

O-539-20

TRADE MARKS ACT 1994

IN THE MATTER OF

INTERNATIONAL TRADE MARK NO. 1450350

IN THE NAME OF WUNDERMIX GMBH

FOR THE TRADE MARK:

easyslider

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 502804

BY EASYGROUP LTD

Background

1. International trade mark registration number 1450350 for the mark **easyslider** (“the contested mark”) stands in the name of Wundermix GmbH (“the holder”). On 30 November 2018, the holder designated the UK as a territory in which it sought to protect the IR under the terms of the Protocol to the Madrid Agreement. Priority is claimed from the date of the base registration filing date in Germany on 1 June 2018 (“the relevant date”). Protection was conferred on 24 April 2019 in respect of the following goods and services:

Class 21: Coasters [tableware]; Coasters for kitchen utensils; Coasters made of wood; Coasters made of stone; Coasters made of glass; Plates of glass; Brushes, in particular cleaning brushes.

Class 35: Wholesaling and retailing, also via the internet, in the field of accessories for kitchen appliances and kitchen machines, brushes.

2. On 18 September 2019, easyGroup Ltd (“the applicant”) applied for a declaration of invalidity based upon ss. 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”), which have application in invalidation proceedings by virtue of s. 47(2) of the Act. The application for invalidation is, under both of these grounds, directed against all of the goods and services in the registration.

3. Under s. 5(2)(b), the applicant relies upon five earlier trade marks, shown below. The applicant relies upon these marks to the extent that they are registered, broadly speaking, in class 35 for retail services in connection with goods as diverse as food and drink, crockery and cutlery, toiletries and luggage, as well as some goods in class 8 for the mark at (v) below. The full lists of goods and services upon which the applicant relies is contained in the annex to this decision. The trade marks and their relevant dates are:

- i) European Union trade mark (“EUTM”) number 17808098 **EASYFOOD**

Filing date: 13 February 2018; date of entry in register: 27 June 2018

ii) EUTM 12715793 **EASYCOFFEE**

Filing date: 21 March 2014; date of entry in the register: 31 March 2015;

iii) EUTM 15600018 **EASYCUPS**

Filing date: 29 June 2016; date of entry in register: 6 December 2017;

iv) EUTM 14920391 **EASYGROUP**

Filing date: 17 December 2015; date of entry in register: 26 May 2016;

v) EUTM 10584001 **EASYJET**

Filing date: 24 January 2012; date of entry in register: 9 January 2015.

4. The applicant submits that there is aural and visual identity at the beginning of the respective marks and that they consist of the word “easy” with another word, including a word which is related to food and drink, to form a neologism. It claims that the goods and services are similar and that there is a likelihood of confusion, including the likelihood of association. The applicant also claims that the marks at (iv) and (v), above, benefit from enhanced distinctive character through the use that has been made of them.

5. Under s. 5(3), the applicant relies upon EUTM 10584001 **EASYJET**, the details of which are shown at paragraph 3(v), above. It claims that the mark has a reputation relating to, broadly, transport, airline and travel-related services in class 39: the full list of services upon which the opponent relies under this ground is shown in the annex to this decision. The applicant claims that the mark has a significant reputation in the UK and EU such that use of the contested mark would cause the relevant public to believe that there is an economic connection between the holder and the applicant, where no such connection exists. It claims that the applicant has a reputation for “great-value, customer-friendly goods and services” and that use of the contested mark would amount to an unfair advantage because it would free-ride on the earlier mark’s reputation without the

associated marketing expense and time. The applicant further claims that there would be detriment to the reputation of the earlier mark if the contested mark were used in relation to inferior goods and services. In addition, the applicant says, “[the] formulation of “easy” followed by an allusive term is redolent of the Applicant. The Applicant’s businesses span across many marks, all using the formulation “easy” plus an allusive term across a range of business sectors, including kitchenware and retail”. It says that use of the contested mark would diminish the power of attraction of the earlier mark and its ability to distinguish the applicant’s goods and services from others’. It is alleged that the distinctive character of the “easy family of brands” would suffer “death by a thousand cuts” if a highly similar mark were used in one of its fields of operation.

6. The holder filed a counterstatement denying the basis of the opposition. In particular, it denies any similarity between the goods and services and claims that there is no likelihood of confusion. In respect of s. 5(3), the holder denies that the earlier trade mark has a reputation in the UK and denies that the average consumer would make the necessary link between the two marks. Absent a link, it says that the use of the contested mark would neither take unfair advantage of nor damage either the reputation or distinctive character of the earlier mark.

7. Given their dates of filing, the applicant’s trade marks qualify as earlier marks in accordance with s. 6 of the Act. As none of them had been registered for five years at the date on which the application for invalidation was filed, they are not subject to the use provisions at s. 47(2B)-(2F) and the applicant may rely upon all of the goods and services identified without showing that it has used the trade marks.

8. Only the applicant filed evidence, though both parties filed written submissions during the evidence rounds, which I will take into account and refer to as appropriate later in this decision. Neither party requested a hearing and neither filed written submissions in lieu. This decision is taken following a careful reading of all of the papers.

9. The applicant is represented by Kilburn & Strode LLP and the holder by Palmer Biggs IP, Solicitors.

Evidence

10. This consists of the witness statements of Ryan Pixton, Stelios Haji-loannou and Christopher Griffin. Mr Pixton is a Trade Mark Attorney at the applicant's professional representatives. Mr Pixton's statement is also a vehicle for the introduction into evidence of the witness statements of Mr Haji-loannou, who is the "founder and director of easyGroup which owns and manages the EASY family of brands", and of Mr Griffin, who is the chief executive of the Museum of Brands.

11. I have read all of the evidence. However, much of it, particularly Mr Haji-loannou's statement, which is dated 2017 and was not prepared for these proceedings, is irrelevant. The following appears to me to be the most relevant and material evidence:

- easyGroup (UK) Limited was founded in 1998.¹ Although Mr Haji-loannou says that easyGroup is not just a corporate vehicle, there is no evidence of its use as a trade mark in relation to any goods/services and no turnover figures for this mark;
- easyJet started in 1995 at Luton airport, where it is still based, with its first domestic flights in October or November of that year; international flights began in 1996.² It appears that a number of flights were to/from the UK and that other European destinations were served.³ By November 2017 this appears to have included 802 routes serving 31 European countries;⁴
- easyJet was floated on the stock market in 2000, which led to increased investment in and expansion of the business;⁵

¹ Haji-loannou, §30.

² Haji-loannou, §§9, 46; REP2, pp. 75, 105.

³ Haji-loannou, §§55, 57

⁴ Exhibit REP2, p. 60.

⁵ Haji-loannou, §47.

- Passenger numbers have seen a steady increase from 30,000 in its first year of operation and exceeded 74 million in the year February 2016 to January 2017.⁶ UK passenger numbers have exceeded 37 million since 2008.⁷ As at February 2017, on an average day, easyJet carries more than 200,000 passengers;⁸
- By 2000, easyJet was recognised as a “superbrand” by the Business Superbrands Council (no further information is given);⁹
- Total revenue for easyJet was in excess of £4 billion between 2013 and 2016.¹⁰ It is not clear whether this relates exclusively to airline services or whether it includes figures for other “goods and services provided under reference to the easyJet mark” referenced in Mr Haji-loannou’s statement (at §§54 and 59);
- easyJet featured in a TV series broadcast on ITV between 1999 and 2006;¹¹
- easyJet services were advertised via the easyEverything internet café website and in premises from March 2000.¹² It is not clear how long this lasted;
- The website easy.com is a portal offering links to each of the opponent’s businesses. It has been in operation since March 2000; both easyJet and easyGroup have appeared on the site since August 2000;¹³
- It appears that by February 2017 easyJet carried more passengers than British Airways; an article printed on 31 October 2016 says it is the UK’s biggest airline;¹⁴
- easyJet was, in November 2015, France’s second-biggest airline;¹⁵

12. I also note the following specific comments about the applicant in articles exhibited at REP2:

- easyCoffee is mentioned in an article from February 2017, in which an outlet in London’s Leicester Square is referenced;¹⁶

⁶ Haji-loannou, §48. See also REP2, pp. 61-64.

⁷ REP2, p. 105.

⁸ REP2, p. 76.

⁹ Haji-loannou, §56.

¹⁰ REP2, pp. 61-63 and Haji-loannou, §57.

¹¹ Haji-loannou, §58.

¹² Haji-loannou, §74.

¹³ Haji-loannou, §§88, 90.

¹⁴ REP2, pp. 75-76, 87

¹⁵ REP2, p. 92.

¹⁶ p. 77.

- An article dated July 2015, which appears to be from the *Mirror*, describes easyJet as “famous for its fees on everything from baggage to changing a name”;¹⁷
- easyJet has won various awards for its airline services, including the UK and Europe’s best low-cost airline (October 2016, eDreams.co.uk), best short-haul airline (August 2014, Business Travel Awards) and second place in the World Airline awards (July 2014, Skytrax).¹⁸ The first of these is said to be based on customer service and overall flying experience; the last includes check-in experience, cleanliness, comfort and entertainment. I note there is some reported criticism of the expense of “low cost” airlines compared with standard carriers;
- easyJet was a sponsor of Manchester Pride in 2014.¹⁹

13. Mr Griffin says that he is an expert in the field of branding, though it is not clear who has recognised him as such. He gives his opinion on the familiarity of the average consumer with the “easy” brand and how the average consumer will respond to other marks featuring the word “easy”.

14. That concludes my summary of the evidence.

¹⁷ p. 80.

¹⁸ pp. 85, 88, 97, 99

¹⁹ p. 102

Section 5(2)(b)

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

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

[...]

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

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

16. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

(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 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;

(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

17. The applicant does not claim that the goods and services are identical but contends that they are similar, in some cases to a high degree. There is obvious similarity between some of the goods and services (for example, between plates of glass in class 21 of the contested specification and retail of plates in class 35 of some of the earlier specifications). For reasons which will become apparent, I do not intend to conduct a full comparison but will proceed on the assumption that the goods and services are similar to a high degree. If the opposition fails where the goods and services are similar to the highest level claimed, it will also fail where there is a lesser degree of similarity between the goods and services.

The average consumer and the nature of the purchasing act

18. It must be determined who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. The average consumer is a legal construct deemed to be reasonably well informed and reasonably circumspect: *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) at [60]. For the purposes 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 and services in question: *Lloyd Schuhfabrik*.

19. Neither party has commented specifically on who the average consumer will be for the goods and services at issue. The majority of the goods and services are general consumer items or services for which the average consumer is likely to be a member of

the public. However, the contested wholesale services in class 35 are likely to be used by business consumers. The “hand tools and implements” in the specification of the earlier EASYJET mark may also have professional users, in addition to the general public.

20. None of the goods or services strikes me as a particularly casual purchase. Goods such as coasters, plates and cutlery are likely to be chosen on the basis of their aesthetic appeal, as well as their suitability for purpose. The latter will be a factor in the selection of the remaining goods in the parties’ specifications. The goods themselves are unlikely to be particularly costly. The member of the general public is likely to pay a medium degree of attention to the selection of all of the goods at issue; where relevant, professional users may have more precise requirements and will pay a reasonably high level of attention.

21. Turning to the services, a member of the public selecting retail services will bear in mind factors such as the range offered, stock levels and customer service provision. The services are, however, likely to be used fairly frequently and the general public is thus likely to pay a medium level of attention to their selection. A business user of wholesaling services is likely to be laying out more money on each transaction and be more reliant on, for example, guarantees of delivery. They will pay a reasonably high degree of attention.

22. The purchasing process for all of the goods and services will be mainly visual. The goods are likely to be selected from the shelves of retail premises or from websites. Consumers may also be exposed to the marks through advertising in print or online. The same type of advertising applies to the services, which may be selected from websites or from physical premises where the mark is likely to be displayed prominently. I do not rule out, however, that there may be an aural aspect to the selection of the goods and services.

Distinctive character of the earlier trade marks

23. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the Court of Justice of the European Union (“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)”.

24. The word “EASY” has a number of meanings, the most relevant of which in the *Collins English Dictionary* is “not requiring much labour or effort; not difficult; simple”.²⁰ I do not doubt that the average consumer will be very familiar with that definition or that s/he is likely to construe it as meaning that the goods or services are not complicated or difficult to use. The word is not inherently distinctive. Although the applicant’s earlier trade marks

²⁰ <https://www.collinsdictionary.com/dictionary/english/easy> [accessed 20 October 2020].

are all presented as one word, all consist of the word “EASY” followed by a second word, i.e. “FOOD”, “COFFEE”, “CUPS”, “GROUP” and “JET”. The average consumer will both be familiar with the second word in each mark and will readily recognise that the earlier marks consist of the word “EASY” united with another word. This, indeed, appears to be the applicant’s position.

25. The words which follow “EASY” in the earlier marks may be regarded as having some distinctive character for some of the goods and services. Even where they are descriptive, however, they will still make a contribution to the overall impression of the composite marks. The distinctiveness of the mark “EASYCUPS” derives from the combination of the specific words in question. However, the balance of distinctiveness will depend on the particular goods and services at issue. For example, where “CUPS” is not descriptive, such as in relation to retail services for aprons, the distinctiveness is weighted in favour of the word “CUPS”. Where “CUPS” is non-distinctive, the distinctiveness is more evenly balanced. The same applies to the “EASYCOFFEE” and “EASYFOOD” marks.

26. The “EASYGROUP” mark is composed of two elements, neither of which has much distinctiveness. The inherent distinctive character of the mark depends on the combination of the two words.

27. As for the “EASYJET” mark, again my view is that the distinctiveness of the mark arises from the combination of the two words. However, as “JET” is not descriptive in relation to any of the goods and services relied upon, the balance of distinctiveness is weighted towards the word “JET”.

28. It follows from what I have said that none of the earlier marks has more than an average degree of inherent distinctive character. Whilst the balance of distinctiveness is not fixed, the inherent distinctiveness of each of the marks results from the combination of two words, and “EASY” would not be perceived as the dominant element in any of the marks.

29. Enhanced distinctiveness is claimed for the “EASYGROUP” and “EASYJET” marks. There is, however, no clear evidence of revenue or turnover in relation to the goods and services relied upon, whilst the press material in evidence relates not to these goods and services but, unsurprisingly, to easyJet as an airline operator. No sales figures are provided for the EASYGROUP mark. Absent any kind of breakdown to assist me in determining what, if any, portion of turnover is attributable to the use of the marks in relation to the goods and services relied upon under this ground, I find that the evidence is inadequate to show that either mark benefits from an enhanced distinctive character.

Comparison of trade marks

30. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel* (particularly paragraph 23). *Sabel* 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 *Bimbo*, 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”.

31. It would be wrong, therefore, to dissect the trade marks artificially, although 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 therefore contribute to the overall impressions created by the marks. The marks to be compared are:

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Earlier trade marks	Contested trade mark
<p style="text-align: center;">EASYFOOD</p> <p style="text-align: center;">EASYCOFFEE</p> <p style="text-align: center;">EASYCUPS</p> <p style="text-align: center;">EASYGROUP</p> <p style="text-align: center;">EASYJET</p>	<p style="text-align: center;">easyslider</p>

32. As I have indicated above, each of the applicant’s marks is presented as one word, consisting of the combination of “EASY” with a second word. The presence of two known words will be recognised by the average consumer and the overall impression of each of the earlier marks is of the combination of two words.

33. Much the same applies to the contested mark. The overall impression is of the combination “easyslider” but the component words “easy” and “slider” will be recognised by the average consumer.

34. The visual similarity between the earlier marks and the contested mark arises from the shared element “EASY”/ “easy” at the beginning of the marks. There is a difference because the word “slider” is different from the second word in each of the earlier marks. There is in each case a medium degree of visual similarity.

35. Each of the marks at issue will be pronounced in its entirety and conventionally. The first two syllables are identical in all of them. There is no similarity between the second word in the respective marks (i.e. “slider” as against “FOOD”, “COFFEE”, “CUPS”, “GROUP” or “JET”). The contested mark has four syllables. “EASYFOOD”, “EASYCUPS”,

“EASYGROUP” and “EASYJET” all consist of three syllables and “EASYCOFFEE” has four. Nonetheless, I consider that there is a medium degree of aural similarity between each of the earlier marks and the contested mark.

36. As to the conceptual comparison, the applicant submits that “slider” describes a type of food. The holder denies this and points out that the applicant has not said what type of food a “slider” is. The applicant chose not to respond in written submissions on this point, nor did it seek to bolster its case with evidence. I do not know what type of food a “slider” is. I have checked *Collins English Dictionary* and the *Oxford English Dictionary*. The former says that a “slider” is a small hamburger; the latter that it may be an ice cream wafer sandwich. There is no evidence to assist me in determining whether a significant proportion of the public will know either meaning. In circumstances in which (a) my own experience is not atypical of that of the average consumer who is a member of the public, (b) the meaning of “slider” as a foodstuff is not apparent to me, (c) two leading dictionaries offer different meanings, (d) the applicant has chosen not to identify the type of foodstuff it considers a “slider” to be and (e) there is no evidence as to the extent to which, if at all, either group of average consumer will be aware of either meaning, my view is that the average consumer will not perceive “slider” as a foodstuff. It seems to me that the average consumer is likely to perceive a “slider” as something that slides. Therefore, all of the marks share the concept of “easy” but each of the earlier marks also has a second component from which the word “slider” is conceptually distinct. The respective marks as wholes are not conceptually similar; any conceptual similarity which may arise from the common word “easy” is not, at least prima facie, a distinctive conceptual similarity because “easy” is descriptive.

Likelihood of confusion

37. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]). Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, whilst indirect confusion involves the consumer recognising that the marks are different but nevertheless concluding that the later mark is another brand of the earlier mark owner. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis Q.C. 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”.

38. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed

out that it is not sufficient that a mark merely calls another mark to mind. This is mere association not indirect confusion.

39. I also bear in mind the comments of Mr Purvis, again 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”.

40. 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.

41. I have proceeded on the basis that the respective goods and services are similar to a high degree. There is a medium degree of both visual and aural similarity between each of the earlier marks and the contested mark. The earlier marks are distinctive to no more than an average degree. However, the element which is common to the respective marks, and from which any conceptual similarity arises, is lacking in distinctiveness. Even where only a medium level of attention is paid to the purchase of the goods and/or services, and

even where the distinctiveness of the earlier marks is evenly balanced between “EASY” and their second word, I do not consider that there is a likelihood of confusion, direct or indirect, with any of the applicant’s marks. The simple fact that the respective marks share the word “EASY” is insufficient to cause the average consumer either to mistake the marks or to believe that there is an economic connection between the users of the marks. I see no reason why the contested mark would be perceived as a brand extension of any of the earlier marks, considered individually, given the conceptual distinctions between the earlier and contested marks. In my view, the average consumer is likely to assume that the common use of “EASY” is a matter of coincidence because of its descriptive nature, rather than there being a connection between the parties. There is no likelihood of confusion.

Family of marks

42. The applicant’s submissions contain various comments on the “family” of “easy” marks. However, where a party wishes to rely on a “family of marks” argument it must plead it. The only potential reference to a family of marks in the application for invalidation is in the pleadings under s. 5(3) regarding detriment to the distinctive character of the mark. The absence of a clear pleading is enough for me to reject the argument. In any event, in order for a family of marks argument to succeed, the trade marks constituting that family must be present on the market: *Il Ponte Finanziaria SpA v OHIM*, Case 234/06 at [64]. The evidence only refers to the EASYGROUP and EASYJET trade marks in any detail; save for one reference to an easyCoffee shop in 2017, there is no evidence that any of the other earlier marks were present on the market at all or, more importantly, at the relevant date. Nor is there any evidence, save for imprecise assertions in Mr Haji-loannou’s statement, that the EASYGROUP or EASYJET marks were in use in relation to the goods and services relied upon at the relevant date. In any case, two marks do not a family make. This line of argument is dismissed.

Section 5(3)

43. Section 5(3) states:

“(3) A trade mark which-

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

44. 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, *Addidas-Salomon*, Case C-487/07, *L’Oreal 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 Saloman*, paragraph 29 and *Intel*, paragraph 63.

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* 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'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a

transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

45. As the earlier mark is an EUTM, I also keep in mind the guidance of the CJEU in *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07, EU:C:2009:611, at [20] to [30] and *Burgerista Operations GmbH v Burgista Bros Limited* [2018] EWHC 35 (IPEC) at [69].

Reputation

46. I accept that "EASYJET" had a strong reputation for airline services at the relevant date: it was clearly an important, if not the UK's biggest, airline by early 2017 and there is no reason to believe that its reputation had diminished significantly in the period before the relevant date. Although there are claims in the evidence to use of the mark in relation to other goods and services, no turnover figures specific to these goods and services are offered and none of the supporting evidence, such as articles in the press, goes to such goods and/or services. I do not consider that the applicant's evidence establishes that its reputation extended beyond airline services.

Link

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

The degree of similarity between the conflicting marks

48. For the reasons given at paragraphs 34 to 36, above, there is a medium degree of visual and aural similarity. Any conceptual similarity is restricted to the shared non-distinctive concept conveyed by “EASY”.

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

49. For the reasons given at paragraphs 19 to 22, most of the contested goods and services will be selected mainly visually by the general public paying a medium degree of attention. Some of the contested goods and services may be subject to purchase by business/trade users who will pay a higher level of attention. The average consumer of airline services is likely to be the general public. Factors such as service coverage, reliability and flight times will all 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. The goods in class 21 are different in all respects from the applicant’s airline services, save for users which is at too high a level of generality to engage similarity overall. The same applies to the contested services. There is no similarity between the services of the earlier mark and the contested specification.

The strength of the earlier mark’s reputation

50. The earlier mark has a strong reputation.

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

51. For the reasons given at paragraph 27, above, the earlier mark is inherently distinctive to an average degree. Given the use which has been made of the mark, its distinctiveness

has been enhanced. It is factually distinctive to a high degree. However, the word “EASY” alone is not distinctive.

Whether there is a likelihood of confusion

52. Given the distance between the respective goods and services and the low level of distinctiveness of the common element “EASY”/“easy”, I see no risk of a likelihood of confusion, including the likelihood of association, on the part of the relevant public.

53. Bearing in mind all of the above, and in particular the conceptual distinction between the marks, the low level of distinctiveness of the common element and the significant distance between the goods and services, I find that despite the strength of the earlier mark’s reputation the average consumer is unlikely to make a link between the respective marks. The opposition under s. 5(3) is dismissed.

54. If that is not right and some consumers would have made a link between the marks, I would still have rejected the s. 5(3) ground. My reasons follow.

Damage

55. The applicant’s pleaded case is that there would be unfair advantage because the average consumer would make a link between the marks because the goods and services are similar and because the contested mark looks like an extension of the applicant’s brand. However, there is no similarity between the goods and services and I have already rejected the assertion that there is a likelihood of confusion under s. 5(2)(b). This aspect of the claim was bound to fail.

56. The applicant also claims that the holder would be able to trade on the applicant’s reputation for “great-value, customer-friendly goods and services”. Even had it been established that such attributes were connected with the applicant’s reputation in airline services, the gap between airline services and the goods and services of the contested

specification is wide. There is no evidence that it would be usual for providers of airline services to expand into the fields covered by the contested specification, which makes it unlikely that any commercial advantage would be gained by the holder and unlikely that there would be any image transfer.

57. It is also claimed that use of the contested mark on or in relation to inferior goods or services could diminish the reputation of the earlier mark. It is, however, difficult to see how the average consumer merely being reminded of the earlier mark would damage the earlier mark's reputation. The proposition that use of a mark with no more than the potential to create a negative association if it were, hypothetically, used in relation to inferior goods and/or services was rejected as insufficient to found an opposition based upon this head of damage in *Unite The Union v The Unite Group Plc*, Case BL O/219/13. The applicant's claim is purely hypothetical and I dismiss it.

58. Finally, the applicant claims that the distinctiveness of its mark will be diluted and will suffer "death by a thousand cuts". 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)".

It went on:

"42. 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’.²¹

59. Although the earlier mark has a strong reputation, given the weakness of the “EASY” element, I do not accept that the coincidence of two marks containing this word will present a serious risk of a change in the economic behaviour of the applicant’s customers. Further, the distance between the goods and services at issue is such that it is difficult to envisage circumstances in which the economic behaviour of the applicant’s customers would be affected by the use of the contested mark.

60. The s. 5(3) ground is therefore also rejected.

Conclusion

61. The application for invalidation is dismissed.

Costs

62. The holder has been successful and is entitled to an award of costs. The applicable scale is contained in Tribunal Practice Notice 2/2016. I take into account that, whilst much of the applicant’s evidence was irrelevant, it was not particularly voluminous, and that the holder filed no evidence. I award costs to the holder as follows:

²¹ See also *32Red Plc v WHG (International) Limited and others* [2011] EWHC 665 (Ch) at [133], in which the judge held that a change in consumers’ economic behaviour could be inferred from the inherent probabilities of the situation and para. 137 of - *Ziff Management Europe Ltd v Och Capital LLP* [2011] F.S.R. 11 (HC).

Considering the application and filing a counterstatement:	£200
Considering the other party's evidence	£500
Written submissions:	£300
Total:	£1,000

63. I order easyGroup Ltd to pay Wundermix GmbH the sum of **£1,000**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30th day of October 2020

Heather Harrison
For the Registrar
The Comptroller-General

ANNEX

Section 5(2)(b): earlier trade marks and specifications upon which the opponent relies

EUTM17808098 EASYFOOD

Class 35: Retail services connected with the sale of fruit drinks and fruit juices, syrups and other preparations for making beverages, mugs, cups, flasks, tumblers; retail services connected with the sale of plates, cutlery, aprons, clothing, footwear and headgear, napkins, serviettes, newspapers, paper, magazines and printed materials.

EUTM 12715793 EASYCOFFEE

Class 35: Retail services connected with the sale of meat, fish, poultry and game, preserved fruits, dried fruits, cooked fruits, dried vegetables, cooked vegetables, products containing fruits, fruit desserts, jellies, jams, compotes, yoghurt, yoghurt based products, vegetable and fruit based snack foods, fruit purée and pulp, dairy products, milk shakes, snack foods, prepared meals, sugar, rice, tapioca, sago, preparations made from cereals, bread, pastry and confectionery, ices, fruit sauces, baked goods, namely, muffins, scones, biscuits, cookies, pastries, pies, pasties and breads, sandwiches and granola, ice cream, frozen confectionery, chocolate, candy and confections, beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages, mugs, cups, flasks, tumblers, plates, cutlery, aprons, clothing, footwear and headgear, napkins, serviettes, newspapers, paper, magazines and printed materials.

EUTM 15600018 EASYCUPS

Class 35: Retail services connected with the sale of plates, cutlery, aprons, clothing, footwear and headgear; napkins, serviettes, newspapers, paper, magazines and printed materials.

EUTM 14920391 EASYGROUP

Class 35: Retail services connected with the sale of food and drink; retail services connected with the sale of preparations and substances for use in the care and appearance of the hair, scalp, lips, face, skin, teeth, nails and eyes; retail services connected with the sale of cosmetics, non-medicated toilet preparations, perfumes, fragrances, colognes and scents, soaps and cleaning preparations; retail services connected with the sale of shampoos, conditioners, moisturisers, tooth cleaning preparations; retail services connected with the sale of depilatory preparations, sun-screening and tanning preparations; retail services connected with the sale of anti-perspirants, deodorisers and deodorants; retail services connected with the sale of sunglasses, personal stereos, MP3 players, CD players, apparatus for playing music and video recordings; retail services connected with the sale of jewellery, stones, watches, clocks; retail services connected with the sale of books, magazines, newspapers, stationery, calendars, diaries; retail services connected with the sale of purses, umbrellas, parasols briefcases, purses, wallets, pouches and handbags; retail services connected with the sale of luggage, suitcases, travelling sets, sports bags, bike bags, backpacks, games, playing cards; retail services connected with the sale of gymnastic and sporting articles; retail services connected with the sale of scooters.

EUTM 10584001 EASYJET

Class 8: Hand tools and implements; cutlery.

Class 35: Retail services connected with the sale of food and drink, preparations and substances for use in the care and appearance of the hair, scalp, lips, face, skin, teeth, nails and eyes, cosmetics, non-medicated toilet preparations, perfumes, fragrances, colognes and scents, soaps and cleaning preparations, shampoos, conditioners, moisturisers, tooth cleaning preparations, depilatory preparations, sun-screening and tanning preparations, anti-perspirants, deodorisers and deodorants, sunglasses, personal stereos, MP3 players, CD players, apparatus for playing music and video recordings, jewelry, stones, watches, clocks, books, magazines, newspapers, stationery, calendars, diaries, purses, umbrellas, parasols briefcases, purses, wallets, pouches and

handbags, luggage, suitcases, travelling sets, sports bags, bike bags, backpacks, games, playing cards, gymnastic and sporting articles, scooters.

Section 5(3): earlier trade mark and specification upon which the opponent relies

EUTM 10584001 EASYJET

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, travel information and travel booking services provided on-line from a computer database or the internet.