

O/0892/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS. UK00004005227 AND UK00004044635

BY EMIRATES PERFUMES LTD

TO REGISTER THE TRADE MARKS:

Fragrances of Emirates

IN CLASS 3

AND



IN CLASSES 3 AND 35

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NOS. 447478 AND 449180

BY EMIRATES

BACKGROUND AND PLEADINGS

1. On 22 January 2024, Emirates Perfumes Ltd (“the applicant”) applied to register the trade mark UK00004005227 (the “**227 Mark**”) shown on the cover page of this decision in the UK. The application was published for opposition purposes on 16 February 2024, and the applicant seeks registration for the following goods:

Class 3 Perfume; Fragrances; Perfume oils; Aftershave lotions; Aftershaves; Body fragrances; Cologne; Cosmetics; Fragrance preparations; Household fragrances; Oils for perfumes and scents; water Perfumed; soaps; Perfumeries; Perfumery; Perfumery and fragrances; Perfumery products; Perfumes; Room fragrances; Room perfume sprays; Scents.

2. On 27 April 2024, the applicant applied to register the figurative trade mark UK00004044635 (the “**635 Mark**”) shown on the cover page of this decision in the UK. The application was published for opposition purposes on 17 May 2024, and the applicant seeks registration for the following goods and services:

Class 3 Perfume; Fragrances; Perfume oils; Aftershave lotions; Aftershaves; Body fragrances; Cologne; Cosmetics; Fragrance preparations; Household fragrances; Oils for perfumes and scents; water Perfumed; soaps; Perfumeries; Perfumery; Perfumery and fragrances; Perfumery products; Perfumes; Room fragrances; Room perfume sprays; Scents; incense; hair spray; room fragancing preparations; shampoos; soap.

Class 35 Marketing research in the fields of cosmetics, perfumery and beauty products; Retail services relating to perfumes.

3. The applications were both fully opposed by Emirates (“the opponent”) on 14 May 2024 and 19 August 2024.

4. The oppositions are based upon sections 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under section 5(3), the opponent relies upon the following marks:

EMIRATES

Comparable UK trade mark (EU) registration no. UK00912333209

Filing date 21 November 2013; Registration date 12 January 2016.

(the First Earlier Mark)



Comparable UK trade mark (EU) registration no. UK00914230163

Filing date 10 June 2015; Registration date 23 October 2015.

(the Second Earlier Mark)

5. I bear in mind that both of the opponent's marks are comparable marks. Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

6. Under section 5(3), the opponent relies upon all of the services for which its First Earlier Mark is registered, and some of the services for which its Second Earlier Mark is registered, as contained in Annex 1 to this decision. The opponent claims that its marks are strongly distinctive due to their extensive use for airline services in the UK, and in light of the opponent's reputation and the distinctive element of the parties' marks (that being "EMIRATES") being identical, that there is a likelihood that the public will believe that the goods and services "offered under the contested mark[s] originate from the opponent or an economically linked undertaking". The opponent claims that

the applicant will benefit from the opponent's investment in its advertising, which will "advantage the applicant without any investment", and therefore "the applicant is likely to gain sales, goodwill and enhanced status with its customers as a result of association" with the opponent's marks. The opponent claims that it will be easier for the applicant to sell its good as the reputation established by the opponent will attach to the applicant's mark, and that this "will be detrimental to the distinctive character and reputation" of the earlier marks because they "will no longer signify origin". The opponent also claims that the "power of attraction of the opponent's mark will be reduced" and that it will "be diluted by concurrent use of a closely similar mark", as well as there being "damage to the opponent's reputation if inferior or different goods and services are provided to those expected by the public".

7. Under section 5(4)(a), the opponent relies upon its **EMIRATES** sign which it claims to have used throughout the UK since at least 1 October 2019 for the retail of fragrances, cosmetics and skincare. The opponent claims that use of the applicant's mark would be contrary to the law of passing off.

8. The applicant filed a counterstatement denying the claims made, requesting that the opponent provide proof of use of First and Second Earlier Marks.

9. The opponent is represented by HGF Limited and the applicant is represented by Abion UK Limited.¹ Both parties filed evidence in chief. Neither party requested a hearing, however, both parties filed submissions in lieu. I make this decision having taken full account of all the papers.

RELEVANCE OF EU LAW

10. 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

¹ The applicant's Form TM8 and counterstatement was filed by Lane IP, which has since been absorbed by Abion UK Limited.

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

11. The opponent's evidence consists of the witness statement of Jori Bindels dated 20 September 2024. Mr Bindels has "served as the Vice President, Corporate Communications, and Marketing & Brand since December 2014". Mr Bindels' statement is accompanied by 13 exhibits (JB1-JB13).

12. The applicant's evidence consists of the witness statement of Jennifer Hitchcock dated 24 February 2025. Ms Hitchcock is a Chartered Trade Mark Attorney at Abion UK Limited, the representatives for the applicant. Ms Hitchcock's statement is accompanied by 7 exhibits (JH1-JH7).

13. Whilst I do not propose to summarise them here, I have taken all of the evidence and the parties' submissions into consideration in reaching my decision and will refer to them where necessary below.

DECISION

Section 5(3)

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

"5(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark."

15. Section 5(3A) of the Act states:

“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.”

16. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L'Oréal SA & Ors v Bellure & Ors* (Case C-487/07), *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09) and *Environmental Manufacturing LLP v OHIM* (Case C-383/12 P). The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph

68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oréal*, paragraph 44.

(g) 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.

(h) 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.

(i) 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.

(j) 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; *Interflora*, paragraph 74, and the court's answer to question 1 in *L'Oréal*.

17. The conditions of section 5(3) are cumulative. Firstly, the opponent's and applicant's marks must be identical or similar. Secondly, the opponent must show that its earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must have established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the opponent's marks being brought to mind by the later marks. Fourthly, assuming that the first, second and third conditions have been met, section 5(3) requires that one or more types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be 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.

18. The relevant date for the assessment under section 5(3) is the date of application of the applicant's marks i.e. 22 January 2024 and 27 April 2024 respectively.

Similarity of the marks

19. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall

impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

20. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

21. The respective trade marks are shown below:

Opponent’s marks	Applicant’s marks
EMIRATES (the First Earlier Mark)  (the Second Earlier Mark)	Fragrances of Emirates (227 Mark)  (635 Mark)

22. I bear in mind that the First Earlier Mark and the 227 Mark are word marks, and therefore their registration covers use in any standard typeface, including presenting the mark in upper and lower-case, or title-case.

23. The opponent’s First Earlier Mark consists of the word “EMIRATES”. There are no other elements to contribute to the overall impression which lies in the word itself. The Second Earlier Mark consists of the word “Emirates” presented in a slightly stylised white title-case typeface, underneath a white intricate abstract device, all of which is presented against a red rectangular background. I find that the word “Emirates” plays

a greater role in the overall impression, with the stylisation, abstract device and background playing a lesser role.

24. The applicant's 227 Mark consists of the words "Fragrances of Emirates". As I will come to discuss, these words have a unitary meaning, and therefore, the overall impression lies in the mark as a whole.

25. The 635 Mark consists of the words "Emirates" and "Perfumes" presented in a slightly bolded, gold, minimally stylised title-case typeface. In between these words, is a device which the average consumer is likely to see as a decorative circular perfume bottle, which is descriptive of its goods and services. The word "LONDON" is presented underneath in a much smaller and minimally stylised capitalised gold typeface, which will be recognised as the capital of England, and will be seen as denoting where the applicant's company is based. Bearing in mind that the eye is naturally drawn to the element of the mark that can be read, I find that the device will play a lesser role in the overall impression. I also find that due to its size and placement at the bottom of the mark, the smaller word "LONDON" will play a lesser role. As I will come to discuss, the words "Emirates Perfumes" in the 635 Mark have a unitary meaning, which I therefore find that these words play a greater role in the overall impression of the mark.

26. Visually, the First Earlier Mark is wholly contained within both of the applicant's marks. However, the applicant's 227 Mark begins with the words "fragrances of", and the applicant's 635 mark contains the words "perfumes" and "LONDON", and the decorative circular perfume bottle device. These act as visual points of difference. I therefore find that the First Earlier Mark and the applicant's 227 Mark are visually similar to above a medium degree. I also find that the First Earlier Mark and the 635 mark are visually similar to no more than a medium degree.

27. In regard to the Second Earlier Mark and the applicant's marks, I note that they all contain the word "Emirates". However, the Second Earlier Mark consists of the white intricate abstract device and the red rectangular background. The applicant's 227 Mark begins with the words "fragrances of", and the 635 mark contains the words "perfumes" and "LONDON", and the decorative circular perfume bottle device. Consequently, I

consider that the Second Earlier Mark and the applicant's 227 Mark and 635 mark are visually similar to between a low and medium degree.

28. Aurally, the word "Emirates" will be pronounced identically in all of the parties' marks. However, the words "Fragrances of" and the words "perfumes" and "LONDON" in the applicant's marks (all of which will be given their ordinary dictionary pronunciation), act as aural points of difference. The perfume bottle device in the 635 mark, and the white intricate abstract device and the red rectangular background in the Second Earlier Mark will not be articulated by the consumer. I therefore find that all of the marks are aurally similar to a medium degree.

29. Conceptually, I bear in mind that the word "Emirates" in all of the marks would be recognised by the average consumer as shortening of the geographical location the "United Arab Emirates". I therefore find that the First and Second Earlier Marks conveys to the consumer that the opponent's airline and air transportation services are from the geographical location of the United Arab Emirates.

30. In regard to the Second Earlier Mark, at paragraph 55 of its submissions in lieu, the opponent submits that the device within the Second Earlier Mark is "the Arabic characters for 'emirates' in calligraphy", but the majority of the public is unlikely to ascribe a meaning to the Arabic characters". I bear in mind that the average consumer is the UK general public, and they may recognise that the intricate device consists of foreign language characters. Nevertheless, the characters will not be attributed any identifiable meaning by the average consumer and will not, therefore, contribute to the conceptual meaning conveyed by the mark. The red rectangular background will also not contribute to the conceptual meaning of the Second Earlier Mark.

31. The words "Fragrances" and "Perfumes" in the applicant's marks are descriptive of the applicant's goods and services. However, I also note that as a whole, the wording "Fragrances of Emirates" and "Emirates Perfumes" in the applicant's marks forms a unit, which conveys to the consumer that the applicant's fragrances and perfumes come from the United Arab Emirates. The perfume bottle device in the 635 Mark reinforces the above conceptual message, and is again, descriptive of the goods and services. As noted above, I also find that the word "LONDON" at the end of the

applicant's 635 Mark will be recognised as the capital of England, and will also be seen denoting where the applicant's company is based.

32. Therefore, taking all of the above into account, on the basis that all of the parties' marks contain the word "Emirates", which conveys where the parties' goods and services are from (that being the geographical location of the United Arab Emirates), I find that as a whole, they are conceptually similar to a medium degree.

Reputation

33. In *General Motors*, Case C-375/97, the CJEU held that:

"25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

34. In determining whether the opponent has demonstrated a reputation for the services in issue, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with the services. In reaching this decision, I must take all of the evidence into account including "the market share held by the trade

mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertakings in promoting it.”

35. The EMIRATES airline was launched in 1984, with its first flights operating from Dubai in October 1985. Mr Bindels states that “Emirates is often reviewed as the most valuable Middle Eastern airlines brand, and 4th most valuable airline brand globally”.²

36. In regard to the UK, the airline has been operating since 1978, with flights to and from London Gatwick.³ Mr Bindels confirms that the airline flies to and from 6 destinations in the UK, namely:

- 1) Birmingham – launched in 2000
- 2) Edinburgh – launched in 2018
- 3) Glasgow – launched in 2004
- 4) London – launched in 1991
- 5) Manchester – launched in 1990
- 6) Newcastle – launched in 2007

37. Mr Bindels states that Emirates has carried over 21 million passengers to and from the UK in 2018 to 2023, a breakdown of which has been provided as follows:

Calendar Year	Passenger numbers – EMIRATES flights to/from the UK
2018	In excess of 5 million
2019	In excess of 5 million
2020	In excess of 1 million
2021	In excess of 1 million
2022	In excess of 4 million
2023	In excess of 5 million

38. Mr Bindels highlights that the figures for 2020 and 2021 reflect the disruption of air travel due to the COVID 19 pandemic. He also highlights at paragraph 14 of his witness statement that “Emirates is currently the largest non-European airline

² Paragraph 7 of his witness statement.

³ Paragraph 9 of his witness statement.

operating to the UK in terms of seat capacity, with 131 weekly passenger flights to seven UK airports, carrying 5.3 million passengers to and from the UK in 2023”.

39. In regard to turnover, I note that the airline’s total revenue for the financial year 2023 to 2024 was AED 121.2 billion (US\$ 33 billion).⁴ I have also been provided with Emirates’ total revenue for the financial year 2022 to 2023 which was AED 107.4 billion (US\$ 29.3 billion).⁵ Moreover, the Airline’s estimated brand value for 2024 grew to USD 6.6 billion, from USD 5.1 billion in 2023.⁶ I find it likely that these are the opponent’s international or worldwide figures, on the basis that at paragraph 12 of his witness statement, he confirms that “the Airline’s turnover in the UK is generally in excess of £1 billion per calendar year. The Airline’s turnover was impacted by the COVID-19 pandemic in 2020 and 2021. Notwithstanding this disruption, approximate turnover in the UK for the EMIRATES airline services for the calendar years 2018-23 was well in excess of £6 billion. Turnover figures have been provided in general terms being commercially sensitive information”. I also note that at paragraph 36 of his witness statement, Mr Bindels confirms that “the airline has provided retail and onboard duty free services since the 1990s”,⁷ and therefore passengers flying to and from the UK on EMIRATES flights have access to the Airline’s retail services, which includes the retail of fragrances and cosmetics.⁸ However, I bear in mind that under section 5(3), the opponent only relies upon its class 39 services, contained in Annex 1 to this decision.

40. Mr Bindels has provided the following list of the airline’s UK sponsorships:

- a) A shirt partnership with the Arsenal Football Club since the 2006-07 season;
- b) Naming rights to Arsenal FC’s home ground, the EMIRATES Stadium, until 2028;
- c) Title sponsor of the FA Cup, the oldest domestic club competition in the world since the 2015-16 season (up to 2028);
- d) Official Airline Partner of The Championships, Wimbledon since 2024;

⁴ Paragraph 5 of Mr Bindels’ statement and **exhibit JB1** which contains the opponent’s “Annual Report”.

⁵ **Exhibit JB1**, the airline’s annual report.

⁶ Paragraph 7 of his witness statement.

⁷ Paragraph 28 of his witness statement.

⁸ Paragraph 36 of his witness statement.

- e) Naming rights to the world famous Old Trafford cricket ground, the EMIRATES Old Trafford, until 2029;
- f) A shirt sponsor of the Lancashire Lightning T20 team since 2013.

41. These sporting sponsorships are also listed in the opponent's "Emirates and the UK" factsheet contained in **exhibit JB4**, which Mr Bindels dates as being from 2023.

Exhibit JB4 also contains the following evidence:

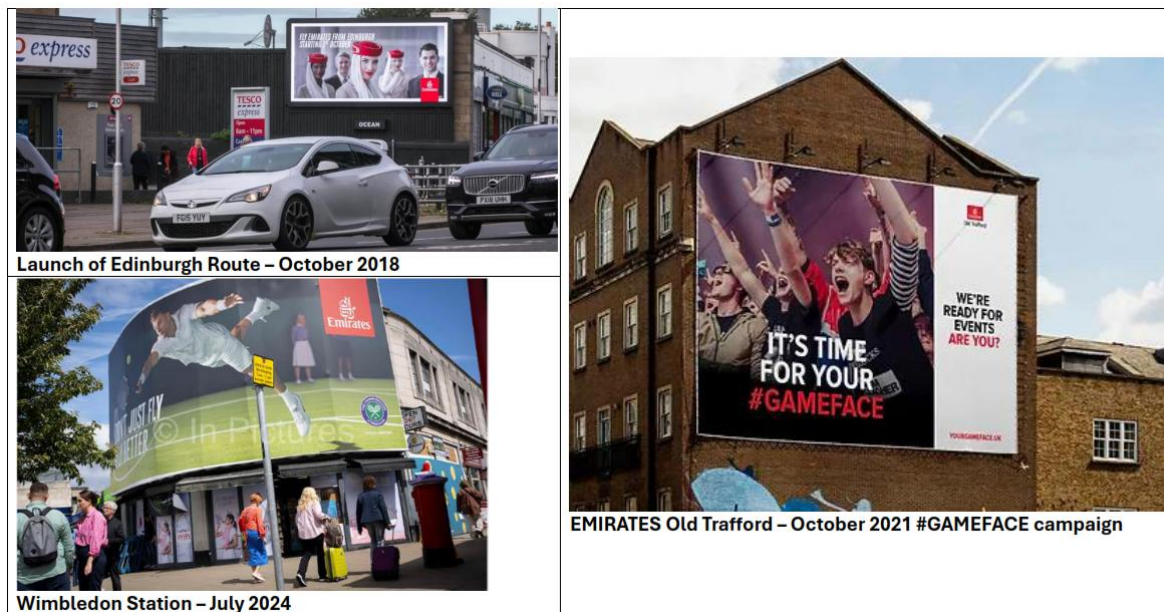
- a) Photographs from articles dated 2022 which show the EMIRATES STADIUM affixed with the Second Earlier Mark and the Arsenal shirts affixed with the words "Emirates FLY BETTER".
- b) A photograph from a 2024 article which shows a "Emirates FA CUP" banner with the 2024 winners, Manchester United.
- c) An undated photograph of the Old Trafford cricket ground, with the wording "Fly Emirates" affixed to a balcony.
- d) A photograph from a 2021 article of the Lancashire Lightning T20 cricket team wearing a top affixed with the words "Emirates FLY BETTER".
- e) An undated photograph from the Championships, Wimbledon, showing a photograph background using an "Emirates" mark.

42. Mr Bindels states that the above list of UK sponsorships is not exhaustive, and that its spend in the UK is over £50 million per annum on sponsorship activities, which does not include other advertising spend in the UK, which is generally "well in excess of £60 million".⁹ I have also been provided with examples of advertising materials used for the Airline's 'Premium Corporate Brand' campaign that was run in the UK between 27 May and 30 June 2019, including:



⁹ Paragraph 17 of his witness statement.

43. The above advertising has been extracted from **exhibit JB6** which contains a brochure on the brand campaign which was to be shown via “paid media channels; digital”. The exhibit also contains the following images of “three EMIRATES billboards *in situ* in the UK”.¹⁰



44. Mr Bindels has also provided a list of the opponent’s “international promotional activities and sponsorships” which include:

- 1) Shirt partnerships with AC Milan and Real Madrid;
- 2) Official Airline Partner of the Australian Open, Roland Garros, US Open and ATP Tour;
- 3) Main sponsor of the Emirates Elite ICC Panel of Umpires and Referees since 2002;
- 4) Official Partner and Airline of the final stage of the DP World Tour.

45. However, I bear in mind that I have no supporting evidence to show how the opponent’s marks were used as part of those sponsorship deals. Mr Bindels also states that he does not have “specific audience numbers for events sponsored by the airline in the UK and internationally”. However, I have been provided with articles that refer to the global estimated audiences for the 2022 FA Cup final and the 2022 Grand

¹⁰ Paragraph 22 of Mr Bindels’ witness statement.

Slam tennis season contained in **exhibit JB5**. The global audience for the FA Cup final was estimated at 500 million fans, and approximately 285 million fans tuned into the Wimbledon Grand Slam matches.

46. Mr Bindels has provided screenshots from bbc.co.uk, showing 35 results from searching “emirates” contained in **exhibit JB7**, including, for example, as follows:

Emirates



Dubai airlines resume full schedule after flooding chaos

Middle East · 20 Apr



Fire engines called as smoke seen when plane lands

4 Jul 2023

Birmingham & Black Country



Airbus A380 'superjumbo' touches down in Glasgow

Scotland · 26 Mar 2023



Giant A380 passenger plane to return to Glasgow

Scotland business · 13 Jan 2023



Plane refuelling staff to strike at Heathrow



Emirates to cap Heathrow summer ticket sales



Emirates refuses Heathrow's demand to cut flights



Emirates will fly to Russia unless owner stops it

47. Whilst I have not been provided with the contents of these articles, I nevertheless note that they clearly show the word “Emirates” affixed to the side of the opponent’s aeroplanes. Lastly, Mr Bindels has provided the following non-exhaustive list of awards won by EMIRATES from 2018 to 2023 for its airline services:¹¹

Calendar Year	Award
2018	Air Transport Awards – Airline of the Year
2019	Sunday Times Top Brands Awards – Best International Airline
2020	The Times and Sunday Times Travel Awards – Best Long-Haul Airline
2022	Skytrax World Airline Awards – World's Best Economy Class, World's Best Economy Class Catering and World's Best Inflight Entertainment
2023	Telegraph Travel Awards – Best Long Haul Airline

¹¹ Paragraph 26 of his witness statement.

48. Mr Bindles states that from 2018 to date, EMIRATES has been “the recipient of at least 30 awards”, and **exhibit JB8** provides article evidence in regard to 5 awards listed in the table above. I also bear in mind that these articles all appear to be published on “.com” websites, which can be accessed worldwide.

My assessment of the evidence

49. I note that the First and Second Earlier Marks are comparable UK trade marks (EU). Therefore, I can consider the evidence that pertains to the EU until IP Completion Day (31 December 2020), and the UK, in order to determine its reputation in both territories. However, I also remind myself that a link has to be made in the mind of the UK relevant public¹² and therefore I will focus on the opponent’s UK evidence only.

50. Based on the above evidence, it is clear that the opponent is an international airline, which has operated out of at least 5 airports in the UK for between 34 and 17 years prior to the relevant dates.¹³ In regard to the opponent’s UK turnover figures, as highlighted by paragraph 39 above, its turnover in the UK is generally in excess of £1 billion per calendar year. However, notwithstanding the disruption from the COVID 19 pandemic, the opponent’s approximate turnover in the UK for EMIRATES airline services for the calendar years 2018-23 was well in excess of £6 billion. I note that the term “airline services” appears in both the First and Second Earlier Mark’s class 39 specifications, and that the opponent’s turnover is clearly significant.

51. I have been provided with supporting evidence in regard to the number of passengers that have been on Emirates flights to and from the UK, which between 2018 to 2023, amounts to over 21 million Emirates passengers. I bear in mind that the opponent has not provided a breakdown of how many of these passengers were from the UK. However, based on the aforementioned UK sales figures, and the destination or departure point of its passengers, it would be reasonable to infer that a significant proportion of passengers were from the UK. I also consider that on the basis the opponent operates 6 airports, that being Birmingham, Edinburgh, Glasgow, London,

¹² *China Construction Bank Corporation v Groupement Des Cartes Bancaires*, (Case BL O/281/14)

¹³ The sixth UK airport, being Edinburgh, was launched in 2018.

Manchester and Newcastle, its passengers are likely to be geographically spread across the UK.

52. I also note that I have been provided with the opponent's general UK sponsorship figure per annum, that being £50 million, which is indeed significant. To support this, I have been provided with a list of the airline's UK sponsorships by Mr Bindel, accompanied by photographic evidence showing how they were presented to the public and approximate viewing figures for some of these sporting events. This includes the FA cup final which reaches a global audience estimated at 500 million, and Wimbledon, of which approximately 285 million fans tuned into the Wimbledon Grand Slam matches. Whilst these viewing figures have not been broken down by territory, I consider that a significant proportion UK consumers would watch these large sporting events, especially as both are held in the UK.¹⁴ Furthermore, I have been provided with accompanying photographs from these events showing the earlier marks clearly being used on banners and backdrops, as well as on other sponsorship shirts and stadiums, including the Arsenal kit and its home ground the EMIRATES Stadium, and the Lancashire Lightning T20 team's shirts and the EMIRATES Old Trafford cricket ground. I bear in mind that the opponent has been Arsenal's shirt sponsorship since the 2006-07 season, which is over 17 years before the relevant dates. The sponsorships are for very large and well-known events which would have incurred significant marketing expenditure for the opponent, as reflected by its aforementioned annual sponsorship spend.

53. In regard to other marketing methods, I note that Mr Bindles' confirms that the advertising spend other than sponsorship in the UK is generally "well in excess of £60 million". I have been provided with advertising materials "used for the Airline's 'Premium Corporate Brand' campaign, which was run between 27 May and 30 June 2019, albeit I note that this was ran for a very short period of time, being less than a month long. In regard to the billboard photographs provided, the Old Trafford billboard shows people at what appears to be a concert, and there is no reference to flying. The Wimbledon billboard is dated July 2024, and therefore falls after both relevant dates. However, the Edinburgh route billboard from 2018 appears to show a photo of an

¹⁴ The FA Cup is the oldest domestic club competition in England, and Wimbledon is hosted in London.

Emirates Airline crew, using the Second Earlier Mark in the bottom right-hand corner. However, the opponent does not confirm how long its billboard was erected for.

54. Mr Bindle has also provided evidence of awards won by the opponent, which are in relation to the opponent being the “Airline of the Year”, the “Best International Airline” and the “Best Long Haul Airline”. Whilst these awards have been reported on websites that can be accessed worldwide (and not UK specific websites e.g. “.co.uk”), I nevertheless note that the awards themselves have been presented by The Times, The Sunday Times and The Telegraph which are all large UK publications. I also find that to win such accolades is clearly noteworthy.

55. Therefore, taking all of the above into account, I am satisfied that the opponent has demonstrated a strong reputation in the UK in relation to the First and Second Earlier Mark’s following services:

Class 39 Airline services; air transportation services.¹⁵

Link

56. As I noted above, my assessment of whether the public will make the required mental ‘link’ between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

57. I have found the level of visual, aural and conceptual similarity between the parties’ marks at paragraphs 26 to 32 above.

58. I remind myself that, conceptually, the word “Emirates” in all of the marks would be recognised by the average consumer as shortening of the geographical location the “United Arab Emirates”. I therefore find that use of the “Emirates” element within

¹⁵ I note that the opponent proposes the same fair specification at paragraph 34 of its submissions in lieu.

all of the marks conveys where the parties' goods and services are from, that being the geographical location of the United Arab Emirates.

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

59. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, 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."

60. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

61. For the purposes of considering the issue of similarity of the parties' goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

62. 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 GC 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 the responsibility for those goods lies with the same undertaking."

63. In *Sanco SA v OHIM*, Case T-249/11, the GC 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, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. (as he then was) noted, as the Appointed Person, 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."

Whilst on the other hand:

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.” Whilst on the other hand: “... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

64. While I bear in mind that the above cases are usually applied in the context of a section 5(2)(b) claim, I find that they can be considered, and are useful, when assessing the similarity of the parties' goods and services in the context of section 5(3).

65. The parties' competing goods and services are as follows:

Opponent's services	Applicant's goods and services
The First and Second Earlier Mark <u>Class 39</u> Airline services; air transportation services	The 227 Mark <u>Class 3</u> Perfume; Fragrances; Perfume oils; Aftershave lotions; Aftershaves; Body fragrances; Cologne; Cosmetics; Fragrance preparations; Household fragrances; Oils for perfumes and scents; water Perfumed; soaps; Perfumeries; Perfumery; Perfumery and fragrances; Perfumery products; Perfumes; Room fragrances; Room perfume sprays; Scents. The 635 Mark <u>Class 3</u> Perfume; Fragrances; Perfume oils; Aftershave lotions; Aftershaves; Body fragrances; Cologne; Cosmetics;

	Fragrance preparations; Household fragrances; Oils for perfumes and scents; water Perfumed; soaps; Perfumeries; Perfumery; Perfumery and fragrances; Perfumery products; Perfumes; Room fragrances; Room perfume sprays; Scents; incense; hair spray; room fragrancng preparations; shampoos; soap. <u>Class 35</u> Marketing research in the fields of cosmetics, perfumery and beauty products; Retail services relating to perfumes.
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Perfume; Fragrances; Perfume oils; Aftershave lotions; Aftershaves; Body fragrances; Cologne; Cosmetics; Fragrance preparations; Household fragrances; Oils for perfumes and scents; water Perfumed; soaps; Perfumeries; Perfumery; Perfumery and fragrances; Perfumery products; Perfumes; Room fragrances; Room perfume sprays; Scents; Incense; room fragrancng preparations.

66. The above goods found within the 227 Mark's and 635 Mark's specifications clearly do not overlap in nature, purpose or method of use with the opponent's airline services and air transportation services.

67. I do not consider there to be an overlap in trade channels, and there is no evidence before me to show that airline undertaking's produce and sell their own branded perfumes and fragrances. The goods and services are not in competition nor complementary in the way described by the case law cited above. Albeit there is an overlap in user, that being the general public, this is not enough on its own to establish similarity. I find the parties' goods and services to be dissimilar.

Hair spray; shampoos; soap.

68. The 635 Mark's above hair goods clearly do not overlap in nature, purpose or method of use with the opponent's airline services and air transportation services. I do not consider there to be an overlap in trade channels, and there is no evidence to show that airline undertaking's produce and sell their own branded hair and toiletry goods. The goods and services are clearly not in competition nor complementary. Albeit there is an overlap in user, this is not enough on its own to establish similarity. I find the parties' goods and services to be dissimilar.

Retail services relating to perfumes.

69. The 635 Mark's above services do not overlap in nature, method of use or purpose with the opponent's airline services and air transportation services. However, I consider that there may be an overlap in trade channels on the basis that airline undertakings usually provide retail services in relation to goods such as perfumes, which are sold on the plane. There will also be an overlap in user. However, the services are neither in competition nor complementary. I therefore consider that the parties' services are similar to a low degree.

Marketing research in the fields of cosmetics, perfumery and beauty products.

70. Without any evidence before me, I do not consider that the 635 Mark's above services overlap in nature, method of use, purpose or trade channels with the opponent's airline services and air transportation services. They are neither in competition nor complementary. They do not overlap in user, on the basis that the applicant's above services would be provided to professional users, whereas the opponent's services would be used by the general public. Consequently, I find the parties' services to be dissimilar.

The strength of the earlier mark's reputation

71. As noted in paragraph 55 above, the First and Second Earlier Marks have a strong reputation for class 35 airline services and air transportation services.

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

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

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

73. I bear in mind that the applicant has filed evidence, that being **exhibits JH4 to JH6**, which contain screenshots showing third party undertakings selling fragrance goods under the word “Emirates” dated 24 February 2025. This evidence also contains a screenshot in regard to the “Emirates Perfumes and Oud exhibition” which was said to take place in October 2025. I bear in mind that all of the screenshots are dated after the filing dates of the applicant's marks (i.e. the relevant dates). Therefore, I am unable to ascertain whether the undertakings were in operation before the relevant date (and/or how long for). On this basis, I find that the evidence before me does not enable

me to assess how many members of the relevant public (if any) would have come into contact with these marks prior to the relevant dates. Consequently, I do not consider that the evidence sufficiently shows that the distinctive character of the word “Emirates” has been weakened because of its frequent use in the fields concerned. The evidence does not assist the applicant.

74. I note that the First and Second Earlier Marks are composed of the word “EMIRATES”, which, as highlighted above, would be recognised by the average consumer as a shortening of the geographical location the “United Arab Emirates”. At paragraph 6 of its submissions in lieu, the applicant submits that the word “Emirates” is low in distinctiveness, as it would be seen as alluding to the place the United Arab Emirates, where the goods originate, or where the provider of the goods and services operates from. I agree that the word “EMIRATES” will be perceived by the customer that the opponent’s airline and air transportation services are from the geographical location of the United Arab Emirates. I therefore find that the First Earlier Mark is inherently distinctive to between a low and medium degree.

75. The Second Earlier Mark also consists of the word “EMIRATES” presented in a slightly stylised white title-case typeface, underneath a white intricate abstract device, all of which is presented against a red rectangular background. As noted above, I have found that the UK general public may recognise that the intricate device consists of foreign language characters. Nevertheless, the characters will not be attributed any identifiable meaning by the average consumer and will not, therefore, contribute to the conceptual meaning conveyed by the mark. The red background also does not add to the conceptual meaning of the mark. I therefore consider that the Second Earlier Mark is inherently distinctive to no more than a medium degree.

76. As noted above, I have found that the First and Second Earlier Marks have a strong reputation for the aforementioned services. I recognise that reputation is not the same as enhanced distinctive character, but the same factors are to be taken into account in both assessments.¹⁶ Therefore, I find that the evidence is, for the reasons set out above in relation to reputation, sufficient to establish enhanced distinctiveness of the

¹⁶ *O2 Worldwide Limited v CX02.COM (UK) Limited*, BL O/393/19, paragraph 39

First and Second Earlier Marks. I find that the distinctiveness of the First Earlier Mark has been enhanced to a between a medium and high degree for its airline services and air transportation services. I find that the distinctiveness of the Second Earlier Mark has been enhanced to a very high degree for its airline services and air transportation services.

Whether there is a likelihood of confusion

77. In this case, I consider that, where used in respect of goods and services which are similar to a low degree, the applicant's "Emirates Perfumes" mark being used for "retail services relating to perfumes" will be seen as a brand extension of the opponent's "EMIRATES" marks (the inherent distinctiveness of which has been enhanced for its "airline services" and "air transportation services"), resulting in indirect confusion.

78. I am now required to determine whether, in this particular case, the relevant public would bring the opponent's marks to mind when confronted with the applicant's marks. That is, to make a link between them.

79. I bear in mind that the closeness of the goods and services is a factor to be taken into account when considering if the use of the later mark would bring the earlier marks to mind.

80. As highlighted above, the opponent's reputation vests in its airline and air transportation services, which I have found to overlap in trade channels and user with the applicant's 635 Mark's retail services relating to perfumes. Whilst I have also found that the meaning of the word "EMIRATES" is inherently distinctive to between a low and medium degree, as it conveys to the consumer that the opponent's airline and air transportation services are from the geographical location of the United Arab Emirates, the distinctiveness of the opponent's marks have been enhanced, and the opponent has a strong reputation which resides in this word. The word "EMIRATES" is also contained in the applicant's marks, and the remaining word element in the applicant's 635 Mark, being "Perfume", and the decorative perfume bottle device in the applicant's 635 Mark is descriptive of the applicant's perfume related goods and services. The

word “LONDON” at the end of the applicant’s 635 Mark, which will be recognised as the capital of England, will also be seen to consumers as denoting where the applicant’s company is based.

81. Therefore, taking all of the above into account, I find that the relevant public would call the opponent’s marks to mind on seeing (or hearing) the applicant’s 635 Mark being used in relation to “retail services relating to perfumes”. I find that the UK relevant public would make a link between the First and Second Earlier Marks and the applicant’s 635 Mark, due to the use of the word “EMIRATES” in all of the parties’ marks.

82. For the applicant’s 227 and 635 Marks’ class 3 perfume, fragrance and toiletry goods and class 35 marketing research in the fields of cosmetics, perfumery and beauty products services, I have found these are entirely different in nature, method of use, purpose, and trade channels with the opponent’s airline and air transportation services. I have therefore found the goods and services to be dissimilar based on the factors identified in *Treat*. I also remind myself that there is no evidence before me to show or suggest that an airline would sell its own branded perfume, fragrance and toiletry goods, nor that they would provide marketing research in the field of cosmetics, perfumes and beauty products.

83. Therefore, notwithstanding the fact that the parties’ marks share the word “EMIRATES”, the distinctiveness of which has been enhanced, and that the goods are likely to overlap in user (with the services not overlapping in user), I nevertheless find that the parties’ goods and services are too removed from one another. Even though the opponent’s reputation is strong for airline and air transportation services, I consider that the applicant’s goods and services are too far removed from what the opponent’s reputation vests in, and in light of this, I consider that upon encountering the marks, the relevant public is unlikely to make a link between them. The further removed the goods and services are from the field in which the opponent has a reputation, the less likely it is that the opponent will be brought to mind and the more likely it is that the use of the word EMIRATES will be understood as referring to a place (rather than having a connection with the opponent’s services). As I have found there to be no link between the marks in the minds of the relevant public in the UK, there can be no

resulting damage caused to the opponent's earlier marks. However, even if a link is made, it would be so fleeting that it would not suffice to result in an unfair advantage or damage to the opponent or its marks.

84. The opposition based upon section 5(3) wholly fails in regard to the applicant's 227 Mark and partially fails in regard to its 635 Mark. The opposition fails for the 635 Mark's following goods and services:

Class 3 Perfume; Fragrances; Perfume oils; Aftershave lotions; Aftershaves; Body fragrances; Cologne; Cosmetics; Fragrance preparations; Household fragrances; Oils for perfumes and scents; water Perfumed; soaps; Perfumeries; Perfumery; Perfumery and fragrances; Perfumery products; Perfumes; Room fragrances; Room perfume sprays; Scents; incense; hair spray; room fragancing preparations; shampoos; soap.

Class 35 Marketing research in the fields of cosmetics, perfumery and beauty products.

Damage

85. As noted above, the opponent also claims that the applicant will benefit from the opponent's investment in its advertising, "leading to advantage to the applicant without any investment", and therefore "the applicant is likely to gain sales, goodwill and enhanced status with its customers as a result of association" with the opponent's marks.

86. I also note that in *Argos Limited v Argos Systems Inc* [2018] EWCA Civ 2211, the Court of Appeal held that a change in the economic behaviour of the customers for the goods and/or services offered under the later trade mark was required to establish unfair advantage. This may be inferred where the later trade mark would gain a commercial advantage from the transfer of the image of the earlier trade mark to the later mark: see *Claridges Hotel Limited v Claridge Candles Limited & Anor* [2019] EWHC 2003 (IPEC).

87. Taking unfair advantage of the distinctive character or reputation of an earlier mark means that consumers are more likely to buy the services of the applicant's mark than they would otherwise have been if they had not been reminded of the earlier marks. Unfair advantage can be the result of the transfer of the image of the earlier mark, or of the characteristics it projects, to the goods or services identified by the later mark. The later mark will get a marketing or commercial 'leg-up' because the link with the earlier, reputed marks means that the owner of the later mark does not have to put as much effort into making the later mark known because it already feels familiar or sends a message to consumers as to what they can expect.

88. The image of the opponent's earlier "EMIRATES" marks evokes an award-winning airline brand. This is an attractive image from which the applicant's "Emirates Perfumes LONDON" 635 Mark will benefit in relation to its class 35 "retail services relating to perfumes". Furthermore, as noted above, the parties' marks share the word "EMIRATES", with the remaining elements within the 635 Mark being descriptive of the services or denoting where the applicant's company is based. I have also found that the opponent's airline services overlaps in trade channels and user with the applicant's "retail services relating to perfumes". I therefore consider that the relevant public will be more likely to use the applicant's services because there will be familiarity with the repute and image of the earlier marks. This means that the applicant's 635 Mark will benefit from the opponent's significant marketing efforts and expenditure, without having to invest at all, or as much, which would normally be required for a new mark, in order to achieve the level of sales it will gain because of the link. The change in consumer behaviour will produce an objectively unfair result by giving the applicant an advantage in relation to its class 35 services, because it is free-riding on the reputation of the First and Second Earlier Marks and the marketing efforts of the opponent.

89. As I have found there to be unfair advantage, I do not need to consider the other pleaded heads of damage. The opposition based upon section 5(3) of the Act succeeds for the following services of the 635 Mark:

Class 35 Retail services relating to perfumes.

Section 5(4)(a)

90. Section 5(4)(a) of the Act states as follows:

“5(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”.

91. Subsection (4A) of section 5 of the Act 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.”

92. 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)."

Relevant date

93. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated as follows:

"43. In *SWORDERS 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.'"

94. As the applicant has filed no evidence of use of its marks, I have only the prima facie relevant dates to consider i.e. 22 January 2024 and 27 April 2024.

Goodwill

95. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

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

96. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; 54 evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

97. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least *prima facie*, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

98. I bear in mind that under the section 5(4)(a) ground, the opponent states that it has used its earlier **EMIRATES** sign on the retail of fragrances, cosmetics and skincare. Specifically, passengers flying to and from the UK on EMIRATES flights have had access to the Airline's retail services, which includes the retail of fragrances and cosmetics. I note the following from the evidence provided by Mr Bindles:

- a) “The airline has provided retail and onboard duty free services since the 1990s”, with a large proportion of its sales residing “in perfume and beauty with sales of over AED 140 million per year (USD 38 million) in these categories”.
- b) “The airline's retail offering was reinvented in 2019 by launching EmiratesRED, a suite of retail services, available on EMIRATES flights globally”, and consists of a retail catalogue, inflight and pre-order retail services, [and] a dedicated website and TV channel”. Mr Bindles' states that **exhibit JB9** includes examples of the use of its EMIRATES sign being used in the context of the EmiratesRED suite of retail services. This exhibit contains the following:
 - a. An undated screenshot of the emiratesred.com website which describes EmiratesRED as a pre-order available on “most flights”.
 - b. An undated photograph of a flight attendant holding a bag affixed with the Second Earlier Mark. This is accompanied by a emirates.com hyperlink that I cannot access.
 - c. 2 screenshots from the Emirates RED magazine dated April and December 2023, which shows the following goods for sale:



- c) Mr Bindles states that the fragrances and beauty range on offer by the airline comprises of “approximately 200 products at any given time”, and these are features on the airline’s monthly EmiratesRED magazine. I have been provided with screenshots from the magazine and aforementioned website from June 2019 to December 2023. These are contained in **exhibit JB10**. I note that the above screenshots are also contained within this exhibit, as well as magazine pages which show perfumes and colognes, as well as serums, oils, creams, sunscreen and lipsticks, available for sale. These pages either show the above “Emirates RED” branding, or the top left-hand corner of the pages contains the wording “**EMIRATESRED**”. In regard to the website screenshots, the same goods appear for sale under the “beauty” tab, and the Second Earlier Mark is used in the top left-hand corner of the website.
- d) The Airline’s revenue from the sale of fragrances and cosmetics on flights to and from the UK between 1 July 2021 and 21 January 2023 has been broken down as follows:

Products sold for : 1 st July 2021 -21 st January 2023	Revenue – EMIRATES flights to/from UK (AED)
Fragrances	In excess of 17 million
Cosmetics	In excess of 4.4 million

- e) I have also been provided with the following breakdown of the above revenue made per direction of travel (to and from the UK):

EMIRATES flights - 1st July 2021 -21st January 2023	Revenue from sale of fragrances and cosmetics (AED)
Arriving to the UK	In excess of 12 million
Departing from the UK	In excess of 9 million

- f) At paragraph 39 of his statement, Mr Bindels states that the sale of fragrances and cosmetics is a “significant revenue generator” for the airline, and that the above sales “during a period of over 29 months during EMIRATES flights to and from the UK was very substantial”.
- g) At paragraph 40 of his statement, Mr Bindels states that “it is not possible to provide receipts or invoices in relation to sales of duty free goods on EMIRATES flights. However, all sales are logged on the Airline’s records, which includes information on the value of the item sold, units sold, date of sale and flight route under the “sector” column”. I have been provided with these records in **exhibit JB12**. The evidence clearly shows that the records have been extracted from the “Emirates – Cashier” system, and are dated from 24 January 2019 to 10 January 2024. They list the sale of the following goods including:
- Clarins New Double Serum 50ml
 - Jo Malone London Cologne
 - Creed Aventus EDP 100ml
 - Dr Levy Intense Eye Rescue 15ml
 - Hugo Boss Bottled Infinite Eau de Parfum, 100ml
 - Benefit BAD Gal Bang Duo Mascara set
 - Benefit Vanity Flare Nude Eyeshadow Palette
 - Midnight Recovery Concentrate by Kiehl’s 50ml
 - Roja Parfums Elixir EDP 100ml
 - Tom Ford Fabulous Private Blend Eau de parfum, 50ml
 - Ultra Facial Cream by Kiehl’s 50ml
 - Bulgari Man Wood Essence EDP 100ml

- m. Boadicea The victorious 100ml
 - n. Maison Rebatchi JASMIN SATIN EAU DE PARFUM 50ML
 - o. Blue Sapphire Eau de Parfum 100ml
 - p. YSL MYSELF MEN EDP 100ML
 - q. Shisedio clear suncare stick SPF50+
- h) The Clarins' double serum, the Jo Malone Cologne, Dr Levy Intense Eye Rescue, Shisedio clear suncare stick, Boadicea The victorious 100ml and the Maison Rebatchi JASMIN SATIN EAU DE PARFUM 50ML are all goods which are shown with the opponent's magazine and website evidence contained in **exhibit JB10**.
- i) Moreover, based on cross-referencing this evidence, the "ELIZABETH ARDEN eight hour beauty must haves" priced at "170.00" is likely to be the following item contained within the Emirates RED magazine dated October 2023:



- j) I note that the goods are only purchased in a singular quantity and that the price of the goods range between "65.00" to "1055.00". The record does not state what the currency price is, however, I find it reasonable to infer that it is in AED on the basis that all of the other prices provided by Mr Bindels have been in this currency.
- k) I also consider it reasonable to infer that the letters "EDP" next to some of the goods listed above stands for "Eau Du Parfum", which is particularly highlighted by these goods having millilitre measurements recorded next to this acronym.

- l) Lastly, I note that Mr Bindles' confirms that the airline offers exclusive third-party fragrances on its EMIRATES flights, including VOYA, an Irish beauty brand, who have curated a range of fragrances exclusively for the opponent in August 2024. However, the third-party article evidence in **exhibit JB11** confirms that VOYA branded skincare has been available for first and business class users since 2016.

99. Goodwill arises as a result of trading activities, and it is clear from the extracts from the "Emirates – Cashier" system that the opponent has been selling perfume and cosmetic goods since January 2019. I bear in mind that the opponent has sold third-party perfume and cosmetic goods, as demonstrated by the list contained in paragraph 98(g). Therefore, the opponent is providing a retail service selling third-party goods, rather than using its EMIRATES sign on perfume and cosmetic goods.

100. This cashier system evidence is supported by turnover figures, which confirms that from July 2021 to January 2023 the opponent has generated in excess of 17 million (AED) in turnover from the sale of fragrances, and in excess of 4.4 million (AED) in turnover from the sale of cosmetics on its EMIRATES flights to and from the UK. Whilst the figures are provided in (AED) and I have not been provided with a breakdown of where the passengers were from, it is nevertheless reasonable to infer that, based on the flight departure point or destination being the UK, a significant proportion of consumers would have been from the UK. I have also been provided with examples from the Emirates RED magazine dated before the relevant dates, showing perfume and cosmetic goods for sale, including those which were listed as sold through the "Emirates – Cashier" system. I am therefore satisfied that the opponent has demonstrated more than a modest degree of goodwill in relation to the retail of fragrances, cosmetics and skincare.

101. I bear in mind that all of the opponent's evidence shows use of the EMIRATES sign on the cashier system, that its sales were made whilst on an EMIRATES flight, and it is also used on the magazine and website evidence. Whilst I note that the magazine and website evidence also shows use of the EMIRATES sign in conjunction with the word "RED", these words do not create a new unitary meaning. On this basis, I consider that the word EMIRATES, which is clearly visible, plays an independent role

when it is used in conjunction with the word RED. On this basis, I find that the opponent's EMIRATES sign was distinctive of the opponent's goodwill at the relevant dates.

Misrepresentation

102. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. 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.”

And later in the same judgment:

“.... 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. I have found that the opponent has benefitted from a more than modest degree of goodwill at the relevant dates in relation to the retail of fragrances, cosmetics and skincare. These services are identical to the applicant's 635 Mark's "retail services relating to perfumes". Therefore, on the basis that the parties' services are plainly in the same field of activity, as well as the marks being similar (on the basis that the opponent's EMIRATES sign is fully replicated at the beginning of the applicant's 635 Mark), I consider that a substantial number of members of the relevant public would be misled into purchasing the applicant's services in the mistaken belief that they are the services of the opponent. Damage through diversion of sales is easily foreseeable.

104. In regard to the applicant's 227 and 635 Mark's class 3 goods, being fragrance, perfume and cosmetic goods, I find that they clearly relate to the same field of activity as the opponent's services (with the opponent's services facilitating the sale of the applicant's goods). In regard to the 635 Mark's remaining "marketing research in the fields of cosmetics, perfumery and beauty products", the only real point of overlap with the services of the opponent is that they all relate to fragrance and beauty products. However, I consider that the differences between the signs/marks are sufficient to avoid misrepresentation arising.

105. In terms of the parties' sign/marks, the opponent's "EMIRATES" sign appears in both the applicant's "Fragrances of Emirates" mark and its "Emirates Perfumes LONDON" mark (accompanied by the decorative perfume bottle device). Nevertheless, as noted above, the relevant public would understand the word "Emirates" as being a shortening of the geographical location the "United Arab Emirates". On this basis, the opponent's sign is lower in distinctiveness as it conveys to the consumer that the opponent's services are from the United Arab Emirates. Therefore, the additional elements within the applicant's marks, albeit descriptive, will nonetheless highlight to the public that these are two different undertakings who both happen to be using abbreviations of the United Arab Emirates as part of their trade names, to denote the geographical location of where its goods and services are from. I consider that this in combination with the greater distance between the parties' respective fields of activity means it is unlikely that misrepresentation would occur, or that damage would arise.

106. The opposition based upon section 5(4)(a) of the Act partially successful in regard to the applicant's 635 Mark's "retail services relating to perfumes" in class 3.

CONCLUSION

107. The opposition is partially successful under sections 5(3) and 5(4)(a) in respect of the following services, for which the **UK00004044635** mark is refused:

Class 35 Retail services relating to perfumes.

108. The **UK00004005227** and **UK00004044635** marks can proceed to registration in respect of the following goods and services for which the opposition has been unsuccessful:

UK00004005227

Class 3 Perfume; Fragrances; Perfume oils; Aftershave lotions; Aftershaves; Body fragrances; Cologne; Cosmetics; Fragrance preparations; Household fragrances; Oils for perfumes and scents; water Perfumed; soaps; Perfumeries; Perfumery; Perfumery and fragrances; Perfumery products; Perfumes; Room fragrances; Room perfume sprays; Scents.

UK00004044635

Class 3 Perfume; Fragrances; Perfume oils; Aftershave lotions; Aftershaves; Body fragrances; Cologne; Cosmetics; Fragrance preparations; Household fragrances; Oils for perfumes and scents; water Perfumed; soaps; Perfumeries; Perfumery; Perfumery and fragrances; Perfumery products; Perfumes; Room fragrances; Room perfume sprays; Scents; incense; hair spray; room fragancing preparations; shampoos; soap.

Class 35 Marketing research in the fields of cosmetics, perfumery and beauty products.

COSTS

109. In these proceedings, the applicant has enjoyed a greater degree of success and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant the sum of £1,200 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a counterstatement (x2)	£300
Considering the opponent's evidence and preparing and filing evidence	£600
Filing submissions in lieu	£300
Total	£1,200

110. I therefore order Emirates to pay Emirates Perfumes Ltd the sum of £1,200. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 30th day of September 2026

L FAYTER

For the Registrar

ANNEX 1

The First Earlier Mark

Class 39

Airline services; air transportation services; aircraft chartering services; courier services for cargo and passengers; cargo handling services; delivery of goods by air; customs clearing services; forwarding agency services in this class; freight brokerage and freight forwarding services; air navigation services; air traffic control services; airport handling services; information, and advisory services relating to all the aforesaid services being services in Class 39.

The Second Earlier Mark

Class 39

Airline services; air transportation services; provision of computerized travel information, airline information retrieval services; arranging of travel and transport reservation services; aircraft chartering services; travel tickets reservation services; courier services (messages or merchandise); delivery of newspapers; escorting of travellers; transport reservation; transportation information; travel reservation; limousine services; cargo transport services; cargo storage and handling services; wrapping of goods; arranging the transportation of goods and luggage, delivery of goods and luggage and storage of goods and luggage packing of goods; guarded transport services; provision of information, consultancy services, and advisory services relating to all the aforesaid services.