

**o/1010/22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003657736**

**BY TRIPZ LIMITED**

**TO REGISTER THE TRADE MARK:**

**ZIP**

**IN CLASS 39**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 428516**

**BY ZIPPE TRANSPORT LTD**

## **BACKGROUND AND PLEADINGS**

1. On 18 June 2021, Tripz Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on the 27 August 2021. The applicant seeks registration for the following services:

Class 39 Transport services; Transport of passengers; travel arrangement services; transport booking services; transport reservation services; taxi services.

2. The application was opposed by ZIPPE TRANSPORT LTD (“the opponent”) on 26 November 2021. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade mark:

**Zippe**

**zippe**

**ZIPPE**

**(Series of 3)**

UK registration no. 3592261

Filing date 8 February 2021.

Registration date 18 June 2021.

3. Whilst it stands registered for goods and services in a number of classes, for the purposes of this opposition, the opponent only relies upon its class 39 services, as set out in the Annex to this decision.

4. The opponent claims that there is a likelihood of confusion because of the high similarity of the marks and the identity of the services.

5. The applicant filed a counterstatement accepting that the services are identical, however, the applicant denied that the marks are visually, phonetically and conceptually similar. The applicant also denied that there is a likelihood of confusion on the part of the relevant public.

6. The opponent is represented by Abel + Imray LLP and the applicant is represented by Sonder & Clay. Neither party requested a hearing, nor filed evidence or submissions during the evidence rounds. However, the applicant filed submissions in lieu. This decision is taken following a careful perusal of the papers.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

## **DECISION**

8. Section 5(2)(b) 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.”

9. The earlier mark had not completed its registration process more than five years before the relevant date (the filing date of the mark in issue). Accordingly, the use

provisions at s.6A of the Act do not apply. The opponent may rely on all of the services it has identified without demonstrating that it has used the mark.

### **Section 5(2)(b) case law**

10. 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 the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of services**

11. As highlighted above, in its counterstatement, the applicant accepts that the parties' services are identical.

12. It is therefore unnecessary for me to undertake a comparison as this issue has been conceded, and I shall proceed on the basis that the opponent's and applicant's transport services are identical.

## **The average consumer and the nature of the purchasing act**

13. 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.”

14. The average consumer for transport services will be members of the general public and businesses. The cost of purchase, and the frequency of purchase, is likely to vary, with, for example, taxi and coach booking/reservation and transport services being low-costing services which would be purchased more frequently, and the transport of passengers covering sea or flight based transport, being more expensive, and a less-frequent purchase.

15. Regardless, various factors are still likely to be taken into consideration during the purchasing process, such as the cost, reputational standing of the provider, capacity of the transport, and the facilities available for the users' needs. Taking all of the above into account, I consider that at least a medium degree of attention will be paid during the purchasing process.

16. The services are likely to be obtained through online materials, such as websites, and brochures. Alternatively, the services may be purchased following perusal of advertisements. Consequently, visual considerations are likely to dominate the

selection process. However, I do not discount that there will also be an aural component to the purchase of the services given that they may be booked over the telephone, or a recommendation for the services may have been given through word-of-mouth.

### **Comparison of the trade marks**

17. 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 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.”

18. 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.

19. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
<p style="text-align: center;"><b>Zippe</b> <b>zippe</b> <b>ZIPPE</b></p> <p style="text-align: center;">(Series of 3)</p>	<p style="text-align: center;"><b>ZIP</b></p>

20. The opponent's marks all consist of the word ZIPPE, in different cases. As registration of a word only mark covers use in any standard typeface, I do not consider that the differences between the marks will make any impact upon my assessment. There are no other elements to contribute to the overall impression which lies in the word ZIPPE itself.

21. The applicant's mark consists of the word ZIP. There are no other elements to contribute to the overall impression which lies in the word itself.

22. Visually, the marks coincide in the beginning 3 letters, Z, I and P. However, the opponent's mark ends in the letters P and E. These act as visual points of difference. I bear in mind that greater attention is normally paid to the beginning of the marks and that normal and fair use of word marks mean that they may be used in any standard typeface, as well as in upper and lower-case lettering. However, I also note that the marks are short in length. There is no special test which applies to the comparison of short marks, the visual similarities must be assessed in the normal way.<sup>1</sup> However, it is clear that the addition of two letters to a mark which is only three letters long is clearly more significant than such an addition of one letter to a longer mark. Therefore, I consider that the additional P and E at the end of the opponent's marks will not just be noticed, but will have more of an impact. Taking all of the above into account, I consider that the marks are visually similar to no more than a medium degree.

---

<sup>1</sup> *Bosco Brands UK Limited v Robert Bosch GmbH*, Case BL- O/301/20, paragraph 44



23. Aurally, the applicant submits that the opponent's mark will be pronounced as "ZI-PEE". However, I disagree. I consider that the presence of the double 'P' will make the average consumer pronounce the mark as ZIP-PEE, ensuring that both P's are articulated. The presence of the letters P and E together at the end of the mark also reinforces the pronunciation of the "PEE" syllable at the end of the mark. I consider that the applicant's mark will be given its ordinary pronunciation; ZIP. Consequently, as the marks overlap in the pronunciation of 'ZIP', I consider that the marks are aurally similar to above a medium degree.

24. Conceptually, the applicant's mark, ZIP, will be assigned its ordinary dictionary meaning, which is a device which is used to open and close parts of clothes, and bags.<sup>2</sup> However, as highlighted by the applicant, the word ZIP has more than one dictionary meaning. The applicant therefore submits that "when used in relation to the services for which the registration is sought, its meaning is 'to move at high speed'". I consider that this concept will be recognised and assigned to the applicant's mark by the relevant public, and that this definition of ZIP is allusive of the applicant's services.

25. The opponent's mark, ZIPPE, does begin with the word 'ZIP'. However, I bear in mind that the average consumer does not dissect the mark, it will be read as a whole. Therefore, I do not consider that the average consumer would extract the word ZIP from the word ZIPPE. The average consumer will read it as a whole, as an invented word, with no meaning. Consequently, as the applicant's mark has a clear concept, and the opponent's mark is an invented word, I consider that the marks are conceptually dissimilar.

### **Distinctive character of the earlier trade mark**

26. 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

---

<sup>2</sup> <https://www.collinsdictionary.com/dictionary/english/zip>

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 C108/97 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 promotion of 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).”

26. 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 goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

27. As highlighted above, the opponent’s marks all consist of the word ZIPPE, in different cases. I consider that these marks, when read as a whole, would be recognised as invented words with no ordinary dictionary meaning. Therefore, I consider that the marks are inherently distinctive to a high degree.

### **Likelihood of confusion**

28. 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 services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, 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.

29. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to no more than a medium degree.
- I have found the marks to be aurally similar to above a medium degree.
- I have found the marks to be conceptually dissimilar.
- I have found the opponent's mark to be inherently distinctive to a high degree.
- I have identified the average consumer to be members of the general public and businesses who will select the services primarily by visual means, although I do not discount an aural component.
- I have concluded that at least a medium degree of attention will be paid during the purchasing process for the services.
- The parties' services are identical.

30. I recognise that the word ZIPPE is highly distinctive, and that the parties' services are admitted to be identical. These are clearly factors in favour of the opponent.

31. However, I bear in mind the comments of Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

32. I consider that it is important to ask, ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

33. As highlighted above, the opponent’s mark is highly distinctive because when read as a whole (ZIPPE) it is an invented word with no particular meaning. The opponent’s mark as a whole is not replicated in the applicant’s mark (in which the distinctive character of the opponent’s mark lies). Furthermore, and as established above, the length of the parties’ marks are short, and therefore I consider that the differences are more likely to be noticed. The addition of the letters P and E at the end of the opponent’s marks consequently has more of an impact. Therefore, I do not consider that the marks would be mistakenly recalled or misremembered as each other, nor do I consider that the average consumer would overlook the letters P and E at the end of the opponent’s marks, because the effect is to change an invented word to an allusive ordinary dictionary word, and vice versa. There is a clearly a strong conceptual hook in which to differentiate the marks. Consequently, I do not consider there to be a likelihood of direct confusion.

34. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

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

35. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

36. Having noticed that the competing trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. I do not consider that the average consumer would think the applicants trade mark was connected with the opponent or vice versa on the basis that they both start with the letter combination Z, I and P. It is more likely to be viewed as a coincidence, especially, as highlighted above, the average consumer does not dissect the mark. Consequently, they are not natural variants or brand extensions of each other. Therefore, taking all of the above into account, I consider there is no likelihood of indirect confusion.

## **CONCLUSION**

37. The opposition is unsuccessful, and the application may proceed to registration.

## **COSTS**

38. The applicant has been successful 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 applicant the sum of **£550** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a Counterstatement	£200
Preparing and filling written submissions in lieu	£350
<b>Total</b>	<b>£550</b>

39. I therefore order ZIPPE TRANSPORT LTD to pay Tripz Limited the sum of £550. This sum is to 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 16<sup>th</sup> day of November 2022**

**L FAYTER**

**For the Registrar**

## ANNEX

### **The opponent's mark**

#### Class 39

Transport; travel arrangement; transportation of passengers by motorized vehicle; transportation of passengers by vehicle through a network of transportation providers; arranging and coordinating vehicle sharing and rental services; transportation reservation services; delivery services; food delivery; parcel delivery; flower delivery; courier services; pick-up of goods, documents, packages and cargo; packaging and storage of goods; freight brokerage services; freight transportation by vehicle; leasing of vehicles; rental of vehicles; taxi services; providing transport and travel information; travel route planning; navigation services; tracking of passenger vehicles by computer or via GPS; tracking and tracing of shipments; emergency roadside assistance services, namely towing, recovery winching of vehicles and key delivery services; providing roadside emergency services, namely voice routing and location assistance services through components integrated into a motor vehicle, namely, transmitters, receivers, microprocessors, software, cellular phones, and electrical architecture all interacting with global position system satellite technology and a customer service centre; information, advisory and consultancy services relating to all of the aforesaid.