

O-099-08

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION Nos 2394493A and 2394493B  
BY FLY FIRST PLC TO REGISTER THE TRADE MARKS FLY FIRST AND  
FIRST FLY AND DEVICE IN CLASSES 16, 36 AND 39**

**AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS  
THERE TO UNDER NOS 94481 AND 94482  
BY FIRSTGROUP PLC**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application Nos. 2394493A and 2394493B  
by Fly First Plc to register the Trade Marks FLY FIRST and FLY FIRST and  
device in Classes 16, 36 and 39**

**and**

**IN THE MATTER OF Oppositions thereto under No. 94481 and 94482  
by FirstGroup Plc**

1) On 18 March 2008 I issued a decision (O-081-08) in these proceedings on behalf of the Registrar and this further decision corrects a number of irregularities in procedure in that decision.

2) In the decision, I made no mention of the outcome in respect to the term *arrangements for transportation by land, sea...* in the applicant's Class 39 specification. This term survived my analysis of the grounds for opposition under Section 3(1) (b) and (c) of the Act but I erroneously made no reference to this. Under the provisions of Rule 66 of the Trade Marks Rules 2000 (the Rules), I correct this error by adding the term to the list of surviving Class 39 services in paragraph 37. In this paragraph, the reference to paragraph 33 should in fact be to paragraph 35 and I correct this also. The amended paragraph 37 now reads as follows (with changes emphasised):

37) I therefore find that the opposition under Section 3(1) (c) of the Act is successful in so far as it relates to the list of goods and services at paragraph 35 and the application survives for the following list of goods and services:

*Class 16: Paper, cardboard; stationery, books, calendars, posters, photographs; model aeroplanes made of card; model aeroplanes made of paper; instructional and teaching material (except apparatus); adhesives for stationery or household purposes; writing instruments.*

*Class 36: Insurance services; travel insurance services; provision of holiday insurance; charge card and credit card services; issuing and redemption of traveller's cheques; currency and money exchange services; cheque account services; financial services relating to airports; information, consultancy and advisory services relating to all the aforesaid services.*

*Class 39: air cargo transport services; rental of aeroplanes; air navigation services; advisory services relating to the operational safety of aircraft; leasing of aircrafts; courier services; car hire services; air freight transportation; airline services for the transportation of cargo; **arrangements for transportation by land (and) sea**; information, consultancy and advisory services relating to all the aforesaid services.*

3) The opponent is successful in part and my findings in relation to the applicant's composite trade marks insofar as they related to passenger land transport were set out in paragraphs 76 (a), 77 and 89. My comments were intended to cover, not only *passenger transport...services*, but also all other terms that describe passenger land transport services in different ways. The terms *arrangement of transportation of people* and *arrangements for transportation by land* in Class 39 are also covered by the general term "passenger land transport", but because of this error they were not included in the list of services where likelihood of confusion would exist. Under the provisions of Rule 66 of the Rules, I hereby correct this error by amending paragraphs 76 (a), 77 and 89 of that decision as follows (with changes emphasised):

76) Taking a balanced view and adopting the global approach advocated by case law, I consider that with respect to:

a) goods and services that relate to passenger land transport, for which the opponent's trade marks have a heightened distinctive character. In respect of these services the word FLY in the applicant's trade marks is liable to be seen as an allusive reference to being transported quickly and the word FIRST as a reference to a specific undertaking. In this instance, the heightened distinctiveness of the earlier trade marks will have the effect of focusing the relevant consumer on the similarity between the respective marks and the presence in the applicant's trade mark of the word FIRST will outweigh the effect of the differences between the respective trade marks. Therefore, I find that there is a likelihood of confusion with respect to *passenger transport...services*, ***arrangement of transportation of people and arrangements for transportation by land*** in Class 39.

77) Accordingly, with regard to the applicant's composite trade marks, I find that the opposition under Section 5(2) (b) is successful with respect to *passenger transport services*, ***arrangement of transportation of people and arrangements for transportation by land*** but fails in respect to all other goods and services.

...

89) In relation to the applicant's two word and device trade marks, the opposition is successful only in respect of *passenger transport services*, ***arrangement of transportation of people and arrangements for transportation by land*** in Class 39 as **these** terms cover land transport services for which the opponent's earlier marks enjoy a high reputation and enhanced distinctiveness. For all other goods and services I find that the applicant's trade marks neither designate a characteristic of the goods and services claimed nor are devoid of any distinctive character. Further, the visual and conceptual characteristics of these trade marks are such that, even where identical goods and services are involved, there is no likelihood of confusion.

4) In relation to the applicant's word trade mark and with respect to *arrangements for transportation by land* my findings in paragraph 76 (a) and as amended above hold true and I find there is a likelihood of confusion. With respect to the term *arrangements for transportation by ... sea*, I find there is no likelihood of confusion and, to reflect this, I amend paragraph 88 as follows (with changes emphasised):

88) I therefore find that there is no likelihood of confusion for the remaining goods and services, namely *(p)aper, cardboard; stationery, books, calendars, posters, photographs; model aeroplanes made of card; model aeroplanes made of paper; instructional and teaching material (except apparatus); adhesives for stationery or household purposes; writing instruments* in Class 16, *insurance services; travel insurance services; provision of holiday insurance; charge card and credit card services; issuing and redemption of traveller's cheques; currency and money exchange services; cheque account services; financial services relating to airports; information, consultancy and advisory services relating to all the aforesaid services* in Class 36 and *car hire services; arrangements for transportation by sea* in Class 39.

5) The appeal period will be reset and will now start from the date of this decision.

**Dated this 8<sup>th</sup> day of April 2008**  
**Mark Bryant**  
**For the Registrar,**  
**the Comptroller-General**