

**O/102/18**

**TRADE MARKS ACT 1994**

**INTERNATIONAL TRADE MARK 1318748**

**IN THE NAME OF PORCHER INDUSTRIES SA**

**AND**

**DESIGNATION OF THE UK FOR PROTECTION PURPOSES**

**AND**

**OPPOSITION 408641 BY EASYGROUP LIMITED**

## Background and pleadings

1. This is an opposition by easyGroup Limited (“the opponent”) to the granting of protection in the UK to international registration 1318748 (“the IR”). The IR is in the name of Porcher Industries SA (“the IR holder”). The IR holder designated the UK for protection of the IR on 11<sup>th</sup> May 2016. However, the IR claims the priority of the filing date of the base trade mark in France on 4<sup>th</sup> January 2016 (“the relevant date”).

2. The subject of the IR is the word mark EASYSAIL in standard characters. It is registered for:

Class 22: Sails (rigging), raw fibrous textile materials; polyamide-based woven reinforcements; polyester-based laminated reinforcement; sails for ski sailing; boat sails; fibrous textile materials for sports applications.

Class 24: Technical fabrics for sports applications, not for insulation and not of metal; technical fabrics for sporting and industrial use in the field of boat sails; tear-proof fabrics impervious to air.

Class 35: Retail or wholesale services, in stores or online, for boat sails.

3. The IR was published for opposition purposes on 25<sup>th</sup> November 2016.

4. The opponent relies on the 7 earlier EU trade marks shown in the table below.

TM No.	Trade Mark	Filing date	Services
14920391	EASYGROUP	17/12/15	Services in class 35 including <i>retail services connected with the sale of gymnastic and sporting articles.</i>
10584001	EASYJET	24/01/12	Goods/services in classes 12, 39 and 43 including <i>apparatus for locomotion by ...water; parts for...water locomotion apparatus, transportation of goods, passengers and travelers by... sea and temporary accommodation;</i>

			<i>restaurant, bar and catering services.</i>
14920433		17/12/15	Services in class 35 including <i>retail services connected with the sale of gymnastic and sporting articles.</i>
14770705	EASYAIR	05/11/15	Services in classes 39 and 43 including <i>transportation of goods, passengers and travelers by... sea and temporary accommodation; restaurant, bar and catering services.</i>
10735561	EASYBUS	16/03/12	As per 10584001 above
10735553	EASYCAR	16/03/12	As per 10584001 above
10626604		08/02/12	As per 14770705 above

5. The opponent claims that the marks are similar to the contested mark and are registered for identical or similar goods or services. According to the opponent, there is a likelihood of confusion on the part of the public. Registration of the contested mark would therefore be contrary to section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).

6. In support of this claim the opponent argues that:

“The opposed Class 35 services of this application are identical or at least highly similar to the Class 35 services of the Opponent's registration. They concern retail services in relation to a range of goods in the case of the Opponent's registration and boat sails in the case of the opposed application.

The travel and hospitality-related services in Classes 39 and 43 of the Opponent's registration are complementary to the goods and services of the opposed application. Sailing is one of a select number of high-cost activities alongside air travel, that is associated with a certain lifestyle and it is a natural

assumption that EASYSAIL is an extension of the Opponent's business."

7. Additionally, the opponent claims that earlier trade mark EASYJET has a reputation in the EU in relation to, inter alia, *transportation of goods, passengers and travelers by air, land, sea and rail, airline services and temporary accommodation; restaurant, bar and catering services*. Further, earlier trade mark EASYGROUP has a reputation in the EU in relation to, inter alia, *retail services connected with the sale of luggage, suitcases, travelling sets, sports bags, bike bags, backpacks; retail services connected with the sale of gymnastic and sporting articles and temporary accommodation; restaurant, bar and catering services*. The reputation of the earlier marks is said to be for "straightforward, low-cost goods and services."

8. In support of this ground the opponent claims that:

"The Opponent is known for operating travel and tourism and hospitality services. It has a significant reputation in the UK in relation to the mark EASYGROUP and we submit that consumers would think that EASYSAIL was an extension of the Opponent's travel and tourism and hospitality businesses. Sailing is complementary to many of the travel, tourism and hospitality services for which the Opponent has a reputation and we submit that there would be a economic link established in the minds of consumers."

9. The opponent claims that use of the contested mark would, without due cause, take unfair advantage of, and/or be detrimental to, the reputation or distinctive character of these earlier marks. According to the opponent, the contested mark would (a) "ride on the coattails of the Opponent's reputation without the attendant effort and cost", (b) tarnish the reputation of the earlier marks, if used in relation to goods and services of inferior quality, and (c) dilute the distinctive character of the earlier marks by diminishing the capacity of easyGroup, easyJet and easyHotels to distinguish the opponent's goods and services.<sup>1</sup> Consequently, protection of the contested mark in the UK would be contrary to s.5(3) of the Act.

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<sup>1</sup> I note that easyHotels is not one of the marks listed as an earlier trade mark in the notice of opposition.

10. The IR holder filed a counterstatement consisting of blanket denials of the grounds of opposition.

## **Representation**

11. The opponent is represented by Kilburn & Strode, patent and trade mark attorneys. The applicant is represented by Groom Wilkes & Wright LLP, trade mark attorneys. Neither side wished to be heard, but both filed written submissions which I have taken into account.

## **The evidence**

### The opponent's evidence

12. This consists of a witness statement dated 18<sup>th</sup> July 2017 by Ryan Pixton, who is a trade mark attorney at Kilburn & Strode. Mr Pixton says that his evidence comes from his own knowledge, the records of his firm or has been supplied to him by (unnamed) "*others*". There are 12 exhibits to Mr Pixton's statement.

13. The first is an extract from Wikipedia downloaded in March 2017. It sets out the history of EasyGroup since it was founded in 1998.

14. The second and third exhibits are copies of pages from easyJet's website in March 2017. They show that easyJet is a large European airline.

15. The fourth, fifth and sixth exhibits are copies of EasyJet plc's reports for the years ending 30<sup>th</sup> September 2014, 2015 and 2016. This latest report shows that the company turned over more than £4.6 billion and that the airline carried 73.1m passengers during the financial year in question.

16. The seventh exhibit consists of an extract from the website campaignlive.co.uk, which appears to consist of a case study from 2002 of EasyJet as a 'superbrand' for airline services.

17. The eighth exhibit consists of a copy of some pages from the website 'rankingthe brands.com'. In the Global Brand Simplicity Index for 2015, EasyJet came 53<sup>rd</sup> out of 87 global brands. I note that none of the other earlier marks relied on by the opponent featured in this ranking.

18. The ninth exhibit consists of a copy of an advert for the Museum of Brands which invites readers to "*see the easy family of brands in a museum!*"<sup>2</sup> The advert is not dated and is barely readable.

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

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

21. Mr Griffin opines that the values consumers associate with the 'easy' brand include "*excellent value, innovation and an entrepreneurial approach.*" He considers

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<sup>2</sup> See exhibit REP1

that these values are likely to be tarnished by third parties offering easy-branded services without the authority or control of easyGroup.

22. The eleventh exhibit consists of a copy of a witness statement dated 7<sup>th</sup> August 2013 by Paul Griffiths, who was at that time the Finance Controller for easyGroup (and had been since 2010). This witness statement appears to have been drawn up in relation to earlier opposition proceedings at the IPO concerning a third party trade mark application. There were 64 exhibits to the original statement, but these have not been filed. The most relevant parts of Mr Griffiths statement are, in my view, as follows.

- Mr Griffiths says that easyGroup Limited was incorporated in 2000 with a view to establishing a group of companies that traded under the “EASY” brand.
- He says that the brand is associated with the values: “great value”, “taking on the big boys”, “for the many not the few”, “relentless innovation”, “keep it simple”, “entrepreneurial”.
- He says that the ‘current’ list of businesses operating under the EASY brand (in 2013) included EASYJET, EASYCAR and EASYBUS. He did not claim that any of the other marks listed in the notice of opposition were in use at the time of his statement.
- He provides EASYJET’s booking figures for 2010/11 which show that most of the airline’s bookings came from the EU, with the UK, France, Italy & Spain the top four.
- EASYJET was active “not only in airline services but in respect of in-flight magazines, car rental, travel insurance and airport parking.”
- EASYCAR was first used in 2004. It allowed customers (via its website) to hire a vehicle in 60 countries, including all the Member States of the EU. Turnover in 2009 was £26m (no figures were provided for later than 2009).
- EASYBUS was first used in 2004 in relation to a bus service operating between London and Luton Airport. At the time of Mr Griffiths’ statement in 2013, additional routes between London and Gatwick and Stanstead Airports had been added.

- EASYBUS turned over around £8m in 2009/2010 (the latest figures provided).

23. The twelfth exhibit consists of “extracts from various national publications and websites.” They appears to have been downloaded from the internet in 2015. They mostly relate to the use of EASY brand extensions, such as EASYHOTEL. I note the following.

- A copy of an article from theguardian.com website dated 23<sup>rd</sup> October 2014 about brand extensions in which it is noted that easyGroup had “*successfully launched sub-brands from property to pizza to gyms*” (although no such sub-brands are listed).
- Copies of webpages from the easy.com website downloaded in June 2017. The website appears to be a portal with links to various ‘easy’ brands.
- An article from Management Today dated August 2014 describes EasyCar Club as a new ‘peer-to-peer car rental platform’. According to the article, the original EasyCar car rental business “hit something of a wall” after losing money.

#### The applicant’s evidence

24. The applicant’s evidence consists of a witness statement by Sylvie Tate of Groom, Wilkes and Wright LLP. Ms Tate’s evidence includes copies of articles about buying sails for boats.<sup>3</sup> These show that boat sails are an expensive and considered purchase. Ms Tate’s evidence also includes copies of websites of third party businesses trading in the UK under names including ‘EASY’, including Easytravel, Easystudentrooms, Easy-Break and Easy Limo. However, all these were obtained in September 2017. Consequently, they do not show that such uses pre-dated the relevant date in these proceedings.

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<sup>3</sup> See exhibit ST1



## Section 5(2)(b)

25. Section 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

26. None of the earlier marks relied upon for this opposition are subject to proof of use under s.6A of the Act. Consequently, the opponent can rely on each of the seven earlier marks in relation to the goods or services for which they are registered.

### Comparison of the goods/services

27. The opponent’s written submissions of 10<sup>th</sup> July 2017 focus on the similarity between the services in class 35 for which two of the earlier marks are pleaded (14920391 and 14920433) and the goods and services covered by the application. So I will start by comparing these services. I have shown in italics the retail services, which I consider to be the closest to the goods/services covered by the IR.

Goods/services covered by IR	Class 35 services covered by earlier marks
<p>Class 22: Sails (rigging), raw fibrous textile materials; polyamide-based woven reinforcements; polyester-based laminated reinforcement; sails for ski sailing; boat sails; fibrous textile materials for sports applications.</p> <p>Class 24: Technical fabrics for sports applications, not for insulation and not of metal; technical fabrics for sporting and industrial use in the field of boat sails; tear-proof fabrics impervious to</p>	<p>Class 35: retail services connected with the sale of food and drink; retail services connected with the sale of preparations and substances for use in the care and appearance of the hair, scalp, lips, face, skin, teeth, nails and eyes; retail services connected with the sale of cosmetics, non-medicated toilet preparations, perfumes, fragrances, colognes and scents, soaps and cleaning preparations; retail services connected with the sale of shampoos, conditioners, moisturisers, tooth cleaning</p>

<p>air.</p> <p>Class 35: Retail or wholesale services, in stores or online, for boat sails.</p>	<p>preparations; retail services connected with the sale of depilatory preparations, sun-screening and tanning preparations; retail services connected with the sale of anti-perspirants, deodorisers and deodorants; retail services connected with the sale of sunglasses, personal stereos, MP3 players, CD players, apparatus for playing music and video recordings; retail services connected with the sale of jewellery, stones, watches, clocks; retail services connected with the sale of books, magazines, newspapers, stationery, calendars, diaries; retail services connected with the sale of purses, umbrellas, parasols briefcases, purses, wallets, pouches and handbags; retail services connected with the sale of luggage, suitcases, travelling sets, sports bags, bike bags, backpacks, games, playing cards; <i>retail services connected with the sale of gymnastic and sporting articles</i>; retail services connected with the sale of scooters</p>
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28. The opponent submits that the earlier marks are registered in relation to a wide range of retail services, some of which are at the least highly similar to the retail of goods covered by class 35 of the IR. The opponent also relies on the retail services covered by class 35 of the earlier mark as regards the goods covered by classes 22 and 24 of the IR. In this respect, the opponent says that the goods in question are similar to those which are the subject of its retail services registrations.

29. The applicant disputes that the goods covered by the IR in classes 22 and 24 are similar to any of the goods/services covered by the earlier marks. As regards the trade in sails, the applicant points to the evidence that it is an involved process requiring careful measurements, assessment of suitability of the sails for the boat concerned, durability and cost. The applicant likens the trade in sails to the level of consideration involved in the replacement of thatched roofs.

30. It is necessary to determine which services are covered by the description *retail services connected with the sale of gymnastic and sporting articles*. In *YouView TV Ltd v Total Ltd*,<sup>4</sup> 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."

31. This means that words in specifications should be interpreted according to the context in which they appear and be given their ordinary and natural meaning. I do not consider that *retail services connected with the sale of ...sporting articles* would naturally be understood to cover retail services connected with the sale of boat sails or fabrics. It is true that sailing boats can be used in sports, but I don't think anyone would think that *sporting article* was a natural description of a sailing boat, let alone the sails for such a boat. In my view, *sporting article* does not cover racing vehicles, but 'articles' (but not 'materials') used specifically for sports, such as boxing gloves or javelins.

32. In *Tony Van Gulck v Wasabi Frog Ltd*,<sup>5</sup> Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

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<sup>4</sup> [2012] EWHC 3158 (Ch)

<sup>5</sup> Case BL O/391/14

“9. The position with regard to the question of conflict between use of BOO! for handbags in Class 18 and shoes for women in Class 25 and use of MissBoo for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*,<sup>6</sup> and *Assembled Investments (Proprietary) Ltd v. OHIM*<sup>7</sup> (upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*),<sup>8</sup> Mr Hobbs concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;

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<sup>6</sup> Case C-411/13P

<sup>7</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment

<sup>8</sup> Case C-398/07P

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

33. Therefore, although it is not necessary for the goods covered by the IR to be identical to the goods specified in the opponent's retail services registrations in order for there to be a complementary relationship between them, it is necessary for there to be a sufficiently close relationship between the respective goods and services that the public might reasonably believe that they are complementary goods/services likely to be offered by one and the same undertaking. I see no such relationship between *retail services connected with the sale of ...sporting articles* (as I have interpreted that term) and any of the goods covered by classes 22 and 24 of the IR.

34. I accept that there is some similarity in purpose and methods of use between *retail services connected with the sale of ...sporting articles* and *retail or wholesale services, in stores or online, for boat sails*, i.e. they are both retail services from shops/websites intended to encourage the sale of goods. However, I find that the nature of the retail services provided in order to encourage sales of the respective goods is likely to be quite different. The services are not in competition and they are not complementary. I therefore find that there is only a low-to-medium degree of similarity between such services.

35. Turning to the services in classes 39 and 43 which the opponent relies on in relation to five of the earlier marks, particularly *transportation of goods, passengers and travelers by... sea* and *temporary accommodation; restaurant, bar and catering services*, I see no similarity with any of the goods/services covered by the IR. The most that can be said is that *transportation of goods, passengers and travelers by... sea* covers transportation services by boat and boats have sails. However, the services concerned are directed at those wishing to obtain transportation services, whereas the goods and services covered by the IR are directed at those operating

sailing craft, as well as other users of raw or technical fabrics. Consequently, the public would not expect the same operator to provide such goods/services and they are not complementary or similar in any other way.

36. Finally, it is necessary to compare the goods covered by class 12 of earlier trade mark 10584001 (EASYJET) with the goods/services covered by the IR. The earlier mark covers, inter alia, *apparatus for locomotion by ...water* and *parts for...water locomotion apparatus*. The first description covers a trade in sailing boats. The second description covers a trade in parts for sailing boats, but not sails which do not fall in class 12. However, a replacement mast would fall in class 12. In my view, there is a degree of similarity in nature between the respective goods, i.e. they all cover parts and/or fittings for boats. Additionally, it is likely that a trader in sailing boats and parts for sailing boats would also provide retail services in relation to boat sails. I therefore find that there is a low degree of similarity between these goods/services.

#### Distinctive character of earlier mark

37. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*<sup>9</sup> 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

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<sup>9</sup> Case C-342/97

registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

38. The opponent submits that EASYJET has become highly distinctive through use in relation to airline services and that the opponent is known for expanding into other business areas under easy-prefixed marks, such as easyBus, easyCar, easyAir and easyTravel. It is implicit in the argument that easy-prefixed marks constitute a ‘family’ of distinctive marks that the easy-prefix of the earlier marks has become distinctive, at least when followed by a descriptive word.

39. The applicant points out that Easy is a basic English word meaning ‘without requiring much labour or effort; not difficult; simple’. It is therefore said to be laudatory and descriptive of the quality of the goods/services covered by the earlier marks, and therefore non-distinctive.

40. I accept that EASY is a natural way of designating goods and services as being easy to use. I therefore agree that the word is inherently low in distinctive character. It is true that BUS is even more descriptive than EASY in relation to transportation services, but that does not mean that it makes no, or only a negligible, contribution to the distinctive character of the composite word mark EASYBUS. I find that the inherent distinctive character of EASYBUS comes from the combination of the words making up the mark, albeit weighted more on EASY than on BUS. The same applies to EASYCAR.

41. In the case of easyProperty and easyTravel, the distinctive character of the earlier marks also comes from the presentation of the words in white letters on a rectangular orange background. This makes a more-than-negligible contribution to the distinctive character of these marks. Additionally, ‘Property’ is not really

descriptive of retail services in class 35 so the distinctive character of the word element of this mark is spread more evenly between the constituent words.

42. The inherent distinctive character of EASYJET and EASYAIR for airline services is somewhat similar to EASYBUS for transportation services, in that it comes from the combination of the specific words in question, but weighted more towards EASY than JET/AIR. However, that last caveat does not apply when the marks are considered in relation to *apparatus for locomotion by ...water* and *parts for...water locomotion apparatus* and *transportation of goods, passengers and travelers by... sea*. This is because JET/AIR is not (as) descriptive of such goods/services.

43. The inherent distinctive character of EASYGROUP also depends on the combination of those words, neither word having much distinctive character by itself.

44. It follows from what I have said that (a) none of the earlier marks have more than an average degree of inherent distinctive character, and (b) EASY would not naturally impact on consumers as being the dominant and distinctive element of any of the marks.

45. The opponent's case is that the marks, and particularly the EASY prefix, have become more distinctive through use. There is no doubt that EASYJET was highly distinctive in fact at the relevant date for airline services. There is insufficient evidence to find that it was highly distinctive for anything else; certainly not for water vehicles or water transportation services.

46. There is no evidence that easyTravel, easyProperty or EASYAIR were in use at the relevant date. Consequently, the distinctive character of these marks has not been enhanced through use. Additionally, EASYGROUP appears to have been used only as a corporate name rather than as a trade mark in relation to particular goods/services. Therefore, the distinctive character of this mark has not been enhanced through use either.

47. Mr Griffin claims to be familiar with other 'easy' brands, specifically 'easyHotel', 'easyGym' and 'easyOffice'. Mr Griffin's statement was made in April 2017, some 16



months after the relevant date. Therefore, it is unclear whether the use of these marks started prior to the relevant date. In any event, none of these marks were included as earlier trade marks in the notice of opposition. And it is not for this tribunal to search the registers to see if these marks are registered in the opponent's name and, if so, for which services.

48. This leaves EASYBUS and EASYCAR. There is evidence that both were in use prior to the relevant date in the UK and, in the case of EASYCAR, elsewhere in the EU. However, it is not easy to establish how much use was made of the marks after 2009/2010, or whether the use continued after 2013. At this time EASYBUS was a bus service between central London and three out-of-London airports. The original EASYCAR car hire service appears to have ceased sometime after 2009 before being replaced some time later by a peer-to-peer car rental club. The scale of the latter business cannot be established from the evidence provided.

49. I therefore conclude that EASYBUS was probably present on the UK market at the relevant date, but the scale and geographical extent of the use of the mark is not sufficient to conclude that the distinctive character of this mark had been enhanced through use to a significant part of the UK public prior to the relevant date. I am not so sure that EASYCAR was present on the market at the relevant date. In any event, it had not become more highly distinctive through use.

#### Average consumer and the selection process

50. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. 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.<sup>10</sup>

51. The average consumer of the goods/services covered by the IR is likely to be a person or business with an interest in buying sails or raw or technical materials, including such materials for making sails. I would expect the consumers of such

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<sup>10</sup> *Lloyd Schuhfabrik Meyer, Case C-342/97*

goods to be sailors (or windsurfers) with the skills required to fit sails to their craft and/or businesses servicing and repairing boats and/or windsurfing boards and/or businesses that make sails. I accept the applicant’s evidence that the purchase of sails is a highly considered purchase. I find that the relevant consumers are likely to pay an above average level of attention when selecting the goods at issue, or a retailer to provide boat sails.

52. The selection process is bound to involve sight of the trade mark, but word-of-mouth recommendations and enquiries are also likely to pay a significant part in the trade in the goods/services covered by the IR.

Comparison of marks

53. As the CJEU stated in *Bimbo SA v OHIM*:<sup>11</sup>


“.....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.”

It would be wrong, therefore, to artificially dissect the trade marks, although, 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 respective trade marks are shown below:

EASYSAIL	EASYGROUP EASYJET EASYBUS EASYCAR EASYAIR
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<sup>11</sup> Case C-591/12P, at paragraph 34 of its judgment

	
Contested trade mark	Earlier trade marks

54. The opponent does not say that any one of the earlier marks is any more similar to the IR than any of the others. Arguably the EASYAIR mark is the closest individual mark because the suffixes –SAIL and -AIR both include the letters ‘AI’. I will therefore take this mark as representing the opponent’s best case on the conventional mark-for-mark comparison basis.

55. Both the marks start with EASY- and they are of similar length; 8 letters versus 7. As a general rule the beginnings of marks tend to make more impact than the ends.<sup>12</sup> However, notwithstanding that they both have suffixes which include the letters ‘AI’, those suffixes look and sound quite different. Further, as the marks are obviously made up of the well-known words EASY and SAIL/AIR, respectively, the different second word is hard to miss. Therefore, I find that there is only a medium degree of overall visual and aural similarity between the marks.

56. As to conceptual similarity, the opponent stresses the common meaning of the EASY prefix and the descriptive nature of the suffixes. The applicant points to the different meanings of all the suffixes and says that it is not appropriate to attribute conceptual similarity to the marks on the basis that the suffix of EASYSAIL and that of some of the earlier marks are associated (in different ways) with transport, i.e. ‘jet’, ‘air’, ‘car’ etc. I accept the last point. In the context of the goods and services covered by the IR, the word SAIL will plainly be taken as referring to the intended use of most of the goods/services (i.e. as sails), whereas in the earlier marks, such as EASYAIR, the suffix will be understood as referring to air transport (or just ‘air’, as in the air we breathe, if the services are not related to air transportation). Therefore, although the common meaning of the EASY- prefix introduces a conceptual similarity of sorts, the marks as a whole are not conceptually similar. Further, the significance of any conceptual similarity that may be identified is weakened by the fact that the

<sup>12</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

common word EASY is *prima facie* descriptive of the goods/services. Therefore, the common element EASY is not, at least *prima facie*, a distinctive conceptual similarity.

57. Overall, I find that EASYSAIL is similar to a medium degree to EASYAIR. It follows that EASYSAIL is no more similar to any of the other earlier marks. In particular, the stark visual, aural and conceptual differences between the suffixes ‘-SAIL’ and ‘-GROUP’ and ‘-Property’ mean that EASYSAIL, EASYGROUP and the easyProperty are similar to only a low degree. And given the absence of any visual, aural or conceptual similarity between the suffixes –SAIL and –JET, I find that there is only a low-to-medium degree of overall similarity between EASYSAIL and EASYJET.

#### Likelihood of confusion

58. The following principles 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.

#### *The principles*

(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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

59. Considering first the likelihood of confusion with the earlier mark EASYGROUP, I found that there is only a low degree of similarity between the marks, a medium degree of similarity between the respective retail services, and no similarity between the goods covered by the IR and the services covered by the earlier mark. I also found that EASYGROUP has an average degree of distinctive character and that the selection process for the goods/services covered by the IR is likely to be a highly considered one undertaken by average consumers paying an above average degree of attention. Taking all the relevant factors into account, I find that there is no likelihood of confusion.

60. The same applies to EASYSAIL and the opponent's earlier easyTravel figurative mark.

61. Turning next to the likelihood of confusion between EASYSAIL and the earlier mark EASYJET, I found that there is a low-to-medium degree of similarity between the marks, a low degree of similarity between some of the goods in class 12 covered by the earlier mark and some of the goods/services covered by the IR, and no similarity between the goods/services covered by the IR and the services in classes 39 and 43 covered by the earlier mark. I also found that EASYJET has an average degree of inherent distinctive character and that there was no evidence of use of that mark in relation to goods in class 12. I also found that the selection process for the goods/services covered by the IR is likely to be a highly considered one undertaken by average consumers paying an above average degree of attention. Taking all the relevant factors into account, I find that there is no likelihood of confusion.

62. Turning next to the likelihood of confusion between EASYSAIL and the earlier mark EASYAIR, I found that there is a medium degree of similarity between the marks, but no similarity between any of the goods/services covered by the IR and the services in classes 39 and 43 covered by the earlier mark. It follows that the opposition under s.5(2)(b) based on this mark must be rejected.

63. The same applies to the earlier marks EASYCAR, EASYBUS and easyTravel (figurative).

## The 'family' of marks case

64. The opponent's primary case appears to be that the IR will be mistaken for being a member of its family of easy-prefixed marks. In *Il Ponte Finanziaria SpA v OHIM*,<sup>13</sup> the CJEU 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

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<sup>13</sup> Case C-234/06

trade marks which are part of that ‘family’ or ‘series’ must be present on the market.”

65. The only marks covered by the grounds of opposition that the opponent has shown were present on the market at the relevant date are EASYJET, EASYBUS and (arguably) EASYCAR. However, none of these marks were present on the market in relation to goods or services that are similar to those covered by the IR. It is an essential requirement for protection under s.5(2)(b) that the respective goods/services must be similar to some degree. I therefore find that the opponent’s case under s.5(2)(b) based on its ‘family’ of easy- marks must be rejected.

66. However, even if I am wrong about that and the similarity between the goods in class 12 for which EASYJET is registered (although not in use) and the goods/services covered by the IR is sufficient to bring the opponent’s case based on a ‘family’ of easy- marks within the scope of s.5(2)(b), I would still reject the case. This is because (a) I do not consider that the opponent has established that the public would expect any mark with an EASY- prefix and a descriptive suffix to be connected to the user of the opponent’s EASY marks, (b) the goods/services covered by the IR are directed at a different market to the airline, car hire and bus services for which the earlier marks EASYJET, EASYCAR and EASYBUS were present on the market at the relevant date, (c) the brand values described by Mr Griffiths do not seem easily transferable to a trade in sails, raw and technical materials for use in making sails, and retail services for boat sails goods. In short, the goods/services covered by the IR do not appear to be a natural extension of the businesses or attributes associated with the opponent’s easy- marks.

67. Accordingly, the opposition under s.5(2)(b) fails.



## Section 5(3)

68. Section 5(3) 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.”

69. 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, *Addidas-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*).

### Reputation

70. I accept that EASYJET had a strong reputation in the UK and EU at the relevant date in relation to airline services. I do not consider that the opponent's evidence establishes that the reputation of the mark extended to other services.

71. I do not accept that EASYGROUP had a reputation as a trade mark at the relevant date.

### Link

72. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

#### *The degree of similarity between the conflicting marks*

For the reasons explained earlier, I find that there is a low-to-medium degree of similarity between EASYJET and EASYSAIL.

#### *The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public*

There is a wide disparity between airline services and sails, raw and technical materials for use in making sails, and retail services associated with boat sails. Consumers of the latter are likely to make up a relatively specialist market, whereas consumers of airline services are businesses of all kinds and

the general public. However, consumers of sails etc. are likely to use airline services so there is a small degree of overlap between the users of the goods/services.

*The strength of the earlier mark's reputation*

The earlier mark has a strong reputation in the UK and EU.

*The degree of the earlier mark's distinctive character, whether inherent or acquired through use*

The earlier mark EASYJET is highly distinctive in fact. However, the common element – EASY – is descriptive of airline services and has not been shown to be highly distinctive on its own.

73. In my view, the low-to-medium degree of similarity between the marks as wholes, the marked difference between the goods/services, and the relatively specialist market for the goods/services covered by the IR, make it unlikely that consumers will make any link between the marks in use. If that is right, the opposition under s.5(3) must fail.

74. However, even if that is wrong, and some consumers would make a link between the marks, I would still have rejected the s.5(3) ground.

Injury to earlier mark

75. The opponent's pleaded case is that consumers will be led to believe that:

“EASYSAIL was an extension of the Opponent's travel and tourism and hospitality businesses. Sailing is complementary to many of the travel, tourism and hospitality services for which the Opponent has a reputation and we submit that there would be a economic link established in the minds of consumers.”

76. However, the IR does not cover sailing services of any kind. And I have already rejected the likelihood of confusion in my analysis under s.5(2)(b). This aspect of s.5(3) case was therefore bound to fail.

77. Additionally, or alternatively, the opponent complains that the reputation of the earlier mark may suffer from the link with the contested mark because it cannot control the quality of the goods marketed under that mark. However, in the absence of any likelihood of confusion it is not easy to understand how simply being reminded of the earlier mark will tarnish EASYJET's reputation with the public. Indeed, in *Unite The Union v The Unite Group Plc*,<sup>14</sup> Ms Anna Carboni as the Appointed Person rejected the proposition that a link between an earlier mark with a reputation and a later mark with the mere potential to create a negative association because of the potential quality of the goods/services marketed under it was sufficient to found an opposition based on detriment to reputation. I would therefore have rejected this head of injury to the earlier mark.

78. Turning to unfair advantage, the opponent claims that the earlier mark will be "*riding on the coat tails*" of the reputation of the earlier mark, which it defines as being associated with "straightforward, low-cost goods and services." However, the goods/services covered by the IR appear to be raw and technical materials and/or relatively complex goods such as sails and related services. In these circumstances, it is difficult to see how the values associated with EASYJET would easily transfer to EASYSAIL. In my view, the opponent has done no more than point to the hypothetical risk of unfair advantage being taken of the earlier EASYJET mark. I would therefore have rejected this aspect of the opponent's case too.

79. Finally, the opponent claims that use of the later mark will dilute the distinctive character of the earlier EASYJET mark and that this will lead to "death by a thousand cuts." In *Environmental Manufacturing LLP v OHIM*,<sup>15</sup> the CJEU stated that:

"34. According to the Court's case-law, proof that the use of the later mark is, or would be, detrimental to the distinctive character of the earlier mark

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<sup>14</sup> Case BL O/219/13

<sup>15</sup> Case C-383/12P

requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered, consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future (*Intel Corporation*, paragraphs 77 and 81, and also paragraph 6 of the operative part of the judgment).

35. Admittedly, paragraph 77 of the *Intel Corporation* judgment, which begins with the words '[i]t follows that', immediately follows the assessment of the weakening of the ability to identify and the dispersion of the identity of the earlier mark; it could thus be considered to be merely an explanation of the previous paragraph. However, the same wording, reproduced in paragraph 81 and in the operative part of that judgment, is autonomous. The fact that it appears in the operative part of the judgment makes its importance clear.

36. The wording of the above case-law is explicit. It follows that, without adducing evidence that that condition is met, the detriment or the risk of detriment to the distinctive character of the earlier mark provided for in Article 8(5) of Regulation No 207/2009 cannot be established.

37. The concept of 'change in the economic behaviour of the average consumer' lays down an objective condition. That change cannot be deduced solely from subjective elements such as consumers' perceptions. The mere fact that consumers note the presence of a new sign similar to an earlier sign is not sufficient of itself to establish the existence of a detriment or a risk of detriment to the distinctive character of the earlier mark within the meaning of Article 8(5) of Regulation No 207/2009, in as much as that similarity does not cause any confusion in their minds."

80. In the absence of a likelihood of confusion, I do not accept that use of the contested mark would result in the opponent's mark becoming any less distinctive than it is now. In particular, it is difficult to see how use of the contested mark in relation to the particular goods/services covered by the IR would affect the distinctive character of EASYJET for airline services, which are very different goods/services targeted at a mostly different section of the public. The position would be no different

if I took the opponent's other easy-prefixed marks into account, all of which also appear to be used in relation to everyday services aimed at the general public.

81. The s.5(3) ground is therefore also rejected.

### **Costs**

82. The applicant has been successful and is entitled to a contribution towards its costs. I calculate these as follows:

£300 for considering the notice of opposition and filing a counterstatement;

£500 for filing evidence and considering the opponent's evidence;

£250 for filing written submissions.

83. I therefore order easyGroup Limited to pay Porcher Industries SA the sum of £1050. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 15<sup>th</sup> day of February 2018**

**Allan James  
For the Registrar**