

O/600/17

TRADE MARKS ACT 1994

TRADE MARK APPLICATION No. 3196832

BY THE SHOPFITTING COMPANY LIMITED

TO REGISTER A SERIES OF TWO TRADE MARKS IN CLASSES 20 & 35

AND

OPPOSITION No. 408642

BY EASYGROUP LIMITED

Background and pleadings

1. This is an opposition by easyGroup Limited (“the opponent”) to an application by The Shopfitting Shop Limited (“the applicant”) to register the series of two trade marks shown below.



2. The application to register the contested trade marks was filed on 15th November 2016 (“the relevant date”).

3. The mark is proposed to be registered in relation to the following services:

Class 20: Walk in wardrobes; fashion storage cupboards; shopfittings; cabinets; counters; shelving; display racks; display cases; boltless racking; display cabinets; display rails and display boards; hanging racks; clothes rails; garment rails; clothing storage rails and arms; covers for rails; racks; boards (display); furniture; slatwall; slatwall panels; slatwall accessories and parts and fittings for all the aforesaid goods; metal clothes rails and wardrobe hanging clamps; shelf brackets and shelf rods; twin slot uprights for walls, metal mesh display stands, mesh display panels, joiners (brackets), wall fix brackets and support legs and fittings for these goods; shopping baskets; baskets; containers; signage; coat hangers; clothes and garment hangers and storage containers; dressmaker dummies; mannequins and body forms; millinery stands and racks; frames; panels and boards; boxes; brochure holders and parts and fittings and accessories for all the aforesaid goods.

Class 35: Retail services, mail order retail services, electronic retail services and wholesale retail services connected with the sale of shop fittings, furniture, cabinets, counters, boltless shelving, display units, display towers, display racks, display cases, display cabinets, display rails and display boards, hanging racks, clothes rails, garment rails, clothing storage rails and arms, covers for rails, racks, boards and

furniture, slatwall, slatwall panels, gridwall mesh panels and gridwall fixtures, slatwall accessories; wardrobe hanging tubes and wardrobe tube support clamps, cable systems for hanging purposes, brackets and rods and twin slot uprights for walls, metal mesh stands, mesh panels and joiners, wall fix brackets and support legs and fittings for these goods, shopping trolleys, shopping baskets, bins, baskets, containers, bags and carriers, barriers, ropes and webbing, signage, coat hangers, clothes and garment hangers, storage containers, dressmaker dummies, mannequins and body forms, millinery stands and racks, frames, panels and boards, boxes, poster sleeves, adhesive tape; adhesive, pricing guns, tagging guns, sockets, leaflet and brochure dispensers, mirrors and parts and fittings and accessories for all the aforesaid goods.

4. The grounds of opposition are based on the following earlier trade marks:

Trade Mark No.	Trade Mark	Services relied upon	Filing date
EU 10584001	EASYJET	Services in classes 35 and 39	24/01/2012
EU 14920391	EASYGROUP	Services in classes 35 and 43	17/12/2015
EU 14920383		Services in classes 35 and 43	17/12/2015
EU 15950868	EZEEGYM	Services in class 35	20/10/2016
EU 10735496	EASYHOTEL	Services in class 43	16/03/2012

5. The opponent's case is, in summary, that:

- The earlier marks are registered in respect of services which are identical or similar to the goods/services covered by the contested marks.
- The earlier marks are similar to the later marks.
- There is a likelihood of confusion on the part of the public and registration of the contested marks should therefore be refused under s.5(2)(b) of the Trade Marks Act 1994.

- The EASYJET mark has a reputation for a range of transport related services in class 39.
- Use of the contested marks in relation to the goods/services applied for would create a link with the reputed mark which would, without due cause, take unfair advantage of the reputation of the earlier mark by trading on its reputation for “*straightforward, low-cost and good value services*” and/or be detrimental to the reputation or distinctive character of the earlier mark.
- The earlier marks EASYGROUP, EASYHOTEL and EASY.COM device also have a reputation with the public in relation to various services in class 35 and/or hotel and related services in class 43.
- Use of the contested marks would, without due cause, take unfair advantage of the reputation of the earlier marks and/or be detrimental to the reputation or distinctiveness of the earlier marks.
- In particular, consumers would assume that the cupboards, wardrobes and cabinets marketed under the contested marks may be provided in easyHotels or in hotels offered as accommodation under the EASYGROUP mark.
- Registration of the contested marks should therefore be refused under s.5(3) of the Trade Marks Act 1994.

6. The proprietor filed a counterstatement denying the grounds of opposition.

Representation

7. The opponent is represented by Kilburn & Strode, patent and trade mark attorneys. The applicant is not legally represented. Neither side wished to be heard, but both filed written submissions which I have taken into account.

The evidence

8. Only the opponent filed evidence. This consists of a witness statement dated 28th June 2017 by Ryan Pixton, who is a trade mark attorney at Kilburn & Strode. Mr Pixton says that his evidence comes from his own knowledge, the records of his firm or has been supplied to him by (unnamed) “*others*”. There are 10 exhibits to Mr

Pixton's statement. The first is an advert for the Museum of Brands which invites readers to "*see the easy family of brands in a museum!*"¹ The advert is not dated and is barely readable. It was printed on 28 June 2017 (i.e. after the relevant date). It has no evidential value. Mr Pixton says that a similar advert appeared in the EasyJet traveller magazine in June 2017. He provides a copy.² It suffers from the same defects as the first advert and therefore also has no evidential value.

9. The third exhibit to Mr Pixton's statement consists of a copy of a witness statement by Christopher Griffin dated 4th April 2017. He is the Chief Executive of the Museum of Brands. Mr Griffin was a director of the Marketing Society for 20 years and is currently the Treasurer of the Worshipful Company of Marketors. He is also a Fellow of the Royal Society of Arts and Institute of Packaging. Mr Griffin says that he is an acknowledged expert in the field of branding. It is not clear who has acknowledged him as such.

10. According to Mr Griffin, the fame of the 'easy' brand commenced with the launch of the 'easyJet' airline in 1995. However, the 'easy' brand has always been "*more expansive than 'easyJet' alone and covers a diverse range of products and services.*" Mr Griffin says that the 'easy' brand uses a distinctive style, beginning with the word 'easy' followed by the relevant product or service, with its first letter capitalised. For example, 'easyHotel', 'easyGym', 'easyOffice'. Mr Griffin "*would expect there to be widespread knowledge of the 'easy' brand, because of the variety and number of 'easy' brands licensed or used by the easyGroup.*" In Mr Griffin's opinion, "*the widespread licensing of the mark 'easy' into fields such as travel, retail, foodstuffs, gyms and estate agency has led to a recognition that commercial activities with an 'easy' prefix and likely to emanate from easyGroup.*" He claims that "*...this association becomes a certainty where either the colour orange of the font Cooper Black is used together with an 'easy' prefixed name.*"

11. Mr Griffin opines that the values consumers associate with the 'easy' brand include "*excellent value, innovation and an entrepreneurial approach.*" He considers

¹ See exhibit REP1

² See exhibit REP2

that these values are likely to be tarnished by third parties offering 'easy'-branded services without the authority or control of easyGroup.

12. Mr Pixtin provides a copy of EasyJet plc's report for the year ending 30th September 2015. This shows that the company turned over more than £4.6 billion and the airline carried 68.6m passengers. ³

13. Exhibit REP6 consists of a copy of some pages from the website 'rankingthe brands.com.' In a listed ranking of Britain's 100 most admired brands in 2015, easyJet came fourth. I note that none of the other earlier marks relied on by the opponent featured in this ranking.

14. Mr Pixton also provides:

- Copies of pages from website ir.easyhotel.com downloaded in June 2017 indicating that easyHotel owned 5 hotels and franchised 20 others in 8 countries, four of which appear to have been in London and one in Barcelona.⁴
- Extracts from easyHotel's annual report for 2015 indicating that it operated 21 hotels at that time, including a hotel in Croydon.⁵
- Copies of press articles, including one from the MailOnline in 2013 about the launch in London of an 8th easyGym.⁶
- A copy of an article from theguardian.com website dated 1st February 2016 about the opening of a pilot easyFoodstore in North-West London.⁷
- A copy of an article from theguardian.com website dated 23rd October 2014 about brand extensions in which it is noted that easyGroup had "*successfully launched sub-brands from property to pizza to gyms*" (although no such sub-brands are listed).
- Copies of webpages from the easy.com website downloaded in June 2017. The website appears to be a portal with links to various 'easy' brands.

³ See exhibit REP5

⁴ See exhibit REP7

⁵ See REP8

⁶ See REP9, page 58

⁷ See REP9 page 67

Outcome of the opposition

15. The opposition fails. The contested marks will therefore be registered for all the goods/services covered by the application. My reasons for this decision are set out below.

Reasons

Section 5(2)(b) grounds

16. 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”.

17. None of the earlier marks had been registered for 5 years at the date of publication of the contested marks. Therefore, the earlier marks are not subject to the proof of use requirements set out in s.6A of the Act. Indeed, the applicant did not request any such proof. This means that the opponent can rely on the registration of the earlier marks in relation to all the specified services, irrespective of whether the marks have yet been used in relation to those services.

18. The opponent points out that 4 of the 5 earlier marks are registered for retail services in relation to homeware goods and clothing, which it considers to be identical or highly similar to the services covered by class 35 of the contested marks. Three of the opponent’s earlier marks (EU 10584001, EU 14920391 and EU 14920383) are protected, inter alia, for:

“retail services connected with the sale of pouches and handbags, luggage, suitcases, travelling sets, sports bags, bike bags”

19. The services for which the applicant seeks to register the contested marks include:

“retail services connected with the sale of bags and carriers”

20. In *Gérard Meric v OHIM*,⁸ the General Court stated that:

“29....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 für 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”.

21. The same applies to services. Therefore, the general description of retail services in the application set out in paragraph 19 above must be held to be identical to the services covered by the earlier marks. This is so whether or not the applicant uses or currently intends to use the contested marks in relation to retail services connected with the sale of *pouches and handbags, luggage, suitcases, travelling sets, sports bags or bike bags*.

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

⁸ Case T- 133/05

The principles

(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.

23. The opponent appears to base its opposition under s.5(2)(b) of the existence of a 'family' of 'easy' prefixed marks. The opponent has not therefore sought to argue that any one of its earlier marks is more similar to the contested marks than any of the others. This appears to be correct. Arguably the closest of the earlier marks based on the word element is EU 14920383, the easy.com device mark. This is because the word EASY dominates the second word element '.com' in that mark more so than the word EASY (or in one case EZEE) dominates the suffixes of any of the other earlier marks. And the word EASY is the only element of any of the earlier marks which has any similarity to the contested marks, i.e. to the word EAZi. However, the easy.com device mark includes the presentation of the word elements within an oval border, all set on a contrasting orange rectangular background. In my view, these are not negligible elements of the earlier mark because they will affect the average consumer's perception of the distinctive character of the mark. Therefore, from a visual perspective, the easy.com device mark as a whole is actually the least similar to the first mark in the series of contested marks, which is shown in shades of green.

24. The second mark in the series of two is shown in shades of grey and white. The Court of Appeal has stated on two occasions following the CJEU's judgment in

Specsavers,⁹ that registration of a trade mark in black and white covers use of the mark in colour. This is because colour is an implicit component of a trade mark registered in black and white (as opposed to extraneous matter).¹⁰ Thus a black and white version of the contested mark could, theoretically, be used in any colour, including orange.

25. The applicant states that it actually uses the second mark in the series on warehouse packaging and also when the mark is printed using black and white printers. Thus it appears that the second mark in the series is not intended to protect that mark irrespective of colour. Rather it is a claim to the mark in the colours grey and white, as it appears above. If that is right then, in use, the second mark in the series is no more likely to be linked to the opponent's marks than the first mark in the series. The opponent has not challenged the applicant on this point. In these circumstances, I do not consider it appropriate for me to raise the matter of colour of my own volition. If that is correct, there is no need for me to say any more about it. However, in case I am found to be wrong about that, I will briefly consider what the position would be if I should have considered the second mark in the series as one that could be used in any colour, including orange.

26. The notional appearance of the second mark in the series in shades of orange would plainly increase the overall level of similarity between the marks, particularly the level of visual similarity. Therefore, considering first EU 14920383 (the *easy.com* device mark) for notionally identical retail services in class 35 as providing the opponent with its best case (or at least as good a case as that based on any of the other earlier marks considered alone), I find that:

- The relevant average consumer for retail services connected with bags and carriers is likely to be a member of the general public who will pay an average level of attention when selecting such goods.

⁹ Case C-252/12

¹⁰ See paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47

- The earlier mark is not descriptive of the services and has a normal level of inherent distinctiveness for such goods.
- There is no evidence that the distinctive character of the earlier mark had been enhanced at the relevant date as a result of use of the mark in relation to the services under consideration.
- The services at issue are likely to be selected primarily from shop signs, internet sites, or brochures. Therefore, the visual similarity between the marks is more important than the way they sound. However, oral orders or word of mouth recommendations are also possible, so aural similarity is also relevant.
- The similarity between the marks is as a result of the visual resemblance between, and the identical sound and meaning of, the words EASY- and EAZi. And as these elements appear as the first word in the marks, this coincidence is more noticeable. Further, both marks could include rectangular backgrounds in shades of orange.
- However, there are important differences between the marks. The most important are (1) the completely different suffixes, .COM and LIFE, the latter of which is not descriptive of the services at issue, (2) the different spellings and appearance of the words EASY and EAZi, (3) the presentation of the contested mark on a background divided into two rectangular sections, one darker than the other, on which the words EAZi and LIFE appear in a contrasting colour, (4) the aural difference between EASE-EE-LIFE and EASE-EE-DOT-COM, and (5) the presentation of the words EASY and .com within an oval border.
- Compared as wholes, there is only a low degree of visual similarity between the marks and only a medium degree of (less important) aural similarity.
- If understood as having the same meaning as EASY LIFE (as the opponent implicitly contends), the words in the contested marks form a unit having a meaning that is more than the individual words. Specifically, 'easy life' is a well-known phrase used to describe those enjoying a comfortable lifestyle, often by those who aspire to such a lifestyle themselves.

- If it means EASY, the word EAZi does not therefore play an independently distinctive role in the contested marks.¹¹
- The word(s) EASY/EASY.com convey the general idea of easiness.
- A comfortable lifestyle is both more specific and different to the general idea of easiness. Therefore, there is more that distinguishes the marks from a conceptual perspective than makes them similar.
- The level of overall similarity between the marks is low.

27. In applying the law to my factual findings I take into account the judgment of the CJEU in *The Picasso Estate v OHIM*,¹² where the court held:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

28. I find that such visual and aural similarity as exists between the marks at issue is outweighed by the visual and aural differences and the fact that there is more that distinguishes the marks from a conceptual perspective than makes them similar.

29. Therefore, even when considered in relation to identical services and making some allowance for imperfect recollection, my conclusion is that there is no likelihood of confusion, including the likelihood of association (indirect confusion). At most, the use of the contested marks (even in shades of orange) in relation to identical retail services would do no more than bring earlier mark EU 14920383 to mind.

30. It follows that there is no likelihood of confusion if the contested marks is used in relation to goods/services which are only similar (or are dissimilar) to the services covered by EU 14920383.

¹¹ See *Bimbo SA v OHIM*, Case C-591/12 P, CJEU, at paragraph 25 of the judgment

¹² Case C-361/04 P

31. Colour is not part of the subject matter of any of the opponent's earlier word-only marks. And there is no evidence that the words themselves have been extensively used in a particular colour.¹³ Therefore, the colour of the contested marks is irrelevant as far as these marks are concerned. It could be argued (although has not in fact been argued) that the earlier mark EZEEGYM is the most similar of the earlier word-only marks to the contested marks. This mark does, at least, contain a mis-spelling of the word EASY involving a letter Z, albeit a different mis-spelling to that used in the contested marks: EZEE v EAZi. However, the EZEEGYM trade mark does not cover retail services in relation to bags etc. Therefore, any greater similarity between the prefixes of these marks is offset by the fact that the respective services are, at the most, only similar.

32. The EASYJET mark appears to be the highly distinctive in relation to airline services. As the case law makes clear, this is a factor which normally increases the likelihood of confusion. However, there is no evidence of the use of that mark in relation to retail services. Consequently, the distinctiveness of EASYJET in relation to services in class 35 must depend upon its inherent distinctiveness. The mark is comprised of two non-descriptive (in class 35) dictionary words. Therefore, the mark appears to have just a normal degree of distinctiveness in class 35. Consequently, the case based on EASYJET is again no stronger than for any of the other earlier marks.

33. And as none of the other earlier marks, considered individually, give the opponent a better case than EU 14920383, I find that there is no likelihood of confusion with any of the other earlier marks either.

The s.5(2)(b) case based upon the existence of a 'family' of earlier EASY marks

34. The opponent did not specifically plead its s.5(2)(b) case based on the existence of a 'family' of trade marks. However, it has been clear since it filed its written submissions in June 2017 that this was the opponent's primary case. The applicant had a chance to file evidence or submissions in response, so I do not consider it

¹³ The opponent's evidence was filed by facsimile and is therefore in black and white. This is consistent with my primary conclusion that colour is no part of the opponent's case.

unfair on the applicant to let the opponent run this ground. However, the opponent can only rely on the earlier marks included in the notice of opposition. Therefore, in deciding whether the opponent has established that it is the proprietor of a 'family' of 'easy' marks, I must focus on the marks shown in paragraph 4 above.

35. In *Il Ponte Finanziaria SpA v OHIM*,¹⁴ the CJEU stated that:

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

63. The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a 'family' or 'series' of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64. As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in

¹⁴ Case C-234/06

order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family' or 'series', the earlier trade marks which are part of that 'family' or 'series' must be present on the market.

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

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

36. The opponent has not filed evidence from anyone within its own business. Consequently, there is no specific evidence from a witness setting out a first-hand account of which 'easy' marks have been used in relation to which services and when. Instead the opponent relies on the hearsay statement of its external trade mark attorney, Mr Pixton, who provides information from publicly available sources, such as the internet. I must therefore determine which of the opponent's pleaded marks were "*present on the market*" at the relevant date based mainly on Mr Pixton's information.

37. The earlier marks are EU trade marks, but the likelihood of confusion must be assessed from the perspective of a UK consumer. Therefore, in order for the existence of a 'family' of 'easy' marks to affect the relevant consumer's reaction to the contested marks, that 'family' must have been evident to UK consumers.

38. So far as I can see, there is no evidence of use of EZEEGYM in the UK or anywhere else. In any event, as the opponent's case appears to be based on the existence of a 'family' of 'easy' marks, EZEEGYM does not appear to a member of that family.

39. There is evidence that EASYJET has been used on a substantial scale in relation to airline services in class 39. There is also evidence that EASYHOTEL was in use at the relevant date in relation to hotel services. There is no evidence that the EASY.COM device mark was in use at the relevant date. In any event, it appears to be just a web portal with links to other 'easy' marks and businesses. It is not therefore clear to me what the services are in relation to which this mark is used. There is evidence of use of EASYGROUP, but this appears to have been used to distinguish a company rather than any particular services. Services having been offered to the public under other marks, such as EASYJET and EASYHOTEL.

40. Mr Griffin claims to be familiar with other 'easy' brands, specifically 'easyGym' and 'easyOffice'. Mr Griffin's statement was made in April 2017, some 5 months after the relevant date. Therefore, it is unclear whether the use of these marks started prior to the relevant date. In any event, neither of these marks were included as earlier trade marks in the notice of opposition. And it is not for this tribunal to search the registers to see if these marks are registered in the opponent's name and, if so, for which services.

41. Assuming that the opponent had a family of 'easy' marks at the relevant date, including at least EASYJET, EASYHOTEL and possibly EASYGROUP, I would have to be satisfied that the contested marks would be taken to be a member of this family. Mr Griffin's evidence appears to be intended to draw me to this conclusion on the basis of his opinion as a branding expert that consumers recognise "*that commercial activities with an 'easy' prefix and likely to emanate from easyGroup.*"

42. In *esure Insurance Ltd v Direct Line Insurance Plc*,¹⁵ L. J. Arden stated that:

"62. Firstly, given that the critical issue of confusion of any kind is to be assessed from the viewpoint of the average consumer, it is difficult to see what is gained from the evidence of an expert as to his own opinion where the tribunal is in a position to form its own view. That is not to say that there may not be a role for an expert where the markets in question are ones with which

¹⁵[2008] EWCA Civ 842

judges are unfamiliar: see, for example, Taittinger SA v Allbev Ltd [1993] F.S.R. 641.”

43. Mr Griffin’s evidence appears to be an attempt to substitute his expert opinion as to the likelihood of confusion for evidence from the opponent itself establishing the basic facts from which I could determine myself whether there is a likelihood of confusion. If there is any role for expert evidence in a case such as this which, at least on the opponent’s side, appears to involve marks used in relation to everyday services, it cannot be as a substitute for the opponent clearly setting out which registered marks it relies upon and providing evidence setting out the basic facts about the use of those marks.

44. In any event, if Mr Griffin is correct that the opponent’s family is identifiable by marks beginning with the word ‘easy’ followed by the name of the relevant product or service, with its first letter capitalised, then I am bound to note that the contested marks do not have these characteristics. So even if I accepted his evidence on this point, it would not have assisted the opponent.

45. For the reasons stated above, I find that even if the opponent had established that it had a family of ‘easy’ marks present on the market at the relevant date, the contested marks would not have been taken as a member of that family.

Section 5(3) grounds

46. 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.”

47. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. 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*.

(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

48. The opponent claims that EASYJET has a reputation in relation to the following services in class 39:

“Transport; packaging and storage of goods; travel arrangement; travel information; provision of car parking facilities; transportation of goods, passengers and travellers by air, land, sea and rail; airline and shipping

services; airport check-in services; arranging of transportation of goods, passengers and travellers by land and sea; airline services; baggage handling services; cargo handling and freight service; arranging, operating and providing facilities for cruises, tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft, vehicles and boats; chauffeur services; taxi services; bus services; coach services; rail services; airport transfer services; airport parking services; aircraft parking services; escorting of travellers; travel agency services: tourist office services; advisory and information services relating to the aforesaid services; information services relating to transportation services, travel information and travel booking services provided on-line from a computer database or the Internet.”

49. The evidence shows that EASYJET has a very substantial reputation for airline services. This would extend to services which are part and parcel of airline services, such as *transportation of goods, passengers and travellers by air, baggage handling services* and *airport check-in services*. I see no evidence of any reputation attaching to the mark in relation to the other services.

50. The opponent claims that EASYGROUP has a reputation in relation to the following services in classes 35 and 43.

“Class 35

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

Class 43

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

51. However, the only evidence of any public recognition of EASYGROUP that I can see in the opponent’s evidence is the article from theguardian.com website dated 23rd October 2014 about brand extensions. The name EASYGROUP is used in that article as the name of a brand owner which has licensed [unidentified] sub-brands across different sectors. There is no evidence that EASYGROUP appears in the public-facing material used to market particular services to the public in such a way that it has come to be recognised as the ‘house’ mark of EASYJET, EASYHOTEL and/or other ‘easy’ marks. Consequently, I cannot accept the opponent’s claim that EASYGROUP has a reputation with the public in relation to services in classes 35

and 43. It follows that the opposition under s.5(3) cannot succeed insofar as it is based on the reputation of EASYGROUP as a trade mark.

52. The opponent claims that EASYHOTEL has a reputation in relation to the following services in class 43:

“Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; hotel services; hotel reservation services; hotel services for the provision of facilities for exhibitions and conferences.”

53. Again, the evidence tendered to demonstrate this reputation is rather flimsy. However, there is sufficient evidence to indicate that EASYHOTEL was in use at the relevant date in relation to 20-25 hotels, at least some of which were in the EU and 4-5 of which were in or around London. For present purposes, I am therefore prepared to accept that the mark had a modest reputation in the EU which would have been apparent to a more-than-negligible proportion of UK consumers of hotel services.

[Link](#)

54. In *Roger Maier and Another v ASOS*,¹⁶ Kitchen L.J. (with whom Underhill L.J. agreed) pointed out that the alleged detriment to the distinctive character of the earlier mark must be connected to the mark’s reputation. The judge stated that:

“122. The requirement that the registered trade mark has a reputation therefore underpins and is intimately tied to the possibility that the mark may be injured. Put another way, if and in so far as the registered mark is not known to the public then, in a case in which there is no likelihood of confusion, it is very hard to see how it can be injured in a relevant way.”

¹⁶ [2015] EWCA Civ 220

This means that the assessment required under s.5(3) must be based on a comparison between the earlier mark(s) and the registered goods/services for which it (they) has (have) a reputation, and the contested marks and the goods/services covered by the application. All relevant factors must be taken into account in determining whether the public will make a link between the marks. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

55. For similar reasons to those given at paragraph 26 above, I find that level of overall similarity between the contested marks and EASYJET and EASYHOTEL is low.

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

56. There is no apparent similarity between the goods and services covered by the contested marks and airline or hotel services. Some of the applicant's services, e.g. *electronic retail services and wholesale retail services connected with the sale of shop fittings*, are clearly business-to-business services whereas the services for which EASYJET and EASYHOTEL have reputations are business-to-consumer services. Having said that some of the applicant's goods/services, e.g. *fashion storage cupboards*, could also be marketed to the general public. I have therefore taken into account that the relevant public for the parties' goods/services could partially overlap.

The strength of the earlier mark's reputation

57. EASYJET has a substantial reputation. EASYHOTEL has a small reputation.

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

58. EASYJET is highly distinctive through use. EASYHOTEL is inherently distinctive to an average degree for hotel type services. There is insufficient evidence to find that the level of distinctiveness of this mark was materially higher in the UK at the relevant date as a result of extensive use.

59. Taking all these factors into account, I conclude that average consumers will not make any link between the contested marks when used in relation to the goods/services in the application, and EASYJET/EASYHOTEL and the services for which they have reputations. Alternatively, any such link will be so weak and fleeting that it will give rise to any unfair advantage or detriment.

60. This is why the opposition under s.5(3) also fails.

Costs

61. The applicant has been successful and would normally be entitled to an award of costs. However, the applicant does not appear to have incurred costs in the form of professional fees. Further, the applicant did not return the pro forma sent to it on 14th August which would have provided the registrar with a breakdown of the hours the applicant spent dealing with the opposition. The applicant was told that no award would be made, except for official fees, in the absence of such information. The applicant has not incurred any official fees. I therefore take the applicant's failure to provide the information requested as meaning that it does not wish to pursue an award of costs. In these circumstances, I decline to award costs.

Dated this 28th day of November 2017

**Allan James
For the Registrar**