

O/816/18

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3254103 BY
ASID REIGNZ ENTERPRISES LIMITED
TRADING AS ASID REIGNZ MUSIC
TO REGISTER:**

Mr Easy

AS A TRADE MARK IN CLASS 41

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 411120 BY
EASYGROUP LIMITED**

Background and pleadings

1. Asid Reignz Enterprises Limited (trading as Asid Reignz Music) (“the applicant”) applied to register the trade mark **Mr Easy** in the United Kingdom on 2 September 2017. It was accepted and published in the Trade Marks Journal on 29 September 2017 in respect of the following services:


Class 41

Entertainment

2. The application was opposed by easyGroup Limited (“the opponent”). The opposition is based upon Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).
3. The opponent is relying upon the trade marks shown in the table below. These are all registered for many goods and services, and I have detailed those services upon which the opponent seeks to rely in these proceedings. The opponent is, however, unable to rely on all the Class 39 services pleaded for the EASYGROUP mark, as it is not registered for all those services. I will return to this point later in my decision.

	<u>Section 5(2) grounds</u>	<u>Section 5(3) grounds</u>
EU (formerly Community) Trade Mark 10584001 (“the easyJet mark”) EASYJET Applied for: 24 January 2012 Registered: 9 January 2015	<u>Class 41</u> <i>Entertainment; sporting and cultural activities; information relating to entertainment, provided on-line from a computer database or the Internet; entertainment services provided on-line from a computer database or the Internet; organising games and competitions, rental of games and playthings.</i>	<u>Class 39</u> <i>Transport; packaging and storage of goods; travel arrangement; travel information; transportation of goods, passengers and travellers by air; airline services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft; airport transfer services; escorting of travellers; travel agency services; advisory and</i>

	<u>Section 5(2) grounds</u>	<u>Section 5(3) grounds</u>
		<i>information services relating to the aforesaid services; information services relating to transportation services, travel information and travel booking services provided on-line from a computer database or the Internet.</i>
<p>EU (formerly Community) Trade Mark 14920391 ("the easyGroup mark")</p> <p>EASYGROUP</p> <p>Applied for: 17 December 2015 Registered: 26 May 2016</p>	<p><u>Class 41</u></p> <p><i>Entertainment services; entertainment information services.</i></p>	<p><u>Class 39</u></p> <p><i>Transportation of goods, passengers and travellers by air; airline services; bus transport services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft; travel reservation and travel booking services provided by means of the world wide web, information services concerning travel, including information services enabling customers to compare prices of different companies; travel agency and tourist office services; advisory and information services relating to the aforesaid services; information services relating to transportation services, including information services provided on-line from a computer database or the Internet.</i></p>

	<u>Section 5(2) grounds</u>	<u>Section 5(3) grounds</u>
<p>EU (formerly Community) Trade Mark 14920383 ("the easy.com mark")</p>  <p>Applied for: 17 December 2015 Registered: 1 July 2016</p> <p>The colours orange and white are claimed.</p>	<p><u>Class 41</u> <i>Entertainment services; entertainment information services.</i></p>	<p><u>Class 39</u> <i>Transport; packaging and storage of goods; travel arrangement; travel information; transportation of goods, passengers and travellers by air; airline services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft; airport transfer services; escorting of travellers; travel agency services; advisory and information services relating to the aforesaid services; information services relating to transportation services, travel information and travel booking services provided on-line from a computer database or the Internet.</i></p>

4. The opponent claims that its Class 41 services are identical to the applicant's services and that the marks are confusingly similar. It also claims that its earlier marks enjoy enhanced distinctive character as a result of the use made of them. For these reasons, it submits that there is a likelihood of confusion under section 5(2)(b) of the Act.
5. For section 5(3) of the Act, the opponent claims that the marks are sufficiently similar that use of the contested mark would lead consumers to think that there is an economic connection between the opponent and the applicant, that the applicant stands to free-ride on the opponent's reputation for the services in Class 39 to benefit

its own business, that the reputation of the opponent may be damaged by use of the opposed mark if the offering is not of the same character as the opponent's offerings, and that the ability of the opponent's marks to distinguish the opponent's goods and services from those of other undertakings would be diminished by use of the opposed mark, with the result that the power of attraction of the opponent's marks is diminished.

6. The applicant filed a defence and counterstatement, denying all the grounds. While it admits that both marks share the common term "EASY", it denies that they are similar when viewed as a whole. The applicant also denies that its use of its mark is without "due cause"; that a link would be made in the mind of consumers which could lead them to think that there is an economic connection between the applicant's mark and the opponent; that confusion between the marks would ever occur; and that the applicant's use of the mark would take unfair advantage of, or be detrimental to, the alleged distinctive character or reputation of the opponent's marks.
7. Both the opponent and the applicant filed evidence in these proceedings. This will be summarised to the extent that is considered necessary.
8. The opponent filed written submissions on 14 May 2018. No hearing was requested, and the applicant filed written submissions in lieu of a hearing on 24 October 2018. The submissions will not be summarised but I will refer to them where appropriate during this decision, which has been taken following a careful perusal of the papers.
9. In these proceedings, the opponent is represented by Kilburn & Strode LLP and the applicant by D Young & Co LLP.

Preliminary issues

10. The opponent states that the easyGroup mark has a reputation for services in Class 39. This mark is, however, not registered for such services and I shall therefore disregard this mark from the opposition for the purposes of the section 5(3) ground.

11. In its written submissions, the opponent claims that its earlier marks form part of a family. It has not, however, made this claim in pleadings, so I shall also disregard it for the purposes of this opposition.

Evidence

Opponent's evidence

12. The opponent's evidence comes from Mr Ryan Edward Pixton, a trade mark attorney at Kilburn & Strode LLP. His witness statement simply lists the exhibits which are attached to it. It is dated 14 May 2018.

13. The first exhibit is a general witness statement made by Sir Stelios Haji-Ioannou, the founder and director of easyGroup. This statement is dated 4 August 2017 and in it Sir Stelios describes the history of the company, its structure and its brand values.¹ This statement is accompanied by a set of press articles and extracts from the company's annual reports,² a witness statement from Christopher Griffin, Chief Executive of the Museum of Brands,³ a *Sunday Times* article about Sir Stelios dated 13 May 2018,⁴ and exhibits that relate to other group brands which do not feature in this opposition.⁵

14. In the early 1990s, Sir Stelios was developing plans to set up an airline, to take advantage of the deregulation of the industry in Europe. He explains how he came up with a name for this airline:

“6. The name ‘easy’ came to me when I was jotting down some names on a napkin as I was sitting at a bar. The options included ‘cheap’, ‘lite’, ‘affordable’, ‘convenient’ and a few others, but I felt that ‘easy’ conveyed the right proportion of affordability and convenience.

¹ Exhibit REP1.

² Exhibit REP2.

³ Exhibit REP6.

⁴ Exhibit REP7.

⁵ These are easyHotel, easyCoffee and easy Kiosk: see Exhibits REP3-5.

7. Later on, during a brainstorming session with staff, the first brand was born when we conjoined 'easy' with the word 'jet', to denote that we were going to use aircraft with jet engines, as opposed to the so-called turbo-prop aircraft which tend to be smaller, and less popular with the public. As is clear from the easyJet business plan, at the time there was a company in America called ValuJet, which was a challenger airline we felt we could emulate, and that probably also influenced my decision to conjoin 'easy' with the word 'jet'.⁶

15. The first easyJet trade mark was registered on 5 April 1995 and the first flight was made a few months later, in October. By 2014, turnover had reached £4.25 billion. The airline was followed in 1999 by a business operating internet cafés (easyEverything, later renamed easyInternetcafe) and in 2000 by a car rental service (easyRentacar, later renamed easyCar). Each business uses the prefix "easy" joined to a second word or phrase that indicates the goods or services provided under the mark.

16. All the intellectual property relating to the group's brands is owned by easyGroup Limited, which licenses it to individual businesses. Sir Stelios states that a full list of current businesses is available on the website www.easy.com. He adds,

"I should make it clear that easyGroup was not just a corporate or legal vehicle, it is the owner and creator, but also a member of the EASY family of brands and it became recognised in its own right. easyGroup had its own website (www.easygroup.co.uk); its own stationery and appeared in the header of purchase orders and letters."⁷

17. The witness statement from Christopher Griffin has been filed in previous, unrelated oppositions. It was summarised by the Hearing Officer in *EASYSAIL*, BL O/102/18, and I reproduce his summary here:

⁶ REP1, pages 2-3.

⁷ REP1, para.41, page 14.

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

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

21. Mr Griffin opines that the values consumers associate with the ‘easy’ brand include *“excellent value, innovation and an entrepreneurial approach.”* He considers that these values are likely to be tarnished by third parties offering easy-branded services without the authority or control of easyGroup.”

Applicant’s evidence

18. The applicant’s evidence comes from Mr Michael Marcellus Solomon Palmer and is dated 16 August 2018. There is also a witness statement from Mr Ian Dyer made on the same date. Mr Dyer performs under the name “Mr Easy” and he confirms that Mr Palmer has been his manager since at least 2009, that the trade mark application

was filed with his permission and that the applicant acts as his agent and was set up on his behalf.

19. Mr Dyer was born in Jamaica and emigrated with his family to Brooklyn. An artist in the reggae/dancehall genre, his first single was released in 1989 and was a cover of the Isley Brothers' hit "Caravan of Love". The witness statement informs me that his biggest hit was a song called "Drive Me Crazy", released in 2001 and streamed over 350,000 times on Spotify and viewed over 600,000 times on YouTube. The evidence does not tell me the date when these figures were reached. He has been touring and recording for the past 30 years.

Decision

Section 5(2)(b) ground

20. Section 5(2)(b) of the Act states that:

"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."

21. An "earlier trade mark" is defined in section 6(1) of the Act:

"In this Act an 'earlier trade mark' means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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.”

22. The registrations upon which the opponent relies qualify as earlier trade marks under the above provision. As the marks were registered within the five years before the date on which the applicant’s mark was published, they are not subject to proof of use and the applicant is therefore entitled to rely on the Class 41 services for which the marks stand registered.
23. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the courts of the European Union in *SABEL BV v Puma AG* (C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (C-334/05 P) and *Bimbo SA v OHIM* (C-519/12 P):
- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
 - (b) the matter must be judged through the eyes of the average consumer of the goods or services in question. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
 - (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
 - (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in

mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

24. The contested services (*Entertainment*) are clearly identical to some of the services on which the opponent is relying: *Entertainment* (the easyJet mark) and *Entertainment services* (the easyGroup mark and the easy.com mark).

Average consumer and the purchasing act

25. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, I must bear in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: see *Lloyd Schuhfabrik Meyer*.

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

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”⁸

27. The average consumer of entertainment is a member of the general public. The applicant submits that:

“... entertainment type of services will predominantly be accessed aurally rather than [sic] visually by members of the relevant public (such as through music streaming platforms, the radio, concerts, etc)”.

While I agree that the aural element will be important, as consumers would hear the marks spoken, perhaps on the radio or by word-of-mouth recommendation, I consider that the visual element would carry slightly more weight. When choosing entertainment services, the consumer is likely to see posters or other advertising material.

⁸ Paragraph 60.

28. Entertainment services range in price from expensive tickets to high-profile rock concerts to advertising-funded services which the consumer can access on the internet without payment. Whatever the cost, the consumer will be making a choice about which services to use. They will know what they already enjoy and use this knowledge to make a decision. In my view, they would be paying an average level of attention.

Comparison of marks


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

“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”⁹

30. It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

31. The respective marks are shown below:

⁹ Paragraph 34.

Earlier mark	Contested mark
<p data-bbox="225 309 475 340">EUTM 10584001:</p> <p data-bbox="437 418 580 450">EASYJET</p> <p data-bbox="225 528 475 560">EUTM 14920391:</p> <p data-bbox="408 638 612 669">EASYGROUP</p> <p data-bbox="225 748 475 779">EUTM 14920383:</p> 	<p data-bbox="1043 418 1166 450">Mr Easy</p>

32. The applicant’s mark consists of two words in a standard font with no stylisation and with the first letter of each word capitalised. A word trade mark protects the word itself, presented in a standard font and irrespective of capitalisation: see *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16. Neither word is more dominant than the other, so the overall impression lies in the phrase as a whole.
33. The opponent’s easyJet mark consists of the words “EASY” and “JET” joined together and presented as a single word in capital letters and a standard font. The overall impression of the mark lies in the two words joined to make one unit. The opponent’s easyGroup mark follows the same pattern and its overall impression is achieved in the same way.
34. The opponent’s easy.com mark consists of the word “easy” presented in white lower case letters on an orange background. Underneath this word, in smaller white letters,

is “.com”. The letters are surrounded by a white oval border and the font used is Cooper Black.¹⁰ The word “EASY” is dominant over the second element “.COM” on account of its position in the centre of the mark, its larger size and the use of a non-standard font. The letters “.COM” appear in a standard font. The oval border and the orange background are not negligible elements of the mark, as they will affect the average consumer’s perception of the distinctiveness of the mark.

35. Visually, the applicant’s mark consists of two words, the first with two letters and the second with four. The opponent’s word marks are each a single word made up of 7 letters (EASYJET) and 9 letters (EASYGROUP). The words have the four letters “EASY” in common. While those letters are at the beginning of the opponent’s word marks, they are at the end of the applicant’s mark. The opponent’s word marks have three syllables, while the applicant’s has four, and they would be spoken in the conventional manner for those words (“EE-ZEE-JET”, “EE-ZEE-GROOP” and “MISSTER-EE-ZEE” respectively). I find that there is a low degree of visual and aural similarity between these marks. The easy.com mark contains a device and colour, which I have already found contribute to the overall impression of the mark. It would be articulated as four syllables: “EE-ZEE-DOT-COM”. I find that there is a low degree of aural and visual similarity between this mark and the applicant’s mark.

36. In paragraph 14 of this decision, I have already quoted Sir Stelios’s description of the concept behind his brands: affordability and convenience. The opponent’s marks bring to mind airline services that are simple and convenient for people to use (EASYJET), a web portal that is straightforward and user-friendly (easy.com) and an umbrella company that acts as a corporate parent for a range of businesses with these qualities (EASYGROUP). The applicant’s mark, on the other hand, would make the consumer think of a person. The word “easy” used in the context of an individual alludes to someone who is relaxed and easy-going. Consequently, I find that the marks are conceptually different.

¹⁰ See Exhibits REP1 and REP6.

Distinctiveness of the earlier marks

37. There is, as has already been noted, a greater likelihood of confusion if the earlier mark is highly distinctive. The CJEU provided guidance on assessing a mark's distinctive character in *Lloyd Schuhfabrik Meyer*.

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

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

38. The word “EASY”, the common element of all these marks, is a basic English word that alludes to a quality of the services. The word is inherently low in distinctive character. The second elements of the words are allusive or descriptive: an airline (“JET”), a group of companies (“GROUP”), and a website portal (“.COM”). For these particular services, the inherent distinctiveness derives from the composite nature of the word, with a greater weight towards “EASY”.

39. I must, however, consider the distinctiveness of the marks in the context of *entertainment* and *entertainment services*. In the case of the easyJet mark, I find that it has a medium level of inherent distinctiveness, as the dictionary word “jet” does not describe those particular services. The opponent has submitted evidence that supports an assessment that “easyJet” had acquired a high level of distinctiveness for airline services. However, there is insufficient evidence that it has acquired enhanced distinctiveness for entertainment services.
40. The inherent distinctive character of the easyGroup mark depends on the combination of those words. Neither word has much distinctive character by itself. There is no evidence of its use in relation to particular services. It appears to me that it is used as a corporate name. In any case, I have been presented with no evidence to show that it has been used for entertainment services and therefore acquired enhanced distinctiveness.
41. In the case of the easy.com mark, the inherent distinctive character of the mark also comes from the presentation of the word “easy” in a non-standard font, in white letters and surrounded by a white oval, all on an orange background. Again, I see no evidence of its use in connection with the services upon which the opponent is relying.
42. Consequently, I find that the earlier marks have no more than a medium level of inherent distinctive character, which has not been enhanced through use.

Conclusions on likelihood of confusion

43. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred in paragraph 23. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods/services may be offset by a greater degree of similarity between the marks, and vice versa.¹¹ The distinctiveness of the earlier mark must also be taken into account.

¹¹ *Canon Kabushiki Kaisha*, paragraph 17.

44. Such a global assessment does not imply an arithmetical exercise, where the factors are given a score and the result of a calculation reveals whether or not there is a likelihood of confusion. I must keep in mind the average consumer of the services and the nature of the purchasing process. I note that it is generally accepted that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture he has kept in his mind.¹²

45. There are two types of confusion: direct and indirect. These were explained by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10:

“Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.’¹³

46. I can deal with direct confusion relatively quickly. Even taking into account the imperfect recollection of the marks, I consider that there is unlikely to be direct confusion between the applicant’s mark and any of the opponent’s marks. I found there to be a low degree of aural and visual similarity. To my mind it is significant that “EASY” is the first element of the composite word. In *El Corte Inglés SA v OHIM*, Cases T-183/02 and T-184/02, the General Court noted that the beginnings of words tend to have more visual and aural impact than the ends.¹⁴ Even in the case of

¹² *Lloyd Schuhfabrik Meyer*, paragraph 27.

¹³ Paragraph 16.

¹⁴ See paragraph 83.

identical services, with “EASY” being at the beginning as opposed to the end of the mark together with the further differences including the conceptual differences, is in my view enough of a difference to avoid the average consumer being confused.

47. I now turn to indirect confusion. The opponent submits that

“... consumers would automatically assume that Mr Easy formed a further extension of the easy family of brands and the easyGroup business. The combination of the prefix easy with any descriptive or non-distinctive term will be inherently allusive to the Opponent’s family of marks and will seemingly be linked to the Opponent and their commercially wide ranging and ever expanding easy family of brands.”

The opponent also refers to Sir Stelios as the figurehead of the business and submits that:

“One might even go so far as to describe him as ‘Mr Easy’ in relation to the easy family of brands.”

48. Commenting on Mr Iain Purvis’s decision in *L.A. Sugar*, Mr James Mellor QC, sitting as the Appointed Person, said in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17:

“... I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: ‘Taking account of the common element in the context of the later mark as a whole.’ (my emphasis)”¹⁵

49. It is not, therefore, enough for a finding of indirect confusion that the contested mark shares the word “EASY” with the earlier marks. It is a common word which, on its

¹⁵ Paragraph 81.4.

own, I have found to be low in distinctive character. I have already noted that the later mark has only a low degree of aural similarity and a low degree of visual similarity with the early marks, and is conceptually different. Accordingly, I consider it unlikely that the average consumer will assume that the later mark is another brand of the owner of the earlier marks. The evidence before me does not put the opponent in a better position. I consider that the average consumer will not assume that “Mr Easy” refers to the founder of the group, Sir Stelios Haji-Ioannou, or in some other way refers to the easyJet/easyGroup business.

Outcome of the Section 5(2)(b) ground

50. The section 5(2)(b) ground fails.

Section 5(3) ground

51. Section 5(3) of the Act states that a trade mark which is identical with or similar to an earlier trade mark

“shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), 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”.

52. The conditions of section 5(3) are cumulative:

- 1) The opponent must show that the earlier mark has a reputation.
- 2) The level of reputation and the similarities between the marks must be such as to cause the public to make a link between the marks.
- 3) One or more of three types of damage (unfair advantage, detriment to distinctive character or repute) will occur.

It is not necessary for the goods to be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

53. The CJEU considered the threshold for showing reputation in *General Motors Corp v Yplon SA*, C-375/95:

“23. Such a requirement is also indicated by the general scheme and purpose of the Directive. In so far as Article 5(2) of the Directive, unlike Article 5(1), protects trade marks registered for non-similar products or services, its first condition implies a certain degree of knowledge of the earlier trade mark among the public. It is only where there is a sufficient degree of knowledge of that mark that the public, when confronted by the later trade mark, may possibly make an association between the two trade marks, even when used for non-similar products or services, and that the earlier trade mark may consequently be damaged.

24. 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.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. 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.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts 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.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

54. The applicant does not dispute that the easyJet mark has a reputation in the EU for the travel-related services in Class 39 for which it is registered, but does not accept this in relation to the easy.com mark. The opponent’s evidence indicates that the latter mark is used in connection with an online portal for information and an email service. The table below shows the Class 39 services for which the easy.com mark is registered and those services for which the opponent claims it has a reputation. I have highlighted those services that in my view could be provided by a portal such as easy.com:

Services for which the mark is registered	Services for which a reputation is claimed
<i>Transportation of goods, passengers and travellers by air; airline and shipping services; airport check-in services; arranging of transportation of goods, passengers and travellers by land and sea; airline services; bus transport services, car transport services, coach services, baggage handling services; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft, vehicles and</i>	<i>Transport; packaging and storage of goods; travel arrangement; travel information; transportation of goods, passengers and travellers by air; airline services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft; airport transfer services; escorting of travellers; travel agency services; advisory and information services relating to the aforesaid services; information services relating to transportation</i>

<i>boats; storage services, packaging services; rental of storage containers; aircraft parking services; travel reservation and travel booking services provided by means of the world wide web, information services concerning travel, including information services enabling customers to compare prices of different companies; travel agency services; provision of tourist travel information, tourist guide services, arranging excursions for tourists, booking of travel through tourist offices; advisory and information services relating to the aforesaid services; information services relating to transportation services, including information services provided on-line from a computer database or the Internet.</i>	services, travel information and travel booking services provided on-line from a computer database or the Internet.
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55. The opponent's evidence includes information obtained from a Google analytics report on easy.com:¹⁶

	Users	Page views (in millions)	Sessions (in millions)
2012	754,514	3.904	1.911
2013	676,179	3.327	1.729
2014	772,055	3.129	1.717
2015	1,028,415	3.306	1.919
2016	642,966	3.350	1.554
2017 (to end July)	458,919	2.400	1.160

¹⁶ Exhibit REP1.

These are significantly lower than comparable figures for easyJet.com:

	Users	Page views (in millions)	Sessions (in millions)
2012	181,066,000	1,384.000	
2013	182,844,000	1,622.000	
2014	204,696,000	1,833.000	
2015	208,363,000	1,625.000	
2016	168,943,000	1,436.000	
2017 (to end July)	86,918,000	919.000	

56. Furthermore, it is not clear what the content was on the pages viewed on easy.com, or whether it was accessed in the EU. From the evidence, I see that the site contains information on all the EASY brands, the email service to which I have already referred and which at the time of Sir Stelios's witness statement was being provided to about 5,000 users, and that the mark was also used for service desks in five of the easyInternetcafés. No information is provided on the extent of the use of the service desks. Taken as a whole, I am unable to find that the easy.com mark has a reputation for the Class 39 services claimed. Consequently, I shall from now on only consider the easyJet mark.

Link

57. In *Intel Corporation Inc v CPM United Kingdom Limited*, C-252/07, the CJEU gave guidance on the assessment of whether the public will make the required mental link between the marks:

“41. The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case (see, in respect of Article 5(2) of the Directive, *Adidas-Salomon and Adidas Benelux*, paragraph 30, and *adidas and adidas Benelux*, paragraph 42).

42. Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark's reputation;
- the degree of the earlier mark's distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public.”

58. When considering the section 5(2)(b) ground, I found that the easyJet mark and the applicant's mark shared a low level of visual and aural similarity and were conceptually different. However, for the purposes of a section 5(3) claim, a lesser degree of similarity may be sufficient to establish a link, as the CJEU noted in *Intra-Press SAS v OHIM*, Joined cases C-581/13 P and C-582/13 P:

“The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 49/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHIM*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”¹⁷

59. The easyJet mark has a strong reputation for airline services. In the year ending 31 January 2017, 74.921 million passengers were flown and each previous year the

¹⁷ Paragraph 72.

numbers had risen. The opponent has also provided newspaper articles detailing awards won, sponsorship of Manchester Pride, and a relationship with UNICEF.¹⁸ I do not consider that sufficient evidence has been provided for me to find that it has a reputation for any of the remaining Class 39 services for which it is registered. The inherent distinctiveness of the mark for services related to air travel derives from the combination of the two words, but is weighted more towards “EASY” as “JET” describes the services provided.

60. While the services were identical for the purposes of the section 5(2)(b) ground, they are different here. The opponent submits that:

“Provision of entertainment is a key feature of both the airline and hotel businesses. Indeed, the in-flight entertainment menu is an important differentiator between many airlines. We submit that the use of Mr Easy in relation to entertainment services would call to mind the opponent and therefore establish the necessary link in the minds of consumers.”

61. The opponent has throughout its evidence and submissions emphasised the importance of the “EASY” prefix to its brand identity. The word “EASY” is, as I have already noted in paragraph 38, in itself inherently low in distinctive character. In my view, the low levels of similarity, in particular the difference in the position of the common element “EASY”, the presence/absence of a further word which describes the nature of the services, and the conceptual differences make it unlikely that consumers will make a link with the easyJet mark.

62. Even if I am wrong about the reputation of the easy.com mark for travel-related services, I would find that the average consumer would not make a link between this mark and the contested mark.

Outcome of the section 5(3) ground

63. The section 5(3) ground fails.

¹⁸ Exhibit REP2.

Conclusion

64. The opposition has failed. The application by Asid Reignz Enterprises Limited may proceed to registration in respect of the following services:

Class 41

Entertainment

Costs

65. The applicant has been successful. In the circumstances, I award the applicant the sum of £1000 as a contribution towards its costs. The sum is calculated as follows:

Preparing a statement and considering the other side's statement: £200

Preparing evidence and considering the other side's evidence: £500

Preparation of written submissions: £300

Total: £1000

66. I therefore order easyGroup Limited to pay Asid Reignz Enterprises the sum of £1000. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 20th day of December 2018

Clare Boucher
For the Registrar,
Comptroller-General