

O-553-20

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3406317
BY EASYGROUP LIMITED IN RESPECT OF THE FOLLOWING TRADE MARK**

easy

IN CLASSES 35, 39 AND 43

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 417879 BY
ALNAIR LIMITED**

Background and pleadings

1. easyGroup Limited (“the applicant”) applied to register the trade mark “easy” in the UK on 12 June 2019. It was accepted and published in the Trade Marks Journal on 28 June 2019 in respect of the following services:

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; retail services connected with the sale of 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, gymnastic and sporting articles, scooters; marketing and publicity services; dissemination of advertising, marketing and publicity materials; 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.*

Class 39: *Transport; travel arrangement; travel information; transportation of passengers and travelers by air; airline services; arranging of transportation of passengers and travelers by sea; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft; airport transfer services; escorting of travelers; travel agency services; tourist guide 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.*

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; provision of facilities for exhibitions and conferences.*

2. Alnair Limited (“the opponent”) opposes the application on the basis of section 5(2)(b), section 5(3), section 5(4)(a) and section 3(1)(b) and (c) of the Trade Marks

Act 1994 (“the Act”). The following five earlier marks are relied upon for the purposes of both the section 5(2)(b) and section 5(3) grounds:

Earlier mark details	Services relied upon	Services opposed
<p>1482481</p> <p>BIG EASY</p> <p>Filing date: 12 November 1991</p> <p>Date of entry on register: 5 March 1993</p>	<p>All relied upon for section 5(2)(b) and section 5(3)</p> <p>Class 42: <i>Restaurant services; all included in Class 42.</i></p>	<p><u>Underlined</u>: under section 5(2)(b)</p> <p>Bold: under section 5(3)</p> <p>Class 35: <u>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; retail services connected with the sale of 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, gymnastic and sporting articles, scooters;</u></p>

		<p><i>marketing and publicity services; dissemination of advertising, marketing and publicity materials; 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.</i></p> <p>Class 39: <i>Transport; travel arrangement; travel information; transportation of passengers and travelers by air; airline services; arranging of transportation of passengers and travelers by sea; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft; airport transfer services; escorting of travelers; travel agency services; tourist guide 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.</i></p> <p>Class 43: <u><i>Services for providing food and drink; temporary</i></u></p>
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		<u>accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; hotel services; hotel reservation services; provision of facilities for exhibitions and conferences.</u>
<p>3150127</p>  <p>Filing date: 17 February 2016</p> <p>Date of entry in register: 27 May 2016</p>	<p>Bold: claimed reputation for section 5(3)</p> <p>Underlined: relied upon for the purposes of section 5(2)(b)</p> <p>Class 32: Beer</p> <p>Class 43: <u>Services for providing food and drink; temporary accommodation; café and coffee bar services; food and drink preparation services; food and drink takeaway services; restaurant services; fast-food restaurant services; canteens; self-service restaurant services; snack-bars; restaurant and bar services including kiosk and take-away; providing prepared meals; preparation of foodstuffs or meals for consumption on or off the premises.</u></p>	AS ABOVE
<p>3200483</p> <p>BIG EASY</p> <p>Filing date: 5 December 2016</p>	<p>Only those shown in bold are relied upon for the purposes of section 5(3)</p> <p>Class 30: Bar-B-Q sauces; chutneys; condiments; cooking sauces; food dressings; chocolate</p>	<p>All of the following are opposed under section 5(2)(b) and section 5(3)</p> <p>Class 35: Retail services connected with the sale of food and drink, preparations and substances for use</p>

<p>Date of entry in register: 20 December 2019</p>	<p><i>sauces; fruit sauces; pepper sauces; fish sauces; sauces for marinading meat and chicken; pasta sauces; ice-cream sauces; biscuits; breakfast cereals; chocolate; confectionery; bread; pastries; cakes; ice-cream; fruit teas; tea; coffee.</i></p> <p>Class 32: Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; ginger beer; isotonic beverages; lemonades; soda water; tomato juice.</p> <p>Class 35: Bringing together for the benefit of others a variety of food and drink products for purchase via an online shop, a retail establishment, restaurant or department store.</p> <p>Class 43: Services for providing food and drink; temporary accommodation; café and coffee bar services; food and drink preparation services; food and drink takeaway services; restaurant services; fast-food restaurant services; canteens; self-service restaurant services; snack-bars; restaurant and bar services including kiosk and take-away; providing prepared meals; preparation of foodstuffs or meals for</p>	<p><i>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; retail services connected with the sale of 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, gymnastic and sporting articles, scooters; [...].</i></p> <p>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; provision of facilities for exhibitions and conferences.</p>
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	consumption on or off the premises.	
<p>3299517</p> <p>BIG EASY BAR.B.Q & CRABSHACK</p> <p>Filing date: 26 March 2018</p> <p>Date of entry in register: 20 December 2019</p>	<p>All relied upon for the purposes of both section 5(2)(b) and section 5(3)</p> <p>Class 43: <i>Services for providing food and drink; temporary accommodation; cafe and coffee bar services; food and drink preparation services; food and drink takeaway services; restaurant services; fast-food restaurant services; canteens; self-service restaurant services; snack-bars; restaurant and bar services including kiosk and take-away; providing prepared meals; preparation of foodstuffs or meals for consumption on or off the premises.</i></p>	<p>AS PER 1482481</p>
<p>3299520</p> <p>BIG EASY BAR.B.Q & LOBSTERSHACK</p> <p>Filing date: 26 March 2018</p> <p>Date of entry in register: 20 December 2019</p>	<p>All relied upon for the purposes of both section 5(2)(b) and section 5(3)</p> <p>Class 43: <i>Services for providing food and drink; temporary accommodation; cafe and coffee bar services; food and drink preparation services; food and drink takeaway services; restaurant services; fast-food restaurant services; canteens; self-service restaurant services; snack-bars; restaurant and bar services including kiosk and take-away; providing prepared meals; preparation of foodstuffs or meals for consumption on or off the premises.</i></p>	<p>Underlined: under section 5(2)(b)</p> <p>Bold: under section 5(3)</p> <p>Class 35: <u>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</u></p>

		<p><i>deodorants, sunglasses; retail services connected with the sale of 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, gymnastic and sporting articles, scooters; marketing and publicity services; dissemination of advertising, marketing and publicity materials; 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.</i></p> <p><i>Class 39: Transport; travel arrangement; travel information; transportation of passengers and travelers by air; airline services; arranging of transportation of passengers and travelers by sea; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and</i></p>
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		<p><i>vacations; chartering of aircraft; rental and hire of aircraft; airport transfer services; escorting of travelers; travel agency services; tourist guide 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.</i></p> <p><u>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; provision of facilities for exhibitions and conferences.</u></p>
<p>European Union Trade Mark (EUTM) 17865072</p>  <p>Colours Claimed/Indication: Red; Black; White; Grey</p>	<p>Only those shown in bold are relied upon for the purposes of section 5(3)</p> <p>Class 29: <i>Jams; jellies; fruit conserves; pickled fruit; fruit snacks; mincemeat; preserved frozen fruit.</i></p> <p>Class 30: <i>Bar-B-Q sauces; chutneys; condiments; cooking sauces; food dressings; chocolate sauces; fruit sauces; pepper sauces; fish sauces; sauces for</i></p>	<p><u>Underlined:</u> under section 5(2)(b) Bold: under section 5(3)</p> <p><u>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.</u></p>

<p>Filing date: 25 November 2015</p> <p>Date of entry in register: 15 March 2018</p>	<p><i>marinading meat and chicken; pasta sauces; ice-cream sauces; biscuits; breakfast cereals; chocolate; confectionery; bread; pastries; cakes; ice-cream; fruit teas; tea; coffee.</i></p> <p>Class 31: <i>Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt; beans; berries; citrus fruit; coconuts; cucumbers; lettuce; marrows; fresh mushrooms; fresh olives; fresh onions; fresh potatoes; rhubarb.</i></p> <p>Class 32: <i>beer</i> [Not relied upon for the section 5(2)(b) grounds]</p> <p>Class 35: <i>Bringing together for the benefit of others a variety of food and drink products for purchase via an online shop, a retail establishment, restaurant or department store.</i></p> <p>Class 43: <i>Services for providing food and drink; temporary accommodation; café and coffee bar services; food and drink preparation services; food and drink takeaway services; restaurant services; fast-food restaurant services; canteens; self-service restaurant services; snack-bars; restaurant and bar services</i></p>	<p><u>moisturisers, tooth cleaning preparations, depilatory preparations, sun-screening and tanning preparations, anti-perspirants, deodorisers and deodorants, sunglasses; retail services connected with the sale of 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, gymnastic and sporting articles, scooters; marketing and publicity services; dissemination of advertising, marketing and publicity materials; 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.</u></p> <p>Class 39: <i>Transport; travel arrangement; travel information; transportation of passengers and travelers by air; airline services; arranging of transportation of</i></p>
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	<p><i>including kiosk and take-away; providing prepared meals; preparation of foodstuffs or meals for consumption on or off the premises.</i></p>	<p><i>passengers and travelers by sea; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft; airport transfer services; escorting of travelers; travel agency services; tourist guide 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.</i></p> <p><u><i>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; provision of facilities for exhibitions and conferences.</i></u></p>
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3. In addition to these five earlier marks, the opponent also relies upon the following earlier mark in respect of the grounds based upon section 5(2)(b) only:

Earlier mark details	Services relied upon	Services opposed
3150127  Filing date: 17 February 2016 Date of entry in register: 27 May 2016	Class 43: <i>Services for providing food and drink; temporary accommodation; café and coffee bar services; food and drink preparation services; food and drink takeaway services; restaurant services; fast-food restaurant services; canteens; self-service restaurant services; snack-bars; restaurant and bar services including kiosk and take-away; providing prepared meals; preparation of foodstuffs or meals for consumption on or off the premises.</i>	Class 35: <i>Retail services connected with the sale of food and drink</i> Class 43: <i>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; provision of facilities for exhibitions and conferences.</i>

4. The opponent asserts that the applicant's mark is wholly incorporated in the opponent's marks (and in respect of the opponent's word and device mark(s), it is the dominant verbal element) and they are, therefore, similar and create a clear link between the two. It also asserts that the applicant's Class 35 services are closely related to opponent's *restaurant services* and that the applicant's Class 43 services are identical or similar to *restaurant services*. It concludes that there is a likelihood of confusion between its marks and the applicant's mark and that the application is contrary to section 5(2)(b) of the Act.

5. In respect of the ground based upon section 5(3), the opponent asserts that use of the applicant's mark in respect of all of the listed services would, because of its similarity to the opponent's marks, lead to an assumption that there is an economic connection between the marks.

6. The section 5(4)(a) ground is based upon the opponent having goodwill identified by the following five signs:

- (i) BIG EASY
- (ii) BIG EASY BAR.B.Q & CRABSHACK
- (iii) BIG EASY BAR.B.Q & LOBSTERSHACK



7. It is claimed that they were all first used in 1991 and use has been in the London area over a period of twenty-eight years. It has three main venues located in prime tourist and business locations in London. The name BIG EASY has become widely recognised in the restaurant and bar trade and goodwill is claimed in respect of the following goods and services:

Beers, wines, sauces, clothing, cocktails, takeaway services, retail services, restaurant services, bar services

8. In addition, the opponent also asserts that the contested application should be refused under section 3(1)(b) and section 3(1)(c) of the Act because the word “easy” is non-distinctive and a “laudatory descriptor of the accessibility or usability” of all the applicant’s services.

9. The applicant filed a counterstatement denying the claims made and requesting that the opponent provide proof of use of its earlier mark 1482481 BIG EASY in respect of *restaurant services; all included in Class 42*.

10. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. Neither side requested to be heard, but the applicant filed written submissions in lieu of a hearing. I will not summarise these but I will refer to them as appropriate. I make my decision after a careful review of the papers.

DECISION

Opponent's Evidence

11. This takes the form of two witness statements. The first is from Michelle Anne Ward, Chartered Trade Mark Attorney for Indelible IP Limited, who is representing the opponent in these proceedings. Ms Ward's evidence relates to the opponent's use of its marks and also provides a dictionary definition for the word "easy".

12. The second witness statement is from Paul Corrett, founder of the Big Easy chain of restaurants. Mr Corrett is also owner and CEO of the opponent company and the managing director of Big Easy Restaurants Limited. The opponent licenses use of the BIG EASY name and logos to the group of companies for the various businesses operating the BIG EASY restaurants in the UK. Mr Corrett's evidence relates to demonstrating use and reputation of the opponent's marks.

Proof of use

13. The registration period for the opponent's earlier mark 1482481 was completed on 5 March 1993 and is more than 5 years before the date of application of the contested mark. The earlier mark is, therefore, subject to the proof of use provisions contained in section 6A of the Act. The earlier mark is BIG EASY and is registered in respect of *restaurant services*. The opponent's earlier mark 3200483 is for the identical mark and its list of goods and services also includes *restaurant services*. This earlier mark is not subject to the proof of use provisions and, as a consequence, the opponent is placed in no stronger position when relying upon its earlier mark 1482481 than when relying upon its 3200483 mark.

14. In light of the above, for the purposes of these proceedings, an assessment of proof of use of the opponent's 1482481 mark would not normally have the capacity to improve the opponent's position. However, in these proceedings the opponent has chosen to oppose a broader list of goods and services when relying upon earlier mark 1482481 than when relying 3200483. However, for reasons that will become apparent, this choice has no impact on whether the issue of proof of use needs to be

considered. Consequently, I will not consider the issue proof of use and will proceed instead on the assumption that use has been shown in respect of *restaurant services*.

Approach to considering the section 5(2)(b) and section 5(3) grounds of opposition

15. The opponent relies upon a total of seven earlier marks with overlapping lists of goods and services. The words BIG EASY are the common theme appearing in all of these marks and it is this element that contains the word EASY, being the same word that the applicant's mark consists of. I am of the view that the opponent's word mark BIG EASY presents its strongest case in respect of most of the opposed services and, therefore, for the purposes of the grounds based upon section 5(2)(b) I will restrict my considerations primarily to the opponent's case based upon its 3200483 BIG EASY mark.

16. In respect of the grounds based upon section 5(3), the opponent's earlier mark 3200483 BIG EASY has a list of goods and services for which there is a claimed reputation that is as least as broad as the reputation claimed in respect of the other earlier marks. Therefore, in the first instance, I will restrict my considerations to the case based upon this earlier mark.

Section 5(2)(b)

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

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

18. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

Comparison of goods and services

19. In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

20. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

21. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“the GC”) stated that:

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

22. When considering the similarity between the respective goods and services with the guidance from *Merici* in mind, the following terms coincide and cover at least some identical services:

Opponent’s services	Applicant’s services
Class 35	
<i>Bringing together for the benefit of others a variety of food and drink products for purchase via an online shop, a retail establishment, restaurant or department store.</i>	<i>Retail services connected with the sale of food and drink</i>
Class 43	
<i>Services for providing food and drink temporary accommodation restaurant services; fast-food restaurant services; self-service restaurant services;</i>	<i>Services for providing food and drink temporary accommodation; provision of holiday accommodation restaurant, bar and catering services</i>

restaurant and bar services including kiosk and take-away	
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23. For reasons of procedural economy, I will not undertake a full comparison of the goods and/or services. The examination of the opposition will proceed on the basis that at least some of the contested services are identical to those covered by the earlier trade marks. If the opposition fails, even where the services are identical, it follows that the opposition will also fail where the services are only similar.

Comparison of marks

24. It is clear from *Sabel BV v. Puma AG*, Case C-251/95 (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*, Case C-591/12P, 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.”

25. 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 and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

26. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
BIG EASY	easy

27. The opponent's earlier mark consists of the two words BIG and EASY. This will strike the average consumer as forming a single term where the first word functions as an adjective which qualifies the second. Therefore, the distinctive character is created by the combination of the two words. The two words share equal dominance and distinctive character within the mark. The applicant's mark consists of the single word "easy" and is self-evidently the dominant and distinctive element.

28. The word "easy" is the only element in the applicant's mark and is the second word of two words in the opponent's mark. This creates visual similarity between the marks. The word "big" appearing at the beginning of the opponent's mark creates a visual difference. Taking all of this into account, the marks share a medium to medium high level of visual similarity.

29. The opponent's mark will be expressed as the three syllables BIG-EASE-EE. The applicant's mark shares the second and third of these syllables and creates a medium to medium high level of aural similarity.

30. Conceptually, the applicant submits that BIG EASY is the nickname for the city of New Orleans. This is confirmed by a dictionary reference where it is listed as an informal name for the city¹ and the evidence illustrates it in use where an Evening Standard review (dated 27 March 2014) of one of the opponent's BIG EASY restaurants begins "The real Big Easy is, of course, New Orleans – that elegant Petri dish of life on the Louisiana coast, birthplace of more good music and more good cocktails than just about anywhere"². For those consumers who are aware of this, the mark creates an immediate and obvious conceptual dissonance with the applicant's mark. Many consumers may not be aware that BIG EASY is an informal name given to New Orleans, nevertheless, they are likely to be familiar with the

¹ https://www.lexico.com/definition/big_easy

² Exhibit PC10, page 6

phrase and are likely to recognise it as an American expression and may know it's a term for an American city even if they are unsure which one. Regardless of which of these levels of knowledge the average consumer has of the term it, nonetheless, creates an expression whose memorable impact resides in the combination of the two words.

31. The applicant also relies upon its claim that its mark "easy" is associated with the applicant in the mind of the average consumer. I dismiss this. The applicant has not filed any evidence and has, therefore, failed to prove such an assertion. Whilst the applicant may have an established business in the UK providing air travel to holiday makers it is far from obvious that this claimed association extends to the word "easy" alone or to the range of goods and services relied upon. Therefore, my consideration is based upon the ordinary meaning of "easy". In this respect, it is likely to be understood as meaning "not requiring much labour or effort; not difficult; simple *an easy job*"³. Taking account of these respective meanings and the fact that, in the opponent's mark, the adjective "big" acts upon the word "easy" to create the impression or expectation that the word "easy" is acting (somewhat unusually) as a noun, there is no conceptual similarity between the marks.

Average consumer and the purchasing act

32. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

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

³ Exhibit MAW6 containing an extract from the Collins English Dictionary

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

34. The parties have made no submissions regarding who the average consumer is, the nature of the purchasing act or the level of care and attention involved in the purchasing act. The majority of the parties’ goods and services are of a nature to be aimed at ordinary members of the public. They are everyday purchases (such as food items) or regularly accessed services (such as retailing, restaurant and bar services). In such cases the purchasing act is likely to be primarily visual in nature and the level of care and attention during the purchasing act is not likely to be particularly high. Some services, such as *temporary accommodation* are likely to be purchased on a less frequent basis and the selection process is likely to be more carefully considered. Finally, services such as *provision of facilities for exhibitions and conferences* are likely to be aimed at business consumers who will pay a higher degree of attention because of the need to meet more complex requirements.

Distinctive character of the earlier trade mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

36. The opponent’s mark consists of the words BIG EASY that is an informal reference to the city of New Orleans. For those consumers who will be aware of this, it is, therefore, suggestive of goods or services that have a connection with or otherwise evoke the image of that city. As I have already found, for those consumers who do not know of its meaning, it will still evoke an image of an American city or at the very least they will recognise it as an American expression. Consequently, I conclude that it is endowed with a medium level of distinctive character.

37. The opponent has made no specific claim to its mark benefiting from an enhanced level of distinctive character but it has provided evidence of use and reputation⁴. I will, therefore, comment briefly on this.

38. The use of the opponent’s mark can be summarised as follows:

- Mr Corrett opened the first BIG EASY restaurant in Kings Road, London in 1991 with further restaurants following in Covent Garden in 2014 and Canary Wharf in 2015⁵. Use has been continual since 1991⁶. It is estimated that since 1991, the opponent has served over 5 million meals and, by way of

⁴ Mr Corrett’s witness statement, paras 12 - 17

⁵ Ditto, para 2

⁶ Ditto, para 3

example, the Canary Wharf restaurant took in the region of £1.2 million in respect of bar sales in its first year⁷;

- Accounts filed at Companies House illustrate turnover of nearly £16.5 million to 31 January 2016 and to 30 July 2017 and over £21 million to 29 July 2018⁸;
- Use of the opponent's mark is shown on undated sample drinks menus⁹ showing "Big Easy" used in phrases like "Big Easy Mixed [drinks]", "Big Easy still or Big Easy Sparkling [water]", house wines being described as "Big Easy White" and "Big Easy Red" as well as a beer pull-pump handle where the BIG EASY BAR.B.Q & CRABSHACK and device mark is shown¹⁰. The opponent sells 10,000 cases of BIG EASY wine a year through its venues¹¹. Example food menus stated to be from August 2014 and February 2016 are also provided¹²;
- Takeaway food and drink has been in constant demand and since 2016 the opponent has had an agreement with Deliveroo to provide takeaway services offered via all three of the opponent's restaurants¹³. The Chelsea restaurant alone has around £400,000 sales per annum in takeaways¹⁴. Screenshots from the Deliveroo website show listings for the BIG EASY restaurants in Chelsea and Canary Wharf¹⁵. These were printed on "03/07/2019";
- Extracts from the opponent's website, obtained on "03/01/19" contains tabs for "Covent Garden", "Kings Road" and "Canary Wharf", presumably a reference to each of the three restaurant locations. They are identified by reference to the words "Big Easy" and the BIG EASY BAR.B.Q & LOBSTERSHACK device mark¹⁶;

⁷ Ditto, para 9

⁸ Exhibit PC9

⁹ At Exhibit PC2

¹⁰ Exhibit PC3

¹¹ Mr Corrett's witness statement, para 4

¹² Ditto, para 7 and Exhibit PC5

¹³ Ditto, para 6

¹⁴ Ditto

¹⁵ Exhibit PC4

¹⁶ Ms Ward's witness statement, para 3 and Exhibit MAW2

- The opponent’s restaurants offer the hire of the venues for corporate dining events and examples of such bookings are provided¹⁷;
- A number of national and London based press articles about the opponent’s BIG EASY restaurants are provided, dated between 2014 and 2016¹⁸. These appeared in publications such as the Guardian, the Telegraph, the Evening Standard, The Independent, The Observer magazine, Bazaar, Tatler and The Handbook;
- Further press coverage was generated when the opponent’s restaurant teamed up with New York bar Dead Rabbit to bring a cocktail promotion to the restaurants for a month in the summer of 2014. This was reported in Hot Dinners, Bar and thespiritbusiness.com and a promotional leaflet is also provided¹⁹;
- The opponent’s Twitter account has been open since July 2010 and its Facebook account since 2019²⁰. A screen shot from both confirms this and both also refer to the opponent’s restaurant by reference to the words “Big Easy” and the BIG EASY BAR.B.Q & CRABSHACK device mark²¹;
- The opponent’s restaurants are also music venues and, in 2014, this led to a collaboration with Mascot Records (described as a world class major record label) to find a new blues star²²;
- The opponent’s restaurants have been popular venues for celebrities and over the years visits to the restaurants have been made by Princes William and Harry, Sheryl Crow and Kelly Brook²³;
- The opening of the Canary Wharf venue was “highly publicised” including by way of a 2-metre-high advertisement placed in Canary Wharf Shopping Centre²⁴.

¹⁷ Exhibit PC7 is an example brochure promoting the provision of corporate dining with a claimed date of September 2014. Exhibit PC8 consists of numerous redacted emails showing bookings for such services from the years 2015 – 2018.

¹⁸ Exhibit PC10

¹⁹ Mr Corrett’s witness statement para 14 and Exhibit PC12

²⁰ Ms Ward’s witness statement, para 4

²¹ Exhibit MAW4

²² Mr Corrett’s witness statement, para 16 and Exhibit PC14

²³ Mr Corrett’s witness statement and Exhibit PC11

²⁴ Ditto, para 17 and Exhibit PC15

39. This evidence demonstrates that the opponent's BIG EASY word mark has been used in respect of three restaurants in London which commenced trading in 1991, 2014 and 2015 respectively. Collective turnover was between £16 million and £21 million a year. Such use is impressive, but I keep in mind the restaurants are all in London and, consequently, use of the opponent's marks has not been geographically widespread around the UK. The share of the UK restaurant market is very small and when considering what proportion of the UK restaurant-going public will identify the opponent's goods and services as originating from a particular undertaking, this is also very small. I note that there is some evidence of promotional activity but it is limited to some promotional flyers (promoting the event with the Dead Rabbit bar) and one advertising hoarding at a shopping centre, again in London. Taking all of this into account, I conclude that the use is not sufficient to demonstrate that the opponent's BIG EASY mark or any other of the marks relied upon have acquired an enhanced level of distinctive character based upon the use made of the marks.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

40. The following principles are obtained from the decisions of the 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 B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely

upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

41. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). These factors must be assessed from the viewpoint of the average consumer who rarely has the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and goods down to the responsible undertakings being the same or related).

42. The applicant submits that BIG EASY is the nickname for the city of NEW ORLEANS but that its mark “easy” is closely associated with the applicant in the minds of the average consumer. It submits that, as a result, the respective marks create a different overall impression.

43. There appears to be no dispute that BIG EASY is the informal name for the city of New Orleans, however, the issue is whether the relevant average consumer in the UK will be aware of this²⁵. It is not clear to me that they would be and certainly there is little evidence that it is the case. The only evidence I can find is the review I referred to in paragraph 30 above. This suggests that the term “Big Easy” is understood as a reference to New Orleans, but it is no more than a suggestion. In the absence of further evidence, I am reluctant to take judicial notice of the fact and I decline to do so.

44. Having reached this conclusion and as I commented earlier, I am still of the view that the term “Big Easy”, nevertheless, is an expression that will be familiar to the UK average consumer. The consumer is likely to recognise the phrase as an American

²⁵ See *CHORKEE Trade Mark*, BL O-048-08, para 37

expression and may know it's a term for an American city even if they are unsure which one. Its construction does not follow the norms of UK English language because the word "big" is normally used as an adjective appearing before a noun. In this case, it appears before another adjective. This construction is not usual and creates an expression whose memorable impact resides in the combination of the two words.

45. Another relevant factor in my considerations is that the word "easy" solus is at best at the low end of the spectrum of distinctiveness. It is an ordinary dictionary word that is commonly used to indicate that something does not require much labour or effort²⁶. Whilst not decisive, I keep in mind that this being so is a factor counting against a finding of a likelihood of confusion.

46. Taking all of the above into account, even where the respective services are identical, a combination of the fact that the mark "easy" is endowed with, at best, only a minimal level of distinctive character and the conceptual distinctions between the marks, when combined, are sufficient that the earlier mark will not be brought to mind. These conceptual differences are sufficient to overcome any visual and aural similarity created by the presence of the word "easy" in both marks. The word "easy" in the opponent's mark does not have a "distinctive significance which is independent of the significance of the whole"²⁷. The guidance of the CJEU in *Medion* that the presence of a common element may lead to a finding of confusion is not necessarily decisive²⁸ and does not reflect the circumstances in the current case.

47. I conclude that there is no likelihood of confusion, either direct or indirect. This finding would not be disturbed if I am found to be wrong regarding whether the opponent's mark has acquired an enhanced level of distinctive character through use. By virtue of the low number of outlets and their geographical scope (limited to London), any enhanced level of distinctive character resulting from such use would only be minimal when considering it from the perspective of the UK consumer.

²⁶ See footnote 3

²⁷ See *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch) where Arnold J (as he then was) considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*

²⁸ See, for example, *Annco, Inc. v OHIM*, Case T-385/09 at [48] – [50]

48. It follows that this finding is extended to where the respective goods are not identical. Further, if the opponent cannot succeed based upon its word mark BIG EASY, it also fails in respect of its other marks that share a lower level of similarity to the applicant's mark.

Section 5(4)(a)

49. Section 5(4)(a) states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa)

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

50. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

51. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

52. Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

53. I will proceed on an assumption that the opponent has the requisite goodwill at the relevant date and, therefore, I will comment upon the issue of misrepresentation. I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that it requires “a substantial number of members of the public are deceived” rather than whether the “average consumer are confused”. However, as recognised by Lewison L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that this is the case here and I find that in light of the differences between the applicant’s mark and the opponent’s BIG EASY sign, members of the public are not likely to be misled into purchasing the applicant’s

services in the belief that they are the opponent's services even where the services are identical.

54. The opponent's BIG EASY sign is more similar to the applicant's mark than the other signs relied upon. It follows that the opponent's reliance upon the four other signs will not lead to a different outcome.

55. In summary, the grounds based upon section 5(4)(a) fail in their entirety.

Section 5(3)

56. 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.

57. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

58. 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*).

Reputation

59. For the purposes of my considerations, I will proceed on the assumption that the opponent has demonstrated that it has the requisite reputation at the relevant date in respect of at least *restaurant services*.

The Link

60. 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

I have found that the applicant's mark shares a medium to medium high level of visual and aural similarity and no conceptual similarity to the opponent's BIG EASY mark.

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

I will proceed on the basis that the respective services are identical.

The strength of the earlier mark's reputation

I make no finding in respect of reputation, but I will proceed based upon the assumption that the earlier mark benefits from a reputation in respect of all of its goods and services relied upon.

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

I have found that the opponent's BIG EASY mark is endowed with a medium level of distinctive character but that this has not been enhanced through use.

Whether there is a likelihood of confusion

I have found that there is no likelihood of confusion.

61. I keep in mind that the level of similarity required for the public to make a link between the marks for the purposes of section 5(3) may be less than the level of

similarity required to create a likelihood of confusion²⁹. Nevertheless, the lack of any conceptual similarity combined with the, at best, low level of distinctive character of the applicant's mark is such that one mark is not likely to bring the other mark to mind, let alone create a link in the mind of the average consumer.

62. In light of the above, I find that the requisite link between the applicant's mark and the opponent's BIG EASY mark has not been established. As I have already stated, the opponent's other earlier marks relied upon are less similar to the applicant's mark than its BIG EASY word mark and it follows that my finding also extends to the opposition based upon these earlier marks too.

63. In the absence of any link being established, it is not necessary that I consider the issue of detriment or unfair advantage.

64. In summary, the grounds based upon section 5(3) fail in their entirety.

Section 3(1)

65. The relevant parts of section 3(1) state as follows:

"3(1) The following shall not be registered –

(a) ...,

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) ...:

²⁹ *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P at [72]

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

Section 3(1)(b) and (c) – General:

66. In *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, the CJEU stated that:

“25. Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

67. In its statement of case, the opponent asserts that the word “easy” is non-distinctive and a laudatory descriptor of the accessibility or usability. I keep in mind the decision of the EUIPO Board of Appeal³⁰ in respect of the applicant’s attempt to register its mark as an EU mark. The Board of Appeal upheld the decision of the EUIPO examiner that “easy” was non-distinctive and designates a characteristic of the services applied for in classes 35, 36, 39, 41 and 43. The applicant’s defence is that dictionary words can be registered as a trade mark and the word is capable of acting as an indication of origin. In respect of the EUIPO Board of Appeal decision, it submits that I am not bound by its findings and it should be disregarded. On this last point, I am not bound by the decision but I will keep it in mind when undertaking my own evaluation of the grounds.

³⁰ Case R 1723/2016-2, a copy of which is provided at Exhibit MAW7 to Ms Ward’s witness statement

Section 3(1)(c)

68. I find it convenient to begin by considering the ground based upon section 3(1)(c).

69. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest

underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all

be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

70. As mentioned earlier, the dictionary meaning of the word "easy" is "not requiring much effort; not difficult; simple". It is an adjective and is, therefore, inherently descriptive. Further, it is a word that is ubiquitous in the English language and the UK consumer will readily understand its meaning.

71. With all of the above in mind, upon encountering the word in respect of any of the applicant's services, the average consumer will understand it to be an indication that the services offered do not require much effort to access, are easy to use, purchase, book, order, to pay for or are in some other way do not require much effort. The word is in extremely common usage and when used in respect of the applicant's services

will be widely understood in this way. Consequently, the word “easy” is a description that should remain free to use by other traders.

72. The opponent has relied upon a dictionary reference and made an assertion that the word “easy” is a laudatory descriptor of accessibility or usability. It has not provided any evidence to support this but, as I have already observed, use of the word is ubiquitous in the English language and I find the absence of evidence does not hinder the opponent’s case.

73. Taking all of the above into account, I agree with the opponent and I find that the ground based upon section 3(1)(c) of the Act succeeds in its entirety.

Section 3(1)(b)

74. As stated in *Starbucks (HK) Ltd v British Sky Broadcasting Group plc* (at para 46) descriptive signs are also devoid of any distinctive character. It, therefore, follows that the opponent must also succeed based upon its section 3(1)(b) grounds. I am further fortified in this by the fact that the opponent asserts that the word “easy” is non-distinctive and a laudatory descriptor of the accessibility or usability. Consequently, it makes no independent claim as to why the mark is non-distinctive other than because it is claimed to be a laudatory descriptor. This also points to there being no need to consider the section 3(1)(b) ground separately to the section 3(1)(c) ground (see the comments of Anna Carboni, sitting as the Appointed Person in O-363-09 *COMBI STEAM Trade Mark*).

75. Therefore, whilst recognising that section 3(1)(b) and section 3(1)(c) are independent of each other, the circumstances in this case are such that it is not necessary for me to consider separately the ground based upon section 3(1)(b)

76. I find that because the mark designates characteristics of the applicant’s services, the mark is also devoid of any distinctive character.

77. I conclude that the ground based upon section 3(1)(b) succeeds in its entirety.

Summary

78. The opposition has failed in respect of all of the section 5 grounds but succeeds in respect of the grounds based upon section 3 of the Act. The application is refused in its entirety.

COSTS

79. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I take into account that the opponent filed evidence and the applicant filed written submissions but that neither side requested to be heard. I award the following sum as a contribution towards the costs of the proceedings, in accordance with TPN 2/2016:

Official filing fee	£200
Preparing statement of case and considering the counterstatement	£450
Preparing evidence	£1000
TOTAL	£1650

80. I, therefore, order EasyGroup Limited to pay Alnair Limited the sum of £1650. The above 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 6th day of November 2020

Mark Bryant
For the Registrar
The Comptroller-General