TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No 12151 BY JONATHAN JAMES MARQUIS FOR A DECLARATION OF INVALIDITY IN RESPECT OF TRADE MARK No 2199041 IN THE NAME OF KENNETH STEPHEN BAILEY

TRADE MARKS ACT 1994

IN THE MATTER OF Application No 12151
by Jonathan James Marquis for a Declaration
of Invalidity in respect of trade mark No 2199041
in the name of Kenneth Stephen Bailey

DECISION

1. Trade mark number 2199041 is for the mark TAXIVISION and is registered for the following goods and services in Classes 9 and 35:-

> **Class 9**
> Apparatus for the recordal, transmission, reception or reproduction of sound or images or a combination thereof, including devices for the transmission and reception of advertising material; parts and fittings for all the aforesaid goods.
>
> **Class 35**
> Advertising services, including dissemination of advertising material utilising devices for the recordal, transmission, reception or reproduction of sound or images or a combination thereof.

The mark stands registered from the filing date of 2 June 1999.

2. On 18 December 2000 Jonathan James Marquis (the applicant) applied for the invalidation of the trade mark registration in relation to the Class 35 services on the grounds that the registration is invalid under Section 47(2)(a) of the Act because of the following earlier UK trade mark registration owned by the applicant:

Mark	Registration No	Registration Date	Journal Ref	Services
CABVISION	2187352	29 January 1999	6271/3624	Advertising services, promotional services, franchising services.

In light of the above registration the applicant contends that the conditions of Section 5(2)(b) apply in relation to registration No 2187352.

3. The registered proprietor filed a counterstatement. While admitting the respective marks are registered for the same and similar goods in Class 35, the registered proprietor denied the grounds of invalidation stating that the trade marks TAXIVISION and CABVISION do not so closely resemble each other so as to be likely to deceive or cause confusion.

4. Both sides have asked for an award of costs in their favour and have filed evidence. A hearing was not requested.

APPLICANT'S EVIDENCE

5. This consists of a witness statement dated 5 April 2001 by Jonathan James Marquis, the registered proprietor of registration No 2187352, CABVISION.

6. Mr Marquis states that the mark sought to be revoked consists of two elements - the word TAXI and the word VISION, whereas his registration also consists of two elements - the word CAB and the word VISION. Mr Marquis contends that as the word VISION appears in the same place at the end of each mark, the issue of similarity will ultimately be determined by considering and comparing the words CAB and TAXI. He adds that, whilst visually and aurally the words are different, in concept they are the same and that this is demonstrated by the dictionary definitions taken from The New Collins Concise English Dictionary which are at Exhibit JJM2 to Mr Marquis' statement and read as follows:-

> **cab** (kæb) *n.* **1.**a. a taxi. **b.** (*as modifier*): *a cab rank*. **2.** the enclosed compartment of a lorry, crane, etc., from which it is driven. **3.** (formerly) a horse-drawn vehicle used for public hire. [C19: <*taximeter cab*]
>
> **taxi** (tæksi) *n., pl.* **taxis** or **taxies. 1.** Also called: **cab, taxicab**. a car, usually fitted with a taximeter, that may be hired to carry passengers to any specified destination. ~vb. **taxiing** *or* taxying, taxied. **2.** to cause (an aircraft) to move along the ground, esp. before takeoff and after landing, or (of an aircraft) to move along the ground in this way. **3.** (*intr.*) to travel in a taxi. [C20: shortened <*taximeter cab*].

Registered Proprietor's Evidence

7. This comprises a witness statement by Kenneth Stephen Bailey dated 16 May 2001. Mr Bailey is the registered proprietor of the mark in suit.

8. Mr Bailey states that the applicant for invalidation has not provided any evidence to support the assertion that there exists, or is likely to exist, a likelihood of confusion between the two trade marks and he adds that a search of the UK trade mark register has revealed that the Registrar has accepted other trade marks which are combined of identical suffixes together with prefixes which could have a similar meaning. Examples given are the mark BUSMILES and COACH MILES in Class 35 and also WEBMILES and NETMILES in Class 9.

9. Mr Bailey concludes that the applicants have not discharged the onus upon them to show that confusion exists or is likely to exist.

DECISION

10. Section 5(2)(b) of the Act states:-

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

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

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

11. 6.-(1) .....

(c) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks, ..."

12. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:-

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;

(h) further, 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; *Marca Mode CV v. Adidas AG*, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

13. In essence the test under Section 5(2)(b) is whether there are similarities in the marks and goods or services which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements, taking into account the category of goods or services in question and how they are marketed.

14. As I have no evidence before me in relation to actual use of either of the respective marks I must compare the mark in suit and the applicant's registration on the basis of fair and notional use.

15. It is common ground before me that the marks cover the same and similar services in Class 35. While I have no evidence before me on the point, it seems to me that the potential customer for the services in question is likely to be informed, knowledgeable and discerning and that the services are likely to be purchased after careful consideration rather than upon impulse or a whim.

16. Before I turn to a comparison of the marks themselves, I wish to comment upon Mr Bailey's submissions in relation to the state of the register in that I do not find them to be of assistance. Mere evidence of entries on the Register without evidence of whether and to what extent the marks concerned are used, is of little or no value. My decision involves a comparison of the applicant's and registered proprietor's marks and must be made on its own merits.

17. The mark in suit comprises the well known dictionary words TAXI and VISION conjoined, whereas the applicant's for invalidation mark consists of the well known dictionary words CAB and VISION conjoined. In my view neither of the marks in their totality has any significant reference or allusion to the nature of the services covered by their specifications. The words TAXI and CAB share identical dictionary definitions and could refer to the method

of advertising e.g. advertising messages placed on taxis or cabs. The identical element i.e. VISION, has no direct reference to the services. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course and circumstances of trade and I must bear this in mind in my considerations.

18. The applicant for cancellation has conceded that the respective marks are visually and aurally different and I agree. In my view the visual and aural differences are considerable. Turning to a conceptual comparison of the marks I take the view that, given that the words TAXI and CAB share the same primary meaning, the marks in their totality are conceptually identical. However, Sabel BV v Puma AG (mentioned earlier in this decision) states that a likelihood of confusion will be difficult to establish on the basis of conceptual similarity alone in circumstances in which the earlier mark is not well known.

19. Conceptual identity is particularly relevant in relation to emphasizing or compounding the imperfect recollection of marks by customers and I must bear in mind that the average customer for goods or services must usually rely upon the imperfect picture of marks he/she has kept in his/her mind. However, in the present case as the services at issue are likely to be ordered/purchased by a careful, informed and discerning customer, imperfect recollection is not likely to be a significant factor and the visual and aural differences in the marks are likely to have a considerable effect in distinguishing the marks. In Sabel BV v Puma AG it was stated that the registration of a mark cannot be opposed merely on the ground that, because the idea behind it and another mark are the same, there is a risk that the public will associate the two marks in the sense that one will simply bring the other to mind without a likelihood of confusion.

20. On a global appreciation I have come to the conclusion that, while it is possible that some people encountering the registered proprietor's mark may think it reminiscent of the applicant's mark it does not follow that a likelihood of confusion exists among the average customers for the services. Given the considerable visual and aural differences between the marks and after taking into account all the relevant factors, including conceptual identity and the possibility of imperfect recollection, it seems to me that the possibility of confusion amongst the relevant customer (who is likely to be sophisticated and discerning) is sufficiently remote that it cannot be regarded as a likelihood. The applicants have not discharged the onus upon them and the case under Section 5(2) fails.

21. As the applicants for invalidity have been unsuccessful, the registered proprietors are entitled to a contribution towards their costs. I order that the applicants pay them the sum of £500. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 02 day of October 2001

J MACGILLIVRAY
For the Registrar
the Comptroller-General