

O-333-13

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO 2552386
IN THE NAME OF eazyTYRES LTD

AND

AN APPLICATION FOR A DECLARATION OF THE INVALIDITY THEREOF
UNDER NO 84349 BY easyGroup IP Licensing



Background



1. The following registration is the subject of this decision:

Mark	Dates	Specification
2552386 	Filing date: 8 July 2010 Date of entry in register: 8.10.2010	Class 12 Automobile tyres; Inner tubes for pneumatic tyres for vehicle wheels; Vehicle tyres Class 37 Repair of tyres; Fitting services for tyres

2. The registration stands in the name of eazyTyres Ltd (“the registered proprietor”).

3. On 7 March 2012, easyGroup IP Licensing Ltd (“the applicant”) filed an application seeking to declare the registration invalid. The application is made under the provisions of section 47 of the Act and is based on objections under sections 5(2)(b), 5(3) and 5(4)(a) of the Act. In respect of the objections under sections 5(2)(b) and 5(3) of the Act, the applicant relies on the following registrations:

Mark and grounds of objection	Specification of goods relied on
2325850 Under section 5(2)(b) only   LIMITATION: The applicant claims the colours orange and white as an element of the first mark in the series Filing date: 6 March 2003	Class 6: Common metals and their alloys Class 12: Scooters, bicycles, vehicles, apparatus for locomotion by land, air or water Class 14: Precious metals and their alloys Class 35: Business organisation, business administration and business management services, business information services, auctioneering services, office functions, promotional services; import-export agency services, business and management consultancy; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a general merchandising outlet, general merchandise kiosk, general merchandise shop onboard aircraft, or from a general merchandise catalogue, by mail order, or by means of telecommunications;

<p>Date of entry in register: 28 September 2007</p>	<p>advisory and arrangement services relating to all the aforesaid; including, but not limited to, all the aforesaid services provided via telecommunications networks, by online delivery, and by way of the Internet and the world wide web</p> <p>Class 39 Arranging of transportation of goods, passengers and travellers by land and sea; car transport services; rental and hire of vehicles; advisory and information services relating to the aforesaid services</p>
<p>CTM 5140157 Under section 5(2)(b) only</p>  <p>Colours claimed: Orange and white</p> <p>Filing date: 15 June 2006</p> <p>Date of entry in register: 31 May 2007</p>	<p>Class 12 Vehicles; apparatus for locomotion by land, air or water</p> <p>Class 36 Insurance including vehicle insurance; financial affairs; monetary affairs; real estate affairs</p> <p>Class 39 Transport; packaging and storage of goods; travel arrangement; vehicle rental and leasing</p>
<p>CTM 5112115 Under section 5(2)(b) only</p>  <p>Colours claimed: Orange and white</p> <p>Filing date: 1 June 2006</p> <p>Date of entry in register: 31 May 2007</p>	<p>Class 12 Vehicles; apparatus for locomotion by land, air or water</p> <p>Class 39 Transport including air travel, vehicle rental, driving and chauffeur services; packaging and storage of goods; travel arrangement</p> <p>Class 43 Services for providing food and drink; temporary accommodation</p>
<p>2266270 Under section 5(2)(b) and 5(3)</p> <p>easyCar</p> <p>Filing date: 3 April 2001</p> <p>Date of entry in register: 23 August 2002</p>	<p>Class 39 Arranging of transportation of goods, passengers and travellers by land and sea; rental and hire of vehicles; advisory and information services relating to the aforesaid services; information services relating to transportation services</p>
<p>2260901</p>	<p>Class 39</p>

<p>Under section 5(2)(b) and 5(3)</p> <p>easyJet</p> <p>Filing date: 9 February 2001</p> <p>Date of entry in register: 20 September 2002</p>	<p>Transportation of goods, passengers and travellers by air; arranging of transportation of passengers by land; airline services; rental and hire of vehicles; travel agency services</p>
<p>2313408A</p> <p>Under section 5(2)(b) and 5(3)</p> <p>EASYBUS easyBus</p> <p>Filing date: 17 October 2002</p> <p>Date of entry in register: 14 October 2005</p>	<p>Class 39</p> <p>Arranging of transportation of goods, passengers and travellers by land; bus transport services, coach services; travel reservation and travel booking services</p>
<p>2321976</p> <p>Under section 5(2)(b) only</p> <p>EASYPRODUCTS</p> <p>easyProducts</p>  <p>Date: 27 January 2003</p> <p>Date of entry in register: 23 March 2007</p>	<p>Class 1</p> <p>Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.</p> <p>Class 2</p> <p>Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.</p> <p>Class 3</p> <p>Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; 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; fragrances, colognes and scents; shampoos, conditioners, moisturisers and rinses; tooth cleaning preparations;</p>

	<p>depilatory preparations; sun-screening and tanning preparations; anti-perspirants, deodorisers and deodorants, cotton wool; preparations and substances for use in massage and aromatherapy.</p> <p>Class 4 Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles, wicks.</p> <p>Class 5 Pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.</p> <p>Class 6 Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; ores.</p> <p>Class 7 Machines namely, machines for agricultural use, machines for conveying articles, machines for drying, machines for washing, machines for generating power, machines for household purposes in the kitchen, machines for loading, machines for packaging, machines for metalworking, machines for operating underwater, machines for recycling, machines for the manufacture of land vehicles, machines for the building and construction industry, machines for the food industry, machines for making glassware and pottery, machines for the textile industry, machines for the mechanical handling of goods, machines for the repair and servicing of vehicles and machine tools;</p>
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	<p>motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements; incubators for eggs.</p> <p>Class 8 Hand tools and implements (hand operated); cutlery; side arms; razors.</p> <p>Class 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; electronic apparatus and instruments, namely, battery chargers, camcorders, cameras, cassette players, compact disc players, compact discs, computers, computer printers, disk drives for computers, floppy discs, headphones, loud speakers, modems, computer monitors, computer mouse, personal stereos, pocket calculators, mobile phones, radios, record players, scanners, stereos, tape recorders, televisions, video players, video cassettes, VDUs, DVDs, DVD players and CD Roms; consumer domestic electrical and electronic apparatus and instruments, namely, battery chargers, camcorders, cameras, cassette players, compact disc players, compact discs, computers, computer printers, disk drives for computers, floppy discs, headphones, loud speakers, modems, computer monitors, computer mouse, personal stereos, pocket calculators,</p>
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	<p>mobile phones, radios, record players, scanners, stereos, tape recorders, televisions, video players, video cassettes, VDUs, DVDs, DVD players and CD Roms; 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 the world wide web; sound and video recordings; sound and video recording and playback machines; arcade games; televisions and television games 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; sunvisors; mouse mats; protective clothing and headgear; parts and fittings for all the aforesaid goods.</p> <p>Class 10 Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopaedic articles; suture materials.</p> <p>Class 11 Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.</p> <p>Class 12 Scooters, bicycles, vehicles; apparatus for locomotion by land, air or water.</p>
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	<p>Class 13 Firearms; ammunition and projectiles; explosives; fireworks.</p> <p>Class 14 Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.</p> <p>Class 15 Musical instruments.</p> <p>Class 16 Bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); printers' type; printing blocks; office requisites, 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; stationery, artists' materials, writing instruments, brochures, travel document folders, guide books, travellers cheques, badges, promotional and advertising material, signs of paper or cardboard; but not including addressing machines.</p> <p>Class 17 Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing and stopping materials.</p> <p>Class 19 Pitch and bitumen; non-metallic transportable buildings; monuments, not</p>
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	<p>of metal.</p> <p>Class 20 Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.</p> <p>Class 21 Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.</p> <p>Class 22 Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials.</p> <p>Class 23 Yarns and threads, for textile use.</p> <p>Class 24 Textiles and textile goods, not included in other classes; bed and table covers.</p> <p>Class 26 Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.</p> <p>Class 27 Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).</p> <p>Class 28 Games and playthings; gymnastic and sporting articles not included in other</p>
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	<p>classes; decorations for Christmas trees; toys; model aeroplanes, scooters, teddy bears, balls, golf balls, playing cards.</p> <p>Class 29 Prepared meals; snacks and snack foods; meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes, fruit sauces; eggs, milk and milk products; edible oils and fats.</p> <p>Class 30 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, chocolate; snacks and snack foods.</p> <p>Class 31 Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt</p> <p>Class 32 Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.</p> <p>Class 33 Alcoholic beverages (except beers); wines, spirits, liqueurs and cocktails.</p> <p>Class 34 Tobacco; smokers' articles; matches.</p>
<p>2321977 Under section 5(2)(b) only</p>	<p>Class 1 Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering</p>

EASYGOODS

easyGoods

easyGoods

Filing date: 27 January 2001

Date of entry in register: 23 March 2007

preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.

Class 2

Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.

Class 3

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; 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; fragrances, colognes and scents; shampoos, conditioners, moisturisers and rinses; tooth cleaning preparations; depilatory preparations; sun-screening and tanning preparations; anti-perspirants, deodorisers and deodorants, cotton wool; preparations and substances for use in massage and aromatherapy.

Class 4

Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles, wicks.

Class 5

Pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

Class 6

Common metals and their alloys; metal

	<p>building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; ores.</p> <p>Class 7 Machines namely, machines for agricultural use, machines for conveying articles, machines for drying, machines for washing, machines for generating power, machines for household purposes in the kitchen, machines for loading, machines for packaging, machines for metalworking, machines for operating underwater, machines for recycling, machines for the manufacture of land vehicles, machines for the building and construction industry, machines for the food industry, machines for making glassware and pottery, machines for the textile industry, machines for the mechanical handling of goods, machines for the repair and servicing of vehicles and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements; incubators for eggs.</p> <p>Class 8 Hand tools and implements (hand operated); cutlery; side arms; razors.</p> <p>Class 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated</p>
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	<p>apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; electronic apparatus and instruments, namely, battery chargers, camcorders, cameras, cassette players, compact disc players, compact discs, computers, computer printers, disk drives for computers, floppy discs, headphones, loud speakers, modems, computer monitors, computer mouse, personal stereos, pocket calculators, mobile phones, radios, record players, scanners, stereos, tape recorders, televisions, video players, video cassettes, VDUs, DVDs, DVD players and CD Roms; consumer domestic electrical and electronic apparatus and instruments, namely, battery chargers, camcorders, cameras, cassette players, compact disc players, compact discs, computers, computer printers, disk drives for computers, floppy discs, headphones, loud speakers, modems, computer monitors, computer mouse, personal stereos, pocket calculators, mobile phones, radios, record players, scanners, stereos, tape recorders, televisions, video players, video cassettes, VDUs, DVDs, DVD players and CD Roms; 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 the world wide web; sound and video recordings; sound and video recording and playback machines; arcade games; televisions and television games apparatus and instruments; photographic</p>
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	<p>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; sunvisors; mouse mats; protective clothing and headgear; parts and fittings for all the aforesaid goods.</p> <p>Class 10 Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopaedic articles; suture materials.</p> <p>Class 11 Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.</p> <p>Class 12 Scooters, bicycles, vehicles; apparatus for locomotion by land, air or water.</p> <p>Class 13 Firearms; ammunition and projectiles; explosives; fireworks.</p> <p>Class 14 Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.</p> <p>Class 15 Musical instruments.</p> <p>Class 16 Bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials' paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); printers' type; printing blocks; office requisites, wrapping and packaging; books, manuals, pamphlets,</p>
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	<p>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; stationery, artists' materials, writing instruments, brochures, travel document folders, guide books, travellers cheques, badges, promotional and advertising material, signs of paper or cardboard; but not including addressing machines.</p> <p>Class 17 Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing and stopping materials.</p> <p>Class 19 Pitch and bitumen; non-metallic transportable buildings; monuments, not of metal.</p> <p>Class 20 Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.</p> <p>Class 21 Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.</p> <p>Class 22 Ropes, string, nets, tents, awnings,</p>
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	<p>tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials.</p> <p>Class 23 Yarns and threads, for textile use.</p> <p>Class 24 Textiles and textile goods, not included in other classes; bed and table covers.</p> <p>Class 26 Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.</p> <p>Class 27 Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).</p> <p>Class 28 Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; toys; model aeroplanes, scooters, teddy bears, balls, golf balls, playing cards.</p> <p>Class 29 Prepared meals; snacks and snack foods; meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes, fruit sauces; eggs, milk and milk products; edible oils and fats.</p> <p>Class 30 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, chocolate; snacks and snack foods.</p> <p>Class 31 Agricultural, horticultural and forestry</p>
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	<p>products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.</p> <p>Class 32 Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.</p> <p>Class 33 Alcoholic beverages (except beers); wines, spirits, liqueurs and cocktails.</p> <p>Class 34 Tobacco; smokers' articles; matches.</p>
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4. Under grounds based on section 5(4)(a) of the Act, the applicant relies on use of the signs EASYCAR, EASYJET and EASYBUS.

5. The registered proprietor filed a counterstatement in which it denied each of the claims made.

6. Only the applicant filed evidence. Much of that evidence is submission or relates to material from outside the relevant jurisdiction and for this reason I do not intend to summarise it. I have, however, reviewed it and will refer to it as appropriate in this decision. Both parties filed written submissions. Neither sought a hearing. I therefore give this decision after a careful review of all the written material before me.

DECISION

7. The application is brought under the provisions of section 47 of the Act, the relevant part of which states:

“47.-(1)

(2) The registration of a trade mark may be declared invalid on the ground -

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
- (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(3) ...

(4) ...

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

The objections under section 5(2)(b) of the Act

8. Section 5(2)(b) of the Act states;

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

(a) ...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

9. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(b)

(c)

(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.”

10. Under this ground, the applicant relies on the eight marks set out in paragraph 3 above. Each is an earlier mark within the meaning of the Act. Whilst three of those earlier marks had been registered, as at the time the application for invalidation was

filed, more than 5 years earlier, the registered proprietor has not put the applicant to proof of their use. The applicant is therefore entitled to rely on each of its earlier marks in respect of each of the goods and services on which it seeks to rely.

11. The test for determining whether there is a likelihood of confusion is well established. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs Q.C., expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

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 B.V.* [2000] F.S.R. 77; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) C-334/05 P.

The principles

“(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade

mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

12. In essence, the test under Section 5(2)(b) is whether there are similarities in marks and goods or services which, when taking into account all the surrounding circumstances, would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address factors such as the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the goods or services, the category of goods or services in question and how they are marketed.

Comparison of goods and services

13. In considering the similarity or otherwise of the respective goods and services, I take into account the comments of Jacob J in *British Sugar PLC v James Robertson & Sons Ltd* [1996] RPC 280 (“*Treat*”), where he said (at 289):

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all, a trade mark specification is concerned with use in trade.”

He went on (at 295) to set out the following factors as being relevant to the question of similarity, without reference to the classes in which they fell:

- (a) the respective uses of the respective goods or services;
- (b) the respective users of the respective goods or services;
- (c) the physical nature of the goods or acts of service;

- (d) the respective trade channels through which the goods or services reach the market;
- (e) in the case of self-service consumer items, where in practice they are respectively found or likely to be found in supermarkets;
- (f) the extent to which the respective goods or services are competitive. This enquiry may take into account how those in trade classify the goods or service, for instance whether market research companies put them in the same or different sectors.

14. In *Canon Kabushiki Kaisha v MGM Inc.* (referred to above), the CJEU stated the following:

“23. In assessing the similarity of the goods or services concerned... all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.”

15. In *El Corte Ingles v OHIM* Case T-420/03, the Court commented:

“96...goods or services which are complementary are those where there is a close connection between them, in the sense that one is indispensable or important for the use the other in such a way that customers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (Case T-169/03 *Sergio Rossi v OHIM-Sissi Rossi* [2005] ECR II-685)”

16. I also take note of the following guidance in *Avnet Inc v Isoact Ltd (Avnet)* [1998] FSR 16:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

17. Finally, I also bear in mind that goods and services can be considered identical when those covered by an earlier mark are included in a wider term by a later mark (and vice versa); see *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (MERIC)* Case T- 133/05.

18. The registered proprietor’s goods are vehicle (automobile) tyres or inner tubes for those tyres. Insofar as the applicant’s earlier trade mark nos. 2325850, CTM 5140157, CTM 5112115, 2321976 and 2321977 are concerned, whilst they each cover a wide range of goods and/or services, I intend to limit my consideration insofar as each includes *vehicles* in class 12 which includes wheeled vehicles. Tyres and their inner tubes are essential parts of such vehicles. The respective goods are reasonably similar as the users and channels of trade may overlap and they are complementary goods. I also consider the registered proprietor’s services in class

37, which are for the fitting and repair of tyres, to be reasonably similar to *vehicles* as many vehicle traders also provide a service for the repair of those vehicles, including the fitting and repair of tyres.

19. The applicant relies on a further three earlier marks. In respect of these marks it relies on them as far as they are registered for the following services.

2266270 easyCar

Class 39

Arranging of transportation of goods, passengers and travellers by land and sea; rental and hire of vehicles; advisory and information services relating to the aforesaid services; information services relating to transportation services.

2260901 easyJet

Class 39

Transportation of goods, passengers and travellers by air; arranging of transportation of passengers by land; airline services; rental and hire of vehicles; travel agency services.

2313408A EASYBUS/easyBus

Class 39

Arranging of transportation of goods, passengers and travellers by land; bus transport services, coach services; travel reservation and travel booking services.

20. Bearing in mind the guidance provided in *Avnet* above, I consider these services to be dissimilar to any of the goods and services for which the registered proprietor's mark is registered. Transportation, arranging of transportation, airline, bus transport and coach services may each involve the provision of a vehicle of some description (usually with a driver) in order to move someone or something from one place to another but the uses, users, nature of the services and channels of trade all differ from the goods and services of the registered proprietor's mark and they are neither in competition nor complementary services. The rental and hire of vehicles is also a service by which a vehicle is provided, (often without a driver) but, for the same reasons, I do not consider them to be similar to the registered proprietor's goods and services. Similarly, I find the applicant's travel agency, travel reservation and travel booking services to be dissimilar to the registered proprietor's goods and services. Whilst each of the applicant's services are related to travel, the uses, users, nature of the services and channels of trade all differ from the goods and services of the registered proprietor's mark and they are neither in competition nor complementary services. It follows that the advisory and information services of the applicant also differ from the registered proprietor's goods and services.

21. In order for there to be a likelihood of confusion, there has to be at least some similarity between the respective goods and/or services. I have found there to be no similarity in respect of the services covered by the applicant's earlier mark nos. 2266270, 2260901 and 2313408A. I therefore go on to consider the objections under section 5(2)(b) without regard to these three earlier marks.

The average consumer and the nature of the purchasing process

22. *Vehicles* can include e.g. a car for domestic use by a member of the (driving) public or a commercial vehicle for use by a business. In relation to the purchase of a car, this will be a relatively rare and high cost one which is likely to involve a very careful decision. This is an issue dealt with in *The LANCER Trade Mark Case (1987) RPC 303* where Fox LJ stated:

“We are concerned here with the market in cars. A car is an expensive piece of equipment. Its purchase will usually be considered with some care, and will be assisted in a competitive market by an abundance of brochure literature. When considering risks of confusion, therefore, the purchase of a car is not to be equated with an everyday purchase over a shop counter. Nor is it likely to be purchased over the telephone.”

23. In my view, the purchase of a commercial vehicle is also likely to be a very considered purchase. Vehicles are available with various standard specifications but in the context of commercial vehicles, further adaptations to bespoke requirements may be needed.

24. The purchase of a tyre or inner tube is made by the owner of a vehicle and may be something that is carried out at regular intervals by choice as part of a planned maintenance programme or may be carried out as a matter of necessity following a puncture. The same is true for the repair and fitting services. In each case, the cost is relatively low (in comparison to the purchase of a vehicle) though a reasonably high degree of care will be taken to ensure e.g. the tyre is of the correct size for the vehicle and is compatible with the other tyres on that vehicle. The nature of the purchase is one that is primarily visual though I do not rule out the aural aspects given that the purchaser may discuss options with the provider.

Comparison of the respective marks

25. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, the average consumer rarely has the chance to make direct comparisons between trade marks but must, instead, rely on the imperfect picture of them he may have kept in mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must go on to compare each of the respective trade marks from the visual, aural and conceptual perspectives.

26. The registered proprietor's mark consists of the words *eazyTyres.co.uk* in the form shown above at paragraph 1, where the initial letter 'e' is presented in a larger font and cursive script and the letter T is presented as a capital letter. The word *eazyTyres* is presented as a single word with *.co.uk* appearing in much smaller font below the last two letters of it but as a whole it is suggestive of an internet address. No claim is made to colour so this does not, for the reasons given by Mann J in *Specsavers International Healthcare Ltd v Asda Stores Ltd (No. 2) [2011] FSR 1*,

assist in distinguishing the competing trade marks. Whilst the word eazyTyres is presented as a single word, it naturally breaks down into the two separate words eazy and tyres. In its counterstatement, the registered proprietor states:

“We chose this name for the following simple reasons:

the “e” stands for e-commerce-we have a website and aim to offer our services via the world wide web. This is in common with many internet businesses.

the “az” stands for a to z (as in everything in between)

“y” –why? Because we fit all tyres (this is a play on words combined with the a-z)

Tyres –Is self explanatory as it explains what we sell

.co.uk –normal suffix for a UK based company”

27. Whatever may have been the intention of the registered proprietor in coining its mark, in my view I do not think that “eazy” will be seen by the average consumer as anything other than an obvious misspelling of the ordinary dictionary word easy which is a word in everyday use. It is a word that, on its own, is unlikely to be distinctive of many goods or services. The word Tyres is descriptive in the context of the goods and services and the .co.uk element is indicative of an internet presence. Whilst none of these separate elements are distinctive in relation to the goods and services at issue, in combination, when considered as a whole, the mark has a degree of distinctiveness albeit a low one.

28. I go on to consider each of the applicant’s marks in turn.

29. The applicant’s mark no 2325850 is for a series of two marks. Both consist of the word easy in lower case. In smaller font and appearing below the middle two letters of the word easy, is “.com”. The words appear in white and are contained within a plain oval shape which itself appears on a darker rectangular background. The first mark in the series is subject to a limitation as to colour as set out in paragraph 3 above. Again, whilst the separate elements are not distinctive for the reasons given above, the mark, when considered as a whole, has a degree of distinctiveness, albeit a low one.

30. Visually, the high point of the comparison rests in the presence in each of the word easy/eazy. Given the difference in spelling of these words, coupled with the differences in the other elements in the respective marks, any visual similarity is very low. Aurally, there is little or no distinction between the words easy/eazy and so the respective marks are slightly closer. That said, there are clear aural differences between the marks due to the other elements within them. The marks are aurally similar to a low degree.

31. The respective marks have some commonality in that each allude to simplicity and each brings to mind a website address. The presence of the word Tyres in the

registered proprietor's mark is a feature not shared by the applicant's mark and leads me to find that any conceptual similarity between the marks is low.

32. CTM 5140157 consists of the word easyVan presented on a rectangular background. Whilst presented as a single word, the capital letter V within it, leads to the word naturally breaking down into its two component parts. I set out above my findings as to the distinctiveness or otherwise of the word easy. The word Van is descriptive of such vehicles. Again, the distinctiveness of the mark, which is low, rests in its totality.

33. Again, from the visual perspective, the high point of the comparison of the respective marks rests in the presence in each of the word easy/eazy. Given the difference in spelling of these words, coupled with the differences in the other elements in the respective marks, any visual similarity is very low. Aurally, there is little or no distinction between the words easy/eazy and so the respective marks are slightly closer. That said, there are clear aural differences between the marks due to the other elements within them. The marks are aurally similar to a low degree.

34. The respective marks have some commonality in that each allude to simplicity. Whilst the word Van and Tyres bring specific images to mind, a tyre is a fundamental part of a vehicle which may lead to further conceptual similarity. The presence of the suffix .co.uk in the registered proprietor's mark brings to mind an internet address which is absent from the applicant's mark. Any conceptual similarity between the marks is low.

35. CTM 5112115 consists of the word easyTaxi presented on a rectangular background. Whilst presented as a single word, the capital letter T within it, leads to the word naturally breaking down into its two component parts. I set out above my findings as to the distinctiveness or otherwise of the word easy. The word Taxi is descriptive of such vehicles. Again, the distinctiveness of the mark, which is low, rests in its totality.

36. Again, from the visual perspective, the high point of the comparison of the respective marks rests in the presence in each of the word easy/eazy. Given the difference in spelling of these words, coupled with the differences in the other elements in the respective marks, any visual similarity is very low. Aurally, there is little or no distinction between the words easy/eazy and so the respective marks are slightly closer. That said, there are clear aural differences between the marks due to the other elements within them. The marks are aurally similar to a low degree.

37. The respective marks have some commonality in that each allude to simplicity. Whilst the word Taxi and Tyres bring specific images to mind, a tyre is a fundamental part of a vehicle such as a taxi which may lead to further conceptual similarity. The presence of the suffix .co.uk in the registered proprietor's mark brings to mind an internet address which is absent from the applicant's mark. Any conceptual similarity between the marks is low.

38. 2321976 is for a series of three marks each consisting of the word EASYPRODUCTS, either in plain block capitals, with all letters except the P in lower case or with all letters except the P in lower case and presented on a plain dark

rectangular background. In whichever form it is presented, the mark naturally breaks down into the words easy and products. Neither of these words is distinctive and therefore the distinctiveness in each mark of the series, which is low, rests in its totality.

39. Again, from the visual perspective, the high point of the comparison of the respective marks rests in the presence in each of the word easy/eazy. Given the difference in spelling of these words, coupled with the differences in the other elements in the respective marks, any visual similarity is very low. Aurally, there is little or no distinction between the words easy/eazy and so the respective marks are slightly closer. That said, there are clear aural differences between the marks due to the other elements within them. The marks are aurally similar to a low degree.

40. The respective marks have some commonality in that each allude to simplicity. The word Products does not bring to mind any particular image whilst the word Tyres will bring those specific items to mind. The inclusion of the .co.uk suffix brings to mind an internet address. Any conceptual similarity between the respective marks is very low.

41. 2321977 is for a series of three marks each consisting of the word EASYGOODS, either in plain block capitals, with all letters except the G in lower case or with all the letters except the G in lower case and presented on a plain dark rectangular background. The word Goods is synonymous with the word Products and, *mutatis mutandis*, my findings above in relation to 2321976 equally apply to my comparison of this mark with the registered proprietor's mark. In summary, the distinctiveness of the applicant's mark rests in its totality, the respective marks have a very low degree of visual similarity, a low degree of aural similarity and any conceptual similarity between them is very low.

The distinctive character of the earlier marks

42. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which it has been acquired and, secondly, by reference to the way it is perceived by the relevant public (see *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods 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 *Windsurfing Chiemsee v Huber and Attenburger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585).

43. The applicant has filed evidence in the form of two witness statements. The first is dated 7 August 2012 and has been filed by Paul David Griffiths who states he has been Finance Controller for easyGroup since 27 September 2012. The second is dated 13 August 2012 and has been filed by Jody Tsigarides who is a solicitor with Clarke Willmott LLP, the applicant's representatives in these proceedings.

44. Whilst the witness statements refer to a very large number of trade marks (Mr Griffiths refers to there being "around 1000"), the only mention of any of the five

trade marks which I am considering under this ground, is found in the witness statement of Mr Griffiths. Whilst he states that “The current list of businesses operating under the Easy brand” includes EASYVAN, he says nothing of when that business began operating and where or in relation to what goods or services. And at PG2 he exhibits what he says are pages taken from the www.easy.com website. Downloaded on “8/11/2011” and “8/8/2012”, pages 1 and 3 of this 3 page exhibit indicate that “easy.com [is] the portal site for all easyGroup companies...” but that is all it says. In short, there is no evidence that any of the five trade marks has been used in relation to the relevant goods and, consequently, no evidence that the distinctive character of them has been enhanced through that use. In my view, each of the five marks is a mark of low inherent distinctive character.

Likelihood of confusion

45. In determining whether there is a likelihood of confusion, a number of factors have to be borne in mind. The first is the interdependency principle whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I also have to factor in the distinctive character of the earlier mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them he has retained in mind.

46. Earlier in this decision I found:

- that the registered proprietor’s goods in class 12 and services in class 37 are reasonably similar to the applicant’s *vehicles*;
- that the purchase of the respective goods and services will involve at least a reasonably high degree of care; and
- that the purchase of the respective goods is primarily visual although aural considerations may also come into play.

47. I also found that each of the respective marks has a very low degree of visual similarity and a low degree of aural similarity. I found that the registered proprietor’s mark has a low degree of conceptual similarity to the applicant’s mark nos 2325850, CTM 5140157 and CTM 5112115 and a very low degree of conceptual similarity to the applicant’s mark nos 2321976 and 2321977.

48. Taking all matters into account, I consider the differences between each of the respective marks are more than sufficient to outweigh any similarities. There is no likelihood of either direct or indirect confusion. The opposition based on section 5(2)(b) of the Act fails.

The objection under section 5(3) of the Act

49. In its application form, the applicant indicates that it is relying on three earlier marks as set out in paragraph 3 above, however, in its statement of grounds, which accompanies the application form, the applicant states that:

“The Trade Marks are highly distinctive and are well-known as a family of marks. In particular, the Applicant has over 104 Community trade marks and over 80 United Kingdom trade marks for a variety of EASY pre-fixed (sic) marks such as EASYJET (no. 2260901), EASYCAR (no. 266270 (sic)), EASYBUS (no. 2313408A) and EASYVAN (no. 5140157) and has a reputation for having a family of trade marks; all with an EASY prefix followed by a word or words appropriate to the services provided so as to form a new word”.

50. In his witness statement, Mr Griffiths states that:

easyGroup has secured around 1,000 trade mark registrations around the world...easyGroup has also established numerous businesses which operate or have operated under the easy brand.”

51. At PG2, Mr Griffiths exhibits 3 pages downloaded on 8 November 2011 and 9 August 2012 from the easy.com website. The second page of the exhibit shows a list of what is said to be “the list of official current easyGroup brands”. There are 22 on the list including easyJet.com, easyBus.co.uk and easyCar.com. At PG5 (p177) there is an article published in the *Daily Telegraph* on 1 September 2005 which contains the following:

“So the theory is that, if you’re using an easyInternet café today, you are more likely, when thinking of your next travel trip, to book an easyJet flight, rent an easyCar, or stay in an easyHotel. Though each company has separate shareholders, they appear to be under the common brand, and therefore common values.”

52. The applicant’s claims to a family of mark are quite optimistic. The statement of grounds which accompanied the application form mentions 104 CTMs and 80 UK trade mark registration but is otherwise not specific and though there is a reference to 1000 trade marks in Mr Griffiths’ evidence, these are said to be from across the globe. In terms of specific trade marks, the list at PG2 suggest there were just 22 brands, and certainly there are relatively few which are shown, in evidence, to have been in use in the UK. In addition, the evidence does not show that the various trade marks were ever in common ownership. Indeed the newspaper article at PG5 would suggest that different companies with different shareholders were using the different marks. The evidence does not tell me what the position was at the relevant date, however, even if it did, the respective goods and services are, for the most part, lacking in any connection. This lack of connection further undermines the claims made. For all these reasons, I reject the claim to a family of marks and will consider the objections on this ground based only on the marks specified in the application.

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

“ A trade mark which-

(a) is identical with or similar to an earlier trade mark shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United

Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

54. The applicant claims that:

“The use of the Sign by the Proprietor would take unfair advantage of or be detrimental to the distinctive character or repute of the Trade Marks. The Proprietor’s adoption of the Sign is liable to cause a public expectation that the Proprietor’s business is a diversification of the Applicant’s business, and/or the public could have cause to believe that the Proprietor’s trade is from an undertaking linked to the Applicant. The Proprietor would gain an unfair commercial advantage through the adoption of the Sign because the Proprietor would be piggy backing on, or riding on the coat tails of, the extensive reputation of the Applicant and the Trade Marks and thus unfairly increase the marketability of the goods and services offered under the Sign. Further, use of the Sign blurs or dilutes the distinctive character of the Trade Marks, as it will make it more difficult for the Trade Marks to operate as trade marks (i.e. to distinguish the goods and services of one undertaking from those of another). The repute of the Earlier Marks will also be harmed if the goods or services offered under the Sign are inferior as the public will believe that the inferior goods or services offered under the Sign originate from or are licensed by the Applicant.”

55. The matter must be judged at a particular point(s) in time. In *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07 the General Court stated:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000.”

56. The registered proprietor has made no claim to have used its mark prior to the relevant date, so no issues as to seniority of user are relevant. The relevant date at which the applicant must establish its goodwill or reputation in each of its marks and that the use of the registered proprietor’s mark was liable to be prevented is, consequently, 8 July 2010.

57. Reputation in this context means that each of the earlier trade mark is known by a significant part of the public concerned with the goods or services covered by that

mark (see paragraph 26 of the CJEU’s judgment in *General Motors Corp. V Yplon SA (CHEVY)* [1999] ETMR 122). The Court stated:

“27 In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking promoting it.”

58. Under this ground, the applicant relies on the following marks:

Mark	Filing/ registration date	Services relied upon
2266270 easyCar	3 April 2001/ 23 August 2002	Arranging of transportation of goods, passengers and travellers by land; rental and hire of vehicles
2260901 easyJet	9 February 2001/ 20 September 2002	Airline services; transportation of goods, passengers and travellers by air; rental and hire of vehicles; arranging of transportation of passengers by land; travel agency services
2313408A EASYBUS easyBus (series of two)	17 October 2002/ 14 October 2005	Arranging of transportation of goods, passengers and travellers by land; bus transport services; coach services; travel reservation and travel booking services

59. I will consider each mark in turn.

60. 2266270 easyCar: Mr Griffiths states that this mark came about as a result of a rebranding in 2001 (the mark previously used is said to have been EASYRENTACAR). He states that since November 2004, it has provided a vehicle rental service through a number of websites including easycar.com, easycar.fr, easycar.es, easycar.de, easycar.it, easycar.nl and easycar.ie. Vehicles are said to be available “in over 4000 locations in 60 countries including in all EU states”. Turnover figures, the majority of which are said to have been generated through vehicle rentals in the EU, are given as follows:

Year	Revenue in GBP
2006	£11.76m
2007	£20.1m
2008	£26.7m
2009	£26.2m

61. Advertising expenditure in the EU is given for the same period, as follows:

Year	
2006	£987,000
2007	£1,914,000
2008	£2,727,000
2009	£2,079,000

62. Mr Griffiths gives no indication of how much of the above figures relate to the UK.

63. At PG19, Mr Griffiths exhibits pages which he says are taken from the “current” easycar.com website. They appear to have been downloaded on 8 November 2011. At PG20, he exhibits various advertisements. The quality of the prints, which appear to be photocopies of photocopies, is very poor. Whilst I can see various references to the website incorporating the word easycar, the only reference I can see to the mark relied on itself, is at page 498, which refers to easyCar rental facilities in Belfast, Northern Ireland and the UK. The page is not dated but the small print at the bottom indicates that prices relate to October 2006. The source of this advertisement is not given. At page 502 is an advertisement from *Web User*, of 16 February 2006 which refers to easyCar van rentals around the UK. No information is given as to where these advertisements may have been circulated or the numbers of people who may have seen them.

64. At PG21, Mr Griffiths exhibits what he states is an emailed newsletter. There are three pages. The first, dated June 2006, refers to the website. Whilst I can see a picture on the page of a van with the words “Rent a Van” next to it, the quality of the text above and below it, is impossible to read and so I cannot see any references to the mark relied upon. The second page of the exhibit indicates that it is a newsletter sent to French customers in January 2009. The text is in French. Whilst it shows the website address, easycar.fr, I cannot see any reference to the mark relied upon. Page 3 is headed “recent Campaigns”. The page consists of a list showing either easyCar-French [easyCar Safe] or just easyCar-French but does not explain what any of this means.

65. At PG22 is a press release taken from the easycar.com website. Dated 4 June 2008, it indicates that “easyCar customers can now pre-book airport parking, airport transfers, accommodation at airport hotels and access to airport pre-flight lounges, all directly through the easyCar website...” No information is given to show who might have viewed this page.

66. At PG23 is what Mr Griffiths states is a newsletter sent to 59,516 people in January 2007 and opened by 7,086 recipients. He gives no indication of whom or where these people might have been. The quality of the print is appalling and the only reference to the mark relied on that I can make out is a reference to the “official launch of easyCar’s sister company easyVan.

67. At PG24 are various pages from the easycar.com, easycar.es and easycar.fr websites from July 2008, May 2007 and May 2007 respectively. Only the first is in English but whilst there are references to the easycar.com and easyvan.com websites on these pages, I can see no reference to the mark relied upon.

68. At PG25 are six pages which include a number of reviews from various sources. Some of these refer to services provided in France and the US, another refers only to the Easyrentacar service. Two refer to easycar rental (dated 19 May 2009 and 29 October 2002) and both are said to be from reviewers in London.

69. At PG26 is a copy of a very short article, the title of which is FULFILMENT: easyCar.com. Published on 27 November 2008 in *New Media Age* it comments on the use of the easyCar.com website. At PG 27 is a one paragraph article published in *ADP France News* on 27 March 2002 about a French company. At PG28 is a very short article published in the *Daily Mail* on 28 June 2011 which is after the relevant date. It is entitled “Stelios driving up profits at easyCar” which the article describes as a car hire business. At PG29 is a two page exhibit. The first page is a copy of the front cover of the report “Business Superbrands An Insight into Britain’s Strongest B2B Brands 2003/04”. The second shows part of an article about easyCar car hire but much of it is unreadable.

70. Whilst it is clear that the sign relied upon has been used, much of the evidence relates to use other than in the UK. Turnover and advertising figures are given and are not insubstantial but the figures relate to use in the EU and nothing is provided which allows me to establish what proportion of these figures relate solely to the UK. The evidence of advertising relates either to other countries or is from after the relevant date. On the basis of the evidence filed, I do not consider the applicant has shown a reputation, in the sense set out in *Chevy*, amongst the relevant UK public at the relevant date, in the mark easyCar.

71. 2260901 easyJet. In his evidence, Mr Griffiths states that easyJet was set up in 1995 as an airline with the first flight made in November of that year. Since then, it has carried over 270m passengers and flies approximately 422 routes from 114 destinations in 27 countries, mainly within Europe. Turnover from launch amounts to some £10billion with advertising since 2007 in the EU amounting to between £217m and £232m.

72. Turnover and advertising expenditure are also given as follows:

Turnover		Advertising	
2004/2005	£1,341,400,000		
2005/2006	£1,619,700,000		
2006/2007	£1,797,200,000	2007	£47m
2007/2008	£2,262,800,000	2008	£45.5m
2008/2009	£2,667,000,000	2009	£38.1m
2009/2010	£2,973,100,000	2010	£35m
		2011	£52m

73. Figures obtained from WebTrends software interface are said to show that the website easyjet.com received some 131,531,020 visits from the UK in the period 31 March 2010 to 31 March 2011 with approximately 6.5m bookings made through it.

74. At PG8, Mr Griffiths exhibits a number of articles detailing various awards. The winners of the Business Traveller Awards 2008 are shown at page 240 and show that easyJet was named the Best Low-Cost Airline. An article dated 11 November 2009 from the *Daily Post* (Liverpool) (page 248) shows that easyJet was named the Best No Frills Airline and Best Economy Class at the British Travel Awards, voted for by the travelling public. An article from *The Guardian* of 15 July 2000 ranked it at No. 7 in the (world’s) Best Leisure Airline category (page 260) and at No 5 in the Best

Business Airline category (page 261). An article from the *Evening News* (Edinburgh) dated 6 September 2002 (page 459 at PG17) described easyJet as “Europe’s largest no-frills carrier.

75. Mr Griffiths states that the airline featured in seven series of a TV programme called Airline shown between January 1999 and Spring 2003. The first series consisted of ten programmes each 30 minutes long. The third series consisted of six one hour programmes. The fifth and sixth series attracted ten million viewers for each episode. In 2003 it was ITV’s most popular factual programme with a total of seventy five million viewers. I am not told how these figures were calculated.

76. In considering the reputation of easyJet, I have taken a variety of factors into account. Whilst the applicant claims to have a reputation in this mark in relation to each of the services set out in paragraph 58 above, the evidence shows only that prior to the relevant date there was substantial use of the mark in relation to an airline. The renown of easyJet must have been increased by the broadcasting of the television series about the airline, whether or not the viewer was a user of that airline. The name of the airline is also likely to be known by those who do not use it but encounter it at e.g. an airport. I conclude from the evidence that at the relevant date there was a substantial reputation in the trade mark easyJet for airline services as it was known to a significant part of the public concerned in a substantial part of the United Kingdom.

77. 2313408A EASYBUS easyBus (series of two). Mr Griffiths states that easyBus Ltd was incorporated in February 2003 and operated its first route, between London and Luton airport, in August 2004. It expanded, at an unspecified date, to serve Gatwick and Stansted airports from/to London. Since its launch, some 5.8m passengers are said to have travelled on an easybus branded bus. Turnover and advertising costs for the company are given as follows:

Year	Turnover	Advertising (EU)
2005/2006	£876,256	85,709
2006/2007	£1,872,336	199,594
2007/2008	£4,662,961	307,291
2008/2009	£6,701,119	560,810
2009/2010	£7,821,348	501,385

78. Visitors to the website easybus.com from the UK between 31 March 2010 and 31 March 2011 are said to number 2,068,161 with 284,509 bookings having been made but much of this activity is likely to have been after the relevant date. At PG52-54 Mr Griffiths exhibits four articles about the introduction of the bus service and which were published in the *Independent* on 5 October 2005, the *Nottingham Evening Post* on 7 September 2004 and the *Guardian* on 31 July and 19 August 2004.

79. Whilst the evidence is not without fault and the routes offered are very limited (the evidence indicates they go only between London and nearby airports), I am prepared to accept that the mark easyBus had a reputation for bus travel amongst a significant part of the public concerned at the relevant date.

80. In addition to having a reputation, a link must be made between the respective marks. In *Adidas-Salomon* Case C-408/01 the CJEU stated:

“The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23). The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, *SABLE*, paragraph 22, and *Marca Mode*, paragraph 40).”

81. I take note that both the CJEU and the GC have reiterated the comment made in *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767 (albeit in relation to section 10(3)) that the purpose of the Regulation is not to prevent registration of any mark which is identical or similar to a mark with a reputation and am mindful of the comments of Patten J in *Intel Corporation Inc v CPM United Kingdom* [2006] EWCH 1878 where he stated:

“But the first step to the exploitation of the distinctive character of the earlier mark is necessarily the making of the association or link between the two marks and all that Neuberger J is, I think, saying in this passage [*Premier Brands* at p789] is that the existence of a later mark which calls to mind the earlier established mark is not sufficient to ground an objection under s.5(3) or s10(3) unless it has one or other of the consequences specified by those provisions. It must be right that the making of the association is not necessarily to be treated as a detriment or the taking of an unfair advantage in itself and in cases of unfair advantage it is likely to be necessary to show that the making of the link between the marks had economic consequences beneficial to the user of the later mark.”

82. Although the issue of the effect on economic behaviour arose in the above case in the context of detriment or dilution, it is, I believe, reasonable to infer that similar considerations would also arise in the context of the question of unfair advantage. Indeed in *Electrocoin Automatics Limited v Coinworld Limited and Others* [2005] FSR 7, Mr Geoffrey Hobbs Q.C., sitting as a Deputy Judge stated:

“102. I think it is clear that in order to be productive of advantage or detriment of the kind prescribed, “the link” established in the minds of people in the market place needs to have an effect on their economic behaviour. The presence in the market place of marks and signs which call each other to mind is not, of itself, sufficient for that purpose.”

83. In *C A Sheimer (M) Sdn Bhd’s TM Application (VISA)* [2000] RPC 484 Geoffrey Hobbs Q.C. sitting as the Appointed Person considered whether Sheimer’s mark

“would, without due cause:

(iv) take unfair advantage of the distinctive character or repute of Visa International's earlier trade mark".

In setting out his finding, he stated:

"I think it is clear that Sheimer would gain attention for its products by feeding on the fame of the earlier trade mark. Whether it would gain anything more by way of a marketing advantage than that is a matter for conjecture on the basis of the evidence before me. Since I regard it as quite likely that the distinctive character or reputation of Visa International's earlier trade mark would need to increase the marketability of Sheimer's products more substantially than that in order to provide Sheimer with an unfair advantage of the kind contemplated by Section 5(3) I am not prepared to say that requirement (iv) is satisfied."

84. I must be satisfied, therefore, that, for those people who make a link between the respective marks, the link they make affects their economic behaviour and, if so, that the reputation of the earlier mark is transposed to the later mark with the result that marketing and selling of the registered proprietor's goods and services becomes easier.

85. The applicant has shown it has a reputation in the mark easyJet in respect of airline services and in the mark EASYBUS in respect of bus travel. Each of these services involves the transportation of passengers from one place to another. There is no evidence that the applicant has used either of these marks in relation to any other area of trade. In my view, given the disparity of the respective goods and services, no link would be made between the respective marks. Even if I am wrong in this, I do not consider that the registered proprietor would gain any unfair advantage through the use of its mark. It is not clear to me exactly what advantage it would gain and, furthermore, there is no evidence of any intention on its part nor any other added factor that would support the applicant's claim under this ground. In relation to dilution, I can see no reason why the capacity of the earlier marks to distinguish the applicant's services would be diminished to any extent, and certainly not one that would have any impact on the economic behaviour of the relevant public. That being the case, the claims brought under section 5(3) of the Act fails.

The objection under section 5(4)(a) of the Act

86. The applicant relies under this ground on use of the signs EASYCAR, EASYJET and EASYBUS. I do not consider that it can be in any stronger position in relation to these earlier rights and in relation to these services than that which I have already considered under grounds brought under section 5(2)(b) and I decline to deal with it.

Summary

87. The application has failed on each of the grounds on which it was brought.

Costs

88. The application having failed, the registered proprietor is entitled to an award of costs in its favour. It has represented itself in these proceedings and its involvement

has been limited to the filing of a counterstatement and relatively short written submissions. I do not consider it to be proportionate to carry out a detailed enquiry as to the costs of preparing those documents or the time it spent on reviewing the evidence filed by the applicant but acknowledge that it would have taken it some time and effort to do so. I consider that the registered proprietor is entitled to an award in the sum of £500 as a contribution towards its costs.

89. I therefore order easyGroup IP Licensing Limited to pay eazyTyres Ltd the sum of £500. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Date this 14th day of August 2013

**Ann Corbett
For the Registrar
The Comptroller-General**