

O/639/18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003235015 BY
GRAHAM & BROWN LIMITED
TO REGISTER THE FOLLOWING SERIES OF MARKS:**

EASY WALLPAPER

AND

EASYWALLPAPER

IN CLASSES 27 AND 35

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 410338 BY
EASYGROUP LIMITED**

BACKGROUND AND PLEADINGS

1. On 2 June 2017, Graham & Brown Limited (“the applicant”) applied to register the series of marks EASY WALLPAPER and EASYWALLPAPER in the UK. The application was published for opposition purposes on 23 June 2017 and is for the following goods and services:

- Class 27 Wall coverings; wall hangings, not of textile; wallpapers; paste-the-wall wallpapers; wall lining papers; expanded blown-vinyl wall coverings; wall coverings of plastics; paper backed wall coverings; fabric backed wall coverings; pvc backed wall coverings; textile wall coverings; wall paper borders; ceiling papers; ceiling lining papers.
- Class 35 Retail store services, retail mail order and on-line retail services connected with the sale of wallpaper pastes, adhesives for wall papers, adhesives for paperhanging, adhesives for ceiling and wall tiles, adhesives for billposting, adhesives for wall coverings, transparent films for graphic use, photosensitive materials, sensitised films for graphic use, sensitised films for use in screen printing, fireproofing preparations, film for printing; retail store services, retail mail order and on-line retail services connected with the sale of paints, varnishes, lacquers, preservatives against rust and against deterioration of wood, colorants, mordants, raw natural resins; retail store services, retail mail order and on-line retail services connected with the sale of metals in foil and powder form for painters, decorators, printers and artists, paper, cardboard; retail store services, retail mail order and on-line retail services connected with the sale of paper and film for printing, printed matter, digital printing paper, laminated paper, display banners of paper, graphic reproductions, art prints, artwork, works of art, photographs, photographic prints, wall paintings and printed photographic murals, adhesive wall decorations of plastic; retail store services, retail mail order and on-line retail services connected with the sale of wallcoverings, wall

hangings, not of textile, wallpapers, paste-the-wall wallpapers, wall lining papers, expanded blown-vinyl wallcoverings' wall coverings of plastics, paper backed wall covering, fabric backed wallcoverings, pvc backed wall coverings, textile wall coverings, wall paper borders, ceiling papers, ceiling lining papers.

2. The application was opposed by easyGroup Limited (“the opponent”). The opposition is based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).

3. The opponent relies on six earlier marks for its opposition under section 5(2)(b):

EU trade mark registration 10584001: EASYJET

Filing date of 24 January 2012; registration date of 9 January 2015
 (“the First Earlier Mark”)

EU trade mark registration 10583111: EASYGROUP

Filing date of 23 January 2012; registration date of 3 July 2014
 (“the Second Earlier Mark”)

EU trade mark registration 10735496: EASYHOTEL

Filing date of 16 March 2012; registration date of 26 July 2012
 (“the Third Earlier Mark”)

EU trade mark registration 11624376:



Filing date of 4 March 2013; registration date of 31 July 2013

Colours claimed: orange and white

(“the Fourth Earlier Mark”)

EU trade mark registration 16079675: easyLand

Filing date of 24 November 2016; registration date of 14 July 2017

("the Fifth Earlier Mark")

EU trade mark registration 14920433:



Colours claimed: orange and white

Filing date of 17 December 2015; registration date of 27 January 2017

("the Sixth Earlier Mark")

10. The services on which the opponent relies in respect of each earlier mark for the purposes of its opposition under section 5(2)(b) are listed in Annex 1 to this decision.

11. The opponent relies on the First Earlier Mark, the Second Earlier Mark and the Third Earlier Mark for its opposition under section 5(3). The opponent claims that the First Earlier Mark and the Second Earlier Mark have a reputation in respect of the following services:

Class 39 Transport; packaging and storage of goods; travel arrangement; travel information; provision of car parking facilities; transportation of goods, passengers and travellers by air, land, sea and rail; 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; chauffeur services; taxi services; bus services; coach services; rail services; airport transfer services; airport parking services; aircraft parking services; escorting of travellers; 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.

12. The opponent claims that the Third Earlier Mark has a reputation in respect of the following services:

Class 43 Temporary accommodation; provision of holiday accommodation; booking and reservation services for holiday accommodation; hotel services; hotel reservation services; hotel services for the provision of facilities for exhibitions and conferences.

13. The opponent claims there is a likelihood of confusion because the respective goods and services are identical or similar and the marks are similar.

14. Further, the opponent claims that the First Earlier Mark, the Second Earlier Mark and the Third Earlier Mark have a reputation in respect of the services listed in paragraphs 11 and 12 above and that use of the applicant's mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or reputation of those earlier marks.

15. The applicant has filed a counterstatement denying the grounds of opposition and putting the opponent to proof.

16. The opponent filed evidence in support of its opposition in the form of the witness statement of Ryan Edward Pixton dated 19 February 2018. The applicant filed evidence in the form of the witness statement of Ann Elizabeth Roome dated 15 June 2018 and the witness statement of Andrew Graham dated 13 June 2018. The opponent filed written submissions in the form of a letter dated 19 February 2018 and the applicant filed written submissions in the form of a letter dated 15 June 2018. No hearing was requested and so this decision is taken following a careful perusal of the papers.

EVIDENCE

The opponent's evidence

17. The opponent's evidence consists of the witness statement of Mr Ryan Edward Pixton, with five exhibits. Mr Pixton is a Trade Mark Attorney with Kilburn & Strode LLP who are the opponent's representatives in these proceedings. Mr Pixton makes no substantive comments in his statement other than to introduce the documents exhibited.

18. Exhibit 1 to Mr Pixton's statement is the witness statement of Sir Stelios Haji-loannou dated 4 August 2017. Mr Haji-loannou is the founder and director of the opponent. The witness statement is described as a "general" statement regarding the EASY family of brands. Various documents are referred to throughout the statement which have not been filed in these proceedings. In his statement, Sir Haji-loannou stated as follows:

a) The development of the EASY family of brands started with the launch of the low-cost airline EASYJET. Sir Haji-loannou went on to describe a variety of other businesses that he launched such as a chain of internet cafes called easyEverything (which later became easyInternetcafe) and a rental car business called easyRentacar (which later became easyCar).

b) The EASYJET offices were initially based in the 'Executive Terminal' at Luton Airport. As this name was not appropriate for a low cost airline, Sir Haji-loannou decided to change the name of the offices to "easyLand" and this was formally registered in the Annual Return of the company dated 1998.

c) In 1995, it was decided that the colour orange would be used for the branding on EASYJET aircrafts and it was later decided that all EASY brands would use the same 'get-up' (the cooper black font in white letters on an orange background).

d) The business model was to develop a family of brands all sharing the prefix EASY. For this purpose, Sir Haji-loannou decided to bring ownership of the intellectual property relating to all of the EASY businesses into the ownership of one company – easyGroup Limited (previously easyGroup IP Licensing Limited). EASY businesses were used to “promote and advertise the goods and services of one another”.

e) At paragraph 41, Sir Haji-loannou stated:

“I should make it clear that easyGroup was not just a corporate or legal vehicle, it is the owner and creator but also a member of the EASY family of brands and it became recognised in its own rights. EasyGroup had its own website (www.easygroup.co.uk); its own stationery and appeared in the header of purchase orders and letters...”

He also stated that there has been extensive press coverage referring to EASYGROUP both in the UK and abroad.

f) The EASY businesses are intended to be seen as taking on or challenging the “big businesses” on behalf of the consumer. The brand values are described at paragraph 44 and include “great value” and “for the many not the few”.

g) Sir Haji-loannou has confirmed the number of passengers that had flown with EASYJET per year from 1995 to 2017. I do not intend to reproduce those figures in full here, but by way of example, the figures for the last three years are as follows:

1 February 2016 to 31 January 2017	74,921,296
1 February 2015 to 31 January 2016	70,082,951
1 February 2014 to 31 January 2015	65,349,451

h) By 2003, the EASYJET website was available in English, French, Spanish, Dutch, German, Italian and Danish. EASYJET has flown to various countries since 1995 including Spain, France, Greece, Portugal, Germany, Switzerland, Italy, Austria and Belgium.

i) Sir Haji-loannou provided statistics confirming the number of visitors to the EASYJET website from 2011 to the end of July 2017 and these are as follows:

Year	Users	Page views
2011	122,774,951	1,290,544,781
2012	181,066,443	1,384,003,741
2013	182,844,400	1,622,460,308
2014	204,695,807	1,832,692,963
2015	208,363,085	1,625,290,017
2016	168,943,682	1,435,611,431
2017 ¹	86,917,538	919,258,176

The website is visited by people around the world including 536,756,400 visitors from Germany and 3,797,300,717 visitors from the UK between 2011 and 2016.

j) In addition to airline services, EASYJET has offered holiday and accommodation services. These have been advertised in the airline's in-flight magazine and were available via the easyJet.chaletfinder.co.uk and easyJet4ski.com websites. The staff and passengers of EASYJET were also featured on the television show 'Airline' from 1999 to 2006, which reached 9 million viewers in 2001.

k) In respect of EASYJET's turnover, Sir Haji-loannou states:

"The easyJet Annual Report for 2012 at shows that by 2011 annual turnover was £3.45 billion and by 2012, £3.85 billion. Total revenue for 2013 was 4.26 billion and £4.25 billion for 2014 (the easyJet Annual Report for 2014)."

l) Internet cafes called easyEverything (and later easyInternetcafe) were launched across Europe in 1999, starting in London and expanding to various other European cities including Amsterdam, Barcelona and Munich. This business was expanded into the United States in 2000. In September 2001, easyEverything had a turnover of £22,491,000. The easyRentacar business was launched in April 2000 and had sites in London, Glasgow and Barcelona. By the end of September 2000, easyRentacar had a turnover of £3.34 million.

m) In 2001, easy.com was established as a web based email system. Email addresses were “@easy.com” and emails sent through this system would contain a footer saying “Sent by Mail @easy.com, an easyGroup company”. This service is still being provided to around 5000 customers.

n) Since at least 24 December 2003, EASYHOTEL has been promoted on the easy.com website along with various other EASY brands. Sir Haji-loannou has provided the following statistics for the website views:

Year	Users	Page Views	Sessions
2012	754,514	3,904,709	1,911,146
2013	676,179	3,327,116	1,729,272
2014	772,055	3,128,506	1,717,423
2015	1,028,415	3,305,865	1,919,335
2016	642,966	3,349,887	1,553,990
2017 ²	458,919	2,400,436	1,159,901
Total since 2012	4,286,067	19,416,522	9,991,070

o) EASYHOTEL was launched in September 2004 and originally operated as a hotel booking facility via the website where customers could book hotel rooms worldwide. The first EASYHOTEL property was launched in August 2005 in London. He confirms that there are now 25 EASYHOTELS in 16 cities and 8 countries across Europe. Sir Haji-loannou has provided revenue figures for EASYHOTEL, the most recent of which is for the year ending December 2011 (£11,161,353). He also records various “System sales”, the most recent being for the year ending September 2015 (£19,950,888). Although he does not

explain what is meant by the term “system sales”, I understand this to mean payments made by franchisees in return for support (such as supplies and marketing).

p) In 2012, discussions were commenced regarding the license of the easyProperty brand for a period of 20 years. Mr Haji-loannou states that the launch of the new brand received significant press coverage. The annual report for easyProperty for the year ending 30 September 2015 shows revenue of £144,161.

q) The first easyOffice was opened in London in 2007. This was intended to provide low cost serviced offices to small businesses. In October 2011 there were 9 offices, 7 of which were in London, 1 was in Hertfordshire and 1 was in Manchester. It also “offered a booking facility under the mark easyOffice for more than 4,000 serviced offices of third parties throughout the world”. A liquidator was appointed in 2012 and since the winding up there are no longer “easyOffices” available to rent. However, the brokerage service is still operated.

r) Sir Haji-loannou stated that allowing a third party to use the mark EASY, especially in combination with elements their ‘get-up’, is likely to dilute the EASY brand and make it less distinctive. He stated that third parties may not adhere to the same values as the EASY brand and therefore the attractiveness of the EASY family will be diminished. He stated that because the EASY brand is known for expanding into different areas, people exploit it as an opportunity to ‘free-ride’.

19. Exhibit 2 to Mr Pixton’s statement consists of various press articles, web print outs and reports which Mr Pixton states demonstrate the significant reputation of EASYJET in the UK in relation to airline services. The first page is an extract from what appears to be an EASYJET webpage. The print out is undated, but describes EASYJET as “Europe’s leading short-haul airline”. The second to fifth pages are extracts from reports which record the results for EASYJET for the years ending 30 September 2016, 30 September 2015, 30 September 2014 and 30 September 2013. These confirm that across these years, EASYJET’s revenue was £4,669 million, £4,686

million, £4,527 million and £4,258 million respectively. The remainder of Exhibit 2 consists of various news articles referring to EASYJET which date between June 2014 and May 2017.

20. Exhibit 3 to Mr Pixton's statement consists of extracts from EASYHOTEL reports which confirm its financial results for the years ending 30 September 2016, 30 September 2015 and 30 September 2014. The total system sales for each of these years is £21.32 million, £19.95 million and £17.3 million respectively.

21. Exhibit 4 to Mr Pixton's statement consist of various news articles referring to easyProperty which date between March 2015 and December 2015.

22. Exhibit 5 to Mr Pixton's statement is the witness statement of Mr Christopher Griffin dated 4 April 2017. Mr Griffin is the Chief Executive of the Museum of Brands and states that he is acknowledged as an expert in the field of branding, although he does not state by whom. Mr Griffin states that the fame of the EASY brand began with the launch of EASYJET in 1995. However, he states that it has always been "more expansive than 'easyJet' alone and covers a diverse range of products and services". Mr Griffin states that the EASY brand has a distinctive style using the word 'easy' followed by the relevant product or services, with its first letter capitalised (such as easyHotel or easyGym). Mr Griffin states that he would "expect there to be widespread knowledge of the 'easy' brand, because of the variety and number of 'easy' brands licensed or used by the easyGroup". He states:

"The widespread licensing of the mark 'easy' into fields as diverse as travel, retail, foodstuffs, gyms and estate agency has led to a recognition that commercial activities with an 'easy' prefix are likely to emanate from easyGroup. This association becomes a certainty where either the colour orange or the font Cooper Black is used together with an 'easy' prefixed name, as both the use of the colour orange and the font Cooper Black have become synonymous with the use made by easyGroup."

23. Mr Griffin stated that values such as “excellent value” and “innovation” which have become associated with the EASY brand may be tarnished by third parties offering an ‘easy-’ branded services without the control of the easyGroup.

Applicant’s Evidence

24. The applicant’s evidence consists of the witness statement of Ann Elizabeth Roome, with three exhibits, and the witness statement of Andrew Graham dated 13 June 2018, with four exhibits. Ms Roome is a Trade Mark Attorney at Roome Associates Limited who represent the applicant in these proceedings. Ms Roome states that the applicant has used various other marks which include the term EASY for a number of years. She also states that there are various other marks registered which include the word EASY in fields which the opponent has no involvement and therefore the opponent cannot have a monopoly on all marks with EASY as the prefix.

25. Exhibit 1 to Ms Roome’s statement is a list of the marks already registered by the applicant for goods in classes 27 and 35, specifically a stylised EASY DÉCOR mark, SUPERFRESCO EASY, GRAHAM & BROWN EASYWALLPAPER and GRAHAM & BROWN EASY4WALLS.

26. Exhibit 2 to Ms Roome’s statement is a list of examples of marks which use the prefix EASY that have already been registered in class 27. These include EASY LINER, EASY LIFE and EASY MAT.

27. Exhibit 3 to Ms Roome’s statement gives examples of some of those marks listed in Exhibit 2 in use. The first of these shows the EASY LINER products for sale on amazon.co.uk. The second is a print out of the Mail Shop online offering for sale “GARDMAN ‘WELCOME’ EASY MAT”. The third shows a stylised EASY BATHING mark displayed on the website bathstore.com. The fourth print out shows various EASY-LOCK products for sale on jordanfitness.com website.

28. Mr Graham does not state in what capacity he makes his witness statement although he does confirm that he is authorised to make it on behalf of the applicant

and refers to the applicant as “my company”. He states that the applicant was formed in 1946. It developed its wallpaper business following the Second World War. Mr Graham states that by the 1970s the applicant was producing millions of rolls of wallpaper a year and were “one of the largest independent wallpaper manufacturers in Britain and a growing force in Europe”. Mr Graham states that the word ‘easy’ has appeared in the applicant’s marketing communications and branding since 1983, with the aim of overcoming the traditional view that hanging wallpaper is difficult. Mr Graham states that this was particularly the case when ‘paste-the-wall’ paper was introduced. He states that this was referred to as ‘easy wallpaper’ in dialogue with customers. Mr Graham states that the word ‘easy’ either as a suffix or a prefix is intended to inform the customer that the wallpaper offered is easy to use. Mr Graham goes on to state that the applicant has an existing reputation and therefore has no need to ride on the back of others such as the opponent.

29. Exhibit A to Mr Graham’s statement is an example of another brand used by the applicant, ‘superfresco’, used in combination with the word ‘easy’ with the addition of a small device bearing the words ‘easy wallpaper’. It consists of two photographs of wallpaper rolls displaying the mark, an example of the mark itself and instructions for using the wallpaper, although it is in very small print and therefore difficult to read.

30. Exhibit B to Mr Graham’s statement is an example of other brands used by the applicant, specifically ‘contour’ and ‘boutique’ which are also used in combination with the small device bearing the words ‘easy wallpaper’. These are also accompanied by sets of instructions, although again they are in very small print and therefore difficult to read.

31. Exhibit C to Mr Graham’s statement shows the device used in combination with the above brands. It consists of the words ‘easy wallpaper’ surrounded by two circles and the words “EASY TO HANG EASY TO REMOVE”.

32. Exhibit D to Mr Graham’s statement consists of a printout from the Express and a photograph taken at an award ceremony which both confirm that the applicant was awarded Best Decorating Brand in 2017.

PRELIMINARY ISSUES

33. In his evidence, Mr Graham makes reference to the applicant's use of the mark applied for in the device mark shown in Exhibit C to his statement and displayed in various photographs in Exhibits A and B. The use of the mark in this way will, as a matter of law, have no bearing on the outcome of the opposition. In *O2 Holdings Limited, O2 (UK) Limited v Hutchinson 3G UK Limited* (Case C-533/06), the Court of Justice of the European Union ("CJEU") stated at paragraph 66 of its judgement that when assessing likelihood of confusion in the context of registering a new trade mark, it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. As a result, my assessment must take into account only the applied-for mark (and its specification) and any potential conflict with the earlier trade marks. This means that the presentation of the mark as shown in Exhibit C to Mr Graham's statement are not relevant as they are not reflected in the applied for mark.

DECISION

34. Section 5(2)(b) of the Act states:

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

(a)...

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

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

35. Section 5(3) of the Act 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 European Union trade mark or international trade mark (EC), or in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

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

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

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

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

37. The trade marks upon which the opponent relies qualify as earlier trade marks under the above provisions.

38. As none of the earlier marks had completed their registration process more than 5 years before the publication date of the application in issue in these proceedings, they

are not subject to proof of use pursuant to section 6A of the Act. The opponent can, as a consequence, rely upon all of the services it has identified.

Section 5(2)(b)

39. 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 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 to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

40. The competing goods and services are listed in Annex 1 to this decision (the opponent's services) and paragraph 1 above (the applicant's goods and services).

41. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU 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.”

42. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-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 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.

43. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU

in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

44. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

45. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“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.”

46. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

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

47. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“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.”

Whilst on the other hand:

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

48. In its Notice of Opposition, the opponent stated in respect of the First Earlier Mark, Third Earlier Mark, Fourth Earlier Mark, Fifth Earlier Mark and Sixth Earlier Mark:

“The Class 35 services are identical and highly similar to the Opponent’s Class 35 services, and to the Opponent’s Class 43 services. Wallpaper is something that is complementary to hotel services as wallpaper will be found in hotel rooms and the opposed Class 27 goods are therefore similar to the Opponent’s Class 35 and Class 43 services.”

49. In respect of the Second Earlier Mark it stated:

“The Class 35 services are identical and highly similar to the Opponent’s Class 35 services, and to the Opponent’s Class 43 services. Wallpaper is something that is complementary to hotel services as wallpaper will be found in hotel rooms and the opposed Class 27 goods are therefore similar to the Opponent’s Class 36 and Class 43 services.”

50. In its written submissions, the opponent went on to state:

“20. We submit that there is identity between the class 35 services and the retail services of the Opponent’s Registration No 010584001, the Opponent’s Registration No 01058311, the Opponent’s Registration No 011624376, the Opponent’s Registration No 016079675 and also the Opponent’s Registration No 014920433. They are all retail services and therefore identical. Further, or in the alternative, if the respective services are not found to be identical then they are certainly highly similar.

21. We submit that there is similarity between the Opponent’s class 43 services relied upon and the class 35 and class 27 services and goods of the opposed application. The Opponent covers the provision of accommodation services in class 43. One of the key features of hotel rooms and other serviced accommodation that is most readily noted and identifiable by consumers is of course the wallpaper. We submit that there is a natural complementarity between the offering of hotel and serviced accommodation on the one hand, and the manufacture and sale of wallpaper on the other. The two are natural companions and would look like natural extensions of the same business.”

51. I have lengthy submissions from the applicant on the similarity of the goods and services, which I do not propose to reproduce here. However, I have taken them all into consideration in reaching my decision.

Class 27

52. It is the opponent's case that the similarity lies between the class 27 goods in the applicant's specification and the class 43 services in the opponent's specification, specifically the provision of hotel services. The fact that hotel rooms are decorated with wallpaper is not sufficient to find complementarity between "wallpaper" in the applicant's specification and "hotel services" in the opponent's specification (or any of the related goods and services). That hotel rooms may be decorated with wallpaper seems to me to be an even weaker comparison than the wine and wine glass example given in the authorities cited above. Neither is important or indispensable for the other. I cannot see any reason why the consumer would expect the same undertaking to be responsible for the production of wallpaper and the provision of hotel and accommodation services. I am not satisfied that there is any similarity between the class 27 goods in the applicant's specification and any of the opponent's services.

Class 35

53. I have limited submissions from the opponent on the similarity of the class 35 services in the applicant's specification and its own services. The only similarity, in my view, lies between the "retail store services, retail mail order and on-line retail services connected with...paper, cardboard" in the applicant's specification and "retail services connected with the sale of...stationery" in the specifications of the First Earlier Mark, the Second Earlier Mark and the Sixth Earlier Mark and "the bringing together for the benefit of others of a variety of goods, namely... stationery" in the specification of the Fifth Earlier Mark. Retail services connected with the sale of stationery is likely to overlap with retail services connected with the sale of paper and other artists materials in the applicant's specification. The services target the same consumers and the trade channels may coincide. I therefore consider that these services are highly similar. I have considered the nature, intended purpose, users and trade channels of the remaining goods and services in class 35 of the applicant's specification and I am not satisfied that there is any similarity to the services in the opponent's specifications.

54. As some similarity between the goods and services is necessary to engage the test for likelihood of confusion¹, my findings above mean that the opposition under section 5(2)(b) can only proceed in respect of the following services:

Class 35 Retail store services, retail mail order and on-line retail services connected with the sale of metals in foil and powder form for painters, decorators, printers and artists, paper and cardboard.

The average consumer and the nature of the purchasing act

55. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which these services are likely to be selected by the average consumer. 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”.

56. I have no submissions from the opponent or the applicant on the average consumer or the purchasing process for the services at issue.

57. The average consumer in these proceedings will be either a member of the general public or a business user. The services in issue are likely to be purchased fairly frequently and be of average cost. The level of attention paid by the average consumer is likely to be average. The services are likely to be purchased from specialist retail

¹ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

outlets or their online equivalent. The purchasing process for the services will be dominated by visual considerations, as the average consumer is likely to select the services at issue following inspection of the premises' frontage on the high street, on websites and in advertisements. However, given that word-of-mouth recommendations may also play a part, I do not discount that there may be an aural component to the selection of the services.

Comparison of the trade marks

58. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU 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.”

59. 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.

60. I will only undertake the mark comparison for the opponent's marks that are registered for similar services to the applicant's goods and services. The respective trade marks are shown below:

Applicant's trade marks	Opponent's trade marks
<p data-bbox="352 304 638 338">EASYWALLPAPER</p> <p data-bbox="464 416 526 450">And</p> <p data-bbox="347 528 643 562">EASY WALLPAPER</p> <p data-bbox="339 640 651 674">(as a series of marks)</p>	<p data-bbox="1026 304 1171 338">EASYJET</p> <p data-bbox="938 360 1259 394">(the First Earlier Mark)</p> <p data-bbox="994 472 1203 506">EASYGROUP</p> <p data-bbox="914 528 1283 562">(the Second Earlier Mark)</p> <p data-bbox="1026 640 1171 674">easyLand</p> <p data-bbox="938 696 1259 730">(the Fifth Earlier Mark)</p> <div data-bbox="962 808 1235 913" style="text-align: center;">  </div> <p data-bbox="932 954 1265 987">(the Sixth Earlier Mark)</p>

61. In relation to the similarity of the marks, the opponent states as follows:

“18. We submit that the opposed mark follows a very similar formulation to the Opponent’s renowned marks. It is composed of the identical prefix **easy-**, conjoined to the word **wallpaper**. The word **wallpaper** is, we submit, non-distinctive and descriptive of all of the class 27 goods of the opposed application, and non-distinctive in relation to the class 35 services of the opposed application. As such, the distinctive character of the opposed mark resides in the combination of those two word elements so as to form a neologism. These elements are shared by the **easy** family of brands, which is distinguished by the conjoining of the identical prefix **easy-** to an allusive or weakly distinctive word element so as to form a neologism.”

62. I have lengthy submissions from the applicant on the similarity of the marks which I do not propose to reproduce in full here. However, I have taken them all into consideration in reaching my decision.

63. As the Sixth Earlier Mark is stylised and designated to specific colours, it is clearly the least similar to the applicant's marks. I will therefore use only the First Earlier Mark, the Second Earlier Mark and the Fifth Earlier Mark for the purposes of the comparison as they represent the opponent's best case. If there is no likelihood of confusion in respect of these marks, there will be no likelihood of confusion in respect of the Sixth Earlier Mark. As the opponent's marks are all presented as conjoined words and it is the opponent's case that the conjoined elements of the applicant's mark contribute to the alleged similarity, I will use the first in the applicant's series of applied for marks EASYWALLPAPER for the purposes of the mark comparison. If there is no similarity between that mark and the opponent's marks then it follows that there will be no similarity between EASY WALLPAPER and the opponent's mark as the former represents the opponent's best case.

64. The applicant's mark consists of 13 letters, presented in capitals. The opponent's mark EASYJET consists of 7 letters, presented in capitals. The opponent's mark EASYGROUP consists of 9 letters, presented in capitals. The opponent's mark easyLand consists of 8 letters, presented in lower case, with the fifth letter capitalised. Although conjoined, I think it clear that all four marks will be perceived as two recognisable dictionary words ("easy" and "wallpaper", "easy" and "jet", "easy" and "group" and "easy" and "land" respectively). I consider that the overall impression of each mark will be as a unit (as opposed to two separate and unrelated words), with neither word dominating.

65. Visually, all four marks start with the word EASY and as a general rule the beginnings of marks tend to make more impact than the ends². The difference between the marks lies in the difference between the suffixes used in each mark. As notional and fair use means that the opponent's marks could be used in any standard typeface, the differences created by the capitalisation are not relevant. I consider there to be a medium degree of visual similarity between the marks.

66. Aurally, all four marks will be broken down into their two respective dictionary words. The word "easy" will be pronounced identically in each mark, with the difference

² *El Corte Ingles, SA v OHIM*, Cases T-183/02 and T-184/02

being created by the different suffixes, which share no aural similarity. I consider there to be a medium degree of aural similarity between the marks.

67. Conceptually, the only similarity between the marks is the use of the word “easy”. However, the use of the word “easy” is in itself descriptive of the nature of the goods and services offered (as set out in the evidence). The different suffix used in each mark creates a conceptual difference, particularly as they are all recognisable dictionary words with different meanings that will be identified by the average consumer. There is no conceptual similarity between the words “wallpaper” and “jet” or “group” or “land”. I therefore consider the marks to be conceptually similar to a low degree.

Distinctive character of the earlier marks

68. 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-2779, 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 promotion of 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).”

69. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

70. I have no submissions from the parties on the distinctive character of the earlier marks. I must make an assessment of the inherent distinctive character of the earlier marks as a whole. EASYJET, EASYGROUP and easyLand all consist of two recognisable dictionary words which are conjoined. The word “easy” is allusive to the nature of the services to which they relate. The word “jet” in the opponent’s mark EASYJET is descriptive of some of the services for which it is registered (although not those in issue). The words “group” and “land” in the opponent’s marks EASYGROUP and easyLand cannot be said to be descriptive of the goods and services to which they relate. The inherent distinctive character of these marks lies in the combination of the words as a whole.

71. The opponent has argued that the marks, particularly the EASY prefix, have become more distinctive through use. There is no doubt that EASYJET was highly distinctive for airline services at the relevant date. However, airline services are not relied upon for the purposes of the opposition under section 5(2)(b) and there is no evidence to suggest that EASYJET has become highly distinctive for the services in issue. Equally, there is no evidence to suggest that EASYGROUP or easyLand have become more distinctive through use in relation to the services in issue. I therefore consider that the opponent’s marks have an average degree of distinctive character.

Likelihood of confusion

72. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible

undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer of the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

73. I have found the parties' marks to be visually and aurally similar to a medium degree and conceptually similar to a low degree. I have found the earlier marks to have an average degree of inherent distinctive character. I have identified the average consumer to be a member of the general public or a business user who will select the services through primarily visual means (although I do not discount an aural component), and I have concluded that the degree of attention paid will be average. I have found the parties' services to be highly similar (except for those which I have found to share no similarity at all).

74. I consider that the visual, aural and conceptual differences between the marks are sufficient to ensure that they will not be misremembered or mistakenly recalled as each other. I am satisfied that there is no risk of direct confusion.

75. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.”

76. The focus of the opponent’s case in this regard is that the applicant’s mark will be mistaken for being a member of its family of easy- prefix marks. In *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, the CJEU stated:

“62. Whilst 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 to 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."

77. The opponent has demonstrated that EASYJET was present on the market at the relevant date. It is arguable that EASYGROUP was on the market at the relevant date, although the opponent's evidence on this point is limited. I have seen no evidence to suggest that the mark easyLand was on the market at the relevant date, other than being used as part of the opponent's office address. In any event, I have seen no evidence that any of the opponent's marks were on the market in relation to the services in issue. I do not consider that the opponent has established that the public would expect any mark with an EASY- prefix and a descriptive suffix to be connected to the opponent. I also consider that the goods and services covered by the applicant's mark are directed at different markets to the services covered by the opponent's earlier marks. I cannot see that the brand values described by Mr Haji-loannou are easily transferable to the retail of paper and art materials. The goods and services covered by the applicant's mark do not appear to be a natural extension of the businesses or attributes associated with the opponent's EASY- marks. I therefore do not consider there to be a likelihood of indirect confusion on the basis of the opponent's family of marks argument.

78. Taking this into account, as well as the visual, aural and conceptual differences between the marks, the average degree of inherent distinctive character of the earlier marks, the average consumer and the purchasing process for the services in issue, I do not consider that the average consumer would expect that the services would be provided by the same or economically linked undertakings. I do not consider there to be a likelihood of indirect confusion and the opposition fails under section 5(2)(b).

Section 5(3)

79. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*,

Case C-487/07, *L'Oreal v Bellure* 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*).

Reputation

80. The opponent has demonstrated that millions of passengers have flown with EASYJET since 1995 (such as the 74,921,296 passengers that flew with easyJet between 1 February 2016 and 31 January 2017 alone). The opponent has demonstrated that EASYJET operates across the EU. The most recent revenue figure provided by the opponent for EASYJET is for 2016 and total was £4,669 million. I accept that EASYJET had a strong reputation in the UK and EU at the relevant date in relation to airline services. I am not satisfied that the opponent's evidence establishes that the reputation of the mark extended to other services.

81. The only evidence provided by the opponent in relation to EASYGROUP is the evidence given by Mr Haji-loannou which details how the intellectual property rights for various companies are held by EASYGROUP to ensure central control and protection and that it was included in the footer of emails sent from easy.com addresses. I do not accept that EASYGROUP had a reputation as a trade mark at the relevant date.

82. The opponent has demonstrated that EASYHOTEL now has 25 hotels located across 16 cities and 8 countries in Europe. The most recent report provided by the opponent for EASYHOTEL shows financial results for the year ending 30 September 2016 and confirms total system sales of £21.32 million. I accept that EASYHOTEL has a reputation in the UK and the EU in relation to the services on which the opponent relies in this opposition.

Link

83. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

For the reasons set out earlier, I consider that there is a low to medium degree of similarity between the applicant's mark and the opponent's earlier marks.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

There is a wide disparity between airline services and hotel services on the one hand and wallpaper and associated goods and services on the other. There is, of course, some overlap between consumers for both types of goods and services as members of the general public and businesses may use both.

The strength of the earlier mark's reputation

EASYJET has a strong reputation in the UK and the EU. EASYHOTEL also has a reasonable reputation in the UK and the EU.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

The word 'easy' is a natural way of designating goods and services as being easy to use. The word itself is therefore inherently low in distinctive character. The words combined with the word 'easy' in the opponent's mark (JET and HOTEL) are both descriptive of the services to which they relate. The inherent distinctive character of the marks lies in the combination of the words (EASYJET and EASYHOTEL). I consider that the earlier marks have an average degree of inherent distinctive character.

It is the opponent's case that the earlier marks, particularly the EASY prefix, have become more distinctive through use. I accept that EASYJET and EASYHOTEL are highly distinctive for airline services and hotel services respectively. There is insufficient evidence to find that they are highly distinctive for anything else. Whilst the marks overall are highly distinctive, the common element EASY is descriptive and has not been shown to be highly distinctive on its own.

Whether there is a likelihood of confusion

I have already found that there is no likelihood of confusion between the applicant's mark and the opponent's EASYJET mark. I consider that the use of the suffix -HOTEL in the opponent's EASYHOTEL mark does not improve its case on the likelihood of confusion. Had I considered this mark under section 5(2)(b) I would have concluded that there was no likelihood of confusion for the same reasons as the opponent's other marks.

84. In my view, the medium degree of aural and visual similarity between the marks, the low degree of conceptual similarity between the marks and the marked difference between the services for which the opponent has proved it had a reputation at the relevant date and the applicant's goods and services make it unlikely that consumers will make any link between the marks in use. The opposition under section 5(3), consequently, must fail. My findings in this regard would have been the same, even if the opponent had established a reputation in respect of the earlier mark EASYGROUP.

CONCLUSION

85. The opposition under sections 5(2)(b) and 5(3) is dismissed and the application will proceed to registration for all the goods and services for which registration has been sought.

COSTS

86. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Note 2/2016. In the circumstances, I award the applicant the sum of **£900** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing a counterstatement and considering the opponent's statement	£200
Preparing evidence and considering and commenting on the other side's evidence	£700
Total	£900

87. I therefore order easyGroup Limited to pay Graham & Brown Limited the sum of £900. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 11th day of October 2018

S WILSON

For the Registrar

ANNEX 1

Earlier Mark	Opponent's goods and services relied upon for the purposes of the opposition under section 5(2)(b)
EU trade mark 10584001: EASYJET	<u>Class 35</u> 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

	<p>publicity services; dissemination of advertising, marketing and publicity materials.</p> <p><u>Class 43</u></p> <p>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.</p>
<p>EU trade mark 10583111: EASYGROUP</p>	<p><u>Class 35</u></p> <p>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 drinks, 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</p>

	<p>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, briefcase, purses, wallets, pouches, 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.</p> <p><u>Class 43</u></p> <p>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.</p>
<p>EU trade mark 10735496: EASYHOTEL</p>	<p><u>Class 43</u></p> <p>Temporary accommodation; provision of holiday accommodation; booking and reservation services for holiday accommodation; hotel services; hotel reservation services; hotel services for the provision of facilities for exhibitions and conferences.</p>

EU trade mark 11624376:



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.

Class 43

Services for providing food and drink; temporary accommodation; catering, hotel, restaurant, café and bar services; rental of meeting rooms; hotel services for the provision of facilities for exhibitions, conferences and seminars; providing facilities for exhibitions, seminars and conferences; room rental for exhibitions, seminars and conferences, hire of temporary office space; rental of office furniture; reservation services for temporary office space, meeting rooms, facilities for exhibitions, seminars and conferences, rooms for exhibitions, seminars and conferences; information, advisory and consultancy services for all the aforesaid services.

EU trade mark 16079675: easyLand	<p><u>Class 35</u></p> <p>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 demonstrating of goods for others; the bringing together for the benefit of others of a variety of goods, namely, sunglasses, jewellery, watches, bags, clothing, footwear, headgear, glassware, porcelain, earthenware, printed matter, stationery, books, magazines, prepared meals, enabling customers conveniently to view and to purchase such goods through retail shops, retail kiosks, the internet, on board aircraft, by means of telecommunications and from a general merchandise catalogue by main order; advisor and arrangement services relating to all the aforesaid; including, but not limited to, all the aforesaid services provided via telecommunications networks, by online delivery and by way of the Internet and the world wide web; hotel management.</p> <p><u>Class 43</u></p> <p>Temporary accommodation; provision of food and drink; catering; hotel, restaurant, café and bar services; hotel reservation services; providing</p>

	<p>facilities for exhibitions and conferences; nursery, kindergarten and creche services.</p>
<p>EU trade mark 14920433:</p> 	<p><u>Class 36</u></p> <p>Operation and supervision of loyalty and incentive schemes; retail services connected with the sale of food and drink; retail services connected with the sale of preparations and substances for use in the care and appearance of the hair, scalp, lips, face, skin, teeth, nails and eyes; retail services connected with the sale of cosmetics, non-medicated toilet preparations, perfumes, fragrances, colognes and scents, soaps and cleaning preparations; retail services connected with the sale of shampoos, conditioners, moisturisers, tooth cleaning preparations; retail services connected with the sale of depilatory preparations, sunscreening and tanning preparations; retail services connected with the sale of anti-perspirants, deodorisers and deodorants; retail services connected with the sale of sunglasses, personal stereos, MP3 players, CD players, apparatus for playing music and video recordings; retail services connected with the sale of jewellery, stones, watches, clocks; retail services connected with the sale of books, magazines, newspapers, stationery, calendars, diaries; retail services connected with the sale of purses, umbrellas, parasols briefcases, purses, wallets, pouches and handbags; retail services connected with the sale of luggage, suitcases, travelling sets, sports bags, bike bags, backpacks, games, playing cards; retail services connected with the sale of</p>

	gymnastics and sporting articles; retail services connected with the sale of scooters.
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