

O/184/21

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
REGISTRATION NO. 3442966  
IN THE NAME OF AGILE DATA WAREHOUSE SOLUTIONS LTD  
FOR THE TRADE MARK:**



**IN CLASSES 9, 35, 41 & 42**

**AND**

**AN APPLICATION FOR A DECLARATION OF INVALIDITY  
UNDER NO. 503074  
BY EASYGROUP LTD**

## **BACKGROUND AND PLEADINGS**

1. Agile Data Warehouse Solutions LTD (“the proprietor”) is the registered proprietor of the trade mark displayed on the cover page of this decision, under registration number 3442966 (“the proprietor’s mark”). The proprietor’s mark was filed on 10 November 2019 and was entered into the register on 7 February 2020. It stands registered in respect of the following goods and services:

Class 9: Data processing apparatus and instruments; data processing equipment; data processing programs; data processing systems; training software; security software; computer software for the remote control of security apparatus.

Class 35: Administrative data processing; administrative support and data processing services; advisory services relating to data processing; automated data processing; business consultancy services relating to data processing; computer data processing; data processing.

Class 41: Training courses; training in administration; training in business management; training in business skills; training in communication techniques; training in computer programming; training in data processing techniques; training in the field of business management; training in the operation of computerised systems; training in the operation of software systems; training in the use and operation of data processors; training relating to data processing; training relating to sales; training services related to business; training.

Class 42: Computer security consultancy; computer security services for protection against illegal network access; computer security services in the nature of administering digital certificates; computer security system monitoring services; computer security threat analysis for protecting data; consultancy in the field of computer security; consultancy in the field of data security; consultancy in the field of security software; data security consultancy; data security services; data security services [firewalls]; design and development of internet security programs.

2. On 17 March 2020, easyGroup Ltd (“the applicant”) made an application for a declaration of invalidity in respect of the proprietor’s mark pursuant to section 47(2) of the Trade Marks Act 1994 (“the Act”). The application is based upon sections 5(2)(b) and 5(3) of the Act and is directed against all the goods and services listed above.

3. In respect of the section 5(2)(b) claim, the applicant relies upon the following trade marks:

**EASYHUB**

EUTM no. 17929119

Filing date: 11 July 2018

Registration date: 27 December 2018

(“the EASYHUB mark”)

**EASYNETWORKS**

EUTM no. 18060442

Filing date: 3 May 2019

Registration date: 8 September 2020

(“the EASYNETWORKS mark”)



EUTM no. 18060440

Filing date: 3 May 2019

Registration date: 21 December 2020

(“the figurative mark”)

**EASYGROUP**

EUTM no. 14920391

Filing date: 17 December 2015

Registration date: 26 May 2016

(“the EASYGROUP mark”)

**easyValue**

EUTM no. 16140782

Filing date: 7 December 2016

Registration date: 26 October 2017

("the easyValue mark")

4. The goods and services relied upon by the applicant are included as an annex to this decision. The applicant contends that the proprietor's mark is similar to each of its earlier marks as they all consist of the word 'easy' conjoined to another word. Moreover, the applicant argues that the goods and services of the competing marks are either identical or similar. As a result of these factors, the applicant submits that there is a likelihood of confusion.

5. For the purposes of its claim under section 5(3), the applicant relies upon its EUTM number 10584001, **EASYJET** ("the EASYJET mark"). The EASYJET mark was filed on 24 January 2012 and was registered on 9 January 2015. The applicant claims to have a significant reputation in respect of the following services:

Class 39: Transport; packaging and storage of goods; travel arrangement; travel information; transportation of goods, passengers and travelers by air; airline and shipping services; airport check-in services; airline services; baggage handling services; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; chartering of aircraft; airport transfer services; airport parking services; aircraft parking services; travel agency services; tourist office services; advisory and information services relating to the aforesaid services; information services relating to transportation services, travel information and travel booking services provided on-line from a computer database or the Internet.

6. The applicant submits that the proprietor's mark looks like an extension of its business and, as such, the average consumer would make a link between the competing marks and mistakenly believe that they are connected. In this regard, the applicant contends that the proprietor would obtain an unfair commercial advantage by free-riding on the applicant's reputation of great-value, customer-friendly goods and

services, and that use of the proprietor's mark would enable it to achieve greater sales without marketing expense or time. The applicant also argues that its reputation would be diminished if the proprietor's mark were used in relation to inferior goods and services. Moreover, the applicant submits that the power of attraction of the EASYJET mark and its ability to distinguish the goods and services of the applicant would be diminished by use of the proprietor's mark.

7. The proprietor filed a counterstatement denying the claims made.

8. The applicant's trade marks qualify as earlier trade marks under section 6 of the Act.<sup>1</sup> Those relied upon for the applicant's claim under section 5(2)(b) had not completed their respective registration processes more than five years before the date of the application for invalidation. The mark relied upon for the applicant's claim under section 5(3) had completed its registration process more than five years before that date and would, ordinarily, be subject to proof of use. However, the proprietor has not sought to require the applicant to provide proof of use of this mark. As such, none of the earlier marks is subject to the proof of use requirements specified in section 47(2B) of the Act and, as a consequence, the applicant can rely upon all of the goods and services identified.

9. The applicant is represented by Kilburn & Strode LLP, whereas the proprietor is unrepresented. Both parties filed evidence in these proceedings, which will be summarised to the extent that it is considered necessary. Both parties were given the option of an oral hearing, though neither asked to be heard on this matter. Neither party filed written submissions in lieu of a hearing, though the applicant filed written submissions during the evidence rounds. I do not intend to summarise these but will refer to them throughout this decision, as and where necessary. This decision is taken following a careful perusal of the papers before me, keeping all submissions in mind.

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<sup>1</sup> Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. Tribunal Practice Notice 2/2020 refers.

10. Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive and, therefore, this decision continues to make reference to the trade mark case law of the EU courts.

## **EVIDENCE**

### **Applicant's evidence**

11. The applicant's evidence consists of the witness statement of Mr Ryan Edward Pixton dated 10 August 2020. Mr Pixton is a trade mark attorney in the employ of Kilburn & Strode LLP, the applicant's representatives in these proceedings. His statement serves as a vehicle for introducing Exhibits REP1 to REP3 into the evidence.

12. Exhibit REP1 is the witness statement of Sir Stelios Haji-Ioannou dated 4 August 2017. Sir Stelios is the founder and director of the applicant. His statement is described as a "general" statement regarding the "EASY family of brands". I note that various documents are referred to throughout the statement that have not been filed in these proceedings. Moreover, I consider much of the statement irrelevant as it refers to trade marks that are not relied upon for the purposes of the present application. However, the most relevant evidence adduced by Sir Stelios appears to be as follows:

- The development of the 'EASY' family of brands began with the launch of the low-cost airline 'easyJet'. The first 'easyJet' trade mark was registered in the UK on 5 April 1995. Thereafter, Sir Stelios started expanding the 'EASY' family of brands;
- Other names for the brand were considered, though Sir Stelios arrived at 'EASY' as he felt that the word conveyed the right proportion of affordability and convenience;

- In order to stand out from competitor airlines, Sir Stelios decided upon the colour orange for the 'easyJet' branding. In addition to the 'easy' prefix, he decided that all 'EASY' brands would use the same get-up. The second word or phrase following the 'easy' prefix would be appropriate to the goods or services provided by that business and its first letter would be capitalised. To conform with brand identity, each business name would be displayed in a white, Cooper Black font on an orange background ("the EASY get-up"). Sir Stelios states that the use of this get-up reinforces the links between the businesses that are formed by the common use of 'EASY' in the minds of consumers;
- The business model was to develop a family of brands all sharing the prefix 'easy'. To this end, in 1998 Sir Stelios brought the ownership of the intellectual property relating to all 'EASY' businesses into one company, easyGroup Limited (previously easyGroup IP Licensing Limited). Rights were then licensed back to the individual businesses;
- Sir Stelios explains that 'EASY' business ventures are intended to benefit the many, rather than the few, and are designed with competitive pricing so as to reach as many consumers as possible. Sir Stelios says that 'EASY' businesses are not intended to be seen as "big" businesses. Instead, they position themselves in the market to challenge big businesses on behalf of the consumer. The brand values are described as "great value" and "keep it simple", amongst others;
- Under easyGroup, Sir Stelios has founded many businesses that offer a diverse range of goods and services. While many of those described are not relevant to these proceedings, I note Sir Stelios refers to 'easyValue', a price comparison website;
- Sir Stelios outlines that easyGroup is not just a corporate or legal vehicle, but also a member of the 'EASY' family of brands, recognised in its own right. EasyGroup had its own website ([www.easygroup.co.uk](http://www.easygroup.co.uk)), its own stationery and appeared in the header of purchase orders and letters. Further, that there has

been extensive press coverage in the UK and abroad featuring easyGroup and the other brands;

- Sir Stelios confirms the number of passengers that had flown with 'easyJet' from 1995 to 2017. I do not intend to reproduce these figures in full, though note that 'easyJet' had 65,349,451 passengers in the year ending 31 January 2015, 70,082,951 in the year ending 31 January 2016 and 74,921,296 in the year ending 31 January 2017. Since 1995, 'easyJet' has flown to various countries including Spain, France, Greece, Portugal, Germany, Switzerland, Italy, Austria and Belgium. 17 of the 18 routes described by Sir Stelios depart from or arrive at destinations in the UK. Moreover, 'easyJet' has operated domestic flights between these UK destinations;
- Between 2011 and 2016, the 'easyJet' website ([www.easyjet.com](http://www.easyjet.com)) had 3,797,300,717 page views from the UK and 536,756,400 from Germany. Sir Stelios provides an annual breakdown of worldwide users and page views of the 'easyJet' website between 2011 and 2017. While I do not intend to reproduce these figures in full, I note that the website had 1,625,290,017 page views in 2015, 1,435,611,431 in 2016 and 919,258,176 in 2017;<sup>2</sup>
- In addition to airline services, 'easyJet' has provided holiday and accommodation services. These were advertised in the airline's in-flight magazine and were available through the [easyJet.chaletfinder.co.uk](http://easyJet.chaletfinder.co.uk) and [easyJet4Ski.com](http://easyJet4Ski.com) websites;
- Sir Stelios states that in 2011 'easyJet' had a turnover of £3.45 billion, rising to £3.85 billion in 2012. Total revenue for the company is given as £4.26 billion and £4.25 billion for 2013 and 2014, respectively. Between 1999 and 2006, the staff and passengers of 'easyJet' were featured in the television series 'Airline'. At its peak, 'Airline' attracted around 9 million viewers per episode in 2001;

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<sup>2</sup> Due to the date of the witness statement, no further statistics have been provided for the years since July 2017.

- In June 1999, Sir Stelios acquired the domain name 'easy.com'. Some of the 'EASY' brands were promoted on the website, which also offered a free web-based email system. At the time of his statement, he says that there remained around 5,000 users of the '@easy.com' email addresses. Sir Stelios provides statistics for the 'easy.com' website between 2012 and July 2017. I do not intend to reproduce these in full, though note that the website had 3,305,865 page views in 2015, 3,349,887 in 2016 and 2,400,436 in 2017;<sup>3</sup>
- Sir Stelios explains that 'easyValue' was in operation from November 2000. He describes it as a price comparison service, based at [www.easyValue.com](http://www.easyValue.com). The 'EASY' get-up was also used for this brand. Sir Stelios refers to press coverage ahead of the launch date, though I note that no evidence of the same has been filed. From its launch until June 2001, monthly visits increased to over 1 million and "finance was over £250,000". Agreements were entered into with third parties which allowed 'easyValue' to compare and advertise goods and services on its website. 'EasyValue' also entered into agreements for the buying and selling of advertising space with both third parties and other 'EASY' businesses. Sir Stelios provides turnover and revenue figures for 'easyValue' from 2000 to 2003. Although I do not intend to reproduce these in full, I note that revenue peaked in 2001 at £76,983;

13. Exhibit REP2 to Mr Pixton's statement comprises press articles and copies of annual reports from 'easyJet' in relation to airline and related services in the UK. The first page is an extract from what appears to be an 'easyJet' webpage. The print was obtained on 13 November 2017 and describes 'easyJet' as "Europe's leading short-haul airline" that has a network of 802 routes across 132 airports in 31 countries. Pages two to five are extracts from reports, detailing 'easyJet' results for the years ending 30 September 2016, 30 September 2015, 30 September 2014 and 30 September 2013. I note that its revenue was £4,669 million in 2016, £4,686 million in 2015, £4,527 million in 2014 and £4,258 million in 2013. Also included in Exhibit REP2 is a print of the Wikipedia entry for 'easyJet' (<https://en.wikipedia.org/wiki/EasyJet>),

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<sup>3</sup> Due to the date of the witness statement, no further statistics have been provided for the years since July 2017.

which provides information about the business and its history. Moreover, an extract from another 'easyJet' webpage is evidenced. The print was obtained on 26 June 2017 and displays a map of Europe entitled 'Route Map'. There are numerous place markers on the map which, from what I can gather, are locations of airports in the 'easyJet' network. The remainder of Exhibit REP2 consists of various news articles dated between June 2014 and May 2017 which refer to 'easyJet' and describe it as an airline.

14. Exhibit REP3 to Mr Pixton's statement is the witness statement of Mr Christopher Griffin dated 4 April 2017. Mr Griffin is the Director of the Museum of Brands. He states that he is acknowledged as an expert in the field of branding. Mr Griffin says that the fame of the 'EASY' brand commenced with the launch of 'easyJet' in 1995 and has been more expansive than the airline alone. Mr Griffin continues by stating that the 'EASY' brand has a distinctive style, using the word 'easy' followed by the relevant product or service, with its first letter capitalised. Whilst he provides examples such as 'easyHotel', none is relevant to the present proceedings. According to Mr Griffin, there would be "widespread knowledge of the 'easy' brand, because of the variety and number of 'easy brands licensed or used by easyGroup". In this regard, he states:

"(4) The widespread licensing of the mark 'easy' into fields as diverse as travel, retail, foodstuffs, gyms and estate agency has led to a recognition that commercial activities with an 'easy' prefix are likely to emanate from easyGroup. This association becomes a certainty where either the colour orange or the font Cooper Black is used together with an 'easy' prefixed name, as both the use of the colour orange and the font Cooper Black have become synonymous with the use made by easyGroup."

15. Mr Griffin concludes his evidence by outlining the values which consumers are likely to associate with the 'EASY' brand; in his view, these include excellent value, innovation and reaching out to the many, not the few, amongst others.

## Proprietor's evidence

16. The proprietor's evidence consists of the witness statement of Mr Andreas Schindler dated 23 November 2020, together with Exhibits 1 and 2. Mr Schindler is the director and owner of the proprietor.

17. Mr Schindler begins by explaining that he was aware of the applicant when he designed the proprietor's mark and that it is of the utmost importance to him that the parties' respective brands cannot be confused. He states that he "reviewed the easyGroup Brand manual to ensure we stay as far away as possible from everything that makes a brand an easyGroup brand". Using the easyGroup Brand Manual (Exhibit 2) and the witness statement of Sir Stelios (Exhibit 1), Mr Schindler seeks to differentiate the proprietor's mark from 'EASY' brands. In this regard, he discusses the features of the foregoing by reference to colour, font and respective wordings. Moreover, he says that a trade mark "starting with easy alone does not suggest easyGroup". Mr Schindler also comments upon the respective target audiences of the parties as well as the respective goods and services. Much of Mr Schindler's statement appears to contain submissions, rather than evidence of fact, and I intend to treat them as such. Nevertheless, in his statement, Mr Schindler states:

- The proprietor conducted a survey in Austria and the UK where it asked business people in its target audience about their perception of several designs of its brand. Only orange designs were associated with easyGroup. However, no evidence as to the parameters, results or sample size, for example, of the survey has been provided;
- Each 'EASY' brand is obligated to use the 'easy' prefix, Cooper Black font and white text on an orange background. The proprietor's mark is written in two fonts, namely, Ingra and Myriad Pro;
- There are thousands of trade marks registered in the UK starting with the word 'easy' and only a fraction of these are owned by the applicant;

- The parties have different target audiences. The proprietor’s business targets medium to large enterprises, whereas the applicant offers goods and services “for the many, not the few”.

## **PRELIMINARY ISSUES**

18. In its evidence, the proprietor argues that, in practice, the respective parties provide different goods and services that are targeted at different audiences, intimating that this defeats any possibility of confusion under section 5(2)(b) of the Act. For reasons which I will now explain, the proprietor’s points on this issue will, as a matter of law, have no bearing on the outcome of these proceedings.

19. A trade mark registration is essentially a claim to a piece of legal property (the trade mark). Every registered trade mark is entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar goods/services if there is a likelihood of confusion. If a trade mark has been registered for five years before the date on which an application for a declaration of invalidity is filed, Section 47(2B) of the Act is engaged and the applicant can be required to provide evidence of use of its marks. Until that point, however, the marks are entitled to protection in respect of the full range of goods/services for which they are registered.

20. The marks relied upon by the applicant under section 5(2)(b) had not been registered for five years at the date on which the application for a declaration of invalidity was filed. Consequently, the applicant is not required to prove use for any of the goods or services for which the earlier marks relied upon under this ground are registered. The earlier trade marks are entitled to protection against a likelihood of confusion with the proprietor’s mark based on the ‘notional’ use of those earlier marks for all the goods and services relied upon.

21. So far as the proprietor’s claimed use of its mark is concerned, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06), the Court of Justice of the European Union (“CJEU”) stated at paragraph 66 of its judgment that, when assessing the likelihood of confusion, it is necessary to consider all the circumstances in which a mark might be used. As a result, even though the proprietor

has suggested the ways in which the mark will be used, my assessment later in this decision must take into account only the proprietor's mark – and its specification – and any *potential* conflict with the applicant's earlier marks. Any differences between the *actual* goods and services provided by the parties, or differences in their trading styles, are not relevant unless those differences are apparent from the marks. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

22. The proprietor has also referred to other trade mark registrations containing the word 'EASY'. I must clarify that the existence of other registered marks which begin with the word 'EASY' will not have any bearing on whether there exists a likelihood of confusion in these proceedings. This is because there is no evidence that the marks are in use and that consumers have become accustomed to differentiating between them. In *Zero Industry Srl v OHIM*, Case T-400/06, the General Court (“GC”) stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865,

paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71.”

23. Again, my assessment later in this decision must take into account only the proprietor’s mark – and its specification – and any potential conflict with the applicant’s earlier marks. The existence of other registered marks is not relevant for the purposes of this assessment.

## **DECISION**

24. Sections 5(2)(b) and 5(3) of the Act have application in invalidation proceedings because of the provisions of section 47 of the Act, which states as follows:

“47. – (1) [...]

(2) The registration of a trade mark may be declared invalid on the ground –

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

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

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

[...]

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

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

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

(c) the use conditions are met.

[...]

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

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

25. Section 5(2)(b) of the Act reads as follows:

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

(a) [...]

(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 or association with the earlier trade mark.”

26. Section 5(3) of the Act reads as follows:

“5(3) A trade mark which –

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

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

27. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## **Comparison of goods and services**

28. Some of the contested goods and services, e.g. ‘*data processing equipment*’ and ‘*data security consultancy*’, are clearly identical to the goods and services relied upon by the applicant. Therefore, for reasons of procedural economy, I will proceed on the basis that all of the goods and services at issue in these proceedings are identical. If the application fails, even where the goods and services are identical, it follows that the application will also fail where the goods and services are only similar.

## **The average consumer and the nature of the purchasing act**

29. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

30. 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 (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

31. Some of the goods and services at issue in these proceedings are available to both the general public and members of the business community. Some, such as the services in class 35, are more likely to be purchased by business users alone.

32. In respect of the general public, the goods and services are likely to be more occasional purchases. The cost of the goods and services will vary, though, overall, they are likely to require an average outlay. The purchasing of the goods and services

is likely to follow a measured thought process and will not merely be casual; for instance, the general public will consider factors such as cost and product specifications when selecting the goods in class 9 and, when selecting the services in class 41, they will consider factors such as the range of courses on offer and the performance or outcomes of previous students. In light of the above, I find that the level of attention of the general public would be medium. The goods are typically purchased by the general public from physical retail establishments, or their online equivalents, after viewing information on physical displays or the internet. In these circumstances, visual considerations would dominate. However, I do not discount aural considerations entirely as the general public may wish to discuss the products with a sales assistant prior to purchasing the goods. The services are likely to be purchased after viewing information on the internet, in brochures or prospectuses. Again, visual considerations would dominate, though I do not discount aural considerations completely as members of the general public may receive word of mouth recommendations or engage in verbal consultations with the service providers before purchasing the services.

33. As for business users, the goods and services are likely to be purchased more frequently for the ongoing administrative, training or technological needs of the business. The selection of the goods would be relatively important for consumers from the business community as they will wish to ensure that they are choosing products which reflect their specification requirements, in accordance with the needs of the business. Similarly, the selection of the services would also be relatively important for these consumers as they will wish to ensure that they are provided to a professional standard and will be suitable for their needs. Business users may also consider factors such as the service provider's technical knowledge and previous outcomes when selecting the services. In light of the above, I find that the level of attention of members of the business community would be higher than normal. The goods are typically sold by brick-and-mortar retail establishments, or their online equivalents, where they are likely to be purchased after viewing information on physical displays or on the internet. In these circumstances, visual considerations would dominate. However, I do not discount aural considerations entirely as it is possible that the purchasing of these kinds of goods would involve discussions with sales representatives or word of mouth recommendations. The services are likely to be purchased after viewing information

on the internet, in business prospectuses or brochures. Overall, I am of the view that the purchasing process would be predominantly visual in nature. However, I do not discount aural considerations as it is possible that the purchasing of the services would incorporate verbal consultations or word of mouth recommendations.

### **Distinctive character of the earlier mark**

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases 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).”

35. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will be

somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced as a result of it having been used in the market.

36. The applicant has argued that the EASYGROUP mark “enjoys elevated distinctive character through the use made of it”. I do not agree: the evidence filed by the applicant does not demonstrate that this mark, nor any of the other earlier marks relied upon under section 5(2)(b) for that matter, have become more distinctive through use in relation to the goods and services relied upon. The majority of the applicant’s material evidence in these proceedings relates to its airline services provided under the EASYJET mark, which is not relied upon for the purposes of this claim. In respect of the easyValue mark, whilst I note that the applicant’s evidence suggests that this was in operation from November 2000, no evidence of the mark being used on the market has been provided. As such, I am unable to determine how long-standing or regular the use of the mark has been. Moreover, no evidence of press coverage or promotion of the mark has been filed. Limited turnover figures have been provided, though turnover of £144,569 over a 4-year period ending 12 years before the date of the application is not sufficient for me to conclude that the mark had an enhanced level of distinctive character at the relevant date. In relation to the other earlier marks, the applicant has not provided any evidence of the marks being used on the market or any information as to the market share held by the marks, the amounts invested by the applicant in promoting the marks or turnover generated under the marks. Therefore, I have only the inherent position to consider.

37. Four of the earlier marks are in word-only format and comprise the words ‘EASYHUB’, ‘EASYNETWORKS’, ‘EASYGROUP’ and ‘easyValue’, respectively. Each of these marks consists of two recognisable dictionary words which are conjoined. The word ‘EASY’ will be perceived as descriptive of the nature of the goods and services, namely, that they are easy to use or access. The word ‘HUB’ is descriptive of some of the services in respect of which the EASYHUB mark is relied upon and allusive of others. Similarly, the word ‘NETWORKS’ is descriptive of some of the goods and services for which the EASYNETWORKS mark is relied upon and allusive of others. The words ‘GROUP’ and ‘Value’ cannot be said to be descriptive of the goods and

services to which they relate. However, neither are they particularly distinctive, the former referring to a number of connected businesses and the latter having laudatory connotations. It is considered that the distinctive character of these earlier marks lies in the combination of the words, i.e. the marks as wholes. Overall, I find that these earlier marks have between a low and medium degree of inherent distinctive character.

38. The figurative mark consists of the word 'easyNetworks', presented in a white, slightly stylised font on an orange background. The word 'easy' will be perceived by consumers in the same manner as described above, while the word 'Networks' is descriptive of some of the goods and services in respect of which the mark is relied upon and allusive of others. The presentation in a white font on an orange background will make a contribution to the distinctiveness of the mark. Overall, I find that the figurative mark possesses a medium degree of inherent distinctive character.

### **Comparison of trade marks**

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

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

40. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks.

Due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

41. The competing trade marks are as follows:

The earlier marks	The proprietor's mark
<p style="text-align: center;">EASYHUB</p> <p style="text-align: center;">EASYNETWORKS</p> <div style="text-align: center;">  </div> <p style="text-align: center;">EASYGROUP</p> <p style="text-align: center;">easyValue</p>	<div style="text-align: center;">  </div>

42. I have lengthy submissions from both parties on the similarity of the marks which I do not propose to reproduce in full here. However, I have taken them all into consideration in reaching my decision.

Overall impression

43. The proprietor's mark is figurative and consists of the words 'easy digital' in a standard typeface. The word 'easy' is presented in a light blue colour, whereas the word 'digital' is in bold and is red in colour. The words 'easy' and 'digital' are ordinary dictionary words. The former will be perceived as a descriptive reference to goods and services that are easy to use or access. The latter will be understood as describing goods and services that involve or relate to the use of computer technology. Above the word 'easy' appears a device which is comprised of four red rough arrow shapes and four light blue circles. The device is oriented so that the shapes fan clockwise. The proprietor has submitted that the shapes represent "celebrating people with raised

arms". I do not agree that this is how the average consumer would perceive them; rather, in my view, the device will be seen as an indefinable assortment of decorative shapes. Due to their relative size and position within the mark, as well as the eye being naturally drawn to elements of trade marks that can be read,<sup>4</sup> it is considered that the combination of the words 'easy digital' provides an increased contribution to the overall impression of the mark, notwithstanding the descriptive meaning of the words. The device and use of colour, while still contributing, will play slightly reduced roles in the overall impression of the mark.

44. The EASYHUB, EASYNETWORKS, EASYGROUP and easyValue marks are in word-only format. Whilst they are conjoined, as each mark consists of two easily recognisable dictionary words, the average consumer will still identify them. The overall impression of each of these earlier marks lies in the combination of the words.

45. The figurative mark consists of the word 'easyNetworks', presented in a white font on an orange background. The word element will dominate the overall impression of the mark. While still contributing, the font and colour combination will play much lesser roles.

#### Visual comparison

*The EASYHUB, EASYNETWORKS, EASYGROUP and easyValue marks and the proprietor's mark*

46. Visually, the competing trade marks are similar as they all share the common identical word 'EASY' at the beginning of the marks, a position which is generally considered to have more impact due to consumers in the UK reading marks from left to right.<sup>5</sup> The earlier marks are plain words and the words of the proprietor's mark are stylised. Notwithstanding this, I do not consider the font in the proprietor's mark to be a point of significant difference as it is unremarkable. As the earlier marks are in word-only format, notional and fair use would allow them to be presented in any standard

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<sup>4</sup> *Wassen International Ltd v OHIM*, Case T-312/03

<sup>5</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

font. The competing marks visually diverge as a result of the different words which follow the word 'EASY'. A further difference is the device in the proprietor's mark; although I have found the device to play a reduced role, it would not be overlooked by consumers and has no counterpart in the earlier marks. Bearing in mind my assessment of the overall impressions, I consider there to be between a low and medium degree of visual similarity between the marks.

#### *The figurative mark and the proprietor's mark*

47. These marks share the same visual similarities and differences that I have identified above. However, given that the figurative mark is presented in a white, slightly stylised font on an orange background, there is an additional difference between the competing marks. In light of the same, I find that these marks are visually similar to a low degree.

#### Aural comparison

48. In my view, having been identified, the two dictionary words comprising each of the earlier marks will be articulated by consumers. The two words in the proprietor's mark will also be pronounced, though the device will not be articulated in any way. The competing marks aurally coincide insofar as they all begin with the identical word 'EASY'. However, the second words of the competing marks will be pronounced very differently. Overall, it is considered that there is between a low and medium degree of aural similarity between the marks.

#### Conceptual comparison

#### *The EASYGROUP and easyValue marks and the proprietor's mark*

49. Conceptually, the competing marks coincide in the use of the word 'EASY'. However, in each of the marks the word 'EASY' is descriptive of a characteristic of the goods and services, i.e. that they are easy to use or access. The different suffix used in each mark creates a conceptual difference, not least because they are recognisable dictionary words with different meanings that will be identified by the average

consumer. There is no conceptual similarity between the words 'digital' and 'GROUP' or 'Value'. Therefore, I consider the competing marks conceptually similar to a low degree, though any conceptual similarity created by the word 'EASY' is not a distinctive similarity.

*The EASYHUB, EASYNETWORKS and figurative marks and the proprietor's mark*

50. Again, these marks coincide in the descriptive use of the word 'EASY'. The different suffixes used in each mark are all recognisable dictionary words with different meanings that will be identified by the average consumer. I am prepared to accept that there is a casual link between the words 'digital', 'HUB' and 'NETWORKS' as they are all words which are meaningful in the field of computer technology. However, these words are also descriptive or allusive of the goods and services they relate to. As such, it is considered that these words increase the level of conceptual similarity between the competing marks, but only to between a low and medium degree.

**Likelihood of confusion**

51. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

52. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related.

53. I also bear in mind the comments of Mr Iain Purvis Q.C., sitting as the Appointed Person, in *Kurt Geiger v A-List Corporate Limited*, BL O/075/13. He pointed out that the level of distinctive character is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar, saying:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it”.

54. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’. Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

55. Having proceeded on the basis that the proprietor’s goods and services are identical to those of the applicant, I further concluded that:

- Average consumers of the goods and services at issue are likely to include the general public and business users, the former demonstrating a medium level of attention and the latter demonstrating a higher than normal level of attention during the purchasing act;

- The purchasing process for the goods and services would be predominantly visual in nature, though I have not discounted aural considerations;
- The EASYHUB, EASYNETWORKS, EASYGROUP and easyValue marks have between a low and medium level of distinctive character, while the figurative mark has a medium level of inherent distinctive character;
- The inherent distinctive character of the earlier marks has not been enhanced through use;
- The word element 'easy digital' plays an increased role in the overall impression of the proprietor's mark, whereas the device and colour combination play slightly reduced roles;
- The overall impressions of the earlier marks are dominated by the combination of their constituent words, while the colour combination in the figurative mark plays a reduced role;
- The proprietor's mark is visually similar to the EASYHUB, EASYNETWORKS, EASYGROUP and easyValue marks to between a low and medium degree;
- There is a low degree of visual similarity between the proprietor's mark and the figurative mark;
- The competing marks are aurally similar to between a low and medium degree;
- There is a low degree of conceptual similarity between the proprietor's mark and the EASYGROUP and easyValue marks, though this is not a distinctive conceptual similarity;
- The proprietor's mark is conceptually similar to the EASYHUB, EASYNETWORKS and figurative marks to between a low and medium degree.

56. I acknowledge that the competing marks share the identical word 'EASY' at the beginning of the marks, a position which is generally considered to have more impact.<sup>6</sup> Nevertheless, there are differences between the marks which are not negligible; to my mind, the differences previously identified would not be overlooked by consumers during the purchasing process, even by those paying no more than a medium level of attention. In my judgement, taking all the above factors into account, the differences between the competing trade marks are likely to be sufficient to avoid the general public and business users mistaking the proprietor's mark for the earlier marks (or vice versa), even on goods and services which are identical. Accordingly, notwithstanding the principles of imperfect recollection and interdependency, it follows that there will be no direct confusion.

57. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., again sitting as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

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<sup>6</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

58. I have borne in mind that these examples are not exhaustive. Rather, they were intended to be illustrative of the general approach.

59. The focus of the applicant’s case in respect of indirect confusion is that the proprietor’s mark will be mistaken for being a member of its family of ‘EASY’ marks. In *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, the CJEU stated that:

“62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a ‘family’ or ‘series’ of marks.

63. The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-

linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a ‘family’ or ‘series’ of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64. As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a ‘family’ or ‘series’, the earlier trade marks which are part of that ‘family’ or ‘series’ must be present on the market.

65. Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

66. It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled to disregard the arguments by which the appellant claimed the protection that could be due to ‘marks in a series’.”

60. The applicant has demonstrated that the EASYJET mark was present on the market at the relevant date. However, I note that this mark is not relied upon for the applicant’s claim under section 5(2)(b) of the Act and is, therefore, not relevant. In my view, it is arguable that the EASYGROUP mark was on the market at the relevant date, though the applicant’s evidence on this point is limited. I acknowledge that the easyValue mark is mentioned by Sir Stelios in the applicant’s evidence. However, I

have seen no evidence to suggest that the mark was on the market at the relevant date. There also is a distinct lack of evidence to suggest that the EASYHUB or EASYNETWORKS marks were on the market at the relevant date. In any event, the applicant has not established that any of the earlier marks were on the market in respect of the goods and services at issue. Moreover, even if I were to accept that the EASYGROUP and easyValue marks were on the market in relation to the relevant goods and services, the presence of two marks on the market does not constitute a 'family' of marks. In light of the foregoing, the applicant's family of marks argument is dismissed.

61. I bear in mind that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.<sup>7</sup> The common element between the marks is the word 'EASY', which I have found to be descriptive of the goods and services. Consequently, I do not believe that the consumers will assume that the applicant and the proprietor are economically linked undertakings on the basis of the competing trade marks; I am unconvinced that consumers would assume a commercial association or licensing arrangement between the parties, or sponsorship on the part of the applicant, merely because of the shared word 'EASY'. The distinctive character of the earlier marks does not rest solely in the word 'EASY' but, rather, the combination of the words. To my mind, both groups of consumers are likely to assume that the use of the word 'EASY' is a coincidence due to its descriptive nature and not an indication that there is a connection between the undertakings responsible for the marks. Taking all of the above factors into account, I do not consider there to be a likelihood of indirect confusion between the competing marks, even in relation to goods and services that are identical.

62. In light of the above, the application under section 5(2)(b) is dismissed.

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<sup>7</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

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

63. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oréal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

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

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

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

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a

change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

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

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oréal v Bellure NV, paragraph 40*.

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

64. The conditions of section 5(3) are cumulative. Firstly, the applicant must show that its earlier mark has achieved a level of knowledge, or reputation, amongst a significant part of the public. Secondly, the applicant must establish that the public will make a link between the marks, in the sense of the earlier mark being brought to mind by the later mark. Thirdly, assuming the first and second conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the applicant will

occur. It is not necessary for the purposes of section 5(3) that the goods or services are similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

## **Reputation**

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

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

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

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

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

66. The applicant’s evidence demonstrates that millions of passengers have flown with ‘easyJet’ since the inception of the airline in 1995. In this connection, I note that 74,921,296 passengers flew with ‘easyJet’ between 1 February 2016 and 31 January 2017 alone. The applicant has demonstrated that ‘easyJet’ operates across the EU, with flight routes between destinations in the UK and various European countries. Further, the airline has a network of 802 routes across 132 airports in 31 countries, predominantly in the EU. The evidence shows that significant revenue has been

generated under the 'easyJet' brand; the most recent figure provided was £4,669 million for 2016. Although no evidence of advertising or promotional expenditure has been provided, the airline was featured in a television series which ran for a number of years in the UK. Moreover, the 'easyJet' website attracted 3,797,300,717 page views from the UK and 536,756,400 from Germany between 2011 and 2016, which suggests that a significant number of consumers have been exposed to the mark. Overall, I am satisfied that the EASYJET mark had a strong reputation in the UK and EU at the relevant date in respect of '*airline services*'. However, I am not satisfied that the applicant's evidence has established a reputation in relation to any of the other services upon which the applicant relies for its claim under section 5(3). This is because there is no documentary evidence at all of use of the mark in relation to any other services and the applicant has provided no indication as to turnover, market share or promotional expenditure in respect of the mark for those services. Therefore, I am unable to find that the mark is known by a significant part of the public concerned with anything other than '*airline services*'.

## **Link**

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

### The degree of similarity between the conflicting marks

The competing marks are similar insofar as they share the identical word 'EASY'. However, this common element is used to describe a characteristic of the goods and services, i.e. that they are easy to use or access. The marks differ because the proprietor's mark contains the word 'digital' and the device element, neither of which have counterparts in the EASYJET mark. Further, the EASYJET mark includes the word 'JET', which is lacking from the proprietor's mark.

It is considered that the competing marks are visually similar to between a low and medium degree, aurally similar to a medium degree and conceptually similar to a low degree.

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

The average consumers of the proprietor's goods and services have been discussed above at paragraphs 31 to 33. The average consumer of '*airline services*' is likely to be the general public but may also include members from the business community. Factors such as service coverage, reliability and flight times will be borne in mind; the costs may vary but these are unlikely to be frequent purchases. A reasonably high level of attention will be paid.

There is, in my view, a wide disparity between '*airline services*' and the proprietor's goods and services, which consist, broadly, of business and training services as well as computer related goods and services. There is no overlap in the nature, intended purpose or method of use of the respective goods and services. Their trade channels are not the same. Neither is there a complementary or competitive relationship between them. There may be some overlap in user at a very general level. However, this, alone, is not sufficient to engage similarity overall. In light of the foregoing, I conclude that there is no similarity between '*airline services*' and the proprietor's goods and services.

The strength of the earlier mark's reputation

The EASYJET mark has a strong reputation in the UK and EU in relation to '*airline services*'.

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

The EASYJET mark consists of the plain word 'EASYJET'. Although the mark is conjoined, as 'EASY' and 'JET' are ordinary, easily recognisable dictionary words, they will still be identified by consumers. The word 'EASY' is a natural way of designating goods and services that are easy to use or access. Accordingly, the word is, itself, inherently low in distinctive character. The word 'JET' is, at best, allusive of the services upon which the applicant may rely. The inherent distinctive character of the mark lies in the combination of the two words. It is considered that the EASYJET mark has between a low and medium degree of inherent distinctive character.

The applicant has argued that the EASYJET mark, particularly the 'EASY' prefix, has become more distinctive through use. Given the use which has been made of it, I am prepared to accept that the distinctive character of the mark has been enhanced to a high degree in respect of '*airline services*'. Whilst, overall, the EASYJET mark is highly distinctive for '*airline services*', the prefix 'EASY' is descriptive and the applicant has not demonstrated that it is highly distinctive on its own.

#### Whether there is a likelihood of confusion

Given the distance between the respective goods and services and the low level of distinctiveness of the common element 'EASY', I see no risk of a likelihood of confusion on the part of the relevant public.

68. Taking all of the above factors into account – not least the low level of distinctiveness of the element common to both marks and the significant distance between the proprietor's goods and services and '*airline services*' – it is considered that, notwithstanding the strong reputation held by the EASYJET mark, the relevant public is unlikely to make a link between the competing marks. As such, the application for invalidation under section 5(3) must fail.

69. For the avoidance of doubt, in reaching this conclusion I have borne in mind the applicant's 'family of marks' argument. However, for the purposes of its claim under

section 5(3), the applicant only relies upon the EASYJET mark which cannot constitute a 'family' of trade marks alone.

70. If I am wrong in my finding that consumers will not make the necessary link between the competing marks, the section 5(3) ground would still be rejected. My reasons follow.

## **Damage**

71. The applicant has contended that use of the proprietor's mark would take unfair advantage of the significant reputation of the EASYJET mark. Further, that it would, without due cause, prove to be detrimental to that reputation. Finally, the applicant has submitted that use of the proprietor's mark would, without due cause, be detrimental to the distinctive character of the EASYJET mark. I deal with each claimed head of damage in turn below.

## Unfair advantage

72. Taking advantage of the distinctive character or reputation of an earlier mark means that consumers are more likely to buy the goods or services of the later mark than they would have otherwise been if they had not been reminded of the earlier mark. As a result, the marketing of the later mark will not require as much effort or investment due to the familiarity that the relevant public would already feel with it or the message they are sent about what to expect. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is

most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

73. I am not persuaded that the proprietor would benefit from the reputation of the applicant’s services in respect of its own goods and services. In my view, even if the applicant’s claim to providing customer-friendly goods and services at competitive prices was established, consumers are not accustomed to providers of airline services expanding into the fields of computer-related goods and services, training or business services. It is, therefore, unlikely that any commercial advantage would be gained by the proprietor. Moreover, the applicant has not filed any evidence or persuasive submissions to enable me to identify how the transfer of any image in relation to airline services would be of benefit to the proprietor for its goods and services. I can see no obvious way in which there would be an unfair advantage. Accordingly, this head of damage is rejected.

#### Detriment to repute

74. Detriment to repute, or ‘tarnishing’, is a reduction in the attractive power of the earlier mark caused by the use of the later mark. As explained in *L’Oréal*, tarnishment may arise either when the later mark itself creates a negative association or where the goods or services on which it is used are incompatible with the image of the earlier mark.

75. The applicant has submitted that the EASYJET mark has a reputation for providing customer-friendly goods and services at competitive prices. According to the applicant, the offering of the proprietor may not match that of the applicant and, therefore, the power of attraction of the EASYJET mark would be reduced. Firstly, while I have found the EASYJET mark to have a reputation for ‘*airline services*’, there is no evidence which demonstrates a reputation for providing customer-friendly goods and services

at competitive prices. Furthermore, the mere potential to create a negative association by hypothetical use of a later mark in relation to inferior goods or services was rejected as insufficient by Ms Anna Carboni, sitting as the Appointed Person, in *Unite the Union v The Unite Group PLC*, BL O/219/13. In the absence of any evidence on the point, this head of damage is rejected.

#### Detriment to distinctive character

76. In *Environmental Manufacturing LLP v OHIM*, Case C-383/12P, the CJEU stated that:

“34. According to the Court’s case-law, proof that the use of the later mark is, or would be, detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered, consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future (*Intel Corporation*, paragraphs 77 and 81, and also paragraph 6 of the operative part of the judgment).”

77. Further, that:

“Admittedly, Regulation No 207/2009 and the Court’s case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.

43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on ‘an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case’.”

78. Although the EASYJET mark enjoys a strong reputation, given the weakness of the ‘EASY’ element, I am not convinced that the coincidence of both marks containing

this word would present a serious risk of a change in the economic behaviour of the applicant's customers. The case law above establishes that the applicant's claim of detriment to distinctive character would require evidence of a change in the economic behaviour of the average consumer of the services for which the EASYJET mark is registered. The applicant has not filed any evidence that shows either a change in the economic behaviour of its customers or that there is a serious likelihood of such a change. Due to the significant distance between the respective goods and services, it is difficult to envisage circumstances in which the economic behaviour of the applicant's customers would be affected by the use of the proprietor's mark. This head of damage is also, therefore, rejected.

79. In light of the above, the application under section 5(3) is dismissed.

## **CONCLUSION**

80. The application for invalidation under sections 5(2)(b) and 5(3) of the Act has failed in its entirety. Subject to any successful appeal against my decision, the proprietor's mark will remain registered in the UK.

## **COSTS**

81. As the application for invalidation has been unsuccessful, ordinarily the proprietor would be entitled to an award of costs. However, as it has not instructed professional representatives, it was invited by the Tribunal to indicate whether it intended to make a request for an award of costs, including accurate estimates of the number of hours spent on a range of given activities relating to defending the proceedings. It was made clear by letter dated 6 January 2021 that, if the pro-forma was not completed, no costs would be awarded. The proprietor did not return a completed pro-forma to the Tribunal and, on this basis, no costs are awarded.

**Dated this 22nd day of March 2021**

**James Hopkins**

**For the Registrar,**

**The Comptroller-General**

**ANNEX**

<b>Earlier mark</b>	<b>Goods and services relied upon for the purposes of the application under section 5(2)(b)</b>
<p>EU017929119</p> <p><b>EASYHUB</b></p> <p>("the EASYHUB mark")</p>	<p>Class 35: Business management; business administration; office functions; office administration services; office equipment rental services; professional business consultancy; business management assistance services; business management consultancy; business information and business inquiries services; file management services; office management services; management of business offices for others; advisory, consultancy and information services relating to all the aforesaid services.</p> <p>Class 41: Education; providing of training; personal training services; life coaching services; arranging and conducting workshops; advisory, consultancy and information services relating to all the aforesaid services.</p> <p>Class 42: Creation and hosting of platforms on the internet; hosting online web facilities for others for sharing online content; design of computer software; hosting, creating and maintaining websites for others; scientific consultancy; computer consultancy; design consultancy; technological consultancy; quality assurance consultancy; website design consultancy; data security consultancy; consultancy in the fields of computers; consultancy in the field of office and work place automation; consultancy, development, advice, assistance, analysis, design, evaluation and</p>

	<p>programming services relating to computer software, firmware, hardware and information technology; hosting, creating and maintenance of websites for others; consultancy and advice relating to the evaluation, choosing and implementation of computer software, firmware, hardware, information technology and of data-processing systems; provision of information relating to technical matters and information technology; scientific and technological services and research and design relating thereto, industrial analysis and research services.</p>
<p>EU018060442 <b>EASYNETWORKS</b> ("the EASYNETWORKS mark")</p>	<p>Class 9: Calculating machines, data processing equipment and computers; computer hardware; computer firmware; apparatus for processing card transactions and data relating thereto and for payment processing; apparatus for verifying data on magnetically encoded cards; parts and fittings for the aforesaid goods.</p> <p>Class 42: Creation and hosting of platforms on the internet; hosting online web facilities for others for sharing online content; design of computer software; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; hosting, creating and maintaining websites for others; scientific consultancy; computer consultancy; design consultancy; technological consultancy; quality assurance consultancy; website design consultancy; data security consultancy; consultancy in the fields of computers.</p>
<p>EU018060440 <b>easyNetworks</b> ("the figurative mark")</p>	<p>Class 9: Calculating machines, data processing equipment and computers; computer hardware; computer firmware; computer software; downloadable</p>

	<p>computer software; computer application software; telecommunications software; apparatus for processing card transactions and data relating thereto and for payment processing; apparatus for verifying data on magnetically encoded cards; parts and fittings for the aforesaid goods.</p> <p>Class 38: Data transmission.</p> <p>Class 42: Software as a service; creation and hosting of platforms on the internet; hosting online web facilities for others for sharing online content; design of computer software; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; hosting, creating and maintaining websites for others; scientific consultancy; computer consultancy; design consultancy; technological consultancy; quality assurance consultancy; website design consultancy; data security consultancy; consultancy in the fields of computers; consultancy and advice relating to the evaluation, choosing and implementation of computer software, firmware, hardware, information technology and of data-processing systems; scientific and technological services and research and design relating thereto, industrial analysis and research services.</p>
<p>EU014920391 <b>EASYGROUP</b> ("the EASYGROUP mark")</p>	<p>Class 35: Business management; business administration; office functions; provision of business information; processing of data relating to card transactions and other payment transactions.</p>

	<p>Class 41: Education; providing of training; arranging and conducting workshops; advisory, consultancy and information services relating to all the aforesaid services.</p>
<p>EU016140782 <b>easyValue</b> ("the easyValue mark")</p>	<p>Class 9: Computer software; computer hardware.</p> <p>Class 35: Business management; business administration; office functions; publicity, promotional services, import-export agency services, business information services, organising exhibitions for commercial or advertising purposes.</p> <p>Class 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.</p> <p>Class 42: Design of computer software; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; hosting, creating and maintaining websites for others; provision of access to computers and the Internet.</p>