

O/0062/26

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. 3870860
IN THE NAME OF BAE SYSTEMS PLC
FOR THE FOLLOWING TRADE MARK:

FalconWorks

IN CLASSES 35, 40 & 42

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. 506362
BY DASSAULT AVIATION

Background and pleadings

1. BAE SYSTEMS plc (“the proprietor”) is the registered proprietor of UK trade mark registration number 3870860, **FalconWorks** (“the proprietor’s mark”). The proprietor’s mark was filed on 24 January 2023 and became registered on 21 April 2023. It stands registered for the following services:

Class 35: Development of concepts for business economy; business consultancy services and business advisory services relating to product development; business advisory services relating to the exploitation of inventions, products and technology; business services relating to the arrangement of joint ventures.

Class 40: Custom manufacture of prototypes.

Class 42: Research, design and development services; research, design and development of new technology, and new products, for others; product research and development; advisory services in the field of product development; technological research, design and consultancy services; scientific and technological research and development services; research, design and development of engineering, electrical hardware and computer software products, used in the military, defence, security, aviation, aerospace and civil engineering sectors; design and development of prototypes; defence research and development; aerospace research and development; engineering services in the field of building technology.

2. On 27 July 2023, Dassault Aviation (“the applicant”) made an application for a declaration of invalidity in respect of the proprietor’s mark pursuant to section 47 of the Trade Marks Act 1994 (“the Act”). The application is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Act. Each ground is directed at all the services of the proprietor’s mark.

3. For the purposes of its claims under sections 5(2)(b) and 5(3), the applicant relies upon the following trade marks:

(i) **Falcon**

UK registration no. 914226

Filing date: 8 September 1967

Priority date: 17 March 1967 (France)

Registration date: 17 March 1967

Relying on all goods, namely:

Class 7: Aeroplane engines, and parts and fittings therefor included in Class 7.

Class 12: Aircraft, and apparatus included in Class 12 for locomotion by air.

("the applicant's first mark")

(ii) **FALCON**

UK registration no. 1275375

Filing date: 1 October 1986

Registration date: 15 December 1995

Relying on all services, namely:

Class 37: Aircraft repair services included in Class 37.

Class 39: Air freight services and air transport services on executive aircraft; hiring and leasing of executive aircraft; all included in Class 39.

("the applicant's second mark")

(iii) **FALCONCARE**

UK registration no. 801038886

Filing date: 26 April 2010

Priority date: 5 November 2009 (France)

Registration date: 8 April 2011

Relying on all services, namely:

Class 37: Maintenance and repair of business aircraft.

("the applicant's third mark")¹

(iv) **FalconEye**

UK registration no. 915395908

Filing date: 2 May 2016

Priority date: 8 December 2015 (France)

Registration date: 2 September 2016

Relying on all goods, namely:

Class 9: Avionic instruments and avionic systems for aircraft, namely information systems and systems for assessing flight conditions, comprising means for automatically processing data for ascertaining control information and assessing situations, commands and electronic display devices, imagers, audiovisual interface elements, data storage devices, assemblies and databases, and operating software in connection therewith; Flight information systems comprising on-board sensors for ascertaining terrain layout and/or detecting obstacles in the vicinity of the aircraft and/or in the vicinity of the flight trajectory of the aforesaid aircraft, means for automatically processing data for ascertaining warning information and risk notifications, commands and electronic display devices, head-up display devices and user-mountable display devices, audiovisual interface elements, data storage devices, assemblies and databases, and software in connection therewith; Image acquisition devices and enhanced day and night flight vision

¹ The applicant's third mark is a comparable trade mark based upon pre-existing International Registration designating the EU number 1038886. On 1 January 2021, in accordance with Article 56 of the Withdrawal Agreement between the UK and EU, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing and priority dates.

systems, for flight configurations of all kinds, also adapted for use in extreme weather conditions and situations of reduced visibility, comprising means for automatically processing data for ascertaining control information and assessing situations, commands and electronic display devices, audiovisual interface elements, imagers, data storage devices, head-up display devices, assemblies and databases, and software in connection therewith; All the aforesaid goods being solely intended for fixed-wing aircraft.

(“the applicant’s fourth mark”)²

4. In its statement of grounds, the applicant argues that, given the presence of the dominant and distinctive element ‘Falcon’, the proprietor’s mark is similar to each of its marks. The applicant also submits that the proprietor’s services are similar to its goods and services. On this basis, the applicant submits that there is a likelihood of confusion, including the likelihood of association, and requests that the proprietor’s mark be declared invalid under section 5(2)(b).

5. Under section 5(3), the applicant claims that each of its marks enjoys a reputation in the UK in respect of all their goods and services. It submits that use of the proprietor’s mark, without due cause, would take unfair advantage of, and/or be detrimental to, the repute and distinctive character of its marks. The applicant also argues that the relevant public would believe there is an economic connection between the users of the competing marks.

6. Turning to section 5(4)(a), the applicant claims that it has significant goodwill in relation to which it has used signs identical to the marks outlined at paragraph 3(i) to (iv) for the same goods and services as shown therein. The applicant contends that use of the proprietor’s mark would be contrary to the law of passing off.

² The applicant’s fourth mark is a comparable UK trade mark automatically created under article 54 of the Withdrawal Agreement on the basis of pre-existing EU trade mark number 15395908. Again, the comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing and priority dates.

7. The proprietor filed a counterstatement, denying the grounds of invalidity. It denies each of the grounds relied upon by the applicant in full and puts the applicant to proof of use, reputation and goodwill in respect of its marks/signs.

8. Both parties filed evidence. A hearing was requested and held before me, by video conference, on 18 September 2024. The applicant was represented by Thomas St Quintin of counsel, instructed by Potter Clarkson LLP. The proprietor was represented by Alaina Newnes of counsel, instructed by CMS Cameron McKenna Nabarro Olswang LLP.

Relevance of EU law

9. 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.

Evidence

10. The applicant's evidence is given in the witness statement of Carlos Brana, dated 24 November 2023, and 19 exhibits (CB1-CB19). He is the Executive Vice President (Civil Aircraft) of the applicant, a position he has held since 1 July 2019. Mr Brana provides evidence of use of the applicant's marks/signs.

11. The proprietor's evidence consists of a witness statement from David Parkes, dated 30 January 2024, and 11 accompanying exhibits (DSP1-DSP11). He is Company Secretary of the proprietor, a position he has held since 26 February 1999. Mr Parkes provides evidence of use of the proprietor's mark, third-party use of the word 'FALCON' in the aviation sector, Google search results and extracts from the register.

12. The applicant filed evidence in reply in the form of a second witness statement from Mr Brana, dated 12 March 2024, and four exhibits (CB2-1-CB2-4). He responds to Mr Parkes' statement, providing further evidence of the parties' use of their respective marks/signs.

13. I have taken all the evidence into account in reaching my decision and will refer to it below where necessary.

Decision

14. Sections 5(2)(b), 5(3) and 5(4)(a) of the Act have application in invalidation proceedings because of the provisions of section 47 of the Act, the relevant parts of which read as follows:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground—

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if–

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered–

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes–

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

[...]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c).

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are—

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

15. As the applicant’s third and fourth marks are comparable marks, paragraph 9 of part 1, Schedule 2A of the Act is relevant. It reads:

“9. (1) Section 47 applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 47(2A)(a) and 47(2B) (the "five-year period") has expired before IP completion day—

(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 47 to the United Kingdom include the European Union.

(3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day–

(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 47 to the United Kingdom include the European Union.”

16. Each of the marks relied upon by the applicant qualifies as an ‘earlier trade mark’ pursuant to section 6 of the Act. As they had all completed their registration processes more than five years before the date on which the application for a declaration of invalidity was filed, they are subject to the use provisions set out above. Accordingly, I must first determine whether, or the extent to which, the applicant’s marks can be relied upon for its claims under sections 5(2)(b) and 5(3).

17. In accordance with the provisions set out above, the relevant periods for this assessment are (i) the five-year period ending with the filing date of the application for invalidity, i.e. 28 July 2018 to 27 July 2023, and (ii) the five-year period ending with the filing date of the proprietor’s mark, i.e. 25 January 2018 to 24 January 2023.

Proof of use

18. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky*[2008] ECR I-

9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*

at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

19. He then stated as follows:

“107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Limited v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

’19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know.

...

22. ... it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal ... comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken,

having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

The evidence

20. In his first witness statement, Mr Brana says that the applicant first used the ‘FALCON’ brand in 1967 as part of a deal with Pan American Airlines. A timeline of the applicant’s history and ‘Falcon’ aeroplanes states that ‘Pan Am’ placed an order for 40 ‘Falcon 20s’ in 1963.³ He says that the applicant has made extensive use of its marks in relation to a wide variety of goods and services connected with the aviation industry via its website at dassaultfalcon.com. Printouts from the website, obtained via the Wayback Machine, are in evidence.⁴ They are dated between 29 January 2018 and 1 July 2023 and show the word ‘Falcon’ in relation to aeroplanes. There are also printouts, dated 13 July 2023, showing the word ‘FalconCare’ in relation to a maintenance programme and the word ‘FalconEye’ in relation to a vision system, both for its ‘Falcon’ aeroplanes. Further, I note that there is a copy of a presentation from the applicant in evidence, which shows a range of ‘Falcon’ aeroplanes.⁵ Mr Brana says that this was from 2023.

21. Goods and services under the ‘FALCON’ brand are said to have been sold to a range of customers, including private, public, civil and military organisations. Mr Brana says that one such user is the Royal Air Force, with the Ministry of Defence selecting two ‘Falcon 900LX’ aircraft for VIP transport. An online article from *The EurAsian Times*, dated 9 February 2022, has been provided; this says that the MoD placed an £80million order for two ‘Falcon’ aircraft the previous day.⁶ A range of news announcements from the applicant, dated between 2018 and 2023, are in evidence.⁷ Some refer to ‘Falcon’ aeroplanes, the ‘FalconCare’ maintenance programme and ‘FalconEye’ vision system, but others refer to marks and services not relied upon in these proceedings (such as, for example, ‘FalconConnect’ and training services).

³ Exhibit CB1

⁴ Exhibit CB2

⁵ Exhibit CB3

⁶ Exhibit CB4

⁷ Exhibit CB5

22. Mr Brana has also provided printouts from third-party websites avbuyer.com, privatejets.co.uk and exclusiveaircraft.co.uk, obtained via the Wayback Machine.⁸ Those from AV Buyer are dated between 15 June 2020 and 5 February 2023 and show second-hand ‘Falcon’ aeroplanes for sale. It appears to be a global website, with very few aeroplanes for sale in the UK or EU. Private Jets and Exclusive Aircraft appear to be UK-focused websites. The printouts of the former are not dated, whilst those of the latter are dated 7 June 2018, 1 February 2019 and 7 February 2019; they show second-hand ‘Falcon’ aeroplanes for sale.

23. Moreover, Mr Brana has evidenced printouts from the jetnet.com website, showing ‘Falcon’ aeroplanes based and registered in the UK (47 and 51 results, respectively).⁹ The printouts are not dated, so it is difficult to ascertain whether any were purchased or registered during the relevant periods. However, a small number are likely to be from 2018, 2019, 2020, 2022 and 2023. For example, a listing for a ‘Falcon 8X’ states “Year Mfr/Dlv: 2019/2020”, which is likely to indicate that this aeroplane was manufactured in 2019 and delivered in 2020.

24. The applicant’s global marketing expenditure between 2018 and 2023 is said to have been around €10million per annum. As for the UK, Mr Brana says that around €850,000 and €650,000 was spent on marketing in 2018 and 2022, respectively. The following figures are given for expenditure on advertisements featuring the applicant’s marks in publications circulated in the UK:

Date	Expenditure (£)
May 2020	3,492
May 2021	3,492
October 2021	8,688
February 2022	20,563
March 2022	8,688
May 2022	3,492
May 2022	20,563

⁸ Exhibits CB6-CB8

⁹ Exhibit CB14

January 2023	35,827
Total	104,805

25. A copy of an advertisement in *How To Spend It* (*Financial Times* weekend supplement) from February 2022, is provided.¹⁰ This shows the word ‘Falcon’ and a photograph of the interior of an aeroplane. Circulation figures for the supplement are given as 95,557 (UK and Ireland) and 39,836 (continental Europe), though it is not clear whether this was for the February 2022 edition or an average. Evidence of other advertisements for ‘Falcon’ aeroplanes in *Flight International Magazine* in May 2020, May 2021, May 2022 and January 2023 have been exhibited, as well as one in *The Gateway* (Harrods Aviation) in Autumn/Winter 2021.¹¹ I note that Mr Brana has also provided a printout from the applicant’s website showing publications it produced between May 2020 and January 2023, as well as a brochure containing details of the ‘Falcon 6X’ aeroplane (April 2023),¹² but he has not explained where or how many were distributed.

26. Mr Brana also exhibits an information sheet about the ‘FalconCare’ programme, which is described as a guaranteed maintenance and service programme for new ‘Falcons’.¹³ The information sheet is not dated. In addition, printouts from the applicant’s website explaining the ‘FalconEye’ system have been provided.¹⁴ It is described as a combined vision HUD system for aircraft which uses multi-sensor cameras and high-definition imaging. The printout is not dated, but the copyright notices state 2022 and 2023. Locations are all in the US and South America.

27. Mr Brana says that the brands covered by the applicant’s marks have achieved or been awarded various accolades and awards. He provides printouts from the news section of the Falcon website announcing the following:¹⁵

- (i) The ‘Falcon 8X’ set a new US cross-country speed record (26 April 2019);

¹⁰ Exhibit CB10

¹¹ Exhibits CB11 and CB12

¹² Exhibits CB9 and CB13

¹³ Exhibit CB9

¹⁴ Exhibit CB9

¹⁵ Exhibit CB15

(ii) The 'Falcon 6X' won an international Yacht & Aviation Award for interior design, sponsored by *design et al*, a UK design magazine (21 September 2020);

(iii) The applicant was voted first in product support surveys by *Aviation International News* in 2019, 2020 and 2021, and voted third and second in product support surveys by *Professional Pilot* in 2020 and 2021, respectively (13 August 2020 and 10 August 2021);

(iv) the 'Falcon 6X' won the Red Dot: Best of the Best award for its cabin design, whilst the 'Falcon 10X' won a Red Dot award of distinction for interior design (19 April 2021 and 19 May 2022);

(v) The applicant's 'fixed based operation' at Geneva International Airport was voted first in a survey of European business aircraft operators by *Business Air News* (27 July 2022).

28. Whilst these are noted, there is nothing which demonstrates how widely these accolades would have been known by consumers in the UK or EU. For instance, no information has been provided as to the number of internet users who accessed the Falcon website or its news section during the relevant periods.

29. Mr Brana states that the applicant has taken part in various trade events during the relevant periods, the most notable of which in the UK being the Farnborough Airshow, which he describes as one of the largest civilian and military air shows in the world. He provides photographs of the applicant's stands at the 2018 and 2022 shows.¹⁶ Models, displays and literature featuring 'Falcon' aeroplanes can be seen within the same. Mr Brana also exhibits associated documents for the airshows, including a range of invoices dated between 4 July 2018 and 7 June 2022 for the applicant's attendance.¹⁷

¹⁶ Exhibit CB16

¹⁷ Exhibit CB17

30. As for third-party coverage, Mr Branna provides a selection of news articles and reviews from the relevant periods.¹⁸ These include references to the ‘Falcon 6X’, ‘Falcon 10X’ and ‘Falcon Eye’ in *Robb Report* (5 August 2019 and 20 May 2021), coverage of the MoD’s £80million order for two ‘Falcon 900LX’ for the RAF in *The EurAsian Times* (9 February 2022) and *Corporate Jet Investor* (15 March 2022), and references to the applicant’s 500th ‘FalconCare’ maintenance contract in *AIN* (15 October 2020), *AVIPEO* (20 October 2020) and *Business Air News* (25 October 2020). There is also coverage of the applicant’s ‘FalconEye’ combined vision system in *AV Buyer* (19 December 2018), *AIN* (20 July 2018), *Aero Contact* (3 May 2019), *Simple Flying* (20 July 2022), *Aviation Pros* (7 March 2023) and *Radio Enthusiast* (August 2018). Most of the articles are featured on global websites and no information as to their respective circulation figures have been provided.

31. Mr Brana has also evidenced printouts from the applicant’s social media pages.¹⁹ From these, I note that the ‘Dassault Falcon’ X (formerly Twitter) page has nearly 70,000 followers, its Facebook page has 49,000 followers and its Instagram page has 166,000 followers. The printouts are not dated. On the basis that the figures were likely to be correct as of the date of Mr Brana’s statement, they do not reflect the position during either of the relevant periods. Moreover, I cannot ascertain what proportion of the followers (if any) were based in the UK or EU.

32. In his second witness statement, Mr Brana says that the ‘Falcon’ brand has a long and rich history associated with the military and defence sectors. In this regard, he says that, over the past 60 years, the applicant has acquired a deep experience of customising ‘Falcon’ aircraft for military and defence purposes. Such “multi-role” aircraft are said to represent around 10% of the worldwide ‘Falcon’ fleet. Mr Brana exhibits what he refers to as examples of “various products/services” that the applicant provides to these sectors under the ‘Falcon’ brand.²⁰ These predominantly comprise printouts from the applicant’s websites which state that ‘Falcon’ aeroplanes are used for, *inter alia*, airborne intelligence, maritime surveillance, VIP transport and medical evacuation. However, these printouts are from global websites and are largely

¹⁸ Exhibit CB18

¹⁹ Exhibit CB19

²⁰ Exhibit CB2-1

undated. A small number include 2024 copyright notices, which is after the relevant periods. Whilst some general figures are given, such as, for example, nearly 700 'Falcon 2000' aeroplanes being delivered (as of an unspecified date), there is no detail about where any customers were based. I note that the printouts suggest that the French Armed Forces initiated intelligence, surveillance and intervention programmes using 'Falcon 8X' and 'Falcon 2000' aeroplanes in 2019 and 2020, respectively; however, the relevant territory for such goods is the UK. As such, this evidence does not assist in establishing how many 'Falcon' aeroplanes were sold/used for the specified purposes during the relevant periods in the relevant territory. There is also a printout from the website of The Royal International Air Tattoo, which says that the 'Falcon 20' has been used for over 30 years to provide electronic warfare adversary training to UK and NATO Forces. It also refers to "the new RAF VIP jet", a 'Falcon 900X'. The printout shows a 2023 copyright notice.

33. Finally, I note that Mr Brana provides evidence regarding research and development projects, including in relation to artificial intelligence, human-machine interface and aerodynamics.²¹ However, the applicant's marks are not registered for any services for which this would be relevant.

Sufficiency of use

34. At the hearing, Mr St Quintin and Ms Newnes both provided detailed submissions on the issue of proof of use. Whilst I do not intend to reproduce them here, I confirm that I have taken them into account and will refer to them below where necessary.

35. The evidence is limited in a number of ways. For instance, no evidence has been provided as to the size of the relevant market or the share of the same held by goods or services offered under the applicant's marks. Moreover, no turnover information has been provided, there is little evidence relating to sales and the evidence of actual use of the marks is limited. Although 'Falcon' aeroplanes were clearly offered for sale on a UK website during the relevant periods (Exclusive Aircraft), and second-hand sales

²¹ Exhibit CB2-2

can constitute genuine use,²² I am not satisfied that this assists the applicant. Even if this should be considered second-hand commercial activity capable of maintaining a market for the applicant's goods, as opposed to a mere recirculation of goods which had already been put on the market under the 'Falcon' mark, there is no direct evidence of sales; there is no evidence that any of those aeroplanes were sold during the relevant periods. Most of the website evidence does not appear to specifically target the UK or EU, and merely being capable of being accessed from these territories is not sufficient.²³ In addition, there is no information as to the circulation of any of the brochures or publications in evidence or how many internet users accessed any of the websites. Similarly, no details have been provided as to how many individuals attended the airshows, albeit that Mr Brana describes Farnborough as one of the largest of its kind in the world. The social media evidence does not assist the applicant because it is not possible to ascertain how many followers the applicant's pages had during the relevant periods or how many of those followers were based in the relevant territories.

36. Nevertheless, an assessment of genuine use is a global assessment, which involves looking at the evidential picture as a whole.²⁴ From the sum of the evidence, it is sufficiently clear that aeroplanes have been manufactured, marketed and sold under the 'Falcon'/'FALCON' mark during the relevant periods; this is evident from the unchallenged evidence regarding the MoD purchasing two such aircraft for the RAF in February 2022. Whilst the sale of two goods may not, on the face of it, seem significant, it is important to bear in mind the nature of the goods and the fact that the market for them is likely to be much smaller than for everyday consumer products; aeroplanes are unlikely to have a large customer base. It is also worth noting that those aircraft were purchased for a reported £80million, which is clearly a significant sum. The printouts from jetnet.com also suggest that a small number of 'Falcon' aeroplanes based/registered in the UK were manufactured and delivered during the relevant periods. Mr Brana's unchallenged narrative evidence is that around €1.5million was spent on marketing in the UK during the relevant period. Even though

²² See, for example, *Joined Cases C-720/18 & C-721/18, Ferrari SpA v DU, London Taxi Corp v Frazer-Nash Research Ltd* [2017] EWCA Civ 1729 and *Aiwa Co. Limited v Aiwa Corporation* [2019] EWHC 3468 (Ch).

²³ *W Sternoff LLC v Peter Kertels*, BL O/0984/25, paragraphs 29-34

²⁴ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09

this appears to have been a global figure (and may, therefore, include expenditure for activities not connected with the 'Falcon' brand), Mr Brana's evidence is that over £100,000 was spent during the relevant periods solely in connection with advertising 'Falcon' aeroplanes in UK publications. Copies of such advertisements have been provided in support, albeit that there are no circulation figures for the same. The applicant also received several awards in the relevant periods in connection with its aeroplanes and product support (one of which was specifically sponsored by a UK design magazine) and showcased its 'Falcon' aeroplanes at the Farnborough Airshow on two occasions. The Royal International Air Tattoo website also suggests that UK Armed Forces have used 'Falcon' aeroplanes for training purposes, potentially during the relevant periods. Finally, although much of the third-party coverage of the applicant's products is not specific to the UK or EU, and no circulation figures have been provided, 'Falcon' aeroplanes did feature in a small number of UK-specific publications (*Robb Report*) during the relevant period. Taking all of the evidence into account, I am satisfied that the opponent has attempted to create and maintain a market for 'Falcon'/'FALCON' aeroplanes during the relevant periods.

Fair specification

37. I must now determine a fair specification for the applicant's marks. In doing so, I bear in mind that fair protection is not achieved by defining the particular examples of goods or services for which there has been genuine use but, rather, the particular categories of goods or services they should realistically be taken to exemplify.²⁵ The task is not to describe the use made by the trade mark proprietor in the narrowest possible terms, unless that is what the average consumer would do.²⁶

The applicant's first mark

38. Firstly, the applicant seeks to rely upon *aircraft, and apparatus included in Class 12 for locomotion by air*. As noted above, I am satisfied that the applicant has demonstrated genuine use in respect of aeroplanes. Whilst these goods clearly fall

²⁵ *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10

²⁶ *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

within the specification as registered, the applicant's terms are broad and encompass a number of subcategories of goods capable of being viewed independently by consumers.²⁷ They include other goods, such as, for example, helicopters, hot air balloons and gliders, which are in essence different from aeroplanes, and in respect of which there is no evidence of the applicant providing. In my view, the average consumer would fairly describe the goods shown in evidence as *aeroplanes*.

39. As for *aeroplane engines, and parts and fittings therefor included in Class 7*, there is no evidence of the applicant manufacturing or selling such goods to third parties as distinct goods separate from its aeroplanes. Although one would undoubtedly expect a complete aeroplane to include an engine, there is nothing in the evidence which suggests that the applicant attempted to create a market for such goods. In fact, the only evidence which specifically mentions engines associated with 'Falcon' aircraft suggests that they are produced by other undertakings under other marks. For example, an article in *The EurAsian Times* regarding the MoD's purchase of two 'Falcon' aircraft states that "[...] Honeywell TFE731-60 turbofan engines, each producing 22.24kN of thrust, power the aircraft." In addition, a news announcement on the Falcon website states that "[the Falcon] 10X's 18,000+ pound thrust Rolls Royce Pearl engine [...]." The applicant's brochure about the 'Falcon 6X' states that it has a "RELIABLE AND ROBUST PUREPOWER® PW812D ENGINE"; the *Robb Report* articles confirm that this is manufactured by Pratt & Whitney Canada. All things considered, I am unable to conclude that the applicant has demonstrated genuine use in respect of these goods.

The applicant's second mark

40. The specification of this mark includes the term *aircraft repair services included in Class 37*. I accept that there is evidence connected with aeroplane repair services. For instance, I note that information and news announcements about the applicant's maintenance services under 'FalconCare' were available on the applicant's website during the relevant periods. One, dated 15 June 2021, said that the applicant had

²⁷ The word 'aircraft' is defined as "any vehicle, with or without an engine, that can fly, such as a plane or helicopter" (i.e. not only aeroplanes): <https://dictionary.cambridge.org/dictionary/english/aircraft>

enrolled more than 500 aircraft the programme. This announcement received coverage in three publications during the relevant periods. However, the applicant's website and the websites on which the articles were published were global in nature, with no indication as to whether they were accessed by any individuals in the UK during the relevant periods. Whilst I do not doubt that the applicant has, indeed, provided repair and maintenance services in relation to its aeroplanes under 'FalconCare', not every commercial use of a mark may automatically be deemed to constitute genuine use. In my view, the evidence provided in respect of these services is simply too vague and lacking in detail. Whilst customers may have signed up to 'FalconCare', and 500 is certainly not an insignificant number of customers in respect of a maintenance programme for aeroplanes, there is nothing which demonstrates where any of those customers are based, how many of the contracts were entered into during the relevant periods, or where and when any repairs or services were completed. Overall, it is my view that the evidence provided is insufficiently solid or specific to meet the requisite standard of proof. The applicant may not rely on these services for the purposes of its application.

41. The specification of this mark also includes *air freight services and air transport services on executive aircraft; hiring and leasing of executive aircraft; all included in Class 39*. Although I have concluded that genuine use has been demonstrated in respect of aeroplanes (as goods), there is no evidence of the applicant providing any of these services under its 'Falcon'/'FALCON' mark. Mr Brana makes no mention of any such services, and I have been unable to find any reference to them in the documentary evidence. Even if offering alternative transport to 'FalconCare' customers ought to be considered an air transport service per se, as indicated above, there is no evidence demonstrating where or when any such services were provided during the relevant periods. Passing references to this feature of 'FalconCare' do not suffice. The applicant may not rely upon these services.

The applicant's third mark

42. In respect of this mark, the applicant seeks to rely upon *maintenance and repair of business aircraft*. I have already discussed the applicant's maintenance and repair services under its 'FalconCare' mark above. My findings at paragraph 40 are equally

applicable here. The applicant may not rely upon these services for the purposes of its application.

The applicant's fourth mark

43. The goods in the specification of this mark broadly consist of avionic, flight information and enhanced vision systems for aircraft. I remind myself that information about the 'FalconEye' combined vision system featured on the applicant's website towards the end of the later relevant period. The technology was also referred to in news announcements on the applicant's website during the relevant periods. One particular news announcement, dated 28 May 2018, said that 'FalconEye' had been available since early 2017 and that the vast majority of 'Falcon 8X' operators had opted to equip their aeroplanes with it. However, as previously outlined, the applicant's website is global in nature and, therefore, does not assist the applicant in demonstrating genuine use in the UK or EU. This is also true of most of the coverage 'FalconEye' received; the websites and publications are nearly all global in nature. It did feature in two articles from a UK-specific publication during the relevant period (*Robb Report*). One stated that the 'Falcon 10X' would also feature the technology. However, it appears that the aeroplane was not released until after the end of the relevant periods, with the applicant's CEO quoted as saying that it would "enter service at the end of 2025". The other stated that the 'Falcon 6X' – due to take its first flight in 2021, with deliveries commencing in 2022 – would feature the technology. Aside from the '8X', '10X' and '6X' models, the evidence suggests that 'FalconEye' was compatible with several other 'Falcon' aeroplanes, including the '2000S/LXS', '90LX' and '900' models. It may be that the technology was available on all these models and I accept that I have found genuine use in relation to the applicant's aeroplanes. Nevertheless, the materials submitted show that 'FalconEye' was optional, i.e. not all aeroplanes sold by the applicant would necessarily be equipped with it. There is no information as to how many aeroplanes featuring the technology were manufactured or sold during the relevant periods. Even if, as noted above, most 'Falcon 8X' operators opted for it, there are no specifics as to how many of these aeroplanes were sold in the relevant territories during the relevant periods. On the balance of the evidence, I am unable to conclude that there has been genuine use of these goods.

Conclusion on fair specification

44. In light of all the above, I find that the applicant may rely upon its first mark, 'Falcon', in respect of *aeroplanes* in class 12 for the purposes of its application.

Section 5(2)(b)

Legislation and case law

45. Sections 5(2)(b) and 5A of the Act read as follows:

“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.”

“5A 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.”

46. 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 goods and services

47. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated, at paragraph 23 of its judgment, that:

“In assessing the similarity of the goods or services concerned, [...] all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

48. The relevant factors identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 for assessing similarity were:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

49. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court stated that ‘complementary’ means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

50. In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for them lies with the same undertaking (or an economically connected) undertaking. As Mr Daniel Alexander QC, sitting as the Appointed Person, noted in *Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

51. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J (as he then was) stated that:

"[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

52. The goods and services to be compared are as follows:

Proprietor's services	Applicant's goods
<p>Class 35: Development of concepts for business economy; business consultancy services and business advisory services relating to product development; business advisory services relating to the exploitation of inventions, products and technology; business services relating to the arrangement of joint ventures.</p> <p>Class 40: Custom manufacture of prototypes.</p>	<p>Class 12: Aeroplanes.</p>

Class 42: Research, design and development services; research, design and development of new technology, and new products, for others; product research and development; advisory services in the field of product development; technological research, design and consultancy services; scientific and technological research and development services; research, design and development of engineering, electrical hardware and computer software products, used in the military, defence, security, aviation, aerospace and civil engineering sectors; design and development of prototypes; defence research and development; aerospace research and development; engineering services in the field of building technology.	
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53. At the hearing, Mr St Quintin and Ms Newnes both provided submissions on the goods and services comparison. Whilst I do not intend to reproduce them, I confirm that I have taken them into account and will refer to them below where necessary.

54. Before proceeding with the comparison, I note that Mr Parkes provides a brief overview of the proprietor's use of its mark. At the hearing, I did not understand Ms Newnes to be advancing an argument that this use in some way distinguishes the parties' goods and services. For the sake of completeness, I record here that it does not. This is because, when assessing the likelihood of confusion, it is necessary to consider all the circumstances in which a mark might be used.²⁸ The following comparison must take into account only the services for which the proprietor's mark is

²⁸ *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06

registered, as they appear in the register, and the applicant's goods framed by the fair specification. Any differences between the actual goods or services provided by the parties are not relevant unless those differences are apparent from the competing specifications.

Class 35

55. The proprietor's services in this class consist of a variety of business services. Clearly, they differ in nature, purpose and method of use when compared with the applicant's *aeroplanes*. It seems unlikely that a manufacturer of aeroplanes would also provide such business services and there is no evidence that the respective goods and services reach the market through shared trade channels. Even if, as Mr St Quintin submitted, the applicant has developed a more efficient billing approach for its maintenance programme, that is an internal process; it is not offering, for example, *development of concepts for business economy* as a service. Given the entirely different purposes, there is no competition between the respective goods and services. I do not consider them to be complementary in the sense outlined in the authorities; whilst the effective running of the business is no doubt important to an aeroplane manufacturer (as it would be to any business), the respective goods and services can operate entirely independently of one another and consumers would not expect responsibility for both to lie with the same undertakings. Users are likely to differ. This is because it is likely to be businesses such as aeroplane manufacturers who seek the proprietor's services, rather than their customers. Taking all of this into account, it is my view that there is no similarity between the respective goods and services.

Class 40

56. The proprietor's services in this class clearly differ in nature, purpose and method of use when compared with the applicant's *aeroplanes*. The proprietor's service covers the custom manufacture of prototypes for third parties.²⁹ Although I do not doubt that aeroplane manufacturers will design and produce prototypes thereof, these activities do not constitute custom manufacturing as a service. Rather, they are (internal) steps

²⁹ See the explanatory note to class 40 of the Nice Classification.

in the manufacturing of their own goods. Whilst it is possible that some aeroplane manufacturers design prototypes for other undertakings, there is no evidence that this is typical in trade. I find that they are likely to be provided by distinct undertakings through different trade channels. There is no material competition between the respective goods and services. Although the result of both could be an aeroplane, one will be a prototype and the other a finished product. As such, the goods and services are not interchangeable. Neither do I consider the respective goods and services to be complementary. I accept that manufacturing a prototype of an aeroplane is important to the ultimate finished product. However, consumers would not expect an aeroplane manufacturer to also provide prototype design (for others). Users are likely to also differ: the prototype manufacture services are likely to be used by the provider of the finished product, rather than its purchaser. In light of all this, I find that the respective goods and services are dissimilar.

Class 42

57. The proprietor's services in this class broadly consist of a range of design, development and research services. Again, when compared with the applicant's *aeroplanes*, the respective goods and services differ in nature, purpose and method of use. Whilst aeroplane manufacturers will undoubtedly conduct scientific and technological research and design, this is likely to be an internal process; they are likely to do so as part of the planning, developing and manufacturing their own products, rather than providing such services to third parties. There is no evidence that it is typical in trade for aeroplane manufacturers to provide the proprietor's services to others. Even though there is (limited) evidence of the applicant's involvement in certain research projects, that alone is not sufficient for this purpose. As such, I find that the respective goods and services are likely to reach the market through different channels of trade by separate undertakings. The respective goods and services are not interchangeable and, therefore, there is no competition between them. Moreover, I do not consider them to be complementary in the sense outlined in the authorities. Aerospace research and the like is clearly important to aeroplanes. Nevertheless, consumers are unlikely to expect an aeroplane manufacturer to also offer research and development services (to others). Again, users are also likely to differ. This is because it is the aeroplane manufacturer, not the aeroplane purchaser,

that is likely to seek the proprietor's services. Overall, I find that the respective goods and services are dissimilar.

Conclusion on the goods and services comparison

58. Some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion; if there is no similarity at all, there is no likelihood of confusion to be considered.³⁰ My findings above mean that this ground must fail in its entirety.

Conclusion

59. The applicant's claim under section 5(2)(b) is dismissed.

Section 5(3)

Legislation and case law

60. Section 5(3) of the Act states:

“(3) A trade mark which-

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 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”.

³⁰ *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA, paragraph 49

61. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected”.

62. As the applicant’s third and fourth marks are comparable marks, paragraph 10 of Part 1, Schedule 2A of the Act is relevant. It reads:

“10.— (1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to—

(a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and

(b) the United Kingdom include the European Union.”

63. The relevant case law can be found in the following judgments of the CJEU: *General Motors*, Case C-375/97, *Intel*, Case 252/07, *Adidas-Salomon*, Case C-408/01, *L’Oréal v Bellure*, Case C-487/07, *Marks and Spencer v Interflora*, Case C-323/09, and *Environmental Manufacturing LLP v OHIM*, Case C-383/12P. 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-Salomon, 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* and *Environmental Manufacturing, paragraph 34*.

(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'Oréal 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'Oréal v Bellure*).

64. The conditions of section 5(3) are cumulative. Firstly, the applicant must show that its marks are similar to the proprietor's mark. Secondly, the applicant must show that its marks have achieved a level of knowledge, or reputation, amongst a significant part of the public. Thirdly, the applicant must establish that the public will make a link between the marks, in the sense of its marks being brought to mind by the proprietor's mark. Finally, assuming the foregoing conditions have been met, section 5(3) requires that one or more types of damage claimed by the applicant will occur. It is not necessary for the purposes of section 5(3) that the goods and services are similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

65. The relevant date for the assessment under this ground is the filing date of the proprietor's mark, that being 24 January 2023.

Reputation

66. In *General Motors*, 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.”

67. I have already discussed the applicant’s evidence. The burden of establishing a reputation falls on the proprietor of the earlier mark.³¹ Even factoring in any evidence which predates the relevant periods assessed under proof of use, it is my primary finding that the evidence as a whole is not sufficient for the purposes of establishing that the applicant’s marks were known by a significant part of the public at the relevant date. This is on the basis of the same issues identified in my assessment of genuine use; the evidence is lacking in solidity and specificity. However, particularly considering that the MoD saw fit to purchase two ‘Falcon’ aeroplanes in the year preceding the relevant date, I will proceed on the basis that the applicant has demonstrated that its ‘Falcon’ mark had a qualifying reputation in respect of *aeroplanes*. That being said, given the nature of the evidence, I am only able to characterise that reputation as modest.

³¹ *Sacentro – Cinericio de Texteis SA v Michael Codd*, BL O/360/20

Link

68. As noted above, my assessment of whether the public will make the requisite mental 'link' between the competing marks must take into account all relevant factors. The factors are identified at paragraph 42 of *Intel*. I take each of these in turn.

The degree of similarity between the competing marks

69. It is clear from *Sabel* 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 *Bimbo* 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.”

70. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

71. The marks to be compared are as follows:

The proprietor's mark	The applicant's first mark
FalconWorks	Falcon

72. At the hearing, Mr St Quintin and Ms Newnes both made submissions on the comparison of marks. Whilst I do not intend to summarise these, I confirm that I have taken these into account and will refer to them below where necessary.

Overall impressions

73. The applicant's mark is in word-only format and consists of the word 'Falcon'. As this is the only element of the mark, the overall impression is dominated by the word itself.

74. The proprietor's mark is in word-only format and comprises the verbal element 'FalconWorks'. Although they are presented as a single word, it is my view that the relevant public will perceive the mark as consisting of two words, i.e. 'Falcon' and 'Works'. This is because they are ordinary, easily identifiable words. There is also a natural break between them created by the different use of capitalisation. It is my view that the two words dominate the overall impression of the mark in roughly equal measure.

Visual comparison

75. Visually, the competing marks are similar because they share the word 'Falcon'. This word forms the entirety of the applicant's mark and appears at the beginning of the proprietor's mark, a position which tends to have most visual impact.³² The competing marks differ insofar as the proprietor's mark contains the additional word 'Works'. Bearing in mind my assessment of the overall impressions, I find that the level of visual similarity between the competing marks is slightly above medium.

Aural comparison

76. The words in the competing marks will be pronounced in the ordinary way. They are similar in that the two syllables which make up the applicant's mark appear at the beginning of the proprietor's mark, a position which generally has most aural impact.

³² *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

The competing marks are aurally different to the extent that the proprietor's mark contains an additional syllable thereafter. Overall, I find that level of aural similarity between the competing marks is slightly above medium.

Conceptual comparison

77. The word 'Falcon' is defined as meaning "a bird with pointed wings and a long tail, that can be trained to hunt other birds and small animals".³³ This would be readily understood by the relevant public. The word 'Works' is defined as meaning "an industrial building, especially one where a lot of people are employed".³⁴ Mr St Quintin and Ms Newnes both offered meanings for the proprietor's mark based on the combination of the words, arguing that this results in the marks being similar or different, respectively. For a concept to be relevant, it must be capable of immediate grasp by the relevant consumer.³⁵ I do not consider that the combination of 'Falcon' and 'Works' will convey any immediately obvious meaning; the words do not combine to form a unit with a different meaning than the two words taken separately. Rather, the two words retain their independence. The competing marks are conceptually similar in that they both refer to the same bird but differ insofar as the proprietor's mark conveys an additional concept. Bearing in mind my assessment of the overall impressions, I find that the competing marks are conceptually similar to a medium degree.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

78. I have found that *aeroplanes* are dissimilar to all the proprietor's services. Dissimilarity is a relative concept. I consider there to be a considerable distance between these goods and the proprietor's services in class 35, which consist of a range of business services. There is arguably more of a connection with the

³³ <https://dictionary.cambridge.org/dictionary/english/falcon>

³⁴ <https://dictionary.cambridge.org/dictionary/english/works>

³⁵ *The Picasso Estate v OHIM*, Case C-361/04 P

proprietor's services in classes 40 and 42, given that these services could all more tangibly relate to the aviation/aerospace sector.

79. The goods and services at issue in these proceedings are not of the kind which would typically be purchased by the general public. The proprietor's services are likely to be purchased by businesses looking to develop products or their internal processes. They are likely to be purchased at varying degrees of frequency; some businesses may seek regular business support or research and development over an extended period, whilst others may only purchase the services occasionally. The purchasing process is unlikely to be merely casual. Businesses will consider factors such as cost, the range of services on offer, previous outcomes and the provider's reputation when selecting the services; they will also be alive to the potential impact the selection will have on their business. In my view, consumers of these services are likely to demonstrate between a medium and high level of attention during the purchasing process. The services are likely to be purchased directly from the provider, after viewing information in brochures or on websites. As such, visual considerations are likely to dominate the purchasing process. However, I do not exclude the possibility of an aural component, given that consumers may wish to discuss the services with the provider.

80. As for the applicant's goods, aeroplanes are most likely to be purchased by businesses and other organisations, such as the military, seeking a method of air travel. They are not likely to be purchased frequently and will attract a very high cost. The goods will be highly considered purchases, given the outlay, the specialist nature of the goods and safety considerations. Therefore, I find that consumers of these goods are likely to demonstrate a high (if not very high) level of attention during the purchasing process. They are likely to be purchased directly from manufacturers or from intermediary dealerships after a visual inspection of the goods, or after viewing information in brochures, catalogues or on websites. As a result, it is my view that the purchasing process is predominantly visual in nature. However, I do not discount that there may be an aural component in the form of discussions with the manufacturer or sales representatives.

The strength of the earlier mark's reputation

81. I have proceeded on the basis that the applicant's first mark possesses a modest reputation.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

82. In *Lloyd Schuhfabrik Meyer*, 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 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).”

83. The applicant's first mark consists of the word 'Falcon' with no other elements. As outlined above, it is a dictionary defined word referring to a type of bird. At the hearing, Ms Newnes submitted that Mr Parkes' evidence demonstrates that 'Falcon' is a common sign used in the aviation sector. The evidence advanced in support of this

line of argument consists of (i) printouts from the websites of Lockheed Martin, Falcon Flying Group, Falcon Aviation, the RAF, Interesting Engineering and Falcon Airfreight and (ii) printouts from the register showing three (out of a purported total of 509) applications/registrations containing the word 'Falcon'.³⁶ I do not agree that this evidence establishes that the applicant's first mark has no distinctiveness or that it has been reduced on the basis that 'Falcon' is a commonly used word in the relevant sector. Firstly, as a registered trade mark (the validity of which is not in question in these proceedings), it must be assumed to have some distinctive character.³⁷ Moreover, the proprietor's argument is reminiscent of *Nude Brands Limited v Stella McCartney Limited and others* [2009] EWHC 2154 (Ch), in which Floyd J stated:

"29. Whilst the use by other traders of the brand name NUDE in relation to perfume may give those traders relative rights to invalidate the mark, it does not give those rights to any defendant. I am not at this stage persuaded that this evidence has a bearing on any absolute ground of invalidity. It certainly does not go as far as establishing ground 7(1)(d) - customary indication in trade. Ground 7(1)(b) is concerned with the inherent character of the mark, not with what other traders have done with it. The traders in question are plainly using the mark as a brand name: so I do not see how this use can help to establish that the mark consists exclusively of signs or indications which may serve to indicate the kind or quality or other characteristics of the goods, and thus support an attack under 7(1)(c)."

84. Even if the plurality of similar names by which individual establishments are known could support the contention that the word 'Falcon' has no, or a reduced level of, distinctive character, the website printouts are largely undated or relate to other jurisdictions (such as the UAE and Austria). These documents cannot be relied upon as showing the position in the UK at the relevant date. The material from the RAF does suggest that the word 'Falcon' was used across the UK in 2022. However, this was not in any generic sense. In addition, it does not show use in the course of trade in respect of aeroplanes or any of the goods or services at issue. Rather, it appears to

³⁶ Exhibits DSP3-DSP10

³⁷ See section 72 of the Act and *Formula One Licensing BV v OHIM*, Case C-196/11P

be the name of the RAF's parachute display team. As for the extract from the register, the mere existence of other trade marks containing the word 'Falcon' can have no bearing on my assessment; there is no evidence that the marks are in use.³⁸ During the course of the hearing, Ms Newnes also conceded that the applicant's mark has an average level of inherent distinctiveness, so I will proceed on that basis.

85. The distinctive character of a mark may be enhanced by virtue of the use made of it. At the hearing, Mr St Quintin argued that the evidence in this case demonstrates that the applicant's mark enjoys an enhanced level of distinctive character. Ms Newnes highlighted that this point had not been pleaded but submitted that the evidence was not sufficient for this purpose in any event. I do not consider the applicant's failure to specifically plead enhanced distinctiveness to be fatal to its case. This is because it is one of the fundamental factors that need to be assessed in every case. As evidence of use has been filed by the applicant, it is incumbent on me to factor it into my assessment of the overall distinctiveness of the applicant's mark.

86. It is my view that the evidence filed in these proceedings falls short of establishing that the distinctiveness of the applicant's mark has been enhanced through use. This is on the basis of the limitations previously discussed. However, whilst I acknowledge that reputation and enhanced distinctive character are different, the nature, factors, and evidence used to prove them are the same.³⁹ Moreover, a mark which has a reputation is highly likely to also benefit from enhanced distinctiveness.⁴⁰ As such, I will proceed on the basis that the distinctive character of the applicant's mark had been enhanced at the relevant date, with the effect that it is factually distinctive to a level slightly higher than medium.

Whether there is a likelihood of confusion

87. I have not thus far considered whether there is a likelihood of confusion because I found the parties' goods and services to be dissimilar, and a prerequisite of section 5(2)(b) is that there is at least some similarity between them. I acknowledge that the

³⁸ *Zero Industry Srl v OHIM*, Case T-400/06

³⁹ *O2 Worldwide Limited v CX02.COM (UK) Limited*, BL O/393/19, paragraph 39

⁴⁰ *Crossfit LLC V Personal Trainer Ltd*, BL O/0330/23, paragraph 27

provisions of section 5(3) offer additional protection which takes into account the repute and distinctiveness of earlier trade marks. Nonetheless, in the circumstances I do not believe that the relevant public, demonstrating an above medium level of attention, would be caused to believe that the user of the proprietor's mark is economically connected to the user of the applicant's mark. The assumed reputation and distinctive character of the applicant's mark are not such that a consumer, perceiving the proprietor's mark in relation to dissimilar services, is likely to believe that there is an economic connection between the users of the marks.

88. In my view, the applicant's 'family' of marks argument does not take its case on likelihood of confusion any further. Mr St Quintin contended that consumers would perceive the proprietor's mark as originating from the same stable as the applicant's 'Falcon', 'FalconEye' and 'FalconCare' marks. Whilst I acknowledge that it is not necessary to demonstrate genuine use of each mark alleged to be in the family, there must be a sufficient number of them and they must be present on the market.⁴¹ Even if three marks could constitute a proper family of marks, from the evidence that has been filed in these proceedings, I am unable to conclude with any degree of certainty that the 'FalconEye' or 'FalconCare' marks were actually present on the UK market at the relevant date. In addition, the authorities – including the case referred to by Mr St Quintin, *W3 Ltd v easyGroup Ltd* [2018] EWHC 7 (Ch) – require the later mark to display characteristics which render it capable of association with the family. Although the proprietor's mark clearly shares the word 'Falcon' with the applicant's marks, I am not satisfied that the word 'Falcon' is distinctive to the point that consumers would believe that any mark using it must be from the applicant's alleged family. Neither am I convinced that the addition of the word 'Works' will lead consumers to believe that the mark belongs to the same family as 'Falcon', 'FalconEye' and 'FalconCare'; it does not, for instance, consist of the word 'Falcon' followed by a descriptive/allusive reference to the goods or services.

⁴¹ *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06

Conclusions on link

89. As per my summary of the case law above, my assessment of whether a mental link will be made between the parties' marks must take into account all relevant factors. One of those factors is the relevant public. In *Intel*, the CJEU stated as follows:

"The relevant public

33 The public to be taken into account in order to determine whether registration of the later mark may be declared invalid pursuant to Article 4(4)(a) of the Directive varies depending on the type of injury alleged by the proprietor of the earlier trade mark.

34 First, both a trade mark's distinctiveness and its reputation must be assessed, first, by reference to the perception of the relevant public, which consists of average consumers of the goods or services for which that mark is registered, who are reasonably well informed and reasonably observant and circumspect (as regards distinctive character, see Case C 363/99 *Koninklijke KPN Nederland* [2004] ECR I 1619, paragraph 34; as regards reputation, see, to that effect, *General Motors*, paragraph 24).

35 Accordingly, the existence of injury consisting of detriment to the distinctive character or the repute of the earlier mark must be assessed by reference to average consumers of the goods and services for which that mark is registered, who are reasonably well informed and reasonably observant and circumspect.

36 Secondly, as regards injury consisting of unfair advantage taken of the distinctive character or the repute of the earlier mark, in so far as what is prohibited is the drawing of benefit from that mark by the proprietor of the later mark, the existence of such injury must be assessed by reference to average consumers of the goods or services for which the later mark is registered, who are reasonably well informed and reasonably observant and circumspect.

[...]

46 It is possible that the conflicting marks are registered for goods or services in respect of which the relevant sections of the public do not overlap.

[...]

48 It is therefore conceivable that the relevant section of the public as regards the goods or services for which the earlier mark was registered is completely distinct from the relevant section of the public as regards the goods or services for which the later mark was registered and that the earlier mark, although it has a reputation, is not known to the public targeted by the later mark. In such a case, the public targeted by each of the two marks may never be confronted with the other mark, so that it will not establish any link between those marks.

[...]

51 It must also be pointed out that certain marks may have acquired such a reputation that it goes beyond the relevant public as regards the goods or services for which those marks were registered.”

90. If the respective relevant publics for the parties' goods and services are not the same and do not overlap, it is difficult to see how a link would be made. I have found that the users of the parties' goods and services differ. Essentially, the relevant public of the proprietor's services are likely to be businesses such as aeroplane manufacturers, themselves, rather than their customers. The customers of those businesses would form a distinct relevant public. The assumed reputation in the applicant's mark is not so strong that it goes beyond its relevant public.

91. Even if there is an overlap in the respective relevant publics, I am of the view that applicant's mark will not be called to mind by the proprietor's mark. I acknowledge that the competing marks share the word 'Falcon', leading to moderate levels of overall similarity between them, and that the applicant's mark is factually distinctive to a higher than medium level. However, the reputed goods and the services for which the proprietor's mark is registered are sufficiently distant to avoid a link being made, even

where they could be said to relate to the aviation/aerospace sector. In addition, on the basis of the evidence before me, I have only been able to proceed on the basis that the applicant's mark has a modest reputation; this level of reputation is, to my mind, insufficient to overcome the distance between the parties' goods and services.

Conclusion

92. The applicant's claim under section 5(3) is dismissed.

Section 5(4)(a)

Legislation and case law

93. Section 5(4)(a) of the Act states:

“(4) 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, where the condition in subsection (4A) is met,

(aa) [...]

(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.”

94. Subsection (4A) of section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of

application for registration of the trade mark or date of the priority claimed for that application.”

95. In *Discount Outlet v Feel Good UK* [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

96. Halsbury’s Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action”.

Relevant date

97. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the Registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In SWORDSERS TM O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”

98. The prima facie relevant date is the filing date of the proprietor’s mark, namely 24 January 2023. Mr Parkes has provided a brief overview of the proprietor’s use of its mark, supported by printouts from the proprietor’s website.⁴² However, these are all undated and do not, therefore, establish any earlier date for the purposes of my assessment. I note that one contains a 2023 copyright notice, but that is not enough to establish public facing use before the prima facie relevant date. In any event, the prima facie relevant date was in January of that year, so even if I considered the position at the earliest possible point that the copyright notice was effective from (a mere 23 days beforehand) it will not have any material impact on the outcome of this ground. The relevant date remains the filing date of the proprietor’s mark.

Goodwill

99. The first hurdle for the applicant is to show that it had the necessary goodwill in the sign relied upon at the relevant date. Goodwill was described in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a

⁴² Exhibits DSP1 and DSP2

business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

100. I have already found that the evidence provided by the applicant is sufficient for establishing genuine use of a registered mark identical to one of the signs relied upon under this ground. For the same reasons as given at paragraph 36, I am satisfied that the applicant has demonstrated that its business in *aeroplanes* enjoyed a moderate level of goodwill at the relevant date. I am also satisfied that the ‘Falcon’ sign was distinctive of that goodwill. In my view, this goodwill does not extend to any other signs or goods and services for the same reasons as given at paragraphs 35 and 39 to 43.

Misrepresentation

101. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt LJ stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants’ [product] in the belief that it is the respondents’ [product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

102. Later in the same judgment, he stated:

“[...] for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

103. When considering the applicant's claim under section 5(2)(b), I did not consider whether there was a likelihood of confusion because I found all the parties' goods and services to be dissimilar. Under this ground, there is no requirement for goods or services to be similar. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet LJ made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression “common field of activity” was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego case Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the

plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

‘...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency) [1972] R.P.C. 838 at page 844 per Russell L.J.

In the *Lego case Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

‘even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.’

In the same case Stephenson L.J. said at page 547:

‘...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged “passer off” seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.’ ”

104. Whilst there is no requirement for the parties to be operating in a common field of activity, it is still a highly relevant consideration. As is clear from the case law above, proving a likelihood of confusion and any resulting damage where there is no common field of activity is a heavy burden. No evidence going to misrepresentation has been filed. Although at least some of the parties' goods and services could be said to relate to the aviation/aerospace sector, it is my view that any overlap this creates between the parties' respective fields of activity is tenuous. To my mind, the moderate level of goodwill in the applicant's business at the relevant date is not sufficient to overcome the distance between the parties' goods and services, notwithstanding the overall levels of similarity between the applicant's sign and the proprietor's mark. Particularly considering a heightened level of attention is likely to be exhibited when purchasing the goods and services at issue, I do not consider that a substantial number of members of the public will be deceived into purchasing the proprietor's services in the

mistaken belief that they are the goods of the opponent. There will be no misrepresentation and, therefore, there is no risk of damage.

Conclusion

105. The applicant's claim under section 5(4)(a) is dismissed.

Overall outcome

106. The application for invalidation under sections 5(2)(b), 5(3) and 5(4)(a) of the Act has been unsuccessful. Subject to any appeal against my decision, the proprietor's mark will remain registered in the UK.

Costs

107. As the proprietor has been successful, it is entitled to a contribution towards its costs. At the hearing, it was common ground that costs in these proceedings should be awarded by reference to the published scale. The relevant scale is that published in Tribunal Practice Notice 1/2023. In the circumstances, I award the proprietor the sum of **£2,600**, which consists of the following:

Considering the applicant's statement and preparing a counterstatement	£400
Preparing evidence and considering the applicant's evidence	£1000
Preparing for and attending a hearing	£1200

108. I order Dassault Aviation to pay BAE SYSTEMS plc the sum of **£2,600**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 28th day of January 2026

**James Hopkins
For the Registrar**