

BL O/674/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3593205

BY

easyGroup Ltd

TO REGISTER AS A TRADE MARK

EASYRIDER

IN CLASSES 16, 39 AND 41

AND

THE OPPOSITION THERETO

UNDER NO 425891

BY

NOTTINGHAM CITY TRANSPORT LIMITED

BACKGROUND AND PLEADINGS

1. On 9 February 2021, easyGroup Ltd ("the applicant") applied to register the above trade mark in classes 16, 39 and 41. In its skeleton argument filed in advance of a hearing, the opponent, Nottingham City Transport Limited, notified the tribunal that it no longer wished to oppose the services in class 41 of the application. The contested goods and services are as follows:¹

Class 16

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

Class 39

Transport; packaging and storage of goods; travel arrangement; travel information; provision of car parking facilities; transportation of goods, passengers, animals, pets, travelers by air, land, sea and rail; pet rescue services; transport of pets; transportation of animals; transportation of pet animals; airline and shipping services; airport check-in services; arranging of transportation of goods, passengers, animals, pets and travelers by land and sea; airline services; baggage handling services; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft, vehicles and boats; chauffeur services; taxi services; bus services; coach

¹ International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).





services; rail services; airport transfer services; airport parking services; aircraft parking services; escorting of travelers; travel agency services; tourist office services for arranging travel; advisory and information services relating to the aforesaid services; information services relating to transportation services, travel information and travel booking services provided on-line from a computer database or the Internet; delivery, collection, transport, forwarding and courier services; food and drink delivery, storage, collection, transport, forwarding and courier services; collection, transport, delivery, forwarding and courier services relating to goods, packages, gifts, parcels, documents, post, mail, correspondence, advertising materials; provision of information, advisory and consultancy services in relation to the aforesaid services.

2. The application was published on 30 April 2021, following which Nottingham City Transport Limited (“the opponent”) filed a notice of opposition against all the goods and services in the application.

3. The opposition is based on sections 5(1), 5(2)(a) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

4. For the purposes of the 5(2)(a) ground the opponent relies on the following mark:

Mark	Services relied on
<p>UKTM 2378918 – for a series of 6 trade marks:</p>	<p>Class 39: Passenger transport services; bus and coach transport services; transport of passengers by bus and/or coach; agency services for arranging travel; services for transportation of passengers and their luggage by road; reservation of tickets for journeys by bus and/or coach.</p>

<p>EASYRIDER</p> <p>easyrider</p>     <p>Applied for on 25 November 2004</p> <p>Registered on 27 May 2005</p>	
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5. The opponent claims that the parties' marks are identical.

6. With regard to the goods and services the opponent claims that the Class 39 services applied for are all identical or very similar to the opponent's class 39 services.

It claims the applicant's goods in class 16 are similar to the class 39 services covered by the earlier mark. The opponent concludes that the applicant's services in class 41 have a lower degree of similarity to its own class 39 services, but submits that this is offset by the signs being identical.

7. For the purposes of the 5(4) ground the opponent relies on the plain word EASYRIDER which it claims to have used since 1981 in Nottinghamshire and Leicestershire for 'passenger transport services; bus and coach transport services; transport of passengers by bus and/or coach; agency services for arranging travel; services for transportation of passengers and their luggage by road; reservation of tickets for journeys by bus and/or coach.' It claims that:

"16. The sign EASYRIDER has been used by the Opponent in the UK since 1981. Since this time, the Opponent has acquired a substantial reputation and goodwill in the sign EASYRIDER. The Applicant is aware of this reputation

following correspondence between the parties in 2004, copies of which will be provided during the course of evidence.

17. Use of the Application will amount to a misrepresentation on the behalf of the Applicant that its goods and services are those of the Opponent or are otherwise licenced or authorised by the Opponent, thereby causing damage to the Opponent's business..."²

8. The applicant filed a counterstatement in which it denies the grounds of opposition and requested that the opponent prove use of its earlier mark. In addition, it requested proof of the opponent's "earlier unregistered right and proof of the claimed enhanced distinctive character of its marks."³

9. Both sides filed evidence. The opponent filed a skeleton argument. A hearing took place before me on 18 May 2022 at which the opponent was represented by Charlotte Blythe of Counsel, instructed by Browne Jacobson LLP. The applicant is represented by Kilburn & Strode LLP, but did not attend the hearing.

10. The opponent's evidence is provided by a witness statement of David John Astill and exhibits DA01-DA09. Mr Astill is currently the managing director of the opponent, a position he has held since April 2021. Since 1998 he has held senior appointments in the bus industry and has been employed by the opponent since 2007. His evidence relates to the opponent's business and use of the sign/mark EASYRIDER. His statement is dated 18 June 2021.

11. The applicant's evidence is provided by a witness statement of Ryan Edward Pixton and exhibits REP1-REP4. Mr Pixton is a Trade Mark Attorney with the applicant's representatives. His evidence relates to use of EASYRIDER by the applicant, in the 1990s, for a magazine. His statement is dated 13 December 2021.

12. I will refer to the evidence as necessary throughout this decision.

² See the opponent's statement of case, attached to its notice of opposition.

³ See paragraph 8 of the applicant's counter statement.

13. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive and, therefore, this decision continues to refer to the trade mark case law of the EU courts.

Preliminary issues

14. The evidence filed by Mr Pixton on behalf of the applicant is introduced by a witness statement which gives no additional narrative. The four exhibits are, firstly, a still from a YouTube video, titled 'easyHistory -The easy family of brands photo album'. The still in the printed copy shows the front cover of a magazine named 'easyRider', with 1996 printed above it. The cover shows a photo of the Rolling Stones.⁴

15. The second exhibit is the same 'photo album' but each page has been exhibited separately. It shows the same 'easyRider' magazine cover with the Rolling Stones cover, this time labelled June 1999. A second cover dated 1998 has a front cover depicting Bill Clinton.⁵

16. The third exhibit is undated pages from eBay which are headed, 'EasyJet collectable airline brochures and inflight magazines'. Only one Easyrider magazine is shown and it is the same Rolling Stones cover. The inflight magazines on the same page dated 2004 and 2005 are both titled 'Easyjet'.⁶

17. The fourth and final exhibit is a profile of the Easyjet founder which Mr Pixton states is featured in the easyRider magazine but the magazine is neither mentioned nor shown anywhere on the exhibited page, which is not dated.⁷

18. There is no indication of what the applicant intends to show with this evidence, no claim has been made to an earlier date of use. Even if it had, this evidence falls a long way short of showing use of any kind. The same magazine cover with several contradictory dates and

⁴ See exhibit REP1.

⁵ See exhibit REP2.

⁶ See exhibit REP3.

⁷ See exhibit REP4.

one other cover, in the absence of any further explanation, is unhelpful and I will say no more about this evidence.

DECISION

19. I will begin by assessing the opponent's case under section 5(4)(a) of the Act.

20. Section 5(4)(a) of the Act states that:

5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met...

(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.

21. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341, HL, Lord Oliver of Aylmerton described the 'classical trinity' that must be proved in order to reach a finding of passing off:

"First, [the plaintiff] must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of

the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."⁸

22. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

⁸ Page 406.

- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action”.

Relevant date

23. In terms of the relevant date for assessment of this ground, in *Advanced Perimeter Systems Limited v Multisys Computers Limited*,⁹ Mr Daniel Alexander QC, sitting as the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in *SWORDERS Trade Mark*:¹⁰

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”

24. There is no claim to earlier use by the applicant and so the relevant date for assessment of the opponent’s claim under this ground is the date of application of the contested EASYRIDER trade mark, namely, 9 February 2021.

Goodwill

25. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a

⁹ BL O-410-11

¹⁰ BL O-212-06

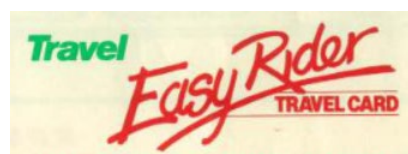
business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

26. The opponent must show that it had goodwill in a business at the relevant date and that the sign relied upon, EASYRIDER, is associated with, or distinctive of, that business. The relevant evidence and my conclusions from it follow.

27. The opponent’s witness, Mr Astill, states that the opponent was incorporated on 27 March 1986. The opponent currently employs in the region of 1,100 people. It has a fleet of 310 buses and had an annual turnover of £53.689 million in the year ending March 2019. The opponent holds an 85% market share in the greater Nottingham bus market. The opponent expanded its operation into Leicestershire in 1991, when it purchased South Notts Bus Co. Ltd.

28. Mr Astill says that the opponent first used the EASY RIDER sign in 1981¹¹ when the EASY RIDER TRAVEL CARD was launched. It offered customers 14 or 28 day pre-paid travel at a discounted rate. 12,000 customers purchased an Easy Rider card in the first year of its operation.¹²

29. Mr Astill provides copies of advertising material from the initial launch of the ‘Easy Rider’ travel card in 1981. The sign is shown in the following form:¹³



30. And:



¹¹ Prior to the opponent’s incorporation in its current form.

¹² See exhibit DA01, page 9.

¹³ See exhibit DA5, page 2.

31. The accompanying text provides details of introductory prices, valid from 1 March 1981.

32. 'Easy Rider' travel cards were available in local stores, initially Littlewoods and then also at the Co-op.¹⁴ At some time in the early 1990s the opponent opened an information centre which provided travel advice and 'Easy Rider' travel cards. Reference to it can be seen in this advertisement, which Mr Astill states is from 1990:¹⁵

Do your bus fares add up like this?

60p each way	=	£1.20 a day
5 days a week	=	£6.00 a week
4 weeks	=	£24

For the same period, Easy-Rider costs **ONLY £22** - AND you can make as many journeys as you want, 7 days a week!

CUT THE COST OF BUS TRAVEL WITH
Easy Rider
TRAVEL CARD
Your Network Ticket

From our
King Street Information Centre

 **Nottingham City Transport** Information 503665 **We get you there**

33. Use in that form continued until 2004. Following the launch of the Nottingham tram system in 2004, the opponent embarked on a rebrand.

34. A page taken from the opponent's website via Waybackmachine shows an article outlining the launch of rebranded Easy Rider cards. The page is dated 9 March 2004, and says that the opponent, "...now operate[s] the largest smartcard travel card system in the UK with over 70,000 passes in regular use".¹⁶

35. The same article explains that the Easyrider travel card can be used on buses and trams and can be renewed via direct debit, telephone or at the opponent's travel centre.

36. A 'Fares and Tickets' leaflet dated August 2004 shows the range of Easyrider passes available. These were: Easyrider city, Easyrider scholar, Easyrider anytime and an Easyrider farecard. The sign is shown in the following form:

¹⁴ See exhibit DA05, part 4.

¹⁵ See exhibit DA05, part 5, page 13.

¹⁶ See exhibit DA05, part 8, page 23.



37. The typeface remains the same throughout the range of travel cards, with a different background colour for each type of card. For example, the Easyrider anytime card had a pink background:



38. The opponent rebranded in 2015, introducing a new suite of Easyrider products. From then until at least the relevant date, the opponent has used the sign in the following form:



39. The new Easyrider products are shown in 'The Easyrider Guide'. The image reproduced here is from a version issued in 2015:¹⁷

¹⁷ See exhibit DA09, part 1, pages 7-15.



40. The guide also includes maps of 'Easyrider routes', details of fares and advises users of 'Easyrider Extras' which give card holders a range of discounts and special offers in 30 outlets across Nottingham.¹⁸

41. Mr Astill provides photographs of Easyrider advertising on the opponent's buses. These images are from 2005:



42. And these from 2016:

¹⁸ See exhibit DA09, part 1, page 15.



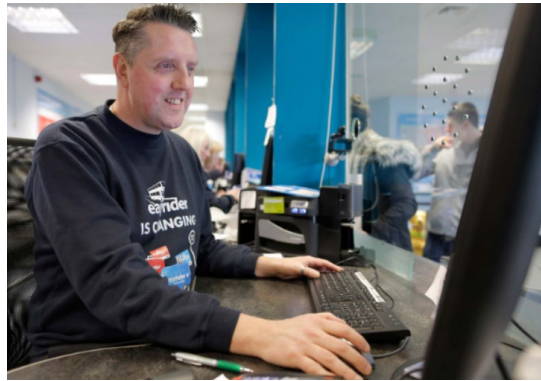
43. Mr Astill also provides examples of artwork which he states was used in the interior of the opponent's buses in 2018:



44. Photographs of the interior of the opponent's travel centre are provided for 2012:



45. And 2021:



46. The opponent offers several ways to pay for tickets, including online, at its travel centre and by mobile. The following was included in the 'Fares and Ticket Guide' dated Sunday 31 March 2019:¹⁹



47. The opponent also provides an Easyrider epurse (previously 'Easyrider Farecard'), which allows a traveller to put money onto a card and then use it to pay for fares on the bus. The fares have a discount applied (15% in the example provided in evidence, though this was printed after the relevant date).²⁰

48. The opponent's website www.nctx.co.uk has details of Easyrider products and how to pay for them. The website page was printed after the relevant date, but the Easyrider smart cards referred to are described as valid from 24 August 2020.²¹

49. With regard to the way in which its travel passes are purchased, Mr Astill states:
"23. '...The Opponent's 'EASYRIDER' services allow customers to reserve the right to travel on the Opponent's vehicles by purchasing a specified number of

¹⁹ See exhibit DA09, part 2, page 25

²⁰ See exhibit DA03.

²¹ See exhibit DA04.

tickets in advance. The customer is then able to redeem those tickets in the future for travel on the Opponent's services, either on specified days...or on days of the customer's choosing..."

50. Mr Astill provides turnover figures for the sale of goods and services under the EASYRIDER brand, such as Easyrider cards. These figures and the number of 'Journeys' for which they were used are calculated to the nearest thousand. The figures are as follows:

Year ending:	Revenue:	Journeys:
March 2012	10,951,000	16,501,000
March 2013	11,013,000	15,596,000
March 2014	11,663,000	16,239,000
March 2015	12,611,000	17,184,000
March 2016	11,939,000	16,454,000
March 2017	13,191,000	17,124,000
March 2018	13,080,000	17,491,000
March 2019	13,673,000	17,479,000
March 2020	14,853,000	17,311,000
March 2021	5,862,000	4,320,000
Total	118,836,000	155,699,000

51. He confirms that the lower figures for 2021 reflect the reduction in travel due to the Covid pandemic.

52. Mr Astill also provides a table of costs incurred in promoting the EASYRIDER brand. He states that these figures do not include the £59,000 spent, since 2016, on advertisements inside and outside of 'its fleet of buses'. The figures are as follows:

Year ending:	Cost (£):
March 2013	20,226.64
March 2014	5,736.00
March 2015	37,825.00
March 2016	41,266.43
March 2017	13,067.00

March 2018	10,744.00
March 2019	20,952.30
March 2020	11,494.10
March 2021	1,540.00
Total	162,851.47

53. The opponent has won numerous awards and provides details of those for the period beginning 2004. Mr Astill draws my attention to the fact that the opponent is the only bus operator to have won ‘UK Bus Operator of the Year’ five times - in 2004, 2012, 2014, 2016 and 2019. It has also been runner-up in the Innovation Award for its Easyrider Anytime card in 2005 and Runner-up for the ‘Winning new customers Award’ for its Easyrider and Citycard in 2008.²² It has won other awards for customer excellence, environmental awards for a fleet of bio-gas buses and has won ‘Large Fleet Operator’ and ‘UK City Operator of the Year’ awards on multiple occasions.

54. It is clear from the evidence that the opponent has a business providing public transport for customers, primarily in, but not limited to, the Nottinghamshire area and I find that there is substantial goodwill in that business, sufficient to be protected under the law of passing off.

55. The opponent’s business uses more than one sign to provide its services and I find that the signs associated with the opponent’s goodwill include, at least, Nottingham City Transport (NCT, which is the provider of the transport services offered by the opponent) as the nominal ‘house brand’, with a number of other signs used for a range of products and services. These additional brands include the Easyrider sign.

56. The Easyrider sign has been used for a range of travel products which enable customers to travel on the opponent’s public transport services. These take the form of travel passes and cards available in both physical form and electronically, via a mobile app. The opponent’s business model allows the consumer to arrange and reserve their own travel in advance by using the opponent’s digital offering to access the Easyrider products, by website or mobile app. Alternatively, the customer can contact the opponent’s travel centre where advice and booking services can be accessed. There is clearly a degree of

²² See exhibit DA02.

co-branding between Nottingham City Transport (who provide the advice centre) and the Easyrider brand which provides access to transport services. A travel centre employee is shown wearing an Easyrider branded sweatshirt and the Easyrider travel service appears to be the dominant product advertised throughout the centre.

57. The opponent's Easyrider sign is used in two-word form, 'Easy Rider' (until 1994) and conjoined, as 'Easyrider' (from 1994 until at least the relevant date). In both versions the words EASY and RIDER are clearly discernible by the relevant public with the distinctive character of the mark unaltered by the presence or absence of the space between the two words. Three different typefaces have been used throughout the use period, but the sign has always been clearly legible and has not been altered by the various presentations. There is some use of the words with a stylised bus image and a large volume of plain word use in the opponent's information literature. Overall, I find that the opponent's goodwill is associated with the plain word 'Easyrider' (with or without the space between the two words).

58. Taking all my findings into account, I find that the evidence is sufficient to demonstrate that at the relevant date the opponent had protectable goodwill in its sign Easyrider for a range of ticket and travel pass related goods and services. However, the only one of these services on which it has relied in its pleadings is 'reservation of tickets for journeys by bus or coach'. I shall proceed on that basis.

Misrepresentation

59. In *Neutrogena Corporation and Another v Golden Limited and Another*, Morritt L.J. stated that:²³

"There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is:

'is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public

²³ [1996] RPC 473

will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]?'

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

60. On the subject of how many of the relevant public must be deceived or confused for the opponent to be successful in a claim under this ground, I bear in mind the decision in *Lumos Skincare Limited v Sweet Squared Limited and others*,²⁴ in which Lord Justice Lloyd commented on the paragraph above as follows:

"64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the "substantial number" of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small."

61. With regard to the location of the goodwill shown by the opponent, it lies in a business operated in the Nottinghamshire and Leicestershire areas of the UK. The nature of the services, being local public transport services, are such that the goodwill generated by the opponent's business is likely to remain, for the most part, in the locality in which it operates. In *Caspian Pizza Limited and Ors v Shah and Ors*²⁵ the court was required to consider local goodwill generated by two parties, in two geographic areas. However, the following paragraph from that case is relevant here:

"23. It is, I think, implicit in these provisions that opposition under s.5(4) based on earlier use of the mark does not have to be use throughout the UK or

²⁴ [2013] EWCA Civ 590

²⁵ [2017] EWCA (Civ) 1874

alternatively in a geographical area which overlaps with the place where the applicant for registration actually carries on business using the same or a similar mark. As the Hearing Officer explained in *SWORDERS*, the application for a national mark operates as a notional extension of the use of the mark over the whole of the country. The only requirement is that the opponent should have established goodwill in the mark over an identifiable geographical area that would qualify for protection in passing off proceedings. Reputation may be enjoyed on such a small scale that it does not generate goodwill at all...but goodwill which is established in a particular locality will be capable of preventing registration of a countrywide mark.”

62. In other words, the fact that the goodwill shown in evidence is less than national does not prevent the claim succeeding since the contested trade mark application is a UK registration which, notionally, may be used in the same geographic area.

63. The opponent has goodwill in the sign Easyrider. The application is made for the word EASYRIDER. Clearly these are identical signs. The earlier sign alludes to a system which allows a passenger to ‘ride’ transport easily, but I do not find it to be directly descriptive of the opponent’s services. Accordingly, it is slightly lower than average in terms of its distinctiveness.

Similarity between the opponent’s services and the applicant’s goods and services

64. On the matter of the opponent’s goodwill, as I have already found, the Easyrider sign is used for a range of travel products which give its passengers access to its bus services. The opponent’s mobile app and website allow the opponent’s customers to reserve a number of journeys in advance (at a discounted rate) and then use a travel pass or mobile app to access the relevant bus service(s). The schemes available include options for daily travellers and for occasional users of the opponent’s services. The mobile app is shown as follows:



65. At the hearing, Ms Blythe, for the opponent, submitted that the relevant public for the relevant goods and services in this case is unlikely to distinguish between tickets and travel passes that allow them to access travel services and the travel service itself. She concluded that the applicant's goods and services and the opponent's services (for which it has shown goodwill) are highly similar. I remind myself here that the opponent has not claimed to have goodwill in the tickets themselves and has shown goodwill only in respect of ticket reservation services, the transport services being provided under the 'house brand' Nottingham City Transport.

66. When a customer buys a ticket for future travel the role of the reservation service is to provide the ticket (whether electronically or in printed form) as an item of commerce as a means of accessing the latter service. The ticket is not purchased for its own intrinsic value but for the fact that it allows use of the related transport services.²⁶ In my own experience, it is not unusual to find ticket reservation services and the related transport services provided by the same undertaking. In that way, the transport services themselves and the tickets, and channels through which they are purchased are inextricably linked.

67. Consequently, I find there is a medium degree of similarity between the opponent's 'reservation of tickets for journeys by bus or coach' and the bus tickets themselves and a slightly lower level of similarity between the bus ticket reservation services and the bus transportation services themselves.

68. The parties' marks are identical and bearing in mind the complementary nature of the parties' goods and services, I consider that a person who is aware of the opponent's Easyrider services in the context of bus transport would believe that the proprietor's

²⁶ I have borne in mind that there are collectors of ephemera who specialise in transport tickets. However, this is likely a small proportion of the relevant public and does not reflect 'normal' marketplace conditions.

Easyrider goods and services (to the extent that they relate to bus and coach transport) would originate from the same undertaking.

69. In conclusion, use of the proprietor's mark at the relevant date would have constituted a misrepresentation to a substantial number of people, in respect of the following goods and services:

Class 16

Tickets, vouchers, coupons and travel documents; documents, tickets and publications, all relating to travel arranged by means of the world-wide web; travel documents folders.

Class 39

Transport; Transportation of passengers and travellers by land; bus services; coach services; airport transfer services; arranging of transportation of passengers and travellers by land; travel arrangement; travel information; advisory and information services relating to the aforesaid services; information services relating to transportation services, travel information and travel booking services provided on-line from a computer database or the Internet; provision of information, advisory and consultancy services in relation to the aforesaid services.

70. And also, for the following broad terms which include bus tickets and timetables, arranging bus tours and services which may be provided by buses:

Class 16

Printed matter and publications; pamphlets, newsletters, brochures.

Class 39

Transport services; arranging operating and providing facilities for tours, excursions and vacations;

Damage

71. Having found that the goodwill and misrepresentation limbs of the test have been satisfied and in respect of the goods and services I have found to be similar, it follows that damage to the applicant's goodwill will arise, most obviously, by diverting trade from the applicant to the proprietor.

72. I note that in *WS Foster & Son Limited v Brooks Brothers UK Limited* [2013] EWPC 18, Mr Recorder Iain Purvis QC stated:

“Damage

55 Although proof of damage is an essential requirement of passing off cases, it will generally be presumed where a misrepresentation leading to a likelihood of deception has been established, since such deception will be likely to lead to loss of sales and/or more general damage to the exclusivity of the Claimant's unregistered mark. Mr Aikens accepted that if there was a misrepresentation in the present case, then he had no separate case on damage. I hold that damage is inevitable, at least in the sense recognised in *Sir Robert McAlpine v Alfred McAlpine* [2004] RPC 36 at 49 (the ‘blurring, diminishing or erosion’ of the distinctiveness of the mark).”

73. I find that to be the case here. I therefore find that use of the proprietor's mark at the relevant date was liable to be restrained under the law of passing off, in respect of the goods and services identified above at paragraphs 66 and 67.

74. The opposition partially succeeds under section 5(4)(a) of the Act.

Additional grounds

75. With regard to the remaining grounds, I will briefly consider the opponent's case under the 5(2)(a) ground, which reads as follows:

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the 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.”

76. The opponent relies on its registration for a series of six Easyrider trade marks - which is subject to proof of use. This is because, at the date of application of the contested mark, it had been registered for five years.²⁷ I will refer to the mark as ‘Easyrider’ by which I mean to include all six of the marks in the series. The relevant date for the purposes of showing genuine use is the period 10 February 2016 to 9 February 2021.

77. The opponent claims to have made use of its Easyrider mark in respect of the following services in class 39:

Passenger transport services; bus and coach transport services; transport of passengers by bus and/or coach; agency services for arranging travel; services for transportation of passengers and their luggage by road; reservation of tickets for journeys by bus and/ or coach.

78. I bear in mind the relevant case law for an assessment of genuine use²⁸ and find that the opponent’s evidence of genuine use shows use for the same services as those for which there is goodwill in the EASTRIDER sign under the previous ground, that is, ‘reservation of tickets for journeys by bus or coach’. The opponent’s business model has not altered since the earliest evidence, it has simply altered the range of tickets and travel passes which are available over the lifetime of the business. Since the opponent does not have a registration for tickets, these goods are not relied on. There is no use shown of the Easyrider mark for the transport services themselves, which are provided by Nottingham City Transport (and the related networks for Leicestershire busses and the tram network).

²⁷ See section 6A(3)(a) of the Act (added by virtue of the Trade Marks Regulations 2018: SI 2018/825) which came into force on 14th January 2019.

²⁸ See the summary in *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) by Arnold J (as he was then).

79. The application is made for the plain word EASYRIDER and the opponent's series of marks includes the plain word EASYRIDER as the first in the series. The respective marks are identical.

80. The average consumer is a member of the general public for the services in classes 16 and 39.²⁹

81. With regard to the comparison of goods and services, I bear in mind the decisions in *Gérard Meric v OHIM*³⁰ and *British Sugar Plc v James Robertson & Sons Limited (Treat)*.³¹ The users and uses overlap for the opponent's reservation services and the applicant's travel related services and they are also likely to be accessible through the same trade channels. With regard to the complementary nature of the goods and services I consider *Kurt Hesse v OHIM*,³² in which the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*,³³ the General Court stated that "complementary" means:

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

82. In *Sanco SA v OHIM*,³⁴ the General Court indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings.

²⁹ See *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*²⁹ [2014] EWCH 439 (Ch).

³⁰ Case T-133/05

³¹ [1996] R.P.C. 281

³² Case C-50/15 P

³³ Case T-325/06

³⁴ Case T-249/11

83. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited*:³⁵

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

84. Whilst on the other hand:

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

85. There is a complementary relationship between the services which the opponent can rely on and the goods and services I have already identified under the 5(4)(a) finding at paragraphs 69 and 70. This varies from identical services for reservation services that can include reservation for bus and coach travel, to a lower degree of similarity between the opponent’s services and the tickets themselves and the opponent’s services and the transport services themselves.

86. The opponent’s EASYRIDER mark is of slightly lower than average distinctiveness but is perfectly capable of operating as an effective trade mark in the relevant business market.³⁶ A consumer familiar with EASYRIDER providing reservation services for bus travel would simply see the applicant’s EASYRIDER services (identified at paragraphs 69 and 70 above) as a brand extension of that business.³⁷ I find that for goods and services where there is any degree of similarity, the use of the application will give rise to a likelihood of indirect confusion with the opponent’s earlier EASYRIDER mark.

87. In other words, for all the reasons I have outlined above, the opponent’s case under this ground gets it no further than the findings I have already made.

³⁵ BL-0-255-13

³⁶ I do not find the distinctive character of the earlier mark to have been enhanced. Use is shown for a fairly small geographic area and the turnover figures include figures for ticket sales, which the opponent is not relying on. I do not have sufficient evidence to consider such a claim.

³⁷ See the comments of Iain Purvis QC, sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc.*

88. The opponent's claim under 5(1) takes it no further. A claim under this ground only relates to identical marks where the parties also have identical goods and services in their specifications. The opponent has already succeeded with regard to those identical services under the other two grounds I have already determined.

Conclusion

89. The applicant's mark can proceed to registration for the following goods and services:

Class 16

Albums, books, manuals, newspapers, magazines and periodicals; travellers cheques; travel guide books; identity cards, not encoded; labels and tags; posters, postcards, stationery, writing instruments, wrapping materials, calendars, diaries, photographs, gift cards and greetings cards; cardboard badges, paper badges, paper name badges; teaching and instructional materials; promotional and advertising material; signs of paper or cardboard.

Class 39

Packaging and storage of goods; provision of car parking facilities; transportation of goods, animals, pets, by air, land, sea and rail; travel agency services; tourist office services for arranging travel; transport of passengers and travellers by air, sea and rail; pet rescue services; transport of pets; transportation of animals; transportation of pet animals; airline and shipping services; airport check-in services; arranging of transportation of goods, animals, pets and by land and sea; arranging of passengers and travelers by sea; airline services; baggage handling services; cargo handling and freight services; arranging, operating and providing facilities for cruises; chartering of aircraft; rental and hire of aircraft, vehicles and boats; chauffeur services; taxi services; rail services; airport parking services; aircraft parking services; escorting of travelers; delivery, collection, forwarding and courier services; food and drink delivery, storage, collection, transport, forwarding and courier services; collection, transport, delivery, forwarding and courier services relating to goods, packages, gifts, parcels, documents, post, mail, correspondence, advertising materials.

Costs

90. Both parties have achieved a measure of success and I find that each should bear their own costs.

Dated this 11th day of August 2022

Al Skilton

**For the Registrar,
the Comptroller General**