

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 2231569
IN THE NAME OF EASYROOMS LTD
OF THE TRADE MARK:**



**AND THE APPLICATION FOR A DECLARATION OF INVALIDITY
THERE TO UNDER NO. 80155
BY EASYGROUP IP LICENSING LIMITED**

**Trade Marks Act 1994
in the matter of registration No. 2231569
in the name of Easyrooms Ltd
of the trade mark:**



**and the application for a declaration of invalidity thereto under No. 80155
by easyGroup IP Licensing Limited**

Background

1) On 23 November 2001 easyGroup IP Licensing Limited (easyGroup) filed an application to have the above trade mark declared invalid. The trade mark was filed on 6 May 2000 and registered on 27 October 2000 in respect of the following services:

travel insurance;

telecommunications services; Internet communications services;

organising of transport and of travel by air, land and sea; organising of holiday travel services;

booking of temporary accommodation;

The above services are in classes 36, 38, 39 and 42 of the International Classification of Goods and Services respectively.

2) easyGroup states that it is the owner by way of assignment in the United Kingdom and the European Union of the following trade marks:

EASYJET

United Kingdom registration no 2016785 in respect of:

Printed matter and publications; books, manuals, pamphlets, newsletters, albums, newspapers, magazines and periodicals; tickets, vouchers, coupons and travel documents; identity cards; labels and tags; posters, postcards, calendars, diaries, photographs, gift cards and greetings cards; teaching and instructional materials – class 16

Transportation of goods, passengers and travellers by air; arranging of transportation of goods, passengers and travellers by land and sea; airline and shipping services; cargo handling and freight services; arranging, operating and providing

facilities for cruises, tours, excursions and vacations; ambulance services; rental and hire of vehicles, boats and aircraft; travel agency and tourist office services; consultancy and advice relating to all the aforesaid services – class 39

Temporary accommodation; catering, hotel, restaurant, cafe and bar services; reservation services for hotel accommodation; provision of exhibition facilities; meteorological information services; hairdressing, grooming and beauty salon services – class 42

EASYTRAIN

United Kingdom registration no 2112957 in respect of:

Transportation of goods, passengers and travellers by land; arranging of transportation of goods, passengers and travellers by land; arranging, operating and providing facilities for tours, excursions and vacations; travel agency and tourist office services; consultancy and advice relating to all the aforesaid services – class 39

EASYBUS

United Kingdom registration no 2112956 in respect of:

Transportation of goods, passengers and travellers by land; arranging of transportation of goods, passengers and travellers by land; coach services; arranging, operating and providing facilities for tours, excursions and vacations; travel agency and tourist office services; consultancy and advice relating to all the aforesaid services – class 39

**easyTrak/
EASYTRAK**
(series of two)

United Kingdom registration no 2168662 in respect of:

Printed matter and publications; books, manuals, pamphlets, newsletters, albums, newspapers, magazines and periodicals; tickets, vouchers, coupons and travel documents; identity cards; labels and tags; posters, postcards, calendars, diaries, photographs, gift cards and greetings cards; teaching and instructional materials; all relating to travel – class 16

Transportation of goods, passengers and travellers by air; arranging of transportation of goods, passengers and travellers by land and sea; airline and shipping services; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; ambulance services; rental and hire of vehicles, boats and aircraft; travel agency and tourist office services; consultancy and advice relating to all the aforesaid services – class 39

Temporary accommodation; catering, hotel, restaurant, cafe and bar services; reservation services for hotel accommodation; provision of exhibition facilities; meteorological information services; hairdressing, grooming and beauty salon services – class 42

**easyWeb/
EASYWEB**
(series of two)

United Kingdom registration no 2168668 in respect of:

Printed matter and publications; books, manuals, pamphlets, newsletters, albums, newspapers, magazines and periodicals;

tickets, vouchers, coupons and travel documents; identity cards; labels and tags; posters, postcards, calendars, diaries, photographs, gift cards and greetings cards; teaching and instructional materials; all relating to travel – class 16

Transportation of goods, passengers and travellers by air; arranging of transportation of goods, passengers and travellers by land and sea; airline and shipping services; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; ambulance services; rental and hire of vehicles, boats and aircraft; travel agency and tourist office services; consultancy and advice relating to all the aforesaid services – class 39

Temporary accommodation; catering, hotel, restaurant, café and bar services; reservation services for hotel accommodation; provision of exhibition facilities; meteorological information services; hairdressing, grooming and beauty salon services – class 42

**easyExtras/
EASYEXTRAS**
(series of two)

United Kingdom registration no 2168672 in respect of:

Printed matter and publications; books, manuals, pamphlets, newsletters, albums, newspapers, magazines and periodicals; stationery; tickets, vouchers, coupons and travel documents; identity cards; labels and tags; posters, postcards, calendars, diaries, photographs, gift cards and greetings cards; teaching and instructional materials; travel documents folders; travel guide books; travellers cheques – class 16

Travel luggage, travel bags; travel garment covers; travellers bags made from leather or imitation leather, travelling sacks and handbags – class 18

Insurance services – class 36

Transportation of goods, passengers and travellers by air; arranging of transportation of goods, passengers and travellers by land and sea; bus transport services, car transport services, coach services; airline and shipping services; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; ambulance services; rental and hire of vehicles, boats and aircraft; travel agency and tourist office services; consultancy and advice relating to all the aforesaid services – class 39

Temporary accommodation; catering, hotel, restaurant, café and bar services; reservation services for hotel accommodation; provision of exhibition facilities; meteorological information services; hairdressing, grooming and beauty salon services – class 42

easyExtras

Community trade mark registration no 848424 in respect of:

Printed matter and publications; books, manuals, pamphlets, newsletters, albums, newspapers, magazines and periodicals;

stationery; tickets, vouchers, coupons and travel documents; identity cards; labels and tags; posters, postcards, calendars, diaries, photographs, gift cards and greetings cards; teaching and instructional materials; travel documents folders; travel guide books; travellers cheques – class 16

Travel luggage, travel bags; travel garment covers; travellers bags made from leather or imitation leather, travelling sacks and handbags – class 18

Insurance services – class 36

Transportation of goods, passengers and travellers by air; arranging of transportation of goods, passengers and travellers by land and sea; bus transport services; car transport services; coach services; airline and shipping services; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; ambulance services; rental and hire of vehicles, boats and aircraft; travel agency and tourist office services; consultancy and advice relating to all the aforesaid services – class 39

Temporary accommodation; catering, hotel, restaurant, café and bar services; reservation services for hotel accommodation; provision of exhibition facilities; meteorological information services; hairdressing, grooming and beauty salon services – class 42

EASYCAFÉ

Community trade mark registration no 931790 in respect of:

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies; jams, fruit sauces; eggs, milk and milk products; edible oils and fats; prepared meals – class 29

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; prepared meals – class 30

Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages – class 32

Alcoholic beverages (except beer) – class 33

Business information services – class 35

Telecommunication services – class 38

Restaurant and bar services; catering services; design of computer software; provision of access to computers and the internet; internet services; provision of on-line services – class 42

EASY EVERYTHING

United Kingdom registration no 2182641 in respect of:

Restaurant and bar services; catering services; design of

<p>easycard/ EASYCARD (series of two)</p>	<p>computer software; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; hosting, creating and maintaining web sites for others; leasing access time to a computer data base – class 42</p> <p>United Kingdom registration no 2184827A in respect of: Clothing; headgear; footwear – class 25</p> <p>Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies; jams, fruit sauces; eggs, milk and milk products; edible oils and fats; prepared meals – class 29</p> <p>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; prepared meals – class 30</p> <p>Beers; mineral and aerated water and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages – class 32</p> <p>Alcoholic beverages (except beer) – class 33</p>
<p>easycard/ EASYCARD (series of two)</p>	<p>United Kingdom application no 2184827B in respect of: Computer software; computer hardware; pre-recorded CD Roms and other disk carriers; sunglasses – class 9</p> <p>Business information services – class 35</p> <p>Telecommunication services – class 38</p> <p>Restaurant and bar services; catering services; design of computer software; provision of access to computers and the Internet; Internet services; provision of on-line services – class 42</p>
<p>easyPay/ EASYPAY (series of two)</p>	<p>United Kingdom registration no 2184833A in respect of: Clothing; headgear; footwear – class 25</p> <p>Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies; jams, fruit sauces; eggs, milk and milk products; edible oils and fats; prepared meals – class 29</p> <p>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; prepared meals – class 30</p> <p>Beers; mineral and aerated water and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages – class 32</p> <p>Alcoholic beverages (except beer) – class 33</p>
<p>easyPay/ EASYPAY (series of two)</p>	<p>United Kingdom trade mark application no 2184827B in respect of: Computer software; computer hardware; pre-recorded CD</p>

Roms and other disk carriers; sunglasses – class 9
Business information services – class 35
Telecommunication services – class 38
Restaurant and bar services; catering services; design of computer software; provision of access to computers and the Internet; Internet services; provision of on-line services – class 42

**easyMoney/
EASYMONEY**
(series of two)

United Kingdom registration no 2184834 in respect of:
Computer software; computer hardware; pre-recorded CD Roms and other recorded computer programs; sunglasses – class 9

Clothing; headgear; footwear. Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies; jams, fruit sauces; eggs, milk and milk products; edible oils and fats; prepared meals – class 29
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; prepared meals – class 30

Beers; mineral and aerated water and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages – class 32

Alcoholic beverages (except beer) – class 33

Business information services – class 38

Telecommunication services – class 38

Restaurant and bar services; catering services; design of computer software; provision of access to the Internet; computers, design, drawing and commissioned writing, all for the compilation of web pages on the Internet; information provided on-line from a computer database or from the Internet; Internet services and on-line access services relating to financial and insurance affairs – class 42

**easyJet. the web's
favourite airline**

Community trade mark registration no 1132596 in respect of:
Transportation of goods, passengers and travellers by air; airport check-in services; arranging of transportation of goods, passengers and travellers by land; airline services; baggage handling services; cargo handling and freight services; operating and providing facilities for tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft; aircraft parking services; travel agency and tourist office services; advisory and information services relating to the aforesaid services; information services relating to transportation services, including information services provided on-line from a computer database or the internet – class 39

easyTech

Information relating to entertainment and education, provided on-line from a computer database or the Internet; entertainment services provided on-line from a computer database or the Internet; educational information provided on-line from a computer database or the Internet – class 41

Community trade mark registration no 1128743 in respect of: Vehicles; apparatus for locomotion by land, air or water; aircraft; parts and fittings for the aforesaid goods included in class 12.

Aircraft repair and maintenance services, aircraft cleaning services, aircraft washing services – class 37

Transportation of goods, passengers and travellers by air; airport check-in services; arranging of transportation of goods, passengers and travellers by land; airline services; baggage handling services; cargo handling and freight services; operating and providing facilities for tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft; aircraft fuelling services, aircraft parking services, travel agency and tourist office services; advisory and information services relating to the aforesaid services – class 39

**easyKiosk/
easy kiosk/
EASY KIOSK/
EASYKIOSK
(series of four)**

United Kingdom registration no 2198933 in respect of:

Printed matter, books, publications, brochures, postcards, menus, catalogues, diaries, promotional and advertising material, wrapping and packaging material, stationery, writing instruments, calendars, posters, photographs, greetings cards, bags, badges, instructional and teaching materials, playing cards, labels, magazines, newsletters, tickets, leaflets, writing paper, goods made of cardboard, manuals, pamphlets, albums, newspapers, periodicals, vouchers, coupons and travel documents, identity cards, tags, gift cards, travel document folders, travel guide books, travellers cheques – class 16

Catering for the provision of food and drink; bar, catering, café and restaurant services; in-flight and airport catering services – class 42

easyKiosk

Community trade mark registration no 1196138 in respect of:

Printed matter, books, publications, brochures, postcards, menus, catalogues, diaries, promotional and advertising material, wrapping and packaging material, stationery, writing instruments, calendars, posters, photographs, greetings cards, bags, badges, instructional and teaching materials, playing cards, labels, magazines, newsletters, tickets, leaflets, writing paper, goods made of cardboard, manuals, pamphlets, albums, newspapers, periodicals, vouchers, coupons and travel documents, identity cards, tags, gift cards, travel document folders, travel guide books, travellers cheques - class 16

Catering for the provision of food and drink; bar, catering, café

EASYJET

and restaurant services; in-flight and airport catering services – class 42

Community trade mark application no 1232909 in respect of:
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 and rinses; tooth cleaning preparations; depilatory preparations; sun-screening and tanning preparations; anti-perspirants deodorisers and deodorants; cotton wool; essential oils; preparations and substances for use in massage and aromatherapy – class 3

Electric, electronic, communications, photographic, measuring, signalling, checking, scientific, optical, nautical, life-saving and surveying apparatus and instruments; computer software, hardware and firmware; computer games software; apparatus, instruments and media for recording, reproducing, carrying, storing, processing, manipulating, transmitting, broadcasting and retrieving publications, text, signals, software, information, data, code, sounds, and images; audio and video recordings; audio recordings, video recordings, music, sounds images, text, publications, signals, software, information, data and code provided via telecommunications networks, by online delivery and by way of the Internet and world wide web; sound and video recordings; sound and video recording and playback machines; coin freed apparatus; arcade games; televisions and television game apparatus and instruments; photographic and cinematographic films prepared for exhibition; photographic transparencies; non-printed publications; educational and teaching apparatus and instruments; electronic, magnetic and optical identity and membership cards; sunglasses and sunvisors; protective clothing and headgear; parts and fittings for all the aforesaid goods – class 9

Printed matter and publications; wrapping and packaging; books, manuals, pamphlets, newsletters, albums, newspapers, magazines and periodicals; tickets, vouchers, coupons and travel documents; identity cards; labels and tags; posters, postcards, calendars, diaries, photographs, gift cards and greeting cards; teaching and instructional materials – class 16

Leather and imitations of leather; goods made of leather or imitations of leather; skins and hides; trunks bags and travelling bags; purses, wallets, pouches and handbags; luggage; sports bags; bike bags; backpacks; umbrellas and parasols; harness and saddlery; parts and fittings for all the aforesaid goods – class 18

Clothing; headgear; footwear – class 25
Prepared meals; snacks and snack foods – classes 29 and 30
Mineral and aerated waters; beers; non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages – class 32
Alcoholic drinks (except beer); wines, spirits, liqueurs and cocktails – class 33
Cigarettes, cigars, snuff, tobacco, tobacco products, smokers' articles, lighters, matches – class 34
Provision of access to the Internet; Internet services – class 38
Transportation and storage; transportation of goods, passengers and travellers by land, sea and air; airline and shipping services; cargo and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; ambulance services; rental and hire of vehicles, boats and aircraft; travel agency and tourism services – class 39
Rental of electric and electronic goods, clothing, toys, games and playthings – class 41
Temporary accommodation; provision of food and drink; catering; hotel, restaurant, cafe and bar services; hotel management and reservation services; non-business professional consultancy; providing facilities for exhibitions and conferences; meteorological information services; hairdressing; grooming and beauty salon services; physical, mental and emotional health-care and well-being services; counselling; nursery, kindergarten and creche; services consultancy, advice, assistance, analysis, design, evaluation and programming services relating to computer software, firmware, hardware and information technology; provision of access to computers; on-line services; consultancy and advice relating to the evaluation, choosing and implementation of computer software, firmware, hardware, information technology and of data-processing systems; rental and licensing of computer software, firmware and hardware; provision of information relating to technical matters, legal matters, information technology, and intellectual property, including that provided via telecommunications networks, by online delivery and by way of the Internet and the World Wide Web; consultancy and advice relating to travel services – class 42



(series of four)

The applicant claims the colours black on white as an element of the first mark in the series, white on black as an element of the second mark, orange on white as an element of the third mark and white on orange as an element of the fourth mark.



White wording on orange background

United Kingdom registration no 2202916 in respect of:

Restaurants and bar services; catering services; design of computer software; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; hosting, creating and maintaining web sites for others; leasing access time to a computer data base – class 42

Community trade mark registration no 1243948 in respect of:

Computer software; computer hardware; pre-recorded CD Roms and other disk carriers; sunglasses – class 9

Business information services; on-line processing of mail orders – class 35

Provision of access to information on-line from the Internet; providing access to a wide range of general interest information via computer networks; providing on-line access to news, weather, sports, current events and reference materials; computer bulletin and message boards in fields of general interest; linking to web sites of others; providing multiple-user access to computer networks for the transfer and dissemination of a wide range of information – class 38

On-line contests and sweepstakes – class 41

Restaurant and bar services; catering services; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; creating and maintaining web-sites; hosting the web sites of others; consulting and technical assistance in the fields of designing, creating, hosting, maintaining, operating, managing, advertising, and marketing of on-line commerce web sites; provision of access to information on-line from a computer database; technical consultancy and advising in the establishment of on-line retail

services; providing on-line facilities for real-time interaction with other computer users concerning topics of general interest and playing games; on-line directory services to help locate people, places, organisations, phone numbers, home pages, and electronic mail address; computer services, namely, creating indexes of information, sites, and other resources available on computer networks; searching and retrieving information on computer networks; leasing access time to a computer database (other than by Internet service providers) – class 42

easyrentacar

Community trade mark registration no 1261502 in the name of EASYRENTACAR (UK) LIMITED in respect of:

Transportation services; hire and rental of motor vehicles – class 39

easyLife

Community trade mark registration no 1343359 in respect of:

Printed matter, books, publications, brochures, postcards, menus, catalogues, diaries, promotional and advertising material, wrapping and packaging material, stationery, writing instruments, calendars, posters, photographs, greeting cards, bags, badges, instructional and teaching materials, playing cards, labels, magazines, newsletters, tickets, leaflets, writing paper, paper, goods made of cardboard, manuals, pamphlets, albums, newspapers, periodicals, vouchers, coupons and travel documents, identity cards, tags, gift cards, travel document folders, travel guide books, travellers cheques – class 16

Advertising; business management; business administration; office functions; publicity, promotional services, import-export agency services, business information services, organising exhibitions for commercial or advertising purposes – class 35

Transportation of goods, passengers and travellers by air; airport check-in services; arranging of transportation of goods, passengers and travellers by land; airline services; baggage handling services; cargo handling and freight services; operating and providing facilities for tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft; aircraft fuelling services, aircraft parking services, travel agency and tourist office services; advisory and information services relating to the aforesaid services; information services relating to transportation services, including information services provided on-line from a computer database or the Internet – class 39

easy.com

Community trade mark application no 1343300 in respect of:

Printed matter, books, publications, brochures, postcards, menus, catalogues, diaries, promotional and advertising material, wrapping and packaging material, stationery, writing instruments, calendars, posters, photographs, greeting cards, bags, badges, instructional and teaching materials, playing

cards, labels, magazines, newsletters, tickets, leaflets, writing paper, paper, goods made of cardboard, manuals, pamphlets, albums, newspapers, periodicals, vouchers, coupons and travel documents, identity cards, tags, gift cards, travel document folders, travel guide books, travellers cheques – class 16

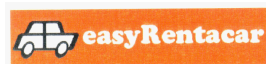
Advertising; business management; business administration; office functions; publicity, promotional services, import-export agency services, business information services, organising exhibitions for commercial or advertising purposes – class 35

Transportation of goods, passengers and travellers by air; airport check-in services; arranging of transportation of goods, passengers and travellers by land; airline services; baggage handling services; cargo handling and freight services; operating and providing facilities for tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft; aircraft fuelling services, aircraft parking services, travel agency and tourist office services; advisory and information services relating to the aforesaid services; information services relating to transportation services, including information services provided on-line from a computer database or the Internet – class 39



United Kingdom registration no 2212473 in respect of:

Transportation services; hire and rental of motor vehicles – class 39



Community trade mark application no 1360981 in respect of Transportation services; hire and rental of motor vehicles – class 39

easyJet tours

Community trade mark application no 1383157 in respect of:

Printed matter and publications; books, manuals, pamphlets, newsletters, brochures, albums, newspapers, magazines and periodicals; tickets, vouchers, coupons and travel documents; identity cards; labels and tags; posters, postcards, stationery, writing instruments, wrapping materials, calendars, diaries, photographs, gift cards and greetings cards; teaching and instructional materials – class 16

Transportation of goods, passengers and travellers by air; airport check-in services; arranging of transportation of goods, passengers and travellers by land and sea: airline and shipping services; baggage handling services; cargo handling and freight services; arranging, operating and providing facilities for cruises, holidays, business travel, tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft; aircraft parking services, travel agency and tourist office services; advisory and information services relating to the aforesaid services; including the provision of such services by means of the Internet or a computer database – class 39

Temporary accommodation; catering, hotel, restaurant, café and bar services; reservation services for hotel accommodation; provision of exhibition facilities; meteorological information services; hairdressing, grooming and beauty salon services; including the provision of such services as well as information and advice relating thereto by means of the Internet or a computer database – class 42

easyJet Services

United Kingdom registration no 2219661 in respect of:

Printed matter and publications; books, manuals, pamphlets, newsletters, brochures, albums, newspapers, magazines and periodicals; tickets, vouchers, coupons and travel documents; identity cards; labels and tags; posters, postcards, stationery, writing instruments, wrapping materials, calendars, diaries, photographs, gift cards and greetings cards; teaching and instructional materials; promotional and advertising material; signs of paper or cardboard – class 16

Transportation of goods, passengers and travellers by air; airport check-in services; arranging of transportation of goods, passengers and travellers by land and sea; airline and shipping services; baggage handling services; cargo handling and freight services; arranging, operating and providing facilities for cruises, holidays, business travel, tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft; aircraft parking services; travel agency and tourist office services; advisory and information services relating to the aforesaid services; baggage check-in services, airline booking services, air traffic control services, aircraft handling services – class 39

Temporary accommodation; catering, hotel, restaurant, café and bar services; reservation services for hotel accommodation; provision of exhibition facilities; meteorological information services; hairdressing, grooming and beauty salon services; security services; airport security services; airline passenger security screening services – class 42

easyJet Services

Community trade mark registration no 1472273 in respect of:

Printed matter and publications; books, manuals, pamphlets, newsletters, brochures, albums, newspapers, magazines and periodicals; tickets, vouchers, coupons and travel documents; identity cards; labels; posters, postcards, stationery, writing instruments, wrapping materials, calendars, diaries, photographs, gift cards and greetings cards; instructional and teaching material; promotional and advertising materials; signboards of paper or cardboard – class 16

Transportation of goods, passengers and travellers by air; registry services; arranging transportation of goods, passengers and travellers by road and by sea: transport services, airline and



forwarding services; baggage handling services; cargo handling and freight services; arranging, operating and providing facilities for cruises, holidays, business travel, tours, excursions and vacations; aircraft chartering; leasing of aircraft; aircraft fuelling services, aircraft parking services, travel agency and tourist office services; information and advisory services relating to all the aforesaid services; registration of luggage, flight reservation services, air traffic control services, aircraft handling services, excluding the transportation of letters and parcels – class 39

Temporary accommodation; catering, hotel, restaurant, café and bar services; reservation services for hotel accommodation; providing facilities for exhibitions; weather information services; hairdressing, grooming and beauty salon services; security services; airport security services; airline passenger security screening services – class 42

Community trade mark registration no 1588326 in respect of: Computer software; computer hardware; pre-recorded CD ROMs and other disk carriers; sunglasses – class 9

Printed matter and publications; books, manuals, pamphlets, newsletters, brochures, albums, newspapers, magazines and periodicals; tickets, vouchers, coupons and travel documents; documents, tickets and publications, all relating to travel arranged by means of the world-wide web; travel documents folders; travel guide books; travellers cheques; playing cards; identity cards; labels and tags; posters, postcards, stationery, writing instruments, wrapping materials, calendars, diaries, photographs, gift cards and greetings cards; badges; teaching and instructional materials; promotional and advertising material; signs of paper or cardboard – class 16

Advertising; business management; business administration; office functions; publicity, promotional services, import-export agency services, business information services, organising exhibitions for commercial or advertising purposes; auctioneering services – class 35

Financial and insurance services – class 36

Telecommunication services; provision of access to the Internet; providing access to information on-line from a computer database or provided with facilities from the Internet – class 38

Transportation of goods, passengers and travellers by air; airport check-in services; arranging of transportation of goods, passengers and travellers by land; bus transport services, car transport services, coach services; airline services; baggage handling services; cargo handling and freight services; operating and providing facilities for tours; cruises, excursions

and vacations; chartering of aircraft; rental and hire of vehicles, boats and aircraft; aircraft fuelling services, aircraft parking services; ambulance services; travel agency and tourist office services; advisory and information services relating to the aforesaid services; information services relating to transportation services, including information services provided on-line from a computer database or the Internet; travel reservation and travel booking services provided by means of the world-wide web – class 39

Information relating to entertainment and education, provided on-line from a computer database or the Internet; entertainment services provided on-line from a computer database or the Internet; educational information provided on-line from a computer database or the Internet; rental of electric and electronic goods, toys, games and playthings – class 41

Temporary accommodation; catering, hotel, restaurant, cafe and bar services; reservation services for hotel accommodation; provision of exhibition facilities; meteorological information services; hairdressing, grooming and beauty salon services; security services; airport security services; airline passenger security screening services; design of computer software; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; posting, creating and maintaining websites for others; leasing access time to a computer database; provision of access to computers; Internet café services; rental of clothing – class 42

Community trade mark registration no 1593326 in respect of: 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 and rinses; tooth cleaning preparations; depilatory preparations; sun-screening and tanning preparations; anti-perspirants deodorisers and deodorants, cotton wool; essential oils; preparations and substances for use in massage and aromatherapy – class 3

Electric, electronic, communications, photographic, measuring, signalling, checking, scientific, optical, nautical, life-saving and surveying apparatus and instruments; computer software, hardware and firmware; computer games software; apparatus, instruments and media for recording, reproducing, carrying, storing, processing, manipulating, transmitting, broadcasting and retrieving publications, text, signals, software, information, data, code, sounds, and images; audio and video recordings; audio recordings, video recordings, music, sounds, images,



Indication of colour – orange

text, publications, signals, software, information, data and code provided via telecommunications networks, by online delivery and by way of the Internet and the world wide web; sound and video recordings; sound and video recording and playback machines; coin freed apparatus; arcade games; televisions and television games apparatus and instruments; photographic and cinematographic films prepared for exhibition; photographic transparencies, non-printed publications; educational and teaching apparatus and instruments; electronic, magnetic and optical identity and membership cards; sunglasses and sunvisors; protective clothing and headgear; parts and fittings for all the aforesaid goods – class 9

Printed matter and publications; wrapping and packaging; books, manuals, pamphlets, newsletters, albums, newspapers, magazines and periodicals; tickets, vouchers, coupons and travel documents; identity cards; labels and tags; posters, postcards, calendars, diaries, photographs, gift cards and greeting cards; teaching and instructional materials – class 16

Leather and imitations of leather; goods made of leather or imitations of leather; skins and hides; trunks bags and travelling bags; purses, wallets, pouches and handbags; luggage; sports bags; bike bags; backpacks; umbrellas and parasols; harnesses and saddlery; parts and fittings for all the aforesaid goods – class 18

Clothing, headgear, footwear – class 25

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread and pastry; honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces; condiments; spices; prepared foods and meals; snacks and snack foods; confectionery; ices; chocolate – class 30

Mineral and aerated waters; beers; non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages – class 32

Alcoholic drinks(except beer); wines, spirits, liqueurs and cocktails – class 33

Cigarettes, cigars, snuff, tobacco, tobacco products, smokers' articles, lighters, matches – class 34

Advertising, marketing and publicity services; dissemination of advertising, marketing and publicity materials; business organisation, business administration and business management of retail outlets, business centres and car parks; business and management consultancy, assistance and advice; purchasing and demonstration of goods for others; bringing together and displaying a variety of goods enabling customers conveniently to view and to purchase such goods; retailing of goods; retailing of goods through shops, kiosks, the Internet, on

board aircraft, and by mail order; advisory and arrangement services relating to all the aforesaid; including, but not limited to, all the aforesaid services provided via telecommunications networks, by online delivery and by way of the Internet and the World Wide Web – class 35

Communication; broadcasting; message transmission; provision of access to the Internet; advisory and arrangement services relating to all the aforesaid; including, but not limited to, all the aforesaid services provided via telecommunications networks, by online delivery and by way of the Internet and the World Wide Web. – class 38

Transportation and storage; transportation of goods, passengers and travellers by land, sea and air; airline and shipping services; cargo and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; ambulance services; rental and hire of vehicles, boats and aircraft; travel agency and tourism services; consultancy and advice relating to the aforesaid services – class 39

Entertainment; education; publishing; production of sound and video recordings; organising games and competitions; rental of electric and electronic apparatus, namely acoustic recording equipment, amusement machines, apparatus for the playing of games, apparatus for the recording and/or reproduction of audio or video signals, or sound, audio apparatus, audiovisual apparatus, cassette recorders, film projectors, educational apparatus, compact disc players, disco equipment, entertainment apparatus, gaming machines, public address systems, radios and televisions and record players; rental of toys, games and playthings; 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 – class 41

Temporary accommodation; provision of food and drink; catering; hotel, restaurant, café and bar services; hotel management and reservation services; non-business professional consultancy; providing facilities for exhibitions and conferences; meteorological information services; hairdressing; grooming and beauty salon services; physical, mental and emotional health-care and well-being services; counselling in relation to illness, addiction and/or death; nursery, kindergarten and creche services; rental of clothing; consultancy, advice, assistance, analysis, design, evaluation and programming services relating to computer software, firmware, hardware and information technology; provision of access to computers; consultancy and advice relating to the evaluation, choosing and implementation of computer

software, firmware, hardware, information technology and of data-processing systems; rental and licensing of computer software, firmware and hardware; provision of information relating to technical matters, legal matters, information technology, and intellectual property; 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 – class 42

EASYEVERTHING

Community trade mark application no 1590561 in respect of:
Computer software; computer hardware; pre-recorded CD Roms and other disk carriers; sunglasses – class 9

Printed matter and publications; books, manuals, pamphlets, newsletters, brochures, albums, newspapers, magazines and periodicals; tickets, vouchers, coupons and travel documents; documents, tickets and publications, all relating to travel arranged by means of the world-wide web; travel documents folders; travel guide books; travellers cheques; playing cards; identity cards; labels and tags; posters, postcards, stationery, writing instruments, wrapping materials, calendars, diaries, photographs, gift cards and greetings cards; teaching and instructional materials; promotional and advertising material; signs of paper or cardboard – class 16

Badges – class 26

Advertising; business management; business administration; office functions; publicity, promotional services, import-export agency services, business information services, organising exhibitions for commercial or advertising purposes; auctioneering services – class 35

Financial and insurance services – class 36

Telecommunication services; provision of access to computers and the Internet – class 38

Transportation of goods, passengers and travellers by air; airport check-in services; arranging of transportation of goods, passengers and travellers by land; bus transport services, car transport services, coach services; airline services; baggage handling services; cargo handling and freight services; operating and providing facilities for tours; cruises, excursions and vacations; chartering of aircraft; rental and hire of vehicles, boats and aircraft; aircraft fuelling services, aircraft parking services; ambulance services; travel agency and tourist office services; advisory and information services relating to the aforesaid services; information services relating to transportation services, including information services provided on-line from a computer database or the Internet; travel reservation and travel booking services provided by means of the world-wide web – class 39

Information relating to entertainment and education, provided on-line from a computer database or the Internet; entertainment services provided on-line from a computer database or the Internet; educational information provided on-line from a computer database or the Internet – class 41

Temporary accommodation; catering, hotel, restaurant, café and bar services; reservation services for hotel accommodation; provision of exhibition facilities; meteorological information services; hairdressing, grooming and beauty salon services; security services; airport security services; airline passenger security screening services; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; posting, creating and maintaining web-sites for others; leasing access time to a computer database; Internet cafe services; rental of clothing, toys, games and playthings; provision of information (relating only to services in Class 42) on-line from a computer database or provided with facilities from the Internet – class 42

EASYCLICKIT

United Kingdom registration no 2230279 in the name of easy.Com (UK) Limited in respect of:

Computer software; computer hardware; pre-recorded CD Roms and other disk carriers; sunglasses – class 9

Printed matter, books, publications, brochures, postcards, menus, catalogues, diaries, promotional and advertising material, wrapping and packaging material, stationery, writing instruments, calendars, posters, photographs, greeting cards, bags, badges, instructional and teaching materials, playing cards, labels, magazines, newsletters, tickets, leaflets, writing paper, paper, goods made of cardboard, manuals, pamphlets, albums, newspapers, periodicals, vouchers, coupons and travel documents, identity cards, tags, gift cards, travel document folders, travel guide books, travellers cheques – class 16

Advertising; business management; business administration; office functions; publicity, promotional services, import-export agency services, business information services, organising exhibitions for commercial or advertising purposes – class 35

Financial and insurance services – class 36

Telecommunication services – class 38

Transportation of goods, passengers and travellers by air; airport check-in services; arranging of transportation of goods, passengers and travellers by land; airline services, baggage handling services; cargo handling and freight services; operating and providing facilities for tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft; aircraft fuelling services, aircraft parking services, travel agency and tourist office services; advisory and information

services relating to the aforesaid services; information services relating to transportation services, including information services provided on-line from a computer database or the Internet – class 39

Information relating to entertainment and education, provided on-line from a computer database or the Internet; entertainment services provided on-line from a computer database or the Internet; educational information provided on-line from a computer database or the Internet; rental of electric and electronic goods, clothing, toys, games and playthings – class 41

Temporary accommodation; catering, hotel, restaurant, café and bar services; reservation services for hotel accommodation; provision of exhibition facilities; meteorological information services; hairdressing, grooming and beauty salon services; security services; airport security services; airline passenger security screening services; design of computer software; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; posting, creating and maintaining websites for others; leasing access time to a computer database; provision of access to computers and the Internet; Internet services; provision of on-line services – class 42

3) easyGroup state that companies in its group have made use in the United Kingdom of the trade marks EASYJET/easyJet on paper goods, travel services and transportation services since 1995, easyKiosk for paper goods, the provision of food and drink and catering services since around 1999, easyTech for aircraft maintenance services since around 1999, easyTrak for transportation services since around 1998, easyRentacar for vehicle rental services since around 1999, easyMoney and easyBank for financial services, easyJet Services for paper goods and transportation services since around January 2000, easyEverything on catering services, Internet services and leasing access time to a computer database since October 1999, easyJet.com & logo, easy.com for free e-mail services since around 2000 and easyValue for on-line price comparator service since 2000.

4) easyGroup state that the trade mark of Easyrooms so closely resembles its trade marks referred to above, which contain the prefix easy, that it is likely to deceive or cause confusion. easyGroup state that the services of the application are either identical or similar to all the class 9, 16, 18, 29, 30, 32, 33, 35, 36, 38, 39, 41 and 42 goods and services covered by its trade marks easyMoney, EASYJET, easyJet.com & logo, easyEverything (stylised), easycard, EASYTRAIN, EASYTRAK, EASYWEB, EASYEXTRAS, easyrentacar, EASYKIOSK, easyJet Services, EASYBUS, easyJet tours, easyPay, easyTech, easyJet ramp, easyLife, easyKiosk, easydotcom, EASYCLICKIT, EASYCAFE, EASYEVERYTHING, EASYPAY and easyJet the Web's Favourite Airline. easyGroup claim, consequently, that there is a likelihood of

confusion and so the registration of the trade mark is contrary to sections 5(2)(b) and 47(2)(a) of the Trade Marks Act 1994 (the Act).

5) easyGroup claims that registration of the application is also contrary to sections 5(4)(a) and 47(2)(a) of the Act on the basis the use of the trade mark **Easyrooms** would be prevented by the law of passing-off. easyGroup claims that there has been extensive use of the trade marks easyMoney, easyBank, easyEverything, easyJet, easyRentacar and many other of its trade marks which have the prefix easy in relation to financial services, travel services, paper goods, Internet café services, Internet services, on-line price comparator services, catering services and transportation services. It states that it has acquired a significant reputation and goodwill in the aforesaid trade marks and that use by the applicant of his trade mark would constitute a misrepresentation as to the origin of the services which would damage its goodwill.

6) easyGroup claims that to the extent that any of its goods and services are considered dissimilar to those covered by the registration, the registration offends against sections 5(3) and 47(2)(a) of the Act. It states that the trade marks EASYJET/easyJet, easyRentacar/EASYRENTACAR, EASYEVERYTHING/easyEverything have a reputation in the United Kingdom and use of the trade mark of Easyrooms on any of the goods covered by the registration without due cause would take unfair advantage, or be detrimental to the distinctive character and repute of the earlier trade marks.

7) easyGroup request that the registration is declared invalid and seek an award of costs.

8) Easyrooms filed a counterstatement. Easyrooms requires that easyGroup proves the use and reputation they claim in relation to their trade marks. All of the grounds of the application for invalidity are denied.

9) Easyrooms claims that easy is a common prefix in trade marks currently registered in the United Kingdom. Furthermore, the word easy is a commonplace descriptive and laudatory English word meaning simple or not difficult. Consequently no one proprietor can, or is in a position to claim, that he has a monopoly in trade marks with the prefix EASY. Easyrooms claim that the only point of similarity between the registration and the trade marks of easyGroup is the word easy.

10) Easyrooms requests that the application for invalidation is rejected. Easyrooms also seeks an award of costs.

11) The matter came to be heard on 30 October 2002. Easyrooms was represented by Ms McFarland of Counsel, instructed by JE Evans-Jackson & Co. easyGroup was represented by Mr Roberts of Counsel, instructed by Page, White & Farrer.

12) At the hearing common submissions were made in respect of this case and also an opposition case between the same parties. Owing to differences in the trade marks of Easyrooms and the dates of their filings there are certain differences between the cases. However, for the most part common issues are involved and common evidence was filed.

Consequently, I have for a large part adopted a common summary of the evidence and analysis of the cases. There are, however, differences where there are divergences between the cases.

Evidence of easyJet

Witness statement by James Rothnie

13) Mr Rothnie states that he has been director of corporate affairs for easyJet Airline Company Ltd and its related companies, easyEverything Limited, easyRentacar (UK) Limited and easyGroup (UK) Limited since 23 August 1999. He does not explain what is the exact relationship between these various enterprises.

14) easyJet Airline was launched in November 1995 as an operator of low cost scheduled airline services. It sells directly to the consumer and does not use travel agents or any third party. easyJet Airline primarily sells its tickets via the Internet with confirmation and booking references e-mailed to the customer. It also advertises its job vacancies through the Internet. In August 2000 over 75% of its airline seats were sold over the Internet. Mr Rothnie states that it has become well-known for its distinctive business practices. He states that it has also become well-known by engaging in many high profile battles with large traditional carrier operators over the right of consumers to uninhibited, low cost air travel. Mr Rothnie states that this has increased the profile and goodwill in the “easy” name in relation to low cost, widely accessible “e-tailored” travel services and it has become well known to consumers.

15) Mr Rothnie states that the success of easyJet Airline and the establishment of a notable reputation within the European Union, particularly in the United Kingdom, paved the way for the expansion of the “easy” brand into other fields. Mr Rothnie states that the easyJet Airline business attributes have been embraced by other “easy” businesses and, to emphasise the cohesiveness of the “easy” brand, cars provided under the easyRentacar trade mark bear stickers of easyJet Airline and previously mouse mats referring to easyJet Airline were used in Internet cafés of easyEverything Limited.

16) Mr Rothnie states that in August 1998 it was announced that car rental services would be provided under the trade name easyRentacar and that this has been extensively publicised from May 1999 onwards. He states that the website of easyJet Airline advertised the forthcoming easyRentacar business from May 1999. Mr Rothnie states that the domain name www.easyRentacar.com was registered on 1 March 1999. Mr Rothnie gives details of from where easyRentacar now operates but does not state what the position was at the relevant date. He states that easyRentacar is distinctive and well-known because of its business ethos of low cost, simplicity and reliability. He states that the business is also distinctive because it is the world’s first Internet only car rental company.

17) Mr Rothnie states that in June 1999 a chain of Internet cafés was launched by the founder of easyJet Airline across Europe, beginning with a 500 seat branch in London. He states that the business was carried out under the brand name easyEverything. He comments on the position of the business at the date of his declaration. However, as this is well after the date of the filing of the application this is not relevant to my considerations to the position at that date – the relevant date for the purposes of this case. He states that in September 2000 there were 1.25 million visitors to easyEverything stores throughout Europe.

18) Mr Rothnie states that easyGroup (UK) Limited is the investment vehicle for the group of companies and acts as an “incubator” for Internet start-up “easy” businesses in new fields. He does not state exactly what the group of companies is, whether it is the group of companies he referred to at the beginning of his statement. He does not advise what he means by “investment vehicle” or “incubator”. He comments on a new on-line financial services company called easyMoney and an Internet portal under the trade mark easyValue, the latter, he states, allows consumers to find the cheapest bargains for all types of goods and services. He states that easyValue and other new “easy” ventures all feature the “easy” brand identity. Mr Rothnie does not give dates for the commencement of these ventures. From his use of the word “new” it would appear that they arise from after the relevant date. As I have nothing before me to show that the ventures were running at the relevant date I cannot take them into account in these proceedings. (*see paragraph 20 below also re easyMoney*)

19) Mr Rothnie states that the united business ethos of simplicity, low cost and the accessibility of easyJet Airline and its related companies has resulted in the emergence of a well-known brand identity. He states that the “easy” trade mark is key to the brand identity. Mr Rothnie states that easyJet Airline and its related companies generally use short trade marks often consisting of two words with the prefix “easy” combined to form one new word, where the suffix has connotations with the services involved. Mr Rothnie exhibits at JR1 printouts from the websites of easyJet Airline and what he describes as related companies. A large number of the printouts lack any clear date of origin. Most of those which do have a date emanate from October 2000. According to some of the news releases that are exhibited, easyRentacar announced that it would be commencing business in March 2000. The business actually commenced on 20 April 2000, cars being available from a site near London Bridge. This was followed by sites in Glasgow on 24 April 2000 and Barcelona on 26 April 2000.

20) Mr Rothnie states that the development of the “easy” name as a distinctive and valuable trade mark was a deliberate policy since the launch of easyJet Airline in 1995. He states that all the “easy” businesses that operate under the “easy” mark can deliver low cost services and that they use the same “easy” brand identity. Mr Rothnie states that the setting up of the easyMoney business involved an expenditure of £492,000 between November 1999 and August 2000, before the service had been launched, and that by August 2000 there was substantial positive feedback and press coverage in the United Kingdom.

21) Mr Rothnie states that the fact that the “easy” prefix is now recognised by the public as denoting the businesses of easyJet Airline and related companies and therefore seen as their trade marks is illustrated by the repeated emphasis in the press of the easy mark and not to the full trading names of the companies. He states that in the documents exhibited at JR2 there are references to easy car hire, easy Group umbrella, easy does it, easy revolution, easyFloat and easyRider. The articles included in JR2 are:

- extract from Reuters Business Briefing dated 25 June 2000 headed “Stranded by ‘Easy’ Car Hire – Directions”;
- extract from Reuters Business Briefing dated 25 June 2000 headed “Easy-Rider Stelios Hits at Critics”;
- extract from Reuters Business Briefing dated 25 June 1999 headed “Easy Does It”. It goes on to state that “EasyEverything is set to revolutionise high street and Internet shopping, the company claims.” The article indicates that three stores will open in London in September 1999;
- extract from “Guardian Unlimited” dated 29 September 2000 which reads: “Easy winner; The internet business EasyEverything owned by Stelios Haji-Ioannou, was last night named ecompany of the year at Future Publishing’s internet awards ceremony”;
- extract from “The Independent” dated 6 October 2000 headed “The Tsar of the easy revolution goes Dutch”. The article deals with various topics including the setting up of an easyRentacar depot in Zaandam;
- extract from “The Independent” dated 11 October 2000 headed “easythis, easythat, easyfloat”. The article deals with the floating of easyJet on the stock market. The article deals with the history of easyJet amongst other things. In the article Stelios Haji-Ioannou is quoted as saying: “What I want to achieve is to have a family of companies linked by a common brand but each developing its own identity. What I do is design a company then let other people run it”. The piece also states:

“In preparation for next month’s easyJet flotation, its directors have been working on a brand licence agreement between the airline and his easyGroup of companies”;
- extract from “The Times” dated 17 October 2000. The extract is from The Times City Diary. The extract deals with various topics including one entitled “Easy does it”. This part of the extract deals with the proposed launch in November 2000 of easyValue.com, a website that will offer price comparisons for various goods and services;
- extract from “The Times” dated 17 October 2000. A sub-heading in the article is “EasyFloat set for turbulent take-off”. This deals with the floating of easyJet on the stock market;
- extract from “The Sunday Times” dated 29 October 2000 headed “Airline boss aims for Easy landing in City”. This is an interview/portrait of Stelios Haji-Ioannou;
- extract from “Reuters Business Briefing”. This extract is undated. It deals with various matters, including the winning of an award for new-media marketer of the year by Stelios Haji-Ioannou. There is no indication as to which year the award

relates. It refers to the easyGroup umbrella, easyJet, easyEverything, easyRentacar and easyBank;.

22) Mr Rothnie states that in the twelve months ending in December 1999 easyJet Airline doubled the number of flights it operated. He states that as of 30 September 2000 easyJet Airline operated on twenty eight routes across Europe. He states that in the United Kingdom airline services are provided to Luton, Liverpool, Glasgow, Edinburgh, Belfast, Gatwick, Inverness, Stansted and Aberdeen with booking services provided to people throughout the United Kingdom by telephone and the Internet. He states that there are approximately 600,000 visits to the home page of easyJet Airline a week. Mr Rothnie does not relate the United Kingdom services or the visits to the home page by reference to dates. It is, therefore, quite possible that what he is referring to is the position at the time of his completing his witness statement; which is well after the relevant date. Mr Rothnie gives the following passenger figures for easyJet:

1995	30,000
1996	420,000
1997	1,140,000
1998	1,880,000
1999	3,670,000
2000	5,996,000

He states that the approximate annual turnover figures for the financial years 1997/1998, 1998/1999 and 1999/2000 are respectively £77 million, £140 million and £267 million.

23) Mr Rothnie states that in April 2000 an NOP poll was carried out which he states indicated that there was a recognition of 81% for the house mark of easyJet Airline Company Ltd in the United Kingdom. He exhibits at JR3 a copy of this poll report. In fact the exhibit states that research was carried out between 25 and 28 August 2000 and not in April 2000 as stated by Mr Rothnie. The results relating to Question 1 – which, if any, of the following low-cost airlines have you heard of? – is not clearly legible. The first page of the result relating to question 2 is also not clearly legible. Question 2 responses the following qualification: “Base: all not spontaneously mentioning Easyjet.” From the copy of the questionnaire in the exhibit this question relates to the reading out of the names of five airlines. The total positive response to the question was 75%. Combined results for questions 1 and 2 is reproduced. This indicates that those interviewed were over fifteen years of age. It indicates that 84% of all persons interviewed had heard of easyJet when asked either spontaneously or when prompted. The third question deals with various attributes that the person answering considers that various airlines have. The fourth question asks which airlines would the interviewee, based on his/her own experiences, recommend to a friend or colleague. The fifth question asks the interviewee which colour do they associate with easyJet; 47% associated the colour orange with easyJet. No copies of the actual questionnaires have been furnished.

24) Mr Rothnie states that turnover in the United Kingdom in the period June to 31 (sic) September 1999 under the trade mark easyEverything was £392,000 and turnover for the 12 months ending 30 September 2000 was £6,704,895. He states that the website relating to easyEverything received 607,278 visits in the year to 15 May 2000. He states that the services are available to customers through five stores in London and one store in Edinburgh. Mr Rothnie does not indicate if this latter statement relates to the position at the relevant date or at the date of his completion of the statement.

25) Mr Rothnie states that the unaudited estimate for the turnover of easyRentacar for the year ending September 2000 was £3,500,000, of which £2,162,175 was earned in the United Kingdom. Mr Rothnie states that in its first month of trading over 40,000 rental days in bookings were taken and there were around 65,000 visits to its website between May and December 1999, before it even began trading in February 2000. This statement does not seem to tally with one of the exhibits of JR1. In that exhibit – entitled “into top gear with HP” – it is stated, amongst other things, that in December 1999 “HP was contracted to develop a dedicated e-commerce environment for easyRentacar”. It further states that the web site went live in March 2000. A further exhibit includes a press release dated 1 March 2000 in which it is stated that “the booking system on www.easyRentacar.com will go live in a few days time”. I am not sure, as Mr Rothnie states that this is the first car rental by Internet only business, how trading commenced before it would appear that the web site had been set up. Mr Rothnie states that by 26 August 2001 over 1.4 million vehicle rental days had been booked and from January to August 2001 an average of 100,000 people visited the car rental website every week.

26) Mr Rothnie states that the companies in the same group as easyGroup have taken great care to create a consistent “easy” brand image. He states that this brand identity is used on all advertising and promotional materials, including any corporate documents such as headed paper. Mr Rothnie states that there is extensive promotion via the Internet. He states that in addition easyJet Airline Company Limited and related companies promote their services in numerous other ways including billboard posters on tube stations and London buses, press releases, customised postcards, the sides of taxis, handbill promotions, key rings, stickers, mouse mats and through radio, press and television advertising. He exhibits at JR4 various materials relating to these activities. The materials exhibited relate to easyEverything, easyRentacar and easyJet. A number of the materials bear no date. There are a large number of advertisements in relation to easyJet, the earliest of those bearing some indication of date being from January 2000. Included in the promotional material for easyEverything is an advertisement announcing that additional stores were to open in Autumn 1999; in fact, later publicity indicates that one of these stores, in Oxford Street, actually was to open on 28 January 2000. The earliest document in relation to easyRentacar is an advertisement for staff from “The Evening Standard” for 17 February 2000. Specimens for advertisements bear dates from Design Department from March 2000. This would appear to be the date that the advertisements were created rather than actually put into use. The earliest advertisement for the actual easyRentacar service comes from “The Guardian” of 13 March 2000. This refers to easyRentacar being “the latest venture from Stelios, the owner of easyJet and easyEverything”. The other advertisements for the most part emanate from June 2000

onwards. The promotional material for the opening of easyEverything states that it is “from the founder of easyJet”. An advertisement from “The Evening News” (Edinburgh) dated 26 May 2000 refers to a “sensational opening offer”. It would appear, therefore, that until sometime in May 2000 the only easyEverything stores in the United Kingdom were in London. The three businesses do not share advertising space, although the advertisements for easyRentacar and easyJet are often either next to each other or in close proximity.

27) Mr Rothnie states that by the end of 2000 easyJet Airline Company Ltd had spent over £40 million on advertising or promoting its business and that £30 million of this had been spent in the United Kingdom. He states that £2.6 million was spent in promoting easyEverything between October 1999 and August 2000 and that by the end of 2000 over £500,000 had been spent in promoting easyRentacar.

28) Mr Rothnie states that there has been significant press coverage of the services of easyJet Airline Company Ltd and related companies. He exhibits at JR5 pages from “Reuters Business Briefing”. The briefings begin in October 1995 and end in August 2000. The listings are titles. No explanation is given as to what they actually are or any indication if there are fuller texts. Mr Rothnie describes the pages as being a sample of the press coverage. The only indication of businesses other than airlines, car rental and Internet cafés that I can find is in relation to banking eg reference no 1937 of 16 August 1999 is EASYGROUP TAKES OFF ON CYBER BANKING, reference no 1948 of 14 August 1999 EASYJET PLANS INTERNET BANK, reference no 1042 of 18 February 2000 EASYJET HEAD MULLING POSSIBLE INTERNET BANKING JOINT VENTURE and reference no 328 of 13 June 2000 EASYGROUP CONFIRMS INTERNET BANK START UP. There are no concrete details of the business, if it has traded and if so under what trade mark and under what conditions.

29) Mr Rothnie states that easyJet Airline Company Ltd has been featured on four series of television programmes made by London Weekend Television and broadcast on ITV at peak time on Friday evening and entitled “Airline”. He states that the first series appeared in 1998 and that the last one was serialised between 12 March 2001 and 28 May 2001 with an average audience during the last series of nine million.

30) Mr Rothnie states that easyJet Airline Company Ltd was voted 7th best leisure airline in July 2000 in “The Guardian” and “The Observer” travel awards, 5th best business airline and the 2nd most popular travel website in the United Kingdom by MMXI Europe. Mr Rothnie states that in July 2000 easyEverything won the Networking Industry award 2000 for its imaginative use of technology, in March 2000 it was given an award for the most promising new retailer by Retail Week Awards and in September 2000 the title e Company of the Year at the Future UK Internet Awards. Mr Rothnie states that the founder of easyJet has been voted PR Week European Communicator of the Year in October 2000, Revolution e-Entrepreneur of the Year in 2000 and Direct Marketeer of the Year in 1998. Mr Rothnie states that in 1999 the founder of easyJet was given the award of London Entrepreneur of the Year, the business was voted the best low cost airline by Business Traveller Magazine and it received an award for the best interactive

campaign in Media Awards. Mr Rothnie states that it was said to be the best new snow sports holiday travel provider by “The Daily Mail” magazine and Marketing magazine listed the launch of easyJet as one of the great marketing moments of the twentieth century. In 2000 the founder of easyJet was voted Business Person of the Year by “The Liverpool Daily Post”, easyJet was awarded the best on-board service concept of the International Flight Catering Association, the founder of easyJet was given the award of New Marketeer of the Year by “Revolution Magazine”, the company was given an award by the International Travel Association for its contribution to the development of European air travel. Mr Rothnie states that in the same year the founder of easyJet was given an honorary fellowship by Liverpool John Moores University. He states that in the same year easyJet was voted the best low cost airline by readers of “The Telegraph”, won the leisure category at the Chartered Institute of Marketing Effectiveness Awards and was voted the best low cost airline by “Business Traveller Magazine”, for the second year running, it was named the best low cost airline in “The Daily Telegraph Travel Awards”, and the founder of easyJet entered “The Guinness Book of Records” as the world’s youngest international scheduled airline chairman by launching easyJet at the age of 28. Mr Rothnie states that in 2001 easyJet won the best value category in the Visa e-tail awards. He states that it has excelled in the Consumers’ Association Holiday Which? Survey being the only low cost airline to be ranked in the first division of consumer satisfaction, and it was voted overall winner in a readers’ survey conducted by “The Sunday Times” of the best on-line travel sites. He states that easyJet won three awards at the Annual Superbrand Tribute Event for the most significant impact on the market sector, the most impressive brand developed in the last ten years and best PR work.

31) Mr Rothnie states that easyGroup and its related companies collectively undertake a vigorous campaign to protect the “easy” mark and brand and are the owners of a large number of trade mark applications and registrations world-wide as well as around 9000 domain names. He also states that they take steps to approach unauthorised parties who use the “easy” mark and brand in relation to on-line consumer services in order to prohibit or restrict such use.

32) Mr Rothnie states that it is inevitable that members of the public in the United Kingdom would assume that the user of the trade mark registration in relation to travel insurance, organising of transport and of travel by air, land and sea, organising of holiday travel services, booking temporary accommodation and telecommunication services and Internet communication services was part of or associated with the business of easyGroup and related companies. Mr Rothnie goes on to list the details of various trade marks of which he states easyGroup is the proprietor.

33) Mr Rothnie continues by commenting on the “risk” of confusion. This part of his statement represents submissions rather than evidence of fact and so I will say no more about it but take on board the comments in reaching a decision.

34) Mr Rothnie states that easyGroup has been providing accommodation to the public and that such services are closely linked with travel services. Mr Rothnie states that from July 1999 until an unspecified date that camping services were provided in the Barcelona

area in connection with the travel, transportation and airline services provided. He states that these services were advertised on easyGroup's websites and were extensively used by the public travelling from abroad to Barcelona.

35) Mr Rothnie states that since 1999 it has been possible for the public to arrange accommodation at the same time as arranging travel and transportation services. He states that when the public booked travel/transport via the Internet there is a link from the website, known as travel extras, to services allowing the booking of hotel accommodation, car rental and similar services. Mr Rothnie states that when a travel booking was made by email the confirmation email would ask whether hotel accommodation had been arranged and refer the traveller to the appropriate website. Mr Rothnie states that for those people booking by telephone, the operator would ask if accommodation had been arranged and if requested, would transfer the caller to the appropriate person to arrange accommodation. He states that confirmation letters following telephone bookings would also refer to booking accommodation. Mr Rothnie states that the close links with accommodation services are further highlighted in the in-flight magazines of the airline which promote accommodation/accommodation companies and also refer people to the accommodation services that his company promotes. Mr Rothnie states that in the summer of 2001, these links were made closer and when the public arrange transportation by reference to easyJet it is now simple for them to arrange accommodation through octopus travel. Mr Rothnie exhibits various documents at JR6. The first document is a webpage relating to camping some 60 kilometres from Barcelona. The page bears the title easyJet tours. It was downloaded on 14 February 2002 and is in French only. Consequently, I do not see that it has a bearing upon the position in the United Kingdom at the relevant date. A second easyJet web page downloaded on 14 February 2002 is exhibited. In this case there is an indication that the page actually emanates from November 1999. There is a reference to "travel extras" on the page but no further details as to what these details are. There is a blank confirmation letter from easyJet.com which refers to the services of easyCar. There is no date on this letter but from the number of easyCar locations listed it would appear to be of recent origin and certainly could not be assumed to be from the relevant date. Part of an easyJet in-flight magazine from February 2002 is included in the exhibit; clearly from well after the relevant date. In so much as it, and other magazines from after the relevant date, might reflect the position of the claimed relationship between airlines and other services I will comment on it. There are advertisements from the Accor group of hotels, octopustravel – which is described as the accommodation partner of easyJet – Marriot vacation club, Direct Travel Insurance (underwritten by AXA), Columbus travel insurance, Holiday Inn in Saint Laurent du Var, Read's Hotel in Mallorca and London Gatwick Travel Inn. All the advertised services are advertised under the name of the advertiser, the only relationship with easyJet indicated is that with octopustravel. Part of an easyJet in-flight magazine from September 2000 is exhibited. There are advertisements for The Hotel Emeraude in Juan Les Pins, Hyde Park Inn and Bewley's Hotels. None of the advertisers makes any link to easyJet. Part of an easyJet in-flight magazine from June 2000 is exhibited. There are advertisements for Hotel zum Storchen, Hotel Emeraude, Carlton George Glasgow – which states "please quote Easyjet offer" when booking' - and various advertisements for property. Again other than the reference

in the Carlton advertisement there is no reference to easyJet in the advertisements. Part of an easyJet in-flight magazine from February 2000 is exhibited. There are advertisements for the Manotel Swiss hotel chain – which includes references to a special tariff for easyJet customers – Travelodge – which also includes references to a special tariff for easyJet customers - Travel Extras, which is described as “the simple one call solution to all your car hire, accommodation, travel insurance and airport parking needs” and states that the company is the preferred supplier of easyJet. Finally, part of an easyJet in-flight magazine from September/October 1999 is exhibited. There are advertisements from Lodge Inns, Travel Extras – again referred to as easyJet preferred supplier – and octopustravel – which is described as the accommodation partner of easyJet.

36) Mr Rothnie states that there are links from the website to the provision of travel insurance at reduced rates for easyJet passengers. He states that the value of accommodation booked between October 1999 and March 2001 via the travel extras link was £1,200,000 with around 4000 separate bookings between October 1999 and September 2000. Mr Rothnie has not exhibited the actual web pages relating to travel extras and hotel booking, it could be that these just represent links to the websites of other undertakings.

37) The rest of Mr Rothnie’s statement represents submissions, rather than evidence of fact, and a recapping of earlier evidence. I, therefore, do not consider it necessary to make any further comment upon it.

Evidence of Easyrooms Ltd

Witness statement by Helene Whelbourn.

38) Ms Whelbourn is a trade mark attorney employed by J E Evans-Jackson & Co Limited, the authorised representatives of Easyrooms Ltd.

39) Ms Whelbourn exhibits an extract from “Collins English Dictionary” which includes a definition of the word ‘easy’. She states that the word means, amongst other things, not requiring much labour or effort; not difficult; simple.

40) Ms Whelbourn exhibits at HW2 a copy of a search of the United Kingdom Trade Marks Registry for trade marks with the prefix EASY in classes 36, 38, 39 and 42. The search was conducted on 3 December 2001. There are eight pending trade marks and twenty registered trade marks; none of the trade marks are in the names of the protagonists in this case. Ms Whelbourn exhibits at HW3 the details of six easy prefixed trade marks filed before 5 April 1995; all of these trade marks are also included in exhibit HW2.

41) Ms Whelbourn exhibits at HW4 printouts from the Internet, they would appear to have been downloaded on 22 April 2002, so after the relevant date. These consist of the following:

- EasyDrive – a school of motoring in the Swansea/Neath/Port Talbot area
- easySolicitor – a service for conveyancing – this would appear to be a United Kingdom website;
- EASYBREAKS – an offer by British Trust Hotels for a special tariff for stays at their hotels - this would appear to be a United Kingdom website;
- EasyPay – public and private hire vehicles insurance – it is indicated that the undertaking was established in 1996 - this would appear to be a United Kingdom website;
- EasyShip – a DHL software package for customers sending more than two hundred shipments per month - this would appear to be a United Kingdom website;
- EasyBusiness – software for the creation of e-commerce sites. It is indicated that the enterprise was established in France in January 2000 – the undertaking promoting the software has an address in London;
- Easy Date Products - this would appear to be a United Kingdom website – the products are: “all-in-one products or bundled solutions that use automatic identification to capture, process display or send out data”. Included in the products are easystores, easytrak, EasyPalm, EasyData M90, easyvisit, easylib, easytag, easyAssetTrack, easyInventory, easyMarket Research and easy com2key.
- Easylife protection – an enterprise based in Bedford offering life and critical illness cover.

42) Ms Whelbourn exhibits at HW5 an extract from the “Thompson Local Directory” for central London for 2001. This lists twenty undertakings beginning with the word easy. Four of these would appear to be related to easyGroup: Easy Everything, Easyeverything, Easygroup Ltd and Easyjet. The others have the following names: Easyart Ltd, Easybite.Com Ltd, Easychoose, Easy-Do Products Ltd, Easyexist, Easy Flying Ltd, Easy Loans, Easymap, Easynet, Easynet Group, Easynet Ltd, Easyoffices.Com, Easy PC, Easyscreen, Easy Tiger Productions Ltd and Easy T Travel.

43) Ms Whelbourn exhibits at HW6 a printout from Companies House showing companies whose names begin with easy. The printout would appear to have been downloaded on 22 April 2002. There are approximately one thousand names listed, approximately one hundred and fifty of the companies are listed as being dissolved.

44) Ms Whelbourn states that easyGroup, in addition to the use of words prefixed by easy, uses the colour combination of white and orange for the get-up of its business. She exhibits at HW7 examples of the get-up. This exhibit consists of hard copies of webpages that appear to have been downloaded on 22 April 2002. They are from easyJet.com, easyCar.com and easyInternetCafé. The first two printouts show a good deal of use of the colour orange, where the name of the undertaking appears it is on an orange background, in orange or in an orange outline. The last printout has the word

easyInternetCafé in both black and orange. The words ‘mission statement’, Stelios and easyGroup all appear in orange. The links to easyCar, easyValue, easyMoney and easy.com are white on an orange background.

45) The other statements in Ms Whelbourn’s statement are submissions rather than evidence of fact. I will take them on board in reaching my decision but do not consider it necessary to say anymore about them here.

Evidence of easyGroup in reply

46) This consists of a further witness statement by Mr Rothnie.

47) A good part of this statement represents submissions rather than evidence of fact. I take on board the submissions in reaching my decision but see no need to say anymore about them here. I will concentrate on those parts of the statement that can be considered to be evidence of fact. Mr Rothnie states that action has been taken against many of the trade marks the details of which were exhibited by Ms Whelbourn. He states that EASYCAR was opposed and withdrawn, opposition has been filed against EasyT. EASYGO has been opposed in the United Kingdom. easyGroup intend to file an application for invalidation against EASYLIFE. He states that EASYBANK has been opposed whilst EASYMARKET has been opposed in various countries. He states that EASYCOACH has been opposed and the application for EASY TRAVEL withdrawn.

48) In relation to the printouts from websites that Easyrooms supplied Mr Rothnie distinguishes between the goods and services that the undertakings supply and those encompassed by Easyrooms’ trade mark. He does not indicate that any action is being taken against these undertakings.

49) In relation to the extract from “Thompson Local Directory” that Ms Whelbourn exhibited Mr Rothnie states that legal action is being taken in relation to Easyart Limited, the trade mark Easy Flying is being opposed in France, Easy Loans is being objected to in the United Kingdom and that Easynet has been the subject of objections to trade marks in Australia, Benelux, Israel, Italy, the European Union, France, Germany, Spain and the United Kingdom. He states that opposition has been lodged against Easy T Travel in the United Kingdom, Benelux, Austria, Finland, Norway, United States of America, Germany, Switzerland the United States of America.

50) Mr Rothnie states that a number of the company names that Ms Whelbourn exhibited are connected with easyGroup, he lists twenty company names.

Decision

51) The relevant parts of the Act in relation to invalidity are sections 47(2 – 6) which read as follows:

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

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

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

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that -

- (a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and
- (b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

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

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

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

52) I also need to consider section 48(1) of the Trade Marks Act 1994 which states:

“Where the proprietor of an earlier trade mark or other earlier right has acquiesced for a continuous period of five years in the use of a registered trade mark in the United Kingdom, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right-

(a) to apply for a declaration that the registration of the later trade mark is invalid,
or

(b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used,

unless the registration of the later trade mark was applied for in bad faith.”

53) The Easyrooms’ trade mark has not been registered for five years and so there is no issue of acquiescence.

Evidence of use by easyGroup

54) Ms McFarland in her submissions questioned Mr Rothnie’s ability to give evidence for easyGroup. She commented that he states in both of his witness statements that he is director of corporate affairs but does not state of what. In his first statement Mr Rothnie states that he is authorised to give evidence for easyGroup and that all the facts that he gives are within his own knowledge or are obtained from company records. He also gives details of his position in various companies.

55) In the face of such clear statements I cannot see on what basis I should discount the statements of Mr Rothnie. In all honesty I cannot see what the problem is. If Easyrooms believed that there was a genuine problem they could have raised this in their evidence or have requested that Mr Rothnie be cross-examined on his evidence. They did neither. I am happy to accept the legitimacy of the evidence of Mr Rothnie; although at the same time comparing his statements to the supporting exhibits in order to ascertain the weight that should be given to them.

56) Easygroup filed evidence of use in relation to their trade marks. I have experienced some difficulty in extracting how much of the evidence is relevant to each set of proceedings. Mr Rothnie filed virtually identical evidence in relation to the two sets of proceedings despite there being nearly fourteen months separating the relevant dates. The matter has been further complicated by Mr Rothnie’s tendency to make statements about the position at the time of his completion of his witness statements; in the case of the main evidence this being 5 March 2002 and 26 April 2002; thus increasing the distance to the relevant dates. Consequently I have looked to see how much of his statements can be tied in with the exhibits.

57) In addition there are occasional inconsistencies between the statements of Mr Rothnie and the exhibited evidence. Mr Rothnie refers to the survey having been carried out in April 2000. However, the report that is exhibited indicates that the survey took place between 25 and 28 August 2000.

58) Mr Rothnie states that in easyRentacar's first month of trading over 40,000 rental days in bookings were taken and there were around 65,000 visits to its website between May and December 1999, before it even began trading in February 2000. This statement does not seem to tally with one of the exhibits of JR1. In that exhibit – entitled “into top gear with HP” – it is stated, amongst other things, that in December 1999 “HP was contracted to develop a dedicated e-commerce environment for easyRentacar”. It further states that the web site went live in March 2000. A further exhibit includes a press release dated 1 March 2000 in which it is stated that “the booking system on www.easyRentacar.com will go live in a few days time”. As Mr Rothnie states that easyRentacar only trade over the Internet I find it difficult to understand how it could have begun trading or having visits to its website when the website was not up and running.

59) I have carefully considered the statements of Mr Rothnie in conjunction with the materials that he has exhibited. On this basis I am ready to accept that there was use of the trade mark easyJet for airline services and in-flight magazines, easyEverything for Internet cafés and easyRentacar for car rental services prior to the relevant date. However, I cannot see that any other claims can be justified upon the basis of the evidence.

60) There are indications of use of other trade marks. However, the indications lack detail. The extract from “The Times” from The Times City Diary of 17 October 2000 deals in part with the proposed launch in November 2000 of easyValue.com, a website that will offer price comparisons for various goods and services.

61) There is an undated extract from “Reuters Business Briefing”. It deals with various matters, including the winning of an award for new-media marketer of the year by Stelios Haji-Ioannou. There is no indication as to which year the award relates. It refers to the easyGroup umbrella, easyJet, easyEverything, easyRentacar and easyBank.

62) Included in exhibit JR6 is a webpage relating to camping some 60 kilometres from Barcelona. The page bears the title easyJet tours. It was downloaded on 14 February 2002 and is in French only. Clearly it is from well past the relevant dates. It can also be presumed that, as it is in French, that it is not designed for the United Kingdom.

63) Mr Rothnie refers to easyMoney and the expenditure in setting up the business between November 1999 and August 2000. However, he does not state or show that at either relevant date the business was up and running.

64) Mr Roberts submitted that I should take into account the survey evidence that easyGroup had filed, although accepting that I might only be able to give it limited weight. Ms McFarland submitted that I should attach no weight to the survey. The standard tests applied to survey evidence are those set out in *Imperial Group plc & Another v. Philip Morris Limited & Another* [1984] RPC 293. For convenience I refer to the headnote which gives a clear synopsis of what is required:

“If a survey is to have validity (a) the interviewees must be selected so as to represent a relevant cross-section of the public, (b) the size must be statistically significant, (c) it must be conducted fairly, (d) all the surveys carried out must be disclosed including the number carried out, how they were conducted, and the totality of the persons involved, (e) the totality of the answers given must be disclosed and made available to the defendant, (f) the questions must not be leading nor should they lead the person answering into a field of speculation he would never have embarked upon had the question not been put, (h) the exact answers and not some abbreviated form must be recorded, (i) the instructions to the interviewers as to how to carry out the survey must be disclosed and (j) where the answers are coded for computer input, the coding instructions must be disclosed.”

65) My first problem with the survey in this case is that part of it was not legible, a fairly fundamental problem. All I have before me is the result of the survey. I do not have any of the background. I do not have any details as to the criteria that were applied. There is an absence of completed questionnaires, of the instructions to interviewers. These are fundamental problems. In the absence of questionnaires and details of the interviewers there is no way that Easyrooms can test through cross-examination the way the survey was carried out. Survey evidence is notoriously fraught with problems. It is very easy to find a reason not to accept it. In this case, however, with the complete absence of the background and supporting documentation I cannot see how I can take it into account. There is no opportunity on the facts as presented to conduct a “peer group review”. I have decided that I must fall upon the side of Ms McFarland in this issue and give no weight to the survey. However, as will be seen from the paragraph below little if anything turns upon this.

66) In considering the reputation of easyJet I have taken a variety of factors into account. Prior to both relevant dates there was substantial use of the airline by the public. The renown of easyJet must have been increased by the broadcasting of television series about the airline. The name of the airline is also likely to be known by those who do not use it. If they are at an airport to which easyJet flies they will hear announcements about the flights. The exhibits suggest a substantial amount of advertising in national newspapers. The exhibits also show that Mr Haji-Ioannou’s activities in relation to easyJet have a very high press profile. I conclude from the evidence that at both relevant dates there was a substantial reputation in the trade mark easyJet for airline services. I consider that, in the terms that the European Court of Justice used in *General Motors Corporation v Yplon SA Case C-375/97* [2000] RPC 572, that the trade mark easyJet was known to a significant part of the public concerned in a substantial part of the United Kingdom.

67) Mr Rothnie states that easyEverything Internet cafés were set up in June 1999. The exact picture in relation to the status of the business is difficult to see owing to Mr Rothnie describing the state of the business as at the time of the completion of his witness statement. From the exhibited evidence it would appear that there were several easyEverything Internet cafés in London prior to May 2000. From the exhibits it would

appear that they were five in number. Mr Rothnie states that this is the current number in London. Sometime in May 2000 a café was opened in Edinburgh. Mr Rothnie does give turnover figures in the United Kingdom in relation to the business. He also comments on the number of visitors to the website. However, there is no indication as to from where the visits were being made. He also gives the figure for promotional expenditure, £2.6 million, however he states that this was between October 1999 and August 2000. Consequently part of the expenditure, I do not know how great a part, falls after the relevant date for the registration. Taking into account the limited evidence before me and the limited geographical base of the business I certainly do not consider that easyGroup have established that easyEverything was known to a significant part of the public concerned in a substantial part of the United Kingdom. The evidence shows that at the relevant time that easyEverything was being used for Internet cafés, that the trade mark was being used. It establishes a goodwill. However, I do not consider that the evidence establishes anything more than this.

68) As I have stated earlier there is a discrepancy between the statement of Mr Rothnie in relation to the easyRentacar business and the exhibited evidence. The website went live sometime in March 2000 and cars were available for hire from 20 April 2000 in London, from 24 April 2000 in Glasgow and from 26 April 2000 in Barcelona. In the case of Barcelona it is not clear if the business was generated in the United Kingdom or from outside the United Kingdom. There are indications of pre-launch publicity. Mr Rothnie gives figures for visits to the car rental website but there is no indication as to where the visitors were based. He states that there in the first month of trading over 40,000 rental days in bookings were taken. However, there is no indication of how much of this business was generated in the United Kingdom or was for car hire in the United Kingdom. Owing to the discrepancies between the exhibits and Mr Rothnie's statement I consider that I must exercise caution as to the figure anyway. Mr Rothnie states that the first month of trading was February, the exhibits contradict this. Mr Rothnie goes on to give figures in relation to vehicle rental days and visits to the website between January and August 2001. Such figures clearly cannot affect the position in relation to Easyrooms' registration. Even in relation to the application they cross the relevant date. Again there is no geographical breakdown. How much of the business was generated from outside the United Kingdom for a service supplied outside the United Kingdom? What amount of the figures relate to a period before 30 June 2001? In the case of easyRentacar I feel that I have had to bear the strictures of Pumfrey J in *South Cone Inc. v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 in mind:

"There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 1938 Act (see Smith Hayden (OVAX) (1946) 63 RPC 97 As qualified by BALI

[1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date."

69) Professor Annand, sitting as the appointed person, in *Loaded* BL0/191/02, accepted that proof of goodwill could be accomplished by other means. In this case I have considered that the evidence is clearly indicative of goodwill for easyJet and easyEverything. I find it far more difficult to decide if easyRentacar enjoyed goodwill at the relevant dates, and especially in relation to the invalidation action, where the relevant date is 6 May 2000. I am not satisfied that the evidence shows that there was a protectable goodwill in relation to easyRentacar at 6 May 2000. In drawing this conclusion I take into account that a limited use can establish goodwill (see for instance *Stannard v Reay* [1967] FSR 140) and also that publicity and promotion without actual sales can establish goodwill (see *BBC v Talbot Motor Co Ltd* [1981] FSR 228). Based on the facts presented I do not believe that a goodwill in easyRentacar is established as of 6 May 2000. It is for easyGroup to establish from their evidence goodwill at the relevant date, not for me to make presumptions on limited and ill defined evidence which also suffers from contradictions. There is evidence after 6 May 2000 eg press advertisements for the service. I am willing to accept on the basis of this evidence that as of 30 June 2001 there was goodwill in the trade mark easyRentacar for car hire services. The evidence indicates that there was a business with a protectable goodwill. It does not lead me to draw any further conclusions eg I do consider that it satisfies the criteria for a reputation in the context of *General Motors Corporation v Yplon SA*.

Family of trade marks

70) One of the planks of easyGroup's case is that they own several trade marks that commence with the prefix easy and that because of this the trade marks of Easyrooms will be identified with them. They, therefore, consider that they own a family or series of trade marks. The family of trade marks concept was one that was accepted under the old Act. It has been accepted as part of the global appreciation of the likelihood of confusion under the current Act (see for instance the decisions of the appointed persons in BL 0/411/01 and BL 0/207/02). It is also a position that has been accepted by the Community Trade Mark Office (see for instance decision no 1649/2000 of the Opposition Division). That an undertaking owns a family of trade marks does not mean, however, that the trade marks are to be considered as a job lot; there has to be a mark to make comparison (see *ENER-CAP Trade Mark* [1999] RPC 362).

71) To a large extent the position as to a family of trade marks follows that under the old law as exemplified by the decision of the Assistant Comptroller in *Beck, Koller* [1947] 64 RPC 76. I consider that the principles upheld in that decision hold good today:

- there must be use of the trade marks – if the public are not aware of the trade marks they are not going to associate a common element with one particular trader;
- the less distinctive the common element the lesser the strength of the family;
- use of the common element by other traders will further weaken the strength of the family.

72) I cannot put the case better than the Assistant Comptroller did:

“My conclusion from the above reasoning is that where an opponent bases his opposition upon a “series” of marks the *Registrar*, in coming to a decision under the provisions of Sec. 12 of the Act, should compare the opponent’s marks individually with the applicant’s mark, but that in making each comparison he should have due regard to any user which either the opponent may establish of other marks of the “series”, or the applicant may establish of other marks having the same common element or characteristic used either by himself or by third persons.”

“I am disposed to agree with Mr. *Burrell*’s submission that the “series” objections is primarily founded upon user, because the inference which the *Registrar* is asked to draw is that traders and the public have gained such a knowledge of the common element or characteristic of the “series” that when they meet another mark having the same characteristic they will immediately associate the latter mark with the “series” of marks with which they are already familiar.”

“But if the Applicants had established that in the same market a number of different proprietors were using marks beginning with the syllables “Plio”, this would have constituted a circumstance which would have tended to soften the conflict if the Applicants’ favour. Similarly, if the Opponents had established that they were using a “series” of other marks beginning with the syllables “Plio” in respect of goods of the same description as the Applicants’ goods, such a circumstance would have tended to harden the conflict under Sec.12 adversely to the Applicants.”

73) It has been a presumption in all cases of a family of trade marks that there is a common owner of the trade marks. If there is not the public are already faced with different ownerships so why should they associate another trade mark with one of several undertakings? If the trade marks are in a different ownership the basic premise of a family of trade marks is missing.

74) I would add to the criteria set out in *Beck Koller* that the public would have to make a connection between the goods/services upon which the trade marks are used. In my view the greatest the distance between the goods and/or services of the family of trade marks the less the public are likely to consider that the common element relates to one undertaking. However, there could be circumstances where there is a great distance

between the goods/services but a connection is still formed eg by advertising or promotional materials that connect the various trade marks.

75) The strength of the family will also depend on the number of trade marks and the extent of the use. The greater the number of trade marks and the greater the use the more that the public are likely to identify the common element with a particular undertaking.

76) In this case easyGroup have made very optimistic claims in relation to owning a family of trade marks, they have based a lot of their claim on trade marks on the register rather than trade marks in the market place.

77) In my view, for the reasons given above, I can only consider trade marks that had been clearly used at the relevant date and can only consider them, in the context of a family of trade marks, in relation to the services for which they had been used. From my considerations above in relation to use the case of easyGroup boils down to three trade marks easyRentacar, easyJet and easyEverything; respectively for car rental, airline services and Internet cafés. (A problem arises owing to the issue of ownership, I will deal with this matter afterwards.)

78) Although I could not accept that easyGroup had established goodwill in relation to easyRentacar as of 6 May 2000 there was some use of easyRentacar and so I include it in my consideration of a family of trade marks in relation to both the opposition and the invalidity action. The trade mark will, however, have more “weight” in relation to the opposition owing to the later relevant date.

79) There are several versions of the above trade marks in use and for which there are trade mark registrations or applications. However, I do not consider that anything turns upon this in relation to the family question. I consider that for the public there are effectively these three trade marks.

80) I will now consider the various factors in relation to the strength of the claimed family of trade marks. The three trade marks include the word easy in lower case followed by a word or words of which the first letter is in upper case. Consequently there is some similarity in “get-up”. I have no exhibits from easyGroup in colour. However, Easyrooms’ evidence includes printouts in colour showing the colour orange. Certain of the trade mark registrations/applications relied on by easyGroup also include colour claims for the colour orange or are in the colour orange. There is also the survey evidence, however, I have already stated that I cannot put any reliance upon this. From the evidence before me I cannot tell how important the colour orange is to the trade marks when in use and so will say no more about this matter.

81) The areas of use of the trade marks are an airline, an Internet café and car rental. I can see little obvious connection between an Internet café and the other services. I have no evidence before me that suggests that there is a common connection in trade. Ms McFarland referred to the need for easyGroup to establish a “nexus” between the various services under consideration. She was, for the main, dealing with the principal issues in

relation to sections 5(2), 5(3) and 5(4)(a) rather than the subsidiary issue of a family of trade marks. However, I consider that this requirement for a connection is important in this context also. Ms McFarland also submitted that it was for easyGroup to show this connection through evidence. I consider that this is correct. There are certain assumptions or presumptions that I can make from my own experience. However, I consider that these must be very strictly limited to what is beyond reasonable question – clear judicial notice. I certainly, for instance, do not consider that my specific experience of using airline websites should colour my decision. Such experience could well be very typical in both my usage and in the sites that I have visited. It is for easyGroup to show any connections that need to be proved. Easyrooms cannot be expected to file their evidence and base their case on guessing as to the experiences that any particular hearing officer might have had.

82) Mr Rothnie states that the easyJet Airline business attributes have been embraced by other “easy” businesses and, to emphasise the cohesiveness of the “easy” brand, cars provided under the easyRentacar trade mark bear stickers of easyJet Airline and previously mouse mats referring to easyJet Airline were used in Internet cafés of easyEverything Limited. These statements have not been challenged by Easyrooms. However, I have no idea of the scale of the cross-referencing of the businesses. How many mouse mats were distributed and for how long a period for instance? Mr Rothnie does not exhibit any of the mats either.

83) I do not consider it unreasonable to state, as something that can be generally accepted, that airports invariably have car hire desks in them. This is a proposition so basic that I do not consider that it requires proof.

84) easyGroup place weight upon the links on the Internet site. However, they do not actually produce any of the linked pages. Links on web pages tell me little in themselves, without clearly identifying where the link goes to, it could be that the link goes to a business with no connection with the linked web page other than that link. Various Internet pages are produced in JR1 but I find few cross-references between the businesses upon them. One undated page from easyJet.com invites the surfer to visit easyRentacar and a page downloaded from easyRentacar.com appears to show links to easyJet, easyEverything, easyMoney and easy.com.

85) On the evidence before me do I consider that easyGroup have shown that the average consumer would make a connection between the three trade marks and the three services that they encompass and connect the easy beginning as a common element indicating that there is a common owner? In the absence of evidence as to why I should I do not see why I should believe that the average consumer would link the trade marks easyEverything and easyJet on the basis of the use and the services. There is perhaps a stronger likelihood in the case of easyRentacar and easyJet owing to the services, at least the services are likely to be found in the same place. There is a very limited amount of exhibited material linking the trade marks. Taking all factors into account the evidence does not sway me. easyGroup have made their claim and it is up to them to substantiate

it. In my view they have failed to do so. **I do not consider that they can rely on a family of trade marks in their claims under sections 5(2)(b), 5(3) and 5(4)(a).**

86) Easyrooms have raised two other issues which affect the proposition that easyGroup can benefit from a family of trade marks. They state that the word easy is not distinctive and that it is also used by others.

87) Part of the argument of Easyrooms was based on the state of the register evidence and records from Companies House. State of the register evidence does not tell me what was happening in the market place at the relevant dates. In exhibit HW3 Easyrooms list six easy + trade marks that have a date of filing before 5 April 1995, the date of the filing of the United Kingdom registration for EASYJET (no 2016785). I have nothing that tells me that these trade marks were in use before that date or if they were in use in relation to the services that easyGroup have shown use on. There is also the extensive list of easy prefixed company names. It could be argued that the sheer number of these company names is indicative of easy being non-distinctive as a prefix in trade marks. However, there are no details of when the company names were registered. It could be that a large number of them have been made on the coat tails of easyJet. Consequently, I do not consider that the state of the register evidence, nor the records of Companies House tell me anything useful.

88) Printouts from websites are also exhibited. The printout from Easydrive school of motoring states that it is a family run business that has been operating for twenty five years. However, it does not tell me if it has been operating under that name for that period. The printout for easySolicitor, for conveyancing services, is copyrighted for 2000 but again there is no indication of when the trade mark was first used. The printout for EasyPay states that the business was established in 1996. The business provides motor insurance for public and private hire vehicles. Easyship is a software product of DHL. There is no indication of when it was first used. The printout for EasyBusiness does not indicate when the enterprise first started trading in the United Kingdom but as it was founded in Paris in January 2000 and has an investment date of September 2000 it would seem to postdate the use of the trade marks of easyGroup. The goods of EasyBusiness are software products for e-commerce sites. There is no indication as to when Easy Data started trading. The products are used to capture, process display or send out data. Finally there is Easylife Protection, again with no indication of when the business commenced; Easylife supply illness and life insurance.

89) The printouts tell me little about what was happening at the relevant dates. However, even if they did I can see no obvious connection between their goods and services and the services of easyGroup. This lack of connection undermines any claim that their presence weakens the claim to a family of trade marks.

90) Easyrooms also relies on an exhibit from "Thomson Local" for 2001. Mr Rothnie comments in his evidence in reply on actions that easyGroup are taking against certain of the companies listed. This exhibit does not identify what was happening at the relevant

dates, it also does not clearly tell me what goods or services the businesses are involved in. Again there is the absence on the evidence of connection.

91) Easyrooms have claimed that the word easy is non-distinctive. Quite possibly they are correct but that is not the issue before me. The issue before me is the use of the word easy in conjunction with another element. Looking at the trade marks I need to consider, easyJet, easyEverything, easyRentacar and Easyrooms, I consider that all of them could be divided into two non-distinctive elements. However, these elements in conjunction combine to form a distinctive whole which in the case of all the trade marks with the exception of easyEverything gives a clear allusion to the services but still is clearly an indicator of origin. The easy element of the trade marks cannot be divorced from the other elements. It might be that on its own easy is not very distinctive, if distinctive at all, but I need to consider it within the context of the trade marks and how it will be seen and acts within them. **The pattern of the trade marks is the word easy followed by a descriptive element, the combination of the two creating a distinctive whole.**

92) I turn finally to the issue of ownership. Whenever I have come across claims to a family of trade marks they have been in common ownership. The claim has been based upon this. In this case there is no evidence that at the relevant dates that the trade marks were in common ownership. Indeed from the evidence of Mr Rothnie and the printouts supplied with the statement of grounds it is clear that previously the trade marks were not in a common ownership.

93) The printouts of the details of the trade marks upon which easyGroup rely show that at the time of the filing of the application for invalidity and the opposition various undertakings other than easyGroup were identified as the owners of various of the trade marks.

- easyExtras (CTM 848424), EASYCAFÉ (CTM 931790), easyJet. the web's favourite airline (CTM 1132596), easyTech (CTM 1128743), easyKiosk (CTM 1196138), easyJet (CTM 1232909), easyEverything (CTM 1243948), easyLife (CTM 1343359), easy.com (CTM 1343300), easyJet tours (CTM 1383157), easyJet Services (CTM 1472273), easyJet.com and device (CTM 1593326), easyJet ramp (CTM 1661834), easyServices (CTM 1821354), easyRamp (CTM 1821370), easy.com (UK 2247942) - all in the name of Easyjet Airline Company Ltd;
- easyrentacar (CTM 1261502) in the name of Easyrentacar (UK) Ltd;
- easyRentacar and device (CTM 1360981) in the name of easy Group Ltd;
- easy dot com (stylised) (CTM 1588326), EASYCLICKIT (UK 2230279), EASYCLICKIT (CTM 1770593), easy dot com (stylised) (UK 2240412) – all in the name of easy.Com (UK) Ltd;
- EASYEVERYTHING (CTM 1590561) in the name of easyEverything Ltd;

- EASY (CTM 1699792), EASYMONEY (CTM 1731223), easyLife (CTM 1796564), easyValue (CTM 1857705), easyHotel (CTM 1866706), easy Odds (CTM 1902394), easyEverything the world's largest Internet cafés (UK 2249416) easy (stylised) (CTM 1976679), easyValue.com (CTM 2255323) - all in the name of easyGroup (UK) Ltd.

94) Without common ownership at the relevant date I cannot see how the claim to a family of trade mark can have any foundation. Common ownership is a fundamental property of a family of trade marks, without it the presence of a common element is irrelevant. The common element in relation to ownership would appear to be Mr Haji-Ioannou, who would appear to have been involved in the various companies. However, a common director or founder is not the same as a common owner. This case is not about the goodwill that arises from the personality of Mr Haji-Ioannou, this is not an Eddy Irvine type case (see *Edmund Irvine, Tidswell Limited V Talksport Limited* [2002] EMLR 32). The ownership would appear, at the relevant date, to have been vested in separate legal entities. easyGroup have put in no evidence that deals with the issue of ownership at the relevant date and have put in no evidence that clearly deals with the relationships between the various undertakings. Mr Rothnie in his evidence does not give a clear exposition of the relationship between the various companies. Indeed his evidence gives rise to more questions than it answers eg in paragraph 7 of his first statement he refers to easyGroup (UK) Limited as the investment vehicle for the group of companies but does not clearly state what this company's relationship is with easyGroup. He refers to easyGroup and its related companies but does not state the nature of this relationship. There are many references in the evidence also to the floating of easyJet airline on the stock exchange, so very publicly creating a new and separate legal entity. In *Easyjet Airline Co Ltd v Dainty (t/a EasyRealestate)* [2002] FSR 6, which Mr Roberts referred to, there were five separate "easy" plaintiffs.

95) Ownership of trade mark registrations and applications is a matter of legal fact, it is the applicant or a subsequent assignee. For passing-off the question of ownership of goodwill is not so clear cut. However, this is an area where there is a difference between reputation and goodwill. The public may believe that the various undertakings using the easy trade marks are one and the same; they may well believe this because of the prominent rôle that Mr Haji-Ioannou plays in various of the companies. In the launches of easyRentacar and easyEverything reference is made to Mr Haji-Ioannou. Goodwill is attached to a business, without a business it is nothing. The businesses in these cases appear to have been, at the relevant date, separate legal entities. The information around the floating of the airline suggests a "very separate" company with its own protectable goodwill. It appears to me that the various undertakings enjoy or enjoyed separate goodwill in their businesses.

96) Mr Roberts did not see that there were different legal entities represented a problem. He submitted that it is not unusual for there to be more than one plaintiff in a passing-off action. I accept that. However, they will normally be taking action in relation to a common goodwill and/or a sign used in common. In this case there are different signs,

with different businesses with different owners. Also a joint action is not on a par with a claim within an action to a family of trade marks. Mr Roberts sought assistance from *Dawnay, Day & Co Ltd v Cantor Fitzgerald International* [2000] RPC 669. I do not see that this case assists easyGroup. In *Dawnay Day* the Dawnay Day group of companies clearly established their relationship, not something done in this case, they also relied on the one sign that they all used – Dawnay Day – in this case the separate entities do not rely on one single sign but are relying in relation to the family of trade marks argument on one single element.

97) In this case the question boils down to the evidence and facts presented, or the lack of them. There is no clear indication of the relationship between the various undertakings, there is use of different signs for different businesses by different legal entities.

98) I had already decided that easyGroup could not look to a claim to a family of trade marks to bolster its claims, irrespective of the ownership issue. Consequently the ownership issue does not determine the matter. However, as there was a good deal of discussion at the hearing in relationship to this point I believe it is appropriate to mention it here.

Objection under section 5(2)(b) of the Act

99) According to section 5(2)(b) of the Act a trade mark shall not be registered if because

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“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.”

100) The term ‘earlier trade mark’ is defined in section 6(i)(a) of the Act as follows:

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

101) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v Adidas AG* [2000] ETMR 723.

102) In his submissions Mr Roberts concentrated on the trade mark EASYJET as being as good a basis for the claims of easyGroup as any other trade mark. He also referred to certain of the trade marks such as:



which he considered had the same web site banner appearance as Easyrooms' registration.

103) I have considered all the trade marks upon which easyGroup rely, in terms of their signs, their goods/services and their reputations and I have compared these with the Easyrooms' trade mark in terms of both the sign and the services it encompasses. (There is no evidence of any use of this sign by Easyrooms.) Any similarity boils down to word elements beginning with the word easy being followed by a word that is usually not particularly distinctive. I can see nothing in the get-up of Easyrooms' sign that is similar to those of easyGroup. The script and the format of the script do not follow any of the stylised trade marks of easyGroup. The pictorial elements at the right hand side of Easyrooms' trade mark are unlike anything in any of the trade marks of easyGroup. Mr Roberts gave little weight to this pictorial element, putting forward that for the services the designs were descriptive. There is nothing particularly surprising or unusual about the pictures of a bed, a caravan, a ship and a castle. For accommodation and travel services they are not particularly original. However, put together with the rest of the mark they create a definite visual impression that cannot be dismissed. They are very much part of the trade mark.

104) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG* page 224). The visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG* page 224). The word easyrooms clearly takes up the greatest part of the trade mark. It is a distinctive and the major component of the trade mark. However, it does not swamp and make disappear the rest of the trade mark.

105) Mr Roberts emphasised the aural similarity between the trade mark of Easyrooms and, for example, the trade mark EASYJET. Yes, both trade marks commence with the same word but they end with very different words. Any aural similarity is limited to these two syllables. I take into account the matter must be judged through the eyes of the average consumer of the goods/services in question (*Sabel BV v Puma AG* page 224) 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 (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* page 84, paragraph 27). I find it difficult taking into account the very different sounds of the words jet and rooms, and that both have well known meanings which will help the listener to identify the sound - these are not invented words upon which he has no hook to attach his consciousness - that the average consumer, who Mr Roberts described as the average traveller would confuse the two sounds. I take into account that according to *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* likelihood of confusion **may** occur where there is only aural similarity. In this case the aural differences between the trade marks, in my view, is too great to bring about confusion.

106) Conceptually the trade marks of Easyrooms and easyGroup share the meaning of the word easy. However, there is no conceptual link between the word rooms and the other elements of the trade marks of easyGroup, nor is there a conceptual similarity when the trade marks are considered in their entirety. The public do not normally dissect trade marks.

107) easyGroup's case rests very much on the common use of the word easy at the beginning of the various trade marks. Again it is necessary to consider the distinctive and dominant element of the trade marks. I have dealt with the distinctiveness of the word easy above in relation to the family of trade marks issue. I considered that the trade marks must be considered in their entirety and that the joining of two elements, which are either non-distinctive or of limited distinctiveness, give rise to a distinctive whole. My findings rested on easy being for most things not particularly distinctive. It is a word that clearly describes how a service works, for instance. (In my experience it is also the case that many speakers of English use the adjective when grammatically they should use the adverb.) With the limited distinctiveness of easy on its own the comparison of the trade marks as a whole becomes even more essential.

108) In considering the various trade marks I have considered where the respective services are identical or highly similar as the European Court of Justice held that a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* page 132, paragraph 17).

109) Mr Roberts referred to the composite test of Mr Hobbs, sitting as the appointed person, in *Balmoral* [1999] RPC 29. Such a composite test must sit within the parameters of the findings of the European Court of Justice and the global appreciation that they require in the consideration of likelihood of confusion. I will, therefore, stick to the findings of the European Court of Justice.

110) Mr Roberts referred me to *Naturelle Trade Mark* [1999] RPC 326 and that words speak louder than the settings in which they appear. This judgement did not have the advantage of the decisions of the European Court of Justice in relation to the likelihood of confusion. I must have a global appreciation to arrive at a finding of likelihood of confusion but as I have already said I can find for likelihood of confusion where there is only aural similarity. Mr Roberts also referred me to the opinion of the advocate general in *SA Société LTI Diffusion v SA Sadas* [2002] ETMR 40. I do not consider that this case greatly assists me as it deals with what can be considered as being identical trade marks. Mr Roberts seemed to advocate on the basis of this that I should effectively consider the trade mark as being word only. The advocate general was of the opinion that

“The concept of identity between mark and sign in Article 5(1)(a) of Council Directive 89/104/EEC covers identical reproduction without any addition, omission or modification other than those which are either minute or wholly insignificant.”

I certainly do not consider the various elements of the EASYROOM trade mark can be dismissed as being minute or wholly insignificant.

111) For me to find that there is a likelihood of confusion the respective signs have to be similar. This is what the Directive states and it is what is pointed out in *Sabel*:

“it is to be remembered that Article 4(1)(b) of the Directive is designed to apply only if by reason of the identity or similarity both of the marks and of the goods or services which they designate, “there exists a likelihood of confusion on the part of the public”.”

112) In relation to reputation mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2) (*Sabel BV v Puma AG* page 224) and 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 (*Marca Mode CV v Adidas AG* page 732, paragraph 41).

113) I have to consider that there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it (*Sabel BV v Puma AG* page 224). As I have indicated above I consider that EASYJET is reasonably distinctive, without use. In relation to airline services owing to its reputation it is highly distinctive.

114) Having taken into account all the surrounding factors, owing to the nature of the trade marks and the differences between them, I come to the conclusion that there is no likelihood of confusion between the trade marks of easyGroup and the trade mark of Easyrooms. The only area where I have any doubt in relation to the likelihood of confusion arises from the trade mark EASYJET in relation to airline services owing to the reputation that the trade mark enjoys in relation to those services. (I note that in use the trade mark is normally displayed as easyJet, however, I do not consider that anything greatly turns upon this.)

115) To succeed under section 5(2)(b) the respective services must be similar. As the only potential case for success rests with airline services I need to only compare such services with those encompassed by Easyrooms’ trade mark. United Kingdom registration no 2016785 includes such services and is for the trade mark EASYJET. The services of the registration under attack are:

travel insurance;

telecommunications services; Internet communications services;

organising of transport and of travel by air, land and sea; organising of holiday travel services;

booking of temporary accommodation.

116) The European Court of Justice held in *Canon* in relation to the assessment of the similarity of goods and/or services that the following factors, inter alia, should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are complementary. I can see no intersection in relation to *telecommunications services* and *Internet communications services*. These services, being in class 38, are the services which supply the infrastructure or the network. They are not services which encompass the content. The airline passenger may well use *travel insurance* or *book temporary accommodation*. However, there is no symbiotic or mutually dependant relationship between these latter services and airline services. easyGroup have also not supplied evidence that there is a connection in normal trade. It maybe that there is. I can only decide the issues on the facts before me and on those facts cannot find that the respective services are similar.

117) This leaves *organising of transport and of travel by air, land and sea; organising of holiday travel services*. The former services will encompass airline services. So for part of the services there will be identical services for which the trade mark EASYJET enjoys a substantial reputation. Is there a likelihood of confusion? Taking into account all the factors I consider that there might be a mere association, a bringing to mind. According to *Sabel* this is not sufficient for a finding of likelihood of confusion. I also bear in mind that the reputation of a trade mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense (*Marca Mode CV v Adidas AG* page 732, paragraph 41).

118) Consequently, I find that there is not a likelihood of confusion and the grounds of objection under section 5(2)(b) are dismissed.

Objection under section 5(3) of the Act

119) According to section 5(3) of the Act:

“A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

120) I have already accepted that EASYJET enjoys a reputation in relation to airline services which satisfies the criteria set out by the European Court of Justice in *General*

Motors Corporation v Yplon SA Case C-375/97 [2000] RPC 572. I have already decided that certain of the services of the registration are not similar to airline services.

121) There is now a formidable body of case law that assists in deciding cases under this part of the act.

122) In *Barclays Bank plc v RBS Advanta* [1996] RPC 307 Laddie J held

“At the most these words emphasise that the use of the mark must take advantage of it or be detrimental to it. In other words the use must either give some advantage to the defendant or inflict some harm on the character or repute of the registered trade mark which is above the level of de minimis”

123) In *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767 Neuberger J refers to the concept of dilution:

“However, while dilution is a useful concept to bear in mind, it does not necessarily follow that every case of infringement under section 10(3) will necessarily involve dilution, nor does it follow that the proprietor of a mark will necessarily succeed in establishing infringement under section 10(3) in every case where he establishes dilution.”

In the same decision he said:

“As I have mentioned, the mere fact that the way in which the sign is used by TEL may give rise to an association between the sign and the mark in the minds of some members of the public is, in my judgement, simply not enough on its own to enable the proprietor of the mark, however well known and valuable it may be, to invoke section 10(3).”

124) In *Daimler Chrysler AG v Javid Alavi trading as MERC* [2001] RPC 42 Pumfrey J stated:

“It would seem odd to drive that head of infringement so enthusiastically out by the door, of it were only to re-enter by a window obviously present in the same Article, albeit for marks with a reputation.”

and

“...but Jacobs AG emphasises that the provision is not to be used to give marks ‘an unduly extensive protection’, emphasising that there is a question of a risk of unfair advantage or detriment: there must be actual unfair advantage or detriment. But, for this to happen, there must be some sort of connection formed (I avoid the word association) between the sign used by the defendant and the mark and its associated reputation.”

and

“The presence of two similar marks where there was only one before seems to me to be detrimental to the distinctive character of the first. I am satisfied that this is not what the words are talking about.”

125) Some clear damage or advantage is required. It seems to me that if easyGroup cannot get off the ground in relation to identical services for which there is a substantial reputation under section 5(2)(b) they are very unlikely to succeed under this head.

126) I am looking for some form of connection. However, on the basis of the evidence before me I can only see any connection in the vaguest form. As I have said previously it is perhaps the case that there is a connection between the various services in the travel industry. I have no evidence to show that this is the norm. Mr Rothnie tells me that when bookings are made by the telephone the traveller is asked if he wants accommodation. However, this might be the case with EASYJET, I don't know if it is the norm in the industry as a whole. If the public are expected to make the connection it will need to be normal in the industry. The website link tells me nothing as I do not know where it goes. It could go to an independent website and so the traveller would see no close connection. The in-flight magazine advertisements for hotels undermine the case of easyGroup as they very much emphasise the separate nature of the businesses. The closest they get to the airline industry is that certain of the hotels give a preferential rate to EASYJET passengers. Mr Rothnie refers to confirmation letters including references to accommodation. However, the confirmation letter that he exhibits includes no such references. There are advertisements for easyCar.com, Green Line buses and Thameslink trains but no mention of accommodation services.

127) I find no telling evidence that there is a connection. Mr Roberts submitted that use of the Easyrooms' trade mark would be detrimental to the distinctive character of EASYJET. However, I do not feel that he explained exactly how; other than on the basis dismissed by Pumfrey J of there being two similar trade marks where there was one before. Perhaps there would have been more of a case for Easyrooms taking unfair advantage of the distinctive character of EASYJET. However, there has been no clear argument as to this point.

128) A requirement of section 5(3) is that the signs are similar. I do not consider that the degree of similarity, which I have discussed under section 5(2)(b), is such that any connection, regardless of other factors, would be formed.

129) I dismiss the grounds of objection under section 5(3) of the Act.

Objection under section 5(4)(a) of the Act

130) According to section 5(4)(a) of the Act “a trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade”. In this case easyGroup rely upon the law of passing-off. As Mr Roberts submitted the requirements for bringing a successful action for passing-off are goodwill, misrepresentation and damage.

131) I have already decided above that goodwill, as of the relevant date, has been demonstrated in respect of the Internet café business conducted under the sign easyEverything and the airline business conducted under the sign easyJet. The case of easyGroup rests on these two businesses. I have also already decided that easyGroup cannot rely on a family of trade marks to improve their position.

132) The misrepresentation, whether intentional or not, needs to lead the public to believe that the services offered by Easyrooms are the services offered by the owners of the goodwill of easyEverything and easyJet.

133) In considering the issue I find it useful to bear in mind what is the attractive force – the goodwill (see Lord Macnaghten *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217, 223 (HL)). It seems to me that helps in deciding whether there will be misrepresentation.

134) I also bear in mind that there is a large amount of case law that insists that a good deal of circumspection must be used when a common element or the sign as a whole is not particularly distinctive - *Office Cleaning Services Ltd v Westminster Window and General Cleaners Ltd* [1946] 63 RPC 39 *Horlicks Malted Milk Co v Summerskill* [1916] 34 RPC 63, *Canadian ShreddedWheat Co. Ltd v Kellogg Co. of Canada Ltd* 55 RPC 125, *McCain International Ltd v Country Fair Foods Ltd* [1981] RPC 69 and others. As I have already stated I consider that the trade marks I am considering have a reasonable degree of distinctiveness although the word easy on its own has, in many circumstances, a limited degree of distinctiveness.

135) The case law also cautions me that easyGroup have to show a definite and real danger of misrepresentation that will cause substantial damage to the easyEverything and easyJet businesses.

136) Lord Fraser in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31 said that the claimant must prove:

“That he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill by reason of the defendants selling goods which are falsely described by the trade name to which the goodwill attaches.”

137) For misrepresentation to take place there has to be some connection, or as Ms McFarland says nexus, between the various services and a connection that leads the public to believe that the owners of the goodwill have made themselves responsible for the services furnished by Easyrooms.

138) In *Harrods v Harrodian School* [1996] RPC 697 Millett LJ states:

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

In the same case Millet LJ states:

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

139) In *Stringfellow v McCain Foods (G.B.) Ltd.* [1984] RPC 501 Slade L.J. said:

“even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.”

140) The services encompassed by Easyrooms’ registration have no obvious connection with an Internet café; not even those in class 38 which are infrastructure services. easyGroup have furnished no evidence to show that the public would be likely to see a connection. They have also furnished no evidence to indicate that in the market that there is commonly a connection. I feel that the claim based on the easyEverything business is very optimistic and lacks a firm evidential foundation. I, therefore, dismiss it.

141) I turn now to easyJet. In my considerations I firmly bear in mind the words of Millet LJ in *Harrods v Harrodian School* (my emphasis added):

The name "Harrods" may be universally recognised, but the business with which it is associated in the minds of the public is not all embracing. **To be known to everyone is not to be known for everything.**

142) However, I do not consider that the extent of a goodwill is irrelevant either. An enormously famous trade mark, combined with services for which there is some connection, is more likely to deceive the public than a trade mark that is not so well known. Equally if the public do not think that the owners of the goodwill of easyJet are responsible for the services supplied by Easyrooms under their trade mark the case fails.

143) The respective signs are, obviously, important. There has to be something about them that leads the public to make a connection. The perception of the Easyrooms' trade mark will also vary according to the services in conjunction with which it is used. The trade mark has little obvious conceptual association with telecommunication services.

144) In terms of goodwill the strongest case that easyGroup has is in relation to the air travel services of Easyrooms. However, the Easyrooms' trade mark is quite distinctive in relation to such services, it is not allusive of the service. This distinctiveness puts further space between the trade mark and easyJet.

145) On the other hand the lesser distinctiveness for booking of temporary accommodation is mitigated by the absence of easyJet goodwill in relation to this service and the absence of evidence of a connection between such services.

146) The Court of Appeal in *BP Amoco PLC v John Kelly Ltd* [2002] FSR 5 held:

“We consider that it is a necessary ingredient of the tort that the customer is deceived into making the purchase by reason of the confusion engendered by the defendant's use of a get-up similar to that of the plaintiff. As Lord Jauncey said in the *Jif Lemon* case at page 417, “Mere confusion which does not lead to a sale is not sufficient”.

In these cases I do not believe that the customer would be likely to make a purchase upon the false premise. There might be a bringing to mind of easyJet but no more than that.

147) Bringing all the above factors into consideration I cannot come to the conclusion that easyGroup has not made out a case that they would be likely to succeed in a passing-off action.

148) I dismiss the grounds of objection under section 5(4)(a).

Conclusion

149) Mr Roberts referred to *EasyJet Airline Co. Ltd v Dainty (t/a EasyRealestate)* [2002] FSR 6. This was a summary judgement and so requires some circumspection in its consideration. I do not consider that this case assists easyGroup as it seems to me that it turned very much on the get-up of the defendant and his actions towards the plaintiffs. Mr Bernard Livesey QC (sitting as a deputy judge of the High Court) commented:

“I agree with the defendant that the claimants are not entitled to appropriate the word "easy" and prevent any businessman from using any name which includes the word "easy". However, in my judgment the test which requires to be established, that is to say that there is a likelihood of deception, is made out in this case not because the defendant has used the word "easy" but because of the four

elements which I have already described as part of the livery or get-up of the claimants.”

However, I do not consider that the case is damning to that of easyGroup either. The services of the defendant were estate agency services, some way from the travel industry. So I find the effects of the above case neutral.

150) Ms McFarland referred to the absence of confusion in the market place. There is no indication of any use of Easyrooms’ trade mark and so the absence of confusion tells me nothing.

151) easyGroup referred, in the evidence I summarised at paragraph 21, to the press playing on the word easy in relation to stories about them. All the articles were after the relevant date. However, if they were not this tells me little. Headline writers look for catchy puns. I notice that in the printouts exhibited at JR6 the press are making puns around the name of the airline Buzz, in headlines that would seem to deal with the launching of the airline.

152) I have found this case a difficult one to decide. In the end it has very much turned upon the evidence that has filed, or perhaps more pertinently the evidence that has not been filed. Much of the case has hinged upon the establishing of connections. In particular connections between the various services. easyGroup have failed, in my view, to establish these. The strength of the case of easyGroup might have been improved if they could have shown that there was a family of trade marks in the market place. I found the claims to enjoy a family of trade marks unconvincing. The evidence was simply not there.

153) All the grounds of invalidation are rejected.

154) Easyrooms Ltd is entitled to a contribution towards his costs and I therefore order easyGroup IP Licensing Limited to pay them the sum of £1500. This sum takes into account that very similar evidence and pleadings were filed by both sides in the opposition proceedings between them. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 22nd day of November 2002

**D.W. Landau
For the Registrar
the Comptroller-General**