

O/696/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3593205

BY EASYGROUP LTD

FOR THE TRADE MARK:

EASYRIDER

IN CLASSES 16, 39 & 41

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 425680

BY ER ASSETS, LP

BACKGROUND AND PLEADINGS

1. easyGroup Ltd (“the Applicant”) applied to register the trade mark **EASYRIDER** in the UK on 9 February 2021. It was accepted and published in the Trade Marks Journal for opposition purposes on 30 April 2021, for the following goods and services:

Class 16: Printed matter and publications; books, manuals, pamphlets, newsletters, brochures, albums, newspapers, magazines and periodicals; tickets, vouchers, coupons and travel documents; documents, tickets and publications, all relating to travel arranged by means of the world-wide web; travel documents folders; travel guide books; travellers cheques; identity cards, not encoded; labels and tags; posters, postcards, stationery, writing instruments, wrapping materials, calendars, diaries, photographs, gift cards and greetings cards; cardboard badges, paper badges, paper name badges; teaching and instructional materials; promotional and advertising material; signs of paper or cardboard.

Class 39: Transport; packaging and storage of goods; travel arrangement; travel information; provision of car parking facilities; transportation of goods, passengers, animals, pets, travelers by air, land, sea and rail; pet rescue services; transport of pets; transportation of animals; transportation of pet animals; airline and shipping services; airport check-in services; arranging of transportation of goods, passengers, animals, pets 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 for arranging travel; 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; delivery, collection, transport, forwarding and courier services; food and drink delivery, storage, collection, transport, forwarding and courier services; collection, transport, delivery, forwarding and courier services

relating to goods, packages, gifts, parcels, documents, post, mail, correspondence, advertising materials; provision of information, advisory and consultancy services in relation to the aforesaid services.

Class 41: Educational services; providing of training; sporting and cultural activities; educational services provided by means of a computer network; teaching; publishing; non-downloadable electronic publications; production of television programmes; entertainment services; fitness instruction and tuition; group fitness and exercise classes; personal training services; provision of gymnasium facilities; gymnasium services relating to body building; gymnasium services relating to weight training; life coaching services; education relating to nutrition; provision of educational information relating to fitness, exercise, diet, health and nutrition; entertainment information services; health club services; gymnasium services; gymnasium club services; sports club services; nutrition coaching; weight management coaching; organisation of sports competitions; physical education services; providing sports facilities; provision of recreation facilities; rental of sports equipment; rental of tennis courts; rental of squash courts; booking of sports facilities; arranging and conducting workshops; hosting of sports leagues; entertainment services in the nature of the hosting of an online sports league; teaching of pet care; animal training; tuition in animal training; provision of social club services; providing cultural activities; leisure services; publication of newsletters, catalogues and brochures; play schemes (entertainment/education); providing animal exercise services; hire of animals for recreational purposes; advisory, consultancy and information services relating to all the aforesaid services.

2. On 21 July 2021, ER Assets, LP, (“the Opponent”) opposed the application pursuant to section 5(2)(b) and section 5(3) of the Trade Marks Act 1994 (“the Act”).
3. Under section 5(2)(b), the opposition relates only to the applicant’s class 16 goods and class 41 services. Under section 5(3) the opposition is raised against all of the applied for goods and services under the contested application.
4. The opponent relies on three marks for the purposes of both grounds of opposition, namely: UK1109370, UK904287215 and UK900178715, all of which are registered for the mark EASYRIDERS. 1109370 was filed on 12 February 1979 and registered on

the same date. 900178715 was filed on 01 April 1996 and registered on 20 April 2004. 904287215 was filed on 14 February 2005 and registered on 10 December 2008.

5. The opponent relies on the following goods under 1109370:

Class 16: Printed matter, periodical publications, and printed publications, all relating to motorcycling.

6. The opponent relies on the following goods under 900178715:

Class 16: Printed matter; magazines.

7. The opponent relies on the following goods under UK 904287215:

Class 09: Electronic publications, namely, magazines, directed to readers and viewers interested in motorcycles, motorcycle customization, the American motorcycle lifestyle and related subjects, recorded on computer media in this class.

8. Use is claimed in respect of all of the goods relied upon, and the opponent claims a reputation in all of the goods relied upon for the purposes of section 5(3).

9. In its statement of grounds the opponent claims that under section 5(2)(b) the contested application should be refused in respect of classes 16 and 41, as there exists a likelihood of confusion between the three earlier UK registrations, collectively the 'EASYRIDERS' registrations, and the contested mark EASYRIDER, which it states are virtually identical.

10. It also asserts that the goods and services under the application in classes 16 and 41 are all identical or similar to the goods covered by the EASYRIDERS registrations, because the majority of the applicant's class 16 goods are identical to the earlier class 16 goods, all being printed matter. It adds that any of the contested goods that are not found to be identical must be highly similar as they would be sold through the same channels, in close proximity, and to the same end users, e.g. a consumer would expect to purchase stationery and writing instruments from the same stores as printed matter such as notepads and greetings cards.

11. The opponent also claims that the contested class 41 services relate largely to entertainment or education and that magazines, periodicals and other types of printed publications are products serving the same purposes. As a result, it submits that they are similar in nature and intended purpose and they may also be in competition, e.g. a consumer might choose to purchase a printed or electronic instructional manual or guide book instead of attending a course, or vice-versa. It is common, the opponent states, for undertakings to offer both an educational course or entertainment event, and a corresponding book, magazine or pamphlet to accompany it. It submits that these goods and services would be offered to the same end-users, and consumers would expect them to originate from the same or economically linked undertakings.

12. The opponent also states that the contested 'publication of newsletters, catalogues and brochures' services are also similar to its earlier goods, as it is common for the same undertakings to be responsible for the sale of printed or electronic publications and their publishing. For example, it asserts that undertakings which produce and sell magazines will often be the same, and there is therefore a level of complementarity between those goods and services.

13. The opponent states that as the marks are so similar and the goods and services are also similar and closely related, there exists a significant likelihood of confusion, including a likelihood of association. The risk of confusion is, it states, further increased by the enhanced level of distinctive character of the earlier mark, which results from the significant use that has been made of it.

14. Under section 5(3) the opponent claims that the contested mark should be refused entirely, as use of the later mark without due cause would be detrimental to the reputation and distinctive character of the earlier registrations and would take unfair advantage of them.

15. In this regard, the opponent states that it has "longstanding rights in the mark EASYRIDERS. The mark has been used in respect of a magazine for more than 50 years. EASYRIDERS was established in 1970 as a platform for motorcycle enthusiasts to immerse in the rugged, on-the-road lifestyle championed by the counterculture movement...".

16. It adds that “Having originally been published monthly, the magazine is now published in the form of a quarterly coffee table-style book. As a result of the extensive use made, and the high quality of the opponent’s products, the EASYRIDERS mark has acquired a significant reputation”. The opponent claims that when seeing the contested mark in respect of the goods and services in issue, consumers will assume that the applicant’s goods and services originate from the opponent. The assumption of a connection is inevitable, the opponent asserts. It adds that use of the later mark will ride on the coattails of the reputation of the earlier mark and the applicant will unfairly benefit from the quality brand image created by the opponent. Further, it asserts that use of the later mark will bring detriment to the reputation and distinctive character of the earlier mark.

17. Given their filing dates, the opponent’s marks are all earlier marks in accordance with section 6 of the Act. As all three earlier marks had completed their respective registration process more than five years before the filing date of the contested application, they are all subject to the proof of use provisions contained in section 6A of the Act.

18. In response the applicant submitted a counterstatement on 27 September 2021 in which it put the opponent to proof of use in respect of all three earlier marks relied upon. It also requested proof of the claimed reputation the opponent relies on for the purposes of section 5(3). The applicant also denied all of the claims made by the opponent in respect of both section 5(2)(b) and section 5(3).

19. The applicant is represented by Kilburn & Strode LLP and the opponent is represented by Mewburn Ellis LLP. Neither party requested a hearing, but both filed evidence and written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE

20. The opponent’s evidence in chief comprises a witness statement from Mark Swan, who has been the Import Group Account Manager at Seymour Distribution Ltd (“Seymour”) since 2017 and prior to that was the Import Sales Manager at COMAG Magazine Distribution Ltd (“COMAG”). Mr Swan had been asked to provide evidence

relating specifically to the EASYRIDERS trade mark, in support of the opponent's case, between 9 February 2016 and 9 February 2021 (the relevant period in which to show proof of use is between 10 February 2016 and 9 February 2021, which is the application's filing date).

21. Mr Swan's witness statement is dated 29 December 2021 and is accompanied by exhibits MS1-MS3 and MS4a-MS4b.

22. Mr Swan states that he is aware that the opponent's earlier mark EASYRIDERS has been used in the UK by the opponent during the relevant period. He states that the "well-known magazine bearing the trade mark was imported from the USA and placed on sale in numerous stores throughout the UK."

23. Mr Swan states that his employer Seymour is part of a larger group that is a magazine distributor based in the UK and is the preferred choice of distributor for independent magazine publishers. He adds that Seymour is the largest importer of foreign magazine titles into the UK, including the EASYRIDERS magazine of the opponent. Mr Swan states that COMAG was a market leading magazine distribution company that managed the UK's largest portfolio of imported press clients before it ceased trading in 2017. He adds that much of the information regarding the EASYRIDERS magazine distribution during the relevant period is no longer available but that he has been able to provide information from more recent use from the records at Seymour.

24. Mr Swan states that the mark EASYRIDERS appears prominently on the magazine front cover. He submits that Exhibit MS1 is a folder containing front covers of the EASYRIDERS magazine during the relevant period. Exhibit MS2 Mr Swan states, provides a breakdown of UK stores that received copies, and their respective sales of the EASYRIDERS magazine from 2019-2021. Whilst this information is limited to three years, Mr Swan states that as far as he is aware the opponent's magazine has been on sale in the UK for at least 15 years. Mr Swan submits that sales of the opponent's magazine have been largely through independent retailers including service stations, but also via some well-known high street retailers such as WH Smith and Martins McColl.

25. Mr Swan submits that Exhibit MS3 comprises an estimated sales report. He asserts that this information is the industry guide on how titles sell. He adds that they tend to be fairly accurate. This information shows that the EASYRIDERS magazine has been on sale in the UK at certain dates. He adds that a magazine will remain on sale until the next issue replaces it, which is generally up to 16 weeks on display. Mr Swan states that the information in Exhibits MS1 – MS3 show that the opponent's magazine has retailed in the UK for between £6.25 and £9.5, making it one of the most expensive magazines of its type.

26. Mr Swan states that Exhibits MS4a and MS4b comprise two presentations which provide market analysis of the UK industry sector and sales information specific to the performance of the EASYRIDERS magazine in the UK. Mr Swan asserts that Exhibit MS4a shows that the EASYRIDERS magazine sits in 4th place in the sub-sector of motorcycling-biker magazines.

27. Having carefully examined the evidence provided under Mr Swan's witness statement I conclude that Exhibit MS1 comprises a selection of magazine front covers dated between July 2019 and February 2016, with prices of £6.25; £7.50 and £9.50. It isn't always possible to see the whole word 'EASYRIDERS' on the front cover, but it is reasonably clear that this is the title of the publication. The name EASYRIDERS is also shown on the barcodes that appear on the lower part of each front cover, in plain text. The opponent claims in submissions that this exhibit also shows use on posters and calendars, however this is not clear to me at all.

28. Exhibit MS2 comprises figures showing sales of the opponent's magazine in the UK. It contains 13 pages of figures and columns that can be broken down into three sections. The first section is headed: 'EASYRIDERS SEP 19'. This section comprises pages 2 – 7 of Exhibit MS2 and shows that in total there were 456 sales of the magazine across the UK. This exhibit also provides store details with addresses that support sales widely across the UK. However, in his witness statement Mr Swan states that the information in Exhibit MS2 provides sales figures of the opponent's magazine across three years 2019 – 2021. It is therefore a little unclear as to whether the figures provided under 'SEP 19' show sales of 456 copies of the magazine in the whole of 2019 or merely the month of September 2019.

29. The second section of Exhibit MS2 runs from page 8 to 11 and is headed “EASYRIDERS #01 20”. This section of Exhibit MS2 shows sales of 314 copies of the EASYRIDERS magazine. It is again unclear whether this information covers the entire calendar year 2020 or just January 2020. The final section of Exhibit MS2 runs from page 12 to 14 and is headed “EASYRIDERS FALL 21”. This section shows sales of 230 copies of the magazine.

30. Exhibit MS3 is comprised a single page that looks like this:

Competitor Title Analysis

Page by:
Magazine: EASYRIDERS

On Sale Date	Issue Description	Issue Cover Price	National Supply	National Sales	National Returns	National Sales Efficiency	National RSV
07/02/2017	Feb-17	£6.25	814	249	565	30.59%	£1,556.25
28/02/2017	Mar-17	£6.25	807	287	520	35.56%	£1,793.75
22/03/2017	Apr-17	£6.25	882	314	568	35.60%	£1,962.50
21/04/2017	May-17	£6.25	904	302	602	33.41%	£1,887.50
12/05/2017	Jun-17	£7.50	959	268	691	27.95%	£2,010.00
13/06/2017	Jul-17	£7.50	822	256	566	31.14%	£1,920.00
07/07/2017	Aug-17	£7.50	923	246	677	26.65%	£1,845.00
04/08/2017	Sep-17	£7.50	876	251	625	28.65%	£1,882.50
01/09/2017	Oct-17	£7.50	1,190	301	889	25.29%	£2,257.50
24/10/2017	Nov-17	£7.50	1,009	305	704	30.23%	£2,287.50
13/12/2017	Dec-17	£7.50	872	306	566	35.09%	£2,295.00
22/12/2017	Jan-18	£7.50	1,133	324	809	28.60%	£2,430.00
19/01/2018	FEB 18	£7.50	897	261	636	29.10%	£1,957.50
20/02/2018	MAR 18	£7.50	997	307	690	30.79%	£2,302.50
29/03/2018	APR 18	£7.50	1,198	305	893	25.46%	£2,287.50
24/04/2018	MAY 18	£7.50	1,149	285	864	24.80%	£2,137.50
30/05/2018	JUN 18	£7.50	1,224	236	988	19.28%	£1,770.00
15/06/2018	JUL 18	£7.50	1,233	310	923	25.14%	£2,325.00
31/07/2018	AUG 18	£7.50	802	249	553	31.05%	£1,867.50
28/08/2018	SEP 18	£7.50	817	254	563	31.09%	£1,905.00
28/09/2018	OCT 18	£9.50	902	249	653	27.61%	£2,365.50
02/11/2018	NOV 18	£7.50	837	224	613	26.76%	£1,680.00
30/11/2018	DEC 18	£7.50	824	257	567	31.19%	£1,927.50
08/01/2019	JAN 19	£9.50	840	243	597	28.93%	£2,308.50
15/02/2019	FEB 19	£7.50	857	199	658	23.22%	£1,492.50
07/03/2019	MAR 19	£7.50	862	219	643	25.41%	£1,642.50
04/04/2019	APR 19	£9.50	739	236	503	31.94%	£2,242.00
30/04/2019	MAY 19	£7.50	738	212	526	28.73%	£1,590.00
30/05/2019	JUN 19	£7.50	722	204	518	28.25%	£1,530.00
28/06/2019	JUL 19	£7.50	744	215	529	28.90%	£1,612.50
30/07/2019	AUG 19	£7.50	608	224	384	36.84%	£1,680.00
29/08/2019	SEP 19	£7.50	549	289	260	52.64%	£2,167.50
11/02/2020	#01 20	£18.00	489	135	354	27.61%	£2,430.00
27/08/2021	FALL 21	£14.99	256	133	123	51.95%	£1,993.67

31. According to Mr Swan, the information provided in Exhibit MS3 is an estimated sales report which shows that the EASYRIDERS magazine has been on sale in the UK between February 2017 and late in 2021. The total number of sales of the EASYRIDERS magazine between February 2017 and July 2021 appears to be 8387 copies with a total sales value of £65,348.

32. Exhibit MS4a shows sales of the EASYRIDERS magazine from 2016 with monthly figures of sales between 300-440 copies (page 8 of MS4a). 63% of sales come from independent retailers (page 12 of MS4a).

33. I note that the table at the top of page 12 of Exhibit MS4a provides sales figures for the same periods of time as the table set out above, e.g. 07/02/2017 and 12/05/2017. That table looks like this:

RETAILER PERFORMANCE – EASYRIDERS

Parent Retail Multiple: INDEPENDENT											
On sale	Issue	Supply	Supply Market Share	Sales	Sales Market Share	Returns	Sales Efficiency	Handling	Supply Per Store	Sales Per Store	Sales Value
Average		585	63.35%	180	63.20%	405	31.13%	285	2.08	0.65	£1,280.48
07/02/2017	01/02/2017	502	62.13%	163	65.73%	339	32.47%	270	1.86	0.60	£1,018.75
28/02/2017	01/03/2017	463	57.80%	176	61.75%	287	38.01%	241	1.92	0.73	£1,100.00
22/03/2017	01/04/2017	538	61.42%	205	65.71%	333	38.10%	258	2.09	0.79	£1,281.25
21/04/2017	01/05/2017	536	60.22%	179	59.08%	357	33.40%	253	2.12	0.71	£1,118.75
12/05/2017	01/06/2017	566	59.83%	160	60.61%	406	28.27%	239	2.37	0.67	£1,200.00
13/06/2017	01/07/2017	490	60.34%	166	64.34%	324	33.88%	219	2.24	0.76	£1,245.00
07/07/2017	01/08/2017	561	61.65%	160	63.24%	401	28.52%	231	2.43	0.69	£1,200.00
04/08/2017	01/09/2017	518	59.95%	149	59.36%	369	28.76%	216	2.40	0.69	£1,117.50
01/09/2017	01/10/2017	801	65.87%	218	63.56%	583	27.22%	394	2.03	0.55	£1,635.00
24/10/2017	01/12/2017	695	69.78%	198	64.92%	497	28.49%	367	1.89	0.54	£1,485.00
13/12/2017	JAN 18	671	69.82%	194	62.99%	477	28.91%	349	1.92	0.56	£1,455.00
19/01/2018	FEB 18	609	67.97%	168	64.37%	441	27.59%	324	1.88	0.52	£1,260.00
20/02/2018	MAR 18	656	66.73%	204	66.02%	452	31.10%	342	1.92	0.60	£1,530.00

34. However, the sales figures in these two tables, although apparently covering the same periods, differ quite significantly. For example, for the period 24/10/2017 in Exhibit MS3 the national supply of EASYRIDERS magazine was 1009, but the figure provided in the table on page 12 of Exhibit MS4a is 695. Sales of copies in that period in the table from Exhibit MS3 are shown as 305 but in the table on page 12 of Exhibit MS4a sales were shown as 198. Sales value of the magazines sold in the period 24/10/2017 are shown in Exhibit MS3 as £2287.50 but the figure provided on page 12 of Exhibit MS4A is £1485.

35. Exhibit MS4a also shows in a table on page 16, that between January and December 2017 the opponent sold 3,271 copies of EASYRIDERS, with a sales value of £23,093.

36. Exhibit MS4b comprises similar material to that provided under MS4a. There are similar issues between the sales figures provided under MS4b and those provided, for the same periods of time, under MS3, these figures do not match. For example, the table on page 9 of MS4b provides information about sales in the period 30/11/2018 which is labelled as 'DEC18'. The sales figures for that period in that table are 286 copies. However, on page 10 of MS4b there are 3 tables which separate out the sales of the magazine by retailer. When adding those three retailers sales figures together for the same 'DEC18' period, copies sold amount to 200. When compared with the table in MS3 and sales of the magazine again for the 'DEC18' period, that exhibit (MS3) provides a sales figure of 257.

37. Exhibit MS4b also shows in a table on page 11, that between February 2018 and January 2019 the opponent sold 2,919 copies of EASYRIDERS magazine, with a sales value of £22,877.

38. The opponent provided further evidence in the form of Witness Statements from Beverly Barragan Barresi and Anthony Dibisceglie, and Exhibit AD1.

39. In her Witness Statement, dated 27 January 2022, Ms Barresi states that she is the Vice President of Teresi Publications, Inc., a General Partner of the opponent ER Assets, LP. She states that the opponent's EASYRIDERS magazine is printed in the United States and exported and sold in the UK. She states that it has been sold in the UK since June 1979. Due to the success of the magazine in the UK since 1979, Ms Barresi claims that the name EASYRIDERS has built up valuable goodwill and reputation.

40. She adds that the opponent has engaged a company called PWX Solutions as its representative for its news stand relations regarding the EASYRIDERS magazine, stating that PWX, and its predecessor ProCirc, has been the opponent's news stand consultant for the EASYRIDERS magazine for at least 20 years and is responsible for the opponent's marketing and publishing activities in the US and overseas, including the UK.

41. In his Witness Statement, dated 28 January 2022, Mr Dibisceglie states that he is the Vice President, Retail Services Group at PWX Solutions, previously known as ProCirc. Mr Dibisceglie states that PWX has been the opponent's newsstand circulation consultant for at least 10 years and that the EASYRIDERS magazine has been on sale in the UK for approximately 40 years. Exhibit AD1 provides samples of front covers of the EASYRIDERS magazine with UK pricing in various years between 1979 and 2013.

42. In response, the applicant filed evidence in the form of a Witness Statement of Ryan Edward Pixton dated 31 March 2022. Mr Pixton is a trade mark attorney with Kilburn & Strode who represent the applicant. Mr Pixton's Witness Statement is accompanied by four Exhibits REP1 – REP4. In his evidence Mr Pixton provides information pertaining to the applicant's use of the contested mark EASYRIDER.

43. The opponent filed further evidence in the form of a Witness Statement of Joanne Elaine Goodchild, dated 19 May 2022. Ms Goodchild is a trade mark attorney with Mewburn Ellis LLP, who represent the opponent. In her Witness Statement Ms Goodchild effectively dismisses the evidence provided by Mr Pixton.

44. As noted above, both parties also filed submissions in lieu of a hearing. I do not propose to summarise those submissions here. However, I have taken them into consideration and will refer to them below where necessary.

DECISION

Proof of Use

45. Relevant statutory provision: Section 6A:

“(1) This section applies where:

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

46. As two of the earlier marks are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

47. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm*

Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG [EU:C:2013:592], [2014] ETMR, Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21].

But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

48. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

49. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

50. Having considered the evidence of the opponent carefully and taking into account the relevant case law set out above, I conclude that the opponent has shown genuine use of the earlier mark, but only on some of the goods relied upon. Despite the inconsistencies in the evidence outlined above, it is sufficiently clear that there has been longstanding and continuous use of the mark in the UK and a significant number of magazines have been sold during the relevant period

51. In its submissions in lieu of a hearing the applicant has provided detailed commentary on the opponent's evidence, which I have considered at length. Whilst I do not accept the claim that the evidence is so "severely deficient" that the opponent has "failed to discharge its obligation to prove use of its registered marks", I do agree with the applicant's submissions regarding the scope of the specifications. In fact, I find that I am slightly more restrictive in my assessment of an 'effective specification' than the applicant has been.

52. I agree with the applicant that no evidence at all has been provided to support earlier mark 904287215 and the goods in class 09, on which the opponent relies. The goods relied upon under this mark are: *Electronic publications, namely, magazines, directed to readers and viewers interested in motorcycles, motorcycle customization, the American motorcycle lifestyle and related subjects, recorded on computer media in this class.* The evidence submitted relates solely to traditional paper copy magazines and there is no evidence at all to support a claim that the opponent provides electronic versions of its EASYRIDERS magazine. Therefore, the opponent may not rely on this earlier mark at all.

53. The evidence does show that the opponent has, within the relevant period of time, sold a reasonable number of magazines that are entirely focussed on motorcycling across the UK. I note for example, that the total number of sales of the EASYRIDERS magazine between February 2017 and July 2021 was 8387 copies, with a sales value of £65,348. The evidence also shows that sales of the opponent's magazine have taken place widely across the relevant territory. Whilst the evidence is deficient in places, when considered in the round I find it to be sufficient to prove use of the earlier mark on very limited goods.

54. Having found that the evidence of the opponent proves genuine use of the mark EASYRIDERS on some of the goods relied upon under **1109370** and **900178715**, I must now determine what goods the opponent may fairly rely upon for the purposes of the section 5(2)(b) ground of opposition.

Fair Specification

55. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

56. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme

Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

57. Having determined that the opponent may no longer rely on earlier mark 904287215 due to a lack of evidence, I will consider the remaining two earlier marks only. Under 1109370 the opponent relies on the following goods: *Printed matter, periodical publications, and printed publications, all relating to motorcycling*. Under 900178715 the opponent relies on: *Printed matter; magazines*.

58. The evidence provided by the opponent has shown genuine use of the earlier mark EASYRIDERS on magazines all relating to motorcycling, and nothing more. Clearly the goods registered under 900178715 are extremely broad and, whilst they encompass 'magazines relating to motorcycling', I do not accept that the opponent should be able to rely on the broader categories of 'printed matter' or 'magazines' *per se*. Nor do I consider the 'printed publications' of 1109370 to be an acceptable category, given the broad nature of the term 'publications'.

59. I have considered the case law above carefully and I take note of the comments of Mr Justice Carr in *Property Renaissance* in respect of categories of goods, and the comments of Mr Hobbs Q.C. In *Euro Gida*, where he said: "...the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned." I find that the average consumer of magazines will be someone with a specific area or field of interest in mind. In this instance the focus of the opponent is clearly motorcycling. It has stated that this is its area of interest, and the evidence it has provided supports that niche field and nothing wider.

60. That being the case, I believe that it would be overly generous to suggest that in this matter the opponent's 'fair specification' should go any wider than 'magazines and periodical publications all relating to motorcycling'. The evidence submitted has shown that the opponent has produced and sold traditional, hard copy paper magazines in the US and UK for more than 40 years, however the evidence also supports my conclusion that there has apparently never been any desire or attempt on the part of the opponent to widen the scope of the content within its EASYRIDERS magazine, away from motorcycling as a constant theme, and that consequently a wider specification is unnecessary in this instance.

61. I conclude therefore, that for the purposes of the opposition under section 5(2)(b), the opponent may rely only on the following goods under both earlier marks:

Class 16: *Magazines and periodical publications, all relating to motorcycling.*

Section 5(2)(b)

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

"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."

The principles

63. The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) 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:¹

- (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;

¹ Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

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

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

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

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

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

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

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

Comparison of goods and services

64. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

“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”.

65. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective users of the respective goods or services;
- (b) The physical nature of the goods or acts of services;
- (c) The respective trade channels through which the goods or services reach the market;
- (d) 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;
- (e) 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.

66. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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 fur 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”.

67. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC 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”.²

68. Following my earlier findings regarding a fair specification, the goods and services at issue are:

Opponent's goods	Contested goods and services
<p>Class 16: Magazines and periodical publications, all relating to motorcycling.</p>	<p>Class 16: Printed matter and publications; books, manuals, pamphlets, newsletters, brochures, albums, newspapers, magazines and periodicals; tickets, vouchers, coupons and travel documents; documents, tickets and publications, all relating to travel arranged by means of the world-wide web; travel documents folders; travel guide books; travellers cheques; identity cards, not encoded; labels and tags; posters, postcards, stationery, writing instruments, wrapping materials, calendars, diaries, photographs, gift cards and greetings cards; cardboard badges, paper badges, paper name badges; teaching and instructional materials; promotional and advertising material; signs of paper or cardboard.</p> <p>Class 41: Educational services; providing of training; sporting and cultural activities; educational services provided by means of a computer</p>

² Paragraph 82

	<p>network; teaching; publishing; non-downloadable electronic publications; production of television programmes; entertainment services; fitness instruction and tuition; group fitness and exercise classes; personal training services; provision of gymnasium facilities; gymnasium services relating to body building; gymnasium services relating to weight training; life coaching services; education relating to nutrition; provision of educational information relating to fitness, exercise, diet, health and nutrition; entertainment information services; health club services; gymnasium services; gymnasium club services; sports club services; nutrition coaching; weight management coaching; organisation of sports competitions; physical education services; providing sports facilities; provision of recreation facilities; rental of sports equipment; rental of tennis courts; rental of squash courts; booking of sports facilities; arranging and conducting workshops; hosting of sports leagues; entertainment services in the nature of the hosting of an online sports league; teaching of pet care; animal training; tuition in animal training; provision of social club services; providing cultural activities; leisure services; publication of newsletters, catalogues and brochures;</p>
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	play schemes (entertainment/education); providing animal exercise services; hire of animals for recreational purposes; advisory, consultancy and information services relating to all the aforesaid services.
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69. The contested goods: *Printed matter and publications; books, manuals, pamphlets, newsletters, brochures, albums, newspapers, magazines and periodicals* are printed goods which are unlimited in the scope of their content and may therefore relate to motorcycling. The opponents *Magazines and periodical publications, all relating to motorcycling* are also printed goods. As the contested goods share nature, purpose, channels of trade, end-user and may contain identical content, these goods, when applying the principle set down in *Meric*, are identical. If they are not identical, these goods must be highly similar.

70. None of the remaining contested goods in class 16 can be said to be similar to the earlier goods *Magazines and periodical publications, all relating to motorcycling*. The opponent has claimed that consumers will purchase e.g. stationery or writing instruments from the same outlets as magazines and that this will create a connection between the goods to the degree that consumers would expect an economic connection. I disagree with this suggestion. I find that the remaining contested goods, even those of a printed nature such as a ticket, voucher, poster or travel guide, do not share purpose, end-user or manufacturer. These goods are not in competition and cannot be said to be complementary. Other than those goods set out above which I conclude to be identical (or highly similar), the remaining contested goods in class 16 are considered to be dissimilar.

71. Regarding the contested class 41 services of the applicant, these are largely completely unrelated to the opponent's earlier class 16 goods. I find that the only contested services that may possibly be said to have any connection with the earlier *Magazines and periodical publications, all relating to motorcycling* are: '*Publishing*;

publication of newsletters, catalogues and brochures and *'Non-downloadable electronic publications'*.

72. I find that the contested 'publishing' and 'publication of newsletters, catalogues and brochures' are services that provide finished printed goods for sale or distribution. Whilst it may be the case that a publisher will go on and provide printed products for sale in the market itself, the printed products may also be sourced by a third-party and then subsequently passed on to the end user. These goods and services are similar, but to only a low degree. They may also be said to be complementary, in the sense that one is important and indispensable to the other in such a way that the average consumer will expect an economic link between the undertakings providing both goods and services.³ Therefore, I find that these services are similar to a low degree and complementary to the earlier *Magazines and periodical publications, all relating to motorcycling*

73. The contested 'Non-downloadable electronic publications' are publications provided electronically. They may share purpose, end-user and provider with the earlier goods. Effectively these services provide an electronic version of a publication that can be purchased and read from an electronic device, rather than in the more traditional manner with a paper copy. These services are similar to the opponent's earlier goods to a medium degree.

74. The remaining contested class 41 services are far removed from the earlier goods of the opponent to the degree that I do not feel it necessary to make a detailed comparison between them. It is evidently clear that e.g. nutrition coaching; organisation of sports competitions; rental of tennis courts; teaching of pet care; animal training; tuition in animal training; provision of social club services; have nothing in common with the earlier goods *Magazines and periodical publications, all relating to motorcycling*.

75. In conclusion, the following contested goods and services have been found to be identical/highly similar, similar to a medium degree, similar to a low degree and complementary:

³ *Boston Scientific Ltd v OHIM*, Case T-325/06

Class 16: Printed matter and publications; books, manuals, pamphlets, newsletters, brochures, albums, newspapers, magazines and periodicals.

Class 41: Publishing; publication of newsletters, catalogues and brochures; non-downloadable electronic publications.

76. All of the other contested goods and services in classes 16 and 41 have been found to be dissimilar.

The average consumer and the purchasing process

77. 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. (as he was then) 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”.⁴

78. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

79. In respect of printed matter and publications; books, manuals, pamphlets, newsletters, brochures, albums, newspapers, magazines and periodicals; non-downloadable electronic publications; I find the average consumer will be the general public who will pay no more than a medium degree of attention when choosing such products. These are products purchased on a fairly frequent basis and cannot be said to be particularly expensive. The selection of these products will be primarily a visual process from high street retail outlets, service stations and specialist retailers such as WH Smith. The electronic products will be purchased online using a computer or

⁴ Paragraph 60.

mobile device and will also largely be a visual purchase. I do not however, discount a verbal transaction taking place either by telephone or through conversation with a sales assistant in a retail outlet.

80. The average consumer of publishing/publication services will likely be a professional consumer, who will pay a higher degree of attention when making their choice. These services will also generally be a visual purchase but may involve word of mouth recommendation and an aural aspect to the selection.

Comparison of marks

81. 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 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 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.”

82. It is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

Earlier Marks	Contested Mark
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EASYRIDERS	EASYRIDER
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Overall impression

83. The marks at issue are portmanteau words, consisting of two standard dictionary words, EASY and RIDER(S) presented in standard typeface. There are no other elements to contribute to their overall impressions, which lie in the words themselves.

Visual Comparison

84. Visually the marks are almost identical, differing only in the letter 'S' of the earlier mark which forms the final letter of the opponent's mark. They share the words/letters EASYRIDER identically. The marks can be said to be visually similar to a very high degree.

Aural Comparison

85. The marks are almost identical aurally and differ only in the sound of the final letter 'S' of the earlier mark. In all other respects they are the same, sharing the syllable sounds EE/ZEE/RV/DER. The marks are aurally similar to a very high degree.

Conceptual Comparison

86. I find the words EASYRIDER and EASYRIDERS to be neologisms or portmanteau words alluding to the notion of something which is simple or easy to ride, however these words do not appear in any standard dictionary and therefore at best, the conceptual impression formed by these words can only be as I have suggested above.

87. I find that any attributed meaning created by EASYRIDER(S) as a unit is shared by the marks in issue. The fact that the earlier mark may be perceived to represent a plurality whilst the contested mark will convey the notion of a single entity does very little, if anything, to set the marks apart conceptually. Therefore, I find that the marks are conceptually very highly similar, if not identical.

Distinctive character of the earlier marks

88. The degree of distinctiveness of the earlier mark is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion⁵. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

89. “In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings” - *Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97* [1999] ETMR 585.

90. Trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. Further, the distinctiveness of a mark can be enhanced by virtue of the use made of it.

91. In this case however, whilst the opponent filed evidence and claimed enhanced distinctiveness through use made of its mark, I have concluded that the evidence, whilst sufficient to prove genuine use of the earlier marks in respect of a very limited range of goods, cannot be said to be enough to prove that the earlier mark EASYRIDERS enjoys an enhanced degree of distinctive character. Longstanding use, which the opponent has shown, does not, in isolation, translate into enhanced distinctiveness. The level of sales of the opponent’s goods across the period have not been particularly significant and no third-party evidence has been provided to suggest that the opponent’s magazine is well-known or considered to be of high quality. No

⁵ *Sabel BV v Puma AG*, Case C-251/95, § 24

information relating to marketing or promotional activities or expenditure, have been provided either. Consequently, I have only the inherent position to consider.

92. I find the earlier mark EASYRIDERS has no obvious link to the goods at issue and cannot be said to be allusive or suggestive of those goods. Therefore, I conclude that the opponent's mark is inherently distinctive to at least a medium degree.

Likelihood of confusion

93. There is no simple formula for determining whether there is a likelihood of confusion. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind.

94. It is clear then that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa (*Canon* at [17]). In making my assessment, I must consider the various factors from the perspective of the average consumer, bearing in mind 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 (*Lloyd Schuhfabrik* at [26]).

95. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

“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.

Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

96. These examples are not exhaustive but provide helpful focus.

97. I have concluded that some the goods at issue are identical or highly similar and some are dissimilar. I have found some of the contested services to be similar to the earlier goods to a medium degree, some to a low degree and complementary, with the majority being dissimilar. The competing marks have been found to be visually and aurally very highly similar, and conceptually very highly similar if not identical. The average consumer of the goods and services in issue will be members of the general public and professionals, who will select the goods and services primarily through visual means, though I have considered an aural component in the selection process as well. I have concluded that the level of attention exercised during the purchasing process will range from average to higher than average, depending on

the consumer group. I have found the opponent's mark to have at least a medium degree of distinctive character.

98. I have taken these factors into account in my assessment of the likelihood of confusion between the marks, and I come to the view that for the contested goods found to be identical or highly similar in class 16 and the contested 'non-downloadable electronic publications' found to be similar to a medium degree in class 41, direct confusion will occur. The marks are almost identical, the goods and services are identical or similar to a medium degree. I believe that the average consumer will mistake one mark for the other.

99. However, I find that for the contested publishing and publication services in class 41, which have been found to be similar to a low degree and complementary, direct confusion will not occur. The average consumer of the earlier goods will largely be a member of the general public, whilst the consumer of publishing and publication services will more likely be a professional, business or a third-party distributor, displaying a higher level of attention. The differences between the goods and services are sufficient, I feel, to ensure that a consumer, where they might possibly overlap, will not select one product in place of the other by mistake.

100. Turning to the possibility of indirect confusion with regard to the contested publishing and publication services, I remind myself of the comments set out above of Mr Purvis QC in *LA Sugar Limited*. In this instance the marks are so closely similar as to be almost identical and the common element 'EASYRIDER' has been found to be inherently distinctive to at least a medium degree. That being the case, I find that indirect confusion will occur, as the average consumer would expect there to be an economic link between the provider of the earlier goods and an undertaking providing publishing and publication services.

101. Having found that for the goods and services considered to be identical or similar, confusion will occur, the opposition, insofar as it is based on section 5(2)(b) has been partially successful.

102. I now move on to consider the section 5(3) ground of opposition.

Section 5(3)

103. Section 5(3) of the Act states:

“(3) A trade mark which-

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

104. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. 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* and *Environmental Manufacturing, paragraph 34*.

(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*).

105. An opposition based on section 5(3) of the Act can only be successful via the establishment of several individual elements, the cumulation of which must satisfy all elements of the claim. To be successful on this ground, the opponent must prove they hold a reputation for the earlier mark amongst a significant portion of the public.

Reputation

106. In *General Motors*, Case C-375/97, the CJEU held that:

“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.”

107. The opponent claimed to have a reputation for all of the goods on which it relied for the purposes of the section 5(2)(b) ground of opposition. This was denied by the applicant and, following my assessment of the opponent’s evidence, I have concluded that the opponent has not proven that it enjoys a reputation for any of the goods claimed. I have concluded that the evidence, whilst proving longstanding use of the mark EASYRIDERS on a motorcycling magazine, does not contain the kind of information required to establish that the goods provided by the opponent are high-

quality or considered to be of repute. Longstanding use, in and of itself, does nothing to establish either. That being the case, the opposition insofar as it is based on section 5(3) must fail.

Conclusion

108. The opposition under section 5(3) has failed entirely. The opposition under section 5(2)(b) has been partially successful. Subject to an appeal to this decision, the application may proceed to registration for the following goods and services:

Class 16: Tickets, vouchers, coupons and travel documents; documents, tickets and publications, all relating to travel arranged by means of the world-wide web; travel documents folders; travel guide books; travellers cheques; identity cards, not encoded; labels and tags; posters, postcards, stationery, writing instruments, wrapping materials, calendars, diaries, photographs, gift cards and greetings cards; cardboard badges, paper badges, paper name badges; teaching and instructional materials; promotional and advertising material; signs of paper or cardboard.

Class 39: Transport; packaging and storage of goods; travel arrangement; travel information; provision of car parking facilities; transportation of goods, passengers, animals, pets, travelers by air, land, sea and rail; pet rescue services; transport of pets; transportation of animals; transportation of pet animals; airline and shipping services; airport check-in services; arranging of transportation of goods, passengers, animals, pets 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 for arranging travel; 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; delivery, collection, transport, forwarding and courier services; food and drink delivery, storage, collection, transport, forwarding and courier services; collection, transport, delivery, forwarding and courier services

relating to goods, packages, gifts, parcels, documents, post, mail, correspondence, advertising materials; provision of information, advisory and consultancy services in relation to the aforesaid services.

Class 41: Educational services; providing of training; sporting and cultural activities; educational services provided by means of a computer network; teaching; production of television programmes; entertainment services; fitness instruction and tuition; group fitness and exercise classes; personal training services; provision of gymnasium facilities; gymnasium services relating to body building; gymnasium services relating to weight training; life coaching services; education relating to nutrition; provision of educational information relating to fitness, exercise, diet, health and nutrition; entertainment information services; health club services; gymnasium services; gymnasium club services; sports club services; nutrition coaching; weight management coaching; organisation of sports competitions; physical education services; providing sports facilities; provision of recreation facilities; rental of sports equipment; rental of tennis courts; rental of squash courts; booking of sports facilities; arranging and conducting workshops; hosting of sports leagues; entertainment services in the nature of the hosting of an online sports league; teaching of pet care; animal training; tuition in animal training; provision of social club services; providing cultural activities; leisure services; play schemes (entertainment/education); providing animal exercise services; hire of animals for recreational purposes; advisory, consultancy and information services relating to all the aforesaid services.

109. The application is refused for the following goods and services:

Class 16: Printed matter and publications; books, manuals, pamphlets, newsletters, brochures, albums, newspapers, magazines and periodicals.

Class 41: Publishing; publication of newsletters, catalogues and brochures; non-downloadable electronic publications.

COSTS

110. As the applicant has been largely successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal

Practice Notice (“TPN”) 2 of 2016. Applying said TPN as a guide, I award costs to the applicant on the following basis:

Reviewing the Notice of Opposition and filing the Counterstatement:	£400
Preparing written submissions and considering the other side’s submissions:	£500
Considering the evidence of the opponent and preparing evidence	£500
Total:	£1400

111. I order ER Assets, LP to pay to easyGroup Ltd the sum of £1400. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18th day of August 2022

Andrew Feldon
For the Registrar