

**O-099-16**

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 081 707 BY easyUni SND  
BHD TO REGISTER AS A SERIES OF TWO THE MARKS:



IN RESPECT OF SERVICES IN CLASS 35

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO 403 895 BY  
EASYGROUP LIMITED

## Background and pleadings

1. easyUni SND BHD (the applicant) applied to register as a series of two the



following trade marks and under No 3 081 707 in the UK on 16 November 2014. It was accepted and published in the Trade Marks Journal on 5 December 2014 in respect of the following services:

Class 35:

*Advertising; advertising agencies; arranging subscriptions to telecommunication services for others; business information; business inquiries; business management assistance; business research; commercial administration of the licensing of the goods and services of others; commercial information agencies; commercial information and advice for consumers [consumer advice shop]; compilation of information into computer databases; compilation of statistics; professional business consultancy; cost price analysis; data search in computer files for others; dissemination of advertising matter; layout services for advertising purposes; advisory services for business management; marketing; marketing research; marketing studies; news clipping services; on-line advertising on a computer network; opinion polling; organisation of exhibitions for commercial or advertising purposes; organisation of trade fairs for commercial or advertising purposes; outsourcing services [business assistance]; presentation of goods on communication media for retail purposes; price comparison services; psychological testing for the selection of personnel; public relations; publication of publicity texts; publicity; publicity agencies; publicity columns preparation; rental of advertising space; rental of advertising time on communication media; sales promotion for others; sponsorship search; systemisation of information into computer databases; telemarketing services; telephone answering for unavailable subscribers; transcription; updating of advertising material; writing of publicity texts.*

2. easyGroup Limited (the opponent) oppose the trade mark on the basis of Section 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act). This is on the basis of, amongst others<sup>1</sup>, its earlier Community Trade Mark: No 1 162 4376:

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<sup>1</sup> The remaining earlier trade marks and rights relied upon are listed in Annex 1 to this decision.

The logo for 'easyOffice' is displayed in white lowercase letters on an orange square background.

in respect of the following services in Class 35:

*Advertising; business management; business administration; office functions; professional business consultancy; business management assistance services; business management consultancy; business information and business inquiries services; telephone answering services; document reproduction services; recruitment services; file management services; personnel management services; payroll services; outsourcing services; photocopying services; word processing and secretarial services; typing services; office administration services; office management services; provision of serviced offices; rental of office machines and equipment; advisory, consultancy and information services relating to all the aforesaid services.*

3. As regards Section 5(2)(b), the opponent argues that the respective services are identical and that the marks are similar. It also makes a claim to a family of marks under the “easy” brand. This will be commented on further below.
4. In respect of its claim under Section 5(3), the Opponent claims that it enjoys a reputation in several of its marks: EASYJET, EASYGROUP, EASYCAR, EASYHOTEL and  (full details of which is shown highlighted in bold at Annex 1). It is noted that this reputation is claimed across the following classes: 38, 39 and 43. Use by the applicant without due cause would take advantage of that reputation by free riding on the marketing efforts and success of the opponent. Further use of the mark by the applicant would be detrimental to the repute of the opponent’s marks if the services rendered were not of a similar standard. Finally, there would be detriment to the distinctive character of the opponent’s marks as it is known for goods and services that are indicated by the signifier “easy” plus a descriptive term. That is the same formulation used by the applicant in the opposed application. Such use would harm the ability of the opponent’s marks to distinguish the opponent’s goods and services from those of third parties.
5. Under its ground of opposition based upon Section 5(4)(a), the opponent has built up considerable goodwill in several of its marks as a result of its use. These earlier rights are: EASYGROUP, EASYJET, EASYMOBILE, EASYHOTEL and EASYCAR (full details of which are displayed in Annex 1 to this decision). Use by the applicant would amount to a misrepresentation that the applicant’s services were provided by or associated with the opponent, which could lead to damage to reputation or loss of sales.

6. The applicant filed a counterstatement denying the claims made.
7. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate.
8. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.
9. The decision will initially consider the opposition in respect of the aforementioned Community Trade Mark and will only consider the remaining trade marks/rights should it be necessary to do so.

### **Evidence of the Opponent**

10. The opponent's evidence is in the form of a witness statement from Mr Ryan Pixton, a Partner with Kilburn & Strode LLP, the representatives of the Opponent in these proceedings. Exhibit RE1 contains copies of the Registration Certificates for the Opponent's Community trade mark registrations upon which the opposition is based; Exhibit RE2 and REP3 are Dictionary extracts regarding the meaning of "uni" and ".com" respectively (the former as being short for "university" and the latter meaning a web site address). Exhibit REP4 is a copy of a witness statement, from Mr Paul Griffiths used in previous proceedings involving the Opponent. This will be described in further detail below. Exhibit REP5 contains extracts of OHIM decisions involving the Opponent. The main crux of these extracts is that the OHIM found that the Opponent did enjoy enhanced protection as a result of having a family of marks as a result of use made in the United Kingdom. It is noted that these decisions are dated between 2004 and 2008. A significant time period (six years) has therefore passed and as such they are of limited use. They do not shed light on the position of the Opponent as at the relevant date here, namely 16 November 2014. Finally, Exhibit REP6 are internet extracts from various national newspapers and organizations, together with extracts from the opponent's website. This exhibit will be described in further detail below.

### **Exhibit REP4: Witness statement of Paul Griffiths**

11. Mr Griffiths is the financial controller for the Opponent, a position held since September 2010. Further, the witness statement was prepared in respect of a different set of proceedings and so the exhibits referred to are absent. The following information is contained therein:
  - easyGroup was incorporated on 25 August 2000 by Stelios Haji-Ioannou (Stelios) with the aim of establishing a group of companies which traded under the "EASY" brand. Following the success of EASYJET, Stelios decided to undertake a brand extension and diversify into other fields. The easyGroup

mission is to manage and extend Europe's leading value brand to more products and services with the core values being: a) great value; b) taking on the big boys; c) for the many not the few; d) relentless innovation; e) keep it simple; f) entrepreneurial; g) making a difference in people's lives; and h) honest, open, caring and fun.

- Since 2000 easyGroup has established a number of businesses which operate or have operated under the easy brand. The entire list will not be repeated here as it is noted that although numerous businesses are mentioned here, only a fraction have been pleaded in these proceedings. This point will be referred to later below. Those pleaded that appear in this witness statement are: a) EASYCAR; b) EASYHOTEL; c) EASYMOBILE (estd 2010); d) EASYOFFICE.
- A number of decisions of the OHIM are described. There are no details as to the dates of these decisions, so there is no applicable context.
- A number of press articles regarding the "easy" brands are described though they are not attached as exhibits to the witness statement. The most recent article described is March 2010. As such, the position as at the relevant date here is unclear.
- The witness statement goes on to describe the reputation built up by several easyGroup businesses. The relevant ones to those proceedings, i.e. the ones pleaded in respect of having a reputation are: EASYJET and EASYHOTEL. Much of the information in respect of these earlier trade marks is out of date; 2010 being the most recent. It is accepted that it has some probative value but this is limited as it does not demonstrate the position as at 16<sup>th</sup> November 2014, the relevant date in these proceedings.

## **Exhibit REP6**

12. The following is included in this exhibit:

- A print out of the home page of the easyGroup website, dated 22 November 2013. It is noted that the following easy brands are listed: easyjet, easycar, easyhotel, easybus, easyvan, easyoffice, easypizza, easygym. There are also links to latest news such as the opening of a new easyhotel in Rotterdam, the opening of an easygym in London and the building of a new easyhotel in Prague.
- A printout of the home page of the easyGroup website, dated 21 December 2013 listing the same brands as mentioned above. There are also articles regarding the acquisition of an easyhotel for Glasgow and a link to a Sunday Times article regarding easycar.
- An article from cityam.com dated March 2014, regarding plans for easyGroup to diversify into the property market.
- An article from the Financial Times dated June 2014, regarding easyhotel's listing on the junior stock exchange. There is also an article in the Telegraph, dated May 2014
- An article from the Management Today website, dated 18 August 2014 regarding plans to shake up the car rental market with EasyCar Club.

- An extract from Wikipedia, dated July 2015 regarding Stelios.
- A report dated 30 September 2014 regarding the performance of easyjet. The key message is that the brand continues to perform strongly and has produced record profits for the fourth year in a row. Its low cost ethos is also mentioned.
- An article from the guardian, dated 4 August 2013 regarding easyFoodstore, a planned supermarket venture.
- An article from the Daily Mail, dated 29 July 2013 regarding the eighth easyGym opened in London. This review is positive in nature.
- An article from the Telegraph, dated February 2006 in respect of easyPizza.
- An article from the Telegraph, dated August 2009 in respect of easyBus.
- An article from the Guardian, dated 23<sup>rd</sup> October 2014 regarding the easyGroup. It describes how it has successfully launched sub brands from property to pizza to gyms and is currently expanding into the grocery sector. The common denominator of their offering in each sector is value and “no frills”.
- An interview with Stelios in the Guardian, in September 2005 regarding brand extension. This explains that easyMobile and easyHotel both started trading in 2005.
- Reuters news article, dated January 2005, describes the huge success of EasyJet and the “easy” brand extension to a range of “no frills” businesses including car rental, consumer credit, leisure, music, pizza and mens’ grooming products. It is noted that, with the exception of easycar (for car rental), the trade marks associated with these brand extensions are not pleaded in the Notice of Opposition. Please see further below.

### **Conclusions on the Opponent’s evidence**

13. It is noted that there are a number of earlier trade marks relied upon in the Notice of Opposition which do not feature in the evidence filed, for example easyCoffee and easyEspresso. They cannot therefore be considered in respect of, for example, the family of marks argument that the Opponent is running. The reverse situation is also true: there are trade marks and signs used in the evidence, for example easyGym and easyFoodstore which are not present in the Notice of Opposition. Likewise these cannot be relied upon in respect of any family of marks argument.
14. The following conclusions regarding the earlier trade marks and rights pleaded are considered to be able to be drawn from the evidence filed:
  - a) Easyjet enjoys a significant goodwill and reputation, at least in respect of airline services. Indeed this earlier trade mark in respect to these services is the high point of the Opponent’s case as regards a claim to a reputation. The position is less obvious in respect of easygroup, but I am prepared to accept that a reputation is also enjoyed in respect of this mark, at least in respect of airline services.
  - b) There is evidence that easyhotel is an example of a successful brand extension. It has clearly been used in respect of accommodation services and has also generated goodwill in its own right. It is unclear as to whether it is

known to a significant section of the relevant public and so the use shown falls short of establishing a reputation.

- c) There is evidence that easyCar has been used prior to the relevant date in these proceedings, though the scale of the use is unclear. As such, though it is possible that it has generated goodwill, it has not established a reputation.
- d) There is little to no information regarding the position of easymobile in the market place.
- e) The only use in the evidence as regards easyOffice is in respect of it being listed on the easygroup's website in 2013 as described in the evidence.

## **Evidence of the Applicant**

15. This is a witness statement from Mr Matthew Gardener, a trade mark attorney representing the applicant. Exhibit MG1 is a printout from the Collins English Dictionary confirming that "easy" means "not difficult; simple". Exhibit MG2 is a printout from the Collins English Dictionary confirming that "uni" is an informal shortening for university. Exhibit MG3 contains copies of a refusal of application for a Community trade mark in relation to EASYCOFFEE; EASYESPRESSO and EASYESPRESSO.

## **DECISION**

### **Section 5(2)(b)**

16. Section 5(2)(b) of the Act is as follows:

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

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

## **Comparison of services**

17. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

18. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;

- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) The extent to which the respective goods or services 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 or services in the same or different sectors.

The earlier services are:

Class 35:

*Advertising; business management; business administration; office functions; professional business consultancy; business management assistance services; business management consultancy; business information and business inquiries services; telephone answering services; document reproduction services; recruitment services; file management services; personnel management services; payroll services; outsourcing services; photocopying services; word processing and secretarial services; typing services; office administration services; office management services; provision of serviced offices; rental of office machines and equipment; advisory, consultancy and information services relating to all the aforesaid services.*

The later services are:

Class 35:

*Advertising; advertising agencies; arranging subscriptions to telecommunication services for others; business information; business inquiries; business management assistance; business research; commercial administration of the licensing of the goods and services of others; commercial information agencies; commercial information and advice for consumers [consumer advice shop]; compilation of information into computer databases; compilation of statistics; professional business consultancy; cost price analysis; data search in computer files for others; dissemination of advertising matter; layout services for advertising purposes; advisory services for business management; marketing; marketing research; marketing studies; news clipping services; on-line advertising on a computer network; opinion polling; organisation of exhibitions for commercial or advertising purposes; organisation of trade fairs for commercial or advertising*

*purposes; outsourcing services [business assistance]; presentation of goods on communication media for retail purposes; price comparison services; psychological testing for the selection of personnel; public relations; publication of publicity texts; publicity; publicity agencies; publicity columns preparation; rental of advertising space; rental of advertising time on communication media; sales promotion for others; sponsorship search; systemisation of information into computer databases; telemarketing services; telephone answering for unavailable subscribers; transcription; updating of advertising material; writing of publicity texts.*

19. The later services are contained within the wider services of the earlier trade mark (indeed the earlier services include the class headings). They are self evidently identical.

## **Comparison of marks**

20. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

22. The respective trade marks are shown below:

|                                                                                   |                                                                                    |
|-----------------------------------------------------------------------------------|------------------------------------------------------------------------------------|
|  |  |
| Earlier trade mark                                                                | Contested trade mark                                                               |

23. Before commencing a comparison of the signs, I must first identify the respective distinctive and dominant components contained in each. In respect of the earlier mark, the verbal element “easyOffice” catches the eye first before the orange box and is distinctive. Within this, the element “easy” is presented entirely in lower case and is followed by a capital letter O at the start of the word “Office”. This has the effect of allowing “easy” to be picked out. Likewise in the contested trade mark, it is “easyuni” which is dominant and distinctive, though within this “easy” is clearly eye catching as it appears in a different colour/shading. The “.com” element is much smaller (though it can clearly be seen).
24. Visually, each of the signs include the element “easy” which appears at the start of each. As already described, “easy” stands out in each as a result of lower case/colour/shading. The marks are similar to this extent. They differ in respect of the remaining elements. There is considered to be a low to medium degree of visual similarity.
25. Aurally, the marks coincide in respect of “easy” and differ in respect of the remaining elements. In particular, the rhythm of the later mark differs due to the inclusion of “.com” which is likely to be articulated. They are similar only to a low degree.
26. Conceptually, the marks coincide in respect of the element easy which means to do something with ease. It is accepted that “uni” is likely to be understood as meaning “university”. Both Office and Uni are physical places for work and/or study, however this does not make them conceptually similar per se. Having said that, the presence of easy in each imply ease of use or access. There is certainly nothing in either of the marks to clearly set them apart conceptually and so it is considered that a similar overall idea is conveyed. The “.com” aspect of the later mark does not detract from this. There is considered to be a medium degree of conceptual similarity.
27. Bearing in mind all of the aforesaid, these marks are considered to similar. This overall degree of similarity is considered to be medium.

## Average consumer and the purchasing act

28. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

29. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

30. The average consumer for these services is likely to be the business sector. The nature of the services are such it will be important for any particular undertaking to select the most suitable provider. There is also likely to be a not insignificant cost implication to procuring these services. The selection process therefore is likely to be a reasonably considered one.

## Distinctive character of the earlier trade mark

31. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been

registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

32. It is noted that no claim has been made that easyOffice (in its own right), has an enhanced distinctive character<sup>2</sup>.

33. It is accepted that the element “easy” alone has a relatively weaker distinctive character. However the earlier trade mark is easyOffice which, in respect of the services to which it is applied, is vague and ambiguous. An office is a physical place where one goes to carry out jobs and tasks or indeed to study and so the earlier trade mark is neither descriptive nor non distinctive. It is considered to have an average degree of distinctive character, prima facie.

## **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

34. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles**

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely

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<sup>2</sup> A family of marks argument has been advanced by the Opponent, but there is insufficient use of easyOffice in the evidence filed.

upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

35. In these proceedings, it has been found that the marks are similar to a medium degree. Further, the services are identical and so the interdependency principle is in full effect. It is true that the purchasing process will be considered which negates against imperfect recollection. As such, it is considered unlikely that consumers will mistake one mark for the other. However, I also bear in mind the following guidance:

36. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

37. In respect of the marks in question here, it is considered that the scenario described in example c) above applies to these proceedings. The earlier trade mark is easyOffice, which conjures up an image of a physical place, an office. The contested trade mark easyuni does the same, albeit a different physical place, a university. The overall construction of each of the marks is similar. Likewise, they communicate a concept similar enough in my view to lead the relevant public to conclude that this is a brand extension and so they emanate from the same undertaking. There is a likelihood of indirect confusion here.

## **Final Remarks**

38. As this earlier trade mark leads to the opposition being successful in its entirety, there is strictly no need to consider the remaining trade marks and

grounds upon which the opposition is based. However, for the sake of completeness I make the following observations:

### **Families of trade marks**

39. This is claimed by the opponent and in this regard, I bear in mind the following guidance:

In *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, the Court of Justice of the European Union stated that:

“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 at paragraph 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.

65 Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

66 It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled

to disregard the arguments by which the appellant claimed the protection that could be due to 'marks in a series'."

40. I accept that the evidence filed demonstrates use of easyjet, easygroup, easycar and easyhotel. However, even if I were to accept these marks as a "family", the area of activity in which they operate is restricted to airline services, accommodation and car rental. In effect, those typically operated within the travel industry. This is far removed from the contested services and in the absence of evidence of use of other pleaded marks (and so with no real diversification to other services in other markets demonstrated) they are in no better position here.

41. Further, in respect of its ground of opposition under Section 5(3), easyjet clearly has a significant reputation in respect of airline services. Easygroup also has (albeit to a relatively lesser extent). There is a huge gap between airline services and those services applied for with the effect being it is considered highly unlikely that a "bringing to mind"<sup>3</sup> would occur. The opponent is in no better position here.

42. Finally, in respect of its ground of opposition under Section 5(4)(a), I also accept that goodwill<sup>4</sup> has been shown in respect of the travel industry, particularly in respect of easyjet, easygroup and easyhotel. It is difficult to see how this advances the opponent's case further.

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<sup>3</sup> For the relevant provisions and case law regarding Section 5(3), please see attached Annex 2.

<sup>4</sup> For the relevant provisions and case law regarding Section 5(4)(a) please see attached Annex 3.

## **COSTS**

43. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £1000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Opposition Fee - £200

Preparing evidence and considering other side's evidence - £500

Filing written submissions - £300

TOTAL - £1000

44. I therefore order easyUni SND BHD to pay easyGroup Limited the sum of £1000. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 25<sup>TH</sup> day of February 2016**

**Louise White**

**For the Registrar,  
The Comptroller-General**

## Annex 1

### Full list of earlier trade marks/rights relied upon:

#### 1. Community trade mark No 1 058 3111<sup>5</sup>:

EASYGROUP

Services relied upon:

Class 35:

Advertising, marketing and publicity services; dissemination of advertising, marketing and publicity materials; 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, assistance and advice; purchasing and demonstration of goods for others; retail services connected with the sale of food and drink, preparations and substances for use in the care and appearance of the hair, scalp, lips, face, skin, teeth, nails and eyes, cosmetics, non-medicated toilet preparations, perfumes, fragrances, colognes and scents, soaps and cleaning preparations, shampoos, conditioners, moisturisers, tooth cleaning preparations, depilatory preparations, sun-screening and tanning preparations, anti-perspirants, deodorisers and deodorants, sunglasses, personal stereos, MP3 players, CD players, apparatus for playing music and video recordings, jewelry, stones, watches, clocks, books, magazines, newspapers, stationery, calendars, diaries, purses, umbrellas, parasols briefcases, purses, wallets, pouches and handbags; luggage, suitcases, travelling sets, sports bags, bike bags, backpacks, games and playthings, playing cards, gymnastic and sporting articles, toys; gymnastic and sporting articles, model airplanes, scooters, teddy bears, balls; commercial administration of the licensing of the goods and services of others; advice relating to business management; advice relating to business organisation; business advice; business management advice.

Class 38:

Communication, **telecommunication**, broadcasting and message transmission services; **provision of access to the Internet**; Internet service providers; advisory and consultancy 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; leasing access time to a computer database, Internet café services, namely renting and leasing access time to a computer database.

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<sup>5</sup> Trade marks and goods/services shown in bold are also relied upon under Section 5(3) of the Act.

**Class 39:**

**Transport; transportation of goods, passengers and travellers by air, land, sea and rail; airline services; travel agency services; bus transport services; car transport services.**

**Class 43:**

**Provision of temporary accommodation; provision of food and drink; catering; hotel, restaurant, café and bar services; hotel management and reservation services; nursery, kindergarten and creche services; hotel services for the provision of facilities for exhibitions; providing facilities for exhibitions and conferences.**

**2. Community trade mark No 1 058 4001:**

EASYJET

Services relied upon:

**Class 35:**

Advertising; business management; business administration; office functions; operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; provision of business information; retail services connected with the sale of food and drink, preparations and substances for use in the care and appearance of the hair, scalp, lips, face, skin, teeth, nails and eyes, cosmetics, non-medicated toilet preparations, perfumes, fragrances, colognes and scents, soaps and cleaning preparations, shampoos, conditioners, moisturisers, tooth cleaning preparations, depilatory preparations, sun-screening and tanning preparations, anti-perspirants, deodorisers and deodorants, sunglasses, personal stereos, MP3 players, CD players, apparatus for playing music and video recordings, jewelry, stones, watches, clocks, books, magazines, newspapers, stationery, calendars, diaries, purses, umbrellas, parasols briefcases, purses, wallets, pouches and handbags, luggage, suitcases, travelling sets, sports bags, bike bags, backpacks, games, playing cards, gymnastic and sporting articles, gymnastic and sporting articles, scooters; marketing and publicity services; dissemination of advertising, marketing and publicity materials.

Class 38:

**Telecommunications**; provision of access to the Internet; **providing user access to the Internet**; 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; broadcasting of radio and television programmes; electronic transmission of announcements; services in connection with teleconferences.

**Class 39:**

**Transport; transportation of goods, passengers and travellers by air, land, sea and rail; airline services; travel agency services.**

Class 43:

Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; hotel services; hotel reservation services; hotel services for the provision of facilities for exhibitions and conferences.

3. Community trade mark No 1 274 7201:



Services relied upon:

Class 35:

Advertising; business management; business administration; office functions;

4. Community trade mark No 1 274 7101:

EASYESPRESSO

Services relied upon:

Class 35:

Advertising; business management; business administration; office functions;

5. Community trade mark No 1 271 5793:

EASYCOFFEE

Services relied upon:

Class 35:

Advertising; business management; business administration; office functions;

6. Community trade mark No 1 153 5961:



Services relied upon:

Class 09:

Telecommunications apparatus and instruments; telephones and mobile telephones and accessories including handsets, headsets, headphones, battery chargers, stands, cases for mobile phones and hands-free devices; audio speakers; software; application software; computer game software; mobile phone software; magnetic or encoded cards; smart cards; optical, measuring, signalling, controlling or teaching apparatus and instruments; apparatus for recording, transmission, processing and reproduction of sound, mechanisms for coin operated apparatus; data processing equipment; parts and fittings for all the aforesaid.

Class 38:

**Telecommunications**; broadcasting and message transmission services; mobile and fixed line communications services; telephone connection services; transmission of data, images, documents, messages and software via communications networks; **providing access to data, images, documents, messages and software via communications networks; providing user access to the internet**; rental of telecommunications apparatus and instruments; information,

advisory and consultancy services in relation to all the aforesaid services.

7. Community trade mark No 1 082 6604:



Goods and services relied upon:

Class 16:

Paper, cardboard and goods made from these materials; printed matter; photographs; stationery; packaging materials; printed publications; books, manuals, pamphlets, newsletters, albums, newspapers, magazines and periodicals; tickets, vouchers, coupons and travel documents; identity cards; labels and tags; posters, postcards, calendars, diaries; teaching and instructional materials.

Class 39:

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

Class 43:

Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; hotel services; hotel reservation services;

hotel services for the provision of facilities for exhibitions and conferences.

## 8. Community trade mark No 1 073 5496:

EASYHOTEL

Goods and services relied upon:

Class 16:

Paper, cardboard and goods made from these materials; printed matter; photographs; stationery; packaging materials; printed publications; books, manuals, pamphlets, newsletters, albums, newspapers, magazines and periodicals; tickets, vouchers, coupons and travel documents; identity cards; labels and tags; posters, postcards, calendars, diaries; teaching and instructional materials.

Class 39:

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

Class 43:

**Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation**; booking and reservation services for restaurants and holiday accommodation; hotel services; hotel reservation services; hotel services for the provision of facilities for exhibitions and conferences.

9. Community trade mark No 9 903 949:

EASYHOLIDAY

Services relied upon:

Class 39:

Transport; packaging and storage of goods; travel arrangement; distribution of electricity; travel information; provision of car parking facilities; transportation of goods, passengers and travelers by air, land, sea and rail; airline and shipping services; airport check-in services; arranging of transportation of goods, passengers and travelers by air, land, sea and rail; 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; escorting of travelers; travel agency and tourist office services; travel booking 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.

Class 43:

Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; 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; Internet café services; nursery and crèche services.

**10. Community trade mark No 1 073 5553:**

EASYCAR

Services for which reputation is claimed:

Class 39:

**Transport; travel arrangements; transportation of goods, passengers and travellers by land.**

The following earlier signs are also relied upon for the purposes of Section 5(4)(a):

1. EASYGROUP. Claimed use of the following services since 2005 throughout the UK:

Class 38:

Telecommunications; providing user access to the internet; providing access to data, images, documents, messages and software via communications networks.

Class 39:

Transport; transportation of goods, passengers and travellers by air, land, sea and rail; airline services; travel agency services; bus transport services, car transport services

Class 43:

Provision of temporary accommodation; provision of food and drink.

2. EASYJET. Claimed use of the following services since 2005 throughout the UK:

Class 38:

Telecommunications; providing user access to the internet; providing access to data, images, documents, messages and software via communications networks.

Class 39:

Transport; transportation of goods, passengers and travellers by air, land, sea and rail; airline services; travel agency services; bus transport services, car transport services

- 3.



Claimed use in respect of the following goods and services since 2005 throughout the UK:

Class 09:

Telecommunications apparatus and instruments; telephones and mobile telephones and accessories including handsets, headsets, headphones, battery chargers, stands, cases for mobile phones and hands-free devices; audio speakers; software; application software; computer game software; mobile phone software; magnetic or encoded cards; smart cards; optical, measuring, signalling, controlling or teaching apparatus and instruments; apparatus for recording, transmission, processing and reproduction of sound, mechanisms for coin operated apparatus; data processing equipment; parts and fittings for all the aforesaid.

Class 38:

Telecommunications; broadcasting and message transmission services; mobile and fixed line communications services; telephone connection services; transmission of data, images, documents, messages and software via communications networks; providing access to data, images, documents, messages and software via communications networks; providing user access to the internet; rental of telecommunications apparatus and instruments; information, advisory and consultancy services in relation to all the aforesaid services.

#### 4. EASYHOTEL

Claimed use of the following services since 2005 throughout the UK:

Class 43:

Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; hotel services; hotel reservation services; hotel services for the provision of facilities for exhibitions and conferences.

#### 5. EASYCAR

Claimed use of the following services since 2005 in the UK:

Class 39:

Transport, travel arrangements; transportation of goods, passengers and travellers by land.

## Annex 2

### Legislation – Section 5(3)

Section 5(3) states:

- “(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 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.”

The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

- a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.
- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.
- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel, paragraph 42*
- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark 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. This 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 coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

## Annex 3

### Legislation – Section 5(4)(a)

Section 5(4)(a) states:

“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

(b) [.....]

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.”

#### General principles of Section 5(4)(a)

Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in 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. It 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.”

The earlier use by the claimant must relate to the use of the sign for the purposes of distinguishing goods or services. For example, merely decorative use of a sign on a T-shirt cannot found a passing off claim: *Wild Child Trade Mark* [1998] RPC 455 (AP)