

O/535/20

TRADE MARKS ACT 1994

IN THE MATTER OF UK REGISTRATION NO. 3390732

IN THE NAME OF TI MEDIA LIMITED

IN RESPECT OF THE FOLLOWING TRADE MARK

EASY GARDENS

AND

AN APPLICATION FOR A DECLARATION OF THE INVALIDITY

THEREOF UNDER NO 502809

BY

EASYGROUP LTD

BACKGROUND AND PLEADINGS

1. Trade mark No. 3390732 shown on the cover page of this decision stands registered in the name of TI Media Limited (“the proprietor”). It was applied for on 9 April 2019 and completed its registration procedure on 28 June 2019. The goods and services for which it is registered are as follows:

Class 9

Electronic publications; downloadable electronic publications; downloadable digital media and multimedia; downloadable video and audio recordings; webcasts; podcasts; vodcasts; podscrolls; downloadable digital media and recordings containing teaching apparatus and instruments; downloadable computer applications (apps).

Class 16

Printed matter; printed publications; books, manuals, magazines, periodicals, journals; articles of stationery; calendars and posters.

Class 35

Advertising; marketing, business and promotional services; placing adverts in printed and electronic media; placing of adverts in magazines; placing of adverts on websites; organisation of events and exhibitions for commercial and advertising purposes; digital advertising, digital promotional and digital marketing services; advertising and marketing on the internet, mobile phone networks and other electronic communication networks; collection of data; database management; provision of business data; market research; data processing; data analysis; advertising analysis; creating advertising material; information, advice and consultancy relating to all the aforesaid.

Class 41

Publication services, electronic publishing services; digital publishing services; television and radio production services; digital video, audio and multimedia entertainment production services; video, audio and multimedia entertainment publishing services; sound recording and video entertainment services; providing

online videos (not downloadable); publication of audio books; production of audio recordings; providing online audio recordings (not downloadable); entertainment services; online entertainment; organisation and planning of shows, concerts, parties and entertainment or educational events; arranging, organising and promoting live events; booking agency services; organisation of competitions and award ceremonies; arranging and conducting conferences, conventions and exhibitions; provision of information by electronic means including the internet; information and advisory services relating to all the aforesaid services.

2. On 18 September 2019, easyGroup Ltd (“the applicant”) filed an application to have this trade mark declared invalid under the provisions of section 47(2)(a) and sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).

3. With regard to its claim under section 5(2)(b) of the Act, the applicant is relying on the following EU Trade Marks (EUTMs):

a) No. 14920391

EASYGROUP

Filing date: 17 December 2015

Registration date: 26 May 2016

Services relied upon:

Class 35

Advertising; business management; business administration; office functions; operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; provision of business information; marketing and publicity services; dissemination of advertising, marketing and publicity materials; processing of data relating to card transactions and other payment transactions; auctioneering.

Class 41

Education; providing of training; sporting and cultural activities; life coaching services; education relating to nutrition; provision of educational information relating to fitness, exercise, diet, health and nutrition; entertainment services; entertainment information services; organisation of sports competitions; arranging and conducting workshops; advisory, consultancy and information services related to all the aforesaid services.

b) No. 10584001

EASYJET

Filing date: 24 January 2012

Registration date: 9 January 2015

Goods and services relied upon:

Class 9

Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, supervision and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; recording discs; data processing equipment and computers; computer hardware and firmware; computer software; software downloadable from the internet; downloadable electronic publications; computer games software; education and teaching apparatus and instruments; electronic, magnetic and optical identity and membership cards; parts and fittings for all the aforesaid goods.

Class 16

Paper, cardboard and goods made from these materials; printed matter; photographs; stationery; packaging materials; printed publications; books, manuals, pamphlets, newsletters, albums, newspapers, magazines and periodicals; tickets, vouchers, coupons and travel documents; identity cards;

labels and tags; posters, postcards, calendars, diaries; teaching and instructional materials.

Class 35

Advertising; business management; business administration; office functions; operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; provision of business information; marketing and publicity services; dissemination of advertising, marketing and publicity materials.

Class 41

Education; providing of training; entertainment; sporting and cultural activities; 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; organising games and competitions, rental of games and playthings.

c) No. 16140782

easyValue

Filing date: 7 December 2016

Registration date: 26 October 2017

Goods and services relied upon:

Class 9

Computer software; computer hardware; pre-recorded CD Roms and other disk carriers.

Class 16

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 document folders; travel guide books; travellers cheques; identity cards; labels and tags; posters, postcards, stationery, writing instruments, wrapping materials, calendars, diaries, photographs, gift cards and greetings cards; cardboard badges, paper badges, paper name badges; teaching and instructional materials; promotional and advertising material; signs of paper or cardboard.

Class 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.

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.

4. The applicant claims that the marks are similar visually and aurally in that they all begin with the word "EASY" and that the goods and services are identical or similar, resulting in a likelihood of confusion on the part of the public. It also claims that the EASYGROUP and EASYJET marks enjoy elevated distinctive character through the use made of them, and that this will increase the likelihood of confusion.

5. Under section 5(3), the applicant is relying on the EASYGROUP and EASYJET marks and claims they have a significant reputation in the UK and EU for the following services:

EASYGROUP mark:

Class 43

Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; hotel services; hotel reservation services; hotel services for the provision of facilities for exhibitions and conferences; room hire services; management of hotels and restaurants; provision of exhibition facilities and amenities; provision of facilities and amenities all for conferences, seminars and banquettes; reservation services for all the aforesaid services.

EASYJET mark:

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 claims that use of the contested mark would take unfair advantage of the reputation of the earlier marks, as it contends that the later mark looks like an extension of the applicant's brand which would be brought to the mind of the public. The applicant claims that it has a significant reputation in the UK for "great-value, customer-friendly goods and services" and that use of the contested mark would enable the proprietor to free-ride on the applicant's reputation to achieve greater sales without the concomitant marketing expense and time. It also claims that the earlier marks have a distinctive reputation among the public in the UK and that, if the

contested mark were used in relation to inferior goods or services, this could damage the applicant's reputation. Finally, it claims that use of the contested mark would diminish the power of attraction of the applicant's marks and their ability to distinguish the applicant's goods and services from those of others.

7. The proprietor filed a defence and counterstatement denying the claims made. In particular it denies that the marks are similar and submits that the word "EASY" is either low in distinctiveness or non-distinctive, resulting in the overall impression of the marks being different. It admits that the goods and services shown in the table in paragraph 21 below are identical to goods and services of the applicant.

8. The proprietor denies that the applicant has a reputation in relation to the EASYGROUP and EASYJET marks and puts the applicant to proof of this and also of its claim that these marks enjoy elevated distinctive character. It denies that the consumer will make a link between the marks and that damage will occur.

9. The applicant filed evidence. I shall summarise this to the extent that I consider it necessary. Both parties filed written submissions, the applicant on 13 February, the proprietor on 20 May. I shall not summarise these but will refer to them where appropriate in my decision.

10. Neither party requested a hearing, so I have taken this decision following a careful consideration of the papers.

11. In these proceedings the applicant is represented by Kilburn & Strode LLP and the proprietor by HGF Limited.

Evidence

12. The applicant's evidence comes from Mr Ryan Edward Pixton, a trade mark attorney at Kilburn & Strode LLP, the applicant's representative. His witness statement, dated 13 February 2020, simply lists the exhibits attached to it.

13. The first exhibit is a general witness statement made by Sir Stelios Haji-loannou, the founder and director of EasyGroup, dated 4 August 2017. In it, Sir Stelios describes the history of the company and its brand values. It has been filed in numerous other proceedings and I shall not summarise it in detail here, but I confirm that I have read it before writing this decision.¹ I shall consider the evidence relating to the EASYGROUP and EASYJET marks later in my decision, but for the moment note that paragraphs 104-115 relate to easyValue, an online price comparison service. The service was launched in 2000 and turnover was £17,700 in 2000, £76,983 in 2001, £22,880 in 2002 and £27,636 in 2003. No later evidence has been provided.

14. Exhibit REP2 contains extracts from easyJet annual reports for 2013-2017 and a collection of press articles on easyJet from sources such as *The Scotsman*, *The Daily Telegraph*, *The Independent* and *The Daily Mirror* dating from 2014 to 2017, and the Wikipedia entry for easyJet, printed on 26 June 2017.

15. Exhibit REP3 is a copy of a witness statement by Christopher Griffin, Chief Executive of the Museum of Brands, dated 4 April 2017. This witness statement, which is directed towards demonstrating the fame of the “easy” brand, has also been filed in previous proceedings and I refer the reader to the summary given by the Hearing Officer in *EASYSAIL*, BL O/102/18.

DECISION

Section 47

16. Section 47 of the Act is as follows:

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

¹ A summary can be found in my previous decision *easyGroup Limited v Asid Reignz Enterprises Limited t/a Asid Reignz Music*, BL O/816/18.

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
- (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

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

...

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

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

...

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

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

- (a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet

acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

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

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

...

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

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

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

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

Section 5(2)(b)

17. Section 5(2)(b) of the Act is as follows:

“A trade mark shall not be registered if because –

...

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

18. An “earlier trade mark” is defined in section 6(1) of the Act as:

“(a) a registered trade mark, international trade mark (UK), a European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(b) a European Union trade mark or international trade mark (EC) which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired,

(ba) a registered trade mark or international trade mark (UK) which –

(i) has been converted from a European Union trade mark or international trade mark (EC) which itself had a valid claim to seniority within paragraph (b) from an earlier trade mark, and

(ii) accordingly has the same claim to seniority, or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.”

19. The registrations upon which the applicant relies qualify as earlier trade marks under the above provision. As the marks completed their registration procedures within the five years before the date on which the application for a declaration of invalidity was made, they are not subject to proof of use and the applicant is therefore entitled to rely on all the goods and services for which the marks stand registered.

20. In considering the application for invalidity under this section, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union (CJEU) 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 BV* (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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 greater 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; and

k) if the association between the marks creates a risk that the public will wrongly 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

21. The proprietor has admitted that some of the contested goods or services are identical to the goods or services on which the application for invalidity is based. These are shown in the table below:

Goods and Services	Applicant's Mark
Advertising Entertainment services; Organisation of competitions and award ceremonies; arranging and conducting conferences, conventions and exhibitions	EASYGROUP
Advertising; marketing services Entertainment services; organisation and planning of educational events	EASYJET
Printed matter; books; articles of stationery; calendars Advertising	easyValue

22. For reasons of procedural economy, the Tribunal will not undertake a full comparison of the goods or services. The examination of the application for a declaration of invalidity on section 5(2)(b) grounds will proceed on the basis that the contested goods or services are identical to those covered by the earlier trade marks. If the application fails, even where the goods or services are identical, it follows that it will also fail where the goods or services are only similar. I shall return to the remaining goods and services later in my decision if it is necessary to do so.

Average Consumer

23. In *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors* [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

24. The average consumer of advertising services is likely to be a business or other organisation, although individuals also use such services on a more *ad hoc* basis when they have goods or services they wish to sell. It is not a purchase that will be made every day and could be significant in value. To make their choice, the consumer will use websites and printed material, and word-of-mouth recommendations will also play a part. Visual and aural elements will therefore be important. Given the relative infrequency of the purchase and significance for the business, the average consumer is likely to be paying a fairly high degree of attention.

25. The identical goods and services also include those aimed at the general public. Entertainment services range in price from expensive tickets to high-profile rock concerts to advertising-funded services which the consumer can access on the Internet without payment. Whatever the cost, the consumer will be paying sufficient attention to decide whether they are likely to enjoy that particular service. They will, in my view, be paying a medium degree of attention. While they may hear the services advertised on the radio or by word-of-mouth recommendation, they are more likely to see adverts in the street, on television or in printed publications or use the Internet to help them decide. The visual element would therefore carry more weight.

26. The average consumer of printed matter, books, articles of stationery and calendars is also a member of the general public. These are frequent, relatively inexpensive purchases and will be made in shops, on the Internet or by mail order. The consumer is therefore likely to see the marks on the goods and may also have viewed advertisements in printed publications or online. The visual element will be most significant and, in my view, the consumer will be paying a medium level of attention.

Comparison of marks

27. It is clear from *SABEL* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the

marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo* that:

“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”²

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

29. The respective marks are shown below:

Earlier marks	Contested mark
<p data-bbox="284 1191 539 1223"><u>EUTM 14920391:</u></p> <p data-bbox="284 1299 488 1330">EASYGROUP</p> <p data-bbox="284 1406 539 1438"><u>EUTM 10584001:</u></p> <p data-bbox="284 1514 427 1545">EASYJET</p> <p data-bbox="284 1621 539 1653"><u>EUTM 16140782:</u></p> <p data-bbox="284 1729 434 1760">easyValue</p>	<p data-bbox="853 1240 1109 1272">EASY GARDENS</p>

30. The contested mark consists of two words in capital letters in a standard font with no stylisation. A word mark protects the words themselves: see *Bentley Motors Limited*

² Paragraph 34.

v Bentley 1962 Limited, BL O/158/17, paragraph 16. The mark hangs together as a phrase and it is in this phrase that the overall impression of the mark lies.

31. The applicant's first mark consists of the words "EASY" and "GROUP" joined together and presented as a single word in capital letters and a standard font with no stylisation. The overall impression of the mark lies in the two words joined to make one unit. The second mark follows the same pattern, this time with the words "EASY" and "JET", and its overall impression is achieved in the same way. The third mark is the words "easy" and "value" joined together in lower case, with an upper case "V", which emphasises the juxtaposition of the two words, and it is in this juxtaposition that the overall impression of the 782 mark lies.

Visual comparison

32. The contested mark consists of two words, the first with four letters and the second with seven. The applicant's marks are nine, seven and nine letters long, but all begin with the same four letters ("EASY"/"easy") which are shared by the contested mark. The EASYGROUP mark also shares with the contested mark "G" as its fifth letter, although in the contested mark the words are kept separate rather than joined together. I agree with the applicant that the marks are visually similar, and I consider this to be to a medium degree.

Aural comparison

33. The contested mark will be articulated as follows: EE-ZEE-GAR-DENS. The applicant's marks will be spoken as EE-ZEE-GROOP, EE-ZEE-JET and EE-ZEE-VAL-YOO. It will be seen that the contested mark possesses four syllables, as does the easyValue mark, while the EASYGROUP and EASYJET marks have three syllables. However, all share the same first two syllables, and the initial letter of the third syllable of the contested mark is the same as that of the third syllable of the EASYGROUP mark. I find there to be a medium degree of aural similarity between the contested mark and the EASYGROUP mark, with a lower degree of similarity between the contested mark and the EASYJET and easyValue marks.

Conceptual comparison

34. The applicant submits that there is conceptual similarity between the marks as they all begin with the word “EASY”, and it is that element to which most attention is paid. In the applicant’s view, the message conveyed to consumers will be the same, although it does not elaborate on what this message might be. While it may be the case that in general consumers will pay more attention to the beginnings of marks, I remind myself that those marks should not be artificially dissected. I found that the overall impression of all the marks lay in the phrase or the joining of the two words. In my view, when considering the contested mark, the consumer will think of gardens that do not require a great deal of effort to maintain or that are perhaps suitable projects for beginners. The applicant’s marks bring to mind airline services that are simple and convenient for passengers to use (EASYJET), simple ways of ensuring that customers get value-for-money (easyValue) and an umbrella company that acts as a corporate parent for these businesses (EASYGROUP). I find that the marks have some conceptual similarity, but this is at a low level.

Distinctive character of the earlier mark

35. In *Lloyd Schuhfabrik Meyer*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Alternberger* [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).”

36. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of or allude to a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

37. The word “EASY”, the common element of all the applicant’s marks, is a basic English word that alludes to a quality of the goods and services sold under the marks. The word is inherently low in distinctive character. The second elements, “GROUP”, “JET” and “Value”, are allusive or descriptive of a group of companies, an airline or value-for-money. The first two are not, however, allusive or descriptive of the goods and services relied on under section 5(2)(b) of the Act. In the case of the easyValue mark, the word alludes to a quality expected to be found in the goods and services supplied under the mark. The inherent distinctiveness of the marks lies in the combination of the two words into one and I consider that EASYGROUP and EASYJET have a medium degree of inherent distinctive character for the services relied on, while that of easyValue is lower.

38. The applicant claims that the EASYGROUP and EASYJET marks have enhanced degrees of distinctive character through the use that has been made of them. The majority of the information provided in the applicant’s evidence relates to the EASYJET mark. Sir Stelios notes that this mark was first used in 1995 and the accounts show revenue of over £4bn in each of the years from 2013 to 2016.³ Passenger figures rose year-on-year from 50.3m in 2010/11 to 74.9m in 2016/17. Sir Stelios also provides information about advertising and promotional activities associated with the EASYJET mark. These include the ITV series “Airline”, broadcast between 1999 and 2006, and

³ Exhibit REP2.

attracting up to 9m viewers per episode. Exhibit REP2 contains articles from national newspapers and evidence that easyJet sponsored Manchester Pride in 2014. It also provides details of awards won, including Europe's Leading Low-Cost Airline at the World Travel Awards 2013. All the evidence is in connection with airline services and so I find that the distinctiveness of the EASYJET mark has not been enhanced beyond its inherent level of medium for the goods and services relied upon under section 5(2)(b) of the Act.

39. There is no evidence of trade mark use of the EASYGROUP mark. In particular, I have been provided with no sales figures for the services relied upon or expenditure on advertising. On the basis of the evidence before me, I am unable to find that the distinctiveness of the EASYGROUP mark has been enhanced beyond its inherent level of medium for the services relied upon under section 5(2)(b).

Conclusions on likelihood of confusion

40. There is no scientific formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where a number of factors need to be borne in mind. The first 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 or vice versa. It is necessary for me to take account of the distinctive character of the applicant's marks, the average consumer and the nature of the purchasing process for the contested goods and services. In doing so, I must be aware 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 they have in their mind.

41. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

“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 recognised 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.’⁴

42. I have found the marks to be visually similar to a medium degree, aurally similar to a medium (EASYGROUP) or lower than medium degree (EASYJET and easyValue) and conceptually similar to a low degree, I consider that there are sufficient differences between the marks for them not to be mistaken for each other, even taking into account the average consumer’s imperfect recollection of marks. I find that there is no likelihood of direct confusion.

43. I turn now to indirect confusion. The applicant submits that the average consumer would make the assumption that the contested mark is associated with the applicant and that the likelihood of confusion is increased by the existence of a family of brands:

“The **easy** family of brands means that **easy-** as a prefix written in lower case, when conjoined to a non-distinctive or weakly distinctive word element so as to form a neologism, is synonymous with the Applicant.”⁵

44. In *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, the CJEU stated that:

“62. While it is true that, in 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

⁴ Paragraph 16.

⁵ Applicant’s written submissions, paragraph 18.

assessment of the likelihood of confusion is to be carried out 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 made 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’.”

45. While Sir Stelios’s witness statement refers to a large number of “EASY” brands, I must confine my attention to those marks that have been relied upon in these proceedings. For a “family of marks” argument to be successful, the applicant needs to show that the marks were on the market at the relevant date of 9 April 2019. I do not consider that the evidence shows that the EASYGROUP and easyValue marks meet this criterion. There are a few minor mentions of EASYGROUP in the articles but to my mind these do not amount to proof of a presence on the market. In the case of the easyValue mark, I have already noted in paragraph 13 above that the most recent sales figures date from 2003. I am unable to find that it was on the market at the relevant date. This leaves one remaining mark: EASYJET. The evidence goes up to 2017, which is prior to the relevant date. However, even if I were to accept that the applicant had shown that this mark was on the market, one mark cannot constitute a family.

46. Even where the goods and services are identical, it seems to me unlikely that the average consumer would assume a connection between the proprietor and the applicant. The two words in the contested mark are separate, not joined, and I recall that the distinctiveness of the earlier marks lay in the juxtaposition of the words. I do not consider that the applicant has shown that the average consumer would expect any mark consisting of the word “EASY”/“easy” followed by a descriptive word would be connected to the applicant. On viewing the contested mark, the average consumer would, in my view, assume that the proprietor wanted to convey the message that its goods and services made gardening less time-consuming or challenging. I find that there is no likelihood of indirect confusion.

47. As I have found no likelihood of confusion where the goods and services are identical, I would also find no likelihood of confusion where the goods and services are merely similar. The section 5(2)(b) ground fails.

Section 5(3)

48. Section 5(3) of the Act is as follows:

“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 (EU) in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

49. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L'Oréal SA & Ors v Bellure & Ors* (Case C-487/07) and *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09). 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 and/or services, the extent of the overlap between the relevant consumers for those goods and/or 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 that 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 and/or 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 and/or services for which the earlier mark is registered, or a serious risk that this will happen in the future; *Intel*, paragraphs 76 and 77.

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

h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oréal*, 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; *Interflora*, paragraph 74, and the court's answer to question 1 in *L'Oréal*.

Reputation

50. In *General Motors Corp v Yplon SA*, Case C-375/97, the CJEU held that:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or services marketed, either the public at large or a more specialised public, for example traders in a specific sector.

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.”

51. The applicant claims that the EASYJET mark has a reputation in the EU for the travel-related services listed in paragraph 5 above and that the EASYGROUP mark has a reputation in the EU for services relating to hotels, bars and restaurants.

52. According to Sir Stelios Haji-Ioannou’s witness statement, easyJet flew almost 75m passengers in the year to 31 January 2017. Most of these appear to have taken flights within the EU, including the UK. I have already referred to Exhibit REP2, which contains information on easyJet’s activities and awards won. I accept that easyJet had a strong reputation in the EU at the relevant date in relation to airline services, but consider that there is not sufficient evidence for me to find that the applicant had a reputation for any of the remaining Class 39 services.

53. The applicant has provided little evidence in relation to the EASYGROUP mark. Sir Stelios’s witness statement explains the role of easyGroup Limited as holding, protecting and licensing the intellectual property associated with the EASY brands.⁶ It later moved into the provision of media relations and brand management services to other EASY brands.⁷ Exhibit REP2 contains an article from *The Independent* dated 14 February 2017 which mentions easyGroup in the context of a holding company for a series of other businesses. I can see no evidence that the EASYGROUP mark had a reputation for any of the Class 43 services listed in paragraph 5 above. I shall therefore continue my analysis of the section 5(3) ground on the basis of the EASYJET mark alone.

Link

54. In assessing whether the public will make the required mental link between the marks, I must take account of all relevant factors. The following were identified by the CJEU in *Intel*:

⁶ Paragraphs 30-31.

⁷ Paragraph 40.

The degree of similarity between the conflicting marks

Earlier in my decision, I found that there was a medium degree of visual similarity, a lower than medium degree of aural similarity, and a low degree of conceptual similarity between the marks.

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

There is a large distance between *airline services* and the Class 9 and 16 goods and Class 35 and 41 services in the contested registration. I accept that there is some overlap in users, as members of the general public and business may use both.

The strength of the mark's reputation

EASYJET has a strong reputation in the UK and the EU for airline services.

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

I found that the inherent distinctiveness of the earlier mark lay in the joining of the two words "EASY" and "JET" and that the mark has a medium degree of inherent distinctive character. I accept that, through use, the mark has become highly distinctive for *airline services*.

Whether there is a likelihood of confusion

I have already found no likelihood of confusion between the two marks.

55. In my view, the medium degree of visual, lower than medium degree of aural, and the low degree of conceptual, similarity between the marks and the differences between the goods and services for which the contested mark is registered and the services for which the applicant has a reputation make it unlikely that consumers would make a link between the marks in use. The section 5(3) ground fails.

CONCLUSION

56. The application for invalidity is dismissed and UK trade mark no. 3390732 shall remain registered.

COSTS

57. The proprietor has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the proprietor the sum of £1000 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

<i>Preparing a counterstatement and considering the applicant's statement:</i>	<i>£300</i>
<i>Considering the applicant's evidence and preparing submissions:</i>	<i>£700</i>
<i>Total:</i>	<i>£1000</i>

58. I therefore order easyGroup Ltd to pay TI Media Limited the sum of £1000. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 29th day of October 2020

Clare Boucher
For the Registrar,
Comptroller-General