

O-425-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2579582
BY ANNE BUTTERLY AND GERALD BUTTERLY
TO REGISTER THE TRADE MARK
EASYDRY
IN CLASS 16
AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER No. 102597 BY
EASYGROUP IP LICENSING LIMITED**

BACKGROUND

1) On 28 April 2011, Anne Butterly and Gerard Butterly (hereinafter the applicants) applied to register the trade mark EASYDRY in respect of the following goods in Class 16: Disposable towels made from cellulosic materials for professional use in the hairdressing and beauty sector.

2) The application was examined and accepted, and subsequently published for opposition purposes on 29 July 2011 in Trade Marks Journal No.6898.


3) On 1 November 2011 easyGroup IP Licensing Limited (hereinafter the opponent) filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade marks:

Mark	Number	Date of application / registration	Class	Specification relied upon
EASYGYM	CTM 9802646	11.03.11 / 22.08.11	3	Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions, dentifrices; aftershave lotions; toiletries; antiperspirants; beauty masks; astringents for cosmetic purposes; breath freshening sprays; cosmetics; cosmetic kits; depilatories; hair lotions; hair spray; shampoos; shaving preparations; soap; nail varnish; varnish removing preparations.
			5	Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use; food for babies; plasters; materials for dressings, materials for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides; herbicides; dietetic beverages adapted for medical purposes; dietetic foods adapted for medical purposes; medical preparations for slimming purposes; vitamin preparations; vitamins; vitamin drinks; preparations for weight control; health food supplements; dietary supplements.
			28	Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; toys; bar-bells; body building apparatus; body training apparatus; fitness apparatus; appliances for gymnastics; physical exercise machines; body rehabilitation apparatus; indoor football tables;

				table tennis tables.
			35	Advertising; business management; business administration; office functions; the bringing together for the benefit of others of cosmetics, cosmetic kits, toiletries, perfumes, hair lotions, dentifrices, aftershave lotions, antiperspirants, beauty masks, hair spray, shampoos, shaving preparations, soap, nail varnish, tanning lotions, pharmaceutical preparations, baby food, plasters, vitamin preparations, vitamins, vitamin drinks, preparations for weight control, health food, health supplements, dietary supplements, toys, games, playthings, sporting articles, barbells, body-building apparatus, body training apparatus, fitness apparatus, fitness equipment, sports clothing, leotards, sports shorts, sports T-shirts, polo shirts, baseball caps, sports shoes, training shoes, swimming costumes, swimming goggles, nose clips for use in swimming, ear plugs for use in swimming, tennis racquets, squash racquets, tennis balls, squash balls, towels, robes, enabling customers to conveniently view and purchase those goods; advice relating to the business management of health clubs; advice relating to the business operation of health clubs.
			41	Education; providing of training; sporting and cultural activities; fitness instruction and tuition; group fitness and exercise classes; personal training services; provision of gymnasium facilities; gymnasium services relating to body building; gymnasium services relating to weight training; life coaching services; education relating to nutrition; provision of educational information relating to fitness, exercise, diet, health and nutrition; entertainment services; entertainment information services; health club services; gymnasium services; gymnasium club services; nutrition coaching; weight management coaching; organisation of sports competitions; physical education services; providing sports facilities; provision of recreation facilities; rental of sports equipment; rental of tennis courts; arranging and conducting workshops; advisory, consultancy and information services relating to all the aforesaid services.
			44	Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services; hairdressing salons; aromatherapy services;

				health care; health spa services; physical therapy; physiotherapy; sauna services; solarium services; health assessment and health risk assessment services; provision of medical referral services; fitness testing services; counselling services relating to health, fitness, diet and nutrition; provision of weight control and weight reduction programmes.
EASYRESORT	CTM 5813481	27.03.07 / 13.03.08	16	Paper, cardboard and goods made from these materials, not included in other classes; 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; stationery, artists` materials, writing instruments; book binding material; adhesives for stationery or household purposes; artists` materials; paint brushes; typewriters and office requisites (except furniture); plastic materials for packaging (not included in other classes); printers` type; printing blocks.
			39	Transport; packaging and storage of goods; travel arrangement; transportation of goods, passengers and travellers by air, land or sea; airline and shipping services; airport check-in services; arranging of transportation of goods, passengers and travellers by land and sea; airline services; baggage handling services; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft, vehicles and boats; aircraft parking services; travel agency and tourist office services; advisory and information services relating to the aforesaid services; information services relating to transportation services; travel information and travel booking services; all the aforementioned services also provided on-line from a computer database or the Internet.
			43	Temporary accommodation; provision of food and drink; catering; hotel, restaurant, café and bar services; hotel reservation services; hotel services for the provision of facilities for exhibitions and conferences; provision of information relating to all of the aforementioned services; booking and reservation services


				relating to all of the aforementioned services.
easyKiosk	CTM 5109491	31.05.06 / 16.01.09	16	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.
			35	Advertising; business management; business administration; office functions; the bringing together, for the benefit of others, of a variety of goods enabling customers to conveniently view and purchase those goods from an in-flight store, by means of telecommunications, an electronic shop or from a retail gift, pharmacy and/or souvenir shop.
			43	Services for providing food and drink; temporary accommodation Catering for the provision of food and drink; bar, catering, cafe and restaurant services; in-flight and airport catering services.
	CTM 5297106	06.09.06 / 08.05.08	16	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; stationery, artists' materials, writing instruments.
			25	Clothing, footwear, headgear.
			28	Games and playthings; toys; gymnastic and sporting articles; decorations for Christmas trees, model boats, scooters, teddy bears, balls, golf balls, playing cards.
			39	Transport; packaging and storage of goods; travel arrangement; transportation of goods, passengers and travellers by air, land and sea; airline, cruise and shipping services; airport and cruise check-in services; arranging of transportation of goods, passengers and travellers by land and sea; baggage handling services; cargo handling and freight services; arranging, operating and providing facilities for

				cruises, tours, excursions and vacations; chartering of aircraft and boats; rental and hire of aircraft, vehicles and boats; aircraft parking services; travel agency and tourist office services; advisory and information services relating to the aforesaid services; information services relating to transportation services; travel information and travel booking services provided on-line from a computer database or the Internet.
			41	Education; providing of training; entertainment; sporting and cultural activities; including the provision of the aforesaid on a cruise ship.
			43	Temporary accommodation; provision of food and drink; catering; hotel, restaurant, café and bar services; hotel reservation services; hotel services for the provision of facilities for exhibitions and conferences.

b) The opponent contends that the mark in suit is similar to its marks CTM 9802646, CTM 5813481, CTM 5109491 and CTM 5297106 above in that “it contains the prominent element “EASY” followed by a word or words appropriate to the services provided so as to form a new word. It states that the goods applied for are similar to the “paper, cardboard and goods made from these materials” goods in its earlier marks. Alternatively, they are similar to the following services “hairdressing salons; health spa services; hygienic and beauty care; sauna services; solarium services; in-flight and airport catering services”. It states that there is considerable reputation in the mark EASYCRUISE. The mark in suit therefore offends against Section 5(2)(b) of the Act.

c) The opponent relies upon the following trade marks and reduced specifications in its section 5(3) opposition:

Mark	Number	Date of application / registration	Class	Specification relied upon
EASYJET	UK 2260901	09.02.01 / 20.09.02	16	Publications.
			39	Airline services; Transportation services; airport check-in services; operating and providing facilities for cruises, tours, excursions and vacations; travel agency and tourist office services; rental and hire of vehicles; travel information services.
			42	Temporary accommodation; in-flight and airport catering. Retail services in relation to cosmetics, perfume, beauty care products, toys, games, snack foods, watches, jewellery and electronics.

EASYBUS	CTM 2900926	17.10.02 / 30.08.05	39	Transportation of goods, passengers and travellers by land; bus transport services; coach services; travel reservation and travel booking services.
easyCar	UK 2266270	03.04.01 / 23.08.02	39	Transportation of goods, passengers and travellers by land; rental and hire of vehicles.
EASYHOTEL	CTM 4433272	08.06.05 / 16.01.07	43	Temporary accommodation; hotel services; hotel reservation services.
	CTM 5297106	06.09.06 / 08.05.08	39	Transport; travel arrangement; transportation of goods, passengers and travellers by sea; cruise and shipping services; operating and providing facilities for cruises, tours, excursions and vacations.
			43	Temporary accommodation.

d) The opponent contends that it has a significant reputation in the UK in its marks above and that they are inherently distinctive. It claims that it has a family of marks with over 104 Community trade marks and over 80 UK trade marks for a variety of EASY prefixed marks such as those above and also easyMoney (2265184) and EASYVAN (5140157). It is contended that a number of OHIM decisions have recognised this “family” to exist. It is also claimed that the services of both parties are similar [I note that no services were ever sought to be registered by the applicants]; Use of the mark in suit by the applicants would take unfair advantage of or be detrimental to the distinctive character or repute of the opponent’s marks. Such use would cause the public to expect that the business is a diversification of the opponent’s business and/or cause the public to believe that the applicants were linked to the opponent. It claims that the applicants would gain an unfair advantage by piggy backing on the extensive reputation of the opponent and thus unfairly increase the marketability of the services [sic] offered under the sign. Use of the mark in suit would blur or dilute the distinctive character of the opponent’s marks and make it more difficult for the marks to act as trade marks in distinguishing the goods and services of one undertaking from those of another. The opponent’s repute could be damaged if the services [sic] offered under the sign are inferior as the public will believe the services [sic] to originate from, or be licensed by, the opponent. The mark in suit therefore offends against Section 5(3) of the Act.

e) The opponent relies upon the following signs and use under its Section 5(4)(a) case:

Sign	Date of first use	Goods or services sign used upon
EASYJET	1995	Airline services; Transportation services; in-flight and airport catering services; rental and hire of vehicles; provision of temporary accommodation; airport check-in

		services; operating and providing facilities for cruises, tours, excursions and vacations; travel agency and tourist office services; travel information services; publications; Retail services in relation to cosmetics, perfume, beauty care products, toys, games, snack foods, watches, jewellery and electronics.
EASYCAR	2002	Transportation services; rental and hire of vehicles; travel information services; Transportation of goods, passengers and travellers by land.
EASYHOTEL	2005	Temporary accommodation; hotel services; hotel reservation services; hotel booking services; travel information services.
EASYBUS	2004	Transportation of goods, passengers and travellers by land; bus transport services; coach services; travel reservation and travel booking services; travel information services.
EASYCRUISE	2005	Transportation of goods, passengers and travellers by sea; cruise services; travel booking services; operating and providing facilities for cruises, tours, excursions and vacations; temporary accommodation.

f) The opponent contends that it has used the above marks throughout the UK from the date of first use, with the exception of Easyhotel and Easybus, which have only been used in London. The opponent contends that it has goodwill in the above marks in the UK and that use of the mark in suit would mislead the public into believing that the applicant's goods originate from or are licensed by the opponent. This would cause damage to the opponent's goodwill and reputation. The mark in suit offends against section 5(4)(a) of the Act.

4) On 18 November 2011, the applicants filed a counterstatement denying all the grounds, pointing out that they have been using their mark in the UK since 2006. They deny that the marks, or goods and services are similar or identical. They state that the only similarity is the prefix "easy" which will be seen by the average consumer as an allusion to the characteristics of the goods or services rather than an indication of origin. They put the opponent to proof of use in relation to the following marks: CTM 2900926, UK 2260901 and UK 2266270 in relation to all the goods and services for which they are registered.

5) Both sides filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 18 July 2013 when the applicants were represented by Mr Reddington of Messrs Williams Powell. The opponent decided not to attend the hearing but did provide written submissions.

OPPONENT'S EVIDENCE

6) The opponent filed two witness statements. The first, dated 23 January 2012, is by Paul David Griffiths, the Finance Controller of the opponent. He has held this position since 27 September 2010. He states that his statement is either from his own

knowledge or from the records of the opponent. He refers to the large number of marks that the opponent has registered worldwide, all of which have the prefix “easy” and provides various references from courts etc which state that the company has a “family” of trade marks which all share the “easy” prefix. A number also refer to the fact that this provides a degree of distinctiveness. There are also numerous instances of newspaper articles referring to the increasing range of services provided under brands beginning with “easy” from the opponent. He also provides detailed evidence which shows that:

- First used in 1995, the mark “easyjet” enjoys significant reputation for providing flights and earning revenue in the billions. In addition to flights the opponent provides other services under the easyjet mark such as hotels, holidays, airport parking and travel insurance.
- First used in 2001, the mark “easycar” enjoys significant reputation in relation to hire car services.
- First used in 2001, the mark “easybus” enjoys a reputation in relation to bus and coach services between London and Gatwick, Luton and Stansted airports.
- First used in 2005, the mark “easycruise” enjoys a significant reputation in relation to cruise services.
- First used in 2004, the mark “easyhotel” enjoys a reputation in relation to the provision of hotel services. They have seven hotels in the UK.
- First used in 2007, the mark “easyoffice” enjoys a reputation in relation to the provision of office facilities. The opponent has a number of sites in the UK and although the turnover is modest it averages over £1million per annum.

7) All the businesses are no-frills operations, offering basic services at low cost. Although all of the turnover figures are stated in GBP, it is not clear if they relate solely to activities within the UK or to worldwide activity.

8) The second witness statement, dated 1 February 2012, is by Jody Tsigardes, the opponent’s Trade Mark Attorney. He provides as exhibit JT1 a copy of an internet search in respect of the term “gymnasium spa” carried out on 20 January 2012. He then used the search to identify those which offered spa or health club services in addition to gym services. He provides the outcome of the search and it shows that a number of gymnasiums do also offer spa/health club services.

APPLICANT’S EVIDENCE

9) The applicant filed a witness statement, dated 5 March 2012, by John Reddington their Trade Mark Attorney. He provides the results of an internet search which shows that a number of businesses have the word “Easy” as a prefix or the first word of their

name. He also provides copies of the opponent's website where the services offered under the various marks of the opponent all seem to describe themselves as being "convenient".

OPPONENT'S EVIDENCE IN REPLY

10) The opponent filed a witness statement, dated 1 May 2012, by Mr Tsigarides who has already provided evidence in this case. He points out that:

"7. One of the distinctive features of the opponent's brand is use of the word "easy" in lower case conjoined with a term appropriate to the services or goods provided under the relevant mark. For example, easyJet, easyCar, easyBus and so on. Many of the companies identified in JR1 [applicant's evidence], are not in that form, for example, easy accountancy, easy broking online and easy buy appliances. However, the mark "easydry" is in that form."

11) That concludes my review of the evidence. I now turn to the decision.

DECISION

12) As a preliminary point, the applicant sought to have the opposition struck out on the basis that the opponent was guilty of abuse of process as the parties agreed terms for a settlement several months prior to the hearing. Whilst the applicant signed an agreement in November 2012, the opponent did not sign it and so no written agreement has been concluded. The applicant referred me to the case of *Grovit and others v Doctor and others* [1997] UKHL 13, however, I do not find this authority to be on all fours with the instant case. In the case referenced there was complete inactivity for two years. There has been no such delay in the proceedings in front of the Registry. The opposition was filed on 1 November 2011 and in the interim the opponent filed its initial evidence and also filed submissions and evidence in reply to the evidence provided by the applicant.

13) I therefore dismiss the request to strike out the opposition.

14) I now turn to the ground of opposition based on section 5(2)(b) which reads:

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."

15) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

- (a) 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.”

16) The opponent is relying upon its trade marks listed in paragraph 3(a) above which are clearly earlier trade marks. The applicant did not request that the opponent provide proof of use in respect of these marks, and because of the interplay of dates between the mark in suit being advertised and the opponent’s marks being registered, the provisions of Section 6A of the Act do not apply.

17) When considering the issues under Section 5(2) and the likelihood of confusion, I take into account the guidance from the settled case law provided by the CJEU 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 B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10) Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

(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/ 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; 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;

(e) 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 in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(g) 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;

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

(i) 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;

(j) 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.

18) Whilst the opposition under this ground relies on the four earlier rights set out above, I intend to consider only CTM 58134841 **EASYRESORT** as, because of the specification of goods covered, it provides the opponent with its strongest case. The opponent clearly considered in its submissions that its strongest case was under CTM 9802646 **EASYGYM** so I will compare both marks to the mark in suit. I will deal with the family of marks issue later in the decision.

Distinctive character of the opponent's earlier trade mark

19) The opponent did not provide any evidence of use of its EASYRESORT mark. When used upon goods in class 16 it has no obvious meaning, other to allude to a destination which has a number of facilities for holiday makers to enjoy and as such it must be considered to have a reasonably high degree of inherent distinctiveness in respect of these goods. The opponent did not provide any evidence of use of its EASYGYM mark. When used upon goods in classes 3 and 5 it has no obvious meaning and as such it must be considered to have a reasonably high degree of inherent distinctiveness in respect of them. In respect of the following services in class 35: "Advertising; business management; business administration; office functions; the

bringing together for the benefit of others of cosmetics, cosmetic kits, toiletries, perfumes, hair lotions, dentifrices, aftershave lotions, antiperspirants, beauty masks, hair spray, shampoos, shaving preparations, soap, nail varnish, tanning lotions, pharmaceutical preparations, baby food, plasters, toys, games, polo shirts.” the mark has no obvious meaning and as such it must be considered to have a reasonably high degree of inherent distinctiveness in respect of them.

20) However, when used on the following services in Class 35 “the bringing together for the benefit of others of vitamin preparations, vitamins, vitamin drinks, preparations for weight control, health food, health supplements, dietary supplements, playthings, sporting articles, bar-bells, body-building apparatus, body training apparatus, fitness apparatus, fitness equipment, sports clothing, leotards, sports shorts, sports T-shirts, baseball caps, sports shoes, training shoes, swimming costumes, swimming goggles, nose clips for use in swimming, ear plugs for use in swimming, tennis racquets, squash racquets, tennis balls, squash balls, towels, robes, enabling customers to conveniently view and purchase those goods; advice relating to the business management of health clubs; advice relating to the business operation of health clubs” I believe that the mark “easygym” does allude that such items are easy to use in a gym, and as such the mark has only a reasonable degree of inherent distinctiveness in respect of them.

21) Similarly, apart from the term “education” in the class 41 services for which easygym is registered where it has no meaning, and as such it must be considered to have a reasonably high degree of inherent distinctiveness in respect of this service; the mark clearly has an allusive meaning for all of the other services listed in this class, and as such the mark has only a reasonable degree of inherent distinctiveness in respect of them.

22) Lastly moving onto the class 44 services the mark has no meaning for “Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services; hairdressing salons; aromatherapy services; health care; physical therapy; physiotherapy; solarium services; health assessment and health risk assessment services; provision of medical referral services; counselling services relating to health, diet and nutrition;” and as such it must be considered to have a reasonably high degree of inherent distinctiveness in respect of these services. However, I believe that it does have an allusive meaning for “health spa services; sauna services; counselling services relating to fitness; provision of weight control and weight reduction programmes; fitness testing services” and as such the mark has only a reasonable degree of inherent distinctiveness in respect of it.

The average consumer and the nature of the purchasing process

23) I must now determine the average consumer for the goods of the parties. Clearly the applicant’s specification is aimed at businesses, whereas the relevant part of the opponent’s specification could be aimed at both businesses and the general public. Although the applicant’s specification mentions hairdressing and beauty salons in particular, there is no reason to suppose that disposable paper towels would not be

used by a wide range of businesses. A consumable item used in simply mopping up spills or drying items is not likely to be subject to a high level of attention when the selection is being made, although I take into account that a business may be buying in bulk and so pay more attention. The opponent's marks cover a vast array of goods and services and so the attention level of the average consumer will vary considerably.

Comparison of goods

24) For ease of reference I have listed the goods of both parties to be considered below.

Applicant's specification	Opponent's relevant specification
<p>Class 16: Disposable towels made from cellulosic materials for professional use in the hairdressing and beauty sector.</p>	<p>CTM 5813481: Class 16: Paper, cardboard and goods made from these materials, not included in other classes.</p> <p>CTM 9802646:</p> <p>Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions, dentifrices; aftershave lotions; toiletries; antiperspirants; beauty masks; astringents for cosmetic purposes; breath freshening sprays; cosmetics; cosmetic kits; depilatories; hair lotions; hair spray; shampoos; shaving preparations; soap; nail varnish; varnish removing preparations.</p> <p>Class 5: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use; food for babies; plasters; materials for dressings, materials for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides; herbicides; dietetic beverages adapted for medical purposes; dietetic foods adapted for medical purposes; medical preparations for slimming purposes; vitamin preparations; vitamins; vitamin drinks; preparations for weight control; health food supplements; dietary supplements.</p> <p>Class 35: Advertising; business management; business administration; office functions; the bringing together for the benefit of others of cosmetics, cosmetic kits, toiletries, perfumes, hair lotions, dentifrices, aftershave lotions, antiperspirants, beauty masks, hair spray, shampoos, shaving preparations, soap, nail varnish, tanning lotions, pharmaceutical preparations, baby food, plasters, vitamin preparations, vitamins, vitamin drinks, preparations for weight</p>

	<p>control, health food, health supplements, dietary supplements, toys, games, playthings, sporting articles, bar-bells, body-building apparatus, body training apparatus, fitness apparatus, fitness equipment, sports clothing, leotards, sports shorts, sports T-shirts, polo shirts, baseball caps, sports shoes, training shoes, swimming costumes, swimming goggles, nose clips for use in swimming, ear plugs for use in swimming, tennis racquets, squash racquets, tennis balls, squash balls, towels, robes, enabling customers to conveniently view and purchase those goods; advice relating to the business management of health clubs; advice relating to the business operation of health clubs.</p> <p>Class 41: Education; providing of training; sporting and cultural activities; fitness instruction and tuition; group fitness and exercise classes; personal training services; provision of gymnasium facilities; gymnasium services relating to body building; gymnasium services relating to weight training; life coaching services; education relating to nutrition; provision of educational information relating to fitness, exercise, diet, health and nutrition; entertainment services; entertainment information services; health club services; gymnasium services; gymnasium club services; nutrition coaching; weight management coaching; organisation of sports competitions; physical education services; providing sports facilities; provision of recreation facilities; rental of sports equipment; rental of tennis courts; arranging and conducting workshops; advisory, consultancy and information services relating to all the aforesaid services.</p> <p>Class 44: Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services; hairdressing salons; aromatherapy services; health care; health spa services; physical therapy; physiotherapy; sauna services; solarium services; health assessment and health risk assessment services; provision of medical referral services; fitness testing services; counselling services relating to health, fitness, diet and nutrition; provision of weight control and weight reduction programmes.</p>
--	--

25) The accepted test for comparing goods is that set out by Jacob J. in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28 TREAT, which was effectively endorsed by the Advocate General in *Canon*; ETMR 1. The factors to be taken into account are:

- a) The respective uses of the respective goods;
- b) The respective users of the respective goods;
- c) The physical nature of the goods;
- d) The respective trade channels through which the goods reach the market;
- e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be found on the same or different shelves;
- f) The extent to which the respective goods are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods in the same or different sectors.

26) I also take into account the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

“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.”

27) The question of complementary goods/services has been considered by the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM) Case T- 325/06 the GC stated:

“It is true that goods are complementary if there is a close connection between them, in the *sense that one is indispensable or important for the use of the other in such a way that* customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685 , paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057 ; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757 , paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000 , paragraph 48).”

28) However, in the cases *Sandra Amalia Mary Elliott v LRC Products Limited* (and cross opposition) [BL O-255-13] in respect of the marks LUV and LOVE respectively Mr Alexander Q.C. acting as the Appointed Person said:

“15 A formulation of the law by the same Hearing Officer in very similar terms was accepted without criticism by either party or by Floyd J (as he then was) *Youview TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) and the Hearing Officer's statement of the law cannot be faulted.

16 However, because of the particular grounds of appeal in this case, which did not arise in the *Youview* case, it is necessary to make three observations about that summary as it applies to the present case.

17 First, the starting point for the analysis of similarity is the wording of the Act and the Directive. These require the tribunal to determine whether or not the respective goods are “identical or similar” but they do not specify the criteria by reference to which similarity is to be assessed. In the well-established guidance from the Court of Justice on this issue originating in Canon , to which the Hearing Officer referred, the Court has not suggested that every case requires assessment of whether the respective goods or services are complementary. To the contrary, the Court has regularly made it clear that all relevant factors relating to the goods or services themselves should be taken into account, of which complementarity is but one (see e.g. in Boston).

18 Second, the concept of complementarity is itself not without difficulty. In a number of cases, reference to it does not make the assessment of similarity easier. If tribunals take the explanation of the concept in Boston as akin to a statutory definition, it can lead to unprofitable excursions into matters such as the frequency with which certain goods are used with other goods and whether it is possible for one to be used without the other. That analysis is sometimes of limited value because the purpose of the test, taken as a whole, is to determine similarity of the respective goods in the specific context of trade mark law. It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense — but it does not follow that wine and glassware are similar goods for trade mark purposes.

19 Third, the Hearing Officer said at [32]:

As stated above, the legal definition of ‘complementary’, as per Boston , is that the goods must be “indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”. It is not sufficient that the goods “can” be used together; nor is it sufficient that they are sold together.

20 In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston .

21 Moreover, it is necessary to view the quotation from Boston in the context of the facts of that case where the dispute over similarity turned in part on whether the goods were used together for a rather specific medical procedure. The Court of First Instance said at [77]-[87]:

Similarity between the products

77 According to consistent case-law, in order to assess the similarity of the products or services concerned, all the relevant features of the relationship that might exist between those products or services should be taken into account. Those factors include, in particular, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary (*Sunrider v OHIM* , paragraph 27 above, paragraph 85; judgment of 15 March 2006 in Case T-31/04 *Eurodrive Services and Distribution v OHIM — Gómez Frías (euroMASTER)* , paragraph 31).

78 As regards the assessment of the similarity of the goods at issue, the Board of Appeal found, in paragraphs 22 to 24 of the contested decision, that, owing to their functional differences, apparatus for placing a suture, on the one hand, and hollow fibre oxygenators with detachable hard-shell reservoir, on the other hand, have a different method of use, are not in competition with each other and are not interchangeable. However, the Board found, in essence, that the goods at issue were closely linked to the goods of the intervener in so far as they had a certain complementary character, since they could be used simultaneously in the field of medicine, for example during surgery. They might also be purchased through the same distribution channels and be found in the same points of sale, so that the relevant public could be led to believe that they came from the same undertaking.

79 Those findings must be upheld.

80 In this respect, it must be noted that the goods bearing the earlier trade mark and those covered by the mark applied for both concern the medical field and are therefore intended to be used in the context of a therapeutic treatment.

81. In addition, as the Board of Appeal rightly pointed out, all the goods covered by the mark applied for have a certain complementary relationship with those bearing the earlier trade mark.

82. It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM — Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685 , paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057 ; Case T-364/05 *Saint-Gobain Pam v OHIM — Propamsa (PAM PLUVIAL)* [2007] ECR II-757 , paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM — Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000 , paragraph 48).

83. It is also true that, as OHIM moreover acknowledged, apparatus for placing a suture cannot be considered to be indispensable or important for the use of hollow fibre oxygenators with detachable hard-shell reservoir.

84. However, it is clear that apparatus for placing a suture and hollow fiber oxygenators with detachable hard-shell reservoir can be considered to be complementary where, in surgery which has required an incision and during which an oxygenator has been used, the surgeon uses apparatus for placing a suture. Thus, in the course of a single, very specific procedure, namely a surgical operation, two apparatus, namely an oxygenator and apparatus for placing a suture, might be used, one bearing the trade mark CAPIOX and the other the trade mark CAPIO.

85. It follows that, even though the applicant claims that the goods at issue cannot be considered to be similar simply because they are both used in the field of medicine, which, according to the applicant, is the case of nearly all goods of significance, the goods at issue are similar because they are in fact in a certain complementary relationship and specifically target certain professionals in the medical sector. In addition, in the present case, contrary to what the applicant claims, the goods at issue are not similar solely because they are used in the field of medicine, but because they could be used in the same, very specific surgical operation, namely open-heart surgery.

86. Finally, the products at issue can in fact be found in the same distribution channels, such a criterion being relevant for the purposes of the assessment of the similarity of the goods (*PiraÑAM* diseño original Juan Bolaños , paragraph 82 above, paragraph 37; see also, to that effect, *SISSI ROSSI* , paragraph 82 above, paragraph 65; and *PAM PLUVIAL* , paragraph 82 above, paragraph 95).

87. Accordingly, given the close link between the products in question as regards their end users, the fact that they are to some extent complementary and the fact that they may be distributed via the same distribution channels, the Board of Appeal was right to find that the applicant's goods and those of the intervener were similar (see, to that effect, [Case T-388/00 Institut für Lernsysteme v OHIM — Educational Services \(ELS\) \[2002\] ECR II-4301](#) , paragraph 56).

22 The Court of First Instance was not attributing decisive importance to the question of whether the goods in that case were complementary in determining the overall question of whether they were similar.

29) I also bear in mind that goods 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

Gerard Meric v OHIM (MERIC) Case T-133/05. In the instant case the opponent's CTM 5813481 EASYRESORT mark covers all paper goods in the class which would encompass the whole of the applicant's specification. The goods must therefore be considered to be identical. In the following comparison I shall refer to the applicant's goods simply as a towel rather than the full description set out in the specification.

30) The opponent's CTM 9802646 is not registered for any goods in class 16 and as such none of the goods and services for which it is registered can be regarded as identical (*Altenic Ltd's Trade Mark Application* [2002] RPC 34). The opponent provides the following submissions regarding the goods and services of CTM 9802646 in relation to a comparison with the goods sought to be registered.

- Class 3: The goods applied for are "for professional use in the hairdressing and beauty sector". The average consumer would view those goods provided under the application as originating from the opponent. It is more conceivable that a brand which offers the goods listed in the opponent's class 3 would also offer towels used in the beauty sector. Indeed a towel such as those defined in the applicant's specification are often used in conjunction with those goods listed in the opponent's class 3. The goods are also often used to apply or remove cosmetics and other such products on/from the skin. On this basis the goods are highly similar.
- Class 5: Once again the goods listed in the application could very easily fall within or be an accompaniment to such goods as "plasters and materials for dressings" as well as "sanitary preparations for medical purposes" all of which are listed in the earlier mark. For example towels, could be sanitary preparations for medical purposes (e.g. wipes for the skin). The goods in question when compared are highly similar.
- Class 35: It would be usual for a retailer specialising in goods such as cosmetics, beauty masks, hair products, plasters, fitness equipment and sports clothing would also sell towels for the hair and beauty sectors.
- Class 41: It is very common that gymnasiums and health clubs offer towels (both paper and fabric) for use by its patrons. In fact many gymnasium members carry towels with them during their fitness programme. Once the gym member has finished exercising they will often use the leisure facilities such as shower room, sauna, spa and all these require the use of a towel. Indeed, many gymnasiums have health clubs and treatment rooms where members can have health and beauty treatments. All require the use of a towel (both fabric and paper). To support this they rely upon the evidence of gymnasiums offering spa services set out in paragraph 8 above.
- Class 44: These services are intrinsically linked to the use of towels, and in particular towels for professional use in the hairdressing and beauty sector as specified in the application. The class 44 specification includes beauty care

services. It is common for such establishments to offer for sale towels and other related products carrying the “house-brand” of the salon or beauty parlour. Further many such establishments require the use of a towel and so the goods are highly similar.

31) I shall first consider the position regarding the opponent’s Class 3 goods. I accept that a towel is often used with grooming products and cosmetics. However, this does not make the goods highly similar. I do not consider that there is a close connection between the goods as, to the best of my knowledge one does not require to use a towel when using grooming products or cosmetics. Using the authorities set out above I do not consider them to be complementary. To my mind the goods are dissimilar.

32) On any reasonable reading of the authorities I have listed above the opponent’s goods in class 5 are dissimilar to the applicant’s goods. I accept that towels can be used could be used to wipe the skin but this is not similar to “sanitary preparations for medical purposes”.

33) The opponent contends that its services in Class 35 are similar to the applicant’s goods on the basis that any retail outlet selling sports wear or beauty/grooming products would also sell towels. I do not accept this contention and the opponent has not filed any evidence to support its case. To my mind the services of the opponent are different to the goods of the applicant.

34) Turning to the opponent’s services in Class 41. The opponent contends that users of gyms often carry a towel and that use of a health spa requires the use of a towel. There are lots of other things that use of a gym or health spa requires such as showers, lights and ventilation. This does not make the goods of the applicant similar to the services of the opponent.

35) Lastly, I turn to consider the services of the opponent in class 44 where a similar argument to that used in relation to its class 41 services is run. No evidence has been provided to support the contentions advanced. To my mind, towels are not similar or complementary to the opponent’s services in class 44.

Comparison of trade marks

36) The trade marks to be compared are as follows:

Applicant’s mark	Opponent’s mark
EASYDRY	EASYRESORT
	EASYGYM

37) 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, he rarely has the chance to make

direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his 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 and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

38) Although all the marks are shown as a single word, the average consumer will, at first sight, understand that all the marks are simply, two well known words conjoined. Both have the word “easy” which is used by the opponent to show that the products/services it provides are convenient and easy to use. Similarly, the applicant’s goods can be said to be easy to use as disposable towels frequently come in a roll and they may be easy to detach from the roll due to the perforations or simply being able to be placed near a spot where spillages may occur and so be in easy reach. It could also reflect on their ease of use in that they are disposable and so do not need to be washed. In neither case do I believe that the term “easy” is the dominant element, and to my mind is relatively non-distinctive. In paragraphs 19 to 22 I have analysed the marks in respect of the goods and services. The “RESORT”, “GYM” and “DRY” elements clearly allude to the services provided. Overall I believe that the average consumer will regard the marks as hanging together with neither element dominating the other.

Visual and aural similarity

39) Clearly all three marks have as their initial word the common element EASY. The mark in suit then has the word DRY whereas the opponent’s marks have the terms RESORT and GYM. Given my earlier comments regarding the descriptive nature of the first part of the parties’ marks, and the obvious differences between the respective marks overall they are visually and aurally different.

Conceptual similarity

40) There are clear differences between the conceptual meanings of the marks being compared.

Likelihood of confusion

41) I must now take all the above into account and consider the matter globally taking into account the interdependency principle- a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and services and vice versa. I must also take into account imperfect recollection. The opponent has not shown that it has a reputation in either its EASYRESORT or EASYGYM marks. Turning first to EASYRESORT, whilst the goods in Class 16 are identical the differences in the marks far outweigh any similarity. To my mind the differences between the marks, despite the fact that the goods are identical, will mean that there is no likelihood of

consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. With regard to the opponent's EASYGYM mark, none of the goods and services are similar and there are clear and obvious differences between the marks. That there is no likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore fails in respect of all the opponent's marks.**

42) I now turn to consider the opponent's contention that it has achieved a reputation in the word "easy" for its goods and services and that it relies upon the "family of marks" contention. In the case of *The Infamous Nut Company v Percy Dalton (Holdings) Ltd* [2003] RPC 7 , Professor Annand sitting as the Appointed Person said:

"It is impermissible for Section 5(2) (b) collectively to group together several earlier trade marks in the proprietorship of the opponents.

Section 5(2)(b) speaks of registration being refused on the basis of an earlier trade mark (as defined by Section 6). This where the opponent relies on proprietorship of more than one earlier trade mark, the registrability of the applicant's mark must be considered against each of the opponent's earlier trade marks separately (ENER-CAP trade mark [1999]RPC 362).

In some circumstances it may be possible for the opponent to argue that an element in the earlier trade mark has achieved enhanced distinctiveness in the eyes of the public because it is common to a "family of marks" in the proprietorship and use of the opponent (AMOR, Decision No 189/1999 of the Opposition Division, OHIM OJ 2/2000 p235). However, that has not been shown by the evidence to exist in the present opposition and cannot, as contended by Mr Walters on behalf of the opponent, be presumed from the state of the register in Classes 29 and 31."

43) I also note that in *Il Ponte Finanziaria SpA v OHIM* Case 234/06P, paragraphs 62-64, reported at [2008] ETMR 13 it was stated:

"62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a 'family or series' of marks.

63. The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that

effect, Canon, paragraph 29). Where there is a 'family or series' of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64. As the Advocate General stated in point 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family or series', the earlier trade marks which are part of that 'family' or series' must be present on the market.”

44) Whilst the latter judgment relates to a likelihood of confusion with the meaning of Article 8(1)(b) of the Regulation, a family of signs could also be relevant in considering an objection under section 5(4) of the Act as per the comments of Mr Thorley Q.C. [as he was then] sitting as the Appointed Person in *ENER-CAP* [1999] RPC 362. All the marks are shown as single words and the average consumer will, at first sight, understand that all the marks are simply, two well known words conjoined. All have the word “easy” which will be seen as a reflection on their convenience or ease of use. They all have second elements which are allusive. I do not believe that the term “easy” is the dominant element, indeed to my mind it is non-distinctive.

45) I accept that the opponent has a reputation for travel services (planes, cars and buses) which are used to get to holiday destinations or for the destination itself (hotels and cruises) and that the mode of transport and the destination all have the opponent’s brand written boldly upon them. To my mind, the opponent has not yet established that use of such a well known word with a clearly understood meaning which is so relevant to various goods and services i.e. they are easy/convenient to use, is necessarily use of its brand. This is perfectly understandable given that the term will be commonly used to describe such goods and services even when those goods and services are provided under an alternative well known brand. The opponent has not provided evidence that it has a reputation in EASYGYM, EASYRESORT OR EASYKIOSK. The only mark that has been shown to have a reputation is EASYCRUISE. One mark does not a family make.

46) I now turn to consider the ground of opposition under Section 5(3) which reads:

“5-(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in 3 the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) 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.

47) The scope of the Section has been considered in a number of cases notably *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] RPC 767, *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42, *C.A. Sheimer (M) Sdn Bhd's TM Application (Visa)* [2000] RPC 484 *Valucci Designs Ltd v IPC Magazines (Loaded)* O/455/00 and, more recently *Mastercard International Inc and Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch) and *Electrocoin Automatics Limited and Coinworld Limited and others* [2005] FSR 7. Guidance in relation to reputation under Section 5(3) has been set out in *General Motors Corporation v Yplon SA* in paragraphs 23 to 27. Paragraphs 26 & 27 indicate the standard that must be reached:-

“26. 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.

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 in promoting it.”

48) The onus is upon the opponent to prove that its earlier trade marks enjoy a reputation or public recognition and it needs to furnish the evidence to support this claim. The opponent relies upon the marks shown in paragraph 3(c) under this ground of opposition. I have accepted in the evidence summary that the marks relied upon have reputation for the provision of certain services. For ease of reference these are as follows:

- EASYJET: First used in 1995, the mark enjoys significant reputation for providing flights and earning revenue in the billions. In addition to flights the opponent provides other services under the EASYJET mark such as hotels, holidays, airport parking and travel insurance.
- EASYBUS: First used in 2001, the mark enjoys a reputation in relation to bus and coach services between London and Gatwick, Luton and Stansted airports.
- EASYCAR: First used in 2001, the mark enjoys significant reputation in relation to hire car services.
- EASYHOTEL: First used in 2004, the mark enjoys a reputation in relation to the provision of hotel services. They have seven hotels in the UK.
- EASYCRUISE and DEVICE: First used in 2005, the mark enjoys a significant reputation in relation to cruise services.

49) To my mind the opponent has provided the evidence that its marks do enjoy such a reputation and so it clears the first hurdle.

50) Once the matter of reputation is settled any applicant for invalidity must then show how the earlier trade marks would be affected by the registration of the later trade mark. The opponent states that its marks are unique in having the element “easy” conjoined with a term appropriate to the services provided. In their evidence (paragraph 10) the opponent accepts that others use the word “easy” as part of their marks but not in a conjoined fashion. In *Inlima S.L.*'s application [2000] RPC 61 Mr Simon Thorley QC, sitting as the Appointed Person, said:

“The word ‘similar’ is a relative term. One has to ask the question ‘similar for what purpose’. The question of similarity accordingly can only be answered within the context of a particular set of facts, once one has identified both the facts and the purpose for which similarity is required. In the case of section 5(3), the purpose of requiring similarity is so that the possibility of detriment or unfair advantage might arise. In any particular case, a conclusion as to whether it does arise must depend not only upon the degree of similarity but on all the other factors of the case, not least, the extent of the reputation. I therefore conclude that the same global appreciation as is required for confusion under section 5(2) is likewise to be applied to the changed circumstances of section 5(3).”

51) More recently this matter was considered by Mr Daniel Alexander sitting as the Appointed Person in B/L O/307/10 where he stated:

“37. The Decision in this case was handed down on 18th May 2009. On 18th June 2009, the ECJ handed down judgment in *L'Oréal v. Bellure*, Case C-487/07 in which it gave guidance on the proper approach to interpretation of 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 (OJ 1989 L 40, p. 1), (the “Trade Marks Directive”).

38. The ECJ said the following as regards Article 5(2) of the Trade Marks Directive and the requirement to show detriment or unfair advantage.”

"40. As regards detriment to the repute of the mark, also referred to as 'tarnishment' or 'degradation', such detriment is caused when the goods or services for which the identical or similar sign is used by the third party may be perceived by the public in such a way that the trade mark's power of attraction is reduced. The likelihood of such detriment may arise in particular from the fact that the goods or services offered by the third party possess a characteristic or a quality which is liable to have a negative impact on the image of the mark.

41 As regards the concept of 'taking unfair advantage of the distinctive character or the repute of the trade mark', also referred to as 'parasitism' or 'free-riding', that

concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coattails of the mark with a reputation.

42 Just one of those three types of injury suffices for Article 5(2) of Directive 89/104 to apply (see, to that effect, Intel Corporation, paragraph 28).

43 It follows that an advantage taken by a third party of the distinctive character or the repute of the mark may be unfair, even if the use of the identical or similar sign is not detrimental either to the distinctive character or to the repute of the mark or, more generally, to its proprietor.

44 In order to determine whether the use of a sign takes unfair advantage of the distinctive character or the repute of the mark, it is necessary to undertake a global assessment, taking into account all factors relevant to the circumstances of the case, which include the strength of the mark's reputation and the degree of distinctive character of the mark, the degree of similarity between the marks at issue and the nature and degree of proximity of the goods or services concerned. As regards the strength of the reputation and the degree of distinctive character of the mark, the Court has already held that, the stronger that mark's distinctive character and reputation are, the easier it will be to accept that detriment has been caused to it. It is also clear from the case-law that, the more immediately and strongly the mark is brought to mind by the sign, the greater the likelihood that the current or future use of the sign is taking, or will take, unfair advantage of the distinctive character or the repute of the mark or is, or will be, detrimental to them (see, to that effect, Intel Corporation, paragraphs 67 to 69).

45 In addition, it must be stated that any such global assessment may also take into account, where necessary, the fact that there is a likelihood of dilution or tarnishment of the mark.

46 In the present case, it is a matter of agreement that Malaika and Starion use packaging and bottles similar to the marks with a reputation registered by L'Oréal and Others in order to market perfumes which constitute 'downmarket' imitations of the luxury fragrances for which those marks are registered and used.

47 In that regard, the referring court has held that there is a link between certain packaging used by Malaika and Starion, on the one hand, and certain marks relating to packaging and bottles belonging to L'Oréal and Others, on the other. In addition, it is apparent from the order for reference that that link confers a commercial advantage on the defendants in the main proceedings. It is also apparent from the order for reference that the similarity between those marks and the products marketed by Malaika and Starion was created intentionally in order to

create an association in the mind of the public between fine fragrances and their imitations, with the aim of facilitating the marketing of those imitations.

48 In the general assessment which the referring court will have to undertake in order to determine whether, in those circumstances, it can be held that unfair advantage is being taken of the distinctive character or the repute of the mark, that court will, in particular, have to take account of the fact that the use of packaging and bottles similar to those of the fragrances that are being imitated is intended to take advantage, for promotional purposes, of the distinctive character and the repute of the marks under which those fragrances are marketed.

49 In that regard, where a third party attempts, through the use of a sign similar to a mark with a reputation, to ride on the coat-tails of that mark in order to benefit from its power of attraction, its reputation and its prestige, and to exploit, without paying any financial compensation and without being required to make efforts of his own in that regard, the marketing effort expended by the proprietor of that mark in order to create and maintain the image of that mark, the advantage resulting from such use must be considered to be an advantage that has been unfairly taken of the distinctive character or the repute of that mark.

50 In the light of the above, the answer to the fifth question is that Article 5(2) of Directive 89/104 must be interpreted as meaning that the taking of unfair advantage of the distinctive character or the repute of a mark, within the meaning of that provision, does not require that there be a likelihood of confusion or a likelihood of detriment to the distinctive character or the repute of the mark or, more generally, to its proprietor. The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of the mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image."

52) It is clear that the opponent's marks have a reputation for travel services and/or destinations offering board and lodging. One can use an "EASY" bus or car to get to the airport / port /hotel and board an "EASY" jet or ship or stay at an "EASY" hotel. If the average consumer saw or used a paper towel in or at any of these I do not accept that they would regard it as an "easy" towel or that if they saw an "easydry" towel that they would assume any link with the opponent. Indeed I doubt that it would even bring to mind any of the opponent's marks. My comments regarding the distinctive and dominant aspects of the marks of both parties apply here equally even though the marks relied upon by the opponent differ somewhat. The second part of the opponent's marks relates to the physical entity which will provide the service "JET", "CAR", "BUS", "HOTEL" with the only difference being the term "CRUISE" which describes the experience rather than the physical entity which would be a boat or ship. The first

aspect of the mark “easy” is used to convey that the service is convenient to use. These differences combined with the opponent’s reputation in a totally different business from paper/disposable towels means that it will not create the link that is required. Adopting the composite approach advocated, the conclusions that I have set out above naturally lead me to the view that there is no advantage for the applicants to derive. As far as detriment is concerned, the opponent suggested that this would subsist in a reduction in the distinctiveness/repute of their marks. I do not consider that registration of the mark in suit could have an impact in this respect, be it to the distinctiveness of the earlier marks or the reputation they enjoy. **The opposition under Section 5(3) therefore fails.**

53) I now turn to the last ground of opposition which is under Section 5(4)(a) which reads:

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

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

54) In deciding whether the mark in question offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.'

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

'To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

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

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

55) I also note the comments of Pumfrey J in *South Cone Incorporated v JackBessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* case, in which he said:

“27. 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 Section 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.

28. 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 at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

56) I must also keep in mind the comments of Mr Justice Floyd in *Minimax GMBH & Co KG and Chubb Fire Limited* [2008] EWHC 1960 (Pat) in which he says of the above:

“Those observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of

passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

57) First I must determine the date at which the opponent’s claim is to be assessed; this is known as the material date. In this regard, I note the judgment of the General Court (GC) 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. In that judgment the GC said:

“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.”

58) The opponent claims that the marks which it relies upon in the ground of opposition have all been used prior to the date that the application for the mark in suit was filed. The dates of first use range from 1995-2005. The applicant has not provided evidence of use of its mark and as such cannot establish that it is the senior user, or that there had been common law acquiescence, or that the status quo should not be disturbed; any of which could mean that the applicant’s use would not be liable to be prevented by the law of passing-off – the comments in *Croom’s Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42 refer.

59) At paragraph 6 of my decision I have accepted that the opponent has shown that it has used the marks EASYJET/ EASYCAR/ EASYHOTEL/ EASBUS/ EASYCRUISE since 1995/ 2002/ 2005/ 2004/ 2005 respectively. I also accept that the evidence shows that it has goodwill and reputation in the marks. Therefore, the opponent clears the first hurdle.

60) It is well established that it is not necessary for the parties to a passing-off action to be in the same area of trade or even a related area of trade. The point can be supported by reference to the following passage from Millet L.J.’s judgment in *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff’s business. The expression “common field of activity” was coined by Wynn-Parry J. in *McCulloch v May* [1948] 65 RPC 58 when he dismissed the plaintiff’s claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd v John Griffiths Cycle Corporation Ltd* (1898) 15 RPC 105 (cameras and bicycles); *Walter v Ashton* (1902) 2 Ch. 282 (The Times Newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing-off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego* case Falconer J. acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing-off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration.”

61) Also:

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services.”

62) And:

“Passing off is a wrongful invasion of a right of property vested in the plaintiff, but the property which is protected in an action for passing off is not the plaintiff’s proprietary right in the name or get-up which the defendant has misappropriated but the goodwill and reputation of the business which is likely to be harmed by the defendant’s misrepresentations.”

63) I also take into account the comments of Morritt L J in the Court of Appeal in *Neutrogena Corporation and Another. v Golden Limited and Another* [1996] RPC 473, when he said, in effect, that the correct test on the issue of deception or confusion was whether, on the balance of probabilities, a substantial number of members of the public would be misled into purchasing the applicant’s products in the belief that they were the opponent’s. In the instant case the average consumer would be the general public which includes businesses.

64) The opponent has goodwill and reputation in the marks relied upon for, broadly, travel services and or destinations offering board and lodging. In essence the question I have to address is whether the relevant public seeing the applicant's mark used on disposable paper towels would be likely to believe the goods were being offered by the opponent. The opponent's evidence does not establish that companies engaged in the travel or hotel/cruise trade are likely to offer branded disposable towels, or that the consumers using its services would assume that the opponent would be engaged in the provision of such a basic product. I accept that consumers will find disposable towels aboard the opponent's planes, hotels and ships. They may even come across them in the opponent's buses. However, they will equally find a large range of other products such as toilet paper, soap etc. I do not believe that the opponent's reputation in the term "easy" is such that any mark which has this element, no matter how far removed the goods and services carrying this mark are from the core travel services of the opponent, would be seen as likely to be associated/linked with the opponent. The goods of the applicant are very different from the services offered by the opponent and the differences in the marks are such that the necessary misrepresentation required by the tort of passing off will not occur. The opposition under Section 5(4)(a) of the Act must fail.

CONCLUSION

65) The opponent has failed under all the grounds of opposition.

COSTS

66) As the applicant has been successful it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£200
Preparing evidence and considering the evidence of the other side	£800
Preparing for and attending a hearing	£1200
TOTAL	£2200

67) I order easyGroup IP Licensing Limited to pay Anne Butterly and Gerard Butterly the sum of £2200. This sum 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.

Dated this 28th day of October 2013

**George W Salthouse
For the Registrar,
the Comptroller-General**