

O/569/20

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. WO0000001461716

IN THE NAME OF CONG TY CO PHAN THUC PHAM

THIEN HUONG (THIEN HUONG FOOD JSC.)

FOR THE FOLLOWING TRADE MARK:



IN CLASS 30

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 502803 BY EASYGROUP LTD

## BACKGROUND AND PLEADINGS

1. Cong Ty Co Phan Thuc Pham Thien Huong (Thien Huong Food JSC.) (“the holder”) is the registered owner of the trade mark shown on the cover of this decision (“the contested mark”). The contested mark was registered with effect from 26 December 2018. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect under the terms of the Protocol to the Madrid Agreement. It was granted that protection on 4 July 2019. It stands registered for the following goods:

Class 30: Instant noodles; instant porridge; soft instant noodle; instant noodle with seasoned and saute beef.

2. On 18 September 2019, easyGroup Ltd (“the applicant”) applied to have the contested mark declared invalid under section 47 of the Trade Marks Act 1994 (“the Act”). The applicant relies upon sections 5(2)(b) and 5(3) of the Act.
3. Under section 5(2)(b) of the Act, the applicant relies on the following trade marks:

EASYGROUP

EUTM no. 14920391

Filing date 17 December 2015; registration date 26 May 2016  
 (“the first earlier mark”)

EASYJET

EUTM no. 10584001

Filing date 24 January 2012; registration date 9 January 2015  
 (“the second earlier mark”)



EUTM no. 11949716

Colours claimed: orange, white

Filing date 2 July 2013; registration date 6 April 2017

("the third earlier mark")

EASYPIZZA

EUTM no. 12492096

Filing date 10 January 2014; registration 16 February 2016

("the fourth earlier mark")

4. The applicant relies on those goods and services for which the earlier marks are registered as listed in the **Annex** to this decision. The applicant claims that there is a likelihood of confusion because the respective goods and services are identical or similar and the marks are similar.
  
5. Under section 5(3), the applicant relies on the second earlier mark only. The applicant claims that the second earlier mark has a reputation in respect of the following services:

Class 39: Transport; packaging and storage of goods; travel arrangement; travel information; transportation of goods, passengers and travelers by air; airport check-in services; airline services; baggage handling services; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; chartering of aircraft; airport transfer services; airport parking services; aircraft parking services; 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.

6. The applicant claims that use of the contested mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or repute of the earlier marks.

7. The holder filed a counterstatement denying the claims made.
8. The applicant is represented by Kilburn & Strode LLP and the holder is represented by Marks & Clerk LLP. The applicant filed evidence in the form of the witness statement of Ryan Edward Pixton dated 18 February 2020. No evidence was filed by the proprietor. During the evidence rounds, the applicant also filed written submissions. No hearing was requested and neither party has filed written submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers.

## **EVIDENCE**

9. As noted above, only the applicant has filed witness evidence, being the witness statement of Ryan Edward Pixton dated 18 February 2020. While the statement does not contain any evidence of fact, it serves to introduce three exhibits into evidence. The first exhibit is the statement of Sir Stelios Haji-loannou dated 4 August 2017. The second consists of press reports and copies of annual reports of easyJet in the UK in relation to airline and related services. The third is a witness statement from Christopher Griffin, being the director of the Museum of Brand in London.
10. Sir Stelios Haji-loannou is the founder and director of the applicant. I note that the statement refers to various documents throughout, however, those documents have not been filed in these proceedings. I also note that much of this statement, which is dated 4 August 2017 and was not prepared for these proceedings, is irrelevant as it refers to a number of the applicant's trade marks that it has not relied on in its present application. However, I have summarised what appears to be the most relevant and material evidence below:
  - a. The 'easy' family of brands started with the launch of the low-cost airline 'easyJet'. The 'easyJet' trade mark was registered on the UK trade mark register on 5 April 1995. Shortly after, Sir Haji-loannou began extending the 'easy' family of brands.

- b. Mr Haji-loannou goes on to describe a number of other businesses that he has launched that includes, amongst others, an in-flight catering service called easyKiosk, a chain of internet cafes called easyInternetcafe (formerly easyEverything) and a rental car business called easyCar (formerly easyRentacar).
  
- c. In order for the 'eastJet' brand to stand out, Sir Haji-loannou decided to use the colour orange for the branding. Sir Haji-loannou also settled on the idea that all 'easy' brands would use the same 'get-up'. This would include the prefix of each brand being the word 'easy' that would be followed by a second word or phrase (with the first letter capitalised) appropriate to the goods or services provided by that business. Each brand would be displayed in a white, cooper black font on an orange background. Sir Haji-loannou believed that this 'get-up' would reinforce the links between the businesses in the minds of the customer that are formed by the common use of the prefix 'easy'.
  
- d. By the end of 1998, Sir Haji-loannou had set up the company easyGroup Limited (formerly easyGroup IP Licensing Limited). The purpose of this was to bring ownership of all intellectual property relating to the 'easy' businesses into the ownership of one company. Under easyGroup, Sir Haji-loannou founded many businesses that covered different areas. Of these, I note Sir Haji-loannou refers to easyPizza for food delivery.
  
- e. Sir Haji-loannou's intention with the 'easy' businesses is to benefit the many, rather than the few by providing a price point that is competitive in the market place. Sir Haji-loannou goes on to state that 'easy' businesses are not intended to be seen as big businesses. Instead, they are intended to be businesses that take on or challenge the big businesses on behalf of the consumer.
  
- f. Sir Haji-loannou states, in paragraph 41 of his statement, 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 goes on to state that there has been extensive press coverage both in the UK and abroad which refers to the easyGroup and the other brands. However, I note that no examples of press coverage in relation to easyGroup are provided.

- g. The numbers of passengers that had flown with easyJet between the years of 1995 and 2017 have been provided. While I do not intend to reproduce the figures in full, I note that easyJet had 65,349,451 passengers in the year ending 31 January 2015, 70,082,951 in the year ending 31 January 2016 and 74,921,296 in the year ending 31 January 2017. I note, given the date of the statement, no further figures since 2017 have been provided.
- h. Between 2011 and 2016, the easyJet website had been visited by 3,797,300,717 visitors from UK. Sir Haji-loannou has also provided the following statistics confirming the number of visitors to the easyJet website from 2011 to the end of July 2017:

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 <sup>1</sup>	86,917,538	919,258,176

I note, given the date of the statement, that no further statistics have been provided for the years since July 2017.

- i. At paragraph 50 of Sir Haji-loannou’s statement, he sets out a number of routes that easyJet have launched since 10 November 1995. I will not

reproduce these in full here but note that of the 19 routes listed, 18 of which are routes that depart from or arrive at locations within the UK. I also note that these routes originate either from London or Liverpool and that destinations also include Aberdeen, Belfast, Edinburgh and Glasgow.

- j. easyJet’s turnover and revenue is broken down by Sir Haji-loannou at paragraph 57 of his statement, which states that “The easyJet Annual Report for 2012 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).”
  
- k. Between the years of 1999 and 2006, the easyJet brand together with its employees and passengers were featured in the television series ‘Airline’ that was broadcast in the UK on ITV. At its peak, ‘Airline’ attracted about 9 million viewers in 2001.
  
- l. In June 1999, Sir Haji-loannou acquired the domain name of easy.com. This website shows a list of all the easy brands and also offers a free web-based email service. As at the date of the witness statement, there are approximately 5,000 people who still use easy.com for their email addresses. I note that emails sent via an easy.com email address contained the footer, “Sent by Mail at easy.com, an easyGroup company”.
  
- m. By August 2000, easyGroup and easyJet (amongst other brands) were promoted on the easy.com website. Sir Haji-loannou has provided a Google Analytics report for the website easy.com that shows the following statistics:

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 <sup>2</sup>	458,919	2,400,436	1,159,901
<b>Total since 2012</b>	<b>4,286,067</b>	<b>19,416,522</b>	<b>9,991,070</b>

I note, given the date of the statement, that no further statistics have been provided for the dates since July 2017.

- n. Sir Haji-loannou goes on to discuss various other brands that have been launched (or considered) over the years. These include easyHotel, easyValue, easyMoney, easyProperty, easyOffice, easyCruise, easyStay and easyHoliday/easyHolidays. However, as these marks are not relied upon for the purposes of these proceedings, this is not relevant.
- o. Sir Haji-loannou states that allowing a third party to use the mark 'easy' in combination with other elements is likely to dilute the 'easy' brand and make it less distinctive. Further, he states that those third parties may not adhere to the same values as the 'easy' brand meaning that the attractiveness of the 'easy' family will be diminished. Sir Haji-loannou also states that as a result of the 'easy' brand being well known for expanding into different businesses, people are likely to exploit this as an opportunity to 'free-ride' off the 'easy' brand name.

11. The second exhibit of Mr Pixton's statement consists of a number of press articles and annual reports from easyJet. The first page is a printout from easyJet's corporate website that states that easyJet is 'europe's number one network' that has 802 routes across 132 airports in 31 countries. The printout has a print date of 13 November 2017. Pages two to five are extracts from reports for the years ending 30 September 2016, 30 September 2015, 30 September 2014 and 30 September 2013. Over these years, I note that easyJet's revenue was £4,669 million in 2016, £4,686 million in 2015, £4,527 million in 2014 and £4,258 million in 2013. The remainder of Exhibit 2 consists of a number of online news articles featuring the easyJet brand dated between June 2014 and May 2017. Excerpts from the news articles include the following:

- a. "You can fly easyjet to Larnac and Paphos from a range of UK airports" – Independent article dated 14 February 2017; and
- b. "Easyjet's passenger numbers have been steadily increasing and in over this period grew from 37.6 million passengers uplifted in 2008 to 58.6 million



passengers uplifted in 2015. EasyJet is the UK's biggest airline in terms of number of passengers and is based at Luton airport." – Statista.com article with a printout date of 28 October 2016.

12. I also note that a printout of Wikipedia's easyJet entry as at 26 June 2017 is included within Exhibit 2 of Mr Pixton's statement. Within this, I note the following:

"Its five largest bases are London Gatwick, Milan-Palpenza, London Luton, Bristol Airport and London Stansted.

[...]

Despite being a British airline and having a significant presence there, it has a significant presence in France, Germany, Italy, Spain and many other European countries. The United Kingdom is its biggest market, containing the airline's largest base and nine others as well as a total of six other non-based airports."

13. The third exhibit of Mr Pixton's statement is the witness statement of Christopher Griffin dated 4 April 2017. Mr Griffin is the Chief Executive of the Museum of Brands.

14. Mr Griffin gives his opinion of the familiarity of the average consumer with the 'easy' brand, which commenced in 1995 with the launch of the 'easyJet' airline. He states that the brand has "been more expansive than 'easyJet' alone and covers a diverse range of products and services." Mr Griffin states that he expects "there to be a widespread knowledge of the 'easy' brand, because of the variety and number of 'easy' brands licensed or used by easyGroup."

15. The applicant's evidence was accompanied by written submissions. Whilst I do not propose to summarise those submissions here, I have taken them into consideration and will refer to them below where necessary.

## DECISION

16. Sections 5(2)(b) and 5(3) of the Act have application in invalidation proceedings because of the provisions of section 47 of the Act, which states as follows:

“47. –

(1) [...]

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

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

(b) that there is an earlier right in relation to which the condition set out in section 5 (4) is satisfied

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

(2ZA) [...]

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered—

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Union.

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c).

[...]

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

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

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

17. Section 5(2)(b) of the Act reads as follows:

“(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 or association with the earlier trade mark.”

18. Section 5(3) of the Act reads as follows:

“5(3) A trade mark which –

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

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

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

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

(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.”

20. The applicant’s trade marks qualify as earlier marks under the above provisions. The earlier marks had not completed their registration process more than 5 years before the date of the application for invalidity. The use conditions do not, therefore, apply to these marks and the applicant can rely upon all goods and services identified in its Notice of Invalidity.

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

21. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (“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.

- (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 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.

### **Comparison of goods and services**

22. The holder's goods are set out in **paragraph 1** of this decision. The earlier marks' goods and services are set out in the **Annex** to this decision.

23. 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 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.”

24. 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.

25. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another or (vice versa):

“29... In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or



where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

26. In *Les Éditions Albert René v OHIM*, Case T-336/03, the GC found that:

“61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

27. 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 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”.

28. 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.”

29. 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.

30. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

31. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

32. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*<sup>1</sup>, and *Assembled Investments (Proprietary) Ltd v. OHIM*<sup>2</sup>, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*<sup>3</sup>, Mr Hobbs concluded that:

“i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).”

33. I have lengthy submissions from the applicant in respect of 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.

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<sup>1</sup> Case C-411/13P

<sup>2</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment

<sup>3</sup> Case C-398/07P

### The first and fourth earlier marks

34. “Instant noodles”, “instant porridge”, “soft instant noodle” and “instant noodle with seasoned and saute beef” in the holder’s specification all describe a type of pre-prepared food that will either be consumed as a meal or a snack. These goods will fall within the broader categories of “snack foods” and “prepared meals” that are included within the specifications of the first and fourth earlier marks. These goods will therefore be identical under the principle outlined in *Meric*. Even if I am wrong in this finding, the goods will overlap in nature, method of use, purpose, user and trade channels and will be highly similar.

### The second and third earlier marks

35. Porridge is commonly made from oats, which is a cereal grain. Therefore, I consider “instant porridge” in the holder’s specification will fall within the category of “preparations made from cereal” that is included within the specifications of the second and third earlier marks. These goods will therefore be identical under the principle outlined in *Meric*.

36. The applicant also states that there is identity between “instant noodles”, “instant porridge”, “soft instant noodle” and “instant noodle with seasoned and saute beef” in the holder’s specification and “preparations made from cereal” in the specifications of the second and third earlier marks. I recognise that noodles can be made from cereal grains such as rice. However, the terms in the holder’s specification are all types of prepared noodle-based meals. While cereal grains may be used as an ingredient to make noodles, I refer to the case of *Les Éditions* (cited above) wherein the GC found that the fact one good is used as part of another is not sufficient to find similarity between those goods. I also do not consider this a reason to find the goods to be identical. Further, while these goods will overlap in user and purpose, in that they will all be eaten by members of the general public, the goods will differ in nature and method of use. I recognise that there may be a degree of overlap in trade channels to the extent that these can all be sold through food shops or supermarkets, but these goods will not be found close to each other in shops or their online equivalents. I also do not consider that the goods have a competitive relationship. Overall, I am not satisfied that there is

any similarity between these goods. If I am wrong in this finding, then any similarity will be low. I have considered the other terms within the applicant's class 30 terms that it has claimed to be similar to the holder's goods. However, I do not consider that these put the applicant in any stronger position.

37. The applicant also submits that these goods are similar to "retail services connected with the sale of food and drink" in the second earlier mark's specification and the class 35 retail services in the specification of the third earlier mark, which I note includes "retail services connected with the sale of [...] prepared meals". While there will be an overlap in user, in that the user of both will be members of the general public, I note that they will differ in nature, method of use and purpose. Further, the goods will be indispensable or important for the services and the average consumer is likely to consider that they are sold through the same undertakings. As a result, I find that there will be a complementary relationship between the goods and services. Overall, I find there to be a medium degree of similarity between the goods and services.

38. I note that the applicant has made a similar case in respect of the class 43 services in its second earlier mark. However, I do not consider that any degree of similarity between these goods and services will be higher than medium. Given my findings of a medium similarity at paragraph 37 above, I do not consider it necessary to compare these goods and services in their entirety.

### **The average consumer and the nature of the purchasing act**

39. 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 decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. 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.”

40. Given my findings above, the relevant average consumer is the consumer of the goods in class 30 and the services in class 35. I have no submissions from either party regarding the average consumer. I find that the average consumer is a member of the general public of the UK.

41. The goods are generally sold through a range of retail shops, such as supermarkets and their online equivalents. In retail premises, the goods at issue will be displayed on shelves, where they will be viewed and self-selected by the consumer. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a webpage. The selection of the goods at issue will, therefore, be primarily visual, although I do not discount that aural considerations may play a part in the form of word of mouth recommendations or advice from a shop assistant. The goods at issue are low in value and will be reasonably frequent purchases. When selecting the goods, the average consumer is likely to consider such things as dietary requirements, flavour and/or nutritional information.

42. As for the class 35 services, I find that they are most likely to be selected having considered, for example, promotional material (in hard copy and online) and store-front signage. Visual considerations will be an important part of the selection process, although I do not discount aural considerations playing a part. When selecting these services, the average consumer is likely to consider such things as stock, price of goods offered in comparison to other retailers and delivery method (for online retail only).

43. In respect of both the goods and the services at issue, I conclude that the average consumer is likely to pay a medium degree of attention during the selection process.

### **Distinctive character of the earlier marks**

44. 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).”

45. Registered trade marks possess various 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. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

46. The applicant's evidence in relation to the second earlier mark relates to airline services only. As these are not being relied upon for the purposes of the application based upon section 5(2)(b), enhanced distinctive character in relation to these services will not assist the applicant. No evidence has been filed to suggest that the second earlier mark has become highly distinctive for the goods and services in issue. Equally, there is no evidence to suggest that the first, third and fourth earlier marks have become more distinctive through use in relation to the goods in issue. Therefore, I have only the inherent position to consider.
47. The first, second and fourth earlier marks are word only marks, being EASYGROUP, EASYJET and EASYPIZZA respectively. These marks consist of two recognisable dictionary words which are conjoined. The word 'EASY' will be seen as descriptive of the nature of the goods and services to which they relate, in that they are easy to use. The word 'EASY' will have a low level of distinctive character. The word 'GROUP' in the first earlier mark cannot be said to be descriptive of the goods and services to which it relates. Given that the applicant is not relying on its airline services, the word 'JET' in the second earlier mark cannot be said to be descriptive of the goods and services at issue. However, 'PIZZA' in the fourth earlier mark is descriptive of some of the goods for which it is registered. The inherent distinctive character of these marks lies in the combination of the words as a whole. Overall, I find that the first, second and fourth earlier marks have between a low and medium degree of inherent distinctive character.
48. The third earlier mark is made up of the word 'easyFoodstore' displayed in a white, slightly stylised typeface on an orange background. The word 'easy' will have the same impact as in the first, second and fourth earlier marks. The word 'Foodstore' will be descriptive of the services for which it is registered. The font and use of colour in the third earlier mark will contribute slightly to the distinctive character of the mark. Overall, I consider that the third earlier mark has no more than a medium degree of distinctive character.



## Comparison of marks

49. It is clear from *Sabel 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.

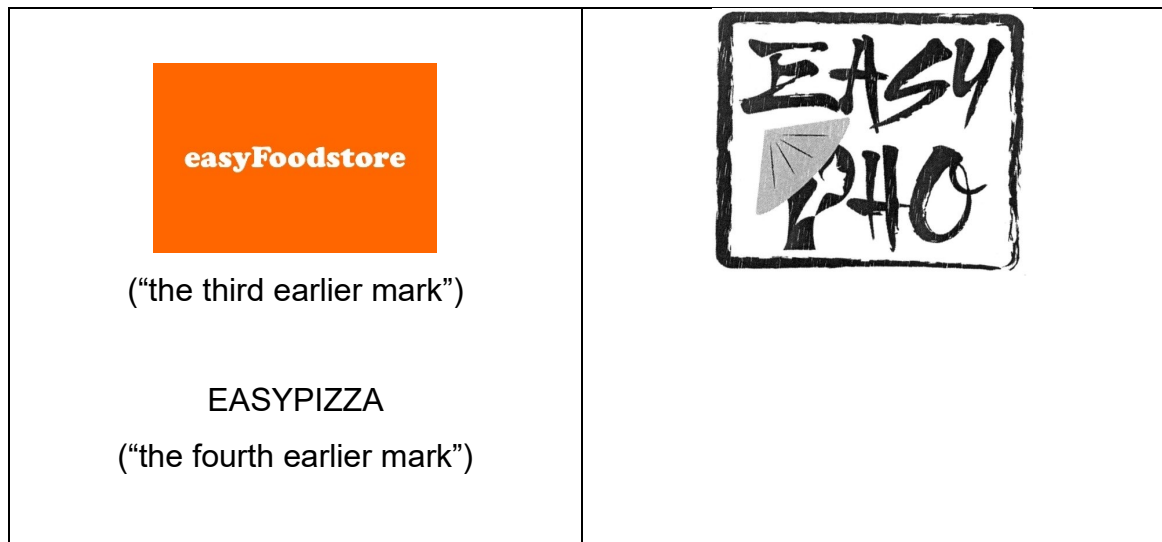
50. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... 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.”

51. 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.

52. The respective trade marks are shown below:

The earlier marks	The contested mark
EASYGROUP ("the first earlier mark")  EASYJET ("the second earlier mark")	



53. The applicant submits:

“4. The holder’s mark and the applicant’s earlier marks all contain the phonetically identical word element ‘easy’, which appears at the beginning of both marks.

5. The case law (*Flex*) suggests that consumers are in the habit of paying greater attention to the beginning of marks than to the end of marks. As the respective beginnings of the marks are identical, this increases the likelihood of them being confused.

6. The marks EASY PHO, easyFoodstore and easyPizza, all have similar meanings and ‘feels’: the prefix easy and a word allusive of or describing foodstuffs.

7. In the case of easyPizza, the first five letters of the marks are identical.

8. Overall, the marks are similar.”

## Overall Impression

### *The contested mark*

54. The contested mark consists of a number of components. The first, is the words 'EASY PHO' presented in a stylised, black typeface. The second component is a square, stylised border presented in black. The final component is a lady's head wearing a traditional conical hat that is incorporated into the letter 'P' of 'PHO'. The lady's head is presented in white and the conical hat is in grey. I am of the view that the eye will be drawn to the part of the mark that can be read. As a result, I find that the word 'EASY PHO' plays the greater role in the overall impression of the mark with the device elements, border and the stylisation of the words playing a lesser role.

### *The earlier marks*

55. The first, second and fourth earlier marks are word only marks. While these marks are conjoined, I think it is clear that they will be perceived as two recognisable dictionary words. I, therefore, consider that the overall impression of these marks lies in the combination of these words.

56. The third earlier mark is 'easyFoodstore' displayed in a white, slightly stylised font on an orange background. Overall, I find that the overall impression of the third earlier mark will be dominated by the conjoined words 'easyFoodstore', with the colour and stylisation elements playing a lesser role.

## Visual Comparison

### *The first, second and fourth earlier marks and the contested mark*

57. Visually, all four marks start with the word 'EASY'. As a general rule, the beginnings of marks tend to have more impact than the ends.<sup>4</sup> The marks differ in the second words used. The marks also differ in that 'EASY PHO' is presented in a stylised

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<sup>4</sup> El Corte Ingles, SA v OHIM, Cases T-183/02 and T-184/02

font whereas the earlier marks are word only marks. There are additional differences in that the device element, being the lady with a hat and the stylised border elements. While these will play a lesser role in the overall impression of the contested mark, they will still constitute a visual difference. I also note that the first, second and fourth earlier marks are word only marks and can be used in any standard typeface. Overall, I find that the marks are similar to between a low and medium degree.

#### *The third earlier mark and the contested mark*

58. Visually, these marks share the same similarities and differences that I have highlighted at paragraph 57 above. However, they will differ further in that the word element of the third earlier mark is displayed as 'easyFoodstore'. It is also displayed in a slightly stylised font that is presented in white on an orange background. Overall, I find that the marks are similar to a low degree.

#### Aural Comparison

59. Aurally, the earlier marks will be broken down into their two respective dictionary words. The word 'easy' will be pronounced identically in all marks with the differences coming in the second words, which share no aural similarity. Overall, I consider there to be a medium degree of aural similarity between the marks.

#### Conceptual Comparison

60. The word 'PHO' in the contested mark may be recognised by some average consumers as a type of Vietnamese noodle dish or, more likely, will be viewed as a foreign language word with no obvious meaning. I have no evidence before me to suggest that a significant proportion of average consumers would understand 'PHO' to mean the former. Consequently, I am unable to make such a finding. I consider that the word PHO will be viewed as a foreign language word with no particular meaning. I find that it will be conceptually neutral, whereas the words GROUP, JET, Foodstore and PIZZA will have clearly identifiable meanings.

61. The remaining shared elements between the marks is the concept of 'EASY', which will be seen as descriptive of the nature of the goods and services offered, in that they are easy to use. Any conceptual similarity arising from the word 'EASY' is not, prima facie, a distinctive conceptual similarity due to its descriptive nature. As a result, any conceptual similarity between the marks will be low at best.

### **Likelihood of confusion**

62. 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 earlier marks, the average consumer for the goods and 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.

63. I have found the contested mark's goods to be identical with the goods in the first and fourth earlier mark's specifications. However, while I have found some of the contested mark's goods to be identical with the goods contained in the second and third earlier mark's specification, I have found some to be similar to a medium degree. I have concluded that the average consumer is a member of the general public who will purchase the goods by primarily visual means, but I do not discount that an aural component will play a part. I have also concluded that the level of attention paid will be medium. I have found the first, second and fourth earlier marks to have between a low and medium degree of inherent distinctive character,

whereas the third earlier mark has no more than a medium degree of inherent distinctive character.

64. I have found that the first, second and fourth earlier marks and the contested mark are visually similar to between a low and medium degree, aurally similar to a medium degree and conceptually similar to no more than a low degree. I have found that the third earlier mark and the contested mark are visually similar to a low degree, aurally similar to a medium degree and conceptually similar to no more than a low degree. I have taken these factors into account in my assessment of the likelihood of confusion between the marks.

65. Taking all of the above factors and the principle of imperfect recollection into account, I consider that the visual and aural difference between the marks are sufficient to ensure that they will not be misremembered or mistakenly recalled as each other. Consequently, I am satisfied that there is no likelihood of direct confusion between the marks, even on goods that I have found to be identical.

66. 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.”

67. I note that the applicant has referred to its ‘family of marks’ argument. This line of argument is one that needs to be specifically pleaded by the applicant and, in this case, the pleading was only made in relation to the applicant’s 5(3) case. However, for the sake of completeness, I will address this point here. I refer to the case of *Ponte Finanziaria SpA v OHIM*, Case C-234/06, wherein the CJEU stated that in order for a family of marks argument to succeed, the trade marks that make up the ‘family’ must be present on the market.

68. While I note that the third and fourth earlier marks are mentioned in passing in the applicant’s evidence, the only sufficient evidence I have in relation to any of the earlier marks being present on the market is in relation to the first and second earlier marks, being EASYGROUP and EASYJET, respectively. While this may be the case, I note that there is no evidence to suggest that they were on the market in respect of the goods or services at issue. Further, I do not consider that the applicant has established that the public would expect any mark with the ‘easy’ prefix and a descriptive suffix to be connected to the applicant. In any event, the presence of two marks on the market does not constitute a ‘family of marks’. Consequently, this line of argument is dismissed.

69. I bear in mind that a finding of indirect confusion should not be made merely because the two marks share a common element. It is not sufficient that a mark merely calls to mind another mark. This is mere association, not indirect confusion.<sup>5</sup> Further, it is clear from the judgment of the CJEU in *Lloyd* (cited above), that descriptive matter should be given less weight when comparing trade marks. The common element of the marks, being EASY, is descriptive of the nature of the goods and services of the respective marks and I do not consider this to be sufficient to cause the average consumer to believe the marks are provided by the same or an economically connected undertaking. The distinctiveness of the earlier marks lies in the combination of the words, rather than in the word ‘easy’ by itself. It is my view that the average consumer is likely to assume that the use of the common element ‘EASY’ is a coincidence due to its descriptive nature, rather than there being a connection between the undertakings responsible for the marks.

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<sup>5</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

Taking all of the above factors into account, I do not consider there to be a likelihood of indirect confusion between the marks, even on goods that are identical.

### **Section 5(3)**

70. I note that, within its submissions dealing with the section 5(3) grounds, the applicant has referred to various marks within the easy brand of marks. However, the applicant has only relied on the second earlier mark in respect of its section 5(3) application and this will be the only mark considered.

71. 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*, Case C-323/09, *Marks and Spencer v Interflora*, Case C383/12P, *Environmental Manufacturing LLP v OHIM*. 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* and *Environmental Manufacturing, paragraph 34*.

(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 holder 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

72. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

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

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

73. I note that within its evidence, the applicant has shown that, since 1995, millions of passengers have flown with easyJet. Of its evidence, I note the following:

- a. easyJet launched its first routes in November 1995 from London Luton to Edinburgh and Glasgow;
- b. between 1 February 2016 and 31 January 2017 alone, easyJet had 74,921,296 passengers;
- c. the easyJet website has been visited by 3,797,300,717 users from UK;

- d. in 2016, the easyJet brand had a total revenue of £4,669 million;
- e. the applicant operates its easyJet brand across 31 European countries;
- f. of the 19 routes discussed by Sir Haji-Ioannou in his statement that easyJet launched since 10 November 1995, 18 of them fly to or from locations from throughout the UK;
- g. easyJet was the subject of a television series that was broadcast in the UK, which, at its peak, attracted about 9 million viewers in 2001;
- h. easyJet operates out of ten airports in the UK, including Bristol and London Luton;
- i. the UK is easyJet's biggest market; and
- j. in terms of passengers, easyJet is the UK's biggest airline.

74. The evidence referred to above relates to the longevity of the use of the second earlier mark in the UK (being as early as 1995). The evidence also shows the significant turnover and passenger figures of the easyJet brand. Finally, the evidence shows widespread geographical use of the easyJet brand throughout the UK, with bases in London Luton and Bristol. It also demonstrates flights either to or from locations such as Liverpool, Scotland and Northern Ireland. Whilst I note that the evidence does not confirm any advertising/promotional expenditure in relation to the second earlier mark, it is clear that such activity has taken place, particularly in light of the television series that ran for a number of years on UK television. Overall, I am satisfied that the second earlier mark had a strong reputation in the UK at the relevant date in relation to airline services. However, I am not satisfied that the applicant's evidence has established a reputation in relation to the other services covered by the applicant's second mark.

## **Link**

75. As 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.

I have found above that the marks are visually similar to between a low and medium degree, aurally similar to a medium degree and conceptually similar to no more than a low degree.

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.

The services upon which the applicant now relies are its class 39 services as set out in paragraph 5 above. While there will be some overlap in user in that members of the general public may use both, I do not consider there to be any overlap in nature, purpose or method of use. There is no overlap in trade channels. There is, quite clearly, a wide disparity between airline services on the one hand and instant noodles/porridge on the other. Given that the overlap in user is at a very general level, I do not consider this enough to warrant a finding of similarity. Consequently, there is no similarity between the contested mark's goods and the services upon which the applicant now relies.

The strength of the earlier mark's reputation

The second earlier mark has a strong reputation in relation to airline services.

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

Due to the fact that 'easy' is a natural way of designating goods and services that are easy to use, I find that the word itself is inherently low in distinctive character. The word that is combined with 'easy' in the second earlier mark is JET, which is allusive of the services upon which the applicant now relies. The inherent distinctive character of the mark lies in the combination of the words 'EASYJET'. I consider that the second earlier mark has between a low and medium degree of inherent distinctive character.

It is the applicant's case that the second earlier mark, particularly the 'EASY' prefix, has become more distinctive through use. While I accept that EASYJET is highly distinctive for airline services, I do not accept that there is sufficient evidence to find that it is highly distinctive for any other goods or services for which it is registered.

While the second earlier mark is highly distinctive, I find that the prefix, being 'EASY', is descriptive and has not been shown to be highly distinctive on its own.

#### Whether there is a likelihood of confusion

Given the distance between the respective goods and services and the low level of distinctiveness of the common element 'easy', I see no risk of a likelihood of confusion on the part of the relevant public.

76. Taking into account all of the above factors, in particular the low level of distinctiveness of the common element of the marks and the significant distance between the contested mark's goods and the second earlier mark's services, I find that despite the strength of the first earlier mark's reputation, the relevant public is unlikely to make a link between the parties' marks. Consequently, the application for invalidity under section 5(3) must fail.

77. For the avoidance of doubt, in reaching this conclusion I have taken the applicant's 'family of marks' argument into account. However, I have dismissed this line of argument. In addition to those reasons set out above, in relation to its 5(3) claim, the applicant relies upon the second earlier mark only which cannot, on its own, constitute a family of marks.

78. If I am wrong in my finding that consumers would not have made a link between the marks, I would still have rejected the section 5(3) ground. My reasons follow.

#### **Damage**

79. The applicant has pleaded that use of the contested mark by the holder would take unfair advantage of the significant reputation of the second earlier mark, that it

would, without due cause, prove to be detrimental to the significant reputation of the applicant and that it would, without due cause, prove detrimental to the distinctive character of the second earlier mark. I will deal with each head of damage in turn below.

### Unfair Advantage

80. Taking advantage of the distinctive character or reputation of an earlier mark means that consumers are more likely to buy the goods/services of the later mark than they would otherwise have been if they had not been reminded of the earlier mark. Essentially, the later mark will get a marketing or commercial 'leg-up' as a result of the link with the earlier mark and, as a result, will not have to put in as much effort in marketing the later mark because it already feels familiar to the relevant public or sends a message to consumers about what they can expect. Unfair advantage has no effect on the consumers of the earlier mark.

81. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

82. I am not persuaded by the applicant's claim that the holder would benefit from the reputation of the applicant's services in respect of its own goods, being "instant noodles", "instant porridge", "soft instant noodle" and "instant noodle with seasoned and saute beef". Even if the applicant's claim to providing customer-friendly goods and services at competitive prices was established, I do not consider that it would be usual for the provider on airline services to expand into the field of instant noodles or instant porridge. It is, therefore, unlikely that any commercial advantage would be gained by the holder. In addition, the applicant has not filed any evidence, nor has it made any persuasive submissions, which would enable me to identify how the transfer of any image in relation to airline services would be of benefit to the holder for its goods. I see no obvious way in which there would be an unfair advantage. This head of damage is, therefore, rejected.

#### Detriment to Repute

83. Detriment to repute, or 'tarnishing', is a reduction in the attractive power of the earlier mark caused by the use of the later mark. As explained in the case *L'Oreal* (cited above), tarnishment may arise either when the later mark itself creates negative association or where the goods and/or services on which it is used are incompatible with the image of the earlier mark.

84. The applicant has submitted that the second earlier mark has a significant reputation for providing customer-friendly goods and services at competitive prices and that the contested mark may not match that of the applicant, therefore, reducing the power of attraction of the second earlier mark. Firstly, while the applicant's second mark has a reputation for airline services, I have no evidence to show its reputation for 'providing customer-friendly goods and services at competitive prices'. Secondly, the argument that there is a mere potential that poor-quality goods or services sold under a later mark would tarnish the earlier mark was rejected by Ms Anna Carboni, sitting as the Appointed Person, in the case of *Unite the Union v The Unite Group PLC*, Case BL O/219/13. Without any evidence or persuasive submissions, this head of damage is dismissed.

## Detriment to Distinctive Character

85. In *Environmental Manufacturing LLP v OHIM*, Case C-383/12P, the CJEU stated that:

“34. According to the Court’s case-law, proof that the use of the later mark is, or would be, detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered, consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future (*Intel Corporation*, paragraphs 77 and 81, and also paragraph 6 of the operative part of the judgment).”

86. It went on:

“Admittedly, Regulation No 207/2009 and the Court’s case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.

43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on ‘an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case’.”

87. While the second earlier mark has a strong reputation, given the weakness of the ‘EASY’ element, I do not accept that the coincidence of both marks containing this word would present a serious risk of a change in the economic behaviour of the applicant’s customers. Further, the case law set out above states that a claim of detriment to distinctive character requires evidence of a change in the economic behaviour of the average consumer of the services for which the second earlier mark is registered. The applicant has not filed any evidence that shows a change in the economic behaviour of the applicant’s customers or that there is a serious



likelihood of such change. Given the distance between the respective goods and services, it is difficult to envisage circumstances in which the economic behaviour of the applicant's customers would be affected by the use of the contested mark. Therefore, this head of damage is rejected.

## **CONCLUSION**

88. The application for invalidity fails in its entirety and the contested mark will remain registered for all goods.

## **COSTS**

89. The holder has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016.

90. In the circumstances, I award the holder the sum of £700 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparation a counterstatement and considering the applicant's statement:	£200
Considering the applicant's evidence:	£500
<b>Total:</b>	<b>£700</b>

91. I therefore order easyGroup Limited to pay Cong Ty Co Phan Thuc Pham Thien Huong (Thien Huong Food JSC.) the sum of £700. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 16th day of November 2020**

**A COOPER**  
**For the Registrar**

## **Annex**

### The first earlier mark

Class 30: Coffee; tea, cocoa, artificial coffee; sugar; rice; tapioca, sago, flour and preparations made from cereals; bread, pastry and confectionery; ices; honey; treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice; fruit sauces; baked goods, namely, muffins, scones, biscuits, cookies, pastries, pies, pasties and breads, sandwiches and granola; snack foods; prepared meals; ice cream, frozen confectionery; chocolate, candy and confections.

Class 35: Retail services connected with the sale of food and drinks.

Class 43: Services for providing food and drinks; restaurant, bar and catering services; booking and reservation services for restaurants and holiday accommodation; management of hotels and restaurants.

### The second earlier mark

Class 29: Meat, fish, poultry and game; meat extracts; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; canned meat and fish.

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

Class 31: Fresh fruits, seeds; nuts.

Class 32: Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages.

Class 33: Alcoholic beverages; wines; spirits and liqueurs; cocktails.

Class 35: Retail services connection with the sale of food and drink.

Class 43: Services for providing food and drink; restaurant, bar and catering services.

The third earlier mark

Class 29: Meat, fish, poultry and game; meat extracts; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; meat products; sausages; fruit preserves; canned fruits; canned meat; canned fish; desserts; yoghurts; nuts and nut butters; pickles plant extracts for foods.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals. bread. pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; chocolate; chocolate products; candy; biscuits; rookies; cakes; ice cream; syrup, treacle, molasses; ketchup; sauces and preparations for making sauces; custard powder; mousses; desserts; puddings; pepper, mustard; vinegar, chutney; spices and seasonings; mayonnaise; natural sweetener; salad dressings.

Class 31: Fresh fruits; foodstuffs for animals.

Class 32: Beers; Mineral and aerated waters and other non-alcoholic beverages; Fruit beverages and fruit juices; syrups and other preparations for making beverages.

Class 33: Alcoholic beverages.

Class 35: Retail services connected with the sale of drink, meat, fish, poultry and game, meat extracts, preserved, frozen, dried and cooked fruits, jellies, jams, compotes, eggs, milk and milk products, edible oils and fats, meat products, sausages, prepared meals, fruit preserves, canned fruits, canned meat, canned fish, desserts. yoghurts, nuts and nut butters,

pickles plant extracts for foods, soups, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking-powder, salt, mustard, vinegar. sauces (condiments), spices, ice, sandwiches, prepared meals, filled sandwiches, pizzas, pies and pasta dishes, chocolate, chocolate products, candy, biscuit, cookies, cakes, ice cream, syrup, treacle, molasses, ketchup, sauces and preparations for milking sauces, custard powder, mousses, desserts, puddings, pepper, mustard, vinegar, chutney, spices and seasonings, mayonnaise, natural sweetener, salad dressings, fresh fruits and vegetables, foodstuffs for animals, beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages, alcoholic beverages, foods and drinks.

#### The fourth earlier mark

Class 29: Jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; meat products; sausages; prepared meals; snack foods; fruit preserves; canned fruits; canned vegetables; canned meat; canned fish; yoghurts; nuts and nut butters; pickles; plant extracts for foods; soups; potato crisps.

Class 30: Coffee, tea, cocoa, sugar, rice, tapiocas., sago, artificial coffee; bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt. mustard; vinegar, sauces (condiment); spices; ice; sandwiches; prepared meals; filled sandwiches; pizzas, pies and pasta dishes; chocolate; chocolate products; candy; biscuits; cookies; cakes; ice cream; ketchup; sauces and preparations for making sauces; custard powder; mousses; desserts; puddings; pepper, mustard; vinegar; chutney; spices and seasoning; mayonnaise; natural sweetener; salad dressings; desserts

Class 35: Retail services connected with the sale of jellies, jams, compotes, milk and milk products, desserts, yoghurts, nuts and nut butters, soups, potato crisps, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, bread, pastry and confectionery, ices, honey, treacle, yeast, ice, sandwiches, filled sandwiches, chocolate, chocolate products, candy, biscuit, cookies, cakes, ice cream, syrup, molasses, custard powder, mousses, desserts, puddings, chutney, natural sweetener, salad dressings, foodstuffs for animals, beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages, alcoholic beverages, foods and drinks.