

O-139-19

TRADE MARKS ACT 1994

IN THE MATTER OF:

**APPLICATION No. 3255476
BY AMERICAN AIRLINES, INC
TO REGISTER**



IN CLASSES 25, 28, 35, 36, 38, 39, 41 & 43

AND

**OPPOSITION THERETO (UNDER No 411115)
BY AIGLE INTERNATIONAL S.A.**

Background and pleadings

1. The relevant details of the application the subject of these proceedings are as follows:

Mark:



Filing date:

8 September 2017

Publication date:

22 September 2017

Applicant:

American Airlines, Inc

Specification:

Class 25 - Clothing; footwear; headgear; shirts; jackets; T-shirts; sweatshirts; pants; shorts; skirts; sweat pants; pajamas; caps; socks; hats; coats.¹

2. Registration of the mark is opposed by Aigle International S.A. (“the opponent”). Its grounds of opposition are based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In relation to the first two grounds, the opponent relies on the same two earlier marks, as follows:

- EU trade mark registration (EUTM) 15713761 which was filed on 1 August 2016 and registered on 17 November 2016. It is registered in respect of goods in classes 9, 18 & 25. The mark itself is as follows:



¹ Although the application covers goods and services in other classes, the opponent does not object to the registration of the mark in relation to them.

- International Registration (“IR”) 850780 for the same mark as above which designated the UK for protection on 22 April 2005, with protection being conferred on 27 November 2005. The mark is protected for goods in classes 9, 14, 18 & 25.

3. Under section 5(2)(b), the opponent claims that there is identity between the goods and that the marks are very similar (“[b]oth marks depict and have as their dominant and distinctive component, the silhouette of an eagle in flight, flying from left to right with a wedge shaped wing and the head of an eagle protruding forward of the wing”) such that there exists a likelihood of confusion. Under section 5(3), it is claimed that the earlier marks have a reputation, that a link will be made between the earlier marks and the applied-for mark, which will lead to unfair advantage and which would also be detrimental to the distinctive character of the earlier marks. The opponent also claims that the earlier mark has been used in the UK such that the use of the applied-for mark is liable to be prevented under the law of passing-off.

4. Both of the opponent’s marks were filed before the applicant’s mark, so meaning that they qualify as earlier marks in accordance with section 6 of the Act. The opponent’s IR had been protected in the UK for more than five years when the applicant’s mark was published for opposition purposes, so meaning that the use conditions set out in section 6A of the Act apply. To this extent, the opponent made a statement of use corresponding to the goods for which the mark is registered. The opponent’s EUTM had not been registered for more than five years, so meaning that the use conditions do not apply; this earlier mark may, therefore, be relied upon without establishing that genuine use has been made of it.

5. The applicant filed a counterstatement denying the grounds of opposition and putting the opponent to proof of use in relation to the opponent’s IR.

6. Both sides filed evidence. A hearing took place before me on 18 January 2019 at which the opponent was represented by Mr Michael Hicks, of Counsel, instructed by Wedlake Bell LLP. The applicant was represented by Mr Douglas Campbell QC, also of Counsel, instructed by Taylor Wessing.

The evidence

7. Rather than provide a standalone evidence summary, I will, instead, refer to the pertinent parts of the evidence when it is necessary to do so. However, for the record, those who have given evidence (and about what) are as follows.

For the opponent - a witness statement from Mr Romain Guinier, the opponent's CEO. His evidence is about the origins of the opponent and includes information about the opponent's business (including in the UK) under the subject mark (and others). He also explains why he is concerned about the applicant's mark being registered.

For the applicant – a witness statement from Ms Alice Curry, the applicant's Managing Director of Customer Loyalty and Insights, setting out some brief background about the applicant's business (an airline) and evidence about how it uses its mark, which Ms Curry describes as “the flight symbol”.

8. I begin this decision with the grounds of opposition under section 5(2)(b) of the Act.

Section 5(2)(b)

9. Section 5(2)(b) of the Act states that:

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

(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.”

10. The following principles are gleaned from the judgments 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 greater 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

11. I will focus on the opponent's EUTM in the first instance, as this mark is not subject to the use conditions and it covers the goods for which the opponent claims identity.

Comparison of goods

12. The opponent's mark covers clothing, footwear and headgear. It was accepted by Mr Campbell that the applied-for goods are identical to those of the earlier mark (see paragraph 45 of his skeleton argument). This is clearly a sensible concession. The goods are identical.

Average consumer and the purchasing act

13. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. 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 of the contest goods is a member of the general public. Such goods are not, generally speaking, greatly expensive. Some care will be taken in respect of style, colour, fitness for purpose etc. I consider that this equates to a reasonable, no higher or lower than the norm, level of care and consideration. The goods will be perused in traditional bricks and mortar retail establishments and their online equivalents. The goods and the marks used in relation to them may be seen in advertisements and on websites. I consider that the visual impression of marks used in this sector will take on most significance.

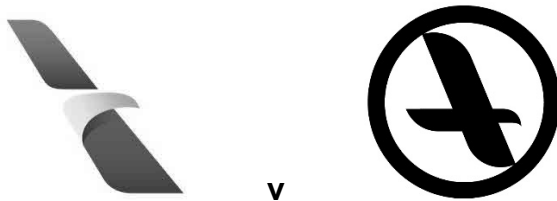
Comparison of marks

15. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the 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.”

16. 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. The marks to be compared are:



17. In terms of overall impression, both marks comprise figurative elements only. The overall impression resides in those elements. There was a discussion at the hearing as to the significance in the overall impression of the circular element in the earlier mark. Mr Hicks submitted that the core component of the mark comprised what he said would be seen as an eagle or a bird of prey, which was simply presented within the circle or border. Mr Campbell on the other hand submitted that the circle played an important role, as it was presented in heavy black print and touched the upper and lower parts of the element within it. In my view, the circle is far from negligible and does play a role in the overall impression, contributing to the look and feel of the mark. However, I do not place its role in the overall impression as highly as Mr Campbell did, as it may nevertheless be seen as a border, albeit one which does contribute, as stated, to the overall look and feel.

Aural similarity

18. Aurally, neither mark contains a verbal element, so there is no aural comparison to make.

Conceptual similarity

19. Conceptually, Mr Hicks argued that the opponent's mark would clearly be seen by the average consumer as an eagle or a bird of prey and that the applicant's mark would also be perceived in this way. In relation to the latter, he pointed to the applicant's own evidence which he said showed that the applicant, an American airline, had used an eagle in previous logo marks it used and, furthermore, Ms Curry, the applicant's witness, describes it as "the flight symbol". The point of the submission was that if the applicant's logo was designed with an intention that it be seen as an eagle, there should be a real reluctance to find that they had not achieved what they had set out to do.

20. Mr Campbell submitted that there was no evidence that the applicant's mark was intended to be an eagle and, in any event, all that mattered is what the mark looked like to the average consumer; he argued that without anything further to point the average consumer towards it, it would not be seen as an eagle (or bird of prey). In relation to the opponent's mark, he submitted that it could be viewed in a number of ways, as a dagger, as a dolphin, or perhaps nothing at all. He accepted that it could also, possibly, be seen as an eagle or bird of prey.

21. In relation to the applicant's mark, I come to the view that whilst it is not an unreasonable inference to believe that the applicant may have intended the mark to form part of some form of eagle-based branding, I agree with Mr Campbell that I should place little significance on this. I must consider the mark for which registration is sought, measured from the perspective of the average consumer, in relation to the class 25 goods the subject of this dispute. I further agree that the mark as a whole lacks any clear concept that the average consumer would attribute to the mark. The details are too imprecise. To get to the viewpoint that the mark comprises an eagle, or indeed any bird of prey, requires a depth of analysis unlikely to be adopted by the average consumer of the contested goods. More is needed to point the average consumer in that direction. Even if I am wrong on that then, at the very most, only a very small number of average consumers would see the mark as an eagle (or bird of prey), and if they did, they would only see part of the bird, its beak. What is described as the wedge would not in my view be seen as the bird's wings.

22. In relation to the opponent's mark, I accept that there is greater potential for it (or more accurately the element within the circle) to be seen as some form of bird of prey. However, that perception will not be universal. Some average consumers will see nothing, others perhaps a dagger or a sword. I think it unlikely that it will be perceived as a dolphin.

23. In *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch), Mann J. approved the approach I adopted at first instance in considering the reactions of average consumers who did, and did not, recognise the word SOUL within the mark SOULUXE. The judge said:

"27. I do not consider that the Hearing Officer made an error of principle in this respect. In considering the question of the effect of the mark within the class, by reference to proportions who did not share the same view, he was following the same line as that pursued by Arnold J at first instance in *Interflora Inc v Marks and Spencer plc* [2013] EWHC 1291 (Ch) . Arnold J considered at some length whether there was a "single meaning rule" in trade mark law under which the court had to identify one, and one only, perception amongst the relevant class of average consumer, and judge confusion accordingly. At paragraph 213 he found there is no such rule and then set out his reasoning over the following paragraphs. Paragraph 224 set out important parts of his conclusion; the references to Lewison LJ is to that judge's judgment in an earlier case.

"224 ... Thirdly, Lewison LJ expressly accepts that a trade mark is distinctive if a significant proportion of the relevant public identify goods as originating from a particular undertaking because of the mark. Thus he accepts that there is no single meaning rule in the context of validity. As I have said, that is logically inconsistent with a single meaning rule when one comes to infringement. Fourthly, the reason why it is not necessarily sufficient for a finding of infringement that "some" consumers may be confused is that, as noted above, confusion on the part of the ill-informed or unobservant must be discounted. That is a rule about the standard to be applied, not a rule requiring the determination of a single meaning. If a significant proportion of the relevant class of consumers is

confused, then it is likely that confusion extends beyond those who are ill-informed or unobservant. Fifthly, Lewison LJ does not refer to many of the authorities discussed above, no doubt because they were not cited. Nor does he discuss the nature of the test for the assessment of likelihood of confusion laid down by the Court of Justice. The legislative criterion is that "there exists a likelihood of confusion on the part of the public". As noted above, the Court of Justice has held that "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". This is not a binary question: is the average consumer confused or is the average consumer not confused? Rather, it requires an assessment of whether it is likely that there is, or will be, confusion, applying the standard of perspicacity of the average consumer. It is clear from the case law that this does not mean likely in the sense of more probable than not. Rather, it means sufficiently likely to warrant the court's intervention. The fact that many consumers of whom the average consumer is representative would not be confused does not mean that the question whether there is a likelihood of confusion is to be answered in the negative if a significant number would be confused ." (my emphasis)

28. That justifies a consideration of confusion in relation to a proportion of the class of average consumer by reference to perceptions, in the manner in which the Hearing Officer went about the matter. It also justifies applying the same technique (where appropriate on the facts) to validity and infringement proceedings alike."

24. The net effect in terms of the conceptual analysis is that there is no material conceptual similarity. This is because only a proportion of average consumers would see the opponent's mark as an eagle/bird of prey, and, at best, only a very small number of average consumers would see the applied-for mark in that way. The likelihood of an average consumer seeing both marks as an eagle/bird of prey is, therefore, negligible.

25. Furthermore, the absence of a clear concept in respect of the applicant's mark means that the resulting conceptual comparison is that some average consumers would see a conceptual difference (if the earlier mark is seen as a dagger or an eagle/bird of prey) whereas for some there would be neither difference nor similarity as both will be seen as meaningless figurative devices.

Visual similarity

26. In its statement of grounds, the opponent's submissions are based upon the similar wedge shape element, through which the head of the eagle protrudes, creating an eagle flying from left to right. Whilst I have found that the applicant's mark is unlikely to be seen as an eagle, I must still consider the inherent visual similarities that do exist. From that perspective, it is true to say that both marks contain a longitudinal element of similar width, both with a slightly diagonal offset (the wedge shape). Both wedges are intersected by a forward facing hooked element.

27. The applicant's position is that there is very little similarity. It highlights the heavy print of the opponent's mark and the circle around the central component. It highlights the 3D feel of the applicant's mark created by the contrasting greyscales being used. It also highlights the cross-piece of the central components of the earlier mark.

28. I come to the view that any similarity on a visual level is low. Notwithstanding the similarity in the wedge and the hooked element, the overall look and feel of the competing marks introduces a number of visual differences. The opponent's mark has a full cross-like section. It is very two-dimensional, with a strong, stark visual impact. The applicant's mark is presented in a quite different way with the shading creating a different look and feel, and being absent the cross-like section.

Distinctive character of the earlier trade mark

29. Having compared the marks, it is necessary to determine the distinctive character of the earlier mark, in order to make an assessment of the likelihood of confusion. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the CJEU stated that:

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).

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).²

30. Mr Hicks suggested that the earlier mark was high in inherent distinctiveness as the mark was not common. I agree that it is not common (or at least there is no evidence showing that it is) and also that the earlier mark makes no particular allusive or suggestive nod towards the relevant goods. However, I consider this to equate simply to a reasonable level of inherent distinctive character.

31. In terms of whether the level of inherent distinctiveness has been enhanced through use, I now turn to the evidence of Mr Guinier. He provides a significant body of evidence. I note the following:

² C-342/97, paras. 22-23

- The origins of the brand date to 1853 when an American citizen living in France started to produce footwear under the name L'AIGLE, inspired by the American eagle.
- The AIGLE brand was first introduced to the UK market around 20 years ago, the witness statement is from May 2018.
- Turnover in the UK has ranged from £4.2 million in 2011 to £5.7 million in 2017.
- In relation to unit sales, most relate to the sales of boots (ranging from 63k units in 2014 to 89k in 2017). But sales are also made of other types of footwear (3.1k to 3.9k in the same period), accessories³ (ranging from 2.9k to 6.7k), and textiles (24k to 14k). The exhibits also show other clothing products, but it is difficult to see within which of the unit sale categories they fall.

32. Supporting evidence is provided in the form of catalogues, pricelists, website prints, invoices and what is described as a “workbook”, all of which support that the mark has been used. However, little is provided to assess how well known the mark has become. For example, there is no information as to the number of retailers through which the goods are sold, or its market share etc.

33. In relation to marketing expenditure, it is stated that 60k Euro is expended in the UK and that this includes press advertising and social media. However, there is nothing to show the significance or impact that any such campaigns will have had. There is, though, evidence of the brand being identified as the third best welly [boot] on a website called INDYBEST. There are also a handful of prints from some retailer websites showing the opponent’s goods, and prints from the opponent’s social media pages.

34. It should be noted, a point that the applicant highlights, that the vast majority of the prints show the mark being used in conjunction with the word AIGLE. Mr Campbell

³ Various exhibits in the evidence show that the term “accessories” relates to items such as hats and scarves.

argued that notwithstanding that a mark may acquire distinctiveness through use in combination with another element or mark⁴, an overall assessment must still be made to ascertain whether the use of the mark relied upon has, as matter of fact, enhanced its distinctiveness. I agree with this approach. However, in terms of the use made, and in particular its manner of use, and despite it almost always being accompanied by the word AIGLE, I consider there is potential for enhancement of distinctive character. The two components (the word AIGLE and the circular logo) as used would strike those encountering it as independent elements – the brand name, and the brand’s logo. That said, I am more concerned with the lack of evidence establishing the impact that the use would have made. The unit sales themselves do not strike me as overly significant. At best, I consider that there may be a small uplift in distinctive character in so far as boots are concerned, but nothing more than that.

Likelihood of confusion

35. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted 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

⁴ As per the *HAVE A BREAK* case [2004]FSR 2

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".

36. Even considering the matter in relation to boots, which are identical and for which there may have been a slight uplift in the distinctive character of the opponent's mark, I do not consider that the factors combine so that the average consumer will be directly confused between the marks. Put simply, this is down to the differences between the marks I have identified and my view that the marks are just not close enough for the average consumer to mistake one for the other, even when imperfect recollection is taken into account. This is so even taking into account the notional use of marks as logos on items of clothing that Mr Hicks referred to. The finding is stronger in relation to those that see a conceptual difference between the opponent's mark and the applied-for mark. However, even where the conceptual assessment was neutral, there would still be no confusion. This finding also applies to indirect confusion - I see no reason why the average consumer would believe that the goods sold under the respective marks come from the same or economically linked undertakings.

37. Even if I am wrong to have held that the proportion of the relevant public who would see both marks as eagles was negligible, I still do not think those consumers would be confused. The differences are still sufficient to ensure that one will not be mistaken for the other. In terms of indirect confusion, even if both were seen as eagles or birds of prey, the different manners of presentation are sufficient to avoid a same-stable assumption.

38. At the hearing, Mr Hicks also mentioned post-sale confusion and initial interest confusion, although he did not press this strongly. However, and even without going into the merits or otherwise of such forms of confusion, I do not consider that any form

of confusion will arise. Simply put, the marks will be perceived as different marks the responsibility of different undertakings.

39. The opposition under section 5(2)(b) fails in relation to the opponent's EUTM. The opponent's IR puts it in no better position as it is for the same mark and there are no other factors which change (improve) the opponent's case.

Section 5(4)(a)

40. Section 5(4)(a) of the Act reads:

“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, or

(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.”

41. It is settled law that for a successful finding under the law of passing-off, three factors must be present: i) goodwill, ii) misrepresentation and iii) damage.

42. It is unnecessary to go into this ground in any real detail. Even assuming that the opponent's mark is associated with a protectable goodwill (which, for the record, I would have found), I do not see how in this case the opponent is in any position to argue that there would be a relevant misrepresentation if there is no confusion. Although the legal tests differ, the outcome would be the same. Indeed, Mr Hicks helpfully accepted that the ground added nothing. The opposition therefore also fails under section 5(4)(a).

Section 5(3)

43. Section 5(3) 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 the repute of the earlier trade mark.”

44. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*.

45. 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).

Reputation

46. 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.”

47. In relation to the EUTM, the required reputation must be in the EU. I have already touched on the evidence at least in relation to the position in the UK. The evidence also shows use in other Member States, notably France and Germany. However, the evidence suffers again from an inability to be able to assess the true significance and impact on the market. Nevertheless, I am prepared to accept that the threshold for a reputation has probably been passed at least in relation to boots. The reputation should not, though, be regarded as a strong one. The same finding applies to the opponent's IR.

The link

48. In assessing whether a link will be made, a number of factors need to be considered, including: the degree of similarity between the respective marks and between the goods/services, and the strength of the earlier mark's reputation and distinctiveness.

49. Whilst the goods are identical, something which goes in favour of the opponent, the other factors point more against it. The marks are visually similar to only a low degree, there is no aural similarity and no material conceptual similarity. The strength of reputation is not great. Whilst inherently the mark is reasonably distinctive, its distinctiveness has not been enhanced to a high level. Whilst appreciating the fact that a link may be established without a finding of confusion, and consequently that a lesser degree of similarity between the marks may be accepted to create a link, I do not find that a member of the relevant public will bring the earlier mark to mind were they to encounter the applied-for mark. The differences, when weighed with the other factors, are sufficient to prevent this from happening.

50. The ground under section 5(3) is dismissed.

Conclusion

51. The opposition has failed. As such, and subject to appeal, the applied-for mark may proceed to registration.

52. In reaching all of the above findings, I am conscious that I have said little about the applicant's evidence. This is due, primarily, to there being little pertinence of it in relation to the grounds of opposition.

Costs

53. I have determined these proceedings in favour of the applicant. It is, therefore, entitled to an award of costs. I award the applicant the sum of £1900 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering the statement of case and filing a counterstatement: £300

Considering and filing evidence: £800

Preparing for an attending the hearing: £800

54. I therefore order Aigle International S.A. to pay American Airlines, Inc. the sum of £1900. The above sum should be paid within 28 days of the expiry of the appeal period or, if there is an appeal, within 28 days of the conclusion of the appeal proceedings.

Dated 14 March 2019

Oliver Morris

For the Registrar

the Comptroller-General