

O-268-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2268792
IN THE NAME OF BRISTOL & WEST PLC
TO REGISTER THE TRADE MARK :**

EASYFLEX

IN CLASS 36

**AND THE OPPOSITION THERETO UNDER NO 90435
BY EASYGROUP IP LICENSING LIMITED**

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in the name of Bristol & West plc
to register the trade mark:
EASYFLEX
in Class 36
and the opposition thereto under no 90435
by easyGroup IP Licensing Limited**

BACKGROUND

1) On 1 May 2001 Bristol & West plc (referred to afterwards as B&W) filed an application to register the trade mark **EASYFLEX**. The application was published for opposition purposes in the "Trade Marks Journal" on 20 June 2001 for the following services in class 36 of the International Classification of Goods and Services:

financial services; insurance and life assurance services; real estate services; valuations and financial appraisals of property; property acquisition management services; rental, letting and leasing of properties; leasing services; banking services; administration of financial affairs; trustee services; administration of mutual funds; cash management services; cash dispensing services; loan services; mortgage services; mortgage broking services; provision of security for loans; credit services; lease purchase financing, hire purchase financing; credit card, charge card, cash card, cheque guarantee card, payment card and debit card services; card and cash replacement services; provision of finance, money exchange and money transmission services; currency services, bureau de change services; foreign exchange services; merchant banking and investment banking services; investment and savings services; investment management services; brokerage of bonds, securities, commodities and futures; securities valuation services; share underwriting services; securities lending services; dividend collection services; payment collection services; underwriting services; unit trust services; investment trust services; security services; tax services; financial planning and investment advisory services; financial research services; pension fund services; provision of financial information; safe keeping, administration and valuation of investments; collateral agency services; securities custody services; safe custody services; consultancy, information and advisory services relating to all the foregoing.

2) On 20 September 2001 easyGroup IP Licensing Limited (afterwards referred to as easyGroup) filed a notice of opposition to the application. At the hearing, counsel for easyGroup, Mr Roberts, honed down the basis of the opposition.

3) easyGroup relies on the following trade mark applications and registrations:

- Community trade mark registration no 1232909 of the trade mark **EASYJET**. The application for registration was filed on 1 July 1999. The trade mark is registered, inter alia, for the following goods and services:

tickets, vouchers, coupons and travel documents

transportation and storage; transportation of goods, passengers and travellers by land, sea and air; airline and shipping services; cargo 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 tourism services.

The above goods and services are in classes 16 and 39 respectively of the International Classification of Goods and Services.

- Community trade mark application no 1699792 for the trade mark **EASY**. The application for registration was filed on 9 June 2000 and published for opposition purposes on 18 August 2003. Its specification includes, inter alia, *financial and insurance services* in class 36 of the International Classification of Goods and Services.
- United Kingdom trade mark registration no 2168672 of a series of four trade marks:

easy extras
easyExtras
EASY EXTRAS
EASYEXTRAS

The application for registration was filed on 5 June 1998. It is registered for, inter alia, *printed matter and travellers cheques and insurance services*, which goods and services are in classes 16 and 36 respectively of the International Classification of Goods and Services.

- United Kingdom trade mark registration no 2245768 of a series of two trade marks:

EASYVALUE
easyValue

The application for registration was filed on 18 September 2000. It is registered for, inter alia, *financial and insurance services* in class 36 of the International Classification of Goods and Services.

- Community trade mark application no 2153575 for the trade mark:



The application for registration was filed on 22 March 2001. Its specification includes, inter alia:

financial and insurance services; monetary affairs, banking, banking services, real estate affairs; advice and consultancy relating to the aforesaid services.

The above services are in class 36 of the International Classification of Goods and Services. easyGroup claims the colours Orange (Pantone No. 021C) and white.

easyGroup argues that all the above trade marks are similar to the trade marks of the registration and encompass similar or identical goods. Consequently, registration of the application would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

4) easyGroup claims that owing to its reputation in the trade mark EASYJET for travel services use of EASYFLEX would, without due cause, take unfair advantage of the distinctive character or repute of EASYJET. In the alternative easyGroup claims that use of EASYFLEX would be detrimental to the distinctive character or repute of EASYJET. easyGroup states that such use would dilute, whether by blurring or tarnishing, the distinctiveness and, therefore, value of easyGroup's brand.

5) easyGroup claims that members of the public with some knowledge of its "easy" businesses and services might think that B&W's services are connected with or authorised by easyGroup. It claims a protectable goodwill and that damage to this goodwill can be inferred. Consequently, use of the trade mark EASYFLEX is liable to be prevented by the law of passing-off and so registration of the trade mark would be contrary to section 5(4)(a) of the Act.

6) B&W denies the grounds of opposition.

7) Both sides filed evidence and seek an award of costs.

8) The case was heard on 13 August 2003. easyGroup was represented by Mr Roberts of counsel, instructed by Page White & Farrer and B&W by Ms McFarland of counsel, instructed by Stevens Hewlett & Perkins.

EVIDENCE OF EASYGROUP

9) The evidence of easyGroup has been furnished by James Rothnie, director of corporate affairs for easyEverything Limited, easyRentacar (UK) Limited and easyGroup (UK) Limited.

10) A good deal of Mr Rothnie's statement is submission rather than evidence of fact. I will just record the evidence of fact which I consider relevant to this case; taking into account that the relevant date is 1 May 2001.

11) easyJet Airline was launched in November 1995. Its business is very much based on the Internet. In August 2000 over 75% of its seats were sold over the Internet.

12) Various press articles are exhibited in relation to some form of financial business that the founder of easyJet, Stelios Haji-Ioannou, intended to set up. These include:

- "The Express" 14 February 2001 – "Bank of Scotland has pulled the plug on a partnership with easyMoney, the online financial services soon to be launched by Stelios Haji-Ioannou's easyGroup."
- "Financial Times" 14 June 2000 – "Bank of Scotland has confirmed it is holding talks with Stelios Haji-Ioannou, founder of EasyJet, the budget airline, over the setting up a lower-cost web-based financial services company. Mr Haji-Ioannou said last week that he had found an unnamed UK banking partner for his latest venture, for which he has already secured the internet domain name EasyMoney.com."
- "The Scotsman" 19 October 1999 – "EasyJet has also decided to call its planned internet banking venture EasyBank.com, rather than EasyMoney.com."
- "The Independent" 14 August 1999 "for what is expected to be called easyMoney or easyBank."

In a printout from easyJet.com of 27 October 2000 Stelios Haji-Ioannou is reported as saying:

"Finally, I am pleased to report that my other ventures continue to make excellent progress. Look out for more news on my latest company, easy.com, which will provide a range of virtual services. I will also be launching easy.money.com shortly – unsurprisingly this seems to be attracting a great deal of interest! easyRentacar, the world's first Internet only car rental company, is now available in 10 locations (not bad when you consider we only started trading in April!) and easyEverything, my chain of Internet cafes, is also undergoing rapid expansion."

I can glean some information about easyValue from a piece in "The Times" of 17 October 2000 – "His latest venture is launched next month, and they have only just got around to advertising for someone to run it. EasyValue.com is a website that will offer price comparisons for books, CDs and other consumer goods...." An article from the

“Financial Times” of 18 November 2000 is exhibited . This is about Mr Haji-Ioannou and states that:

“On Monday, the 33-year-old Mr Haji-Ioannou launches EasyValue.com, an internet service that will allow consumers to compare prices of books, compact discs and other products.”

There is no indication in the evidence of the success or otherwise of this service. There is an absence of concrete detail as to the turnover of the service, the number of “hits” and the exact nature of the service. Overall the evidence suffers from paucity and poor quality. The evidence in relation to the financial service is no more compelling. So as far as I can see Mr Haji-Ioannou had some plans for a financial services company. The name was not settled nor is there any clear indication as to what the exact nature of the business was to be. Certainly, at the date of the filing of the application there was no business.

13) Mr Rothnie states that it was announced in August 1998 that car rental services would be provided under the trade mark easyRentacar and that this was extensively publicised from May 1999 onwards. He gives a list of car rental sites but does not state which ones were in operation as of 1 May 2001. Various press releases are exhibited:

- Thursday 20 April 2000: “The first **easyRentacar.com** A-class Mercedes were driven away by customers from the London Bridge site this morning, starting at 7am.....The premises at Glasgow Airport will be opening on Monday morning April 24th, followed by Barcelona on Wednesday April 26th. These sites will be supported by fleets of around 500 vehicles each.”
- Wednesday 8^h March 2000 – easyRentacar signs site in Barcelona. “Bookings at www.easyRentacar.com will be starting in the near future.”
- Monday 20 March 2000 – easyRentacar signs site in London

Exhibited at JR2 is a page downloaded from Internet headed easyRentacar.com:

“As a result of HP’s dedication, the initial phase of the work was completed in only three months, with the Web site going live in March 2000.”

Mr Rothnie states that unaudited estimates of turnover for easyRentacar between February 2000 and the end of September 2000 are £2 million. Mr Rothnie does not advise how much of this relates to United Kingdom business and how much to business abroad. He states that there were 65,000 visits to its website between May and December 1999 before it began trading in February 2000. I find this difficult to tally with the exhibited evidence. easyRentacar’s website according to the press release referred to above only went live sometime in March 2000. I do not understand how an Internet only company was trading and having visits to its website when that website only went live in

March 2000. Hewlett Packard also indicates that it took only three months to set the web site up. So it only started working on it in December 1999 at the earliest.

14) The first advertisement for easyRentacar.com that is exhibited is from “The Guardian” of 13 March 2000. A series of press advertisements are exhibited from the weekend of Saturday and Sunday 3 and 4 June 2000 onwards from newspapers such as “The Guardian”, “The Times”, “Daily Express”, “Sunday Express”, “Mail on Sunday”, “Sunday Telegraph”, “The Independent”, “Metro” (London) and “The Evening Standard”. Exhibited is a proof of an advertisement created on 10 July 2000 which gives the names of sites in Glasgow, London Bridge, Barcelona, Malaga and one due to open in Nice on 20 July. Also exhibited is a proof of an advertisement created on 21 July 2000 advertising the opening of a site in Manchester on 17 August, this also mentions a site in Birmingham. The evidence shows that the easyRentacar.com name appears on the sides of the car and so the source of the car will be readily seen.

15) Mr Rothnie refers to an NOP survey he exhibits at JR4. He states that this emanates from April 2000. However, it clearly states that the fieldwork was undertaken between 25 and 28 August 2000. The survey is headed “EasyJet Awareness – Omnibus Research”. None of the questionnaires are exhibited. Parts of the survey are illegible. There is no explanation of the methodology of the survey and no statements from those who undertook the survey. The head note to *Imperial Group plc & Another v. Philip Morris Limited & Another* [1984] RPC 293 gives a useful summary to the requirements for a survey:

“If a survey is to have validity (a) the interviewees must be selected so as to represent a relevant cross-section of the public, (b) the size must be statistically significant, (c) it must be conducted fairly, (d) all the surveys carried out must be disclosed including the number carried out, how they were conducted, and the totality of the persons involved, (e) the totality of the answers given must be disclosed and made available to the defendant, (f) the questions must not be leading nor should they lead the person answering into a field of speculation he would never have embarked upon had the question not been put, (g) the exact answers and not some abbreviated form must be recorded, (h) the instructions to the interviewers as to how to carry out the survey must be disclosed and (j) where the answers are coded for computer input, the coding instructions must be disclosed.”

What Mr Rothnie supplies falls well short of the requirements and I think, wisely, Mr Roberts did not rely on this survey evidence. I certainly give it no weight.

16) Mr Rothnie states that in June 1999 a chain of Internet cafés was launched beginning with a five hundred seat branch in London. He gives a list of current cafés but does not state which ones were in operation at the relevant date. Mr Rothnie states that in September 2000 there were 1.25 million visitors to easyEverything stores throughout Europe. He does not advise how many of these visitors were in the United Kingdom or how many of the visitors were repeat visitors. It would seem that the figure represents visits rather than different visitors. An article from “The Sunday Herald” of 11 June

2000 states: "Recently he spent £10 million to launch easyEverything, a chain of cybercafes. The chain opened Scotland's largest internet café in Edinburgh's Rose Street last month and is looking at sites in Glasgow." "Retail Week" of 25 June 1999 advises that in that week "EasyEverything, a new retail concept, opened its doors in Wilton Street near London's Victoria Station."

17) Mr Rothnie states that turnover in the United Kingdom in the period June to 30 September 1999 under the trade mark easyEverything was £392,000 and turnover for the twelve months ending 30 September 2000 was £6,704,895. He states that the services are available in London, with five stores, and in one store in Edinburgh. Mr Rothnie does not state if this was the position as of the relevant date. Exhibited at JR5 are examples of advertising for easyEverything. Much of the material is not linked to a date and the poor quality of the reproduction makes it difficult, sometimes impossible, to read certain of the material. However, the following advertisements have both an attributable date and source:

"Evening Standard" 15, 30 May 2000

"Evening News" (Edinburgh) 17,19, 22, 26 May 2000

"Time Out" 3-10 May 2000

"High Life" May 2000

18) By the end of 2000 easyJet Airline Company Ltd had spent over £40 million on advertising and promoting its business and of this £30 million had been spent in the United Kingdom. £2.6 million was spent in the United Kingdom between October 1999 and August 2000 in relation to the promotion of easyEverything and over £500,000 spent on promotion in relation to easyRentacar in London alone by the end of 2000. Mr Rothnie exhibits Reuters listings of press coverage of easyJet Airline Company Ltd and related companies.

19) Mr Rothnie gives a list of the awards and prizes made to easyJet and its founder. Awards have also been made to easyEverything: March 2000 - an award for the most promising new retailer by "Retail Week", July 2000 - Networking Industry award for imaginative use of technology and in September 2000 - e Company of the Year at the Future UK Internet Awards.

20) Ms McFarland did not dispute the fame of EASYJET as a passenger airline service so I do not consider it necessary in dealing with the evidence in relation to this undertaking,

21) Mr Rothnie exhibits pages downloaded from the B&W website on 26 March 2002. These show that EASYFLEX is being used in relation to a range of flexible mortgages.

EVIDENCE OF B&W

Witness statement of Paul Usher

22) Mr Usher is the marketing manager of B&W. The trade mark EASYFLEX was first used by B&W in the United Kingdom in 2001 when B&W introduced a new range of flexible mortgages. Various material relating to EASYFLEX mortgages is exhibited. The original documents that are exhibited show use of predominantly blue print on a white background. There is also use of orange for headings, the B&W logo and the trade mark; in the trade mark either the EASY or the FLEX element is in orange and the non-orange element is in blue. Mr Usher states that the services provided under EASYFLEX have been provided throughout mainland Britain and he exhibits a list of places where the services have been furnished. In the year 2001/2002 1285 “units” were sold and in the year 2002 up to August 938 units. Mr Usher gives respective “turnover” figures of £121,491,375 and £85,720,912 for these periods. As these figures relate to mortgages supplied the actual amount tells me little.

23) Mr Usher states that EASYFLEX services have been widely advertised and that in the financial year 2001/2002 B&W spent £126,970 on advertising and publishing the services sold under EASYFLEX. Certain material is exhibited. In all of the material, referred to in this paragraph and the paragraph above, EASYFLEX is clearly identified as a service supplied by B&W.

24) Mr Usher states that he is aware that third parties have adopted trade marks incorporating the word EASY for financial services including Legal & General, Alliance and Leicester, Stroud & Swindon Building Society, Ulster Bank and the West Bromwich Building Society. The following matter is exhibited in relation to this:

- Page downloaded from Legal & General website on 25 March 2002 which refers to an Easy Access Tracker Account and an Easy Tracker Account.
- A leaflet for an EasySaver account of Alliance Leicester with a publication date of September 2001.
- An advertisement for an EasySaver account of Alliance Leicester. The source of the advertisement is not identified, nor its date of publication. However, the advertisement does state that the details therein were correct as at 3 December 2001.
- Two pages, dated February 2002, dealing with Bank and Building Society Accounts which show Direct Easy Access accounts, Easy Access Savings and Direct Easy Access from, respectively, Stroud & Swindon BS, Ulster Bank and West Bromwich BS.
- A page downloaded from the Internet on 7 March 2002 for Easy Loans. The page states that Easy Loans is a trading style of Sterling Direct Finance Ltd. The services supplied are mortgages, loans and re-mortgages.
- Pages downloaded from the Internet on 7 March 2002 for Easy Quote. The pages state: “Easy Quote does not sell financial services or give advice but provides a free consumer service to search for competitive quotes”. A variety of financial

services are listed eg personal loans, life insurance and car insurance. The second page ends with the following: "Please note that Easy Quote is not associated with easyGroup companies".

- Pages downloaded from the Internet on 7 March 2002 for "easy way" which is a property selling and buying service.
- A page downloaded from the Internet on 7 March 2002 for Mortgages Made Easy.
- A page downloaded from the Internet on 7 March 2002 for easy 4 finance.com which supplies a variety of financial services.
- An advertisement for Alliance Leicester's EasySaver. The source of the advertisement is not indicated nor the date when it appeared. However, the advertisement does state that the details therein were correct as at 2 November 2001.

All the above material post-dates the date of the filing of the application.

Witness statement of Jonathan Sutton.

25) Mr Sutton is a trade mark agent. A large part of his statement is submission rather than evidence of fact and I will say no more about that aspect of it.

26) Mr Sutton states that a search of the Internet for the term EASY has uncovered in excess of one thousand web sites. He does not state how many of these supply services in or to the United Kingdom nor how many relate to financial services in the United Kingdom. He exhibits a selection of the websites but does not advise how or why he has chosen this particular selection. The only financial services website appears to be the Easy Quote site which is mentioned in the evidence of Mr Usher. Several of the printouts clearly relate to the United States of America. Mr Sutton states that a search of the Community and United Kingdom trade mark databases has revealed in excess of two thousand trade marks which include the word EASY. He exhibits printouts for trade marks including the word EASY in class 36 and states that there are more than a hundred. A good number of these are in the name of easyGroup. Various of them also have no link with class 36 eg abandoned Community Trade Mark no 2740793 which is for goods and services in classes 16, 30, 32 and 41. Certain of them also use the word easy in a clearly non trade mark sense eg artshuttle the easy way to discover your favourite city. Certain of the trade marks also do not follow the easyJet format of commencing with EASY eg DISHEASY.

EVIDENCE IN REPLY OF EASYGROUP

Second witness statement of James Rothnie

27) A good deal of Mr Rothnie's statement is not evidence of fact but submission and a critique of the evidence of B&W. Despite the length of Mr Rothnie's second statement there is little that assists me in coming to a conclusion in this case. He

refers to the use of the phrase “easy does it” in press articles about easyGroup operations and that B&W use the phrase in relation to their EASYFLEX mortgages. I am not sure where this use of cliché and poor puns is supposed to lead me. Mr Rothnie comments on the use of the colour orange by easyGroup.

FURTHER EVIDENCE OF B&W

Second witness statement of Paul Usher

28) Mr Usher states that B&W has used the colours orange and blue as its corporate colours since 1991. He states that all of B&W’s literature, branch fascias and promotional/advertising material since 1991 has contained these colours to a substantial degree. He exhibits various materials to support this claim:

- B&W’s annual report for 1991. This shows use of the colour orange in the company logo and in headings and page numbers.
- Copies of extracts from B&W’s retail browsing campaign for 1991/92 which was given an award by Building Society Marketing Awards. The B&W logo appears in orange, as the predominant colour, white and blue. Promotional leaflets for opening an account are mainly in blue and orange with some white writing on a blue or orange background.
- A colour copy of “Quaytimes”, an in-house magazine, for October 1999. The B&W logo is now predominantly orange. The colours blue and orange are used for headlines and titles. The letter Q and the word times is in orange, the other letters are in white.
- A copy of B&W’s brochure from August 1999 for EASYLIFE instant access savings. Orange and blue are used in the brochure both for lettering and background. EASYLIFE is presented on the front cover in lower case with the word easy in orange and the word life in blue.

FURTHER EVIDENCE OF EASYGROUP

Third witness statement of James Rothnie

29) All of Mr Rothnie’s statement represents submissions and a critique of the evidence of B&W. It is not evidence of fact and I will say no more about it.

DECISION

Likelihood of confusion – section 5(2)(b)

30) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

31) The term ‘earlier trade mark’ is defined in section 6 of the Act as follows:

“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.”

Two of the trade marks upon which easyGroup relies are applications which have not been registered. I, therefore, have to take into account section 6(2) of the Act which states:

“References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

32) The trade marks upon which easyGroup relies all fall within the definition of earlier trade marks.

33) 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] RPC 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v Adidas AG* [2000] ETMR 723.

Comparison of services

34) The specification of the application is for:

financial services; insurance and life assurance services; real estate services; valuations and financial appraisals of property; property acquisition management services; rental, letting and leasing of properties; leasing services; banking services; administration of financial affairs; trustee services; administration of mutual funds; cash management services; cash dispensing services; loan services; mortgage services; mortgage broking

services; provision of security for loans; credit services; lease purchase financing, hire purchase financing; credit card, charge card, cash card, cheque guarantee card, payment card and debit card services; card and cash replacement services; provision of finance, money exchange and money transmission services; currency services, bureau de change services; foreign exchange services; merchant banking and investment banking services; investment and savings services; investment management services; brokerage of bonds, securities, commodities and futures; securities valuation services; share underwriting services; securities lending services; dividend collection services; payment collection services; underwriting services; unit trust services; investment trust services; security services; tax services; financial planning and investment advisory services; financial research services; pension fund services; provision of financial information; safe keeping, administration and valuation of investments; collateral agency services; securities custody services; safe custody services; consultancy, information and advisory services relating to all the foregoing.

With the exception of the EASYJET registration all of the earlier rights upon which Mr Roberts relied include *financial and insurance services* or *insurance services*. B&W's specification obviously includes services which are identical to these services. If easyGroup does not succeed for identical services in relation to these four trade marks I cannot see that its position can be any better for services that might not be considered identical eg *real estate services*. So I do not see any need to delve in deeper into this matter in relation to these four trade marks. I also note that there is no evidence of use in relation to the goods and services upon which there is reliance in this case.

35) The EASYJET registration does not encompass identical services. Mr Roberts relies upon the following goods and services for his case:

tickets, vouchers, coupons and travel documents

transportation and storage; transportation of goods, passengers and travellers by land, sea and air; airline and shipping services; cargo 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 tourism services.

The above goods and services are in classes 16 and 39 of the International Classification of Goods and Services.

36) The European Court of Justice in *Canon* held in relation to the assessment of the similarity of goods and/or services, that the following factors, inter alia, should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are complementary.

37) Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 stated:

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

I will give the words in the specifications their natural meaning, but within the context that they appear in a specification derived from the International Classification of Goods and Services. I also bear in mind the comments of Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* where he stated:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade.”

I take on board the class in which the goods or services are placed is relevant in determining the nature of the goods and services (see *Altecnic Ltd's Trade Mark Application* [2002] RPC 34). In relation to the comparison of services I firmly bear in mind the comments of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

38) Mr Roberts placed a lot of emphasis on the idea of complementary services or goods. If the case is to stand and fall on a complementary nature of goods and/or services I consider that there will have to be a very close nature; that of the symbiotic or mutually dependant. It would have to be on the scale of operating software and a computer rather than of electricity and a machine that uses electricity or the bun and the plate upon which it is put.

39) The only area where I see a possible intersection of the goods and services of the EASYJET registration and the services of the application is in relation to *travel agency services* in the earlier registration and *banking services; provision of finance, money exchange and money transmission services; currency services, bureau de change services; foreign exchange services* in the application. *Banking services* will include all the specific services that follow it. I am aware that *banking services* encompasses a myriad of other activities other than those that follow its recitation in the specification,

many of which are also in the specification. However, I cannot decide which other specific services included in this term are of interest to B&W.

40) In my experience it is normal for travel agents to supply foreign currency, indeed to have discrete areas of their premises for this function. It is part and parcel of their trade. Of course, when they supply foreign currency they are taking part in a class 36 activity and so easyGroup's specification gives no cover for this exact service. However, the end user of both services is the same; the person travelling aboard. I am loathe to state that the services are complementary. There is a connection between travelling abroad and getting foreign currency or travellers cheques and between travel agents and the supplying of means of payment abroad. However, there is no symbiotic and mutually dependant relationship. I think it is dangerous to promote a connection into a complementary relationship. Nevertheless, I consider that the trade tradition of travel agents supplying this banking service cannot be ignored in making an overall assessment of the similarity of the services. Taken overall I consider that there is a degree of similarity between *banking services; provision of finance, money exchange and money transmission services; currency services, bureau de change services; foreign exchange services and travel agency services.*

Comparison of trade marks

41) 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). 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). I take into account 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 BV page 84, paragraph 27).

42) The trade marks to be compared are:

easyGroup's trade marks

B&W's application

EASYJET

EASY

easy extras)
easyExtras)
EASY EXTRAS) **series of four**
EASYEXTRAS)

EASYFLEX

EASYVALUE) **series of two**
EasyValue)



43) Mr Roberts referred to the decision of Mr Hobbs QC, sitting as the appointed person in *Torremar Trade Mark* [2003] RPC 4 and in particular the comments at paragraphs 18 – 25:

18 Each of the earlier trade marks cited by the opponent must be considered in turn for the purpose of determining whether it prevents acceptance of the contested application for registration under s.5(2) of the Act.

19 In each case the question to be determined is whether there are similarities (in terms of marks and goods) which would combine to create a likelihood of confusion if the earlier trade mark and the sign subsequently presented for registration were used concurrently in relation to the goods for which they are respectively registered and proposed to be registered.

20 The objection cannot be upheld if it does not appear that the public could believe that the goods supplied under the marks in contention come from the same undertaking or, as the case may be, from economically-linked undertakings: Case C-39/97 Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer inc. [1998] E.C.R. I-5507, paragraphs 26 to 30.

21 When (as contemplated by s.5(2)(b) of the Act) the marks in issue are not identical, they need to be *distinctively similar* in order to be capable of inducing such a belief in the mind of the average consumer of the goods concerned.

22 At this point it is necessary to observe that marks which converge upon a particular mode or element of expression may or may not be found upon due consideration to be distinctively similar. The position varies according to the propensity of the particular mode or element of expression to be perceived, in the context of the marks as a whole, as origin specific (see, for example, *Wagamama Ltd v City Centre Restaurants Plc* [1995] F.S.R. 713) or origin neutral (see, for

example, *The European Ltd v The Economist Newspaper Ltd* [1998] F.S.R. 283).
23 The relevant propensity may, on established principles, be inherent or acquired through use. This leaves room for evidence demonstrating that the mode or element of expression in question has an established significance which the average consumer would take to have been carried through to the marks in issue.
24 The view that the established significance is origin specific may be supported by evidence directed to the way in which the mode or element of expression has been used as the basis for a "family" of distinctively similar marks: *Duonebs Trade Mark* January 2, 2001 SRIS O/048/01 (Mr Simon Thorley Q.C.); *The Infamous Nut Company Ltd's Application* September 17, 2001 SRIS O/411/01 (Professor Ruth Annand); *Lifeforce International Inc.'s Application*; *Opposition of Novartis Nutrition AG* [2001] E.T.M.R. 106, p.1227 (Opposition Division, OHIM). The view that the established significance is origin neutral may be supported by evidence directed to the way in which the mode or element of expression has been used by traders and consumers more generally.”

In relation to the comments in paragraph 24 the evidence indicates that easyValue might have been used for something or other from November 2000 but exactly for what and to what extent is impossible to ascertain. There is no evidence that EASYJET has been used in relation to travel agency services or what would be perceived as travel agency services by the average reasonably informed consumer. (See Aldous LJ in *Thomson Holidays Ltd v Norwegian Cruise Line Ltd* [2003] RPC 32 where he stated:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”)

EASYJET is without doubt a famous name for passenger airline services but there is a world of difference between such a business and financial services.

44) I will leave the application for the trade mark EASY to one side for the moment. All the trade marks share the word easy, that is the common element. The final word element is conceptually different. This is not a matter of conceptual neutrality, as one has with different invented elements, but conceptual dissonance which puts greater distance between the trade marks. All of the second elements are well-known words. There is no phonetic similarity between the second elements. Taking this into account it is not surprising that Mr Roberts laid claim to the word EASY.

45) The visual similarity will very much depend on the perception of the words. B&W's trade mark is word only. easyGroup has made much of the use of the colour orange by B&W. However, it has not put in any convincing evidence that the colour orange is associated with easyGroup and especially not in relation to financial services.

46) EASY is a common and very descriptive word. It is not a word, in my view, that on its own is likely to be distinctive of any goods or services. The trade marks have distinctiveness in the combination of their elements. This is a case where the trade marks very much have to be considered in their entirety, an artificial dissection will not do. I am afraid the argument of Mr Roberts is very much of that wealthy trader who is trying to enclose the great common of the English language. However, easyGroup does not have enclosure acts to aid its cause. Mr Livesey QC, sitting as a deputy judge of the High Court, viewed the issue as follows in *EasyJet Airline Co. Ltd v Dainty (t/a EasyRealestate)* [2002] FSR 6:

“I agree with the defendant that the claimants are not entitled to appropriate the word "easy" and prevent any businessman from using any name which includes the word "easy". However, in my judgment the test which requires to be established, that is to say that there is a likelihood of deception, is made out in this case not because the defendant has used the word "easy" but because of the four elements which I have already described as part of the livery or get-up of the claimants.”

47) The consideration of the similarity also has to take into account the nature of the goods and services and the concept of imperfect recollection. The services of the registration are the sort where there will be a very careful and cautious purchasing decision; where because of the various financial services acts and money laundering legislations forms will have to be carefully completed. The average consumer will have plenty of time to consider the trade marks of the registration. Owing to the divergence in the trade marks I do not consider that imperfect recollection is going to have an effect on the issue of similarity.

48) I have no hesitation in coming to the conclusion that the B&W's trade mark is not similar to the four trade marks of easyGroup that I have considered above.

49) I turn now to the trade mark EASY. In *The European Ltd v The Economist Newspaper Ltd* [1998] ETMR 307 Millet LJ commented upon the issue of distinctiveness in relation to likelihood of confusion:

“Although he did not have the benefit of the decision, he did in my opinion faithfully carry out the instructions of the European Court of Justice in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1 to the effect that:
"The likelihood of confusion must be appreciated globally, taking into account all factors relevant to the circumstances of the case. That global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind in particular their

distinctive and dominant components . . . the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public. The more distinctive the earlier mark, the greater will be the likelihood of confusion."

The converse, of course, follows. The more descriptive and the less distinctive the major feature of the mark, the less the likelihood of confusion."

50) It is an issue that has been dealt with under the old law and under passing-off. The word of Lord Simons in *Office Cleaning Services Ltd v Westminster Window & General Cleaners* [1946] 63 RPC 39 at 43 still hold true:

"It comes in the end, I think, to no more than this, that where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The Court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles sold or the services to be rendered."

51) The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)*). 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, judgement 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).

52) Mr Roberts relies on EASY in relation to *financial and insurance services*. For such services the trade mark could readily be used in a descriptive fashion; especially taken into account that the adjectival form of the word is often used instead of the adverbial form. I note that the trade mark has been published and so OHIM must assume that it has some distinctive character, whether by nature or nurture I do not know. Taking into account the exceptionally limited nature of any distinctiveness, I have no hesitation in deciding that the relevant public will readily be available to distinguish it from B&W's trade mark; especially when there is no evidence of use of this trade mark.

Conclusion on likelihood of confusion

53) The European Court of Justice in *Sabel* held:

“In that connection, it is to be remembered that Article 4(1)(b) of the Directive is designed to apply only if, by reason of the identity or similarity both of the marks and of the goods or services which they designate, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

There has to be a similarity of trade marks and goods. In this case, I do not consider that there is any such similarity, consequently, the grounds of opposition under section 5(2)(b) must fail.

54) The reputation of EASYJET for passenger airline services and imperfect recollection will make no difference to the issue.

55) In reaching the conclusion the state of the register of evidence has not been of use to me. It does not tell me what is happening in the marketplace. All that it indicates to me is that easy is a commonly used word and that it is of limited distinctiveness. I do not consider that I needed evidence to come to this conclusion. The evidence of use from the various websites all emanates from after the relevant date and so does not tell me what was the position as at the date of the filing of the application.

56) The submission that there has not been confusion in the marketplace despite use of EASYFLEX does not take B&W anywhere. There is no indication of use by easyGroup of the trade marks for financial services. The use of EASYFLEX has been within a specific and special environment and for only a limited number of the services of the trade mark. The trade mark could be sold on, it could be used in other fora. I have to consider normal and fair use of the trade mark for all the services. The absence of confusion tells me very little. If the trade mark had been let out on its own into the market place at large, without always holding the hand of B&W, the use of the trade mark might have told me something about the general assertion of easyGroup of likelihood of confusion with its trade marks.

57) It seems to me that Mr Roberts’s case has three threads :

- the reputation of EASYJET swamping all other differences
- the “ownership” of EASY at the beginning of trade marks by easyGroup
- the difference in the “non-reputation” trade marks being compensated by the identity of services.

Mr Roberts tried to avoid claiming “ownership” of EASY, however, that is the basis of his *Torremar* claim and it is the basis of the passing-off claim. He might wish to hide the claim of easyGroup but that, in my view, is what it boils down to.

58) The ground of opposition under section 5(2)(b) is dismissed.

Section 5(3) objection

59) Section 5(3) of the Act states:

“A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or 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 a 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.”

60) Mr Roberts relied upon the reputation of EASYJET for travel services. He did not, however, demur when I stated that I considered that its reputation was for passenger airline services rather than travel services at large.

61) The issue of the nature of the reputation that is required to support a claim under section 5(3) of the Act was dealt with by the European Court of Justice in *General Motors Corporation v Yplon SA Case C-375/97* [2000] RPC 572 (*Chevy*). The court stated the following:

“Article 5(2) of the First Council Directive (89/104/EEC) of 21 December 1988 to approximate the laws of the Member States relating to trade marks is to be interpreted as meaning that, in order to enjoy protection extending to non-similar products or services, a registered trade mark must be known by a significant part of the public concerned by the products or services which it covers. In the Benelux territory, it is sufficient for the registered trade mark to be known by a significant part of the public concerned in a substantial part of that territory, which part may consist of a part of one of the countries composing that territory.”

“The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant factors of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking in promoting it.”

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

62) I have no hesitation in accepting that the trade mark EASYJET enjoys a *Chevy* type of reputation for passenger airline services. easyGroup have passed this first hurdle. However, the respective trade marks have to be similar. I have already decided, in relation to section 5(2)(b) that they are not similar. **This ground of opposition must, therefore, fail.**

63) I will briefly comment on other reasons why the ground would have failed. Mr Roberts, despite my questioning, did not make the section 5(3) claim particularly precise. He even continued with the submission that there could be tarnishing. Tarnishing is about the goods or services. The classic example is of *Lucas Bols* [1976] IIC 420 where the connotations of gin and detergent were considered damaging to the gin manufacturers. For section 5(3) to get off the ground there would have to be something that would trigger a connection in the mind of consumer between EASYJET and EASYFLEX. In *Daimler Chrysler AG v Javid Alavi trading as MERC* [2001] RPC 42 Pumfrey J stated:

“...but Jacobs AG emphasises that the provision is not to be used to give marks ‘an unduly extensive protection’, emphasising that there is a question of a risk of unfair advantage or detriment: there must be actual unfair advantage or detriment. But, for this to happen, there must be some sort of connection formed (I avoid the word association) between the sign used by the defendant and the mark and its associated reputation”

This might be from a relationship between the services. I do not see any such relationship.

Passing-off – section 5(4) of the Act

64) Section 5(4)(a) of the Act states that a trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented 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. In this case the rule of law relied upon by easyGroup is the law of passing-off.

65) I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC in the *Wild Child case* [1998] 14 RPC 455. In that decision Mr Hobbs stated that:

"A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 and *Erven*

Warnink BV v J Townend & Sons (Hull) Ltd [1979] ACT 731 is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation."

.....Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 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.””

66) It is well established that the relevant date for passing-off is the date of the behaviour complained of (see *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd* [1981] RPC and *Inter Lotto (UK) Ltd v Camelot Group PLC* [2003] EWCA Civ 1132). In this case there has been use of B&W’s trade mark. However, it has only been used in relation to mortgages, and so not the whole gamut of the specification. It is also use within a very specific context, the B&W environment, it has not been used in a stand alone context. In these circumstances I do not consider that the nature of the use is such that it can be defined as representing the behaviour complained of. That must be the filed trade mark and the filed specification, what might be described as the idealised trade mark. Section 5(4)(a) is derived from article 4(4)(b) of First Council Directive 89/104 of December 21, 1998 which states:

“rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark”.

In these circumstances I consider that the relevant date will need to be the date of the filing of the application.

67) Mr Roberts claims a goodwill in financial services, I have dealt with the evidence in relation to this in paragraph 12 above. It is possible for promotional activity to give rise to a goodwill (see *BBC v Talbot Motor Co Ltd* [1981] FSR). However, I do not consider that the evidence before me puts easyGroup on a par with the BBC. The proposed financial services are not defined. Talks to find a partner are set up and breakdown. easyGroup have not even fixed upon a sign to use in relation to the services. All the evidence is cuttings from the press. The evidence falls a long way short of establishing a reputation or goodwill in relation to financial services of any kind and certainly does not establish what sign would be used in relation to them. At the hearing I reminded Mr Roberts of Pumfrey J’s comments in *South Cone Inc. v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19:

"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 requirements of the objection itself are considerably more stringent than the enquiry under s 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 to the relevant date."

The evidence falls a long way short of this.

68) For similar reasons I do not consider that easyGroup can be considered to have established a goodwill for a business which uses the sign EASYVALUE. Again the evidence is just not good enough.

69) There is a goodwill in a passenger airline business which uses the trade mark easyJet. A goodwill in an Internet café business in London and Edinburgh which uses the trade mark easyEverything. There is a goodwill in a car rental business which uses the trade mark easyRentacar. Mr Roberts appeared to rely on the effect of the use of EASY prefixed trade marks as a whole to sway his case.

70) On a trade mark to trade mark basis I cannot see that easyGroup can do better under passing-off than it did in relation to likelihood of confusion. The kernel of Mr Roberts' case seems to me the EASY element. The very presence of EASY in another trade mark will lead to deception. This runs into the problem of whether there is a commonly owned goodwill, for which there is an absence of evidence. However, putting that issue to one side one runs into other problems. There is the fact that the common element is non-distinctive. One is very much back to the issues of *Office Cleaning Services Ltd v Westminster Window & General Cleaners*. I also cannot see any relationship between an air passenger airline, a car rental business and an Internet café business and financial services. There is no evidence to suggest that there is one.

71) In *Harrods v Harrodian School* [1996] RPC 697 Millett LJ states:

"It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant's goods or services"

In the same case he goes on to state:

"The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration."

and

"The name "Harrods" may be universally recognised, but the business with which it is associated in the minds of the public is not all embracing. To be known to everyone is not to be known for everything."

In *Stringfellow v McCain Foods (G.B.) Ltd.* [1984] RPC 501 Slade L.J. said:

“even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.”

72) Lord Fraser in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31 said that the claimant must prove:

“That he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill by reason of the defendants selling goods which are falsely described by the trade name to which the goodwill attaches.”

73) The absence of a common field of activity, the difference in the signs and the non-distinctive nature of the common EASY element are all enough for me to reject the claim under passing-off, without even considering the issue of whether there is a commonly owned goodwill.

Costs

74) Ms McFarland requested that in considering the costs I should take into account those rights and that evidence which was not relied upon at the Hearing by Mr Roberts. I do not consider that it is appropriate to penalise one side for not relying upon certain evidence or earlier rights at a hearing. This would almost be to encourage Counsel to pursue courses that they do not need to. What is relevant, in my view, is whether grounds were clearly unsustainable at the commencement and/or evidence irrelevant. I consider that the issue is whether one side was put to needless trouble and expense by the other. *Rizla Ltd's Application* [1993] RPC 365 confirms that in the matter of costs the registrar has a wide discretion. In *BUD and Budweiser Budbräu Trade Marks* [2002] RPC 38, Mr Simon Thorley QC, sitting as a deputy judge of the High Court, accepted that off the scale costs could be awarded where a side had behaved unreasonably or put in a large amount of evidence that is of little or no relevance.

75) The earlier rights which easyGroup listed were in my view excessive. However, I am not certain that B&W would have been put to a great deal of trouble in going through them. Nevertheless, B&W would have had to do some unnecessary work in checking through all the earlier rights. Certainly the evidence, and especially the exhibits, of easyGroup could have been better presented and more strictly to the point. However, B&W have put in state of the register of evidence which was not going to be of any relevance in the proceedings. Jacob J stated in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281:

Aln particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led to the Registrar to put the marks concerned on the Register. It has long been held that under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see *e.g. MADAME Trade Mark* (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence.@

The rest of the evidence of B&W was of very dubious value in relation to the issues of this case. In these circumstances I do not consider that I should veer away from the normal scale and allocation of costs. However, I take into account that this one of two sets of proceedings between the sides. The two cases were heard together and certain of the evidence was common.

76) Bristol & West plc having been successful it is entitled towards a contribution towards its costs. I order easyGroup IP Licensing Limited to pay Bristol & West plc the sum of £1400. This sum is 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 27th day of August 2003

**David Landau
For the Registrar
the Comptroller-General**