

**O/560/17**

**TRADE MARKS ACT 1994**

**TRADE MARK APPLICATIONS 3176112 & 3176115**

**BY WORLDVENTURES HOLDINGS, LLC**

**AND**

**OPPOSITIONS 407815 AND 407816**

**BY FLYBE LIMITED**

## Background and pleadings

1. WorldVentures Holdings, LLC (“the applicant”) filed trade mark applications 3176112 and 3176115 (“the contested marks”) on 22 July 2016. The ‘115 mark consists of the word **FLYE**. The ‘112 mark consists of a stylised version of the same word, which looks like this:



2. The applications claim the priority date of 13<sup>th</sup> July 2016 (“the relevant date”) based on slightly earlier filings of the same marks in the USA.

3. The applications cover a wide range of goods and services in classes 9, 16, 25, 35, 36, 38, 39, 41, 42, 43, 44 and 45, including travel agency services in classes 39 and 43.

4. The marks were published for opposition purposes on 19<sup>th</sup> August 2016.

5. Flybe Limited (“the opponent”) opposes the registration of the contested marks. There are two legal grounds of opposition based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994. These grounds are based on the opponent’s use and registration of the following marks.

EU 3422433

FLYBE (word mark). Registered in 2003. The opponent relies on the registration of this mark in relation to (broadly) printed publications in class 16 and air transport and travel agency services in class 39.

EU 13646211



EU 13646245



These marks were registered in 2015. The opponent relies on the registration of the marks in relation to goods/services in classes 16, 25, 35, 36, 39, 41 and 42.

6. The opponent claims that EU 3422433 has a reputation in relation to (broadly) air transport and travel agency services in class 39. It claims that the other two earlier marks also have a reputation in relation to these services and also (broadly) arranging hotel and holiday accommodation in class 43. The opponent claims that use of the contested marks in relation to any of the goods/services in the applications will lead the public to believe that there is a connection between the parties. It considers that such use would take unfair advantage of the reputation of the earlier marks.

7. The applicant filed counterstatements denying the grounds of opposition.

8. Both sides seek an award of costs.

9. The opposition proceedings were consolidated.

### **Representation**

10. The applicant is represented by Page White & Farrer, trade mark attorneys. The opponent is represented by Ashfords LLP, solicitors. A hearing took place on 6<sup>th</sup> October 2017. Mr Carl Steele appeared on behalf of the opponent. The applicant was not represented, but I have had the benefit of written submissions filed by Page White & Farrer in lieu of attending the hearing.

## Evidence

11. The opponent's evidence takes the form of two witness statements by Catherine Ledger, who is the General Counsel of the Flybe group of companies. The second of Ms Ledger's statements was filed in reply to the applicant's evidence described below.

12. In her first statement, Ms Ledger says that her company's airline was re-launched under the Flybe mark in 2002. The blue Flybe logo (EU 13646245) was first used in that year. The purple logo (EU 13646211) was first used in 2014.

13. In 2015-16, Flybe carried 8.2m passengers on 176 routes from 61 airports, 26 in the UK and 35 in Europe. 6.8m of these passengers started their journeys from UK airports. The company owned or leased 74 airplanes each of which carried the Flybe logo. Over the years 2011 to 2016, Flybe generated over £4.1 billion in income, £3.1 billion of which came from selling tickets for Flybe flights. The tickets are primarily sold directly to the public via the Flybe website. Historical examples of pages from the Flybe website are in evidence.<sup>1</sup> They show use of the word Flybe and the blue Flybe logo. The services promoted were primarily air travel, but the availability of car hire, airport parking and hotels (under the heading 'Flybe Hotels') was also promoted.

14. The opponent spends around £25m per annum promoting and advertising FLYBE air travel and associated services. The company holds a database of around 7m customers and potential customers and markets its services to them via emails. Of those customers who register a country of residence, nearly 90% are in the UK. However, there are also examples of promotions directed at customers in France and Germany.<sup>2</sup>

15. The opponent also promotes its services via social media. It has Facebook and Twitter accounts and posts videos on YouTube. The opponent advertised its

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<sup>1</sup> See exhibit CFL9 showing the website as at July 2014.

<sup>2</sup> See exhibit CFL19

services via television broadcasts in Estonia and the UK in 2011 and 2014. It has also advertised Flybe services through regional radio broadcasts in the UK.

16. The opponent operates about 26% of domestic UK scheduled flights. It has around 3% of the market for scheduled flights in the EEA.

17. In 2014, Which? magazine awarded Flybe the title 'top airline for punctuality'. In 2016 Flybe was named 'Best Short-Haul Airline' at the Business Travel Awards.

18. Ms Ledger says that in addition to passenger flights, the opponent also provides various travel agency services. By way of example, she claims that users of the Flybe website were able to book third party car hire, hotel and airport parking services. The car hire services were provided by Avis Budget. Users could click on a link which took them to a co-branded page of the Avis website through which they could book car hire. The hotel booking service was provided by Hotel Reservation Service Limited up until July 2014. After that it was provided by Booking.com B.V. Users of Flybe's website could click on a link that took them to a "co-branded" webpage from which they could book hotel accommodation. A similar arrangement operated after 2012 with various car parking providers in relation to airport parking services. The opponent has also promoted third party travel insurance and ski hire services. Historical pages from the Flybe.com website are in evidence which bear out the claims that it was used to advertise hotel accommodation, car hire, airport parking and travel.<sup>3</sup> Additionally, the opponent provided details about the number of such bookings via the Flybe.com website between 2011 and 2016. These show that 200k car hire bookings were made, over 1.5m sales of travel insurance and 380k bookings for airport parking.

19. Ms Ledger states that details of accommodation bookings are not available because Bookings.com does not share this information with the opponent. A press release issued by Flybe and Bookings.com in 2014 stated that:

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<sup>3</sup> See exhibit CFL10

*“The direct link to Bookings.com accessed via the airlines website www.flybe.com provides a ‘one-click booking gateway’ to over 500,000 hotels, apartments, B & Bs, villas, hostels, resorts and more in 201 countries.”*

20. The press statement also mentions that Bookings.com operates its own customer service team providing an exceptional customer experience.

21. The opponent provides all its passengers with a complimentary copy of the Flybe in-flight magazine. Up until 2014 this was called Flybe Uncovered. From 2014 onwards it has been entitled Flybe Flight Time. Ms Ledger states that the purpose of the magazine is “...to promote the Flybe brand and the company’s FLYBE branded services.”<sup>4</sup>

22. The opponent owns the Flybe Training Academy, which provides training for pilots and cabin crew to Flybe’s staff and also the pilots and crew of third party airlines. An example of a training manual used in the training is in evidence.<sup>5</sup> It bears the stylised Flybe mark registered under EU 13646245.

23. The applicant filed submissions on the opponent’s evidence and a witness statement by Taryn Byrne, a Senior Associate at Page White & Farrer. Ms Byrne’s statement introduced the results of searches that she had conducted of the trade mark register as well as online searches for marks used in relation to travel services.<sup>6</sup> Not surprisingly, these searches revealed that there are many registered marks which include the word FLY, and that a (smaller) number of such marks are in use in the travel sector (in 2017). The most relevant of the latter are FlyBus and Flymi.

24. Ms Ledger’s second statement replied to the applicant’s criticisms of her evidence in chief. She provides:

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<sup>4</sup> Examples are included in exhibit CFL6

<sup>5</sup> See exhibit CFL7

<sup>6</sup> See exhibits TJB1 and TJB2

- Copies of video and radio advertisements in which the opponent's FLYBE mark is always pronounced as a single two syllable word, i.e. FLY-BEE.<sup>7</sup>
- Extracts from the opponent's website showing that it is possible to book and pay for car hire and car parking directly from the opponent's flybe.com website.<sup>8</sup>
- Extracts from third party airline websites showing that it is possible to book air travel, accommodation and other services directly from some of these providers, e.g. Easyjet and British Airways.<sup>9</sup>

25. Although the extracts from the opponent's website postdate the opposition, Ms Ledger says that she understands from Helen Mason, Flybe's Marketing Manager, that the web pages have looked the same when she joined the company in July 2013.

### **Proof of use of earlier mark EU 3422433**

26. Section 6A of the Act is as follows:

"Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

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<sup>7</sup> See exhibits CFL28 and CFL29

<sup>8</sup> See exhibit CFL30

<sup>9</sup> See exhibit CFL31

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) 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.”

27. Earlier marks EU 13646211 and EU 13646245 (the Flybe logo marks) are not subject to proof of use. This is because they were only registered in 2015. Therefore, there was less than 5 years between the end of the registration procedures and the date of publication of the contested marks. This means that the opponent can rely on these marks in respect of all the goods/services for which they are registered.

28. EU 3422433 (the FLYBE word mark) was registered more than 5 years before the date of publication of the contested marks on 19<sup>th</sup> August 2016. Consequently, the opponent can only rely on this mark to the extent that it has shown that the mark was put to genuine use in the EU in the period 20<sup>th</sup> August 2011 to 19<sup>th</sup> August 2016 (“the relevant period”).

29. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, 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].

(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].

(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].

(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].”

30. In applying the law I bear in mind that s.100 of the Act states:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

31. By the time of the hearing the applicant accepted that the FLYBE word mark had been put to genuine use during the relevant period in relation to *in-flight magazines*, *aviation training manuals* and *airline services*. Therefore, I have not been required to consider whether the use of the earlier mark in relation to complimentary in-flight magazines constitutes use of the mark for the purpose of creating a market for those goods, as per point 5 in Arnold J.’s summary of the relevant factors.

32. The opponent contended that the mark had also been genuinely used in relation to *air travel services* and *travel agency services*. Further, the opponent submitted that the applicant’s proposed description of its class 16 goods was pernickety and a more appropriate specification would be *printed magazines* and *training manuals*.

33. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors*<sup>10</sup>, Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas*

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<sup>10</sup> [2016] EWHC 3103 (Ch)

*Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

34. Applying this guidance, by analogy, to proof of use in opposition proceedings, I find that aviation training manuals is a fair description of the goods shown in the

opponent's evidence. This is because there are many other types of training manuals for which no use of the mark has been shown and which constitute meaningful sub-categories of training manuals.

35. I see more force in the opponent's contention that *printed magazines* is an appropriate specification reflecting the use of the FLYBE mark in relation to its in-flight magazines. If all that the words *in-flight* added was the place where the magazines were provided, I would accept the opponent's submission. However, I consider that *in-flight* also designates the type of magazine, being a magazine with a focus on travel and travel destinations. The opponent has shown no use of the earlier marks in relation to many other sub-categories of magazines, such as car magazines, fashion magazines, interior design & home improvement magazines or cooking magazines. I therefore accept the applicant's submission that an appropriate description of the use shown is *in-flight magazines*.

36. There is a dispute as to whether the evidence shows that the opponent has used the FLYBE mark in relation to travel agency services. The opponent claims it has. The applicant submits that the evidence shows only that advertisements for third party hotels, car hire, car parking etc. were included on the FLYBE website, or on pages linking to it.

37. The opponent provided a definition of a travel agency taken from The Shorter Oxford English Dictionary. It is as follows:

“a firm which makes transport, accommodation etc., arrangements for travellers, and which acts as agent for tour operators.”

38. It is clear from this that a travel agency acts as an agent for third parties rather than providing the transport, accommodation etc. itself. Therefore, the mere fact that the evidence shows that the opponent offers services provided by third parties is not inconsistent with the opponent's claim to have used FLYBE in relation to travel agency services.

39. In *Apple Inc. v Deutsches Patent- und Markenamt*,<sup>11</sup> the CJEU ruled that a trade mark used in connection with retailing goods may be protected for services intended to induce the consumer to purchase the goods, provided that those services do not form an integral part of the offer for sale of the goods (emphasis added). The court stated:

“26. ....it must be held that, if none of the grounds for refusing registration set out in Directive 2008/95 preclude it, a sign depicting the layout of the flagship stores of a goods manufacturer may legitimately be registered not only for the goods themselves but also for services falling within one of the classes under the Nice Agreement concerning services, where those services do not form an integral part of the offer for sale of those goods. Certain services, such as those referred to in Apple’s application and clarified by Apple during the hearing, which consist of carrying out, in such stores, demonstrations by means of seminars of the products that are displayed there, can themselves constitute remunerated services falling within the concept of ‘service’.”

40. By analogy, a travel agency service must consist of something more than an airline selling the operator’s own airline tickets, which appears to be mainly what the Flybe website was used for during the relevant period. Additionally, the Flybe website provided offers from third party providers and links to pages from which add-on services could be purchased. The Flybe website featured the FLYBE mark and the trade marks of the third party providers offering the add-ons. It is said that the links from the Flybe website led to booking pages which were also co-branded. The contentious issue is whether this is sufficient to constitute use of FLYBE in relation to travel agency services.

41. In *Avnet Incorporated v Isoact Limited*,<sup>12</sup> Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of

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<sup>11</sup> Case C-421/13

<sup>12</sup> [1998] F.S.R. 16

activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

42. I must therefore be satisfied that the FLYBE mark has been used in relation to travel agency services, not merely advertising hotel, car hire and car parking services etc., provided by others.<sup>13</sup> One way of testing whether the opponent provided travel agency services is to assess whether, and to what extent, it acted as an agent, particularly in the context of the provision of transport and accommodation services, which appear to be the core activity of a travel agency service.

43. Insofar as air transport was concerned, the opponent did not act an agent for any other party. Rather, it sold tickets for its own airline services under the FLYBE mark. The sale of those tickets via the FLYBE website formed an integral part of the offer for sale of the opponent’s airline services.

44. The opponent has not provided figures showing what income (if any) it received from selling or promoting accommodation, car hire or car parking services etc. Further, the opponent does not appear to know how many bookings for accommodation were made via the FLYBE website or from linked webpages. This confirms the impression given in the press release issued at the time that Bookings.com became the opponent’s accommodation partner, i.e. that Bookings.com was acting as the booking agent for accommodation and the Flybe website was merely a portal providing access to that party’s services. This impression is further confirmed by the fact that Ms Ledger’s reply evidence showed extracts from the current Flybe website showing how customers can book car hire and car parking services from third parties, but nothing showing that accommodation can be booked. If I am right so far, this means that the opponent was not acting as a travel agent in relation to (air) transport or accommodation services, i.e. the core services of a travel agency.

45. The opponent has provided figures showing the number of car hire and car parking bookings made via the links from the FLYBE website. I do not consider that

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<sup>13</sup> See, by analogy, the distinction between a job advertisement service and ‘employment agency services’. *Reed v Reed* [2004] 40, Court of Appeal at paragraph 62 of the judgment.

this is enough to establish that the opponent provided travel agency services, as defined in the Shorter Oxford Dictionary. Standing back and looking at the evidence as a whole leads me to the conclusion that the opponent has not acted as a travel agent in a sense that would be recognised as such by the relevant trade, or by relevant average consumers. I therefore find that there has been no use of the FLYBE mark in relation to travel agency services.

46. The opponent submits that there is no meaningful distinction between *airline services* and *air travel services*. I agree. Both are accurate descriptions of the opponent's core business. The evidence shows genuine use of FLYBE throughout the relevant period in relation to these services.

47. I conclude that the opponent can rely on the registration of the FLYBE word mark in relation to *in-flight magazines* and *aviation training manuals* in class 16 and *airline services* and *air travel services* in class 39.

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

48. Section 5(2)(b) of the Act is 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”.

49. I will first consider the opponent's case based on earlier EU trade mark 3342433, the word FLYBE.

### Comparison of goods and services

50. The goods/services listed in the left hand column below are those the opponent's representative submitted were identical or similar to the goods/services for which the earlier mark is protected. The goods/services shown in the right hand column are the

goods/services said to be identical or similar to those covered by the contested marks, adjusted to take account of my findings on genuine use.

<b>Goods/services covered by contested marks</b>	<b>Goods/services for which EU 3342433 is entitled to protection</b>
<p>Class 9: Downloadable electronic publications in the nature of magazines, brochures, pamphlets newsletters and manuals in the field of travel; computer application software for mobile phones, desktop and handheld computers; mobile app; downloadable podcasts; educational audio and video recordings in the field of travel.</p>	<p>Class 16: In-flight magazines and aviation training manuals.</p>
<p>Class 16: Printed publications, namely, magazines, brochures, pamphlets, newsletters and manuals in the field of travel.</p>	<p>Class 16: In-flight magazines and aviation training manuals.</p>
<p>Class 35: Online retail store services relating to downloadable electronic publications in the nature of magazines, brochures, pamphlets, newsletters and manuals in the field of travel.</p> <p>Online retail store services relating to printed publications, namely, magazines, brochures, pamphlets, newsletters and manuals in the field of travel.</p>	<p>Class 16: In-flight magazines and aviation training manuals.</p>
<p>Class 39: Travel agency services, namely, providing travel information and making reservations for air transportation, tours, cruises, attractions, namely, arranging and conducting</p>	<p>Class 39: Airline services and air travel services.</p>

sightseeing tours, arranging of cruises and booking travel by means of telephone, computer and electronic communications networks; provision of travel information.	
Class 41: Providing on-line publications in the nature of magazines, brochures, pamphlets, newsletters and manuals in the field of travel. Making reservations for attractions, namely, shows and other entertainment events and concert bookings.	Class 16: In-flight magazines and aviation training manuals.
Class 43: Travel agency services, namely, making reservations for temporary accommodations.	Class 39: Airline services and air travel services

51. In *Gérard Meric v Office for Harmonisation in the Internal Market*,<sup>14</sup> the General Court stated that:

“29. ....the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM-Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

52. Taking this guidance into account I find that *printed publications, namely, magazines... and manuals....in the field of travel* covered by class 16 of the contested marks are identical to the extent that this covers *in-flight magazines and aviation training manuals*. None of the other goods/services covered by the contested mark are identical to the goods/services for which EU 3342433 is entitled to protection.

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<sup>14</sup> Case T-133/05

53. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*,<sup>15</sup> the court stated at paragraph 23 of its judgment 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”.

54. Starting first with the residue of the class 16 goods, I find that *printed publications, namely, brochures, pamphlets, newsletters in the field of travel and magazines and manuals in the field of travel other than in-flight magazines and aviation training manuals* are similar to a high degree to *in-flight magazines and aviation training manuals*. This is because they are similar in nature, purpose and method of use.

55. I find that, to the extent they cover downloadable in-flight magazines and aviation training manuals, *downloadable electronic publications in the nature of magazines... and manuals in the field of travel* in class 9 are similar to a high degree to *in-flight magazines and aviation training manuals* in class 16. The same applies to *providing on-line publications in the nature of magazines.....and manuals in the field of travel* in class 41. This is because, although the method of use of the applicant’s goods/services is different to printed *in-flight magazines and aviation training manuals*, the nature of the goods/services (publications) and purpose (information about travel and flying) are the same. Moreover, there is a degree of competition between printed and on-line/downloadable versions of publications in the sense that one may be purchased as an alternative to the other.

56. I find that *downloadable electronic publications in the nature of magazines... and manuals in the field of travel* in class 9 which are not downloadable or online electronic in-flight magazines and aviation training manuals are similar to medium

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<sup>15</sup> Case C-39/97

degree to printed *in-flight magazines* and *aviation training manuals*. This is because the nature and purpose of the respective goods is less similar than in the case of online or downloadable *in-flight magazines* and *aviation training manuals*. Further, the respective goods/services are less likely to be in competition with one another.

57. I find that *downloadable electronic publications in the nature of... brochures, pamphlets, newsletters... in the field of travel* in class 9 are also similar to printed *in-flight magazines* and *aviation training manuals* in class 16 to a medium degree. The same applies to *providing on-line publications in the nature of... brochures, pamphlets, newsletters... in the field of travel* in class 41. Again although there is a degree of similarity between the nature and purpose of the respective goods/services, it is not as pronounced as with online and downloadable versions of *in-flight magazines* and *aviation training manuals*. Further, the method of use is different and the respective goods/services are less likely to be in competition with one another.

58. I find that there is low degree of similarity between *in-flight magazines* in class 16 and *downloadable podcasts; educational audio and video recordings in the field of travel* in class 9. In this case the nature and method of use of the goods is different, and they are not in competition. On the other hand, the subject matter (travel) is, or could be, the same and the goods are therefore similar in purpose to a certain degree.

59. I see no similarity between *in-flight magazines* in class 16 and *computer application software for mobile phones, desktop and handheld computers; mobile app* in class 9.

60. The opponent submits that *in-flight magazines* and *aviation training manuals* in class 16 and *online retail store services relating to printed publications, namely, magazines, brochures, pamphlets, newsletters and manuals in the field of travel*, and online retail store services relating to analogous downloadable publications in class 35, are complementary and therefore similar.

61. In *Kurt Hesse v OHIM*,<sup>16</sup> 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*<sup>17</sup> 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”.

62. In *Oakley, Inc v OHIM*,<sup>18</sup> the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and are therefore similar to a degree. However, it is important to keep in mind that that a registration of a trade mark for retail services is not a registration for goods, but the retail services intended to encourage consumers to purchase such goods from a particular (in this case online) retailer.<sup>19</sup>

63. There is no reason why *in-flight magazines* and *aviation training manuals* could not be sold/selected through *online retail stores relating to* [downloadable electronic or printed] *publications in the nature of magazines, brochures, pamphlets, newsletters and manuals in the field of travel*. The retail services intended to encourage consumers to purchase such goods from a particular online retailer may therefore be seen as complementary to trading in *in-flight magazines* and *aviation training manuals*. I therefore find that that applicant’s online retail store services in class 35 are similar to a low to medium degree to *in-flight magazines* and *aviation training manuals*.

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<sup>16</sup> Case C-50/15 P

<sup>17</sup> Case T-325/06

<sup>18</sup> Case T-116/06, at paragraphs 46-57

<sup>19</sup> See the decision of Mr Geoffrey Hobbs Q.C. as the Appointed Person in *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14

64. I find that *travel agency services* in classes 39 and 43 are similar to a medium degree to *airline services* and *air travel services* in class 39. The purpose of both services is to facilitate travel and both services include the sale of air travel services. Further, these are complementary services. Travel agents are self-evidently important for the use of airline and air travel services. Further, average consumers would be bound to assume that a travel agent with the same name as an airline was economically connected to the airline.

65. So far as *provision of travel information* in class 39 is concerned, an information service is different in nature and purpose to an airline/air travel service. Further, travel information is not an important or indispensable (commercial) service for the use of *airline services* and *air travel services* in such a way that customers may think that the responsibility for those services lies with the same undertaking.

Consequently, these are not complementary services in the sense described in the case law. They are not similar in any other way. Therefore, these are not similar services or, if simply being connected with travel is sufficient to create a degree of similarity, then it is low.

66. Finally, I see no similarity between *making reservations for attractions, namely, shows and other entertainment events and concert bookings* in class 41 and any of the goods/services for which the earlier trade mark is protected.

#### Global comparison

67. 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.

### *The principles*

(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.

#### Average consumer and the selection process

68. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*.

69. The opponent claims that the average consumer of the goods/services covered by the application will pay an average degree of attention during the selection process. The applicant submits that consumers pay an above average degree of attention when selecting airline services.

70. I find that air travel is now so common and affordable that average consumers pay no more than an average or 'normal' degree of attention when selecting such services. In any event, although the earlier marks cover airline services the contested marks do not. Consequently, even if the applicant is right, this sheds no light on the likelihood of confusion amongst those encountering the contested marks. In my view, average consumers of all the goods/services covered by the contested

marks (and listed in paragraph 50 above) will pay an average level of attention when selecting the goods/services.

71. The opponent submits that the goods/services covered by the contested marks are likely to be selected by a mixture of visual and oral means, e.g. enquiries to sales assistants and word of mouth recommendations. In fact most of the goods/services listed in paragraph 50 above are likely to be selected mainly by eye, particularly the downloadable and online products/services. However, it is possible that word of mouth recommendations could play some part in the selection process. Additionally, oral enquiries are a significant channel of communication for travel agents. Therefore, visual means of selection are most important, but the potential for aural confusion (or the lack of it) must also be considered.

#### Distinctive character of earlier mark

72. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* 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).”

73. The applicant submits that FLY- is descriptive of the opponent’s goods/services (as per paragraph 50 above) and -BE is a common word (as in “to be”) as well as being an abbreviation for the opponent’s former trading name (British European). The opponent submits that FLYBE as a whole is non-descriptive and the applicant’s approach is based on an artificial (and therefore non-permissible) dissection of the earlier mark.

74. I accept the opponent’s submission. FLYBE as a whole is not descriptive of the opponent’s goods/services. Although it includes the word FLY, which I accept is descriptive, or at least allusive, in relation to travel related goods/services, the mark as a whole has a normal degree of inherent distinctiveness.

75. The distinctiveness of the mark has undoubtedly been enhanced through its extensive use within the EU and the UK in relation to airline and air travel services. For these services, the mark was highly factually distinctive at the relevant date.

#### Comparison of marks

76. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*<sup>20</sup> 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

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<sup>20</sup> See paragraph 34 of the judgment in Case C-591/12P

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

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.

77. The respective trade marks are shown below:

FLYBE	FLYE 
Earlier trade mark	Contested trade marks

78. The applicant submits that a one letter difference is likely to be noticed in short four or five letter marks and that the prefix of the earlier mark is descriptive.

79. The opponent points out that, in general, the beginnings of marks make more of an impression than the ends, and that both of the marks begin with FLY- (and end in -E).

80. I find that there is a medium to high degree of visual similarity between FLYBE and the applicant’s word mark FLYE, and a medium degree of visual similarity between FLYBE and the applicant’s stylised word mark. This is because:

- Although it is necessary to keep in mind that FLY is a descriptive word for air travel services and related goods/services, that word is not an independent element of any of the marks.

- The contested marks are comprised of four letters, all of which are present in the earlier mark and appear in the same order.
- The beginnings and last letter of all the marks are the same.
- Although the stylisation to the letter E in the applicant's stylised word mark is not negligible in impact, and reduces the level of overall similarity between the marks, it makes less impact than the (similar) word element FLYE.
- Normal and fair use of FLYBE includes use in any normal font, which would include use in a similar lower case font to that used for the letters f-l-y in the contested marks.<sup>21</sup>

81. The opponent submits that FLYBE is pronounced as a single two syllable word FLY-BEE and that the contested marks could also be pronounced as a two syllable word FLY-EE. The applicant disputes this.

82. I agree with the applicant. In my view, average consumers will pronounce the applicant's mark as a single syllable word: FLYE as in STYE. Consumers are used to treating a letter E at the end of words as a silent letter, which sometimes changes the sound of the letter which precedes it. It is difficult to think of English words in which the letter E alone, appearing at the end of a word, is articulated as -EE. I accept the opponent's submission that allowance must be made for the possibility of different perceptions amongst different sections of average consumers: there is no single meaning rule. However, in my judgment, no significant section of average consumers will pronounce the applicant's mark as FLY-EE. Comparing FLY-BEE to FLYE (as in 'stye'), I find that there is only a low degree of aural similarity between the marks.

83. FLYBE has no obvious conceptual meaning. It is plainly more than a play on, or mis-spelling of, FLY. By contrast, a significant proportion of average consumers are likely to see the contested marks (when used in relation to travel related goods/services) as a play on FLY. Therefore, although not all average consumers

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<sup>21</sup> See the decision of Ms Amanda Michaels as the Appointed Person in *BOOHOO v Boo Boo* BL 0-387-11

will see it, there is a certain degree of conceptual distinction between the respective marks.

#### Likelihood of confusion

84. Where the respective goods/services are the same, or similar to high degree, I find that the level of visual similarity between the marks is sufficient to create a likelihood of confusion amongst relevant average consumers. In these circumstances, I find that there is likelihood of confusion through imperfect recollection of the marks.

85. Additionally, I find that the highly distinctive character of FLYBE for airline and air travel services is sufficient to create a likelihood of confusion if the contested marks are used in relation to travel agency services. As was recognised by Richard Arnold QC (as he then was) as the Appointed Person in *Kennedy Fried Chicken*,<sup>22</sup> human beings have a tendency to see what they expect to see. Where FLYBE is highly factually distinctive and has acquired a reputation amongst UK consumers for airline and air travel services, it is more likely that a significant proportion of average consumers will misread FLYE as FLYBE, if it is used in relation to travel agency services.

86. As the opponent submitted, it is not necessary that all, or even most, average consumers are likely to be confused.<sup>23</sup> If, having regard to the perceptions and expectations of the average consumer, the tribunal concludes that a significant proportion of the relevant public is likely to be confused, then there is a likelihood of confusion within the meaning of s.5(2) of the Act.

87. Consequently, even if a majority of average consumers recognise the contested marks as a play on the word FLY, and are therefore perhaps less likely to

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<sup>22</sup> See BL 0-227-04

<sup>23</sup> See *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ at point (v) of paragraph 34 of the judgment and *Soulcycle v Matalan Ltd* [2017] 496 at paragraphs 20-30.

misunderstand them as FLYBE marks,<sup>24</sup> this will have no bearing on the likelihood of confusion amongst the significant proportion of average consumers who do not immediately recognise that conceptual meaning.

88. Where the respective goods or services are similar to only a medium degree, or less, and the highly distinctive character of the earlier mark is less relevant (or irrelevant), I find that there is no likelihood of confusion. In this case the likelihood of consumers misreading the applicant's marks as FLYBE, or being otherwise being confused through imperfect recollection, is sufficiently low that it must be rejected.

89. This means that the opposition under s.5(2) based on earlier EU mark 3342433 succeeds in relation to:

Class 9: Downloadable electronic publications in the nature of in-flight magazines and aviation training manuals.

Class 16: Printed publications, namely, magazines, brochures, pamphlets, newsletters and manuals in the fields of travel.

Class 39: Travel agency services, namely, providing travel information and making reservations for air transportation, tours, cruises, attractions, namely, arranging and conducting sightseeing tours, arranging of cruises and booking travel by means of telephone, computer and electronic communications networks.

Class 41: Providing on-line publications in the nature of in-flight magazines, and aviation training manuals.

Class 43: Travel agency services, namely, making reservations for temporary accommodations.

Otherwise the opposition under s.5(2) based on EU mark 3342433 fails.

90. I next consider the opposition based on EU 1364211, the purple flybe logo.

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<sup>24</sup> Based on the so-called counteraction theory whereby conceptual differences may sometimes be sufficient to counteract visual and aural similarities: see *The Picasso Estate v OHIM*, CJEU, Case C-361/04 P at paragraph 20 of the judgment.

91. In the light of my decision based on EU mark 3342433, I see no need to consider the goods/services for which I have already decided that the contested marks will be refused registration.

92. I next consider the likelihood of confusion between the purple flybe logo mark and the contested marks if they are used in relation to (the remaining) identical goods/services. The opponent identifies these as follows.

<b>Goods/services covered by contested marks</b>	<b>Identical goods/services covered by EU 1364211</b>
Class 25: Clothing, footwear and headwear.	Class 25: Clothing; footwear; headgear.
Class 35: Multi-level marketing services; advertising; advertising, marketing and promotion services; advertising and marketing services provided by means of indirect methods of marketing communications, namely, social media, search engine marketing, inquiry marketing, internet marketing, mobile marketing, blogging and other forms of passive, shareable or viral communications channels.	Class 35: Promotional services.  Organisation, operation and supervision of sales and promotional incentive schemes; customer loyalty, incentive and bonus programme schemes; customer loyalty services for commercial, promotional and/or advertising purposes.
Class 35: Online retail store services relating to clothing footwear and headwear.	Class 35: The bringing together, for the benefit of others, of a variety of goods, namely clothing, footwear, headgear, enabling customers to conveniently view and purchase any of those goods including from a retail store, a catalogue by mail order, by means of telecommunications or from an internet website; retail services connected with

	clothing, footwear, headgear.
Class 35: Business information relating to loans, finance and capital.	Class 35: Business information.
Class 36: Underwriting, issuing and administration of travel insurance, automobile collision insurance, liability insurance and life insurance; insurance administration and underwriting of medical, hospital and related health care services and benefit programs; loan services; venture capital financing; arranging and provision of credit, loans, insurance, currency exchange and travellers cheques; financing and loan services; financing of loans.	Class 36: Financial services; credit card services; provision of credit cards; credit card advisory services, credit card management services, credit card payment processing services and issuing credit cards; travel insurance services.
Class 41: Arranging and conducting of training workshops, training sessions and seminars in the field of travel; educational services, namely, conducting education courses related to the travel industry; arranging and conducting of training sessions and seminars in the field of travel; online crowd-sourced community-based education services.  Providing an online computer games and electronic games; providing online video games; providing temporary use of non-downloadable computer games; providing temporary use of non-downloadable electronic games; providing temporary use of non-downloadable video games.	Class 41: Training and education services; training and educational courses.  Entertainment (services).

93. Taking into account the inclusion principle identified in *Gérard Meric*, I accept that, with the exception of those services covered in the following paragraph, the goods/services shown above are identical. If they are not identical then they are so similar as to make no real difference.

94. I do not accept that *automobile collision insurance, liability insurance and life insurance; insurance administration and underwriting of medical, hospital and related health care services and benefit programs* are identical to *financial services or travel insurance services*. This is because financial services are concerned with obtaining, providing or guaranteeing finance and/or processing financial transactions. Although insurance services involve guaranteeing financial compensation in particular circumstances, I do not consider that average consumers would regard financial services as a natural description of insurance services. Travel insurance services are self-evidently not identical to other insurance services. However, I accept that *liability insurance* is identical to *credit card services* (credit cards being well known to provide liability insurance on purchases).

#### Average consumer and the selection process

95. With the exception of *venture capital financing*, I find that average consumers of the identical goods/services identified above would pay an average or normal degree of attention when selecting the goods/services at issue. Certain services, such as *loan services* could of course include large amounts of money where a higher level of attention may be assumed. However, it could also cover loans of small amounts where 'only' a normal level of attention would be paid to the selection of a service provider. In this case it is appropriate to take account of the likelihood of confusion amongst those paying a normal level of attention.

96. *Venture capital financing* is a specialist business-to-business service almost exclusively involving large scale investments. The average consumer for *venture capital financing* is likely to pay a very high level of attention.

97. The goods/services at issue would be primarily selected by eye, although oral enquiries/orders/recommendations must also be considered.

Distinctive character of earlier mark

98. The most dominant and distinctive element of the earlier mark is the word flybe. However, the use of white letters on a purple background, and the dots used to ‘underline’ the letters ‘BE’, make a more than negligible contribution to the visual impact of the mark. The get-up therefore also forms part of the distinctive character of the earlier mark.

99. The word FLYBE is not descriptive of the goods/services. Although it is not a very complex word, the word FLYBE (which is the only element of the earlier mark with any similarity to the contested marks) has a normal degree of inherent distinctive character in relation to the goods/services relied on by the opponent.

100. There is no evidence that the distinctiveness of the earlier mark has been enhanced through use of the purple Flybe logo in relation to the goods/services under consideration.

Comparison of marks

101. The respective marks are shown below.

	
Earlier trade mark	Contested trade marks

102. As regards aural and conceptual similarity, I adopt my earlier findings made in relation to the opponent’s FLYBE word mark, i.e. there is only a low degree of aural similarity and a conceptual distinction that would be apparent to a majority of, but not all, average consumers.

103. Comparing the visual impacts made by the marks, I note that:

- The contested marks are comprised of four letters, all of which are present in the word element of the earlier mark and appear in the same order.
- The beginnings and last letter of the word elements of all the marks are the same.
- The purple background of the earlier mark has no counterpart in the contested marks and placing the applicant's marks on such a background would not constitute normal and fair use of the contested marks.
- The 'underlining' of the letters BE in 'flybe' serves to emphasise those two letters and therefore helps to point up the main difference between FLYE and FLYBE.
- Although the stylisation of the letter E in the applicant's stylised word mark is not negligible in impact, and reduces the level of overall similarity between the marks, it makes less impact than the word element FLYE.

104. Taking all these factors into account, I find that there is a low level of visual similarity between the earlier mark and FLYE, and a slightly lower level of visual similarity between the earlier mark and the stylised flye mark.

#### Likelihood of confusion where identical goods/services are concerned

105. I find that the level of overall similarity between the marks is insufficient to create a likelihood of confusion, even where the goods/services are identical and the consumer's level of attention is 'normal'. Assuming use of the earlier mark in the distinctive get-up in which it is registered, I do not think it likely that average consumers will imperfectly recollect the contested marks as the earlier mark, or vice versa.

106. Such confusion is even less likely where the average consumer's attention level will be exceptionally high, i.e. during the selection of *venture capital financing*.

107. I have also considered the possibility of indirect confusion, i.e. that consumers will see the contested marks as variants of the earlier mark and used by the same or related undertakings. However, given the overall difference between the look and feel of the marks and the emphasis given to the letters BE in the word flybe, I see no reason why average consumers would suppose that the contested marks are variants of the earlier mark.

Likelihood of confusion where non-identical goods/services are concerned

108. It follows from the above that, with the possible exception covered in the following paragraphs, the opposition under s.5(2)(b) based on the flybe purple logo mark also fails where the respective goods/services are only similar.

109. To the extent that the opponent relies on the registration of the earlier mark in relation to airline and air travel services, I must take into account that the earlier mark was highly factually distinctive at the relevant date. This could affect the outcome of my assessment as to the likelihood of confusion.

110. The opponent provided a table helpfully setting out which goods/services covered by the contested marks it considered to be similar to goods/services covered by the registration of the purple FLYBE logo. The parts of the table in which the opponent relied upon the *airline and air travel services* are set out below.

<b>Goods/services covered by contested marks</b>	<b>Similar goods/services covered by EU 1364211</b>
Class 9: Virtual reality software for travel; computer application software for mobile phones, desktop and handheld computers; mobile app; downloadable podcasts; video and computer game programs; electronic game software for handheld electronic devices; electronic game software.	Class 39: Airline services; air travel services.

Educational audio and video recordings in the field of travel.	
Class 42: Creating an on-line community by means of hosting and maintaining an interactive website; providing an interactive web site and mobile app; peer-to-peer browser photo sharing services, namely, providing a website featuring technology enabling users to upload, view and download digital photos.	Class 39: Airline services; air travel services.

111. So far as the class 42 services are concerned, I cannot see any similarity between these services and airline and air travel services. The opponent's representative at the hearing fairly accepted that these services were furthest away from those covered by the earlier mark.

112. The opponent submits that *computer application software for mobile phones, desktop and handheld computers; mobile app* in class 9 covers software applications for booking flights which are complementary to *airline and air travel services*. However, even accepting that software applications for booking flights could be regarded as important for the use of *airline and air travel services*, I do not accept that the goods and services are complementary in such a way that customers may think that the responsibility for those services lies with the same undertaking. On the contrary, there is no evidence that airlines customarily provide flight booking software for their customers and that fact (if true) is outside my experience as a consumer. In the absence of any other basis for finding similarity between the goods in class 9 and *airline and air travel services*, I find that they are dissimilar.

113. It follows from the above that the opposition under s.5(2)(b) based on the purple flybe logo does not improve the opponent's position over the opposition under s.5(2)(b) based on the FLYBE word mark.

114. I next consider the opposition based on EU 13646245, the multicolour flybe logo.

115. The multicolour flybe logo is registered for the same goods/services as the purple flybe logo. The way that the word flybe is presented in two shades of blue serves to further visually separate the FLY prefix from the BE suffix. The use of dots to 'underline' the letters BE also serves to emphasise the difference between the word flye and flybe. In these circumstances, the opponent is no better off with the opposition under s.5(2)(b) based on EU 13646245.

### **Section 5(3)**

116. Section 5(3) states:

“(3) A trade mark which-

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

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

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

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

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

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

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and

occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

### Reputation

118. There is no doubt that the earlier marks have a strong reputation in the UK and the EU in relation to *airline* and *air travel services*. For reasons given earlier, I do not accept that the marks have a reputation for travel agency services or similar services.

### Link

119. The opponent claims that use of the contested marks in relation to all the goods/services covered by the applications would take unfair advantage of the earlier marks. The full list of goods/services is set out in Annex A below.

120. I accept that the public are likely to make a link between the FLYBE word mark and the contested marks if they are used in relation to travel agency services and the other goods/services for which I have found that there is a likelihood of confusion under s.5(2)(b).

121. I find that no such link will be made if the contested marks are used in relation to the other goods/services covered by the applications. If I am wrong about this then any such link is only plausible if the contested marks are used in relation to travel-related goods/services, e.g. *educational audio and video recordings in the field of travel* in class 9 or *underwriting, issuing and administration of travel insurance* in class 36. If such a link is made then I find that:

- Although the relevant public with whom the earlier mark has a reputation for *airline* and *air travel services* overlaps with the public for other travel-related goods/services, the level of similarity between the marks and those goods/services is not sufficient for more than a small proportion of average consumers to make any link between the marks;
- The link will be fleeting and not strong;
- The link will not be such as to create a likelihood of confusion.

122. Consequently, as the opponent's case, as described at the hearing, appears to be based on unfair advantage arising from confusion as to the trade origin of the goods/services marketed under the contested marks, the opposition under s.5(3) does not succeed beyond that set out above in my analysis of the likelihood of confusion under s.5(2)(b) based on EU 3342433.

123. The application of s.5(3) does not, of course, depend upon a likelihood of confusion. However, no other basis has been identified which would result in the contested marks taking unfair advantage of the earlier marks. The oppositions under s.5(3) therefore fail.

## **Outcome**

124. The oppositions succeed in relation to the goods/services specified in paragraph 89 above. Otherwise the opposition fails. This means that the contested marks can proceed to registration for all the goods/services covered by classes 25, 35, 36, 38, 41, 42, 44 and 45, and for the following goods/services in classes 9, 39 and 41.

#### Class 9

Downloadable electronic publications in the nature of magazines, brochures, pamphlets, newsletters and manuals in the field of travel; but not including downloadable in-flight magazines or aviation training manuals; smart cards; computer application software for mobile phones, desktop and handheld computers; mobile app; downloadable podcasts; educational audio and video recordings in the field of travel; computer e-commerce software to allow users to perform electronic business transactions conducted in the form of an auction via a global computer network and computer database software featuring information in the field of hobbies, collectibles and a wide variety of products; electronic device in the nature of a digital wallet that stores and protects financial; virtual reality software for travel; downloadable software in the nature in the nature of browsing crowd-sourced information; video and computer game programs; electronic game software for handheld electronic devices; electronic game software.

#### Class 39

Provision of travel information.

#### Class 41

Providing on-line publications in the nature of magazines, brochures, pamphlets, newsletters and manuals in the field of travel; but not including on-line in-flight magazines or aviation training manuals; arranging and conducting of training workshops, training sessions and seminars in the field of travel; making reservations for attractions, namely, shows and other entertainment events and concert bookings; educational services, namely, conducting education courses related to the travel industry; arranging and conducting of training sessions and seminars in the field of travel; Online crowd-sourced community-based education services; providing an online computer games and electronic games; providing online video games; providing temporary use of non-downloadable computer games; providing temporary use of non-downloadable electronic games; providing temporary use of non-downloadable video games.

125. The applications to register the contested marks in classes 16 and 43 are refused.

### **Costs**

126. The applicant has been more successful than the opponent and is therefore entitled to a contribution towards its costs which reflects the overall outcome. I calculate this as follows.

£350 for considering the notices of opposition and filing g counterstatements;  
£700 for considering the opponent's evidence and filing submissions and evidence in response;  
£200 for filing submissions in lieu of attending the hearing.

127. I therefore order Flybe Limited to pay WorldVentures Holdings, LLC the sum of £1250. This sum to be paid within 14 days of the end of the period allowed for appeal.

**Dated this 02<sup>nd</sup> day of November 2017**

**Allan James**  
**For the Registrar**

**ANNEX A**

#### Class 9

Smart cards; computer application software for mobile phones, desktop and handheld computers; mobile app; downloadable podcasts; educational audio and video recordings in the field of travel; downloadable electronic publications in the nature of magazines, brochures, pamphlets, newsletters and manuals in the field of travel; computer e-commerce software to allow users to perform electronic business transactions conducted in the form of an auction via a global computer network and computer database software featuring information in the field of hobbies, collectibles and a wide variety of products; electronic device in the nature of a digital wallet that stores and protects financial; virtual reality software for travel; downloadable software in the nature of browsing crowd-sourced information; video and computer game programs; electronic game software for handheld electronic devices; electronic game software.

#### Class 16

Printed publications, namely, magazines, brochures, pamphlets, newsletters and manuals in the field of travel.

#### Class 25

Clothing, footwear and headwear.

#### Class 35

Multi-level marketing services; advertising; business management; business administration; office functions; advertising, marketing and promotion services; online retail store services relating to smart cards, computer application software for mobile phones, desktop and handheld computers, mobile apps, downloadable podcasts, educational audio and video recordings in the field of travel, downloadable electronic publications in the nature of magazines, brochures, pamphlets, newsletters and manuals in the field of travel, computer e-commerce software to allow users to perform electronic business transactions conducted in the form of an auction via a global computer network and computer database software featuring information in the field of hobbies, collectibles and a wide variety of products, electronic devices in the nature of a digital wallet that stores and protects financial, virtual reality software for travel, downloadable software in the nature of browsing

crowd-sourced information, video and computer game programs, electronic game software for handheld electronic devices, electronic game software, printed publications, namely, magazines, brochures, pamphlets, newsletters and manuals in the field of travel, clothing, footwear and headwear; online trading services, namely, operating online marketplaces for sellers and buyers of goods and services; online trading services in which sellers post products or services to be offered for sale, and purchasing or bidding is done via the Internet in order to facilitate the sale of goods and services by others via a computer network; providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods and services, buyers' and sellers' performance, delivery, and overall trading experience in connection therewith; providing a searchable online advertising guide featuring the goods and services of online vendors; providing a searchable online evaluation database for buyers and sellers; providing a website where users can post ratings, reviews, and recommendations on products and services; advertising and marketing services provided by means of indirect methods of marketing communications, namely, social media, search engine marketing, inquiry marketing, internet marketing, mobile marketing, blogging and other forms of passive, sharable or viral communications channels; business advice and information relating to loans, finance and capital; business development services.

#### Class 36

Underwriting, issuing and administration of travel insurance, automobile collision insurance, liability insurance and life insurance; Insurance administration and underwriting of medical, hospital and related health care services and benefit programs; loan services; real estate management and leasing services; venture capital financing; arranging and provision of credit, loans, insurance, currency exchange and travellers cheques; financing and loan services; financing of loans; rental of real estate; real estate listing services for housing rentals and apartment rentals; real estate rental services, namely, rental of residential housing, vacation homes, condominiums and apartments.

#### Class 38

Chat room services for social networking; providing access to computer databases in the field of social networking; providing on-line communications links which transfer web site users to other local and global web pages; providing user access to data on the Internet in the field of social networking; telecommunications services, namely, providing online and telecommunication facilities for real-time interaction between and among users of computers, mobile and handheld computers, and wired and wireless communication devices; providing an online community forum for users to share information, photos, audio and video content about themselves, their likes and dislikes and daily activities, to get feedback from their peers, to form virtual communities, and to engage in social networking; telecommunications services, namely, electronic transmission of data, messages, graphics, images and information; peer-to-peer photo sharing services, namely, electronic transmission of digital photo files among Internet users; providing access to computer, electronic and online databases; providing online communications links which transfer web site users to other local and global web pages; providing online chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest; broadcasting services over computer or other communication networks, namely, uploading, posting, displaying, and electronically transmitting data, information, messages, graphics, and images; telecommunications services, namely, electronic transmission of photos and videos; electronic bulletin board services; telecommunication services, namely, transmission of advertisements and media advertising communications via computer and communication networks; delivery of digital music by electronic transmission; text messaging services; providing user access to third party web sites hosted on computer servers accessible via a global computer network; non-downloadable podcasts; chat rooms.

#### Class 39

Travel agency services, namely, providing travel information and making reservations for air transportation, tours, cruises, attractions, namely, arranging and conducting sightseeing tours, arranging of cruises and booking travel by means of telephone, computer and electronic communications networks; provision of travel information.

#### Class 41

Arranging and conducting of training workshops, training sessions and seminars in the field of travel; making reservations for attractions, namely, shows and other entertainment events and concert bookings; educational services, namely, conducting education courses related to the travel industry; providing on-line publications in the nature of magazines, brochures, pamphlets, newsletters and manuals in the field of travel; arranging and conducting of training sessions and seminars in the field of travel; Online crowd-sourced community-based education services; providing an online computer games and electronic games; providing online video games; providing temporary use of non-downloadable computer games; providing temporary use of non-downloadable electronic games; providing temporary use of non-downloadable video games.

#### Class 42

Creating an on-line community by means of hosting and maintaining an interactive website; providing an interactive web site and mobile app; peer-to-browser photo sharing services, namely, providing a website featuring technology enabling users to upload, view and download digital photos; design and development of virtual reality software; hosting of websites; software as a Service (SaaS) services featuring software for use by organizations for the analysis of crowd-sourced digital identity analytics and device recognition data; computer services, namely, platform as a service through providing an application platform interface for use by others for the collection, aggregation, compilation, dissemination, transmission, and processing of both crowd-sourced data and data from global positioning systems for use in predictive modelling and analysis.

#### Class 43

Travel agency services, namely, making reservations for temporary accommodations.

#### Class 44

Comprehensive health care benefit programs, namely, integrated healthcare services with a network of international healthcare providers including health care rendered through health maintenance organizations and preferred provider

organizations, namely, medical, dental, hospital, home health care, preventive health care treatment, physical and mental therapy services.

#### Class 45

Online social networking services; dating services, marriage counselling, counselling, namely, offering advice regarding personal relationships and personal well-being via a global computer network; Internet based introduction and social networking services; providing a website featuring information in the area of personal relationship wellness; providing information in the field of personal relationship wellness; providing information in the field of social introduction.