

O/485/20

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003402773
BY UNIVERSAL DELIVERY SOLUTIONS LTD
TO REGISTER THE FOLLOWING MARK:**



IN CLASS 39

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 417752
BY UNITED PARCEL SERVICE OF AMERICA, INC**

BACKGROUND AND PLEADINGS

1. On 29 May 2019, Universal Delivery Solutions Ltd (“the applicant”) applied to register, in the UK, the trade mark shown on the cover page of this decision. The application was published for opposition purposes on 14 June 2019 and registration is sought for the goods and services listed in paragraph 23 below.

2. On 16 September 2019, United Parcel Service of America, Inc (“the opponent”) opposed the application based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). For the purposes of its opposition based upon section 5(2)(b), the opponent relies on the following trade marks:

UPS

UK registration no. 1297284

Filing date 7 January 1987; registration date 15 March 1991

Relying on all services for which the mark is registered, namely:

Class 39 Transportation of goods by road and by air; arranging the transport of goods by road and air; all included in Class 39.

(“the First Earlier Mark”)

UPS

UK registration no. 2175260

Filing date 18 August 1998; registration date 13 August 2004

Relying on some services for which the earlier mark is registered, namely:

Class 35 Providing computerized tracing of packages in transit.

Class 38 Services of transportation of letters, documents, and other texts, by telex, by telephone, by electronic means, by one or more global computer networks, by facsimile transmission, by the Internet.

(“the Second Earlier Mark”)

UPS WORLDWIDE EXPRESS SAVER

UK registration no. 2471843

Filing date 8 November 2007; registration date 4 April 2008

Relying on all goods for which the earlier mark is registered, namely:

Class 39 Transportation of letters, documents, communications, printed matter, and other goods and property by diverse means of transportation, and including related services namely warehousing and storage and packing and delivery.

(“the Third Earlier Mark”)

UPS SUPPLY CHAIN SOLUTIONS

UK registration no. 2311978

Filing date 30 September 2002; registration date 23 July 2004

Relying on some services for which the earlier mark is registered, namely:

Class 35 Logistics management; integrated tracking and management of commercial transactions; providing computerized tracing of packages in transit.

Class 39 Freight forwarding; packaging articles for transportation; services of transportation of letters, documents, communications, printed matter, and other goods and property by diverse means of transportation, and including related services in Class 39 such as warehousing, storage, packing, delivery and returns with respect to the foregoing.

(“the Fourth Earlier Mark”)

UPS SUPPLY CHAIN SYMPHONY

UK registration no. 3373453

Filing date 7 February 2019; registration date 26 April 2019

Relying on all services for which the earlier mark is registered, namely:

Class 35 Logistics management in the field of transportation and delivery services; integrated tracking and management of commercial transactions on a global computer network; business management services, namely, managing logistics, reverse logistics, supply chain services, supply chain visibility and synchronization, supply and demand forecasting and product distribution processes for others; data processing services; providing computerized tracing of packages in transit;

management assistance services; business management consulting services.

Class 39 Transportation and delivery of personal property by air, rail, boat, and motor vehicle; transport by air, land, and sea; freight forwarding; document delivery, namely, services of transportation of letters, documents, communications, printed matter, and other goods and property by diverse means of transportation; document delivery and returns.

Class 42 Providing online non-downloadable computer programs for use in data management for transportation and delivery services.

(“the Fifth Earlier Mark”)

3. The opponent claims that there is a likelihood of confusion because the respective marks are similar, and the goods and services are identical or similar.

4. For the purposes of its opposition based upon section 5(3) of the Act, the opponent relies on the First and Second Earlier Marks only. The opponent claims a reputation in respect of the goods and services listed above for which the First and Second Earlier Marks are registered. The opponent claims that use of the applicant’s mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or reputation of the earlier marks.

5. For the purposes of its opposition based upon section 5(4)(a) of the Act, the opponent relies upon the sign **UPS**. The opponent claims to have used the sign throughout the UK since as early as 1990 in respect of the following goods and services:

“Logistics services; transportation of goods by road and by air; arranging the transport of goods by road and by air; transportation of letters, documents, communications, printed matter, and other goods and property by diverse means of transportation, and including related services namely warehousing and storage and packing and delivery; freight forwarding; packaging articles for transportation; logistics management; document delivery and returns.”

6. The applicant filed a counterstatement denying the claims made.

7. The applicant is unrepresented and the opponent is represented by D Young & Co LLP. Both parties filed evidence in chief. The opponent did not file evidence in reply. Neither party requested a hearing and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE

The Opponent's Evidence

8. The opponent filed evidence in the form of the witness statement of Scott Casey dated 7 January 2020, which was accompanied by 11 exhibits. Mr Casey is Vice-President of the opponent, a position he has held since June 2015. Mr Casey confirms that he has been employed by UPS continuously since July 1999.

9. Mr Casey confirms that the opponent was founded in Seattle in 1907 and that the UPS brand was first used in the UK in 1985. By 2018, the opponent had more than 3,100 access points in the UK, more than 8,500 employees and a delivery fleet of more than 2,800 vehicles.¹ Mr Casey explains that “access points” provide customers with an alternative to home delivery. The list of services offered in the UK includes freight, air and shipping services.

10. Mr Casey describes UPS as “the world’s largest package delivery service and provider of specialised transportation and logistics services”.² Extracts from the opponent’s UK website obtained from the Wayback Machine dated July 2017, confirm that the opponent offered a range of shipping services, both nationally and internationally.³ These services included a range of freight and air freight services. The pages all display the following mark:

¹ Exhibit SC2

² Witness statement of Scott Casey, para. 7

³ Exhibit SC4



11. The opponent's mark has been referenced in publications such as The Financial Times (2005 and 2018) and Reuters (2018).⁴

12. The opponent's Annual Report for 2018 confirms that it had over 10.6 million customers.⁵ It also recorded revenue of \$71,861 million for 2018, \$66,585 million for 2017 and \$61,610 million for 2016. However, I note that none of these figures are broken down by country, although the report states "Europe, one of our largest regions outside of the US, accounts for approximately half of international revenue and is one of the primary drivers of our growth".

13. In 2019, UPS was voted as number 51 of the World's Most Valuable Brands by Forbes.⁶ In 2017 and 2018, Brand Value identified UPS as "the world's most valuable logistics brand". Interbrand listed UPS as number 29 of the Best Global Brands 2018.

14. Mr Casey explains that in 2010, the opponent heavily invested in rebranding its entire UK fleet with the 2012 logo for the Olympics and Paralympics. A press release dated 5 October 2010 confirms this and states that:

"UPS is responsible for virtually all the distribution and logistics services for the London 2012 Olympic and Paralympic Games via an integrated supply chain solution that includes venue logistics services, warehousing services and a distribution network that will collect and deliver virtually everything from documents to heavy freight. UPS will also be responsible for all customs clearance, freight forwarding and courier services before, during and after the London 2012 Olympic and Paralympic Games."⁷

⁴ Exhibit SC5

⁵ Exhibit SC6

⁶ Exhibit SC9

⁷ Exhibit SC10

15. As noted above, the opponent filed written submissions in lieu. Whilst I do not propose to summarise those submissions here, I have taken them into consideration and will refer to them below where necessary.

The Applicant's Evidence

16. The applicant filed evidence in the form of the witness statement of Neeraj Chawla dated 5 March 2020, which was accompanied by 4 exhibits. Mr Chawla is the Managing Director of the applicant.

17. Mr Chawla notes that the applicant runs a worldwide courier service and also that the applicant has over 20 years of experience in the industry.

18. Mr Chawla has also attached examples of the parties' vehicles with their respective branding visible, as well as their respective logos.⁸ I will address each of these points where appropriate in my decision. Mr Chawla's evidence also contained a number of statements which amounted to submissions rather than evidence. I will not summarise those points here, but will address them below where appropriate.

PRELIMINARY ISSUE

19. I note Mr Chawla's reference to the fact that the applicant has a lot of experience in the industry. However, it is not clear when the applicant started using the applied-for mark or how long it has been in use for. There certainly does not appear to be any suggestion that the applicant's use pre-dates the opponent's use of its mark. In any event, for the avoidance of doubt, prior use of the applied-for mark is not a defence to these opposition proceedings and I do not consider that this would assist the applicant.⁹

⁸ Exhibits SC1 to SC4

⁹ See Tribunal Practice Notice 4/2009

DECISION

Section 5(2)(b)

20. Section 5(2)(b) of the Act reads as follows:

“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.”

21. By virtue of their earlier filing dates, the trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As the Fifth Earlier Mark had not completed its registration process more than 5 years before the application date of the mark in issue, it is not subject to proof of use pursuant to section 6A of the Act. By contrast, the First, Second, Third and Fourth Earlier Marks would have been subject to the proof of use requirements. However, in its counterstatement, the applicant elected not to require the opponent to provide evidence of use. The opponent can, therefore, rely upon all of the earlier marks identified in respect of all of the relied upon services.

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

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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

23. The competing services are as follows:

Opponent's services	Applicant's services
<p>The First Earlier Mark</p> <p><u>Class 39</u> Transportation of goods by road and by air; arranging the transport of goods by road and air; all included in Class 39.</p> <p>The Second Earlier Mark</p> <p><u>Class 35</u> Providing computerized tracing of packages in transit.</p> <p><u>Class 38</u> Services of transportation of letters, documents, and other texts, by telex, by telephone, by electronic means, by one or more global computer networks, by facsimile transmission, by the Internet.</p>	<p><u>Class 39</u> Advisory services related to removals; Advisory services relating to road transportation; Advisory services relating to the distribution of goods; Advisory services relating to the handling of goods; Advisory services relating to the packing of goods; Advisory services relating to the repacking of goods; Advisory services relating to the storage of goods; Advisory services relating to the tracking of goods in transit; Advisory services relating to the transportation of goods; Advisory services relating to transport; Agency services for arranging the transportation of goods; Air cargo transport; Air cargo transport services;</p>

<p>The Third Earlier Mark</p> <p><u>Class 39</u></p> <p>Transportation of letters, documents, communications, printed matter, and other goods and property by diverse means of transportation, and including related services namely warehousing and storage and packing and delivery.</p> <p>The Fourth Earlier Mark</p> <p><u>Class 35</u></p> <p>Logistics management; integrated tracking and management of commercial transactions; providing computerized tracing of packages in transit.</p> <p><u>Class 39</u></p> <p>Freight forwarding; packaging articles for transportation; services of transportation of letters, documents, communications, printed matter, and other goods and property by diverse means of transportation, and including related services in Class 39 such as warehousing, storage, packing, delivery and returns with respect to the foregoing.</p> <p>The Fifth Earlier Mark</p> <p><u>Class 35</u></p> <p>Logistics management in the field of transportation and delivery services; integrated tracking and management of</p>	<p>Air courier services; Air freight shipping services; Air freight transportation; Air transport; Air transportation; Air transportation of freight; Air transportation services for cargo; Air transportation services for freight; Arranging for the shipping of cargo; Arranging for the transport of air freight; Arranging for the transport of goods by sea; Arranging the collection of goods; Arranging the collection of packages; Arranging the collection of packets; Arranging the collection of parcels; Arranging the delivery of gifts; Arranging the delivery of goods; Arranging the delivery of goods by post; Arranging the shipping of goods; Arranging the storage of goods; Arranging the storage of luggage; Arranging the transportation of cargo; Arranging the transportation of goods; Arranging the transportation of parcels; Arranging the transportation of parcels by air; Arranging the transportation of parcels by land; Arranging the transportation of parcels by sea; Arranging the unloading of cargo; Arranging transport services by land, sea and air; Arranging transportation by land, sea, and air; Arranging transportation of goods; Baggage handling; Bonded storage; Bonded storage of goods; Bonded warehousing; Booking of transport; Brokerage (Freight -);</p>
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<p>commercial transactions on a global computer network; business management services, namely, managing logistics, reverse logistics, supply chain services, supply chain visibility and synchronization, supply and demand forecasting and product distribution processes for others; data processing services; providing computerized tracing of packages in transit; management assistance services; business management consulting services.</p>	<p>Brokerage services relating to storage; Brokerage services relating to transport; Brokerage (Ship -); Brokerage (Transport -); Bulk storage; Cargo container rental services; Cargo delivery services; Cargo forwarding services; Cargo handling; Cargo handling and freight services; Cargo handling services; Cargo loading services; Cargo services; Cargo ship transport; Cargo tracking services; Cargo transportation; Cargo unloading; Cargo unloading services; Collection of documents; Collection of freight; Collection of goods; Collection of letters; Collection of luggage; Collection of packages; Collection of packages by air; Collection of packages by road; Collection of packages by sea; Collection, transport and delivery of goods; Collection, transport and delivery of goods, documents, parcels and letters; Collection, transport and delivery of palletised goods; Commercial furniture removals; Commercial removal services; Consultancy in the field of air transport; Consultancy in the field of business travel provided by telephone call centers and hotlines; Consultancy in the field of storage services provided by telephone call centers and hotlines; Consultancy in the field of transport services provided by telephone call centers and hotlines;</p>
<p><u>Class 39</u></p> <p>Transportation and delivery of personal property by air, rail, boat, and motor vehicle; transport by air, land, and sea; freight forwarding; document delivery, namely, services of transportation of letters, documents, communications, printed matter, and other goods and property by diverse means of transportation; document delivery and returns.</p>	<p>Collection of letters; Collection of luggage; Collection of packages; Collection of packages by air; Collection of packages by road; Collection of packages by sea; Collection, transport and delivery of goods; Collection, transport and delivery of goods, documents, parcels and letters; Collection, transport and delivery of palletised goods; Commercial furniture removals; Commercial removal services; Consultancy in the field of air transport; Consultancy in the field of business travel provided by telephone call centers and hotlines; Consultancy in the field of storage services provided by telephone call centers and hotlines; Consultancy in the field of transport services provided by telephone call centers and hotlines;</p>
<p><u>Class 42</u></p> <p>Providing online non-downloadable computer programs for use in data management for transportation and delivery services.</p>	<p>Consultancy in the field of air transport; Consultancy in the field of business travel provided by telephone call centers and hotlines; Consultancy in the field of storage services provided by telephone call centers and hotlines; Consultancy in the field of transport services provided by telephone call centers and hotlines;</p>

	<p> Consultancy in the field of transport services provided by telephone call centres and hotlines; Consultancy in the field of travel provided by telephone call centers and hotlines; Consultancy services relating to storage; Consultancy services relating to the distribution of electricity; Consultancy services relating to transportation; Consultancy services relating to warehousing; Container handling; Container hire services; Container leasing; Container leasing for the shipping industry; Container rental; Container storage; Container stuffing of ships cargo; Container transport services; Containers (Rental of -); Courier services; Courier services for cargo; Courier services for goods; Courier services for merchandise; Courier services for messages; Courier services for the delivery of goods; Courier services for the delivery of parcels; Courier services for the delivery packages; Courier services for the transportation of cargo; Courier services [merchandise]; Courier services [messages or merchandise]; Courier services (Travel -); Crating of goods; Crating services; Delivery and forwarding of letters and parcels; Delivery and forwarding of mail; Delivery and storage of goods; Delivery by road; Delivery, despatching and distribution of </p>
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	<p> newspapers and magazines; Delivery [distribution] of goods; Delivery of cargo by air; Delivery of cargo by land; Delivery of correspondence; Delivery of goods; Delivery of goods by mail order; Delivery of goods by messenger; Delivery of goods by rail; Delivery of hampers containing food and drink; Delivery of letters; Delivery of magazines; Delivery of mail by courier; Delivery of messages; Delivery of messages by courier; Delivery of messages [courier]; Delivery of packets; Delivery of parcels; Delivery of parcels by air; Delivery of parcels by courier; Delivery of parcels by land; Delivery of parcels by road; Delivery of parts to grounded aircraft via airplane; Delivery of spirits; Delivery of valuables; Delivery of wines; Despatch of goods; Distribution services; Distribution services relating to beverages, such as alcoholic beverages; Distribution [transport] of goods by air; Distribution [transport] of goods by road; Distribution [transport] of goods by sea; Distribution [transport] of retail goods; Document delivery; Document delivery [hand carried]; Express delivery of freight; Express delivery of goods; Express delivery of letters; Filling of containers; Filling of vehicles with freight; Food delivery; Forwarding agency services; Forwarding of freight; Forwarding of </p>
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	<p>goods; Forwarding of letters; Forwarding of parcels; Franking of mail; Freight and cargo services; Freight and cargo transportation and removal services; Freight and transport brokerage; Freight and transport brokerage services; Freight brokerage; Freight brokerage [forwarding (Am.)]; Freight brokerage services; Freight forwarding; Freight forwarding agency services; Freight forwarding between seaports; Freight forwarding by air; Freight forwarding by land; Freight forwarding by sea; Freight forwarding services; Freight loading services; Freight services; Freight ship transport; Freight shipping; Freight [shipping of goods]; Freight train transport; Freight transportation; Freight transportation brokerage; Freight transportation by air; Freight transportation services; Freight warehousing; Freight warehousing services; Freight-forwarding services; Freighting; Freighting services; Furniture moving; Furniture removals; Furniture transportation; Furniture (Transporting -); Goods (Delivery of -); Goods (Storage of -); Goods warehousing; Handling of baggage; Haulage services; Haulage services (Road -); Import and export cargo handling services; International air freight shipping services; International ocean freight shipping services;</p>
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	<p> Labelling services; Land freight services; Letters (Collection of -); Letters (Delivery of -); Loading and unloading of goods; Loading of air freight; Loading of cargo; Loading of freight; Luggage storage; Luggage storage services; Mail delivery; Mail delivery and courier services; Messenger courier services; Messenger (Delivery of goods by -); Messenger services for letters; Ocean shipping; Overseas removal services; Package delivery; Packaging and storage of goods; Packaging and storage services; Packaging of goods; Packaging of goods in transit; Packaging of products; Packaging services; Packing; Packing and packaging services; Packing articles for transportation; Packing of cargo; Packing of freight; Packing of goods for removal; Packing of goods in containers; Packing of merchandise; Packing services; Pallet packaging services; Palletised freight distribution services; Parcel collection services; Parcel delivery; Parcel delivery services; Parcel distribution; Parcel receipt services; Parcel shipping services; Parcel storage services; Pick-up and delivery of letters; Pickup and delivery of parcels and goods; Pick-up and delivery of textile goods; Postal services; Providing information relating to cargo unloading services; Providing information relating </p>
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	<p>to freight brokerage; Providing information relating to removal services; Providing information relating to shipbrokerage; Providing information relating to the delivery of documents, letters and parcels; Providing information relating to the rental of warehouse space; Providing information relating to the temporary storage of personal belongings; Providing information relating to warehousing services; Provision of warehousing services and facilities; Rail freight distribution services; Rail freight services; Rail transport services; Railway transport; Railway transport services; Sea freight forwarding services; Sea freight services; Services for freight-forwarding by air; Services for freight-forwarding by land; Services for freight-forwarding by sea; Services for the arranging of transportation; Services for the storage of freight; Services for transportation; Services of a freight broker; Shipping; Shipping agency; Shipping agency services; Shipping agency services for arranging the transportation of goods; Shipping of cargo; Shipping of documents; Shipping of goods; Shipping services; Storage; Storage and delivery of goods; Storage of baggage; Storage of cargo; Storage of cargo after transportation; Storage of cargo before</p>
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	<p>transportation; Storage of commercial goods; Storage of documents; Storage of freight; Storage of goods; Storage of goods for transportation; Storage of goods in transit; Storage of goods in warehouses; Storage of luggage; Storage of packages; Storage of parcels; Storage of passengers baggage; Storage of passengers luggage; Storage services; Storage services for freight; Storage services for goods; Transport; Transport and delivery of goods; Transport and freight brokerage; Transport and freight brokerage services; Transport and storage; Transport brokerage; Transport by air; Transport by heavy goods vehicles; Transport by land; Transport by road; Transport by sea; Transport by ship; Transport by water; Transport of cargo by air; Transport of freight by air; Transport of freight by rail; Transport of freight containers by lorry; Transport of freight containers by rail; Transport of freight containers by ship; Transport of furniture; Transport of goods; Transport of goods by inland water; Transport of goods by rail; Transport of goods by ship; Transport of packages; Transport of parcels; Transport services; Transportation; Transportation and delivery of goods; Transportation and delivery services by air, road, rail and</p>
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	<p> sea; Transportation and storage; Transportation and storage of goods; Transportation by air; Transportation by air of baggage; Transportation by air of freight; Transportation by courier; Transportation by land; Transportation by rail; Transportation by road; Transportation logistics; Transportation of baggage; Transportation of cargo; Transportation of cargo by air; Transportation of cargo by land vehicle; Transportation of clothing; Transportation of containers; Transportation of cosmetics; Transportation of food; Transportation of freight; Transportation of freight by air; Transportation of freight by land; Transportation of freight by road; Transportation of freight by water; Transportation of furniture; Transportation of furniture of others by trucks; Transportation of goods; Transportation of goods by air; Transportation of goods by rail; Transportation of goods by road; Transportation of goods by sea; Transportation of household effects; Transportation of luggage; Transportation of parcels; Transportation of parcels by air; Transportation of parcels by road; Transportation of parcels by sea; Transportation of parcels overnight; Transportation of passengers' </p>
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	baggage; Transportation services; Transshipment services; Truck hauling; Truck transport; Unloading and repackaging services; Unloading cargo; Unloading cargo and luggage; Unloading of cargo; Unloading of cargo (Services for the -); Unloading of goods (Services for the -); Unloading services; Warehouse storage; Warehouse storage services; Warehousing; Warehousing of baggage; Warehousing of finished goods; Warehousing of freight; Warehousing of goods; Warehousing services.
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24. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“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 trade mark application (Case T-388/00 *Institut for Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

25. In the *Treat* case, [1996] R.P.C. 281, Jacob J. (as he then was) identified the following factors for assessing similarity:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

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

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

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

26. The following services in the applicant's specification all fall within the broader category of "transportation of goods by road and by air" in the First Earlier Mark's specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*:

Air cargo transport; Air cargo transport services; Air courier services; Air freight shipping services; Air freight transportation; Air transportation of freight; Air transportation services for cargo; Air transportation services for freight; Delivery by road; Delivery of cargo by air; Delivery of parcels by air; Delivery of parcels by road; Delivery of parts to grounded aircraft via airplane; Distribution [transport] of goods by air; Distribution [transport] of goods by road; Freight forwarding by air; Freight transportation by air; International air freight shipping services; Services for freight-forwarding by air; Transport of freight by air; Transport of freight containers by lorry; Transportation of cargo by air; Transportation of cargo by land vehicle; Transportation of freight by air; Transportation of freight by road; Transportation of furniture of others by trucks; Transportation of goods by air; Transportation of goods by road; Transportation of parcels by air; Transportation of parcels by road.

27. "Arranging for the transport of air freight" and "Arranging the transportation of parcels by air" in the applicant's specification fall within the broader category of

“arranging the transport of goods by road and air” in the First Earlier Mark’s specification and are, therefore, identical.

28. The following terms in the applicant’s specification are all *Merix* identical to “transportation of letters, documents, communications, printed matter, and other goods and property by diverse means of transportation, and including related services namely warehousing and storage and packing and delivery” in the Third Earlier Mark’s specification, “packaging articles for transportation” in the Fourth Earlier Mark’s specification, “services of transportation of letters, documents, communications, printed matter, and other goods and property by diverse means of transportation, and including related services in Class 39 such as warehousing, storage, packing, delivery and returns with respect to the foregoing” in the Fourth Earlier Mark’s specification and/or “document delivery, namely, services of transportation of letters, documents, communications, printed matter, and other goods and property by diverse means of transportation” in the Fifth Earlier Mark’s specification:

Bonded storage; Bonded storage of goods; Bonded warehousing; Bulk storage; Cargo delivery services; Cargo handling; Cargo handling and freight services; Cargo handling services; Cargo loading services; Cargo services; Cargo ship transport; Cargo tracking services; Cargo transportation; Cargo unloading; Cargo unloading services; Collection of documents; Collection of freight; Collection of goods; Collection of letters; Collection of luggage; Collection of packages; Collection of packages by air; Collection of packages by road; Collection of packages by sea; Collection, transport and delivery of goods; Collection, transport and delivery of goods, documents, parcels and letters; Collection, transport and delivery of palletised goods; Commercial furniture removals; Commercial removal services; Container handling; Container storage; Container stuffing of ships cargo; Container transport services; Courier services; Courier services for cargo; Courier services for goods; Courier services for merchandise; Courier services for messages; Courier services for the delivery of goods; Courier services for the delivery of parcels; Courier services for the delivery packages; Courier services for the transportation of cargo; Courier services [merchandise]; Courier services [messages or merchandise]; Crating of goods; Crating services; Delivery and forwarding of

letters and parcels; Delivery and forwarding of mail; Delivery and storage of goods; Delivery, despatching and distribution of newspapers and magazines; Delivery [distribution] of goods; Delivery of cargo by air; Delivery of cargo by land; Delivery of correspondence; Delivery of goods; Delivery of goods by mail order; Delivery of goods by messenger; Delivery of goods by rail; Delivery of hampers containing food and drink; Delivery of letters; Delivery of magazines; Delivery of mail by courier; Delivery of messages; Delivery of messages by courier; Delivery of messages [courier]; Delivery of packets; Delivery of parcels; Delivery of parcels by courier; Delivery of parcels by land; Delivery of spirits; Delivery of valuables; Delivery of wines; Despatch of goods; Distribution services; Distribution services relating to beverages, such as alcoholic beverages; Distribution [transport] of goods by sea; Distribution [transport] of retail goods; Document delivery; Document delivery [hand carried]; Express delivery of freight; Express delivery of goods; Express delivery of letters; Filling of containers; Filling of vehicles with freight; Food delivery; Franking of mail; Freight and cargo services; Freight and cargo transportation and removal services; Freight loading services; Freight services; Freight ship transport; Freight shipping; Freight [shipping of goods]; Freight train transport; Freight transportation; Freight transportation services; Freight warehousing; Freight warehousing services; Freighting; Freighting services; Furniture moving; Furniture removals; Furniture transportation; Furniture (Transporting -); Goods (Delivery of -); Goods (Storage of -); Goods warehousing; Handling of baggage; Haulage services; Haulage services (Road -); International ocean freight shipping services; Labelling services; Land freight services; Letters (Collection of -); Letters (Delivery of -); Loading and unloading of goods; Loading of air freight; Loading of cargo; Loading of freight; Luggage storage; Luggage storage services; Mail delivery; Mail delivery and courier services; Messenger courier services; Messenger (Delivery of goods by -); Messenger services for letters; Ocean shipping; Overseas removal services; Package delivery; Packaging and storage of goods; Packaging and storage services; Packaging of goods; Packaging of goods in transit; Packaging of products; Packaging services; Packing; Packing and packaging services; Packing articles for transportation; Packing of cargo; Packing of freight; Packing of goods for removal; Packing of goods in containers; Packing of merchandise; Packing services; Pallet

packaging services; Palletised freight distribution services; Parcel collection services; Parcel delivery; Parcel delivery services; Parcel distribution; Parcel receipt services; Parcel shipping services; Parcel storage services; Pick-up and delivery of letters; Pickup and delivery of parcels and goods; Pick-up and delivery of textile goods; Postal services; Provision of warehousing services and facilities; Rail freight distribution services; Rail freight services; Sea freight services; Services for the storage of freight; Shipping; Shipping of cargo; Shipping of documents; Shipping of goods; Shipping services; Storage; Storage and delivery of goods; Storage of baggage; Storage of cargo; Storage of cargo after transportation; Storage of cargo before transportation; Storage of commercial goods; Storage of documents; Storage of freight; Storage of goods; Storage of goods for transportation; Storage of goods in transit; Storage of goods in warehouses; Storage of luggage; Storage of packages; Storage of parcels; Storage of passengers baggage; Storage of passengers luggage; Storage services; Storage services for freight; Storage services for goods; Transport and delivery of goods; Transport and storage; Transport by heavy goods vehicles; Transport of cargo by air; Transport of freight by rail; Transport of freight containers by rail; Transport of freight containers by ship; Transport of furniture; Transport of goods; Transport of goods by inland water; Transport of goods by rail; Transport of goods by ship; Transport of packages; Transport of parcels; Transportation and delivery of goods; Transportation and delivery services by air, road, rail and sea; Transportation and storage; Transportation and storage of goods; Transportation by air of baggage; Transportation by air of freight; Transportation by courier; Transportation of baggage; Transportation of cargo; Transportation of clothing; Transportation of containers; Transportation of cosmetics; Transportation of food; Transportation of freight; Transportation of freight by land; Transportation of freight by water; Transportation of furniture; Transportation of goods; Transportation of goods by rail; Transportation of goods by sea; Transportation of household effects; Transportation of luggage; Transportation of parcels; Transportation of parcels by sea; Transportation of parcels overnight; Transportation of passengers' baggage; Transshipment services; Truck hauling; Truck transport; Unloading and repackaging services; Unloading cargo; Unloading cargo and luggage; Unloading of cargo; Unloading of cargo (Services for the -); Unloading of goods

(Services for the -); Unloading services; Warehouse storage; Warehouse storage services; Warehousing; Warehousing of baggage; Warehousing of finished goods; Warehousing of freight; Warehousing of goods; Warehousing services.

29. "Freight forwarding" appears identically in the applicant's specification and the specifications of the Fourth and Fifth Earlier Marks. I consider "Forwarding of freight", "Freight forwarding between seaports", "Freight forwarding by land", "Freight forwarding by sea", "Freight forwarding services", "Freight-forwarding services", "Sea freight forwarding services", "Services for freight-forwarding by land" and "Services for freight-forwarding by sea" in the applicant's specification to be self-evidently or *Meric* identical to this term.

30. "Cargo forwarding services", "Forwarding agency services", "Forwarding of goods", "Forwarding of letters", "Forwarding of parcels" and "Freight forwarding agency services" in the applicant's specification are all likely to be sold through the same trade channels as "freight forwarding" in the Fourth and Fifth Earlier Marks' specifications. The services are likely to overlap in user, use, method of use and purpose. I consider the services to be highly similar.

31. The following services in the applicant's specification are all likely to be sold through the same trade channels as "transportation of goods by road and by air" in the First Earlier Mark's specification, "providing computerized tracing of packages in transit" in the Second Earlier Mark's specification and/or "Transportation of letters, documents, communications, printed matter, and other goods and property by diverse means of transportation, and including related services namely warehousing and storage and packing and delivery" in the Third Earlier Mark's specification. There will also be overlap in user. I consider these services to be similar to a medium degree:

Advisory services related to removals; Advisory services relating to the distribution of goods; Advisory services relating to the handling of goods; Advisory services relating to the packing of goods; Advisory services relating to the repacking of goods; Advisory services relating to the storage of goods; Advisory services relating to the tracking of goods in transit; Advisory services

relating to the transportation of goods; Arranging for the shipping of cargo; Arranging for the transport of goods by sea; Arranging the collection of goods; Arranging the collection of packages; Arranging the collection of packets; Arranging the collection of parcels; Arranging the delivery of gifts; Arranging the delivery of goods; Arranging the delivery of goods by post; Arranging the shipping of goods; Arranging the storage of goods; Arranging the storage of luggage; Arranging the transportation of cargo; Arranging the transportation of goods; Arranging the transportation of parcels; Arranging the transportation of parcels by land; Arranging the transportation of parcels by sea; Arranging the unloading of cargo; Arranging transportation of goods; Baggage handling; Providing information relating to cargo unloading services; Providing information relating to removal services; Providing information relating to the delivery of documents, letters and parcels; Providing information relating to the rental of warehouse space; Providing information relating to the temporary storage of personal belongings; Providing information relating to warehousing services.

32. "Transportation logistics" in the applicant's specification falls within the broader categories of "logistics management" in the Fourth Earlier Mark's specification and "logistics management in the field of transportation and delivery services" in the Fifth Earlier Mark's specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

33. The following services in the applicant's specification are identical to the opponent's transport services (such as "transportation of goods by road and rail" in the First Earlier Mark's specification and "Transportation of letters, documents, communications, printed matter, and other goods and property by diverse means of transportation, and including related services namely warehousing and storage and packing and delivery" in the Third Earlier Mark's specification) on the principle outlined in *Meric*:

Air transport; Air transportation; Arranging transport services by land, sea and air; Arranging transportation by land, sea, and air; Booking of transport; Rail transport services; Railway transport; Railway transport services; Services for

the arranging of transportation; Services for transportation; Transport; Transport by air; Transport by land; Transport by road; Transport by sea; Transport by ship; Transport by water; Transport services; Transportation; Transportation by air; Transportation by land; Transportation by rail; Transportation by road; Transportation services.

34. The following services will overlap in user and trade channels with the opponent's transport services (such as "transportation of goods by road and rail" in the First Earlier Mark's specification):

Advisory services relating to road transportation; Advisory services relating to transport; Consultancy in the field of air transport; Consultancy in the field of transport services provided by telephone call centers and hotlines; Consultancy in the field of transport services provided by telephone call centres and hotlines; Consultancy services relating to transportation.

In that regard, the services will be similar to between a low and medium degree.

35. "Consultancy in the field of business travel provided by telephone call centers and hotlines", "Consultancy in the field of travel provided by telephone call centers and hotlines" and "Courier services (Travel -)" in the applicant's specification are all likely to relate exclusively to the transport of people, because of their reference to 'travel'. There will be an overlap in user with the opponent's transport services, as these could be used by members of the general public. However, there will be no overlap in nature, purpose, method of use or trade channels. There will be no competition. I consider the services to be dissimilar.

36. There may be an overlap in trade channels and user between "Consultancy in the field of storage services provided by telephone call centers and hotlines", "Consultancy services relating to storage" and "Consultancy services relating to warehousing" in the applicant's specification and "Transportation of letters, documents, communications, printed matter, and other goods and property by diverse means of transportation, and including related services namely warehousing and storage and packing and delivery" in the Third Earlier Mark's specification and "services of transportation of letters,

documents, communications, printed matter, and other goods and property by diverse means of transportation, and including related services in Class 39 such as warehousing, storage, packing, delivery and returns with respect to the foregoing” in the Fourth Earlier Mark’s specification. I consider these services to be similar to between a low and medium degree.

37. “Consultancy services relating to the distribution of electricity” in the applicant’s specification do not appear to share any overlap in terms of use, method of use, trade channels, nature or purpose with any of the opponent’s services. There is no competition or complementarity.¹⁰ I consider the services to be dissimilar.

38. There will be overlap in purpose and user between “Agency services for arranging the transportation of goods”, “Shipping agency”, “Shipping agency services” and “Shipping agency services for arranging the transportation of goods” in the applicant’s specification and the opponent’s various transportation services. I consider that there may also be a degree of overlap in trade channels, although I recognise that that will not always be the case. I consider the services to be similar to a medium degree.

39. A brokerage service involves someone acting as an intermediary between two interested parties. For example, in this case, that might be carriers who are able to transport goods and businesses who need goods shipped from one place to another. There will, therefore, be no overlap in trade channels between the following services in the applicant’s specification and the opponent’s transportation services:

Brokerage (Freight -); Brokerage services relating to storage; Brokerage services relating to transport; Brokerage (Ship -); Brokerage (Transport -); Freight and transport brokerage; Freight and transport brokerage services; Freight brokerage; Freight brokerage [forwarding (Am.)]; Freight brokerage services; Freight transportation brokerage; Providing information relating to freight brokerage; Providing information relating to shipbrokerage; Services of

¹⁰ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

a freight broker; Transport and freight brokerage; Transport and freight brokerage services; Transport brokerage.

There will be overlap in purpose and user with the opponent's transport services (such as "transportation of goods by road and rail" in the First Earlier Mark's specification and "Transportation of letters, documents, communications, printed matter, and other goods and property by diverse means of transportation, and including related services namely warehousing and storage and packing and delivery" in the Third Earlier Mark's specification). There may also be a degree of competition in that someone looking to ship goods might go to either a broker or direct to a carrier. I consider the services to be similar to a medium degree.

40. The same will also apply to "Import and export cargo handling services" in the applicant's specification, as these may also be provided by a third party intermediary. For the same reasons set out above, I consider these services to be similar to a medium degree.

41. In my view, there may be a degree of overlap in user and trade channels between "Cargo container rental services", "Container hire services", "Container leasing", "Container leasing for the shipping industry", "Container rental" and "Containers (Rental of -)" in the applicant's specification and the opponent's various transport services (such as "transportation of goods by road and rail" in the First Earlier Mark's specification and "Transportation of letters, documents, communications, printed matter, and other goods and property by diverse means of transportation, and including related services namely warehousing and storage and packing and delivery" in the Third Earlier Mark's specification). The purpose of the services will differ, as will the method of use and nature. Taking this into account, I consider the services to be similar to between a low and medium degree.

42. As some degree of similarity between the services is necessary to engage the test for likelihood of confusion, the opposition under section 5(2)(b) must fail in respect of those services that I have found to be dissimilar.¹¹

¹¹ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

The average consumer and the nature of the purchasing act

43. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the services are likely to be selected by the average consumer. 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.”

44. The average consumer for the services will be either a member of the general public or a business user. The cost of the purchase is likely to vary, from postal services that are likely to be relatively low in cost to international brokerage services which are likely to be much more expensive. Even where the cost of the purchase is low, various factors will be taken into account such as speed of delivery, security of storage or warehouse facilities and capacity. Taking this into account, I consider that at least a medium degree of attention will be paid during the purchasing process.

45. The services are likely to be purchased from specialist retail premises or their online equivalents. Consequently, visual considerations are likely to dominate the selection process. However, I recognise that verbal advice may still be sought and word of mouth recommendations may be made and so aural considerations cannot be discounted. Further, the aural component to the purchase is likely to be of greater importance for some of the services, such as brokerage services, where discussions are likely to take place by telephone.

Comparison of trade marks

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

47. 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.

48. Mr Chawla states that the applicant mainly works in the Indian market and notes that the opponent’s focus is Europe and the US. Mr Chawla makes the following points, by way of submission:

“1. Distinct difference between the branding colours of both company logos, UPS: Brown & Yellow in comparison to Universal Delivery Solutions: Red White and Black.


2. Both logos are far from being identical in anyway or form.

3. UPS have used lower case on their logo, Universal Delivery Solutions have used upper case on their logo.

4. The font is completely different for Universal Delivery Solutions & UPS.
5. UPS have a shield around their logo, which makes their logo very distinctive.
6. Universal Delivery Solutions has a arrow going through the first 2 letters of their logo.
7. Universal Delivery Solutions use the term 'Logistics Simplified' as part of their logo. UPS has just the 3 letters as part of their logo.
8. Distinct difference in the advertising on company vehicles. UPS advertises their logo and Worldwide Services, Universal Delivery Solutions Have the logo & the services listed as well as the freight forwarders associations of which we are members of.
9. Under the UDS logo, on the vans or in fact, any advertising, UDS have their full company name printed. Universal Delivery Solutions. UPS do not..."

49. For the avoidance of doubt, it is the marks as applied-for/registered that are relevant to my assessment. The opponent relies upon word only marks in these proceedings and it is these marks that I must consider when assessing the likelihood of confusion.

50. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
<p style="text-align: center;">UPS (the First and Second Earlier Marks)</p> <p>UPS WORLDWIDE EXPRESS SAVER (the Third Earlier Mark)</p>	 <p>The logo for UDS (Universal Delivery Solutions) features the letters 'UDS' in a bold, red, sans-serif font. The letter 'U' is stylized with a white arrow pointing to the right, passing through the 'D'. Below the 'UDS' text, the words 'Logistics Simplified' are written in a smaller, black, sans-serif font.</p>

UPS SUPPLY CHAIN SOLUTIONS (the Fourth Earlier Mark)	
UPS SUPPLY CHAIN SYMPHONY (the Fifth Earlier Mark)	

51. The applicant's mark consists of the letters UDS presented in red, overlaid with a white arrow device. Beneath these letters is a thin line and the words "Logistics Simplified" in title case. Although the letters UDS are overlaid with the arrow device, I consider that the average consumer will still identify them as these letters, particularly given the propensity to identify letters within trade marks. Given their size and positioning, I consider the letters UDS play the greater role in the overall impression, with the arrow device, colour and words "Logistics Simplified" playing a lesser role.

52. The First and Second Earlier Marks consist of the letters UPS. There are no other elements to contribute to the overall impression of the marks, which lies in the combination of these letters. The Third, Fourth and Fifth Earlier Marks all consist of the letters UPS followed by series of other words (WORLDWIDE EXPRESS SAVER, SUPPLY CHAIN SOLUTIONS and SUPPLY CHAIN SYMPHONY respectively). These all appear to be slogans or service descriptions, and so I consider that the letters UPS play a greater role in the overall impression of these marks, with the following words playing a lesser role.

Visual Comparison

The First and Second Earlier Marks

53. The marks all overlap in the presence of the letters U-S. The point of visual difference between the marks, is the presence of the letter P in the earlier marks and the letter D in the applicant's mark. However, I note that the letters P and D do themselves share a degree of visual similarity. I do not consider that the use of red in the applicant's mark has any impact, as registration of a mark in black and white (as

is the case in respect of the earlier marks) will cover use of that mark in any colour. The additional point of visual difference is the arrow device in the applicant's mark, and the words "Logistics Simplified" which have no counterpart in the earlier marks. Taking this into account, I consider the marks to be visually similar to a medium degree.

The Third, Fourth and Fifth Earlier Marks

54. The same comparison applies in relation to the letters UPS and UDS in each of the marks. The arrow device remains a point of visual difference. However, in the case of these earlier marks the letters UPS are followed by words which appear to be a slogan or service description. Taking all of this into account, I consider the marks to be visually similar to between a low and medium degree.

Aural Comparison

The First and Second Earlier Marks

55. The First and Second Earlier Marks will be pronounced YOU-PEE-ESS. The letters UDS in the applicant's mark will be pronounced YOU-DEE-ESS. I do not consider that the presence of the arrow device will alter this pronunciation. I also do not consider that the words "Logistics Simplified" are likely to be pronounced, as they are likely to be seen as a slogan or service descriptor. Consequently, I consider the marks to be aurally highly similar.

The Third, Fourth and Fifth Earlier Marks

56. The letters UPS and UDS in each of the marks will be pronounced as described above. Again, I consider that the additional wording in each of the earlier marks (WORLDWIDE EXPRESS SAVER, SUPPLY CHAIN SOLUTIONS and SUPPLY CHAIN SYMPHONY respectively) are unlikely to be pronounced as they will be seen as slogans or service descriptors. As noted above, I also do not consider that the words "Logistics Simplified" in the applicant's mark will be pronounced. The marks will be aurally highly similar.

Conceptual Comparison

57. Clearly, the letters used in each of the marks have some meaning to the parties. It appears that UDS stands for “Universal Delivery Solutions” and UPS stands for “United Parcel Service”. However, those meanings are not apparent from their respective trade marks and will not, in my view, be identified by the average consumer. I consider that the average consumer will view both UDS and UPS as acronyms with no particular meaning. Consequently, the conceptual position in respect of these elements will be neutral. The wording “Logistics Simplified” in the applicant’s mark, and the additional wording in each of the Third, Fourth and Fifth Earlier Marks clearly carry different specific meanings and will act as a point of conceptual difference between the marks.

Distinctive character of the earlier trade marks

58. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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).”

59. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

60. I will begin by assessing the inherent distinctive character of the earlier marks. The earlier marks all consist of, or contain, the letters UPS. As noted above, this is likely to be viewed as an acronym with no particular meaning. Consequently, I consider it to be inherently distinctive to between a medium and high degree. The Third, Fourth and Fifth Earlier Marks also contain additional wording (WORLDWIDE EXPRESS SAVER, SUPPLY CHAIN SOLUTIONS and SUPPLY CHAIN SYMPHONY respectively). I consider that these words are likely to be viewed as descriptors or slogans and, consequently, do not contribute significantly to the earlier marks’ distinctive character. Therefore, when taking the Third, Fourth and Fifth Earlier Marks as a whole, I conclude that they are inherently distinctive to a between a medium and high degree.

61. The relevant market for assessing enhanced distinctive character is the UK. I note that Mr Casey’s evidence states that the mark UPS has been used in the UK since 1985. However, the opponent’s evidence has a number of issues. In particular, much of the evidence is not broken down by region. UPS is described as the “world’s largest package delivery service”, but no information is provided about its UK market share. Revenue figures have been provided, but this relates to the opponent’s worldwide operation and no breakdown is given in relation to the UK market. There is clearly use of the UPS mark in the UK, and that use is clearly geographically widespread. In this regard, I note that the opponent has 3,100 access points across the UK. Further, the opponent has a delivery fleet of over 2,800 vehicles and more than 8,500 employees in the UK. Some examples have been provided of the UPS mark being referenced in publications (such as the Financial Times and Reuters) but no information is provided about advertising expenditure in the UK. Whilst I note that the UPS mark was

associated with the 2012 Olympic and Paralympic Games and that this was recorded in a press release by the opponent, I have no evidence as to how or the extent to which this association was publicised. I recognise that the UPS mark has received recognition as one of the “World’s Most Valuable Brands” and one of the “Best Global Brands” but, again, no information is provided about how this relates to the UK market.

62. Taking all of this into account, I am not able to conclude that the opponent has demonstrated enhanced distinctiveness in the UK.

Likelihood of confusion

63. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

64. I have found the First and Second Earlier Marks to be visually similar to the applicant’s mark to a medium degree. I have found them to be aurally highly similar. I have found the Third, Fourth and Fifth Earlier Marks to be visually similar to between a low and medium degree to the applicant’s mark. I have found them to be aurally highly similar. I have found the UPS/UDS elements of each mark to be conceptually neutral, with the additional wording in the applicant’s mark and the Third, Fourth and Fifth Earlier Marks acting as a point of conceptual difference. I have found the earlier marks to be inherently distinctive to between a medium and high degree. I have

identified the average consumer to be a member of the general public or a business user. I have found that the average consumer will purchase most of the services predominantly by visual means, although I do not discount an aural component. Further, for some of the services where intermediaries are used, I recognise that the aural component will play a greater role. I have concluded that at least a medium degree of attention will be paid during the purchasing process. I have found the services to be identical or similar to at least between a low and medium degree (except for those that I have found to be dissimilar).

65. I note in its counterstatement, that the applicant has stated:

“We have gone through asking 30-40 individuals to ask if they can make out by looking at the logos as to what UPS stand for and what UDS standfor.”

66. In its written submissions in lieu, the opponent responds as follows:

“The applicant states in its counterstatement that it asked 30-40 individuals if the individuals could ascertain what UPS stands for and what UDS stands for when looking at the logos. However, the Applicant has not made clear whether these individuals were confused and no evidence was provided indicating the nature of questioning including whether leading questions were posed. In any event, the legal tests under the relevant sections of the Act do not incorporate whether a consumer can ascertain what the prefixes of the mark stand for.”

67. I agree with the opponent. In any event, the fact that these individuals may have been able to tell the difference between the marks when comparing them side by side does not assist the applicant. We do not know exactly what marks were presented to these individuals and what questions were asked of them. Importantly, the assessment that I must make is based upon the views of an average consumer who, as noted above, would not have the benefit of a side by side comparison.

68. In my view, the visual differences between the marks will be sufficient to avoid them being mistakenly recalled or misremembered as each other. For those services in respect of which aural considerations will play a greater role, I recognise that where

the marks are encountered aurally, and keeping in mind that only the UPS/UDS elements are likely to be pronounced, there is a likelihood of direct confusion. I consider that this will be the case notwithstanding the fact that at least a medium degree of attention will be paid during the purchasing process.

69. In considering whether there is a likelihood of indirect confusion, I recognise that the opponent has also pleaded a family of marks argument i.e. that the average consumer will view the applicant's mark as part of the opponent's 'family' of UPS marks. In *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, the CJEU stated:

“62. Whilst it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation to use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a 'family' or 'series' of marks.

63. The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a 'family' or 'series' of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64. As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order

for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family' or 'series', the earlier trade marks which are part of that 'family' or 'series' must be present on the market.”

70. Clearly, there is evidence of the opponent using the First and Second Earlier Marks (which are themselves identical). However, there is no evidence relating to use of the Third, Fourth and Fifth Earlier Marks. Consequently, there is only evidence of the First and Second Earlier Marks being present on the market. I do not consider that the use of two marks (both of which are identical) is sufficient to support a family of marks argument. I, therefore, dismiss this line of argument.

71. However, in my view, the similarity between the UPS/UDS elements are sufficient to lead the average consumer to overlook the different middle letter, and will view the additional elements (slogan-style wording, colour and device) as an alternative mark being used by the same or economically linked undertakings. Consequently, I consider there to be a likelihood of indirect confusion in respect of those services that are similar to at least between a low and medium degree.

Section 5(3)

72. Section 5(3) of the Act states:

“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 a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

73. As noted above, by virtue of its earlier filing date the First and Second Earlier Marks qualify as earlier marks pursuant to section 6 of the Act.

74. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* 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 public calls 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 risk 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*).

75. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the later mark. Thirdly, assuming the first and second conditions have been met, section 5(3) requires that one or more of the types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the services be similar, although the relative distance

between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

76. The relevant date for the assessment under section 5(3) is the date of the application i.e. 29 May 2019.

Reputation

77. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. 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.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

78. In determining whether the opponent has demonstrated a reputation for the services in issue, it is necessary for me to consider whether its marks will be known by a significant part of the public concerned with the services. In reaching this decision, I must take all of the evidence into account including “the market share held by the

trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertaking in promoting it.”

79. I note in the opponent’s written submissions in lieu it states:

“52. Indeed, as can be seen on page 1 of the Applicant’s Witness Statement, the Applicant comments on “the likes of UPS” and notes that the main “sector” of UPS is believed to be the USA/Europe, and on page 3 of the Applicant’s Witness Statement, the Applicant notes that “We (Logistics Industry) all know, UPS is a very big banner/Company”. That the Applicant recognises UPS as being used in Europe and is well-known shows that the Applicant is aware of and admits to UPS’s presence and reputation in the logistics industry in the relevant territory.”

80. I do not consider these statements to be an admission on the part of the applicant. Firstly, the earlier marks are all UK registrations and the opponent must, therefore, establish a reputation in the UK. The applicant makes reference to the use of UPS in the USA and Europe, but makes no reference to the presence of the opponent in the UK market. Secondly, the fact that businesses within the logistics industry recognise the opponent’s mark does not mean that the relevant public for the services offered by the opponent will. Consequently, I do not consider this line of argument to be of assistance to the opponent.

81. No market share information has been provided for the UK market. The only revenue figures provided relate to the opponent’s worldwide operations, with no breakdown provided. Notwithstanding the fact that a reference is made to the extent of use made “in Europe”, this does not assist in demonstrating a reputation in the UK. As noted above, there clearly has been use in the UK given the number of employees, the number of access points and the size of the opponent’s delivery fleet. However, reputation is about the knowledge of a mark amongst a significant part of the relevant public. Some examples of the earlier marks being referenced in the publications have been provided, but no information is provided regarding advertising expenditure in the UK. Further, no information is provided about how widely advertised the opponent’s association with the 2012 Olympic and Paralympic games was, so as to make this

known to the relevant public. Notwithstanding the fact that there is clearly recognition of the opponent's brand, this appears to be on a worldwide scale, rather than being linked with the UK market. Taking the evidence as a whole into account, I am unable to find that the opponent has a reputation for the services.

82. I note that the opponent has referred to the judgment of Mr Justice Arnold in *Och-Ziff* [2011] ETMR 1 in which he states that proving a reputation is "not a particularly onerous requirement". I refer the opponent to the decision of Mr Phillip Johnson, sitting as the appointed person in Case BL O/360/20, in which he stated:

"31. It is important to remember that the burden of establishing a reputation for the purposes of section 5(3) falls on the proprietor of the earlier mark. For a mark with an established reputation this may not be "a particularly onerous requirement" to satisfy: *Och-Ziff Management Europe Ltd & Anor v Och Capital LLP & Anor* [2010] EWHC 2599 (Ch), [2011] FSR 11, paragraph 126. However, this does *not* mean that the proprietor of an earlier mark who has filed only weak, incomplete, or irrelevant evidence to establish the reputation should be given the benefit of the doubt at the expense of the applicant. The reason it is not an onerous requirement is because collecting the evidence should be straightforward (even if time consuming) where a mark has the necessary reputation."

83. As I have found the opponent's evidence to be incomplete for the reasons set out above, I do not consider that reliance on this authority in this regard is of assistance to the opponent.

Link

84. For the avoidance of doubt, even if I had been able to find that the opponent had a reputation, the evidence is limited to services relating to the delivery, freight and transportation of goods. In my view, even if the opponent had demonstrated a reputation for these services, the distance between them and the services that I have found to be dissimilar above, would be sufficient to offset the similarity between the marks and the opponent's reputation and to avoid a link being made in the mind of the

consumer. I do not, therefore, consider that the section 5(3) ground would have put the opponent in any stronger position.

85. The opposition based upon section 5(3) is unsuccessful.

Section 5(4)(a)

86. Section 5(4)(a) of the Act states as follows:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

aa)...

b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

87. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

88. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

89. The applicant’s evidence is that it has over 20 years’ experience in the industry. However, no information is provided about how long the applied-for mark has been used. Further, no evidence has been provided to support the suggestion that the applied-for mark has been used prior to the date of the application, other than undated photographs of the applicant’s logo. Consequently, the only relevant date that I am able to consider is the date of the application i.e. 29 May 2019.

Goodwill

90. The House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

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

91. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

92. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

93. Goodwill arises as a result of trading activities. Whilst I have not found the opponent's evidence sufficient to justify a finding of reputation (because that relates to knowledge of the mark amongst a significant part of the relevant public), it is clear that the opponent had been trading prior to the relevant date. This is clear from the number of employees and access points that it has and the size of its delivery fleet. Further, there is evidence that the opponent was working as part of the 2012 Olympic and Paralympic Games, even if there is no evidence about how widely known this association was. Taking the evidence as a whole into account, I am satisfied that the opponent had at least a reasonable degree of goodwill in the UK at the relevant date. I also consider that the sign relied upon was distinctive of that goodwill.

Misrepresentation and damage

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

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's

reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

95. I recognise that the test for misrepresentation is different from that for likelihood of confusion in that it entails ‘deception of a substantial number of members of the public’ rather than ‘confusion of the average consumer’. However, as recognised by Lewison L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that to be the case here in respect of those services that I have found to be similar to at least between a low and medium degree. In respect of those services, I consider that a substantial number of members of the relevant public would be misled into purchasing the applicant’s services in the mistaken belief that they were the services of the opponent. Damage through diversion of sales is easily foreseeable.

96. However, I do not consider that the same applies in respect of those services that I have found to be dissimilar. I recognise that it is not essential under the law of passing off for the parties to be engaged in the same fields of business activity (see *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA)). However, the closeness of the parties’ respective fields is a factor which must be taken into account. Where the applicant’s services are dissimilar to the opponent’s, I consider that this will offset the similarities between the marks. In my view, the differences between the dissimilar services, combined with the differences between the respective marks will be sufficient to avoid consumers purchasing the applicant’s services in the mistaken belief that they are the services of the opponent.

CONCLUSION

97. The opposition is successful in relation to the following services for which the application is refused:

Class 39

Advisory services related to removals; Advisory services relating to road transportation; Advisory services relating to the distribution of goods; Advisory services relating to the handling of goods; Advisory services relating to the packing of goods; Advisory services relating to the repacking of goods; Advisory services relating to the storage of goods; Advisory services relating to the tracking of goods in transit; Advisory services relating to the transportation of goods; Advisory services relating to transport; Agency services for arranging the transportation of goods; Air cargo transport; Air cargo transport services; Air courier services; Air freight shipping services; Air freight transportation; Air transport; Air transportation; Air transportation of freight; Air transportation services for cargo; Air transportation services for freight; Arranging for the shipping of cargo; Arranging for the transport of air freight; Arranging for the transport of goods by sea; Arranging the collection of goods; Arranging the collection of packages; Arranging the collection of packets; Arranging the collection of parcels; Arranging the delivery of gifts; Arranging the delivery of goods; Arranging the delivery of goods by post; Arranging the shipping of goods; Arranging the storage of goods; Arranging the storage of luggage; Arranging the transportation of cargo; Arranging the transportation of goods; Arranging the transportation of parcels; Arranging the transportation of parcels by air; Arranging the transportation of parcels by land; Arranging the transportation of parcels by sea; Arranging the unloading of cargo; Arranging transport services by land, sea and air; Arranging transportation by land, sea, and air; Arranging transportation of goods; Baggage handling; Bonded storage; Bonded storage of goods; Bonded warehousing; Booking of transport; Brokerage (Freight -); Brokerage services relating to storage; Brokerage services relating to transport; Brokerage (Ship -); Brokerage (Transport -); Bulk storage; Cargo container rental services; Cargo delivery services; Cargo forwarding services; Cargo handling; Cargo handling and freight services; Cargo handling services; Cargo loading services; Cargo services; Cargo ship transport; Cargo tracking services; Cargo transportation; Cargo unloading; Cargo unloading services; Collection of documents;

Collection of freight; Collection of goods; Collection of letters; Collection of luggage; Collection of packages; Collection of packages by air; Collection of packages by road; Collection of packages by sea; Collection, transport and delivery of goods; Collection, transport and delivery of goods, documents, parcels and letters; Collection, transport and delivery of palletised goods; Commercial furniture removals; Commercial removal services; Consultancy in the field of air transport; Consultancy in the field of storage services provided by telephone call centers and hotlines; Consultancy in the field of transport services provided by telephone call centers and hotlines; Consultancy in the field of transport services provided by telephone call centres and hotlines; Consultancy services relating to storage; Consultancy services relating to transportation; Consultancy services relating to warehousing; Container handling; Container hire services; Container leasing; Container leasing for the shipping industry; Container rental; Container storage; Container stuffing of ships cargo; Container transport services; Containers (Rental of -); Courier services; Courier services for cargo; Courier services for goods; Courier services for merchandise; Courier services for messages; Courier services for the delivery of goods; Courier services for the delivery of parcels; Courier services for the delivery packages; Courier services for the transportation of cargo; Courier services [merchandise]; Courier services [messages or merchandise]; Crating of goods; Crating services; Delivery and forwarding of letters and parcels; Delivery and forwarding of mail; Delivery and storage of goods; Delivery by road; Delivery, despatching and distribution of newspapers and magazines; Delivery [distribution] of goods; Delivery of cargo by air; Delivery of cargo by land; Delivery of correspondence; Delivery of goods; Delivery of goods by mail order; Delivery of goods by messenger; Delivery of goods by rail; Delivery of hampers containing food and drink; Delivery of letters; Delivery of magazines; Delivery of mail by courier; Delivery of messages; Delivery of messages by courier; Delivery of messages [courier]; Delivery of packets; Delivery of parcels; Delivery of parcels by air; Delivery of parcels by courier; Delivery of parcels by land; Delivery of parcels by

road; Delivery of parts to grounded aircraft via airplane; Delivery of spirits; Delivery of valuables; Delivery of wines; Despatch of goods; Distribution services; Distribution services relating to beverages, such as alcoholic beverages; Distribution [transport] of goods by air; Distribution [transport] of goods by road; Distribution [transport] of goods by sea; Distribution [transport] of retail goods; Document delivery; Document delivery [hand carried]; Express delivery of freight; Express delivery of goods; Express delivery of letters; Filling of containers; Filling of vehicles with freight; Food delivery; Forwarding agency services; Forwarding of freight; Forwarding of goods; Forwarding of letters; Forwarding of parcels; Franking of mail; Freight and cargo services; Freight and cargo transportation and removal services; Freight and transport brokerage; Freight and transport brokerage services; Freight brokerage; Freight brokerage [forwarding (Am.)]; Freight brokerage services; Freight forwarding; Freight forwarding agency services; Freight forwarding between seaports; Freight forwarding by air; Freight forwarding by land; Freight forwarding by sea; Freight forwarding services; Freight loading services; Freight services; Freight ship transport; Freight shipping; Freight [shipping of goods]; Freight train transport; Freight transportation; Freight transportation brokerage; Freight transportation by air; Freight transportation services; Freight warehousing; Freight warehousing services; Freight-forwarding services; Freighting; Freighting services; Furniture moving; Furniture removals; Furniture transportation; Furniture (Transporting -); Goods (Delivery of -); Goods (Storage of -); Goods warehousing; Handling of baggage; Haulage services; Haulage services (Road -); Import and export cargo handling services; International air freight shipping services; International ocean freight shipping services; Labelling services; Land freight services; Letters (Collection of -); Letters (Delivery of -); Loading and unloading of goods; Loading of air freight; Loading of cargo; Loading of freight; Luggage storage; Luggage storage services; Mail delivery; Mail delivery and courier services; Messenger courier services; Messenger (Delivery of goods by -); Messenger services for letters; Ocean shipping; Overseas removal services; Package delivery; Packaging and storage

of goods; Packaging and storage services; Packaging of goods; Packaging of goods in transit; Packaging of products; Packaging services; Packing; Packing and packaging services; Packing articles for transportation; Packing of cargo; Packing of freight; Packing of goods for removal; Packing of goods in containers; Packing of merchandise; Packing services; Pallet packaging services; Palletised freight distribution services; Parcel collection services; Parcel delivery; Parcel delivery services; Parcel distribution; Parcel receipt services; Parcel shipping services; Parcel storage services; Pick-up and delivery of letters; Pickup and delivery of parcels and goods; Pick-up and delivery of textile goods; Postal services; Providing information relating to cargo unloading services; Providing information relating to freight brokerage; Providing information relating to removal services; Providing information relating to shipbrokerage; Providing information relating to the delivery of documents, letters and parcels; Providing information relating to the rental of warehouse space; Providing information relating to the temporary storage of personal belongings; Providing information relating to warehousing services; Provision of warehousing services and facilities; Rail freight distribution services; Rail freight services; Rail transport services; Railway transport; Railway transport services; Sea freight forwarding services; Sea freight services; Services for freight-forwarding by air; Services for freight-forwarding by land; Services for freight-forwarding by sea; Services for the arranging of transportation; Services for the storage of freight; Services for transportation; Services of a freight broker; Shipping; Shipping agency; Shipping agency services; Shipping agency services for arranging the transportation of goods; Shipping of cargo; Shipping of documents; Shipping of goods; Shipping services; Storage; Storage and delivery of goods; Storage of baggage; Storage of cargo; Storage of cargo after transportation; Storage of cargo before transportation; Storage of commercial goods; Storage of documents; Storage of freight; Storage of goods; Storage of goods for transportation; Storage of goods in transit; Storage of goods in warehouses; Storage of luggage; Storage of packages; Storage of parcels; Storage of passengers baggage; Storage of passengers

luggage; Storage services; Storage services for freight; Storage services for goods; Transport; Transport and delivery of goods; Transport and freight brokerage; Transport and freight brokerage services; Transport and storage; Transport brokerage; Transport by air; Transport by heavy goods vehicles; Transport by land; Transport by road; Transport by sea; Transport by ship; Transport by water; Transport of cargo by air; Transport of freight by air; Transport of freight by rail; Transport of freight containers by lorry; Transport of freight containers by rail; Transport of freight containers by ship; Transport of furniture; Transport of goods; Transport of goods by inland water; Transport of goods by rail; Transport of goods by ship; Transport of packages; Transport of parcels; Transport services; Transportation; Transportation and delivery of goods; Transportation and delivery services by air, road, rail and sea; Transportation and storage; Transportation and storage of goods; Transportation by air; Transportation by air of baggage; Transportation by air of freight; Transportation by courier; Transportation by land; Transportation by rail; Transportation by road; Transportation logistics; Transportation of baggage; Transportation of cargo; Transportation of cargo by air; Transportation of cargo by land vehicle; Transportation of clothing; Transportation of containers; Transportation of cosmetics; Transportation of food; Transportation of freight; Transportation of freight by air; Transportation of freight by land; Transportation of freight by road; Transportation of freight by water; Transportation of furniture; Transportation of furniture of others by trucks; Transportation of goods; Transportation of goods by air; Transportation of goods by rail; Transportation of goods by road; Transportation of goods by sea; Transportation of household effects; Transportation of luggage; Transportation of parcels; Transportation of parcels by air; Transportation of parcels by road; Transportation of parcels by sea; Transportation of parcels overnight; Transportation of passengers' baggage; Transportation services; Transshipment services; Truck hauling; Truck transport; Unloading and repackaging services; Unloading cargo; Unloading cargo and luggage; Unloading of cargo; Unloading of cargo (Services for the -); Unloading of goods (Services for

the -); Unloading services; Warehouse storage; Warehouse storage services; Warehousing; Warehousing of baggage; Warehousing of finished goods; Warehousing of freight; Warehousing of goods; Warehousing services.

98. The application may proceed to registration in respect of the following services:

Class 39 Consultancy in the field of business travel provided by telephone call centers and hotlines; Consultancy in the field of travel provided by telephone call centers and hotlines; Consultancy services relating to the distribution of electricity; Courier services (Travel -).

COSTS

99. The opponent has enjoyed the greater degree of success and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£1,700** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Filing a Notice of opposition and considering the applicant's counterstatement	£400
Filing evidence	£750
Submissions in lieu	£350
Official fee	£200
Total	£1,700

100. I therefore order Universal Delivery Solutions Ltd to pay United Parcel Service of America, Inc the sum of **£1,700**. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 30th day of September 2020

S WILSON

For the Registrar