

O-190-03

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2227364  
BY SIEMENS FINANCIAL SERVICES LIMITED  
FOR THE TRADE MARKS:**

**ease-e:finance  
EASE-E:FINANCE**

**(a series of two)**

**AND THE CONSOLIDATED OPPOSITIONS THERETO  
UNDER NOS 51515 AND 51516  
BY EASYGROUP IP LICENSING LIMITED**

**Trade Marks Act 1994**  
**in the matter of application no 2227364**  
**by Siemens Financial Services Limited**  
**for the trade marks:**  
**ease-e:finance**  
**EASE-E:FINANCE**  
**(a series of two)**  
**and the consolidated oppositions**  
**thereto under nos 51515 and 51516**  
**by easyGroup IP Licensing Limited**

## **Background**

1) On 28 March 2000 Schroder Leasing Limited applied to register **ease-e:finance** and **EASE-E:FINANCE** (the trade marks) as a series of two trade marks. The application was published for opposition purposes in the "Trade Marks Journal" on 5 July 2000. Since the filing of the application Schroder Leasing Limited has changed its name to Siemens Financial Services Limited (referred to afterwards as Siemens). Since publication the specification of the application has been amended. It now reads as follows:

*computer software all relating to processing financial transactions; electronic publications and computer software accessible and downloadable from the Internet, all relating to processing financial transactions*

*printed matter; financial and banking documents; magazines; reports and circulars; all the aforesaid relating to the provision of financial services*

*services relating to leasing and hire purchase arrangements; finance procurement and other financing arrangements; insurance services relating to the aforesaid services; professional consultancy services relating to leasing, hire purchase and other commercial and financial transactions; information services and professional consultancy services relating to all the aforesaid services, including those services accessible through web-pages on the Internet or other databases or computer networks*

*consultancy services relating to the design, development and implementation of computer systems and networks for processing financial transactions*

The above goods and services are in classes 9, 16, 36 and 42 of the International Classification of Goods and Services respectively. The oppositions were not withdrawn following the amendment to the specification.

2) On 5 October 2000 Easyjet Airline Company Limited and easy Group Limited each filed an opposition to Siemens' application. On 6 November 2001 the two oppositions

were consolidated and on 9 April 2002 easyGroup IP Licensing Limited (referred to afterwards as easyGroup) took over as the opponent in the consolidated proceedings.

3) easyGroup relies upon the following trade marks in its opposition:

**EASYJET**

United Kingdom registration no 2016785 in respect of:  
Printed matter and publications; books, manuals, pamphlets, newsletters, albums, newspapers, magazines and periodicals; tickets, vouchers, coupons and travel documents; identity cards; labels and tags; posters, postcards, calendars, diaries, photographs, gift cards and greetings cards; teaching and instructional materials – class 16

Transportation of goods, passengers and travellers by air; arranging of transportation of goods, passengers and travellers by land and sea; airline and shipping services; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; ambulance services; rental and hire of vehicles, boats and aircraft; travel agency and tourist office services; consultancy and advice relating to all the aforesaid services – class 39

Temporary accommodation; catering, hotel, restaurant, cafe and bar services; reservation services for hotel accommodation; provision of exhibition facilities; meteorological information services; hairdressing, grooming and beauty salon services – class 42

**EASYTRAIN**

United Kingdom registration no 2112957 in respect of:  
Transportation of goods, passengers and travellers by land; arranging of transportation of goods, passengers and travellers by land; arranging, operating and providing facilities for tours, excursions and vacations; travel agency and tourist office services; consultancy and advice relating to all the aforesaid services – class 39

**EASYBUS**

United Kingdom registration no 2112956 in respect of:  
Transportation of goods, passengers and travellers by land; arranging of transportation of goods, passengers and travellers by land; coach services; arranging, operating and providing facilities for tours, excursions and vacations; travel agency and tourist office services; consultancy and advice relating to all the aforesaid services – class 39

**easyTrak/  
EASYTRAK**  
(series of two)

United Kingdom registration no 2168662 in respect of:  
Printed matter and publications; books, manuals, pamphlets, newsletters, albums, newspapers, magazines and periodicals; tickets, vouchers, coupons and travel documents; identity cards; labels and tags; posters, postcards, calendars, diaries, photographs, gift cards and greetings cards; teaching and instructional materials; all relating to travel – class 16

Transportation of goods, passengers and travellers by air; arranging of transportation of goods, passengers and travellers by land and sea; airline and shipping services; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; ambulance services; rental and hire of vehicles, boats and aircraft; travel agency and tourist office services; consultancy and advice relating to all the aforesaid services – class 39

Temporary accommodation; catering, hotel, restaurant, cafe and bar services; reservation services for hotel accommodation; provision of exhibition facilities; meteorological information services; hairdressing, grooming and beauty salon services – class 42

**easyWeb/**  
**EASYWEB**  
(series of two)

United Kingdom registration no 2168668 in respect of:

Printed matter and publications; books, manuals, pamphlets, newsletters, albums, newspapers, magazines and periodicals; tickets, vouchers, coupons and travel documents; identity cards; labels and tags; posters, postcards, calendars, diaries, photographs, gift cards and greetings cards; teaching and instructional materials; all relating to travel – class 16

Transportation of goods, passengers and travellers by air; arranging of transportation of goods, passengers and travellers by land and sea; airline and shipping services; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; ambulance services; rental and hire of vehicles, boats and aircraft; travel agency and tourist office services; consultancy and advice relating to all the aforesaid services – class 39

Temporary accommodation; catering, hotel, restaurant, cafe and bar services; reservation services for hotel accommodation; provision of exhibition facilities; meteorological information services; hairdressing, grooming and beauty salon services – class 42

**easy extras/**  
**easyExtras/**  
**EASY EXTRAS/**  
**EASYEXTRAS**  
(series of four)

United Kingdom registration no 2168672 in respect of:

Printed matter and publications; books, manuals, pamphlets, newsletters, albums, newspapers, magazines and periodicals; stationery; tickets, vouchers, coupons and travel documents; identity cards; labels and tags; posters, postcards, calendars, diaries, photographs, gift cards and greetings cards; teaching and instructional materials; travel documents folders; travel guide books; travellers cheques – class 16

Travel luggage, travel bags; travel garment covers; travellers bags made from leather or imitation leather, travelling sacks and handbags – class 18

Insurance services – class 36

Transportation of goods, passengers and travellers by air;

arranging of transportation of goods, passengers and travellers by land and sea; bus transport services, car transport services, coach services; airline and shipping services; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; ambulance services; rental and hire of vehicles, boats and aircraft; travel agency and tourist office services; consultancy and advice relating to all the aforesaid services – class 39

Temporary accommodation; catering, hotel, restaurant, café and bar services; reservation services for hotel accommodation; provision of exhibition facilities; meteorological information services; hairdressing, grooming and beauty salon services – class 42

**easyExtras**

Community trade mark registration no 848424 in respect of:

Printed matter and publications; books, manuals, pamphlets, newsletters, albums, newspapers, magazines and periodicals; stationery; tickets, vouchers, coupons and travel documents; identity cards; labels and tags; posters, postcards, calendars, diaries, photographs, gift cards and greetings cards; teaching and instructional materials; travel documents folders; travel guide books; travellers cheques – class 16

Travel luggage, travel bags; travel garment covers; travellers bags made from leather or imitation leather, travelling sacks and handbags – class 18

Insurance services – class 36

Transportation of goods, passengers and travellers by air; arranging of transportation of goods, passengers and travellers by land and sea; bus transport services; car transport services; coach services; airline and shipping services; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; ambulance services; rental and hire of vehicles, boats and aircraft; travel agency and tourist office services; consultancy and advice relating to all the aforesaid services – class 39

Temporary accommodation; catering, hotel, restaurant, café and bar services; reservation services for hotel accommodation; provision of exhibition facilities; meteorological information services; hairdressing, grooming and beauty salon services – class 42

**EASYCAFÉ**

Community trade mark registration no 931790 in respect of:

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies; jams, fruit sauces; eggs, milk and milk products; edible oils and fats; prepared meals – class 29

Coffee; tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals; bread, pastry and

confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; prepared meals – class 30

Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages – class 32

Alcoholic beverages (except beer) – class 33

Business information services – class 35

Telecommunication services – class 38

Restaurant and bar services; catering services; design of computer software; provision of access to computers and the internet; internet services; provision of on-line services – class 42

**EASY  
EVERYTHING**

United Kingdom registration no 2182641 in respect of:

Restaurant and bar services; catering services; design of computer software; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; hosting, creating and maintaining web sites for others; leasing access time to a computer data base – class 42

**easycard/  
EASYCARD**  
(series of two)

United Kingdom registration no 2184827A in respect of:

Clothing; headgear; footwear – class 25

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies; jams, fruit sauces; eggs, milk and milk products; edible oils and fats; prepared meals – class 29

Coffee; tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals; bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; prepared meals – class 30

Beers; mineral and aerated water and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages – class 32

Alcoholic beverages (except beer) – class 33

**easycard/  
EASYCARD**  
(series of two)

United Kingdom application no 2184827B in respect of:

Computer software; computer hardware; pre-recorded CD Roms and other disk carriers; sunglasses – class 9

Business information services – class 35

Telecommunication services – class 38

Restaurant and bar services; catering services; design of computer software; provision of access to computers and the Internet; Internet services; provision of on-line services – class 42

**easyPay/  
EASYPAY**  
(series of two)

United Kingdom registration no 2184833B in respect of:  
Clothing; headgear; footwear – class 25  
Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies; jams, fruit sauces; eggs, milk and milk products; edible oils and fats; prepared meals – class 29  
Coffee; tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals; bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; prepared meals – class 30  
Beers; mineral and aerated water and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages – class 32  
Alcoholic beverages (except beer) – class 33

**easyPay/  
EASYPAY**  
(series of two)

United Kingdom trade mark application no 2184833A in respect of:  
Computer software; computer hardware; pre-recorded CD Roms and other disk carriers; sunglasses – class 9  
Business information services – class 35  
Telecommunication services – class 38  
Restaurant and bar services; catering services; design of computer software; provision of access to computers and the Internet; Internet services; provision of on-line services – class 42

**easyJet. the web's  
favourite airline**

Community trade mark registration no 1132596 in respect of:  
Transportation of goods, passengers and travellers by air; airport check-in services; arranging of transportation of goods, passengers and travellers by land; airline services; baggage handling services; cargo handling and freight services; operating and providing facilities for tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft; aircraft parking services; travel agency and tourist office services; advisory and information services relating to the aforesaid services; information services relating to transportation services, including information services provided on-line from a computer database or the internet – class 39

Information relating to entertainment and education, provided on-line from a computer database or the Internet; entertainment services provided on-line from a computer database or the Internet; educational information provided on-line from a computer database or the Internet – class 41

**easyTech**

Community trade mark registration no 1128743 in respect of:  
Vehicles; apparatus for locomotion by land, air or water; aircraft; parts and fittings for the aforesaid goods included in

class 12.

Aircraft repair and maintenance services, aircraft cleaning services, aircraft washing services – class 37

Transportation of goods, passengers and travellers by air; airport check-in services; arranging of transportation of goods, passengers and travellers by land; airline services; baggage handling services; cargo handling and freight services; operating and providing facilities for tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft; aircraft fuelling services, aircraft parking services, travel agency and tourist office services; advisory and information services relating to the aforesaid services – class 39

**easyKiosk/  
easy kiosk/  
EASY KIOSK/  
EASYKIOSK**  
(series of four)

United Kingdom registration no 2198933 in respect of:

Printed matter, books, publications, brochures, postcards, menus, catalogues, diaries, promotional and advertising material, wrapping and packaging material, stationery, writing instruments, calendars, posters, photographs, greetings cards, bags, badges, instructional and teaching materials, playing cards, labels, magazines, newsletters, tickets, leaflets, writing paper, goods made of cardboard, manuals, pamphlets, albums, newspapers, periodicals, vouchers, coupons and travel documents, identity cards, tags, gift cards, travel document folders, travel guide books, travellers cheques – class 16

Catering for the provision of food and drink; bar, catering, café and restaurant services; in-flight and airport catering services – class 42

**easyKiosk**

Community trade mark registration no 1196138 in respect of:

Printed matter, books, publications, brochures, postcards, menus, catalogues, diaries, promotional and advertising material, wrapping and packaging material, stationery, writing instruments, calendars, posters, photographs, greetings cards, bags, badges, instructional and teaching materials, playing cards, labels, magazines, newsletters, tickets, leaflets, writing paper, goods made of cardboard, manuals, pamphlets, albums, newspapers, periodicals, vouchers, coupons and travel documents, identity cards, tags, gift cards, travel document folders, travel guide books, travellers cheques - class 16

Catering for the provision of food and drink; bar, catering, café and restaurant services; in-flight and airport catering services – class 42

**EASYJET**

Community trade mark registration no 1232909 in respect of:

Preparations and substances for use in the care and appearance of the hair, scalp, lips, face, skin, teeth, nails and eyes; cosmetics; non-medicated toilet preparations; perfumes, fragrances, colognes and scents; soaps and cleaning preparations; shampoos, conditioners, moisturisers and rinses;



tooth cleaning preparations; depilatory preparations; sun-screening and tanning preparations; anti-perspirants deodorisers and deodorants; cotton wool; essential oils; preparations and substances for use in massage and aromatherapy – class 3

Electric, electronic, communications, photographic, measuring, signalling, checking, scientific, optical, nautical, life-saving and surveying apparatus and instruments; computer software, hardware and firmware; computer games software; apparatus, instruments and media for recording, reproducing, carrying, storing, processing, manipulating, transmitting, broadcasting and retrieving publications, text, signals, software, information, data, code, sounds, and images; audio and video recordings; audio recordings, video recordings, music, sounds images, text, publications, signals, software, information, data and code provided via telecommunications networks, by online delivery and by way of the Internet and world wide web; sound and video recordings; sound and video recording and playback machines; coin freed apparatus; arcade games; televisions and television game apparatus and instruments; photographic and cinematographic films prepared for exhibition; photographic transparencies; non-printed publications; educational and teaching apparatus and instruments; electronic, magnetic and optical identity and membership cards; sunglasses and sunvisors; protective clothing and headgear; parts and fittings for all the aforesaid goods – class 9

Printed matter and publications; wrapping and packaging; books, manuals, pamphlets, newsletters, albums, newspapers, magazines and periodicals; tickets, vouchers, coupons and travel documents; identity cards; labels and tags; posters, postcards, calendars, diaries, photographs, gift cards and greeting cards; teaching and instructional materials – class 16

Leather and imitations of leather; goods made of leather or imitations of leather; skins and hides; trunks bags and travelling bags; purses, wallets, pouches and handbags; luggage; sports bags; bike bags; backpacks; umbrellas and parasols; harness and saddlery; parts and fittings for all the aforesaid goods – class 18

Clothing; headgear; footwear – class 25

Prepared meals; snacks and snack foods – classes 29 and 30

Mineral and aerated waters; beers; non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages – class 32

Alcoholic drinks (except beer); wines, spirits, liqueurs and cocktails – class 33

Cigarettes, cigars, snuff, tobacco, tobacco products, smokers'

articles, lighters, matches – class 34

Provision of access to the Internet; Internet services – class 38

Transportation and storage; transportation of goods, passengers and travellers by land, sea and air; airline and shipping services; cargo and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; ambulance services; rental and hire of vehicles, boats and aircraft; travel agency and tourism services – class 39

Rental of electric and electronic goods, clothing, toys, games and playthings – class 41

Temporary accommodation; provision of food and drink; catering; hotel, restaurant, cafe and bar services; hotel management and reservation services; non-business professional consultancy; providing facilities for exhibitions and conferences; meteorological information services; hairdressing; grooming and beauty salon services; physical, mental and emotional health-care and well-being services; counselling; nursery, kindergarten and crèche; services consultancy, advice, assistance, analysis, design, evaluation and programming services relating to computer software, firmware, hardware and information technology; provision of access to computers; on-line services; consultancy and advice relating to the evaluation, choosing and implementation of computer software, firmware, hardware, information technology and of data-processing systems; rental and licensing of computer software, firmware and hardware; provision of information relating to technical matters, legal matters, information technology, and intellectual property, including that provided via telecommunications networks, by online delivery and by way of the Internet and the World Wide Web; consultancy and advice relating to travel services – class 42



(series of four)

The applicant claims the colours black on white as an element of

United Kingdom registration no 2202916 in respect of:

Restaurants and bar services; catering services; design of computer software; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; hosting, creating and maintaining web sites for others; leasing access time to a computer data base – class 42

the first mark in the series, white on black as an element of the second mark, orange on white as an element of the third mark and white on orange as an element of the fourth mark.

**easyEverything**

White wording on orange background

Community trade mark registration no 1243948 in respect of:  
Computer software; computer hardware; pre-recorded CD Roms and other disk carriers; sunglasses – class 9

Business information services; on-line processing of mail orders – class 35

Provision of access to information on-line from the Internet; providing access to a wide range of general interest information via computer networks; providing on-line access to news, weather, sports, current events and reference materials; computer bulletin and message boards in fields of general interest; linking to web sites of others; providing multiple-user access to computer networks for the transfer and dissemination of a wide range of information – class 38

On-line contests and sweepstakes – class 41

Restaurant and bar services; catering services; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; creating and maintaining web-sites; hosting the web sites of others; consulting and technical assistance in the fields of designing, creating, hosting, maintaining, operating, managing, advertising, and marketing of on-line commerce web sites; provision of access to information on-line from a computer database; technical consultancy and advising in the establishment of on-line retail services; providing on-line facilities for real-time interaction with other computer users concerning topics of general interest and playing games; on-line directory services to help locate people, places, organisations, phone numbers, home pages, and electronic mail address; computer services, namely, creating indexes of information, sites, and other resources available on computer networks; searching and retrieving information on computer networks; leasing access time to a computer database (other than by Internet service providers) – class 42

**easyrentacar**

Community trade mark registration no 1261502 in respect of:  
Transportation services; hire and rental of motor vehicles – class 39

**easyLife**

Community trade mark registration no 1343359 in respect of:  
Printed matter, books, publications, brochures, postcards,

menus, catalogues, diaries, promotional and advertising material, wrapping and packaging material, stationery, writing instruments, calendars, posters, photographs, greeting cards, bags, badges, instructional and teaching materials, playing cards, labels, magazines, newsletters, tickets, leaflets, writing paper, paper, goods made of cardboard, manuals, pamphlets, albums, newspapers, periodicals, vouchers, coupons and travel documents, identity cards, tags, gift cards, travel document folders, travel guide books, travellers cheques – class 16

Advertising; business management; business administration; office functions; publicity, promotional services, import-export agency services, business information services, organising exhibitions for commercial or advertising purposes – class 35

Transportation of goods, passengers and travellers by air; airport check-in services; arranging of transportation of goods, passengers and travellers by land; airline services; baggage handling services; cargo handling and freight services; operating and providing facilities for tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft; aircraft fuelling services, aircraft parking services, travel agency and tourist office services; advisory and information services relating to the aforesaid services; information services relating to transportation services, including information services provided on-line from a computer database or the Internet – class 39

**easy.com**

Community trade mark application no 1343300 in respect of:

Printed matter, books, publications, brochures, postcards, menus, catalogues, diaries, promotional and advertising material, wrapping and packaging material, stationery, writing instruments, calendars, posters, photographs, greeting cards, bags, badges, instructional and teaching materials, playing cards, labels, magazines, newsletters, tickets, leaflets, writing paper, paper, goods made of cardboard, manuals, pamphlets, albums, newspapers, periodicals, vouchers, coupons and travel documents, identity cards, tags, gift cards, travel document folders, travel guide books, travellers cheques – class 16

Advertising; business management; business administration; office functions; publicity, promotional services, import-export agency services, business information services, organising exhibitions for commercial or advertising purposes – class 35

Transportation of goods, passengers and travellers by air; airport check-in services; arranging of transportation of goods, passengers and travellers by land; airline services; baggage handling services; cargo handling and freight services; operating and providing facilities for tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft;



### easyJet Services

aircraft fuelling services, aircraft parking services, travel agency and tourist office services; advisory and information services relating to the aforesaid services; information services relating to transportation services, including information services provided on-line from a computer database or the Internet – class 39

United Kingdom registration no 2212473 in respect of:

Transportation services; hire and rental of motor vehicles – class 39

Community trade mark application no 1360981 in respect of Transportation services; hire and rental of motor vehicles – class 39

Community trade mark registration no 1472273 in respect of:

Printed matter and publications; books, manuals, pamphlets, newsletters, brochures, albums, newspapers, magazines and periodicals; tickets, vouchers, coupons and travel documents; identity cards; labels; posters, postcards, stationery, writing instruments, wrapping materials, calendars, diaries, photographs, gift cards and greetings cards; instructional and teaching material; promotional and advertising materials; signboards of paper or cardboard – class 16

Transportation of goods, passengers and travellers by air; registry services; arranging transportation of goods, passengers and travellers by road and by sea: transport services, airline and forwarding services; baggage handling services; cargo handling and freight services; arranging, operating and providing facilities for cruises, holidays, business travel, tours, excursions and vacations; aircraft chartering; leasing of aircraft; aircraft fuelling services, aircraft parking services, travel agency and tourist office services; information and advisory services relating to all the aforesaid services; registration of luggage, flight reservation services, air traffic control services, aircraft handling services, excluding the transportation of letters and parcels – class 39

Temporary accommodation; catering, hotel, restaurant, café and bar services; reservation services for hotel accommodation; providing facilities for exhibitions; weather information services; hairdressing, grooming and beauty salon services; security services; airport security services; airline passenger security screening services – class 42

### easyJet tours

Community trade mark application no 1383157 in respect of:

Printed matter and publications; books, manuals, pamphlets, newsletters, brochures, albums, newspapers, magazines and periodicals; tickets, vouchers, coupons and travel documents; identity cards; labels and tags; posters, postcards, stationery, writing instruments, wrapping materials, calendars, diaries,

**easyMoney/  
EASYMONEY**  
(series of two)

photographs, gift cards and greetings cards; teaching and instructional materials – class 16

Transportation of goods, passengers and travellers by air; airport check-in services; arranging of transportation of goods, passengers and travellers by land and sea: airline and shipping services; baggage handling services; cargo handling and freight services; arranging, operating and providing facilities for cruises, holidays, business travel, tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft; aircraft parking services, travel agency and tourist office services; advisory and information services relating to the aforesaid services; including the provision of such services by means of the Internet or a computer database – class 39

Temporary accommodation; catering, hotel, restaurant, café and bar services; reservation services for hotel accommodation; provision of exhibition facilities; meteorological information services; hairdressing, grooming and beauty salon services; including the provision of such services as well as information and advice relating thereto by means of the Internet or a computer database – class 42

United Kingdom registration no 2184834 in respect of:

Computer software; computer hardware; pre-recorded CD Roms and other recorded computer programs; sunglasses – class 9

Clothing; headgear; footwear – class 25

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies; jams, fruit sauces; eggs, milk and milk products; edible oils and fats; prepared meals – class 29

Coffee; tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals; bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; prepared meals – class 30

Beers; mineral and aerated water and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages – class 32

Alcoholic beverages (except beer) – class 33

Business information services – class 38

Telecommunication services – class 38

Restaurant and bar services; catering services; design of computer software; provision of access to the Internet; computers, design, drawing and commissioned writing, all for the compilation of web pages on the Internet; information provided on-line from a computer database or from the Internet; Internet services and on-line access services relating

**EASYBANK.COM** to financial and insurance affairs – class 42  
United Kingdom application no 2211957 in respect of:  
Financial and insurance services – class 36

**EASYBANK** United Kingdom application no 2211958 in respect of:  
Financial and insurance services – class 36

easyGroup also referred to Community trade mark application no 1283647, however, this application has since been withdrawn.

4) At the time of the filing of the oppositions all the earlier rights stood in the name of Easyjet Airline Company Ltd with the following exceptions:

nos 2211957 and 2211958 in the name of Easybank Ltd  
nos 2184833, 2184827, 2184834, 2212473 and 1360981 in the name of easy Group Ltd  
no 12621502 in the name of Easyrentacar (UK) Ltd

Since the filing of the oppositions all the above trade marks have been assigned to easyGroup IP Licensing Limited with the exception of nos 2211957 and 2211958 which have remained in the same ownership as recorded on 5 October 2000.

5) easyGroup states that the trade marks of the application have the phonetically identical prefix to its various EASY prefixed trade marks and consequently are similar to these trade marks. easyGroup also states that the respective goods and services are similar. Consequently, there is a likelihood of confusion and registration of the trade marks would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

6) easyGroup states that it has made substantial use of its EASYJET and other EASY prefixed trade marks in the United Kingdom and European Union in relation to travel related goods and services since 1995. Consequently, its trade marks have acquired a reputation and use of Siemens' trade marks, without due cause, would take unfair advantage of or be detrimental to the distinctive character of its earlier trade marks. easyGroup states that, to the extent that any goods and services of the application are considered to be dissimilar to those of its trade marks, registration of the trade marks would be contrary to section 5(3) of the Act.

7) easyGroup states that at the date of the filing of the application there existed considerable goodwill and reputation in the United Kingdom in its trade marks. Use of the trade marks would amount to a misrepresentation and damage to easyGroup and be liable to be prevented by the law of passing-off. Consequently, registration of the trade marks would be contrary to section 5(4)(a) of the Act.

8) easyGroup states that at the date of the filing of the application Siemens would have been aware of its EASY prefixed trade marks and its reputation. Consequently, the filing of the application constitutes bad faith and registration of the trade marks would be contrary to section 3(6) of the Act.

- 9) easyGroup requests the refusal of the application in its entirety and an award of costs.
- 10) Siemens filed counterstatements. In the counterstatements Siemens contests whether various of the earlier rights could be relied upon as they were not recorded in the name of the opponents at the times but were in the name of easyGroup. Siemens denies all the grounds of opposition. Siemens seeks an award of costs.
- 11) Both sides filed evidence.
- 12) At the end of the evidence rounds I reviewed the case and suggested that it would benefit from a hearing. However, both sides requested that a decision be made from the papers. Siemens furnished written submissions. Consequently, I give a decision based upon the papers and the written submissions of Siemens.

### **Evidence of easyGroup**

#### **Witness statement of Nick Manoudakis**

13) Mr Manoudakis is director of easyGroup. He states that easyGroup is associated with easyGroup Limited (Jersey) and easyJet Airline Company Limited, the original opponents.

14) Mr Manoudakis states that easyGroup is an operator of a financial business over the Internet which trades under the name EASYMONEY. Mr Manoudakis states that the setting up of the EASYMONEY business was first announced in August 1999 by Stelios Haj-Ioannou, chairman of easy Group Limited (Jersey). The domain name easyMoney.com was registered on 28 September 1999 and from then the EASYMONEY business was advertised. Mr Manoudakis states that there has been press coverage of the EASYMONEY business since August 1999 in various newspapers, including “The Financial Times”, “Sunday Herald”, “Independent” and “Scotland on Sunday”. On 22 September 2001 the website went “live” in the United Kingdom with on-line applications. I cannot see that the latter is relevant in this case as the relevant date is the date of the filing of the application, 28 March 2000. Mr Manoudakis exhibits material relating to easyMoney.com. None of this emanates from on or before the relevant date. One part of the material is a press release dated 21 August 2001. It states at the beginning the easyMoney.com’s first “offering” will be a credit card which will be available from early September (2001). Mr Manoudakis produces no examples of the press coverage to which he refers.

15) Mr Manoudakis states that easyGroup is the owner of numerous registrations and applications in the United Kingdom and the European Union for trade marks incorporating the word EASY. He attaches printouts of these trade marks and specifically lists seventeen of them in his statement. Of these seventeen, nine do not form a basis of the oppositions; they are not referred to in the statement of grounds and have filing dates later than that of the application.



16) Mr Manoudakis states that easyGroup has traded under the easyJet trade mark since November 1995. He states that easyJet sells tickets primarily via its website directly to the passenger. Mr Manoudakis states that the success of easyJet has led to the creation of other “easy” businesses: easyEverything Internet cafés, easyRentacar car hire, easyValue price comparison services and easyMoney financial services.

17) Mr Manoudakis states that in 1998 easy Group was formed by Mr Haji-Ioannou; this is a holding company promoting new ventures and extending the EASY brand using the Internet. Mr Manoudakis states that the first of these ventures was easyEverything Internet cafés. He states that the first café opened in London in 1999. He goes on to state that other cafés have since been opened.

18) Mr Manoudakis states that in February 2000 an Internet car hire business was launched trading under the name easyRentacar. He states that the founding of the easyRentacar business was announced in August 1998 and was extensively publicised from May 1999, this publicity includes advertisements of the easyRentacar website. The press releases in attachment 3 to Mr Manoudakis’s statement state that the service actually began in London on 20 April 2000, after the relevant date. From the summer of 1999 there are references to the setting up of a car rental business in various press articles but nothing in the way of publicity for the public. In a printout from [easygroup.co.uk](http://easygroup.co.uk) it is stated on 1 March 2000 that the booking system for easyRentacar “will go live in a few days time”. Mr Manoudakis states that official trading under the easyRentacar trade mark began in February 2000. I have difficulty envisaging how an enterprise that only trades via the Internet began trading in February 2000 when on 1 March 2000 its booking system was still not live. Mr Manoudakis states that between 1 May 1999 and 31 December 1999 there were 64,173 visits to the easyRentacar website. He does not state where these visits came from. He does not exhibit material as to what was on the website at the time.

19) Mr Manoudakis states that promotion of easyGroup’s easyMoney business began on 29 November 1999 and by the end of August 2000 £492,000 had been spent. I have referred to easyMoney in paragraph 14 above. The matter exhibited at attachment 3 to Mr Manoudakis’s statement shows that there was not a settled name for this business. A piece from “The Scotsman”, dated 19 October 1999, advises that easyJet has decided to call its planned Internet banking venture EasyBank.com rather than EasyMoney.com. By August 2001 the name had reverted back to EasyMoney.com. An article from “The Financial Times” of 13 August 1999 states that the bank is in its early stages of development and that it could start as a fund management operation before moving into full-blooded banking. There is no evidence of any publicity material for this venture before the relevant date in these proceedings.

20) Mr Manoudakis states that total passenger figures have risen from 1.7 million in 1998 to 5.6 million in the financial year ending on 30 September 2000. Mr Manoudakis gives various figures relating to turnover and advertising expenditure. However, these are not tied down to a specific period, specific services or specific jurisdictions. He refers to an NOP poll but does not reproduce the poll or the details about it.

21) Mr Manoudakis states that the ITV programme “Airline”, about easyJet, was first broadcast in January 1999, consisting of ten programmes of thirty minutes duration. He states that “Traffic” a fifty minute long documentary about easyJet was broadcast in September 1999. He does not state on which channel it was broadcast.

22) A printout from easyValue.com, in attachment 4 to the statement of Mr Manoudakis, states that it went live on 21 November 2000, after the relevant date.

23) Mr Manoudakis goes on to give further details of the businesses. Again much of this relates to periods after the relevant date.

24) Mr Manoudakis states that easyJet Airline Company Limited and easyGroup Limited are associated companies and have assigned their earlier trade marks relied upon in these oppositions to easyGroup. He does not state how specifically the companies are related. Mr Manoudakis states that five of the earlier rights have not been assigned yet but that easyGroup is in the process of effecting the recordal of the assignment, I refer to two of these in paragraph 4 above. Mr Manoudakis’s statement is dated 26 March 2002. At the date of writing this decision these trade marks have not been assigned nor, according to the records of the registrar, has there been an application for them to be assigned.

## **Evidence of Siemens**

### **Witness statement of Kirstine Wilson**

25) Ms Wilson is a director of Siemens. She states that Siemens is a provider of vendor financing programmes and specialist leasing and financing facilities. Ms Wilson states that Siemens helps all types of businesses to invest in the capital assets necessary to develop their businesses. She states that the areas where Siemens specialises include healthcare, information technology, telecommunications, the professions and office technology financing; as well as funding for customers acquiring Siemens equipment. Ms Wilson states that financing solutions include finance leases, operating leases, lease purchase and loans. Siemens has 203 employees in its offices in Harrow, Bracknell, Bristol, Manchester and Wilmslow.

26) Ms Wilson states that Siemens has over 100,000 finance agreements with customers in a wide variety of sectors eg health, information technology, telecommunications, vending, digital imaging, medical professions, legal and accountancy, public sector, education and industry.

27) Ms Wilson states that Siemens is part of Siemens Financial Services, based in Munich. Siemens Financial Services is a division of the Siemens AG group of companies.

28) Ms Wilson states that Siemens owns the following three United Kingdom trade mark registrations (the first two are series of two trade marks):

ease-e:)

**EASE-E:)**

ease-e:)ease

**EASE-E:)EASE**

### **EASE-ELEASE**

The first two registrations were filed on 28 March 2000 and the last registration on 5 February 2001. The registrations are all in classes 9, 16, 36 and 42 and encompass very similar goods and services to those of the application. Ms Wilson states that easyGroup did not oppose the above registrations.

29) Ms Wilson goes on to comment on the use of EASE-ELEASE. She states that the trade marks of this application were developed in the context of a broader strategy involving the use of the EASE-E prefix. She states that at the end of 1999 Siemens was engaged in the development of a range of on-line business to business leasing services. It explored a number of names for these new services and initially the branding development team favoured E-LEASE. However, a trade mark search identified two potentially conflicting applications. Siemens was unwilling to abandon the E-LEASE concept completely, and the name EASE-ELEASE / EASE-E:) EASE was developed. The decision was then taken to extend the EASE-E branding concept to create similar names for a range of financial products which Siemens intends to develop and offer on-line. The creation of the EASE-E:FINANCE trade mark was part of this strategy.

30) Between January and February 2000 various domain names were registered using the EASE-E beginning.

31) Ms Wilson rejects the assertion by easyGroup that the application for the trade marks was made in bad faith and that Siemens was attempting to associate itself with easyGroup and any reputation that it may possess.

### **Witness statement of Douglas Brian Reynolds**

32) Mr Reynolds is a director of a firm of private investigators. He states that in July 2002 he was asked to conduct a "common law" investigation into the use of the trade mark EASY, or derivatives of the word EASY, in the United Kingdom. He was asked to concentrate on the financial sphere. He was also asked to ignore any use made by easyJet or companies that he recognised as being members of the easyJet group. On 9 July 2002

he wrote a letter with the results of the initial investigation. This letter is exhibited at DBR1. The initial domain name search resulted in so many hits that he had to limit the search to include words that indicated use in the financial sector. Mr Reynolds states that he conducted further searches via a variety of Internet search engines. He exhibits extracts from sites that he considered to be relevant at DRB1. He lists examples of use from the Internet and exhibits printouts from the undertakings' websites. These are as follows:

AN EASY LOAN.COM – for loans – it is not clear in which country the loans are given.  
EASY LOANS AND MORTGAGES.co.uk- loans and mortgages.  
EASY-BORROWING.COM – it is not clear in which country the loans are given.  
Easy Quote – effectively a search engine for mortgages, loans, savings accounts and insurance. There is the following statement on the web page: “Please note that Easy Quote is not associated with easyGroup companies”.  
easy4finance – various financial products. It is not clear in which country the loans are given.  
EasyCredit (UK) Limited – car loans.  
easyloans – loans, mortgages and re-mortgages.  
Easy Bank – banking.  
Easy Bank Planner 1.0 – software for the management of personal finances.  
Easy Bank – no indication of the goods or services or where they are supplied.  
EzMoneyMakers.net – a computer program which is being sold from the United States.  
EZ Store Manager, EZ Retailer, EZ Money Pro, EZ Invoice – business software.  
Easi ISA – this appears to be an explanation of ISAs rather than a business.  
EZ:UK Mortgage – mortgages.

All the printouts were downloaded in July 2002 and I cannot see any internal evidence to suggest whether any of the businesses were being run under these trade marks at the relevant date, 28 March 2000.

33) Mr Reynolds states that he then extended the search to cover records of Companies House. He exhibits the results at DBR1. Mr Reynolds states that there are many hundreds of companies registered at Companies House which incorporate the word EASY or a recognisable derivative of that word. He states that the number of companies located meant that it was not possible to conduct an exhaustive search.

34) Mr Reynolds states that on 7 August 2002 he was provided with an extract from a trade mark search that had been conducted and was asked to make further investigations into the trade marks shown. He exhibits a copy of the search extract. Mr Reynolds did not manage to locate use of all of the trade marks. He states that he found use of the following trade marks:

EASYTRAVELGERMANY – on-line travel service.  
EASYMORTGAGEQUOTE – mortgage and life assurance.  
EASYDESK – customer relations software.  
EASYSCREENS - customer relations software.

EASYWORKER - customer relations software.  
EASE-E:LEASE – leasing services.  
EASYPAYMENT – on-line payment software.  
EASYTRAK – complaint handling software.  
EASE – electric cabling accessories.

Mr Reynolds's documentation indicates use in the United Kingdom. EASYDESK, EASYSCREENS and EASYWORKER come from the same undertaking and EASE-E:LEASE is from Siemens. The evidence of use consists for the most part of printouts downloaded from the Internet in August 2002. A letter re EasyDesk dated 16 August 2002 states that it is a new product. Ms Wilson states in her statement that Siemens did not start using its trade mark until July 2000. Part of the printout about EASYPAYMENT states that the latest version is being launched on 1 October 1998. There is no clear indication if EASYPAYMENT was available in the United Kingdom in October 1998. Consequently, there is no clear link between the use of the above trade marks on or before the relevant date.

35) Mr Reynolds states that he extended his investigation to look at some of the companies located in his first investigation – the records from Companies House. He states that he did find use of EASY CAR FINANCE by a car finance company in Norwich. Mr Reynolds states that at this stage he reached the cost budget he had been set and ceased his investigations.

#### **Witness statement of Edmund Stephen Harrison**

36) Mr Harrison is a trade mark attorney who is acting for Siemens in this case. He begins by giving a history of the filing of the application and his actions following the lodging of this opposition. Mr Harrison states that in addition to Mr Reynolds's investigation he maintained a watch for EASY trade marks that are used in the financial market. He states that this additional research has located the following trade marks:

EASY MOVE – on-line estate agents.  
EASYCOVER – insurance services.  
EASY I – internal information services, including financial information.  
EASY BUY PROPERTIES – estate agency services.  
EASY CLAIMS – accident compensation specialists.  
EASY SECURED LOANS – on-line loans service.  
EASY MONEY – regular financial section in the "The Times".  
EASY MONEY – regular financial section in "The Guardian".  
EASYLOANS – loans service.

Mr Harrison exhibits at ESH2 examples of the use of the above trade marks by means of printouts downloaded from the websites of the undertakings. The examples all indicate use in the United Kingdom.

37) Mr Harrison states that outside of the financial market he has located use of the following EASY trade marks:

EASYGOLF.CO.UK - golf retail site.  
EASYRECORDS – a record company.  
EASY SCRIPTS ARCHIVE – a software programming company.  
EASYBUY APPLIANCES – online domestic appliance retail site.  
EASY SOFTWARE – a software programming company.  
EASY OFFICE RELOCATION – an office relocation company.  
EASY-SITE – a website development company.  
EASY OFFICES – an office solutions company.  
EASY:I.T. – a website development company.  
EASY STREET – a music management company.

Mr Harrison exhibits at ESH3 examples of the use of the above trade marks by means of printouts downloaded from the websites of the undertakings. With the exception of EASYRECORDS the use can all be tied down to the United Kingdom. The evidence relating to use of the trade marks referred to in this paragraph and in paragraph 36 above all emanates from 2002. The only internal evidence which suggests that any of the trade marks was being used on or before the relevant date is from EASYCOVER, the Internet printout states that it was established in 1995. The EASY SCRIPTS ARCHIVE website states that it was set up on 23 October 2001.

38) Mr Harrison states that he instructed the professional searching company Compu-Mark to conduct a search of the trade marks register in the United Kingdom. His first instruction was to conduct a full clearance search for the trade mark EASY in classes 9, 16, 36 and 42. He states that he was contacted by the researcher who advised that this would result in a search that was excessively large and unusable. He told the researcher to only look for “active” trade marks and to exclude any owned by easyGroup. He exhibits a copy of the search at ESH4. Mr Harrison states that the search report is 410 pages long and shows an enormous number of trade marks which incorporate the word EASY or derivatives thereof. Mr Harrison lists just over fifty trade marks in class 36 and which he states would appear to have a relevance to the financial market. He states that he only lists registered Community trade marks and United Kingdom trade marks that have been registered or advertised. The list includes trade marks such as EASYDEBT, BT EASYSHARE, EASY OPTIONS, EASYLIFE, EASYINFO and EASYBANK.

39) Mr Harrison exhibits a copy of the judgment of Mr B Livesey QC, sitting as a deputy judge of the High Court, in *easyJet Airline Company Limited (and others) v Tim Dainty (t/a easyRealestate)*.

### **easyGroup's evidence in reply**

40) This consists of a further witness statement by Mr Manoudakis. Much of what Mr Manoudakis states is a critique of the evidence of Siemens or submission or a combination of the two; not evidence of fact. I take on board these elements of Mr Manoudakis's statement in reaching my decision but will confine the summary of the evidence to what can be considered as evidence of fact.

41) Mr Manoudakis states the list of trade marks furnished by Mr Harrison includes a number which easyGroup is taking action against through opposition or invalidity proceedings such as THE TIMES EASY MONEY, EASYBANK and EASYLIFE. He states that the list includes trade marks which easyGroup has acquired. He gives one example of this: EASYDRIVE. Mr Manoudakis states that the EASYDRIVE registration and domain name now stand in the name of easyGroup and the remaining EASYDRIVE domain names have now lapsed.

42) Mr Manoudakis refers in his statement to two exhibits. However, the registrar has not received any such exhibits. However, taking into account what they relate to in the statement of Mr Manoudakis nothing turns upon this point.

## **DECISION**

### **The effects of the evidence of easyGroup**

43) easyGroup has filed evidence which goes towards several matters:

- establishment of a reputation for the purposes of section 5(3) of the Act
- establishment of goodwill for the purposes of the passing-off issue under section 5(4)(a) of the Act
- establishment of a reputation for the purposes of section 5(2)(b) of the Act
- showing use in order to establish a family of trade marks.

In all these matters the relevant date is the date of the application for the trade mark, 28 March 2000.

44) The issue of the nature of the reputation that is required to support a claim under section 5(3) of the Act was dealt with by the European Court of Justice in *General Motors Corporation v Yplon SA* Case C-375/97 [2000] RPC 572 (*Chevy*). The court stated the following:

“Article 5(2) of the First Council Directive (89/104/EEC) of 21 December 1988 to approximate the laws of the Member States relating to trade marks is to be interpreted as meaning that, in order to enjoy protection extending to non-similar products or services, a registered trade mark must be known by a significant part of the public concerned by the products or services which it covers. In the Benelux territory, it is sufficient for the registered

trade mark to be known by a significant part of the public concerned in a substantial part of that territory, which part may consist of a part of one of the countries composing that territory.”

“The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant factors of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking in promoting it.”

“The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.”

45) Pumfrey J in *South Cone Inc. v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 states:

"There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97 As qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date."

Professor Annand, sitting as the appointed person, in *Loaded* BL0/191/02, accepted that proof of goodwill could be accomplished by other means. I take into account that a limited use can establish goodwill (see for instance *Stannard v Reay* [1967] FSR 140) and also that publicity and promotion without actual sales can establish goodwill (see *BBC v Talbot Motor Co Ltd* [1981] FSR 228).

46) In relation to section 5(2)(b) the amount of use required to have an effect will depend on the purpose it is serving. The issue of reputation/use and their effects are dealt with by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199 and *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117. According to *Sabel* there is a greater likelihood of confusion where an earlier trade mark has a particularly



distinctive character, either per se or because of the use that has been made of it. In this context the amount of use required is relative to the inherent distinctiveness or otherwise of the earlier trade mark. If the earlier trade mark is already particularly distinctive use is not going to assist it. Reputation can assist an opponent where there is only a low degree of similarity between the goods (*Canon*). *Canon* allows for reputation to be of assistance to an opponent where it would lead the public to believe that the goods “come from the same undertaking or, as the case may be, from economically-linked undertakings”. The *Canon* type reputations are, in my view, absolute concepts. They cover the type of position referred to by Mr Thorley QC, sitting as the appointed person, in BL O/048/01:

“In my judgment, I believe what the ECJ had in mind was the sort of mark which by reason of extensive trade had become something of a household name so that the propensity of the public to associate other less similar marks with that mark would be enhanced. I do not believe that ECJ was seeking to introduce into every comparison required by section 5(2), a consideration of the reputation of a particular existing trade mark.”

47) In relation to a family of trade marks there are no express criteria for the extent of use.

48) Various claims are made for easyMoney which, in my view, fall on the basis of the evidence. There was no clear purpose for the business when the idea was first floated. During the period of gestation the proposed name for the proposed business changed to easyBank and then reverted to easyMoney. In the end the website went “live” on 22 September 2001 and the only product was a credit card. The evidence in relation to the trade mark until the launch of the website lies with press releases and press comment; no advertising and no direct public engagement. Taking into account the nebulous nature of the business, the changing of its name and the date of its eventual launch I do not consider that the evidence establishes use or goodwill in the business. If there was goodwill in the business it would be difficult to ascertain what sign is used in relation to that goodwill until the launch of the website. Consequently, easyMoney is out of the use equation.

49) People did not start driving easyRentacar cars until 20 April 2000, after the relevant date. As I have indicated above certain of the evidence of the statements of Mr Manoudakis raise problems when taking into account the exhibited evidence. For convenience I quote from my summary of the evidence:

“In a printout from easygroup.co.uk it is stated on 1 March 2000 that the booking system for easyRentacar “will go live in a few days time”. Mr Manoudakis states that official trading under the easyRentacar trade mark began in February 2000. I have difficulty envisaging how an enterprise that only trades via the Internet began trading in February 2000 when on 1 March 2000 its booking system was still not live. Mr Manoudakis states that between 1 May 1999 and 31 December 1999 there were 64,173 visits to the easyRentacar website. He does not state

where these visits came from. He does not exhibit material as to what was on the website at the time.”

There are various press releases in relation to easyRentacar and copies of articles from newspapers. There is an absence of direct advertising material. It is not established when the public could actually book on the website. It could have been after the relevant date. I certainly do not consider that a goodwill has been established within the guidelines set out in *South Cone Inc. v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)*. It is for easyGroup to establish its case. On the basis of the evidence before me I do not consider that I can accept that at the relevant date there was a goodwill in the business conducted under the sign easyRentacar. Nor do I consider that I can accept that there was use such that the average consumer would make a connection with any of the other trade marks upon which easyGroup rely. On the basis of the evidence before me, as of the relevant date, easyRentacar must be viewed to all intents and purposes as an unused trade mark.

50) The evidence in relation to easyEverything shows that several very large Internet cafés had been running for some time in London at the relevant date. The geographical spread of use, the number of establishments, the length of use and the supporting evidence establishes a goodwill in relation to the business at the relevant date in London. However, the evidence does not, in my view, go anywhere near to establishing a reputation which would allow the use of easyEverything to be considered to satisfy the *Chevy* criteria or to give it any greater protection under section 5(2)(b).

51) Taking into account the nature of the press articles, which when referring to other undertakings refer back to easyJet, the extent of use, and the amount of publicity I have no doubt that for passenger airline services the trade mark easyJet, whether in this form or all in upper case, lower case or upper case, enjoy a reputation and renown that satisfies the criteria for section 5(3) and passing-off and also, for these services, give it greater protection under section 5(2)(b).

52) On the basis of the evidence before me the only use of the trade marks, on or before the relevant date, upon which easyGroup rely is for easyJet for passenger airline services and easyEverything for Internet cafés.

53) One of the planks of easyGroup’s case is that it owns a family of trade marks. In his first statement Mr Manoudakis describes how easyGroup uses its trade marks:

“The use of the “easy” mark with a word which refers to the services provided so to form one new word; and

The presentation of the “easy” brand name in lower case and the second part of the trading name with an initial capital letter, as in “**easyJet**”, “**easyEverything**”, “**easyRentacar**” and “**easyGroup**”, the emphasis being on the distinctive element of the trading name, the “easy” mark.”

I referred to the issue of a family of trade marks in two earlier decisions involving easyGroup – BL 0/474/02 and BL 0/473/02. In those decisions I wrote the following:

“The family of trade marks concept was one that was accepted under the old Act. It has been accepted as part of the global appreciation of the likelihood of confusion under the current Act (see for instance the decisions of the appointed persons in BL 0/411/01 and BL 0/207/02). It is also a position that has been accepted by the Community Trade Mark Office (see for instance decision no 1649/2000 of the Opposition Division). That an undertaking owns a family of trade marks does not mean, however, that the trade marks are to be considered as a job lot; there has to be a mark to mark comparison (see *ENER-CAP* Trade Mark [1999] RPC 362).

69) To a large extent the position as to a family of trade marks follows that under the old law as exemplified by the decision of the Assistant Comptroller in *Beck, Koller* [1947] 64 RPC 76. I consider that the principles upheld in that decision hold good today:

- there must be use of the trade marks – if the public are not aware of the trade marks they are not going to associate a common element with one particular trader
- the less distinctive the common element the lesser the strength of the family
- use of the common element by other traders will further weaken the strength of the family

70) I cannot put the case better than the Assistant Comptroller did:

“My conclusion from the above reasoning is that where an opponent bases his opposition upon a “series” of marks the *Registrar*, in coming to a decision under the provisions of Sec. 12 of the Act, should compare the opponent’s marks individually with the applicant’s mark, but that in making each comparison he should have due regard to any user which either the opponent may establish of other marks of the “series”, or the applicant may establish of other marks having the same common element or characteristic used either by himself or by third persons.”

“I am disposed to agree with Mr. *Burrell*’s submission that the “series” objections is primarily founded upon user, because the inference which the *Registrar* is asked to draw is that traders and the public have gained such a knowledge of the common element or characteristic of the “series” that when they meet another mark having the same characteristic they will immediately associate the latter mark with the “series” of marks with which they are already familiar.”

“But if the Applicants had established that in the same market a number of different proprietors were using marks beginning with the syllables “Plio”, this would have constituted a circumstance which would have tended to soften the

conflict in the Applicants' favour. Similarly, if the Opponents had established that they were using a "series" of other marks beginning with the syllables "Plio" in respect of goods of the same description as the Applicants' goods, such a circumstance would have tended to harden the conflict under Sec.12 adversely to the Applicants."

72) I would add to the criteria set out in *Beck Koller* that the public would have to make a connection between the goods/services upon which the trade marks are used. In my view the greater the distance between the goods and/or services of the family of trade marks the less the public are likely to consider that the common element relates to one undertaking. However, there could be circumstances where there is a great distance between the goods/services but a connection is still formed eg by advertising or promotional materials that connect the various trade marks.

73) The strength of the family will also depend on the number of trade marks and the extent of the use. The greater the number of trade marks and the greater the use the more that the public are likely to identify the common element with a particular undertaking."

54) The normal rule of thumb for a family of trade marks is that there is a minimum requirement of use of three trade marks. In this case the evidence only establishes use of two trade marks at the relevant date: easyJet and easyEverything. There is also the distance between the respective services, a passenger airline and an Internet café. I cannot see that there is any obvious connection in trade, nothing about one service that would trigger an association with the other. However, I do note that in use there is a common get-up and the press articles make a connection with Mr Haji-Ioannou. Unlike in the cases I referred to above there does not appear to be a difference in ownership. The printouts relating to the earlier rights filed at the time of the filing of the oppositions showed the easyJet and easyEverything trade marks to be in the same ownership, a position that has continued with the assignment of both trade marks to the current opponent.

55) Added to this mix is the issue as to whether use of the word easy at the beginning of trade marks is non-distinctive; a different matter from deciding whether the trade marks in their entireties are non-distinctive. Siemens has put in a lot of evidence in relation to this point. The data from Companies House and the United Kingdom and Community trade mark offices can be characterised as state of the register of evidence. The comments of Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 have been quoted time and time again by the registrar:

**A**n particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led to the Registrar to put the marks concerned on the Register. It has long been held that under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for

registration, see *e.g. MADAME Trade Mark* (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence.@

Most of the actual evidence of use of trade marks does not show use on or before the relevant date. Mr Harrison included in his evidence the judgment of Mr Bernard Livesey QC (sitting as a deputy judge of the High Court) in *EasyJet Airline Co. Ltd v Dainty (t/a EasyRealestate)* [2002] FSR 6. This was a summary judgement and so requires some circumspection in its consideration. However, Mr Livesey commented:

“I agree with the defendant that the claimants are not entitled to appropriate the word "easy" and prevent any businessman from using any name which includes the word "easy". However, in my judgment the test which requires to be established, that is to say that there is a likelihood of deception, is made out in this case not because the defendant has used the word "easy" but because of the four elements which I have already described as part of the livery or get-up of the claimants.”

The implication of this is that Mr Livesey considered that easy is not per se very distinctive and cannot be monopolised. Despite the comments of Jacob J above I do not consider that I can ignore the state of the register of the evidence. The sheer amount of registrations or applications for trade marks and company names, combined with the number of domain name hits, is indicative, in my view, that easy as a prefix in a trade mark is not very distinctive. In *EasyJet Airline Co. Ltd v Dainty (t/a EasyRealestate)* the case turned upon matters of get-up and the actions of the defendant.

56) Based upon all the above factors I do not consider that the family of trade marks argument is going to assist easyGroup. I also do not consider that the argument would assist easyGroup owing to the nature of the two trade marks. The first element is ease-e or EASE – E and not EASY. It is followed by a colon, which is not part of the easyGroup pattern. Mr Manoudakis also refers to the use of easy in lower case and the second part of the trade mark beginning in upper case; not something that happens in respect of Siemens’ trade marks.

### **Submissions of Mr Harrison**

57) In his submissions Mr Harrison refers to the lack of confusion between the trade marks of easyGroup and EASE-E:)EASE and EASE-ELEASE. Apparent lack of confusion with a different trade mark tells me nothing. I have to consider the trade marks before me. Even if this were not the case there is nothing to suggest that the use of these trade marks has been in the same market as easyGroup has been in. I need to consider the entire spectrum of goods and services covered by the trade marks of the application and the trade marks relied upon by easyGroup. It is also the case that evidence of confusion is very hard to come by. If a person is completely confused he or she is not going to be aware that he has made an error in his assumptions, because of his complete confusion. If he or she is aware that a mistake has been made there is no particular reason either undertaking would be informed. It is very rarely that one gets the objective

evidence of confusion as arose from “The Nipple Advertisement” in *Neutrogena Corporation and Anr v Golden Limited and Anr* [1996] RPC 473 when the Independent Television Commission received 158 letters of complain.

58) Mr Harrison comments that there is no evidence to show that easyGroup, when they took over the oppositions, also took over the reputations and goodwill upon which they are relying. I do not see that this is relevant. The key question is whether there was a goodwill or reputation in connection with various of the trade marks as of 28 March 2000. In proceedings before the registrar an opponent does not require a locus standi. The opponent can rely on the rights of other parties if it chooses, although there might be problems in proving some of those rights. All I have to consider is whether easyGroup has made out its case as of 28 March 2000.

### **Objection under section 3(6) of the Act**

59) Section 3(6) of the Trade Marks Act 1994 states:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

Lindsay J in *Gromax Plasticulture Limited v Don and Low Nonwovens Ltd* [1999] RPC 167 stated:

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes some dealings which fall short of the standard of acceptable commercial behaviour observed by reasonable and experienced men in the particular field being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances.”

In *Royal Enfield* BL 0/363/01 Mr Simon Thorley QC, sitting as the Appointed Person, held:

“An allegation that a trade mark has been applied for in bad faith is a serious allegation. It is an allegation of a form of commercial fraud. A plea of fraud should not lightly be made (see Lord Denning M.R. in *Associated Leisure v. Associated Newspapers* (1970) 2 QB 450 at 456) and if made should be distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts (see *Davy v. Garrett* (1878) 7 Ch. D. 473 at 489). In my judgement precisely the same considerations apply to an allegation of lack of bad faith made under section 3(6). It should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctly proved and this will rarely

be possible by a process of inference. Further I do not believe that it is right that an attack based upon section 3(6) should be relied on as an adjunct to a case raised under another section of the Act. If bad faith is being alleged, it should be alleged up front as a primary argument or not at all.”

easyGroup states that at the date of the filing of the application Siemens would have been aware of its EASY prefixed trade marks and its reputation. Consequently, the filing of the application constitutes bad faith and registration of the trade mark would be contrary to section 3(6) of the Act.

60) The evidence of easyGroup indicates that Siemens would probably have been aware of use of easyJet for airline services. More cannot be said. To file an application for the goods and services of this application for the series of trade marks does not strike me as being outside the acceptable standard of commercial behaviour. Ms Wilson explains how the choice of the trade marks came about. Her evidence has not been challenged. The evolution of the trade marks shows no nefarious intention. easyGroup have made the serious allegation of bad faith but have not put in a shred of evidence to justify it let alone to distinctly prove it.

**61) I find no basis for the ground of opposition under section 3(6) of the Act and it is dismissed.**

**Objections under sections 5(2)(b), 5(3) and 5(4)(a) of the Act**

62) All these objections depend on similarity between the trade marks of Siemens and the trade marks/signs of easyGroup. easyGroup have relied upon a large number of earlier trade marks. From the evidence of Mr Manoudakis it appears that he considers his best case arises where the second part of the trade mark has a reference to something in the financial market (see paragraphs 12, 17 and 19 of his second witness statement). I believe, if this is his position, that he is correct in it. I have carefully considered all the other trade marks and cannot see that any sensible argument can be advanced to consider that they would give rise to a greater degree of similarity with the trade marks of Siemens. This leaves the following trade marks to be considered:

- easyPay/EASYPAY (series of two) - nos 2184833A (the B registration encompasses completely unrelated goods).
- easyLife – no 1343359
- easyMoney/EASYMONEY – no 2184834
- EASYBANK.COM – no 2211957
- EASYBANK – no 2211958

Nos 2184833A, 2211957 and 2211958 are not yet registered. None of these trade marks can support claims under sections 5(3) or 5(4)(a) as they did not have the requisite reputation or goodwill at the relevant date.

63) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

64) The term ‘earlier trade mark’ is defined in section 6(1)(a) of the Act as follows:

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

Section 6(2) of the Act deals with the position of trade mark applications which have not been registered:

“(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

65) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

66) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details ( *Sabel BV v Puma AG* page 224). 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 (*Sabel BV v Puma AG* page 224). I take into account the matter must be judged through the eyes of the average consumer of the goods/services in question (*Sabel BV v Puma AG* page 224) 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 (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* page 84, paragraph 27).

67) In the case of the earlier trade marks the two elements which they comprise are, in my view, in relation to financial related goods and services, which is the conflict here, non-distinctive. EASY on its own describes something that is simple to use and user friendly. The words PAY, LIFE, MONEY and BANK are clearly descriptive of goods and services relating to payment, life assurance, money and banking. It is only in their combination that the two elements combine to form trade marks that are not devoid of



distinctive character. I have to consider that there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it (*Sabel BV v Puma AG* page 224). The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T79/00 *Rewe Zentral v OHIM (LITE)*). In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, I 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, judgement 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). All five trade marks give a clear and direct allusion to goods and services: payment, life assurance, money and banking goods and services that are easy to use. (I take into account that they encompass other goods and services but the issue here relates to the goods and services of the application and this is the relevant consideration.) I am of the view, therefore, that the trade marks have a low degree of inherent distinctiveness. Consequently, the public are likely to be able to distinguish them from other trade marks by limited differences.

68) Visually the only similarity lies with the first three letters of the trade marks of the application: EAS. The Siemens' trade marks then have a letter e, a hyphen and a colon before the word FINANCE. I consider that the overall visual impression of the respective trade marks is quite different.

69) It is possible that the beginnings of the trade marks of the applications will be pronounced as the word EASE and then the letter E as in e-mail. However, my first reaction was to pronounce the beginning of the trade marks as the word EASY. I consider, therefore, that there is a reasonable chance that the beginning of all the trade marks will be pronounced in the same way. However, there is no aural similarity in the remainder of the trade mark. Comparing the respective trade marks in their entireties I do not consider that they are aurally similar.

70) The ends of the various trade marks have conceptual associations with aspects of the financial market. However, this covers a very wide area. In the case of easyMoney this in itself is a commonly used expression which has conceptual associations of its own. None of the endings of the earlier trade marks are synonyms for FINANCE, they relate to aspects of finance. I have no reason to believe that the public will not be able to differentiate between the various conceptual associations. They are linked by a theme and not by a direct meaning. Taking into account the possible pronunciation of EASE.E, I am of the view that there is a conceptual association with the EASY part of the earlier trade marks. However, taking the trade marks as a whole I do not consider that they are conceptually similar. If I am wrong in this assessment I take into account the comments of the European Court of Justice in *Sabel*:

“In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public. However, in circumstances such as those in point in the main proceedings, where the earlier mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar is not sufficient to give rise to a likelihood of confusion.”

The earlier rights do not have a particularly distinctive character nor at the date of the applications is there evidence of use. So even if there was an analogous semantic content it would not assist easyGroup.

71) Taking into account all the above I do not consider that the respective trade marks are similar. For me to find that there is a likelihood of confusion the respective signs have to be similar. This is what the Directive states and it is what is pointed out in *Sabel*:

“it is to be remembered that Article 4(1)(b) of the Directive is designed to apply only if by reason of the identity or similarity both of the marks and of the goods or services which they designate, “there exists a likelihood of confusion on the part of the public”.”

Without similarity there cannot be confusion. Certain of the goods and services encompassed by the earlier registrations and the application are identical, however, this cannot assist easyGroup when the trade marks are not similar. In coming to my conclusion as to the lack of similarity between the trade marks I take into account that the public seldom have the opportunity to directly compare trade marks directly and have to rely on their recollection, which could well be imperfect. I also bear in mind that nature of the goods and services of the application. It strikes me that, especially in relation to the services, that a fairly reasoned and educated purchasing decision is going to be involved. They are not services that are likely to be purchased on impulse or on a whim and they are services for which there is likely to be a good deal of supporting documentation.

72) If easyGroup cannot succeed on the basis of the above trade marks I cannot see that they can succeed in relation to any others, all of which are more distant. There is a substantial reputation in easyJet. However, it is a very different trade mark. Reputation cannot make the dissimilar similar. If easyGroup cannot succeed on the basis of the trade marks in paragraph 62, it cannot succeed in respect of easyJet. Section 5(3) requires the trade marks to be similar and passing-off requires deception or confusion, which again requires similarity of the signs. For passing-off the comparison would also be for the services for which there is a goodwill. In the case of easyJet, airline services, and in the case of easyEverything, Internet cafés. easyGroup would run into the problem not only of the difference in the signs but also in the distance in the goods and services, for which

there is no obvious link. As Millet LJ in *Harrods v Harrodian School* [1996] RPC 697 stated:

“The name "Harrods" may be universally recognised, but the business with which it is associated in the minds of the public is not all embracing. To be known to everyone is not to be known for everything.”

**73) Consequent upon all the above I dismiss all the grounds of opposition.**

### **Costs**

74) In his submissions Mr Harrison requests costs off the scale owing to the vague nature of the grounds of opposition and of the opponent's evidence. I experienced problems with much of the exhibited material as easyGroup in lengthy pieces had not highlighted the relevant parts. Some of the evidence was illegible owing to poor photocopying. Parts of it were not in English but no translation was filed. Owing to the work required in relation to this evidence I consider it reasonable that an award of costs should be at the top end of the scale. However, I am most concerned by the use of section 3(6) of the Act as a ground of opposition. easyGroup put in no evidence or argument to substantiate its claim in relation to this ground. Most of the evidence of Ms Wilson in my view goes to the issue of bad faith. I refer again to the comments of Mr Thorley QC in *Royal Enfield*:

“An allegation that a trade mark has been applied for in bad faith is a serious allegation. It is an allegation of a form of commercial fraud. A plea of fraud should not lightly be made (see Lord Denning M.R. in *Associated Leisure v. Associated Newspapers* (1970) 2 QB 450 at 456) and if made should be distinctly alleged and distinctly proved.”

In this case the allegation does appear to have been lightly made and not followed up. In these circumstances I have decided that Siemens should receive appropriate compensation for the cost of the statement of Ms Wilson.

75) As Siemens has been successful it is entitled to a contribution towards its costs. I will allow Siemens one month from the date of this issuing of this decision to furnish a breakdown of the costs involved in the drawing up and filing of the statement of Ms Wilson. I will make an award of costs at the end of the period.

**Dated this 2<sup>nd</sup> day of July 2003**

**David Landau  
For the Registrar  
the Comptroller-General**