

O-082-03

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO 705343
AND THE REQUEST BY FERAG VERPAKKINGSTECHNIEK B.V.
TO PROTECT A TRADE MARK IN CLASSES 6, 7, 9 & 16**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 70446
BY EASYGROUP IP LICENSING LIMITED**

**IN THE MATTER OF International Registration No 705343
and the request by Ferag Verpakkingstechniek B.V
to protect a trade mark in Classes 6, 7, 9 & 16**

and

**IN THE MATTER OF opposition thereto under No 70446
by EasyGroup IP Licensing Limited**

BACKGROUND

1. On 23rd October 1998, Ferag Verpakkingstechniek B.V. sought to extend protection of International Registration No. 705343 to the United Kingdom. The International Registration is in respect of the following mark:



2. Protection is sought in respect of the following goods:

Class 6 Metallic holders or similar products for warehousing and transportation of printed matter, particularly metallic holders for storing piles of printed matter packets, and for expediting their transportation.

Class 7 Printing machines; machines for processing printed products for dispatch; components for such machines, namely transfer systems, including conveyor belts and tongs, band conveyors, conveyors, cam chain conveyors; palletization devices (machines); apparatus for printed document sealing, including drums; machines for gathering and stapling printed matter; machines for treating covers; machines for packing printed matter; machines for sorting printed matter; printing machines for making inscriptions on covers; machines for setting printed matter in rack drums; winding stations, stacking stations, star feeders, hubs for magnetic tapes and cassettes particularly tape reel supports (all the above goods as part of transport or packing installations); control devices for machines processing printed matter; engines and motors; transmissions; transmission parts; all of the above products included in this class; all for use in the production of newspapers and magazines.

Class 9 Electronic apparatus for controlling transfer systems and processing device systems for printed matter which make ready-to-ship units; electronic apparatus for measuring and controlling printed matter quantity and quality; rate generators; electronic reading devices; auxiliary electronic apparatus for sorting printed matter; mechanical, electronic or optical apparatus for training in machine operation; all of the above products included in this class all for use in production in newspaper and magazines.

Class 16 Packed and sealed newspapers and magazines; paper, cardboard and plastic materials for packaging newspapers and magazines; (not included in other classes); addressing machines.

3. On 9 November 2000, EasyJet Airline Company Limited filed a notice of opposition to the granting of protection within the United Kingdom. They detail various registrations and applications that they or related company's own, many of which post-date the designation. I have detailed below only those with an earlier date.

EASYJET	<p>United Kingdom registration no 2016785 in respect of:</p> <p>Class 16 - Printed matter and publications; books, manuals, pamphlets, newsletters, albums, newspapers, magazines and periodicals; tickets, vouchers, coupons and travel documents; identity cards; labels and tags; posters, postcards, calendars, diaries, photographs, gift cards and greetings cards; teaching and instructional materials.</p> <p>Class 39 - Transportation of goods, passengers and travellers by air; arranging of transportation of goods, passengers and travellers by land and sea; airline and shipping services; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; ambulance services; rental and hire of vehicles, boats and aircraft; travel agency and tourist office services; consultancy and advice relating to all the aforesaid services.</p> <p>Class 42 - Temporary accommodation; catering, hotel, restaurant, cafe and bar services; reservation services for hotel accommodation; provision of exhibition facilities; meteorological information services; hairdressing, grooming and beauty salon services.</p>
EASYTRAIN	<p>United Kingdom registration no 2112957 in respect of:</p> <p>Class 39 - Transportation of goods, passengers and travellers by land; arranging of transportation of goods, passengers and travellers by land; arranging, operating and providing facilities for tours, excursions and vacations; travel agency and tourist office services; consultancy and advice relating to all the aforesaid services.</p>

<p>EASYBUS</p>	<p>United Kingdom registration no 2112956 in respect of:</p> <p>Class 39 - Transportation of goods, passengers and travellers by land; arranging of transportation of goods, passengers and travellers by land; coach services: arranging, operating and providing facilities for tours, excursions and vacations; travel agency and tourist office services; consultancy and advice relating to all the aforesaid services.</p>
<p>easyTrak/ EASYTRAK (series of two)</p>	<p>United Kingdom registration no 2168662 in respect of:</p> <p>Class 16 - Printed matter and publications; books, manuals, pamphlets, newsletters, albums, newspapers, magazines and periodicals; tickets, vouchers, coupons and travel documents; identity cards; labels and tags; posters, postcards, calendars, diaries, photographs, gift cards and greetings cards; teaching and instructional materials; all relating to travel.</p> <p>Class 39 - Transportation of goods, passengers and travellers by air; arranging of transportation of goods, passengers and travellers by land and sea; airline and shipping services; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; ambulance services; rental and hire of vehicles, boats and aircraft; travel agency and tourist office services; consultancy and advice relating to all the aforesaid services.</p> <p>Class 42 - Temporary accommodation; catering, hotel, restaurant, cafe and bar services; reservation services for hotel accommodation; provision of exhibition facilities; meteorological information services; hairdressing, grooming and beauty salon services.</p>
<p>easyWeb/ EASYWEB (series of two)</p>	<p>United Kingdom registration no 2168668 in respect of:</p> <p>Class 16 - Printed matter and publications; books, manuals, pamphlets, newsletters, albums, newspapers, magazines and periodicals; tickets, vouchers, coupons and travel documents; identity cards; labels and tags; posters, postcards, calendars, diaries, photographs, gift cards and greetings cards; teaching and instructional materials; all relating to travel.</p> <p>Class 39 - Transportation of goods, passengers and travellers by air; arranging of transportation of goods, passengers and travellers by land and sea; airline and shipping services; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; ambulance services; rental and hire of vehicles, boats and aircraft; travel agency and tourist office services; consultancy and advice relating to all the aforesaid services.</p> <p>Class 42 - Temporary accommodation; catering, hotel, restaurant, cafe and bar services; reservation services for hotel accommodation; provision of exhibition facilities; meteorological information services; hairdressing, grooming and beauty salon services.</p>

**easyExtras/
EASYEXTRAS**
(series of two)

United Kingdom registration no 2168672 in respect of:

Class 16 - Printed matter and publications; books, manuals, pamphlets, newsletters, albums, newspapers, magazines and periodicals; stationery; tickets, vouchers, coupons and travel documents; identity cards; labels and tags; posters, postcards, calendars, diaries, photographs, gift cards and greetings cards; teaching and instructional materials; travel documents folders; travel guide books; travellers cheques.

Class 18 - Travel luggage, travel bags; travel garment covers; travellers bags made from leather or imitation leather, travelling sacks and handbags.

Class 36 - Insurance services.

Class 39 - Transportation of goods, passengers and travellers by air; arranging of transportation of goods, passengers and travellers by land and sea; bus transport services, car transport services, coach services; airline and shipping services; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; ambulance services; rental and hire of vehicles, boats and aircraft; travel agency and tourist office services; consultancy and advice relating to all the aforesaid services.

Class 42 - Temporary accommodation; catering, hotel, restaurant, café and bar services; reservation services for hotel accommodation; provision of exhibition facilities; meteorological information services; hairdressing, grooming and beauty salon services.

easyExtras

Community trade mark registration no 848424 in respect of:

Class 16 - Printed matter and publications; books, manuals, pamphlets, newsletters, albums, newspapers, magazines and periodicals; stationery; tickets, vouchers, coupons and travel documents; identity cards; labels and tags; posters, postcards, calendars, diaries, photographs, gift cards and greetings cards; teaching and instructional materials; travel documents folders; travel guide books; travellers cheques.

Class 18 - Travel luggage, travel bags; travel garment covers; travellers bags made from leather or imitation leather, travelling sacks and handbags.

Class 36 - Insurance services.

Class 39 - Transportation of goods, passengers and travellers by air; arranging of transportation of goods, passengers and travellers by land and sea; bus transport services; car transport services; coach services; airline and shipping services; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; ambulance services; rental and hire of vehicles, boats and aircraft; travel agency and tourist office services; consultancy and advice relating to all the aforesaid services.

Class 40 - Temporary accommodation; catering, hotel, restaurant, café and bar services; reservation services for hotel accommodation; provision of exhibition facilities; meteorological information services; hairdressing, grooming and beauty salon services.

EASYCAFÉ	<p>Community trade mark registration no 931790 in respect of:</p> <p>Class 29 - Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies; jams, fruit sauces; eggs, milk and milk products; edible oils and fats; prepared meals.</p> <p>Class 30 - Coffee; tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals; bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; prepared meals.</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.</p> <p>Class 33 - Alcoholic beverages (except beer).</p> <p>Class 35 - Business information services.</p> <p>Class 38 - Telecommunication services.</p> <p>Class 42 - Restaurant and bar services; catering services; design of computer software; provision of access to computers and the internet; internet services; provision of on-line services.</p>
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4. The grounds of opposition are, in summary, as follows:

- Under Section 5(2)(b)** The trade mark applied for is similar to earlier trade marks, and the goods and services for which the opposed trade mark is applied for are similar to the goods and services for which the earlier trade marks are protected, such that there exists a likelihood of confusion on the part of the public.
- Under Section 5(3)** The opponent's marks have acquired a reputation in the United Kingdom and European Community and use of the mark applied for without due cause would take unfair advantage of or be detrimental to, the distinctive character or the repute of the opponent's earlier trade marks.
- Under Section 5(4)(a)** Use of the mark applied for would amount to a misrepresentation, would damage the opponent and would be liable to be prevented by the law of passing off.
- Under Section 3(6)** The applicants would have been aware of the opponent's EASY prefixed marks and the opponent's reputation. Accordingly the filing of the application constitutes bad faith.

5. The applicants filed a counterstatement in which they deny (or put to proof) the grounds on which the opposition is based. Both sides request that costs be awarded to them.

6. During the course of proceedings all the earlier rights relied upon by the opponent were assigned to easyGroup IP Licensing Limited. A request was made by the assignee for them to be treated as the opponents in this matter; the request was granted.

7. Both sides filed evidence in these proceedings. Neither party requested an oral hearing in this matter. The applicant's representatives, Keith W Nash & Co, filed written submissions in lieu of a hearing.

Preliminary point

8. The opponent's representative requested that the applicant's written submissions (in so far as they relate to the opponent's evidence in reply) be deemed inadmissible. They say that the applicants have no right to make submissions in response to the opponent's evidence in reply. For their part the applicants say they are merely written submissions and should be given full consideration by the hearing officer determining the case.

9. In my view the applicant's submissions are no more than a critique of the opponent's evidence in reply and do not contain any additional evidence. It is usual for parties when making submissions, be they written or oral, to highlight the strengths in their own case and the weaknesses in the other sides. The applicants have done no more than this, and I see no reason to discount their submissions.

Opponent's evidence

10. Before giving a summary of the opponent's evidence, it is appropriate to stress that the relevant date in these proceedings is 23rd October 1998, the date on which the owner of the international registration sought to extend the protection to the United Kingdom. This is relevant because much of the opponent's evidence post dates this date, and whilst I have read and taken into account all of the evidence filed, I have summarised in detail only that which has relevance at, or prior to the 23rd October 1998.

11. The opponent's evidence consists of a witness statement dated 18th May 2001, by Mr Mike Cooper, Commercial Director of EasyJet Airline Company Limited. Mr Cooper describes the opponents as an operator of local scheduled airline carriers trading under, and by reference to the name EASYJET. He states that the opponents have continuously traded under this name since 1995. He then describes the emphasis that the opponents place upon e-commerce e.g. booking flights via the internet.

12. Mr Cooper refers to what he calls the "easy brand" that has developed from the success and reputation of EASYJET, and extended to other fields. He refers to Aeasy everything@which denotes a chain of Internet cafes launched in June 1999, after the relevant date, He goes on to refer to AeasyRentacar@, a car rental service that Mr Cooper says was first announced in August 1998 (before the relevant date), and extensively publicised from May 1999, with the business being launched in February 2000. Mr Cooper states that the car rental service is distinctive

because it is the world's first internet only car rental company. He describes the opponent's business ethos of simplicity, low cost and accessibility which has resulted in the emergence of a well known brand identity. He refers to the important and distinctive ways in which the opponent promotes its services. These can be categorised as follows:

- ! Use of the Aeasy@mark in conjunction with a more descriptive word to form one new word.
- ! Use of the Aeasy@mark in lower case lettering, but the second part of the trading name with an initial capital letter e.g. AeasyJet@.
- ! Reference is made to other features (e.g. the colour orange, the Afat@font of the Aeasy@mark), but Mr Cooper states that the opponents believe that the most distinctive and repeatedly used feature of the brand identity is the Aeasy@mark.

13. Mr Cooper says that the development of the Aeasy@name as a distinctive and valuable trade mark has been a policy since the launch of EASYJET. Care is taken to ensure that all Aeasy@ businesses work to the same ethos, and promote themselves in accordance with the brand identity.

14. The turnover and extent of use of the Aeasy@marks is then detailed by Mr Cooper. Numerous figures and breakdowns are provided. Those that have some bearing on this matter (taking into account the relevant date) are:

- ! Passenger figures have risen from 1.7 million in 1998 to 5.6 million in the financial year ending 30th September 2000, although given the relevant date I only take cognisance of the figures relating to 1998.
- ! Approx. turnover figures (although not specifically stated as being for the UK) for services sold under and by reference to the Aeasy@mark are in excess of , 77 million in 97/98. Given that the only mark used in trade by the opponents during this time period appears to be the EASYJET mark, I take this to cover use in respect of that mark alone.
- ! Advertising spend in relation to EASYJET throughout the Community - approx , 40 million (, 30 million of this in the UK). This figure is not allocated to any specific date range.

15. Mr Cooper refers to attachments 2 & 3, which consist of press cuttings bearing or relating to the Aeasy@marks either in the UK or the Community. He also says that advertising has taken place via the publication of leaflets, brochures etc and other promotional campaigns on e.g. buses, taxis, posters and sandwich bags. None of these documents are dated prior to the relevant date.

16. Mr Cooper then states that the Aeasy@prefix is recognised by the public as denoting the opponent's business (and trade mark). He says that this is illustrated by press cuttings again shown in attachments 2 & 3, which contain references to e.g. AeasyGroup umbrella@, Aeasy does it@, Aeasy revolution@, Aeasy float@ and Aeasy rider@ etc, although again, none are dated before the relevant date.

17. Mr Cooper concludes his statement by detailing various awards won by the company; most of which were won in 2000, but one "Direct Marketer of the Year" was won in 1998. He says that the evidence he has given attests to the enormous goodwill attached to the Easy@group and that the Easy@mark has become wholly distinctive of the opponents, and that in view of this goodwill and reputation, use of EASY by the applicant would cause confusion.

Applicant=s evidence

18. This consists of an affidavit by Markus Felix dated 23 January 2002. Mr Felix is the Director of the central patent and license department of WRH Walter Reist Holding AG, of which the applicant company is a subsidiary. The central patent and license department is responsible for all Intellectual Property matters of the WRH group.

19. Mr Felix describes the applicant=s business as the supply of large scale machinery to post-press operations such as newspaper mailrooms and commercial printer finishers. Exhibit MF1 consists of customer periodicals entitled "FERAG MAGAZINE-I-N-F-O" which are supplied to companies throughout the group and to their customers. The periodicals exhibited include editions dating from 1996 to 1998 and show the large scale machinery referred to above. Another edition of the magazine, dated 1998 is shown at Exhibit MF2.

20. Mr Felix says that the applicant=s customers include publishers, newspaper producers and commercial printing firms. He refers to Exhibit MF3, which consists of a leaflet describing a large item of machinery denoted by the EASYSTRAP name. Mr Felix lists 25 firms from across the United Kingdom who have been supplied with the EASYSTRAP machine, all of which appear to be involved in newspaper production or the printing industry. Mr Felix says that the purchasers of the applicant=s products are an extremely specialised and knowledgeable group of people, and that the products are not conventional consumer goods. He also states that he is unaware of any confusion being reported with the Easyjet Airline Company.

21. Mr Felix says that the applicant's products are promoted through trade fairs and by sending publicity material direct to potential purchasers, and that product awareness is further raised by mentions in editorials and technical journals such as "Printing World". Exhibit MF4 consists of an extract from the "Printing World" publication (dated August 3rd & October 5th 1998) which refers to the EASYSTRAP machine.

22. Mr Felix says that the EASY device mark was first used in 1995 at a trade show in Amsterdam where the EASYSTRAP machine was presented. Brochures relating to this product (Exhibit MF3) show the machine to carry the EASY device. Exhibit MF5 is an advertisement for the EASYSTRAP machine placed in an English periodical, although this is after the relevant date. He says that the first UK sale of the EASYSTRAP machine was agreed in 1995 and supplied in 1996. He then refers to the applicant's attendance at a number of trade shows throughout Europe (including the UK). Reference is made to the turnover of the EASYSTRAP machine. The "EASYSTRAP 6000" turned-over , 160K in 1996, , 80K in 1997, 20K for 1998 & 20K for 1999. The "EASYSTRAP 35" turned-over , 180K in 1997, , 500K in 1998, , 1120K in 1999 & , 2200 in 2000.

Opponent=s evidence in reply

23. This consists of a witness statement by Mr Nick Manoudakis, Director of easyGroup IP Licensing Limited. Mr Manoudakis says that the applicant=s use of the EASY device is limited to a reference in the EASYSTRAP brochure (Exhibit MF3), and therefore the arguments and material incorporated in the applicant=s evidence relate to the EASYSTRAP mark.

24. Mr Manoudakis says that Mr Felix=s comments in relation to the type of purchaser of the applicant=s products and his lack of awareness of instances of confusion should be disregarded because Mr Felix is not part of the applicant=s marketing department and therefore may not be aware of any instances of confusion.

25. Mr Manoudakis says that the mark applied for extends to Class 16 and incorporates goods in relation to which the opponent has earlier rights.

26. Any further information contained in Mr Manoudakis= witness statement appears to be opinions or submissions on the possibility of confusion (and the other grounds pleaded). As this is not evidence of fact, I will draw upon this, as appropriate, as part of this decision.

DECISION

27. The first ground of opposition is under Section 5(2)(b) of the Act. This reads:

“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.”

28. An earlier trade mark is defined in Section 6 as:

“6.-(1) In this Act an "earlier trade mark" means -

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

(b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or

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

29. In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723, and that of Jacob J. in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 7, paragraph 17;
- (f) in assessing the similarity (or otherwise) of the respective goods or services, regard should be taken of:
 - (i) The nature of the goods or services;
 - (ii) The end-users of the goods or services;

- (iii) The way in which the goods or services are used;
- (iv) Whether the respective goods or services are competitive or complementary. This may take into account how those in trade classify goods and the trade channels through which the goods or services reach the market;
- (v) 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; *British Sugar Plc v James Robertson & Sons Ltd*, page 296;
- (g) In determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account. *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 133 paragraph 24;
- (h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 8, paragraph 24;
- (i) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 224;
- (j) further, 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; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;
- (k) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 9 paragraph 29.

30. The opponents are the proprietors of a large number of marks that incorporate the element EASY. However, as I have previously mentioned, only seven of these pre-date the relevant date in these proceedings and therefore qualify as “earlier marks”. Two of these are identical in the marks and specifications; the only difference being that one is a UK filing, the other a CTM.

31. These earlier marks consist of the word EASY conjoined with another ordinary word; JET, TRAIN, BUS, TRAK, WEB, EXTRAS and CAFÉ, each having a varying degree of reference to the nature or a characteristic of at least some of the goods and services to be provided under the mark.

32. The word EASY is an ordinary dictionary word that, amongst others, has the meaning of “simple, not difficult or requiring much effort”. It has relevance when used in relation to a range of goods or services that can be described as, for example, easy to use or obtain. But whether it has any real significance, and if so, to what degree, will very much depend upon the nature of the goods or services. In relation to the opponent’s primary business, airline services, it would, in my view, be no more than a passing allusion to its “no frills” concept. It should also not be forgotten that a combination of two elements, even if both individually descriptive, can combine to create a distinctive whole. In this case there is no suggestion that any of the opponent’s earlier marks is devoid of distinctive character.

33. Turning to the question of whether the opponent’s reputation in their earlier marks warrants a wider penumbra of protection. As I have already indicated, much of the evidence submitted by the opponents post-dates the relevant date in these proceedings. What evidence there is indicates that the only trade mark that the opponents appear to have used in trade prior to the relevant date is that of EASYJET in relation to their airline. The use of “easyRentacar” is in my view of little significance. The opponents say that in 1998 the airline carried some 1.7 million passengers and achieved a turnover for services sold under and by reference to the EASYJET in excess of , 77 million, although this is not specifically detailed as being in relation to the UK. Although these figures have not been put into context of the overall size of the UK market, taking into account that the airline industry in this country contains a very limited number of players, and that the launch of a new airline will be headline news, I consider that it is reasonable to infer that at the relevant date, the trade mark used in respect of the airline, EASYJET, is likely to have made an impact into the airline market and become widely known in this regard by consumers.

34. Whilst the use of “EASY” marks in other areas of trade gave birth to references such as “the EASY” group, this primarily came after the relevant date, and accordingly, too late for the opponents to rely upon it, either in arguing that they have used a family of “EASY” marks, or that they had established the concept of “EASY” brand extension in the minds of the consumer. I acknowledge that the launch of EASYRENTACAR was announced in August 1998, and only two months prior to the relevant date. There is nothing that establishes that the mark had been extensively publicised or used in the intervening period, and therefore, no indication of what impact that announcement had on the minds of the public in relation to the “EASY” brand. I do not consider that this fact adds much in the circumstances.

35. The mark applied for has a stylized initial letter “E” but is still, nonetheless, the word EASY. All of the earlier marks relied upon by the opponents contain the word EASY with another word as a suffix. Insofar as the respective marks share this element there must be some degree of visual and aural similarity. But as stated above, the average consumer normally perceives a mark as a whole and does not analyse its various details. I see no reason why they should depart from this approach here, and pick out the word EASY from the opponent’s marks. Taking into account the opponent’s marks in their totality, and the stylization in the applicant’s mark, I would say that when compared as a whole the marks are more dissimilar than similar.

36. In most cases the suffix is a word capable of being seen as having some reference to a characteristic of the goods or services covered, and in that respect I would say that the EASY element could be regarded as the more distinctive, and arguably, the dominant, if only by virtue of its positioning at the beginning of each mark. The opponent's infer that the public has come to associate them with the colour orange and the Afat@ font of the Aeasy@ mark. Whilst the applicants may, in normal and fair use, represent their mark in the colour orange, or indeed use their mark in a font similar to that of the opponents, there is no evidence to support the opponent's claim to a reputation in these features and mere assertion carries no weight.

37. The respective marks are based upon the word EASY so again there must be some conceptual similarity. However, the opponent's marks also contain other words which lessens this similarity, as does the stylisation in the applicant's mark. I consider there to be little conceptual similarity.

38. Save for the goods in Class 16 of the application, all of the goods in the specifications relate to and/or are limited to specialised machinery and products used in the production process of newspapers and magazines. It appears self-evident to me that there is nothing within any of the opponent's specifications which conflict with these goods.

39. The opponents have not been specific about what goods they consider to be either the same or similar, and therefore I have to infer any similarity in respect of the goods in class 16 of the application is in respect of "packed and sealed newspapers and magazines", all of which would be covered in all but two of the opponent's earlier marks, either in the specific terms, or in the general term "printed matter and publications". Neither the applicant's nor the opponent's Class 16 specification is limited in any way and I therefore consider that notionally, these goods share the same market, from manufacture to consumer. But as I have already indicated, the opponent's use (of any of its marks) does not extend to these goods.

40. Taking all of the above into account and adopting the Aglobal@ approach advocated, I see no real likelihood of consumers being led into wrongly believing that the goods provided by the applicants are those of the opponents or provided by some undertaking linked to them, and the ground under Section 5(2)(b) is dismissed accordingly.

41. Turning next to the ground under Section 5(3). That section reads as follows:

"5.-(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods and services which are not similar to those for which the earlier trade mark is protected

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 Community trade mark, in the European Community) 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."

42. Other than a simple recital of the relevant section of the Act, the opponents do not provide any explanation as to the nature of their claim. In *Pfizer Ltd v Euro Food-Link (UK) Ltd* ((ChD) [1999] 22(4) IPD 22039) Mr Simon Thorley QC sitting as a Deputy High Court Judge said:

"What is necessary is that the trade mark proprietor should prove the required reputation and should then satisfy the Court that the defendants' use of the sign is:

- (a) without due cause; and*
- (b) takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark."*

43. The first requirement to be met under Section 5(3) is for the earlier trade mark to be identical or similar to the trade mark applied for. The marks are clearly not identical, and as I have already stated in my determination of the grounds under Section 5(2)(b), I find them to be more dissimilar than similar. It also requires that the goods or services be dissimilar. With the exception of a small number of goods in Class 16, this is the position.

44. The next requirement is that the opponent's mark possesses a reputation in the UK to the extent set out by the ECJ in *General Motors Corporation v. Yplon SA* [1999] E.T.M.R. 122 (Chevy). The court concluded that the requirement implies a certain degree of knowledge amongst the public, with the degree of knowledge required being considered to have been reached when the earlier mark is known by a significant part of the public concerned by the products of services covered by that mark. In deciding whether this requirement is fulfilled all relevant factors should be considered, including, the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking promoting it; the stronger the reputation and distinctive character, the easier it will be to accept that detriment has been caused to it.

45. As I have already stated, the evidence shows that prior to the relevant date, the opponents had only used the trade mark EASYJET, and in relation to their airline service. Although the figures relating to their trade have not been put into context of the overall size of the UK market, if account is taken of the fact that the industry contains a small number of airlines, and that the launch of a new carrier will almost certainly be heavily reported in the media, I consider it is reasonable to infer that at the relevant date, the opponent's EASYJET trade mark is likely to have become known to a significant part of the public as a provider of airline services.

46. Even accepting that the opponent's mark EASYJET had achieved public awareness, this is some way from saying that the public would associate them with use of the word EASY in relation to goods quite distant from the area in which they have become known. There is no evidence that I have seen from which it would be reasonable to infer any such thing. I fail to see what unfair advantage would be derived by the applicant's use of the mark applied for in respect of the goods that they have specified, or conversely, what damage or detriment could be suffered by the opponents., and the ground of opposition under Section 5(3) is also dismissed.

47. The next ground is that raised under Section 5(4)(a). The section reads as follows:

“5.-(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.”

48. The requirements for a success under this ground are set out in the decision of Mr Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. In respect of opposition proceedings, the three main elements required can be summarised as follows:

- (1) that the opponent’s goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the applicants are goods of the opponent; and
- (3) that the opponent has suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicant’s misrepresentation.

49. To the above I add the comments of Pumfrey J in the *South Cone Incorporated v Jack Bessant, Dominic Greensmith, and others* (the *Reef* case), in which he said:

*There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirement of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.*

Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.®

50. I have accepted that at the relevant date the opponents are likely to have established a reputation, and I would say also goodwill in the mark EASYJET, in respect of airline services. The difficulty is that I consider the respective marks to be dissimilar and do not see how there can be misrepresentation. The goods and services provided under the marks are, in all but a small number in Class 16, quite distinct, in their nature, purpose and markets. There is no evidence that

shows airlines have engaged in a trade in any of the goods covered by the applicant's specifications. I do not see how their goodwill or reputation in EASYJET could suffer any damage, and the ground under Section 5(4)(a) is dismissed accordingly.

51. The final ground is under Section 3(6). That section reads as follows:

“3.-(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

52. The opponents assert that the applicants knew of their “EASY” prefixed marks, and the reputation that they had acquired, but nonetheless made the application, which must be considered to constitute an act of bad faith. Whilst it is possible that the applicants were aware of the opponent's use of EASYJET, there is no evidence to support this assertion. But even if there were, would that matter? Why should the use of EASYJET as the name of an airline have given the applicants cause to consider whether they should use EASY (an ordinary English word) in relation to their printing related products, or that in making their application for registration they fell below the standards of acceptable behavior observed by reasonable and experienced men in the particular area being examined? I see absolutely no reason why, and this final ground is also dismissed.

53. The opposition has failed on all grounds. The applicant is consequently entitled to an award of costs. I order the opponent to pay the sum of £1,100 as a contribution towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 2ND day of April 2003

**Mike Foley
For the Registrar
the Comptroller-General**