

O-018-04
TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 2280764
BY EASY4STUDENTS LIMITED TO REGISTER
A TRADE MARK IN CLASSES 38, 41 AND 42

AND

IN THE MATTER OF OPPOSITION No. 90696
BY EASYGROUP IP LICENSING LIMITED

TRADE MARKS ACT 1994

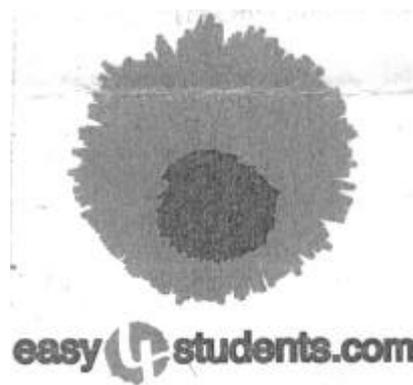
**IN THE MATTER OF Application No. 2280764
by Easy4Students Limited to register a Trade Mark
in Classes 38, 41 and 42**

and

**IN THE MATTER OF Opposition No. 90696
by Easygroup IP Licensing Limited**

BACKGROUND

1. On 15 September 2001 Easy4Students Limited applied to register the following mark:



It has been applied for in respect of the following services:

Class 38:

The provision of e-mail services to students to enable the transmission and receipt of e-mail communications; receipt and delivery of messages, documents, images and other data by electronic transmission; electronic mail services; electronic bulletin services; electronic chat room services.

Class 41:

The provision to students of educational advice relating to student lifestyles; training and entertainment services; information services relating to any of the aforesaid services.

Class 42:

The provision to students of personal career development advice, information and databases accessed electronically via the world wide web or by e-mail; information services relating to any of the aforesaid services; web-design services.

The application is numbered 2280764.

2. On 13 June 2002 easyGroup Licensing Limited filed notice of opposition to this application. They claim to be the proprietors by assignment of some 81 UK and CTM registrations or applications consisting of or incorporating the word EASY usually as the first element of the marks. I do not propose to list them all but will identify those that I consider to be most relevant in the body of my decision.

3. Companies in the Group are said to have made continuous use in the UK of the following marks:

- EASYJET/easyJet - for paper goods, travel services and transportation services since 1995;
- easyKiosk - for paper goods, the provision of food and drink and catering services since around 1999;
- easyTech - for aircraft maintenance services since around 1999;
- easyTrak - for transportation services since around 1999;
- easyRentacar - for vehicle rental services since around 1999;
- easyJet Services - for paper goods and transportation services since around 2000;
- easyEverything - for catering services, Internet services and leasing access time to a computer database since around October 1999;
- easyMoney - for financial services;
- easyJet.com & logo - for free e-mail services since around 2000;
easy.com
- easyValue - for on-line price comparator services since 2000;
- easyInternetcafe - for catering services, Internet services and leasing access time to a computer database since 2001;
- easyCar - for vehicle rental services since 2001.

4. easyGroup claims that the applied for mark so closely resembles their own trade marks which contain the prefix EASY that it is likely to cause confusion. easyGroup claims that the services of the application in suit are identical or similar to all the Class 9, 16, 18, 29, 30, 32, 33, 35, 36, 38, 39, 41 and 42 goods and services of their various registrations/applications. As a result it is said that the application is open to objection under Section 5(2)(b) of the Act.

5. They further claim that:

“Registration of the trade mark easy4students.com is also contrary to Section 5(4)(a) on the basis that use could be prevented by virtue of a rule of law, namely, the rule of passing off, protecting trade marks used in the course of trade. By virtue of the extensive use of the trade marks easyMoney, easyEverything, easyJet, easyRentacar and the many other trade marks of the Opponent which have the prefix easy in relation to travel services, paper goods, Internet café services, Internet services, financial services, on-line price comparator services, catering services, and transportation services, since the dates referred to above, the Opponent has acquired a significant reputation and goodwill in the aforesaid trade marks and use by the Applicant of the trade mark easy4students.com would constitute a misrepresentation as to the origin of the services which would damage such goodwill.

To the extent that any of the goods and services of the Opponent’s earlier registrations and applications are considered dissimilar goods and services to those covered by application No. 2280764, registration of the Trade Mark also offends the provision of Section 5(3) because there are earlier trade marks in relation to which this Section applies. In this respect, the earlier Trade Marks EASYJET/easyJet, easyRentacar/EASYRENTACAR, EASYEVERYTHING/easyEverything and easy.com of the Opponent have a reputation in the UK and use of the later mark easy4students.com on any of the services covered by the application without due cause, would take unfair advantage, or be detrimental to the distinctive character and repute of the earlier trade marks.”

6. The applicants filed a counterstatement denying the above grounds. In doing so they offer a number of observations on the respective marks and goods/services. I do not propose to rehearse these points here but will take them into account in my decision and refer to them as necessary below. Two further matters are referred to. Firstly, the applicants say that their services are directed at students. Secondly, they refer me to the decision of the High Court in *easyJet Airline and Tim Dainty (t/a as easyRealestate)* [2002] FSR6.

7. Both sides ask for an award of costs in their favour.

8. Both sides filed evidence. The case was reviewed by a Registry Hearing Officer who suggested that the matter might benefit from submissions at a hearing. My understanding is that a hearing was arranged for 21 October 2003 but that shortly before the hearing date the parties requested that a decision be made from the papers instead. A further period was allowed for written submissions. Weightman Vizards have provided written submissions on behalf of the applicants under cover of their letter of 18 November 2003. Acting on behalf of the Registrar and with the above material in mind I give this decision.

EVIDENCE

9. The evidence in this case is as follows:

Opponents' evidence in chief:

Witness Statement of James Rothnie & exhibits JR1-6

Applicants' evidence in support:

Witness Statement of Rajesh Rajan and exhibit 1

Opponents' evidence in reply:

Witness Statement of James Rothnie & exhibits JR7 & JR8

10. Mr Rothnie is Director of Corporate Affairs for easyJet and its related companies. He gives evidence about the launch of easyJet airline in November 1995 and the subsequent development of that business. I do not believe there can be any doubt about the reputation easyJet has established as an operator of low cost airline services offered primarily over the Internet. The evidence also goes to the Group's expansion in other fields such as the rental car business (easyRentacar) and Internet cafés (easyEverything). Reference is also made to more recent trading developments such as an on-line financial services company (easyMoney) and an Internet price comparator service (easyValue). I note that Mr Rajan, who gives evidence for the applicants, concedes that the opponents have a considerable goodwill and reputation in their airline business and their car rental business (paragraph 4 of Mr Rajan's witness statement). That seems to me to be a sensible concession which makes it unnecessary to record any further details about these businesses save for emphasising that they are largely Internet based.

11. The remainder of Mr Rothnie's lengthy witness statement is directed to a review of his company's marks, submissions in relation to similarity of goods and services and a commentary on the applicants' counterstatement.

12. Mr Rajan's evidence is largely by way of submissions. I bear these in mind but do not propose to record them at this point. He also describes the applicants' business as being "...a website which principally operates as an advertising tool for landlords to advertise premises for rental to students. It also provides other services to students such as information on bars and restaurants, lifestyle advice and information on the town or city in which the student is located."

13. Mr Rothnie's reply evidence for the opponents also consists largely of submissions. He exhibits two new pieces of evidence, these being articles publicising easyMoney and extracts from both parties' websites showing use of the colour orange.

THE LAW

14. The relevant parts of the statute (Section 5) read as follows:

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

- (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.

(3) A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

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 Community trade mark, in the European Community) 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.

(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, or
- (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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.”

15. I will take the objections under each head of opposition in turn.

SECTION 5(2)

16. In approaching the issues under this head I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] R.P.C 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, 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; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

Opponents' submissions

17. The main points to emerge from Mr Rothnie's evidence seem to me to be as follows:

- 'easy' is key to the opponents' brand identity;
- their marks usually consist of 'easy' combined with a further word which describes or alludes to the goods or services (and sometimes followed by .com). But others cannot be categorised in this way (e.g. easyEverything, easy.com etc);
- the word 'students' in the applied for mark is purely descriptive of the target audience for the applicants' services;
- thus, it is said, 'easy' is the key element with .com emphasising that, like the opponents, it is an internet business;
- the logo (device), although large, does not represent anything and would be difficult to describe or refer to;
- the applicants use lower case lettering;
- it is also noted that the applicants' company name employs a capitalised letter S for 'Students' in the same way that the opponents employ a capitalised letter for the second element of their marks;
- the applied for mark employs 'full' lettering which is not dissimilar to the fat type used by easyGroup;
- the stylised number 4 is not very clear, and is descriptive in suggesting the word 'for';
- the opponents have strong links with Liverpool (where the applicants are based) and have promoted their services to students;
- the applicants' website has links to sites containing 'shocking material';
- the easyRealestate case can be distinguished and contained obiter statements that are not binding on me. Furthermore, it showed that the opponents could prevent the use of that mark in relation to a service area in which they do not operate;
- the applicants' mark is used in or containing the colour orange in common with the opponents' marks.

Applicants' submissions

18. These are in summary that:

- the opponents are seeking to prevent other businesses using the word 'easy';

- the applied for mark has the word 'easy' followed not by a word describing or alluding to the underlying services but the class of customers being addressed;
- the applied for mark employs a different font;
- the first element of the second part of the applicants' mark is not a letter but a numeral encompassed within a logo;
- the applicants will use their mark in yellow and blue rather than orange and white and would be prepared to limit accordingly;
- the opponents' marks are distinct from the applicants' on analysis of all the features that make up the respective marks;
- the opponents' success in the easyRealestate case was because of the particular circumstances of that case.

19. As noted above, the opponents' statement of grounds refers to over 80 registrations or applications. The opponents have made little attempt to refine their case. Theoretically the opponents are entitled to ask that their position be tested on a mark by mark basis. That would involve a lengthy and, in my view, unproductive series of comparisons involving both marks and goods/services. I believe the applicants are correct in saying that the opponents are unable to point to any of their marks which combine the word 'easy' with a word describing the nature of the consumer or customer as is the case with the applied for mark. Rather the opponents' case appears to rest on their ownership of marks employing 'easy' as the first element taken together with the overall content, construction and presentation of their marks.

20. On that basis I consider that their claims can be adequately tested by considering the six registrations or applications identified in the Annex to this decision. They come closest to the applied for mark in terms of the elements from which they are made up and, in the case of easyEverything, has been shown to be in use. They are also registrations/applications where there appears to be at least some overlap with the services of the application. I am not proposing to give detailed consideration to the opponents' best known mark easyJet. It is acknowledged that this mark is now very well known but not in relation to services that are relevant for Section 5(2)(b) purposes.

21. Before considering the registrations and applications thus identified I should make a few general observations on the character of the applied for mark. It consists of a device and the words and numeral easy4students.com. The device is a visually dominant element but, as the opponents suggest, does not easily lend itself to description. The numeral 4 is set against a contrasting background. In the context in which it appears it will be seen as standing for the word 'for'. The lower case lettering and the suffix .com are likely to convey the message that this is a website address. The distinctive character of a mark must be assessed by reference to the goods or services and the relevant public (European Court of First Instance in *Rewe Zentral v OHIM (Lite)* Case T-79/00. The applied for mark carries the unmistakable message that the underlying services are, or may be, aimed at students and offer ease of access or use. The

visually dominant device is very distinctive, the words and numeral easy4students.com much less so. I regard the totality as having a reasonably high degree of distinctiveness.

22. There are two general points made about the applicants' mark on which I should comment. It is said that extracts from their website (Exhibit JR8) show that they use the colour orange and that this is also easyGroup's corporate colour. If I understand the applicants' position correctly they claim to be using the colours yellow and blue. On the basis of the examples provided their mark is presented with the device element in what seems to me to be light orange and blue with the words easy and students.com in blue and the numeral 4 in black against a light orange background. Additionally, in the examples provided the word Liverpool (in lower case) is shown in light orange immediately after .com There is also a descriptive strapline in white. The whole is set against a black background. The easyGroup orange is a darker shade but I accept that that may be too fine a point of distinction given that the average consumer is unlikely to have the opportunity to compare the respective marks/colours in this way. Nevertheless if the examples of the applicants' mark shown are to be taken as paradigm use, then I am of the view that the overall content and presentation of the mark is not materially closer to any of easyGroup's marks as a result of the colour combinations used.

23. The parties have also sought to enhance their positions by seeking to make comparisons and to draw distinctions based on presentational aspects of the respective marks including the fonts employed and the use of lower case and of capitalised elements. These points are ultimately inconclusive. It is true that the opponents frequently present their marks with the initial letter of the second word capitalised (e.g. easyJet, easyEverything). But the applicants' mark employs no such element. Their company name does capitalise the S of Students but it also employs a capital letter for the E of Easy. It is, of course, the mark itself I must consider and not the company name. The use of lower case lettering and conjoining of elements is in conformity with common practice on the internet and is in itself unremarkable.

24. Turning to the opponents' registrations and application.

EASY (No. 1699792)

25. This is currently a pending CTM application. It will become an earlier trade mark within the meaning of Section 6(1)(a) subject to its being registered (Section 6(2)). The statement of grounds makes no claim to use of this mark.

26. EASY is a common dictionary word the meaning of which is readily comprehended. It would seem to be apt to describe a broad range of goods and services. If it is capable of achieving registration I would take the view that it can only have a very low level of distinctiveness.

27. On the basis of its current specification it is apparent that certain of the services in Classes 38, 41 and 42 overlap with those of the application in suit. The applicants have sought to distinguish the respective services. Thus they characterise their own Class 38 services as being provided to, from and by a website in contrast to the opponents' which they say are primarily access services to computers and the internet. It is too fine a distinction. The applicants'

services cover the provision of means of communication and the transmission of messages, documents, data etc and must be closely similar at least to the Class 38 services of No. 1699792.

28. The applicants say that their Class 41 services cover the provision of advice and information to students whereas the opponents' are primarily the provision of general entertainment and educational services. No such distinction is possible in my view. Both specifications cover educational information services and entertainment services. Identical services are in play.

29. Certain of the applicants' Class 42 services (notably career development advice) are not similar to any of the opponents' Class 42 services but the specifications have web design services in common. There is thus at least a measure of overlap. Further analysis and comparison of a lengthy list of goods and services would be otiose at this stage save to say that I do not accept the applicants' contention that it is possible to differentiate on the basis that their services are aimed at students whilst the opponents' services are not targeted at students even if the latter may be users. The opponents' services are not restricted in any way. More importantly, whatever the applicants' intentions, they have not restricted the provision of all their services to students.

30. It is beyond dispute that the applied for mark contains the whole of the opponents' pending CTM application. But that is not to say that it captures the distinctiveness of the opponents' earlier trade mark (see *10 Royal Berkshire Polo Club* [2001] RPC 32). In the context of the services applied for the public would readily recognise that the applied for mark is making a statement about the nature of the services involved and/or the audience to whom they are addressed. They would be highly unlikely to focus on the common element to the exclusion of the other matter in the mark. The single point of visual and aural similarity would be overridden by the quite different perceptions created in the minds of consumers by the totality of the applicants' mark. Bearing in mind also the very low degree of distinctiveness (at best) inherent in the opponents' mark, the result is that I do not consider there is a likelihood of origin confusion.

31. However, indirect as well as direct confusion must be considered. If the association between the marks causes the public to wrongly believe that the respective services come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the Section (*Canon v MGM*, paragraph 29). Can it be said that consumers (whom I take for present purposes to be the public at large) might think that services offered under the applicants' mark emanated from the same trade source as services offered under the mark EASY? That is to say would it be seen as a development of an existing trade but targeted this time at students and signposted as such in the mark itself. Such a proposition cannot be dismissed as entirely fanciful.

32. The underlying difficulty for the opponents is that EASY (even if it achieves registration) will remain a commonly used word with a very low claim to distinctive character. It follows that when it is used in a context such as the applicants' mark, the overriding impression is the message that these are services which are easy for students to use. *Sabel v Puma* stresses that consumers perceive marks as wholes and do not pause to analyse them. Faced with the applicants' mark, as I have suggested above, I think it highly probable that consumers would see

it as conveying a message about the target audience and ease of use and highly improbable that they would single out the first element as an indicator of trade origin to be associated with the opponents.

EASY EVERYTHING/easyEverything (Nos. 2182641, 2202916 and 1243948)

33. The distinctive character of the mark seems to me to reside in the bringing together of two very common words, one an adjective the other a pronoun, into an unusual whole, which carries no obvious or readily identifiable meaning. I regard it as having reasonably strong credentials from the point of view of its inherent distinctiveness.

34. The mark has been in use since June 1999 in relation to internet café services. There was a quantum leap in turnover from a modest base to £23.6 million in the period June 1999 to June 2001. There are now five stores in London and stores in Edinburgh, Glasgow and Manchester. The stores are being rebranded as easyInternetcafé. In all the circumstances it seems to me that the reputation attaching to the EASY EVERYTHING/easyEverything mark is likely to be localised in character and subject to the effects and timing of the rebranding exercise. None of this, of course, detracts from the fact that the marks are registered and with strong inherent distinctiveness.

35. Again the visual and aural similarities between the respective marks is limited to the first element. Conceptually, EASYEVERYTHING has no defined or discernible meaning and, as noted above, depends in part on the unusual conjoining of an adjective and pronoun as a key part of its distinctive character. In contrast the mark applied for contains a clear message alluding to the services and/or the audience for those services. In short the applied for mark does not capture the distinctive character of the opponents' marks and I can see no likelihood of confusion.

easydotcom and easy.com (Nos. 2240412 and 2247942)

36. The characteristics of these marks are quite different from EASY solus. They would be perceived as being domain names carrying the connotation of ease of access, simplicity of use or something similar in the internet field. easy.com is said to have been used for free e-mail services "since around 2000" though the evidence is silent as to the extent of use. In relation to such services the mark can at best be said to have only a modest claim to a distinctive character. The same is true to the extent that other goods and services within the specification of these applications may be the subject of internet ordering or be internet based. I will not repeat my earlier remarks in relation to the services save to say that there are at least some identical and/or closely similar services in each of the three overlapping Classes.

37. The opponents can reasonably say that their marks have a number of features in common with the applied for mark, specifically the elements easy and .com. There is also the conjoining of the elements of the marks but, as already noted, in the context of website addresses that is the normal form of presentation so it can scarcely be said to be a feature that contributes to making the marks distinctively similar. Against this the applied for mark is much longer and it is inconceivable that consumers would note the common elements without also noting the overall

context in which those elements were being used. There is additionally, the prominent device which is likely to feature in any visual appreciation of the mark even if its abstract nature does not permit of a ready description. Conceptually, the parties' marks allude to simplicity. But the key feature of the applied for mark is that it focuses on the user of the services. None of the opponents' marks operate in this way.

38. On a global appreciation of the matter having regard to the net effect of the similarities and differences in the marks I do not consider that confusion as to trade origin can be considered likely. I believe that would be the case even if the parties were to operate in the same business area as they would be entitled to do within the current scope of their specifications.

SECTION 5(3)

39. The scope of the Section has been considered in a number of cases notably *General Motors Corp. v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] ETMR 1071, *Daimler Chrysler v Alavi (Merc)* 2001 [RPC] 42 and *C.A. Sheimer (M) Sdn Bhd's TM Application (Visa)* 2000 RPC 484.

40. The objection is said only to arise to the extent that any of the opponents' goods or services are considered to be dissimilar to those of the application in suit. The *Chevy* case sets out the underpinning requirement that any mark relied on by an opponent must have the necessary reputation. The opponents here rely on EASYJET/easyJet, EASYRENTACAR/easyRentacar, EASYEVERYTHING/easyEverything, and easy.com.

41. The applicants concede that the opponents have a considerable goodwill in their airline and car rental businesses. These areas of trade are self-evidently different to the services applied for. It is well established that it is not necessary to establish confusion between the respective marks to succeed under this head (see *Typhoon* at page 1094 et seq). If the similarities between the marks are such as to lead to an association being made between them which in turn leads to one of the adverse consequences envisaged by the Section then the opponents may succeed.

42. I would hold here that the points of similarity between the marks relied on by the opponents and the mark applied for are far outweighed by the differences having regard to the distinctive character of the respective marks. That is likely to be sufficient in itself to dispose of the objection under Section 5(3). However, there is a further reason for dismissing this aspect of the opponents' case. The opponents' particular concern appears to be damage to the "easy" brand. Mr Rothnie's evidence suggests that the applicants' website contains links to a third party site that is said to contain shocking material. The exhibited website pages seems to me to range from the mildly amusing to material that is in very poor taste and beyond that to items that many would find offensive. I can, however, see nothing suggesting that easy4students.com have made themselves responsible for the content of these sites which are variously given as www.rotten.store.com, www.rotten.com and www.dailyrotten.com. At worst it might be said that the applicants have shown questionable judgement in providing a link to such sites. But, on the evidence before me, it is not the easy4students.com site that gives rise to any cause for complaint. Visitors to the 'rotten' sites would well understand that it is the owners of those sites and not easy4students.com who have made themselves responsible for the content.

43. The objection under Section 5(3) must fail because the opponents have failed to establish that any association would be made between their easyJet and easyRentacar marks and the applied for mark. Furthermore, the material that is said to be damaging to the reputation of the “easy” brand is not directly attributable to the applicants’ mark. I would come to the same view in relation to the mark easyEverything if it was held that that mark enjoyed a sufficient reputation to found a Section 5(3) action. I have separately held that there is no or insufficient evidence as to the use of easy.com to enable me to conclude that that mark enjoys a reputation.

SECTION 5(4)(a)

44. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- (1) that the opponents’ goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the applicants (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicants are goods or services of the opponents, and
- (3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicants’ misrepresentation.

45. The pleaded case is that the opponents’ goodwill arises “by virtue of the extensive use of the trade marks easyMoney, easyEverything, easyJet, easyRentacar and the many other trade marks of the Opponent which have the prefix easy in relation to travel services, paper goods, Internet café services, Internet services, financial services, on-line price comparator services, catering services, and transportation services”

46. Of the four marks specifically referred to easyEverything (the Internet café business) is the service area closest to the services of the applied for mark. I have considered the opponents’ position in this respect in relation to Section 5(2)(b). They are in no better position under Section 5(4)(a). The opponents’ goodwill under the marks easyJet (airline services) and easyRentacar (car rental) does not assist them. The differences in the parties’ respective marks combined with the differences between the service areas are such that there can be no misrepresentation or damage. The position in relation to easyMoney is similar save that it was not launched until September 2001 (Mr Rothnie’s second witness statement, paragraph 4) that is to say at or about the relevant date in these proceedings and would be heavily dependent on the claims in relation to pre-launch publicity for any goodwill.

47. Finally, I should comment briefly on references in the opponents’ evidence to their family of marks. I take this to represent a claim in relation to the prefix ‘easy’. Whether it also relates to other features of the mark (e.g. the presentation of the lettering and the colour orange) is not

clear. The point was not expressly raised or particularised in the statement of grounds. Given the general lack of focus in the grounds I do not consider that the applicants should be expected to deal with any such claim. The judgment in the easyRealestate case makes it clear that some care is needed in determining the distinguishing features of the opponents' signs (see, paragraph 7 of the judgment). I note too that the Deputy Judge said "I agree with the defendant that the claimants are not entitled to appropriate the word "easy" and prevent any businessman from using any name which includes the word "easy"." The judgment in that case was delivered on 19 February 2001 (albeit that the evidence would have been from a slightly earlier period). I see no basis for concluding that the position was materially different by 15 September 2001, the relevant date in the current proceedings.

COSTS

48. The opposition has failed on all the grounds on which it was brought. The applicants are entitled to a contribution towards their costs. Their evidence was not extensive and consisted largely of submissions. Like me they have had to address broadly based and largely unfocussed pleadings. The opponents have put little effort into identifying which marks they rely on for their Section 5(2) case and it would have been unreasonable to expect the applicants to address their extensive portfolio of marks on an individual basis.

49. In the circumstances I propose to make an award in favour of the applicants towards the upper end of the scale. I order the opponents to pay the applicants the sum of £2000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of January 2004

M REYNOLDS
For the Registrar
the Comptroller-General

		<p>airport check-in services; arranging of transportation of goods, passengers and travellers by land; bus transport services, car transport services, coach services; airline services; baggage handling services; cargo handling and freight services; operating and providing facilities for tours; cruises, excursions and vacations; chartering of aircraft; rental and hire of vehicles, boats and aircraft; aircraft fuelling services, aircraft parking services; ambulance services; travel agency and tourist office services; advisory and information services relating to the aforesaid services; information services relating to transportation services, including information services provided on-line from a computer database or the Internet; travel reservation and travel booking services provided by means of the world-wide web.</p> <p>41 Information relating to entertainment and education, provided on-line from a computer database or the Internet; entertainment services provided on-line from a computer database or the Internet; educational information provided on-line from a computer database or the Internet; rental of electric and electronic goods, clothing, toys, games and playthings.</p> <p>42 Temporary accommodation; catering, hotel, restaurant, café and bar services; reservation services for hotel accommodation; provision of exhibition facilities; meteorological information services; hairdressing, grooming and beauty salon services; security services; airport security services;</p>
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			airline passenger security screening services; design of computer software; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; posting, creating and maintaining websites for others; leasing access time to a computer database; provision of access to computers and the Internet; Internet cafe services.
2182641 (UK)	EASY EVERYTHING	42	Restaurant and bar services; catering services; design of computer software; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; hosting, creating and maintaining web sites for others; leasing access time to a computer data base.
2202916 (UK)		42	Restaurants and bar services; catering services; design of computer software; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; hosting, creating and maintaining web sites for others; leasing access time to a computer data base.
1243948 (CTM)		09 35 38	Computer software; computer hardware; pre-recorded CD Roms and other disk carriers; sunglasses. Business information services; on-line processing of mail orders. Provision of access to information on-line from the Internet; providing access to a wide range of general

		41 42	<p>interest information via computer networks; providing on-line access to news, weather, sports, current events and reference materials; computer bulletin and message boards in fields of general interest; linking to web sites of others; providing multiple-user access to computer networks for the transfer and dissemination of a wide range of information.</p> <p>On-line contests and sweepstakes.</p> <p>Restaurant and bar services; catering services; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; creating and maintaining web-sites; hosting the web sites of others; consulting and technical assistance in the fields of designing, creating, hosting, maintaining, operating, managing, advertising, and marketing of on-line commerce web sites; provision of access to information on-line from a computer database; technical consultancy and advising in the establishment of on-line retail services; providing on-line facilities for real-time interaction with other computer users concerning topics of general interest and playing games; on-line directory services to help locate people, places, organisations, phone numbers, home pages, and electronic mail address; computer services, namely, creating indexes of information, sites, and other resources available on computer networks; searching and retrieving information on computer networks; leasing access time to a computer database (other than by Internet service providers).</p>
2240412 (UK)		16	Printed matter and publications;

		<p>books, manuals, pamphlets, newsletters, brochures, albums, newspapers, magazines and periodicals; tickets, vouchers, coupons and travel documents; documents, tickets and publications, all relating to travel arranged by means of the world-wide web; travel documents folders; travel guide books; travellers cheques; playing cards; identity cards; labels and tags; posters, postcards, stationery, writing instruments, wrapping materials, calendars, diaries, photographs, gift cards and greetings cards; badges; teaching and instructional materials; promotional and advertising material; signs of paper or cardboard.</p> <p>35 Advertising; business management; business administration; office functions; publicity, promotional services, import-export agency services, business information services, organising exhibitions for commercial or advertising purposes; auctioneering services.</p> <p>36 Financial and insurance services.</p> <p>38 Telecommunication services.</p> <p>39 Transportation of goods, passengers and travellers by air; airport check-in services; arranging of transportation of goods, passengers and travellers by land; bus transport services, car transport services, coach services; airline services; baggage handling services; cargo handling and freight services; operating and providing facilities for tours; cruises, excursions and vacations; chartering of aircraft; rental and hire of vehicles, boats and aircraft; aircraft fuelling services, aircraft</p>
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		<p>parking services; ambulance services; travel agency and tourist office services; advisory and information services relating to the aforesaid services; information services relating to transportation services, including information services provided on-line from a computer database on the Internet; travel reservation and travel booking services provided by means of the world-wide web.</p> <p>41 Information relating to entertainment and education, provided on-line from a computer database or the Internet; entertainment services provided on-line from a computer database or the Internet; educational information provided on-line from a computer database or the Internet; rental of electric and electronic goods, clothing, toys, games and playthings.</p> <p>42 Temporary accommodation; catering, hotel, restaurant, cafe and bar services; reservation services for hotel accommodation; provision of exhibition facilities; meteorological information services; hairdressing, grooming and beauty salon services; security services; airport security services; airline passenger security screening services; design of computer software design, drawing and commissioned writing, all for the compilation of web pages on the Internet; posting, creating and maintaining websites for others; leasing access time to a computer database; provision of access to computers and the Internet; Internet services; provision of on-line services.</p>	
2247942 (UK)	Easy.com	09	Computer software; computer

		16	hardware; pre-recorded CD Roms and other disk carriers; sunglasses. Printed matter and publications; books, manuals, pamphlets, newsletters, brochures, albums, newspapers, magazines and periodicals; tickets, vouchers, coupons and travel documents; documents, tickets and publications, all relating to travel arranged by means of the world-wide web; travel documents folders; travel guide books; travellers cheques; playing cards; identity cards; labels and tags; posters, postcards, stationery, writing instruments, wrapping materials, calendars, diaries, photographs, gift cards and greetings cards; badges; teaching and instructional materials; promotional and advertising material; signs of paper or cardboard.
		35	Advertising; business management; business administration; office functions; publicity, promotional services, import-export agency services, business information services, organising exhibitions for commercial or advertising purposes; auctioneering services.
		36	Financial and insurance services.
		38	Telecommunication services.
		39	Transportation of goods, passengers and travellers by air; airport check-in services; arranging of transportation of goods, passengers and travellers by land; bus transport services, car transport services, coach services; airline services; baggage handling services; cargo handling and freight services; operating and providing facilities for tours; cruises, excursions and vacations;

		<p>chartering of aircraft; rental and hire of vehicles, boats and aircraft; aircraft fuelling services, aircraft parking services; ambulance services; travel agency and tourist office services; advisory and information services relating to the aforesaid services; information services relating to transportation services, including information services provided on-line from a computer database or the Internet; travel reservation and travel booking services provided by means of the world-wide web.</p> <p>41 Information relating to entertainment and education, provided on-line from a computer database or the Internet; entertainment services provided on-line from a computer database or the Internet; educational information provided on-line from a computer database or the Internet; rental of electric and electronic goods, clothing, toys, games and playthings.</p> <p>42 Temporary accommodation; catering, hotel, restaurant, cafe and bar services; reservation services for hotel accommodation; provision of exhibition facilities; meteorological information services; hairdressing, grooming and beauty salon services; security services; airport security services; airline passenger security screening services; design of computer software; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; posting, creating and maintaining websites for others; leasing access time to a computer database; provision of access to computers and the Internet;</p>
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			Internet services; provision of on-line services.
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