

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION
No. 693313 AND A REQUEST BY WEGENER FALKPLAN BV
TO PROTECT A TRADE MARK IN CLASSES 9 AND 16**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 70343 BY EASYGROUP IP LICENSING LIMITED**

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BACKGROUND

1. On 21 April 1998 Wegener Falkplan BV (formerly Suurland Falkplan BV), on the basis of a Benelux registration, requested protection in the United Kingdom of the following trade mark:



in relation to the following goods:

Class 09

CD-Roms and computer programs (software) in the nature of maps

Class 16

Printed matter in the nature of software manuals.

I note that the International Registration holders claim the colours green and white as an element of the mark.

2. The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration were published in accordance with Article 10.

3. On 26 July 2000 EasyJet Airline Company Limited filed notice of opposition to the conferring of protection on this international registration. At the request of the UK attorneys

behalf of the opponents easyGroup IP Licensing Limited were later substituted as opponents. So far as I am aware nothing turns on this point. The grounds of opposition remain the same. The opponents are the proprietors of the following UK registrations:

No.	Mark	Class	Specification
2016785	EASYJET	16	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.
		39	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.
		42	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.
2112957	EASYTRAIN	39	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.
2112956	EASYBUS	39	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.

The statement of grounds also refers to a Community Trade Mark application No. 608570, but I understand that this application has since been withdrawn.

4. The opponents express their objections in the following terms:

“The opposed application is of an ordinary, non-distinctive device in combination with the words EASY and TRAVEL and is applied for in respect of goods in Class 9 as well as goods in Class 16 which are similar with the goods for which the earlier trade mark is protected. Accordingly, the mark applied for is similar to an earlier trade mark and the goods for which the opposed trade mark is applied for are similar with the goods for which the earlier trade mark is protected. Furthermore, there exists a likelihood of confusion on the part of the public and registration of the trade mark applied for would be contrary to the provisions of Section 5(2)(b) of the Act.

The Opponent has made substantial use of the EASYJET mark and other EASY prefixed marks in the United Kingdom in relation to travel related goods and services since a date prior to the application date for the trade mark applied for, namely, 1995. Consequently, the Opponent’s mark has acquired a reputation in the United Kingdom and use of the mark applied for without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the Opponent’s earlier trade marks. To the extent, if any, to which the goods specified in the mark applied for are considered dissimilar to those of the Opponent’s registrations, registration should in any event be refused in accordance with Section 5(3) of the Act.

At the date of application of the opposed mark, there existed considerable goodwill and reputation in the United Kingdom in the Opponent’s marks. Use of the mark applied for would amount to a misrepresentation, would damage the Opponent and would be liable to be prevented by the law of passing-off. Registration therefore should be refused in accordance with Section 5(4)(a) of the Act.

When filing its application, the Applicant would have been aware of the Opponent’s EASYJET trade mark and its other EASY prefixed marks and the Opponent’s reputation. Accordingly, the deliberate use of this combination and the application for registration of such a highly similar mark in respect of similar goods was made in bad faith and should therefore be refused in accordance with Section 3(6) of the Act.”

5. The International Registration holders (for ease of reference I will refer to them hereafter as the applicants) filed a counterstatement denying the above grounds.

6. Both sides ask for an award of costs in their favour.

7. Both sides filed evidence. The matter came to be heard on 28 January 2003 when the applicants were represented by Mr M Hickey of Castles and the opponents by Mr A Clarke of Marks & Clerk.

Opponents' Evidence

8. The opponents filed a witness statement by Nick Manoudakis, a Director of easyGroup (UK) Ltd. He says that he is responsible for the easy Group of companies of which the opponents are part. The facts in his witness statement are from his own knowledge or from his company's books and records.

9. I do not propose to provide a full summary of the contents of Mr Manoudakis' witness statement. The material date in these proceedings is 21 April 1998. A large part of what he has to say relates to periods after that date. To take two prime examples – a chain of internet cafés which trades under the name easyEverything was launched in June 1999 and a car hire business which trades under the mark easyRentacar was announced in August 1998 and publicised from May 1999 onwards. It seems, therefore, that the 'easy' concept has expanded in the period since April 1998. In the context of a developing business of this nature some care must be exercised to avoid current trading and knowledge colouring the position in April 1998. The key relevant facts to emerge from Mr Manoudakis' witness statement are that:

- the company is an operator of local scheduled airline carriers trading under the name easyJet;
- that trade commenced in November 1995;
- the company's operations are heavily internet-based. Thus ticket sales are primarily made through the company's website and job vacancies are advertised in the same way;
- the business ethos pervading the company's operations is simplicity, low cost and accessibility;
- turnover for 1997/98 is said to have been in excess of £77 million;
- total passenger numbers in 1998 were 1.7 million (whether this is a calendar or financial year figure (or other) is not clear);
- some £40 million has been spent on advertising of which £30 million has been spent in the UK though it is not said how much of this preceded the material date;
- in addition, large (but unspecified and undated) sums have been spent in publishing leaflets, brochures, catalogues, price lists and other promotional campaigns including advertising on buses, taxis, underground, posters and sandwich bags;

- the company's businesses have won numerous awards. Those listed, with one possible exception, are after the material date.

10. Mr Manoudakis refers to the following ways in which the company promotes its services and creates a brand identity:

“The use of the “easy” mark with a word which may bear some reference to the services provided so as to form a newly coined word; and

The presentation of the “easy” brand in lower case and the second part of the trading name with an initial capital letter, as in “easyJet”, “easyBus”, “easyTrain”, “easyEverything”, “easyRentacar” and “easyGroup”, the emphasis being on the distinctive element of the trading name, the “easy” mark.”

and

“Although there are other features which are used consistently in the Company's advertising, namely the colour orange and the “fat” font of the “easy” mark, it is the Company's belief that the most distinctive, and most repeatedly used, feature of the Company's brand identity is the “easy” mark.”

11. There are four attachments to Mr Manoudakis' witness statement but I am unable to find a single document that can confidently be placed within the relevant period.

Applicants' Evidence

12. The applicants filed a statutory declaration by Mark John Hickey, a Trade Mark Attorney with Castles, the applicants' professional representatives in this matter. The purpose of his declaration is to exhibit the results of a review of the UK Trade Marks Register for marks which prominently include the word EASY. He suggests that this co-existence is not surprising given the meaning attributable to the word EASY.

13. That completes my review of the evidence.

The Law

14. The Section 3(6) ground was withdrawn prior to the hearing. The remaining grounds are based on Section 5 of the Act. The relevant statutory provisions read:

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

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

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

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

(3) 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.

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

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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

Section 5(2)

15. I was referred to and accept that I must take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;

- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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 B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) 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*, paragraph 23;
- (e) 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*, paragraph 17;
- (f) 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*, paragraph 24;
- (g) 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*, paragraph 26;
- (h) further, 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*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

Similarity of goods

16. Mr Hickey realistically accepted that ‘printed matter in the nature of software manuals’ must be encompassed within the unrestricted term ‘printed matter’ in the opponents’ Class 16 specification for No. 2016785. Furthermore the applicants’ Class 9 goods are or may be the electronic equivalent of the Class 16 goods. It is common ground, therefore, that identical and similar goods are involved.

17. Although it is strictly not necessary for me to consider the point I should for completeness record that Mr Clarke also submitted that certain of the opponents' Class 39 services (particularly airline services etc) were also similar to the applicants' goods.

18. It was held in *CANON v MGM* that:

“In assessing the similarity of the goods or services concerned ... all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary ...”

19. In *British Sugar Plc v James Robertson Sons Ltd*, [1996] RPC 281 Jacob J also considered that trade channels should be taken into account.

20. Whilst I accept that at a high level of generality the users of airline services and the users of electronic maps and printed matter may coincide, in almost every other respect these goods and services must be considered some distance apart on the basis of the above tests.

Distinctive character of the opponents' mark

21. As I understand it the opponents claim an enhanced distinctive character for their EASYJET mark. The evidential basis for this claim is weak. There is a turnover figure for 1997/8 which may or may not span the periods before and after the material date and a passenger number figure which suffers from the same problem. Almost all of the remaining material is after, sometimes well after, the material date. Nevertheless one would have had to lead an unusually insular existence not to have encountered the mark EASYJET as one of the first of the so called no frills airlines. The nature of the business, the novelty of the concept and the press coverage received is enough to say that even by April 1998 a reputation had been established (trade having commenced in 1995). The question is what was the extent of that reputation at that time. In *DUONEBS Trade Mark*, BL O/048/01, Mr S Thorley QC, sitting as the Appointed Person, said:

“In my judgment, I believe what the ECJ had in mind was the sort of mark which by reason of extensive trade had become something of a household name so that the propensity of the public to associate other less similar marks with that mark would be enhanced. I do not believe that ECJ was seeking to introduce into every comparison required by Section 5(2), a consideration of the reputation of a particular existing trade mark.”

22. It may be that EASYJET did enjoy such a reputation by April 1998 but I find it impossible to reach a concluded view on the matter on the basis of the evidence before me. Bearing in mind that this has been a fast developing area of trade I cannot confidently say from the perspective of a decision being written in 2003 what the extent of the reputation of a business (started in 1995) was in April 1998. In any case so far as I can see that reputation has not been shown to extend to those goods in earlier trade mark No. 2016785 which I have found to be similar to the goods applied for.

23. It follows that I base my consideration of the distinctive character of the mark EASYJET on its inherent characteristics. I doubt that that materially disadvantages the opponents. Their mark is composed of commonplace elements, that is to say the well understood dictionary words EASY and JET. Nevertheless non distinctive elements have the capacity to create novel wholes when juxtaposed. That is in my view the case here. The mark alludes to the ethos of the airline in terms of simplicity, low cost and accessibility of operation but, unusually, by linking it to the mode of transport ie. jet. Strictly it is the service that is 'easy' not the plane itself. The concept embodied in the mark captures and embodies the spirit of the opponents' operation but it does so in a clever and novel way. In short it is a good and strong trade mark. If that is so of the core airline services it must be even more so when applied to printed matter and such like goods which are, as it were, at one remove from airline services. I, therefore, find that EASYJET has a high degree of distinctive character.

Similarity of the respective marks

24. The applied for mark is, like the opponents' earlier trade mark, composed of commonplace elements. Although Mr Hickey reminded me that it is more than simply the words EASY TRAVEL I doubt that the rectangular device and colour claim will feature as high in consumers' recollection as the words themselves. In relation to the goods of interest (maps and such like items) the words EASY TRAVEL are no more than commonplace elements. They allude in a not particularly oblique way to the nature of the goods. In short I regard the dominant component of the applied for mark to be the words EASY TRAVEL but that those words do not create a particularly strong mark.

25. With those preliminary observations in mind I go on to consider the visual, aural and conceptual similarities. Although the applied for mark is presented as two words and the earlier trade mark as a single word I do not consider anything turns on this point. The composition of EASYJET is as readily apparent as if it had been two words. Self evidently, therefore, both marks share the element EASY and do so at the start of the marks. The first syllable/element of marks has traditionally been held to be of particular importance. That is a point in the opponents' favour but it is more than offset by the fact that EASY is being used adjectively and therefore is not likely to be singled out. Rather it will be seen and referred to as part of the composite mark of which in each case it is part. The visual similarity rests with the common element. The nouns that follow in each case have no visual similarity and the overall visual impressions are quite distinct. Similar considerations apply in relation to aural usage and do not require further elaboration.

26. The position adopted by Mr Clarke in his skeleton argument was that "There is a strong conceptual similarity between the respective marks which outweighs any visual or phonetic dissimilarities in the suffixes." The point is not entirely without force in the sense that a jet is a mode of travel but the proposition seems to me to be based more on a loose association of ideas rather than conceptual similarity. JET and TRAVEL are not interchangeable terms. They are not synonyms for one another. One tends to be used as a shorthand form for a jet-propelled aircraft, the other is an abstract noun. The average consumer (the general public) who is deemed to possess the qualities set out in the *Lloyd Schuhfabrik* case (see above) is unlikely to engage in a mental process which seeks to make associations between marks. Alternatively, if that is

putting the matter too high, any conceptual association between the marks is relatively weak bearing in mind the commonplace elements in the marks and the weakly distinctive nature of the applied for mark.

Likelihood of confusion

27. The opponents' position is heavily dependent on three key considerations viz the presence of the common element EASY, the claimed conceptual similarity between the marks and identity and similarity of the goods.

28. Given that EASY is an ordinary word of the English language and the fact that the applicants' mark has descriptive overtones in the context of the goods applied for I am not persuaded that there is a likelihood of direct confusion with the opponents' mark assuming notional fair use of both.

29. The more relevant question implicit in the opponents' case based on conceptual similarity is whether any association that might be made between the marks causes the public to wrongly believe that the goods come from the same or economically linked undertakings. Bearing in mind the factors identified above I am not persuaded that the average consumer would consider that there was an association of ideas between the marks. Still less am I persuaded that if an association was made it would be anything other than a fleeting and superficial one. The test is whether there is a likelihood of confusion. In my view the answer to that is in the negative.

30. There is one further point under Section 5(2) that was touched on briefly in Mr Clarke's skeleton argument and at the hearing. That is the suggestion that the opponents have a family of marks. I indicated, and now confirm, that I saw no prospect of such a submission succeeding as even on the most favourable reading of the evidence the only mark that had been used by the material date was EASYJET. Professor Ruth Annand, sitting as the Appointed Person in *The Infamous Nut Co Ltd's* Trade Marks application, [2003] RPC 7 made it clear that an underpinning requirement for a family of marks' claim was that the marks must be in use.

“In some circumstances, it may be possible for the opponent to argue that an element in the earlier trade mark has achieved enhanced distinctiveness in the eyes of the public because it is common to a “family of marks” in the proprietorship and use of the opponent (*AMOR*, Decision no. 189/199 of the Opposition Division, OHIM O.J. 2/2000, p.235). However, that has not been shown by the evidence to exist in the present opposition and cannot, as contended by Mr Walters on behalf of the opponent, be presumed from the state of the register in Classes 29 and 31.”

31. The opposition fails under Section 5(2)(b).

Section 5(3)

32. It is fair to say that this was not pursued as a strong alternative to the Section 5(2) ground. On the evidence, and given the test laid down in *General Motors Corporation v Yplon SA* [1999] FSR 950 at paragraphs 26 and 27, the opponents have not substantiated the reputation necessary

as a starting point for an action under this provision. They face the further problems that the marks have a low level of similarity and the opponents' claims as to damaging consequences as a result of use of the later mark never advance beyond generalised statements. This ground also fails.

Section 5(4)

33. The conventional test for determining whether a party has succeeded under this section has been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC sitting as the Appointed Person, in *WILD CHILD* Trade Mark [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- (1) that the opponents' goods have acquired a goodwill or reputation in the market and are known by some by some distinguishing feature;
- (2) that there is a misrepresentation by the applicants (whether or not intentional) leading or likely to lead the public to believe that goods offered by the applicants are goods of the opponents;
- (3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicants' misrepresentation.

34. The very full guidance given in the *WILD CHILD* case by Mr Hobbs by reference also to Halsbury's Laws of England can be found at pages 460 and 461 of that decision.

35. For the reasons given above it is doubtful on the evidence that the opponents can be said to have substantiated goodwill/reputation at the material date. Even if I were to accept that the first leg of the test had been met it would be in relation to airline services only. Those services are considerably further removed from the goods of the application than the goods on the basis of which I have rejected the Section 5(2) ground. At the hearing I drew the representatives' attention to *Easyjet Airline Co. Ltd v Dainty*, [2002] FSR 6, an action launched against the domain name *easyRealestate.co.uk* where the Deputy Judge found as follows:

"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."

36. Thus the claimants' success in that case was heavily dependent on the fact that the defendant had adopted a number of features (itemised in paragraph 7 of the judgment) which cumulatively led to the view that the website was calculated to take advantage of as close an association with *easyJet* as the defendant could devise.

37. Absence of intention to deceive (which the opponents accept here) is not proof against a passing off action. But it is clear that the sort of calculated adoption of features of easyJet's trade livery which was an influencing factor in the above case are simply not present here. Given the low level of similarity between the marks and the distance between the goods applied for and airline services the opponents cannot succeed under this head.

38. The applicants have been successful and are entitled to a contribution towards their costs. I order the opponents to pay them the sum of £1250. 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 10 day of February 2003

**M Reynolds
For the Registrar
the Comptroller-General**