

O-357-19

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3277410
BY MACRO PACKAGING LTD
TO REGISTER**

Easipack

**AS A TRADE MARK IN CLASS 16
AND
OPPOSITION THERETO (UNDER NO. 412812)
BY
PREGIS LIMITED**

BACKGROUND

1) On 15 December 2017, Macro Packaging Ltd ('the applicant') applied to register 'Easipack' as a trade mark in respect of 'Packaging materials' in class 16.

2) The application was published in the Trade Marks Journal on 16 March 2018 and notice of opposition was subsequently filed by Pregis Limited ('the opponent'). The opponent claims that the trade mark application offends under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ('the Act').

3) In support of its grounds under section 5(2)(b) of the Act, the opponent relies upon two earlier trade mark registrations. Details of those marks, including the goods relied upon are shown in the table below.

Trade Mark details	Goods relied upon
<p data-bbox="204 1077 722 1115">TM No: UK00001572690 ('mark 1')</p> <p data-bbox="209 1211 523 1283">Easypack</p> <p data-bbox="204 1368 576 1406">Filing date: 20 May 1994</p> <p data-bbox="204 1424 743 1509">Date of entry in register: 29 August 1997</p>	<p data-bbox="794 1099 1394 1189">Class 7: Machines for the manufacture of packaging; all included in Class 7.</p>

<p>TM No: UK00002447589 ('mark 2')</p> <p>EASYPACK</p> <p>Filing date: 23 February 2007</p> <p>Date of entry in register: 04 April 2008</p>	<p>Class 7: Machines for the manufacture of packaging and packing; parts and fittings therefor.</p> <p>Class 16: Packing paper and plastics; paper and plastics for wrapping, packaging and packing; void-fill materials made from plastics and paper.</p> <p>Class 22: Packing, cushioning and stuffing materials; paper twine.</p>
---	---

4) Both of the trade marks shown in the table above are also relied upon under section 5(3) of the Act in respect of the same goods. The opponent claims that the applicant will take unfair advantage of the reputation of the earlier marks and that use of the contested mark will cause detriment to the reputation and distinctive character of the earlier marks.

5) The trade marks relied upon by the opponent under sections 5(2) and 5(3) are earlier marks, in accordance with section 6 of the Act. As both completed their registration procedure more than five years prior to the publication date of the contested mark, they are subject to the proof of use conditions, as per section 6A of the Act.

6) Under section 5(4)(a) of the Act, the opponent relies upon use of the sign EASYPACK throughout the UK since 1992, in relation to 'Packing products and materials and packaging machinery and tools including machines for the manufacture of packaging and packing; parts and fitting therefor; packing paper; paper for wrapping, packaging and packing; void-fill materials made from paper; packing cushioning and stuffing materials; paper twine; and other packing and packaging related solutions; related consultancy, training and other services.' It is

claimed that use of the applicant's mark in respect of the goods applied for will mislead the public into believing that those goods are connected to the opponent.

7) The applicant filed a counterstatement in which it denies the grounds of opposition and asserts that the applicant has been supplying packaging materials under the mark EASIPACK for the past ten years without conflict with the opponent. It also puts the opponent to proof of use of both earlier marks for goods within class 16.

However, only mark 2 is registered in respect of such goods. Therefore, it is only that mark for which the opponent is required to furnish proof of use in class 16. The opponent is entitled to rely upon all the other goods in classes 7 and 22 covered by mark 2 and all the goods in class 7 for which mark 1 is registered.

8) The opponent is represented by Dorsey & Whitney (Europe) LLP; the applicant represents itself. Both parties filed evidence accompanied by written submissions. Neither party requested to be heard or filed written submissions in lieu. I now make this decision after carefully considering the papers before me.

EVIDENCE

Opponent's evidence in chief

9) This comes from George Voice, the opponent's Director of Finance. Mr Voice explains that the opponent's business was established in Hertfordshire in 1992 and is now a market leader in the UK (and various other countries in Europe) in relation to packaging machines, packaging technology and the supply of packaging goods and materials including paper and plastic packing materials, cushioning and void-fill materials. The opponent adopted the mark EASYPACK in relation to its range of packaging machines and packaging materials in, or around, July 1994 and continues to use that mark to the present day.

10) Mr Voice explains that the opponent's innovative, environmentally friendly packaging materials and packaging machines are targeted to commercial and enterprise customers across a wide variety of sectors concerned with the manufacture and supply of manufactured articles. Those customers include suppliers

of food and drink, ceramics, glassware, cosmetics, electronics, homewares and gifts, pharmaceuticals and engineered products.

11) Mr Voice states that the mark EASYPACK has developed a significant presence in the market and acquired an extensive reputation among customers and members of the trade. He explains that sales of packaging machines and consumables, including paper and plastic packaging materials and void-fill materials under the mark EASYPACK amounted to over £16 million in the UK between November 2013 and November 2018. A table¹ is provided showing a breakdown of those sales, as follows:

£	2013/14	2014/15	2015/16	2016/17	2017/18	Total
Machines	153,136	131,557	112,131	116,836	139,925	653,585
Consumables	3,255,680	3,137,426	2,920,404	3,236,095	3,493,093	16,042,697

12) Numerous invoices bearing the mark Easypack (presented in blue) spanning 2014 to 2017 are provided by Mr Voice. All the invoices bear commercial addresses in the UK. Customers include DPD Logistics, Lloyds Pharmacy and Lush Manufacturing Ltd. The vast majority of those invoices relate to the sale of rolls of packaging paper. One refers to 'Airspeed 5000 Film Renew' which, from other parts of the evidence before me, I understand to be a type of plastic packaging material².

13) A copy of the audited annual accounts of the opponent showing gross revenue (turnover) figures for the year ending 31 Dec 2017 of £11.2 million is also provided. The figure for the period from 9 February 2016 to 31 December 2016 was £9.4 million.³ Mr Voice explains that those figures include the sale of packaging machines and packaging consumables and related services such as warranty services, maintenance and support services and training and consultancy services.

14) Mr Voice states that the opponent has the second largest share in the market for packaging solutions in the UK (after the market leader, Ranpak).

¹ Exhibit GV2

² Exhibit GV1

³ Exhibit GV3

15) The opponent promotes the EASYPACK packaging products through a range of activities including a salesforce of six field representatives in the UK by distributing brochures, catalogues, newsletters and other print materials to customers and potential customers and by attending trade shows and conferences. In addition, the opponent advertises its EASYPACK products through its website, press releases, videos and social media. Examples of newsletters, catalogues and brochures are provided all bearing the mark Easypack in relation to packaging machines and packaging materials such as paper, void-fill paper cushions, shredded card and plastic air bags/cushions⁴. Photographs of the opponent's exhibition stands at various trade shows in the UK, Germany and France are also provided all showing use of the mark Easypack.⁵ Mr Voice also provides prints from the opponent's website showing use of the mark Easypack on, and in relation to, various packaging machines and packaging materials including paper rolls and plastic void-fill packaging⁶ and prints from the opponent's social media accounts showing adverts for Easypack goods.⁷

16) In the last five years, the opponent has spent £590,000 in the UK on promotional activities and advertising for the EASYPACK packaging products, broken down as follows:

Advertising & Promotions	£96,786
Marketing	£227,191
Catalogues, printed materials & CDs	£27,233
Fair and Exhibition Expenses	£206,224
Website services	£31,922
Total	£589,357

17) Mr Voice explains that the mark EASYPACK is well-known in the logistics, packaging solutions and packaging technology industry and is frequently mentioned

⁴ Exhibit GV4

⁵ Exhibit GV5

⁶ Exhibit GV6

⁷ Exhibit GV7

in press and trade publications. A number of such articles are provided from publications such as 'Warehouse and Logistics News', 'Intralogistics Magazine' and 'Packaging News' spanning 1999 to 2017. In those articles EASYPACK is described as being a leading manufacturer of high quality, sustainable and environmentally-friendly packaging solutions⁸.

18) The opponent has earned the Queen's Award for Enterprise: International Trade in the UK in 2003, 2009 and 2013 for its outstanding business.⁹ In June 2018, the opponent was announced as a finalist in the SHD Logistics Awards 2018 in the Environment and Sustainability category. The article from Warehouse & Logistics News UK detailing those awards refers to the Easypack brand as "the UK's leading brand of eco-friendly packaging solutions..."¹⁰

Applicant's evidence

19) This takes the form of a witness statement, dated 28 January 2019, from James Knight, Director of the applicant. Mr Knight explains that the applicant's business was established online in 2008 and supplies packaging materials, including cardboard boxes, bubble wrap, jiffy bags, packaging tape and polythene grip seal bags. Easipack is a trading style of the applicant.

20) Mr Knight also provides the following information:

- Easipack has a feedback score of 100% on ebay from the past ten years of trade. A snapshot of the applicant's 'Feedback profile' from www.ebay.co.uk (dated 28 Jan 2019) is provided. Mr Knight states that this feedback score has been maintained over 197,626 ebay orders. He does not provide any more information about those orders or explain how many of them took place before the relevant date of 15 December 2017 (the filing date of his application).
- Easipack also has an Amazon store that has been trading since 2015 with a "96% lifetime feedback score", as demonstrated in the accompanying

⁸ Exhibit GV8

⁹ Exhibit GV9

¹⁰ Exhibit GV10

snapshot print from www.Amazon.co.uk (also dated 28 Jan 2019). No information is given about the number of sales made through Amazon or whether any such sales took place before the relevant date.

- Easipack has a website at www.easipack.co.uk which has been trading online since 2011 and which supplies various packaging materials to customers predominantly in the UK. A snapshot of that website is provided listing various categories of packaging such as boxes, jiffy bags, tape and paper. In the top left-hand corner of the page is the mark 'EASI PACK' in a stylised font and with 'EASI' presented on a rectangular background which is shaped something like a speech bubble.
- In the last ten years, the applicant has spent approx. £1,020,000 on promotional activities, advertising and platform charges (equating to over £100,000 per annum). No further details are provided to show, for example, the nature of those activities or where they took place.

21) The applicant also filed brief submissions which I will not summarise here. Rather, I will refer to them when it is appropriate to do so in the following decision.

DECISION

Proof of use

22) Section 6A of the Act states:

“Raising of relative grounds in opposition proceedings in case of non-use

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), (b) 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 period of five years ending with the date of publication.

(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 period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(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.”

23) Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

Consequently, the onus is upon the opponent to prove that genuine use of mark 2 was made in the relevant period. (As I mentioned earlier, the scope of the applicant’s request for proof of use means that it is only mark 2, and only in respect of goods in class 16, for which genuine use must be proved.)

24) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He stated:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, 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]; *Centrotherm* at [71]; *Leno* 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]; *Centrotherm* at [71]; *Leno* at [29].

(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]. 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].

(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]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(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]; *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].”

25) In accordance with section 6A(3)(a) of the Act, the relevant period in which genuine use must be established is the period of five years ending on the date of publication of the contested mark. In the case before me, that period is 17 March 2013 to 16 March 2018.

26) The evidence before me shows substantial and continuous use of mark 2 in the UK over the relevant period. This is borne out by various aspects of the evidence such as the significant sales figures and numerous press articles recognising the opponent as one of the market’s leading and most reputable brands. The use is in various fonts and sometimes in the colour blue which, to my mind, falls within acceptable notional and fair use of the registered mark. Even if I am wrong on that, it clearly qualifies as use of the registered mark in a form differing in elements which do not alter its distinctive character.¹¹ I find that mark 2 has been put to genuine use in the relevant period.

¹¹ Having regard for the comments in *Nirvana Trade Mark*, BL O/262/06, [33] – [34]

27) I now need to consider what constitutes a fair specification, having regard for the goods upon which genuine use has been shown. 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.”

28) 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.

“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.”

29) The evidence shows genuine use on various items of plastic and paper packaging and wrapping including rolls of paper and void-fill materials. I find that the opponent is entitled to rely upon its specification in class 16, as registered.

Section 5(2)(b)

30) Both of the earlier marks contain the same word, albeit they are presented in different fonts and case; there is no material difference between them. Bearing this in mind, together with the wider breadth of goods covered by mark 2 (including goods in class 16), I need only consider that mark in my assessment of the likelihood of confusion. I will proceed accordingly.

31) 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.”

32) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

33) The goods to be compared are:

Opponent's goods	Applicant's goods
<p>Class 7: Machines for the manufacture of packaging and packing; parts and fittings therefor.</p> <p>Class 16: Packing paper and plastics; paper and plastics for wrapping, packaging and packing; void-fill materials made from plastics and paper.</p> <p>Class 22: Packing, cushioning and stuffing materials; paper twine.</p>	<p>Class 16: Packaging materials.</p>

34) In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) ('*Meric*'), the GC held:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

As the opponent's goods in class 16 are all types of packaging materials, they fall within the applicant's term 'Packaging materials'. Those respective goods are therefore identical in accordance with the *Meric* principle.

Average consumer and the purchasing process

35) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

36) The average consumer of the parties' goods in class 16 is the commercial user and the general public. The purchasing act will be primarily visual; they are likely to be selected after perusal of racks/shelves in retail establishments, or from Internet websites, trade catalogues or brochures. However, the aural aspect must still be considered because the goods may sometimes be the subject of discussions with sale representatives. While the goods may vary in price, they are not particularly costly items. I consider that the average consumer is likely to pay a normal degree of attention during the purchase.

Comparison of marks

37) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and

conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The 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.”

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

38) The marks to be compared are:

EASYPACK v Easipack

39) Both marks will be recognised as two words joined together (‘EASY’ and ‘PACK’ in the opponent’s mark and ‘Easi’ and ‘pack’ in the applicant’s mark). The two words in both marks form a unit in which neither dominates the other and the distinctiveness of each mark lies in the whole.

40) Visually, the only difference between the marks is in their fourth letter, being ‘Y’ and ‘i’ respectively. That difference is not a striking one given that it occurs within the middle of the words, as opposed to the beginning of the words which tend to have greater impact. The presentation of the marks in different cases is not a point of visual difference since, as plain word marks, both may be used in upper, lower or title case. There is patently a very high degree of visual similarity. Aurally, they will be pronounced in an identical fashion. Conceptually, the average consumer is likely

to recognise that 'Easi' in the applicant's mark is a mis-spelling of the well-known word 'Easy'. It follows that, insofar as either mark sends a clear conceptual message, it is identical. Any such message will be one of easy to use packs/packaging.

Distinctive character of the earlier mark

41) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

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

42) 'EASY' is likely to suggest to the consumer that the goods are easy to use and 'PACK' is a reference to the goods being packaging. While the overall message sent

by the combination of those two words is not descriptive, it is allusive i.e. packaging that is easy to use. I find the mark to have a fairly low degree of inherent distinctiveness.

43) I now turn to the question of whether the distinctiveness of EASYPACK has been enhanced through the use made of it in relation to goods in class 16. The evidence shows substantial sales of those goods in the UK every year since 2013 (averaging around £3 million per annum) together with frequent exposure in trade publications, many of which refer to EASYPACK as a leading manufacturer of packaging products. Mr Voice has also made an unchallenged statement that the opponent has the second largest share in the UK packaging market. I find that EASYPACK has been enhanced to a good degree in relation to the opponent's goods in class 16, at least insofar as commercial users are concerned.

Likelihood of confusion

44) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

45) The applicant draws my attention to two trade marks on the register for the mark EASYPACK (one of which is owned by the opponent). The applicant appears to contend that if those two identical marks can co-exist on the register then so too can the applicant's mark with the opponent's mark. This information does not assist the applicant. There are many reasons why two identical marks may co-exist on the register including (but not limited to) co-existence agreements made between the owners of such marks or because one (or both) are not actually in use. Their

presence on the register is irrelevant to the question of whether there is a likelihood of confusion between the marks at issue.

46) The applicant also states that there has been no conflict between its mark and the opponent's mark in the ten years in which the applicant has been trading. The problem for the applicant is that I cannot tell, from the evidence it has provided, how many of the ebay orders referred to took place prior to the relevant date of 15 December 2017 or the precise goods which were the subject of those orders. There is also no information showing the nature of the promotional activity or advertising referred to or where it took place. Further, it is unclear to what extent the mark, as applied for, has been used. In this connection, I note that the snapshot of the applicant's website shows use of a stylised version of the mark EASIPACK (as described in the evidence summary) rather than the word-only mark. For all these reasons, I find the evidence before me fails to establish that the average consumer has been exposed to both parties' marks for a sufficient length of time, and on such a scale, that they are able to distinguish between them.

47) I now turn to assess the likelihood of confusion, reminding myself of all my earlier findings. I have found that the respective marks are visually similar to a very high degree and aurally identical. Insofar as both marks send a clear conceptual message, it is identical. The goods at issue are also identical. All these factors clearly point strongly in the opponent's favour. I find that an average consumer paying a normal degree of attention is likely, through imperfect recollection, to confuse one mark for the other. In other words, there is a likelihood of direct confusion. I reach this conclusion for commercial consumers (for whom the mark has a good degree of distinctiveness) and the general public (for whom the mark may be perceived as fairly low in distinctiveness). The fairly low degree of distinctiveness of the earlier mark from the perspective of the latter group of consumers is not enough to outweigh all of the factors pointing strongly in the opponent's favour. **The claim under section 5(2)(b) of the Act succeeds.**

Section 5(3) and 5(4)(a)

48) The opposition under section 5(3) is based on the claimed reputation of marks 1 and 2 in relation to the packaging products for which they are registered. The claim under section 5(4)(a) is based on signs which are identical to marks 1 and 2 in relation to a business selling packaging products. As I have already found that the opposition under s.5(2)(b) succeeds, I do not consider it necessary to also assess the claims under ss.5(3) and 5(4)(a).

OUTCOME

49) The opposition succeeds and, subject to appeal, the application is refused registration.

COSTS

50) As the opponent has been successful, it is entitled to a contribution towards its costs. Using the guidance in Tribunal Practice Notice 2/2016, I award the opponent costs on the following basis:

Official fee:	£200
Preparing a statement and considering the applicant's statement	£300
Preparing evidence and considering the other side's evidence	£1000
Written Submissions	£500
Total:	£2000

51) I order Macro Packaging Ltd to pay Pregis Limited the sum of **£2000**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen

days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 26th day of June 2019

**Beverley Hedley
For the Registrar,
the Comptroller-General**