

O/1164/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003875585

BY WHITE MAGIC TRAVELS LTD

TO REGISTER:

Sky America

AS A TRADE MARK IN CLASS 39

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 440915 BY

ONTRO LIMITED

BACKGROUND AND PLEADINGS

1. On 7 February 2023, White Magic Travels Ltd (“the applicant”) applied to register the trade mark on the cover page of this decision in the UK (“the applicant’s mark”). The applicant’s mark was published for opposition purposes on 17 February 2023 and registration is sought for the services set out in the Annex of this decision.
2. On 17 May 2023, the applicant’s mark was opposed by Ontro Limited (“the opponent”). The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is reliant upon the following trade mark:



UK registration no. 2552169

Filing date 6 July 2010; registration date 14 January 2011

Relying on some services only, namely the following:

Class 39: Arrangement of flights and flight planning service.
 (“the opponent’s mark”).

3. The opponent claims that due to the level of similarity between the marks and the identity of the services at issue, there is a risk of both direct and indirect confusion on the part of the average consumer.
4. The applicant filed a counterstatement wherein it accepted that the services at issue were the same but claimed that the shared use of the word ‘Sky’ across the marks was insufficient to establish a likelihood of confusion between them.
5. The opponent is represented by Sanderana Limited, and the applicant is unrepresented. Neither party filed evidence. No hearing was requested and only

the opponent filed written submissions in lieu. This decision is taken following a careful consideration of the papers.

6. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

PRELIMINARY ISSUE

7. It is noted that the opponent's mark is currently subject to an ongoing invalidity application brought under application number 503328. Those proceedings have an impact here because if they succeed then the opponent's mark will be declared invalid and treated as if it was never applied for. If this happens then so long as the invalidation extends to the class 39 services covered by the opponent's mark (which are relied upon here), it would no longer be deemed an earlier mark for the purpose of the present proceedings. As a result, the opponent would not be permitted to rely on it for the basis of this opposition. Therefore, in the event that this opposition succeeds, the outcome will be provisional pending the outcome of invalidity application 503328.
8. Alternatively, if the application against the opponent's mark fails (to the extent that it remains registered for the services relied upon here) then those proceedings will have no impact upon any outcome I reach here.
9. If necessary, I will return to discuss this issue further at the outcome of my decision.

DECISION

Section 5(2)(b): legislation and case law

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

“(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 or association with the earlier trade mark.”

11. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

12. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark or international trade mark (UK) 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.

13. The opponent’s mark qualifies as an earlier trade mark under the above provisions. The opponent’s mark had completed its registration process more than five years prior to the filing date of the applicant’s mark and was, therefore, open to a request for proof of use pursuant to section 6A of the Act. However, the applicant did not

elect to put the opponent to proof of use. Therefore, the opponent may rely on the services highlighted in its notice of opposition.

14. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) ("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 the services

15. The applicant's services are set out in the Annex of this decision. The opponent's services are set out at paragraph two above.

16. As mentioned above, the opponent's case was brought on the basis that the services at issue are identical. Also noted above was the fact that, in its counterstatement, the applicant confirmed that it agreed with the opponent in that the services under class 39 are the same. This is, plainly, a concession that the services at issue are identical and it is on this basis that I will proceed.

The average consumer and the nature of the purchasing act

17. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' services. I must then decide the manner in which these services are likely to be selected by the average consumer in the course of trade. 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.”

18. The services at issue cover a wide range of different types of travel booking or travel agency services. Such services will be sought by members of the general public at large. The services are likely to be available via travel agents (be that in physical stores or online) or the actual travel provider itself (for example, it is common for airlines to also offer holiday packages and excursions). The majority of consumers will select the services either from brochures or after seeing the services listed on webpages. As such, the selection process will be primarily visual. Having said that, I appreciate that some consumers may select some services via telephone and, further, will be in regular contact via telephone with their travel agents in order to add various excursions or additional bookings to their holiday plans. As a result, I do not discount the aural component playing a role and acknowledge that in some circumstances, it may be of equal importance to the visual component.

19. The frequency of selection and cost of the services will vary. For example, some services such as the selection of a large package holiday will be a less frequent

and more expensive selection, whereas services such as the booking of seats for travel on coaches (being a term in the applicant's specification) may be less expensive and selected more frequently.

20. In terms of the level of attention paid, this will also vary. I say this because the aforementioned booking seats for travel on coaches will attract a somewhat lower degree of attention because it is likely to be a cheap selection and, for a short coach journey (such as an airport shuttle, for example) the consumer is not going to consider it in any detail beyond simply ensuring that they have a place on the coach. On the other end of the scale, I appreciate that some package holidays will be selected upon the consideration of various factors such as the departure airport, destination (including the hotel), baggage allowance, time period (for example, the services may be more expensive during school holidays), class of travel and additional services offered (such as entertainment offered at a resort or lounge access prior to boarding). While I appreciate that these factors are numerous, and the holiday may be expensive, the actual selection of the service itself is not likely to attract a high degree of attention. This is because the factors listed above are relatively ordinary and regardless of the price paid, the consumers are likely to pay a medium degree of attention.

Comparison of the marks

21. It is clear from *Sabel 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.


22. 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.”

23. 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.

24. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
	Sky America

25. The opponent's position in respect of the marks at issue is that the 'SKY' element of the opponent's mark is captured entirely within the applicant's mark, which makes them visually similar. As for the aural comparison, the opponent argues that because both marks start with 'SKY', they are aurally similar. In respect of the conceptual comparison, the meaning of SKY in both marks would be obvious to the average consumer. Further, the opponent argues that 'AMERICA' lacks distinctiveness since it simply describes the feature of the services at issue (i.e. travel to America). Lastly, I note that the opponent has made reference to the case of *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02 wherein the General Court noted that beginnings of words tend to have more visual and aural impact than the ends.

26. The above submissions are noted and I will bear them in mind when making my comparisons below. At this point, however, I wish to point out that while the reference to *El Corte* is noted (and I acknowledge that this is, indeed, a general rule), there is also case law which suggests that, on the contrary, similar beginnings are not necessarily important or decisive.¹ As such, the fact that both marks share the same beginnings to their verbal elements does not automatically lead to a finding of confusion and this issue is one that varies on a case by case basis.

Overall impression

27. The applicant's mark is a word only mark that consists of the words 'SKY AMERICA'. As above, the opponent's argument is that 'AMERICA' lacks distinctiveness because it alludes to the destination of the services. I appreciate that such an argument would ordinarily mean that the word plays a lesser role in the overall impression of the mark. However, in the present assessment, I am of the view that this same argument can equally apply to the word 'SKY'. I say this because I consider it to be of an equal level of distinctiveness on the basis that it can be said to allude to airline services or air travel, generally. As a result, I am of the view that the overall impression of the applicant's mark lies across both words equally.

28. Turning to the opponent's mark, this is a figurative mark that consists of the word 'SkyClub' which sits within an aeroplane shaped border. It is noted that the border connects to the letters 'y' and 'b' in 'SkyClub'. The typeface used is standard and both elements are presented in white on a black background. While presented as one word, 'SkyClub' will clearly be perceived as two, being 'Sky' and 'Club'. While 'Sky' will be seen as allusive to airline services, 'Club' is equally allusive. I will expand upon this when considering the conceptual comparison of the marks below. As a result, I consider that neither word dominates the other. As for the device, this will play a lesser role than the words because consumers are naturally drawn to elements of marks that can be read. Further, as I will come to discuss later, it only serves to reinforce the concept of air travel. Therefore, I find that the overall

¹ See *CureVac GmbH v OHIM*, T-80/08.

impression of the opponent's mark lies in the word 'SkyClub' with the device element playing a lesser role.

Visual comparison

29. Both marks share the word 'Sky', that sit at their beginnings. Given that the applicant's mark is a word only mark in black and white, it is capable of being presented in any standard typeface and in any colour. I consider that this extends to the same typeface and colour used by the opponent meaning that the typeface used and use of white text on a black background are not to be considered points of visual distinction between the marks. That being said, the way in which the 'y' and 'b' are connected by an aeroplane border device in the opponent's mark is not covered by the fair and notional use of word marks. As such, this device is a point of visual difference between the marks, despite it playing a lesser role in the opponent's mark. The marks differ in the presence of the word 'Club' in the opponent's mark and 'America' in the applicant's. Taking all of this into account and bearing in mind the overall impression of the marks, I find that they are visually similar to a medium degree.

Aural comparison

30. I consider that the marks at issue will both be pronounced in full. This means that the opponent's mark is two syllables in length whereas the applicant's mark is five syllables. Both marks will be pronounced in the ordinary way. The first syllable in both marks is identical whereas the remaining syllables (being 'Club' in the opponent's mark and 'America' in the applicant's) all differ. From an aural perspective, I note that the opponent's mark is a short mark and while there is no special test which applies to the comparison of 'short' marks,² I am of the view that in the present case, the shortness of the opponent's mark is such that the average consumer is more likely to notice the differences. This is particularly the case given that the applicant's mark is aurally over twice the length of the opponent's mark. While this assists in counteracting the point of identity at the beginning of the marks

² See paragraph 44 of *BOSCO*, BL O/301/20

to some degree, it does not negate it entirely. Taking all of this into account, I find that the marks are aurally similar to a medium degree.

Conceptual comparison

31. While the words in the applicant's mark, being 'Sky' and 'America' have individual meanings that will be well-known to the UK consumer, I am of the view that, in combination and in the context of the services at issue,³ they will be understood as a reference to air travel to or from America. As for the opponent's mark, the word 'SkyClub' will be immediately perceived as a conjoining of two ordinary words that have obvious meanings to consumers in the UK. However, in combination and in the context of the services at issue, I consider that they will be understood as a reference to a *club* offered by an airline.⁴ I say this because, as far as I am aware, member or executive clubs are common amongst many airline carriers that offer rewards programmes and, in my view, this is a concept that will be immediately understood by average consumers. In addition, I consider that the device element of an aeroplane will only serve to reinforce this concept.

32. In comparing the marks from a conceptual stand point, the concept associated with 'Sky' will be the same across both marks, i.e. a reference to air travel. However, the equally dominant words 'Club' and 'America' together with the concepts created by the parties' marks as wholes will be points of conceptual difference. Taking all of this in to account, I am of the view that the marks are conceptually similar to a medium degree due to the common reference to the word 'Sky'.

Distinctive character of the opponent's mark

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

³ I appreciate that, as per the case of *EMILIANA* (Case BL O/052/22), conceptual comparisons are usually done without reference to the goods or services at issue. However, in the present case, I am of the view that the obvious connection to the services at issue cannot be ignored.

⁴ For the avoidance of doubt, it is on this basis that the word 'Club' in the context of the mark will be considered allusive, being a finding I made during my overall impression assessment of the marks above.

“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-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

34. 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 or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The opponent has not filed any evidence of use and, therefore, I have only the inherent position to consider.

35. I have set out above that the average consumer in the UK will understand the word ‘SkyClub’ (being one that is perceived as a conjoining of two words) to be a reference to a member or executive club offered by an airline. The word ‘Sky, as a whole, is therefore allusive to the services upon which the opponent has relied upon here, being those that expressly relate to air travel. As for the device element, plainly, it will be seen as something that simply reinforces the meaning of ‘SkyClub’. While I consider that it will play a role, it will not contribute to the overall

distinctiveness of the mark to the point that it increases the level beyond that which is created by 'SkyClub'. Therefore, I consider that the distinctive character of the mark will be dominated by the word 'SkyClub'.

36. While I do not consider that the distinctive character of the opponent's mark extends to an outright low degree, I am of the view that the allusive nature of the word 'SkyClub' is such that it leads me to conclude that its inherent distinctive character lies somewhere between a low and medium degree.

Likelihood of confusion

37. 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 goods and 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 opponent's 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 they have retained in their minds.

38. I have found the services at issue to be identical based on the concession of the applicant in its counterstatement. I have found that the average consumer base is formed of members of the general public who will select the services via primarily visual means (although I do not discount an aural component playing a role, and even in some instances, it may be of equal importance). I have concluded that the level of attention paid will be medium, however, I appreciate that some services will attract a lower degree of attention. I have found the marks at issue to be

visually, aurally and conceptually similar to a medium degree. Lastly, I have found the opponent's mark to be inherently distinctive to between a low and medium degree. On this point, I wish to set out that a weaker degree of distinctive character in an earlier mark does not preclude a finding of confusion.⁵

39. In discussing the issue of direct confusion, I note that the opponent's submissions set out that one example where this would occur is via word-of-mouth recommendations. The opponent claims that a consumer may mention to a peer that they used 'SkyClub' services to book travel to America and that this could lead the peer to select the services of 'Sky America', especially when considering the principle of imperfect recollection.

40. While the submissions of the opponent are noted, I am not convinced that this scenario is one that is likely to occur, even when bearing in mind the principle of imperfect recollection. I say this because it requires the consumer to forget the 'Club' element of the opponent's mark entirely. This would require an artificial dissection of the mark and would also require consumers to forget an equally distinctive element of the mark. While some services may attract a lower degree of attention when selected, they are not casual purchases/selections such as low-cost goods selected at a checkout or free downloadable goods. Therefore, I do not consider that consumers would overlook the presence of the word 'Club' for 'America', or vice versa, regardless of whether they are confronted by the marks visually or aurally.

41. While the above-mentioned scenario was just one example, the opponent did not offer any other scenario wherein direct confusion would occur. In my view, taking all of the factors listed above into account and, again, even bearing in mind the principle of imperfect recollection, I do not consider that the parties' marks will be misremembered or inaccurately recalled for one another. While I appreciate that the marks share the word 'Sky' and that this sits at the beginning of the marks, the additional words will not be overlooked, especially given the conceptual hook created by the addition of the words 'Club' and 'America'. On this point, I repeat

⁵ See *L'Oréal SA v OHIM*, Case C-235/05 P

what I have said above in that, as per *CureVac*, similar or identical beginnings are not necessarily important or decisive to the question of confusion. Consequently, I do not consider that there exists a likelihood of direct confusion between the marks at issue. For the avoidance of doubt, this applies even where the services at issue are identical and in instances where the consumer pays a lower degree of attention.

42. I turn now to consider whether there exists a likelihood of indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

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

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

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

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

43. While the above examples in *L.A. Sugar* are noted, they are not intended to be treated as an exhaustive list of the only instances wherein indirect confusion occurs.

44. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 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.

45. In its submissions, the opponent's arguments as to indirect confusion are that the services of the applicant emanate from the opponent. In bringing this argument, the opponent claimed that 'Sky America' could be perceived as a sub-brand or promotional brand of 'SkyClub' relating to travel services in America. It stated that this is likely to occur for two reasons. Firstly, in light of category (b) of *L.A. Sugar*, the applicant's mark simply adds a non-distinctive element to the earlier mark. Secondly, in line with category (c) of *L.A. Sugar*, the opponent's mark comprises a number of elements and that change of one appears entirely logical and consistent with a brand extension. Therefore, the opponent argues that the change from 'SkyClub' to 'Sky America' will be seen as falling within this category. I will deal with these points in turn below.

46. Firstly, I consider that the reliance on category (b) of *L.A. Sugar* is misguided. I say this because while such an argument would apply in circumstances where the marks to be compared were 'SkyClub' and 'SkyClub America', this is not the case here. Instead, the comparison I must make is between 'SkyClub' and 'Sky America'. In my view, it does not follow that 'Sky America' simply *adds a non-distinctive element* to the earlier mark. Therefore, I find that this aspect of the opponent's claim is of no assistance.

47. Turning to the second argument in reliance upon category (c) of *L.A. Sugar*, I consider that this one carries more weight. While that may be the case, I still do not consider that it gets the opponent over the line. I have found throughout this decision that the distinctive character of the opponent's mark lies in the word 'SkyClub' as a whole. Therefore, I do not consider that a consumer would consider it logical or consistent with a sub-brand that an undertaking would remove an equally distinctive element of its mark (being 'Club') and replace it with the name of a country. In making this finding, I bear in mind that for the services at issue, 'Sky' is not particularly distinctive to the point that it would be viewed as an indicator of origin for the opponent's mark. The same applies for the applicant's mark. Instead, I am of the view that while the shared use of 'Sky' may be noticed, in the context of the services at issue, this would plainly be seen as a coincidence in that the marks, as wholes, denote two separate undertakings that operate businesses that relate to air travel. Lastly, I wish to point out that while consumers may call to mind the opponent's mark when confronted with the applicant's mark, this is mere association and not indirect confusion.⁶

48. While the opponent has offered no argument as to whether category (a) of *L.A. Sugar* applies, I consider it necessary to give it a brief mention here. In short, this category of indirect confusion requires a finding that the shared element of the marks is so strikingly distinctive that only one consumer would use it. As I have already set out above, the shared use of 'Sky' would be viewed as coincidental. Clearly, it is not strikingly distinctive and, therefore, category (a) of *L.A. Sugar* does not apply.

⁶ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

49. As I have set out above, the categories described in *L.A. Sugar* are not exhaustive and, therefore, indirect confusion can apply in other scenarios. While that may be the case, the opponent has not offered any explanation as to what these scenarios may be. On this point, I will set out that where an opponent wishes to rely on additional scenarios beyond those categories set out above, it is for the opponent to raise them itself. I do not consider it appropriate in the circumstances (or fair to the applicant) for me to seek to formulate the opponent's case on its behalf when it has remained silent on the issue. However, given this point further consideration, I am not convinced that any other scenarios apply.

50. Consequently, and taking everything I have said above into account and also bearing in mind the comments of Mr Mellor Q.C. and Arnold LJ mentioned at paragraph 44 above, I find that there exists no likelihood of indirect confusion. For the avoidance of doubt, I consider that this applies even bearing in mind that the services at issue are identical and even where consumers pay a lower degree of attention when selecting the services. In respect of the latter point, I repeat what I have said above in that while some services may attract a lower degree of attention, they are not casual selections.

FINAL REMARKS

51. I set out above that any success enjoyed by the present opposition would be provisional on the basis that the opponent's mark is subject to its own invalidity application. However, given that I have found that the opposition has failed, this decision is to be considered final.

CONCLUSION

52. The opposition fails in its entirety and the applicant's mark may proceed to registration for all of the services applied for.

COSTS

53. The applicant has succeeded in defending its mark in its entirety. The applicant would, therefore, in the ordinary course of these proceedings, be entitled to a contribution towards its costs. However, the applicant is unrepresented meaning that, in order to claim its costs, it was required to file a completed costs pro-forma. It did not do so. On this point, I note that a blank costs pro-forma was provided to the applicant under the cover of a letter from the Tribunal dated 28 March 2024. This letter set out that:

“If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded.”

54. As no costs pro-forma was filed and the applicant incurred no official fees arising from this action, I make no order as to costs. Therefore, both parties are to bear their own costs of these proceedings.

Dated this 10th day of December 2024

A COOPER

For the Registrar

ANNEX

Class 39

Travel agency services for arranging travel; Travel agents services for arranging travel; Travel agency services for arranging holiday travel; Travel agency services for business travel; Arranging for travel visas and travel documents for persons travelling abroad; Travel arrangements; Travel reservations; Arranging of travel; Travel services; Travel reservation; Reservation (Travel -); Arranging for travel visas, passports and travel documents for persons traveling abroad; Travel and passenger transportation; Organising of travel; Travel information; Organizing of travel; Arranging of transport and travel; Travel booking agencies; Travel arrangement; Arrangement of travel; Booking of holiday travel and tours; Arranging holiday travel; Services for the booking of travel; Arranging of transportation for travel tours; Travel agency services relating to travel by omnibus; Organisation of travel; Travel organisation; Air travel services; Arranging travel tours; Arranging of travel tours; Tours (Arranging of travel -); Travel guide services; Organization of travel; Travel organization; Arranging of air travel; Arranging of coach travel; Arranging of business travel; Agents for arranging travel; Arranging and booking of travel; Organising of foreign travel; Booking of tickets for travel; Organization of travel and boat trips; Itinerary travel advice services; Organisation of travel tours; Arrangement of travel to and from hotels; Booking of tickets for air travel; Reservation services for airline travel; Organization of travel tours; Tourist travel reservation services; Travel and transport reservation services; Travel reservation services; Reservation services for travel; Booking of travel through tourist offices; Booking agency services for airline travel; Booking agency services for travel; Consultancy for travel planning of routes; Booking of seats for travel; Holiday travel reservation services; Reservation services for air travel; Ticketing services for travel; Travel courier services; Organisation of holiday travel; Booking of seats for air travel; Ticket booking services for travel; Cruise ship services [for travel]; Booking of seats for rail travel; Travel agency services, namely arranging transportation for travelers; Planning, arranging and booking of travel; Tour operator services for the booking of travel; Agency services for arranging travel; Arranging and booking of travel for package holidays; Making travel bookings (Services for -); Planning and booking of airline travel, via electronic means; Services for the booking of seats for travel; Travel arrangement services; Booking of seats for coach travel; Issuing of tickets for travel;

Providing cruise ships for travel; Travel information services; Travel reservation and booking services; Travel ticket reservation services; Ticket reservation services (Travel -); Ticket reservation services for travel; Providing tourist travel information; Planning and booking of travel and transport, via electronic means; Booking agency services relating to travel; Seat reservation services for travel; Provision of tourist travel information; Arranging of travel by bus; Reservation services for travel by air; Providing transport and travel information; Making travel reservations (Services for -); Package holiday services for arranging travel; Arranging of travel by coach; Reservation of seats for travel; Arranging of overseas travel for cultural purposes; Travel and tour ticket reservation service; Travel arrangement and reservation services.