

**O-279-20**

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No. 3240568  
BY NATALIE WALDBAUM  
TO REGISTER THE TRADE MARK**



**IN CLASSES 5, 10, 24 & 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 410493 BY  
EASYGROUP LIMITED**

## BACKGROUND

1) On 29 June 2017, Natalie Waldbaum (hereinafter the applicant) applied to register the trade mark shown on the front page of this decision in respect of the following goods:

- In Class 5: Hygienic preparations and articles; sanitary preparations for medical purposes; pharmaceutical and sanitary preparations and substances for infants; infants' foods; nappies for babies and incontinents; feminine hygiene products; breast-nursing pads; absorbent sanitary articles; belts for sanitary napkins [towels]; anti-bacterial preparations; germicidal preparations [other than soap]; antibacterial handwash; babies' diaper-pants; babies' diapers; disposable training pants of paper for infants; shaped napkins of paper for babies; disposable diapers; panty liners; sanitary towels; sanitary pants; reusable sanitary pants; cotton wool in the form of buds for medical use; towels impregnated with medicated or disinfectant lotions; impregnated antiseptic wipes; impregnated medicated wipes; petroleum jelly (for medical purposes); skin care creams for medical use; medicated creams; babies' creams (medicated); medicated skin creams; nappy cream (medicated); sanitising wipes; moist wipes impregnated with a pharmaceutical lotion; antiseptic wipes; medicated balms; teething gel; medicated nipple creams; parts and fittings for all the aforesaid goods.
- In Class 10: Medical dressings and supportive garments; medical nursing bra conversion kit; medical breastfeeding bra; breast pumps for use by nursing mothers; baby bottles; baby feeding systems and baby feeding apparatus; baby feeding implements and containers for baby feeds; breast pumps; teats for baby bottles; battery operated breast pumps; dental care apparatus; flexible and disposable dental trays; teething rings; soothers and pacifiers; baby dummies; teething rings for infants and babies; parts and fittings for the aforesaid goods.
- In Class 24: Textiles and textile goods, not included in other classes; fabrics; coverings for furniture; labels; linens; bed covers; table covers; bath linen, except clothing; bed blankets; bed clothes; bed covers of paper; bed linen; billiard cloth; bolting cloth; brocades; buckram; bunting; calico; canvas for tapestry or embroidery; cheese cloth; chenille fabric; cheviots; cloth; coasters; cotton fabrics; covers for cushions; fabrics for textile use; household linen; lining fabric for shoes; linings; loose covers for furniture; mattress covers; napkins, of cloth, for removing make-up; net curtains; non-woven textile fabrics; sanitary flannel; serviettes of textile; sheets; shower curtains of textile or plastic; shrouds; silk; silk fabrics for printing patterns; table

linen, not of paper; table runners; tablecloths, not of paper; tablemats, not of paper; textile material; towels of textile; traced cloth for embroidery; travelling rugs; tulle; upholstery fabrics; velvet; wall hangings of textile; washing mitts; woolen cloth; zephyr; textiles for making clothing; duvets; duvet covers; pillow covers; bath linen; bed canopies; curtains; blankets; bed blankets made of cotton; bed blankets made of wool; bed blankets made of man-made fibres; baby bedding; blankets for babies; cot blankets; lap blankets; children's blankets; travel blankets; blankets for use in pushchairs, strollers and prams; fabric protectors for baby carriers and car seats; fabric washable drool pads; buggy straps; towel blankets; hooded towels; hooded towels for babies; face towels; children's towels; sleeping bags for babies; pillows; nursing pillows; pillowcases; pillow cover and protectors; parts and fittings for all the aforesaid goods.

- In Class 25: Clothing; footwear; headgear; lingerie; bra; support bra; breastfeeding garments.

2) The application was examined and accepted, and subsequently published for opposition purposes on 7 July 2017 in Trade Marks Journal No.2017/027.

3) On 9 October 2017 easyGroup Limited (hereinafter the opponent) filed a notice of opposition, amended by its letter dated 1 July 2019. The opponent is the proprietor of the following trade marks:

Mark	Number	Dates of filing & registration	Class	Specification relied upon
EASYJET	EU 10584001	24.01.12 09.01.15	3	Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery; essential oils; cosmetics; hair lotions; dentifrices; deodorants for personal use; preparations and substances for use in the care and appearance of the hair, scalp, lips, face, skin, teeth, nails and eyes; cosmetics; non-medicated toilet preparations; shampoos and conditioners; moisturisers; sun-screening and tanning preparations.

			25	Clothing, footwear, headgear.
			39	Transport; packaging and storage of goods; travel arrangement; travel information; provision of car parking facilities; transportation of goods, passengers and travelers by air, land, sea and rail; airline and shipping services; airport check-in services; arranging of transportation of goods, passengers and travelers by land and sea; airline 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 boats; chauffeur services; taxi services; bus services; coach services; rail services; airport transfer services; airport parking services; aircraft parking services; escorting of travelers; travel agency services; tourist office services; advisory and information services relating to the aforesaid services; information services relating to transportation services, travel information and travel booking services provided on-line from a computer database or the Internet.
EASYGROUP	EU 10583111	23.01.12 03.07.14	3	Preparations and substances for use in the care and appearance of the hair, scalp, lips, face, skin, teeth, nails and eyes; cosmetics; non-medicated toilet preparations; perfumes, fragrances, colognes and scents; soaps and cleaning preparations; shampoos, conditioners, moisturisers and rinses; tooth cleaning preparations; depilatory preparations; sun-screening and tanning preparations;

				polishing preparations, dentifrices, bleaching preparations, hair lotions, anti-perspirants, deodorisers and deodorants, cotton wool; essential oils; preparations and substances for use in massage and aromatherapy.
			25	Clothing, footwear, headgear.
			39	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 boats; aircraft parking services; aircraft fuelling 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 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.
EASYFITNESS	EU 14365911	14.07.15 03.05.17	3	Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions,

				dentifrices; aftershave lotions; toiletries; antiperspirants; beauty masks; astringents for cosmetic purposes; breath freshening sprays; cosmetics; cosmetic kits; depilatories; hair lotions; hair spray; shampoos; shaving preparations; soap; nail varnish; varnish removing preparations.
			5	Sanitary preparations for medical purposes; food for babies; plasters; materials for dressings, materials for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides; herbicides.
			44	Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services; hairdressing salons; aromatherapy services; sauna services; solarium services.
EASYHOTEL	EU 10735496	16.03.12 26.07.12	43	temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; hotel services; hotel reservation services; hotel services for the provision of facilities for exhibitions and conferences.

4) The grounds of opposition are, in summary:

- a) The opponent contends that its marks above and the mark applied for are very similar and that the goods applied for are identical / similar to the goods for which the earlier marks are registered. The opponent claims that the class 25 goods are identical, whilst its goods in classes 3 and 44 are similar to those applied for in classes 5 and 10. It also contends that its services in class 43 are similar to all the goods applied for. As such the mark in suit offends against Section 5(2)(b) of the Act.

b) The opponent also contends that it has a considerable reputation in its marks in relation to its services in classes 39 and 43 which relate to transport, travel and accommodation. It states that the similarity between the marks is such that there is a likelihood of consumers assuming a link. It contends that this will enable the applicant to take unfair advantage of the opponent's reputation and free ride on its investment in promoting and advertising the brand. Use of the mark in suit will dilute and tarnish the reputation of the opponent. It contends that the mark in suit offends against section 5(3) of the Act.

5) On 4 April 2019 the applicant filed a counterstatement, basically denying that the goods and services and marks are similar. It puts the opponent to proof of use of its mark EU 10735496.

6) Both parties filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard; Both parties filed written submissions which I shall refer to as and when necessary in my decision.

## **OPPONENT'S EVIDENCE**

7) The opponent filed a witness statement, dated 1 July 2019, by Ryan Edward Pixton, the opponent's Trade Mark Attorney. He does not comment but simply provides four exhibits.

REP1: A witness statement, dated 4 August 2017, by Sir Stelios Haji-Ioannou the founder and Director of Easygroup. This is clearly a generic statement as it references a number of marks which are not relied upon by the opponent in the instant case and does not take into account the relevant date in the instant case. I take the following points from his statement:

- Every company in the group uses the same get-up of “cooper black font and white letters on an orange background”. All businesses in the group are obliged to use this brand identity, and it is set out in the brand licenses.
- From the figures provided it is clear that Easyjet has a reputation for airplane travel and that easyhotel has a reputation for accommodation services.

- Mention is made of easyeverything, easyrentacar and easyvalue amongst others, but the only turnover figures are either insignificant or over fifteen years old i.e. from 2003. It is therefore not possible to judge what if any reputation remains, and as no mention is made of market share of any of these businesses what their reputation was at the time of the last figures.

REP2: A copy of the 2015 annual report for easyhotel which shows turnover of approximately £20million in relation to the provision of accommodation.

REP3: Press articles relating to easyhotel, all of which are after the relevant date

REP4: A copy of a witness statement, dated 4 April 2017, by Christopher Griffin the Chief Executive of the Museum of Brands. He attests to the fame of the “easy” brand which covers a “diverse range of products and services”. He states:

“(3) Each 'easy' brand uses a distinctive style, beginning with the word 'easy' followed by the relevant product or service offered, with its first letter capitalised. For example, the “easy” family of brands include, “easyHotel”, “easyGym”, “easyOffice”, “easyCar”, “easyCoffee” and “easyfoodstore”. I would expect there to be widespread knowledge of the “easy” brand, because of the variety and number of “easy” brands licensed or used by easyGroup.

(4) The widespread licencing of the mark 'easy' into fields as diverse as travel, retail, foodstuff's, gyms and estate agency has led to a recognition that commercial activities with an 'easy' prefix are likely to emanate from easyGroup. This association becomes a certainty where either the colour orange or the font Cooper black is used together with an 'easy' prefixed name, as both the use of the colour orange and the font Cooper lack have become synonymous with the use made by easyGroup.

(5) As an expert in the field, I am particularly conscious of values that consumers are likely to associate with the 'easy' brand, which include excellent value, Innovation, and an entrepreneurial approach, And the brand reaching out to the many, not the few. It is these brand promises that are liable to be tarnished by the offer of an 'easy'-brand service produced by a third party, acting without the authority or control of easyGroup.”

## **APPLICANTS' EVIDENCE**



8) The applicant filed two witness statements, the first, dated 29 August 2019, by the applicant Natalie Waldbaum. She states:

“3. I came up with the name Easy Nurse to identify a specific set of items related to underwear that would assist mothers when nursing their babies, in particular a DIY nursing bra conversion kit. The Easy Nurse Bra Conversion Kit provides the components and full instructions to turn any bra into a breastfeeding bra in just a few simple steps.

4. I am later planning to expand to other breastfeeding related items such as nursing pads, teething, nursing support pillows and breastfeeding garments.

5. Easy Nurse consumers are currently female members of the public, in particular breastfeeding mothers. As can be seen at Exhibit NW1 a print-out of my Etsy shop through which I sell The Easy Nurse Nursing Bra Conversion Kit.”

6. I started using the name Easy Nurse logo on September 2017.”

9) The second witness statement, dated 29 August 2019, is by Rosario Valedéz-Knight the applicant's Trade Mark Attorney who provides a list of previous cases where the EUIPO and UKIPO have decided against the opponent either in inter-partes cases or where registrations of “easy” marks sought by the opponent have been refused due to their being descriptive. She also provides “state of the Register” evidence at RVK3. None of her evidence assists my decision.

10) That concludes my summary of the evidence filed, insofar as I consider it necessary.

## **DECISION**

11) The first ground of opposition is under section 5(2)(b) which reads:

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

(a) .....

- (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.”

12) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

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

13) The opponent is relying upon its four trade marks listed in paragraph 3 above, all of which are clearly earlier trade marks. None of the opponent’s four marks had been registered for five years at the time that the instant mark was published (7 July 2017) and so the proof of use requirements do not bite.

14) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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

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

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

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

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

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

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

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

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

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

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

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

## The average consumer and the nature of the purchasing decision

15) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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:

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

16) The goods at issue in these proceedings are, broadly speaking, Hygienic preparations and articles; pharmaceutical and sanitary preparations; items specifically for babies; textiles; clothing, footwear and headgear. The average consumer for such items will be the public at large including businesses such as retail outlets. Such goods will typically be offered for sale in retail outlets, such as supermarkets, pharmacies and department stores as well as on the internet including ordering by phone. The initial selection is therefore primarily visual. It is possible that the selection will be discussed with a member of staff, or ordered over the phone. The latter, along with personal recommendations, bring aural considerations into play. **Considered overall, the selection process for such goods is likely to be predominantly a visual one, although I accept that aural considerations will also play their part.** Turning now to the level of attention the average consumer will display when selecting these goods, the average cost of such items is, broadly speaking, relatively low, but the average consumer will want to ensure that the goods will meet their, and their babies', particular bodily needs. **To my mind, the average consumer for such goods will be likely to pay a medium degree of attention to the selection of the goods at issue.**

## Comparison of goods and services

17) In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

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

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

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

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

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application

(Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

20) In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

21) In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... 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.”

22) I also note that if the similarity between the goods is not self-evident, it may be necessary to adduce evidence of similarity even if the marks are identical. In *Commercy AG, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07, the General Court pointed out that:

“43. Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan v OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27).”

23) Thus, where the similarity between the respective goods / services is not self-evident, the opponent must show how, and in which respects, they are similar.

24) In carrying out the comparison of the goods and services I must also consider whether they might be considered complementary. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

25) Whilst in *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

26) I shall first consider the class 5 goods applied for by the applicant. For ease of reference the goods of the two parties to be compared are as follows:

Applicant's goods	Opponent's goods	Result
Class 5: Hygienic preparations and articles; sanitary preparations for medical purposes; pharmaceutical and sanitary preparations and substances for infants; anti-bacterial preparations; germicidal preparations [other than soap]; antibacterial handwash; petroleum jelly (for medical purposes); skin care creams for medical use; medicated creams; babies' creams (medicated); medicated skin creams; nappy cream (medicated); medicated balms; teething gel; medicated nipple creams;	EU 14365911: Class 5: Sanitary preparations for medical purposes; disinfectants; preparations for destroying vermin; fungicides; herbicides.	Identical
infants' foods;	food for babies;	Identical
nappies for babies and incontinents; feminine hygiene products; breast-nursing pads; absorbent sanitary articles; belts for sanitary napkins [towels]; babies' diaper-pants; babies diapers; disposable training pants of paper for infants; shaped napkins of paper for babies; disposable diapers; panty liners; sanitary towels; sanitary pants; reusable sanitary pants; cotton wool in the form of buds for medical use; towels impregnated with medicated or disinfectant lotions; impregnated antiseptic wipes; impregnated medicated wipes; sanitising wipes; moist wipes impregnated with a pharmaceutical lotion; antiseptic wipes; parts and fittings for all the aforesaid goods.	Sanitary preparations for medical purposes; disinfectants; preparations for destroying vermin; fungicides; herbicides.  plasters; materials for dressings, materials for stopping teeth, dental wax;	Similar

27) Clearly the specifications of both parties share certain goods which must make them identical. To my mind the terms "Sanitary preparations for medical purposes; disinfectants; preparations for destroying vermin; fungicides; herbicides" encompasses much of the applicant's specification as shown above as medicated items must be regarded as sanitary. Although the opponent does not put forward any reasoning for its contention that all of the class 5 goods are identical, I consider that the



balance of the applicant’s goods as shown above is similar to the “sanitary preparations” of the opponent as they will be sold to the same people, they will be found in close proximity in supermarkets and to a degree are used together to achieve an overall result. The opponent in its TM7 also relied upon the class 44 services shown earlier in this decision. However, it did not mention these in its submissions, and I do not believe it has a stronger case under these services than the goods above.

28) I next turn to the class 10 goods of the applicant. The opponent relies upon its class 5 specification for this comparison.

Applicant’s goods	Opponent’s goods	Result
Class 10: Medical dressings and supportive garments; medical nursing bra conversion kit; medical breastfeeding bra; breast pumps for use by nursing mothers; baby bottles; baby feeding systems and baby feeding apparatus; baby feeding implements and containers for baby feeds; breast pumps; teats for baby bottles; battery operated breast pumps; dental care apparatus; flexible and disposable dental trays; teething rings; soothers and pacifiers; baby dummies; teething rings for infants and babies; parts and fittings for the aforesaid goods.	EU 14365911: Class 5: Sanitary preparations for medical purposes; food for babies; plasters; materials for dressings, materials for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides; herbicides.	Not similar.

29) The opponent contends that these goods would be sold through the same trade channels and sold to the same consumers and as they are complementary. However, the opponent did not file any evidence that such items would share the same trade channels and given the difference between apparatus such as breast pumps and the opponent’s goods it seems unlikely that this would be the case. The charge that the goods would be bought by the same consumers has little value given that I have found the average consumer to be the whole of the UK public. The goods of the two parties are, in my view, not similar. The opponent in its TM7 also relied upon the class 44 services shown earlier in this decision. However, it did not mention these in its submissions, and I do not believe it has a stronger case under these services than the goods above.

30) I next turn to the applicant’s goods in class 24 which the opponent contends are similar to its class 43 services. For ease of reference the goods and services are as follows:

Applicant's Goods	Opponent's services	Result
<p>Class 24: Textiles and textile goods, not included in other classes; fabrics; coverings for furniture; labels; linens; bed covers; table covers; bath linen, except clothing; bed blankets; bed clothes; bed covers of paper; bed linen; billiard cloth; bolting cloth; brocades; buckram; bunting; calico; canvas for tapestry or embroidery; cheese cloth; chenille fabric; cheviots; cloth; coasters; cotton fabrics; covers for cushions; fabrics for textile use; household linen; lining fabric for shoes; linings; loose covers for furniture; mattress covers; napkins, of cloth, for removing make-up; net curtains; non-woven textile fabrics; sanitary flannel; serviettes of textile; sheets; shower curtains of textile or plastic; shrouds; silk; silk fabrics for printing patterns; table linen, not of paper; table runners; tablecloths, not of paper; tablemats, not of paper; textile material; towels of textile; traced cloth for embroidery; travelling rugs; tulle; upholstery fabrics; velvet; wall hangings of textile; washing mitts; woolen cloth; zephyr; textiles for making clothing; duvets; duvet covers; pillow covers; bath linen; bed canopies; curtains; blankets; bed blankets made of cotton; bed blankets made of wool; bed blankets made of man-made fibres; baby bedding; blankets for babies; cot blankets; lap blankets; children's blankets; travel blankets; blankets for use in pushchairs, strollers and prams; fabric protectors for baby carriers and car seats; fabric washable drool pads; buggy straps; towel blankets; hooded towels; hooded towels for babies; face towels; children's towels; sleeping bags for babies; pillows; nursing pillows; pillowcases; pillow cover and protectors; parts and fittings for all the aforesaid goods.</p>	<p>EU 10735496: Class 43: temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; hotel services; hotel reservation services; hotel services for the provision of facilities for exhibitions and conferences.</p>	<p>Not similar</p>

31) The opponent in its submissions contends that the applicant's class 24 goods, "particularly insofar as they cover bedding materials" are similar to its class 43 services as "It is clear that bed linen etc would be found in the type of temporary accommodation and hotel services for which the opponent not only enjoys registered protection but also a reputation. It is part of the opponent's business model

that extra bedding and other linen can be requested and purchased by consumers, so it is clear that there is complementarity there and therefore the possibility of confusion”.

32) Firstly, the opponent did not show that “bed linen and other linen” can be purchased by guests staying in its hotels. Even if had provided such information, it is not clear that the items would carry the EASYHOTEL trade mark or the name of the actual hotel. From my experience if the linen in a hotel has a name upon it, it is invariably the hotel name. I quite understand that certain people would wish to have a reminder of their stay at a high class hotel (Savoy, Dorchester, Claridges etc), perhaps to bring out and place in the guest bathroom prior to the arrival of said guests in a pathetic bid to impress, even though most people would believe such an item to have been stolen. Whilst such items are used in hotels one would not expect that the hotel was responsible for their production, any more than the furniture, phones and televisions in the rooms. The average consumer will be aware that just like the computers at the reception desk such items are simply purchased from retailers as and when required, just like any other business purchases such items. The goods in class 24 of the applicant are not similar to the class 43 services of the opponent and neither are they complementary. The reference to the reputation does not enter into the comparison at this stage. In its TM7 the opponent also relied upon its class 25 goods in relation to the class 24 goods of the applicant. However, it made no mention of this in its submissions only referring to the class 43 services. To my mind, there is no obvious similarity between the goods of the two parties in classes 24 and 25 and in the absence of any evidence or submissions on the matter I look to the comments in paragraphs 22 & 23 above.

33) Lastly, I turn to the class 25 specification applied for:

Applicant's goods	Opponent's goods	Result
Class 25: Clothing; footwear; headgear; lingerie; bra; support bra; breastfeeding garments.	EU 10584001: Clothing, footwear, headgear. EU 10583111: Clothing, footwear, headgear.	Identical

34) Clearly the terms “clothing, footwear and headgear” are in both parties goods and the term “clothing” encompasses the additional items of the applicant’s specification.

### **Distinctive character of the earlier trade mark**

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

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

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

36) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.’

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out".

37) The opponent contends that the marks of the two parties begin with the same prefix "easy". It states that "in the light of the specification of goods and services of the opposed application, it is clear that NURSE is non-distinctive, and descriptive, in relation to the opposed goods and services. The marks therefore coincide in their dominant and distinctive identical prefixes".

38) The applicant submitted:

"8. The Opponent's earlier marks consist of the word EASY conjoined with the ordinary words; JET, GROUP, FITNESS, HOTEL and GYM, each one of these suffixes have a connection with the nature of the services that the Opponent provides under the mark. For example, Easyjet relating to transport, Easyfitness covers fitness services, or Easyhotel covering hotel services. None of those prefixes has a connection whatsoever with the word NURSE which is the word incorporated in the Applicant's mark. If we were to analyze the marks separately, applying the same comparison exercise used by the Opponent, there exists no link between the words 'Jet' with 'Nurse', or 'gym' with 'Nurse', or 'hotel' with 'nurse', or 'fitness' with 'nurse' or even the word 'group' with 'nurse'.

9. Further, the word 'easy' is an ordinary dictionary word that, amongst others, has the meaning of "simple, not difficult or requiring much effort". The use of such a word or the fact that some marks or logos incorporate the word as part of their brands is to try to give an idea that the goods or services covered may be easy to use or obtain. In relation to the Applicant's mark, the combination of the words EASY+NURSE as separate words which include a logo of a woman breastfeeding suggests that the mark has some link to the act of nursing babies. On the other hand, the Opponent's marks, all are conjoined with lifestyle words such as travel, fitness, jet, gym, hotel. The structure of the marks is different, the words as a whole are different not just aurally but also phonetically and conceptually. Further, the image of a woman nursing a baby on the Applicant's mark will clearly distance the marks even more."

39) The opponent submits that EASYJET and EASYHOTEL have become highly distinctive through use in relation to airline services and temporary accommodation respectively, and that the opponent is known for expanding into other business areas under EASY-prefixed marks, such as EASYFITNESS. In its evidence and submissions, the opponent mentions a host of other marks but I note that these marks were not included in the pleadings. The opponent contends that these easy-prefixed marks constitute a family of distinctive marks and by extension the easy-prefix itself has become distinctive, when followed by a descriptive word.

40) I note that in its evidence the founder of the opponent company stated that: "Every company in the group uses the same get-up of "cooper black font and white letters on an orange background". All businesses in the group are obliged to use this brand identity, and it is set out in the brand licenses." I also note that its brand expert in his witness statement said: "Each 'easy' brand uses a distinctive style, beginning with the word 'easy' followed by the relevant product or service offered, with its first letter capitalised." I note that none of the marks registered use the "get-up" described by the founder and which must make a contribution to the distinctive character of these marks. I also note that whilst EASYJET may be descriptive of airline services, in the instant case the opponent is relying upon the mark for class 25 goods and so the word "jet" has no descriptive qualities in relation to such items. The same is true of EASYGROUP which is also relied upon for class 25 goods; and EASYFITNESS which is relied upon for class 5 goods which do not have an obvious connection with fitness. In the instant case each of the three marks mentioned do not conform to the brand ethos outlined by the expert. Clearly, in this case the inherent distinctiveness lies within the whole of each of the marks EASYJET, EASYGROUP and EASYFITNESS as neither of the two words which make up each mark has much distinctive character by itself. This leaves EASYHOTEL which is registered for class 43 services, where the word HOTEL is descriptive. As the applicant points out "EASY" is a basic English word meaning "simple, not difficult or requiring much effort", which is descriptive of the quality of the goods/services covered by the earlier marks and therefore non-distinctive. I agree with this view and that the word is inherently low in distinctive character. Clearly, HOTEL is more descriptive than EASY in relation to temporary accommodation, but this does not mean that it makes no, or only a negligible, contribution to the distinctive character of the composite word mark EASYHOTEL. I find that the inherent distinctive character of EASYHOTEL comes from the combination of the words making up the mark, albeit weighted more on EASY than on HOTEL.

41) I fully accept that EASYJET has a reputation with regard to airline services and that for these services it is highly distinctive, but there is no evidence that it was highly distinctive for goods in class

25. In conclusion EASYJET, EASYGROUP and EASYFITNESS have no more than an average degree of inherent distinctive character, and EASY would not naturally impact on consumers as being the dominant and distinctive element of any of the marks when used upon the goods relied upon in the instant case. Turning to EASYHOTEL I accept that this has a reputation with regard to temporary accommodation and that for these services it is inherently of low distinctiveness but can benefit from enhanced distinctiveness through use.

**Comparison of trade marks**

42) 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 them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

43) It would be wrong, therefore, to artificially dissect the trade 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 them. The trade marks to be compared are:

Opponents’ trade marks	Applicants’ trade mark
EU 10584001: <b>EASYJET</b>	
EU 10583111: <b>EASYGROUP</b>	
EU 10735496: <b>EASYHOTEL</b>	

EU 14365911: **EASYFITNESS**



44) The opponent does not identify one of its marks as being its strongest case, and so I will carry out a comparison of all four marks with the mark in suit. It merely contends that the instant mark has an identical prefix to all of the opponent's marks whilst the term "nurse" is non-distinctive as it is descriptive of the goods in the application. However, the term "nurse" is not descriptive of the whole of the specification applied for e.g. Billiard cloth, bunting, traced cloth for embroidery amongst others.

45) Visually, I accept that the marks of both parties begin with the word EASY, however in the mark in suit it is not conjoined to the second word in the mark. The words in the instant mark are not in plain font capitals but appear hand-written and are in pink which ties in with the pink in the image of a mother nursing a baby. None of the second words of the opponent's mark begin with the letter "N" and one (JET) is much shorter, whilst one (FITNESS) is considerably longer. The other two words in the opponent's marks GROUP and HOTEL are the same length but share only two and one letters respectively. None of the letters in the opponent's marks are in the same place within the word or in the same order where there are two shared letters. None of the opponent's marks has a logo whereas the mark in suit has a very prominent logo which emphasises the wording. **The opponent's marks are, at best, visually similar to a low degree to the mark in suit.**

46) Aurally, all the marks shown above have an identical start, but they are then completely different in terms of the second word. **Aurally, all of the opponent's marks have a medium degree of similarity to the mark in suit.**

47) Regarding conceptual similarity, the opponent points to the common prefix easy and its meaning. I accept that this is the case, but I note that the suffixes have vastly different meanings. The opponent's marks relate to air travel (JET), temporary or hotel accommodation (HOTEL), use of gyms etc. (FITNESS) and a collection of companies (GROUP), whereas the mark in suit relates to caring for



infants. **I have to consider the marks as a whole and as a whole the opponent's marks are not conceptually similar to the mark in suit.**

### **Likelihood of confusion**

48) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer for the goods is the general public including businesses who will select the goods by predominantly visual means, although not discounting aural considerations. They will pay a medium degree of attention to the selection of the goods at issue.
- the marks of the two parties are visually similar to a low degree, aurally similar to a medium degree and conceptually dissimilar.
- the opponent's marks EASYJET, EASYGROUP and EASYFITNESS have an average degree of inherent distinctiveness in relation to the goods for which they are relied upon in the instant case and none can benefit from enhanced distinctiveness through use. EASYHOTEL is of inherently low distinctiveness in relation to temporary accommodation but can benefit from enhanced distinctiveness through use.
- the goods in class 5 of the two parties are identical or similar; the applicant's goods in class 5 are not similar to the opponent's goods in class 10 or services in class 44; the applicant's goods in class 24 are not similar to the opponent's goods in class 25 or services in class 43; the class 25 goods of both parties are identical .

49) It is necessary to consider the likelihood of both direct and indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person, explained that:

“16. 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 recognized 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.”

50) I also note that in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

51) I note that in *The Picasso Estate v OHIM*, Case C-361/04 P, the Court of Justice of the European Union found that:

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

52) I also note that in *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some

minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

53) In view of all of the above, and allowing for the concept of imperfect recollection, despite the identity of some of the goods the differences between the trade marks of the two parties is such that there is no likelihood of consumers being indirectly or directly confused into believing that the goods provided by the applicant are those of the opponent or provided by an undertaking linked to it. **The opposition under Section 5(2) (b) therefore fails.**

54) The opponent has contended that it has a family of EASY marks. However, it has only shown recent use of two marks EASYJET and EASYHOTEL. In *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, the Court of Justice of the European Union stated that:

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

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

64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a

family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family' or 'series', the earlier trade marks which are part of that 'family' or 'series' must be present on the market.

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

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

55) In my opinion two marks do not a family make. I also note that in actual use the opponent requires all licensees to use the same get-up in terms of font and colour which makes a significant difference to the way the marks would be viewed by the average consumer and would merely serve to emphasise the difference between the mark in suit and those of the opponent.

56) I next turn to the ground of opposition under section 5(3) which reads:

"5. (3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

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

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29 and Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L’Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark’s image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court’s answer to question 1 in *L’Oreal v Bellure*).

58) The first hurdle is the issue of reputation as set out at points (a) and (b) above. The onus is upon the opponent to prove that its trade mark enjoys a reputation or public recognition. Earlier in this decision I considered the evidence provided regarding the use of the opponent’s marks and came to the conclusion that it had shown reputation in its EASYJET and EASYHOTEL marks in relation to, broadly speaking, airline services and temporary accommodation/hotel services respectively. The opponent has not shown that it has reputation in relation to EASYGROUP or EASYFITNESS in respect of any goods or services. The reputation in EASYJET and EASYHOTEL is in the mark in full, the opponent has not shown that it has reputation in the term EASY. I also note that the marks are registered in plain font in capital letters, yet it is clear from the evidence that any use of these marks would be in the cooper font and in white letters on an orange background. However, for the sake of the instant case I will assume that the opponent has a reputation in the marks as registered.

59) I now turn to stage two where I have to consider whether the public will make a link. In Case C-408/01, *Adidas-Salomon*, the CJEU held that:

“28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual

similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

60) The level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion. In *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, the CJEU stated (at paragraph 72 of its judgment) that:

“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 40/94 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 OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

61) Earlier in this decision I found that the marks of the two parties are visually similar to a low degree, aurally similar to a medium degree and conceptually dissimilar. Although the goods and services of the two parties do not need to be similar under this opposition heading, the degree of closeness or dissimilarity between the goods and services is a factor I need to consider. Although the users of the applicant’s goods may also consume the opponent’s airline and hotel services the goods and services of the two parties are dissimilar. In my opinion, given all the above, it is unlikely that

consumers will make any link between the marks in use. **As such the opposition under section 5(3) must fail.**

## **CONCLUSION**

62) The opposition under sections 5(2)(b) and 5(3) have failed.

## **COSTS**

63) As the applicant has been successful it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
Preparing evidence / considering and commenting upon the applicant's evidence	£800
Provision of submissions	£500
<b>TOTAL</b>	<b>£1,600</b>

64) I order EASYHROUP Limited to pay Natalie Waldbaum the sum of £1,600. This sum is to be paid within two months of the expiry of the appeal period or within twenty one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 12<sup>th</sup> day of May 2020**

**George W Salthouse**  
**For the Registrar,**  
**the Comptroller-General**