

**O-462-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**TRADE MARK REGISTRATION NO. 3287143**

**IN THE NAME OF ARNOLD CLARK AUTOMOBILES LIMITED**

**IN RESPECT OF THE TRADE MARK:**

**ARNOLD CLARK EASY PAY**

**AND**

**AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO**

**UNDER NO. 502148 BY EASYGROUP LIMITED**

## BACKGROUND

1) The trade mark ARNOLD CLARK EASY PAY stands registered in the name of Arnold Clark Automobiles Limited ('the proprietor'). It was applied for on 01 February 2018 and entered in the register on 04 May 2018 in respect of the following services:

**Class 36:** Financial, insurance and monetary affairs; loan services; credit services; financial services for the leasing, purchase, insurance and maintenance of vehicles including motor vehicles; lease purchase financing of motor vehicles; provision of personal contract purchase (PCP) financing for the purchase of vehicles; credit services relating to motor vehicles; insurance services relating to vehicles; brokerage services relating to the insurance of vehicles; financial services connected with the sale and lease back of vehicles; provision of operating leases (financial); provision of operating leases (financial) in connection with vehicles; extended warranty insurance, motor vehicle breakdown insurance, warranty services, vehicle warranty services, warranty insurance services, insurance underwriting services; financial guarantee services for the reimbursement of expenses incurred as a result of vehicle accident or breakdown; provision of financial advice to accident investigators; underwriting of personal accident insurance; providing agency services in relation to making insurance claims; financial services relating to the provision of contract hire of vehicles; secured loans based on the provision of instalment credit agreements on vehicles; benefit card, cash card, charge card, credit card and debit card payment and validation services; credit services; hire purchase, financing; issuing of tokens of value; financial services associated with promotional incentive schemes and loyalty schemes; lending services to merchants for the purpose of financing store inventories of vehicles; providing risk management analysis for vehicles and providing risk management analysis for fleets of vehicles (financial); accident management services (liaising with insurers, uninsured loss recovery, personal injury assistance); information, advisory and consultancy services relating to all of the aforesaid services.

**Class 37:** Repair, maintenance and servicing of vehicles; accident repair services; vehicle body work repair services; vehicle undercoating and painting services; vehicle refuelling services; tyre maintenance and repair services; tyre fitting services; tyre, brake, clutch and exhaust fitting services; fitting of replacement vehicle parts; vehicle washing, cleaning and polishing services; vehicle battery charging; valeting services for vehicles; car valeting services; vehicle tuning services; inspection of vehicles; repair of accident damage to vehicles; accident management services (damage assessment (repairs), arrangement of vehicle repairs); arranging for the repair and recovery of vehicles; anti-rust treatment for vehicles; installation of replacement windows and windscreens for vehicles; assembling, installation, servicing and repair of accessories for vehicles; emergency vehicle repair services; installation of parts and fittings for vehicles; vehicle lubricating and greasing services; reconditioning of vehicle engines; refurbishment of vehicles; vehicle damage evaluation services; installation and fitting of car safety seats for children, infants and babies; rental of vehicle repair and maintenance equipment; glazier services for vehicles; diagnostic, repair, maintenance and appraisal services for vehicles; vehicle detailing; information, advisory and consultancy services relating to all of the aforesaid services.

**Class 42:** Certification services for vehicles; vehicle appraisal services; testing of vehicles for roadworthiness; MOT certification services; testing of vehicles; technological and research services relating to motor vehicles, parts and fittings for vehicles, and for car safety seats for children, infants and babies; preparation of engineers reports; inspection of motor vehicles for road worthiness; inspection services for persons buying or selling vehicles; vehicle verification; technical and professional consultancy services relating to vehicles and/or driving; safety technology services relating to vehicles; website design and development; compilation of web pages on the Internet; computer software management; information services relating to the testing and certification of vehicles; hosting digital content for others; computer services including design of personal home pages, website design services, website hosting services, maintenance of websites and hosting online web facilities for others; consulting and technical assistance in the fields of

designing, creating, hosting and maintenance of websites for others; design and development of software applications for use through a personalised webpage interface; hosting digital content on the Internet; creating data including images, graphics, sound, text or audio-visual information via the Internet or other communications networks; scientific, technological, research, design and development services relating to vehicles, telecommunications, navigational, tracking, location and fleet management apparatus and software; advice and design services in respect of traffic and vehicular information, of instruction and equipment, and of tracking and immobilisation of vehicles by remote control; research in the field of carbon emissions; analysis of carbon emissions; provision of advice and consultancy in relation to reducing carbon emissions and in reducing fuel consumption; maintenance of databases of vehicles for sale, hire, lease or rental; maintenance of databases of spare parts for vehicles; maintenance of databases; maintenance of databases; maintenance of databases of vehicles; providing risk management analysis for vehicles and providing risk management analysis for fleets of vehicles (provision of technical information); information, advisory and consultancy services relating to all of the aforesaid services.

2) On 11 July 2018, easyGroup Limited ('the applicant') filed an application to have this trade mark declared invalid under the provisions of sections 47(2)(a) and 5(2)(b) of the Trade Marks Act 1994 ('the Act'). The relevant provisions read as follows:

“47. - (1) ...

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

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

(b) ...

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

And:

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

(a) .....

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

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

3) The applicant relies upon four earlier European Trade Mark Registrations<sup>1</sup>. Those registrations cover large numbers of goods and services. Full details of the goods and services relied upon can be found in the Annex to this decision. I record here the following information about the earlier marks:

| <b>Trade Mark details</b>   | <b>Goods and Services relied upon</b>               |
|---|---|
| <b>TM Registration No: EU014365878</b><br><br>EASYCURRENCY<br><br><b>Filing date: 14 July 2015</b><br><b>Date of entry in register: 14 January 2016</b>                     | All goods and services in classes 9, 36, 39 and 42. |
| <b>TM registration No: EU015729891</b><br><br><br><br><b>Filing date: 05 August 2016</b> | All services in classes 36 and 39.                  |

<sup>1</sup> A fifth mark (TM Registration No. EU017873259) was originally pleaded but later withdrawn by the opponent as per the written submissions dated 27 November 2018.

|   |   |
|---|---|
| <p><b>Date of entry in register: 24 August 2017</b></p>   |   |
| <p><b>TM Registration No: EU010583111</b></p> <p>EASYGROUP</p> <p><b>Filing date: 23 January 2012</b></p> <p><b>Date of entry in register: 03 July 2014</b></p>   | <p>All goods and services in classes 09, 12, 36, 39 and 42.</p> |
| <p><b>TM Registration No: EU016931396</b></p>  <p><b>Filing date: 28 June 2017</b></p> <p><b>Date of entry in register: 09 March 2018</b></p> | <p>All services in classes 36 and 42.</p>                       |

4) The applicant's registrations are earlier marks, in accordance with section 6 of the Act. As they all completed their registration procedure less than five years prior to the publication date of the contested mark, none are subject to the proof of use conditions, as per section 6A of the Act. The applicant claims that all its marks enjoy enhanced distinctiveness through use and are similar to the proprietor's mark. It also claims that the services covered by its registrations are identical and/or similar to those of the proprietor such that there exists a likelihood of confusion.

5) The proprietor filed a counterstatement. It puts the applicant to proof of its claim to enhanced distinctiveness of its marks and denies that its mark is similar to any of the applicant's earlier marks. It does not admit to similarity or identity between any of the respective services, arguing that the differences between the marks are such that any identity/similarity between the goods and services is irrelevant.

6) The applicant is represented by Kilburn & Strode LLP; the proprietor by Murgitroyd & Company. No evidence has been filed in these proceedings with both parties opting to file written submissions only during the evidence rounds. Neither party has requested a hearing nor filed written submissions in lieu. I now make this decision after a careful consideration of the papers before me.

## **DECISION**

7) Section 5(2)(b) of the Act states:

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

(a)...

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

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

8) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-

120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles**

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

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

9) All relevant factors relating to the goods and services should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU, Case C-39/97, stated at paragraph 23 of its judgment:

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

10) Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

11) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, it was stated:

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

12) Further, in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) (*‘Meric’*), the GC held:

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

are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

13) I first consider the services of the ‘easyMoney’ mark. The applicant claims that the services covered by that registration, in classes 36 and 39, are similar to the proprietor’s services. However, it gives me no submissions as to why it considers them to be similar, (unlike for its other earlier marks for which it sets out a table identifying where it considers the similarity/identity to lie). The ‘easyMoney’ mark covers ‘Real estate affairs; advice and consultancy relating to the aforesaid services’ in class 36 and various travel and transport services in class 39. I can see no obvious similarity between any of those services with the proprietor’s services having regard, in particular, for their respective intended purpose and channels of trade. They are also not in competition or complementary in the sense described in the case law. In the absence of any submissions from the applicant as to why I should find to the contrary, I find that none of the services covered by the ‘easyMoney’ mark are similar to any of the services of the contested mark. Without any similarity, the application for invalidation must fail insofar as it is based upon the ‘easyMoney’ mark.<sup>2</sup> Accordingly, I make no further mention of that earlier mark in my assessment of the likelihood of confusion.

14) I now turn to the other three marks relied upon. As all the proprietor’s services in class 36 are encapsulated by the applicant’s ‘financial services’ covered by the ‘EASYCURRENCY’ and ‘EASYGROUP’ marks they are identical. A number of the proprietor’s services are also obviously identical to the applicant’s ‘banking services’, ‘monetary affairs’ and ‘insurance services’ covered by the ‘easyConveyance’ mark.

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<sup>2</sup> In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that: “49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

15) The proprietor's 'website design and development; compilation of web pages on the Internet; design and development of software applications for use through a personalised webpage interface' in class 42 are identical to the applicant's 'posting, creating and maintaining websites for others' ('EASYCURRENCY') and 'hosting, creating and maintaining websites for others' ('EASYGROUP'). The proprietor's 'hosting digital content on the internet' is also identical to the applicant's 'creation and hosting of platforms on the internet' ('easyConveyance').

16) Given that a number of services covered by the applicant's 'EASYCURRENCY', 'EASYGROUP' and 'easyConveyance' marks are, as I have identified above, clearly identical to the proprietor's services in classes 36 and 42, I intend, for the sake of procedural economy, to consider first the likelihood of confusion on the basis of those identical services. If the applicant does not succeed in respect of those identical services, it cannot be in any better position in respect of any of the other goods or services relied upon under those marks. I will proceed on that basis.

### **Average consumer and the purchasing process**

17) It is necessary to determine who the average consumer is for the respective services and the manner in which they are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

18) The average consumer of the parties' services in classes 36 includes both the general public and business professionals. The financial/monetary services at issue

are wide ranging such that the degree of attention is likely to vary depending on the precise nature of the service. I would nevertheless expect the purchase for all the services in class 36 to be a well-considered one for both types of consumer given that they are likely to take account of factors such as charges, interest rates, accessibility of services. Turning to the parties' services in class 42, the average consumer is likely to be a business user rather than the general public. Again, I would expect these services to be well-considered given that they are unlikely to be inexpensive and may require consideration of a number of factors and/or discussions with website developers/company representatives to ensure that the product is tailored to meet the consumer's needs.

19) I would expect all the relevant services at issue in classes 36 and 42 to be encountered primarily by visual means on websites, brochures and signage over premises etc. However, aural use of the marks is also an important consideration bearing in mind word of mouth recommendations or discussions with bank clerks, sales representatives or website developers (for example).

### **Comparison of marks**

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

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

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

21) The marks to be compared are:

| Applicant's marks  | Proprietor's mark            |
|--|------------------------------|
| <p>Mark 1:<br/>EASYCURRENCY</p> <p>Mark 2:<br/>EASYGROUP</p> <p>Mark 3:<br/> </p> | <p>ARNOLD CLARK EASY PAY</p> |

22) The proprietor's mark consists of the words 'ARNOLD CLARK EASY PAY' in plain block capitals. The mark naturally splits into two elements; the full name 'ARNOLD CLARK' and 'EASY PAY'. Of those two elements, it is the name which carries considerably more weight in the overall impression owing to: i) its far greater degree of distinctiveness (if the 'EASY PAY' element has, of itself, any degree of distinctiveness, it is of a very low degree) and ii) its prominent position at the beginning of the mark.

23) As to the applicant's marks, the closest of these to the proprietor's mark is clearly 'EASYCURRENCY' (mark 1).

24) The overall impression of mark 1 is based on the combination of the two recognisable words of which it consists ('EASY' and 'CURRENCY') with neither word having more weight than the other.

25) There are a number of obvious visual and aural differences between mark 1 and the proprietor's mark. Indeed, there are more points of difference than similarity. The single point of coincidence lies in the common presence of the word 'EASY' which is present at the beginning of the applicant's mark and as the third word in the proprietor's mark. Overall, I find them to be visually and aurally dissimilar. If I am wrong on that, any visual and aural similarity is very low.

26) Conceptually, the combination of 'EASY' and 'CURRENCY' evokes the idea of currency that is, in some way, easy to use or obtain. I consider this concept to be similar to a medium degree to the second element of the proprietor's mark, 'EASY PAY' which is likely to evoke the idea of easy payment. However, the presence of the name in the proprietor's mark is a clear point of conceptual difference. Overall, there is a low to medium degree of conceptual similarity between mark 1 and the proprietor's mark.

27) Marks 2 and 3 are clearly no more visually or aurally similar to the proprietor's mark. Again, I find them to be visually and aurally dissimilar to the proprietor's mark or, at best, visually and aurally similar to a very low degree. Further, 'EASYGROUP' evokes no clear concept at all and 'easyConveyance' evokes the idea of conveyancing services that are easy to use in some way. As such, neither mark 2 or 3 evokes any concept that is shared by the proprietor's mark.

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

28) The distinctive character of the earlier marks must be considered. The more distinctive they are, either by inherent nature or by use, the greater the likelihood of

confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

29) All of the earlier marks consist of the well-known, everyday word, ‘easy’ combined with a second well-known word, being either ‘currency’, ‘group’ or ‘conveyance’ (the latter also being presented on an orange background). The word ‘easy’ is likely to indicate to the consumer that the relevant services are easy to use. As such, ‘easy’, of itself, is low in distinctiveness. Further, the word ‘currency’, in relation to the financial services covered by the ‘easycurrency’ mark is, of itself, descriptive in relation to such services for obvious reasons. Bearing these factors in mind, together with my earlier findings as to the conceptual messages the earlier marks, as wholes, are likely to portray, I find that, mark 1 (easycurrency) is inherently distinctive to a low degree in relation to financial services (and the like) and has an average degree of inherent distinctiveness for the services in class 42 of that

registration. Marks 2 and 3 are each inherently distinctive to an average degree in relation to the services in classes 36 and 42 of those registrations. The degree of distinctiveness of each earlier mark stems from the combination of the two words of which they consist (the orange background in mark 3 does nothing to elevate the distinctiveness of that mark to any higher degree).

30) As there is no evidence before me, there is nothing to show that the inherent distinctiveness of any of the earlier marks has been enhanced through use.

### **Likelihood of confusion**

31) The applicant submits:<sup>3</sup>

“20. Customers of easyMoney, easyCurrency and easyConveyance might naturally expect EASY PAY to be part of the same stable of services. They look and feel the same. The Applicant enjoys protection for a suit of similar marks, and EASY PAY looks like an extension of that. That is a likelihood of confusion...”

32) I note that the proprietor responded to this statement in the following terms:

“[This] suggests that the customers would recognise easyMoney, EASYCURRENCY and easyConveyancy all as a family of services emanating from the applicant, because they would be aware that all three of these trade marks are owned by the applicant. This suggests a reputation in a family of marks, which has **not** been claimed and has **not** been demonstrated by the applicant. In fact, no such evidence has been provided and therefore, the only basis on which these invalidity proceedings can move forward is to compare each of the marks on which the applicant had based this action for invalidity separately with the mark in suit.”

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<sup>3</sup> Written submissions dated 27 November 2018, paragraph 20

33) I agree with the proprietor. The applicant did not plead a ‘family of marks’ in its application for invalidation let alone file any evidence to show that any of the marks relied upon are used on the market. Its arguments on this point must therefore be disregarded in accordance with *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, where the CJEU stated:

“62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a ‘family’ or ‘series’ of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a ‘family’ or ‘series’ of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a ‘family’ or ‘series’, the earlier trade marks which are part of that ‘family’ or ‘series’ must be present on the market.

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

66 It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled to disregard the arguments by which the appellant claimed the protection that could be due to 'marks in a series'."

34) When conducting the global assessment of the likelihood of confusion, I must keep in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods/services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

35) I have no hesitation in finding that there is no likelihood of direct confusion between the contested with any of the earlier marks. This is because, insofar as mark 1 is concerned, the identity between the services and low to medium degree of conceptual similarity are not enough to counterbalance the lack of any visual and aural similarity between the marks (or, at best, very low degree of visual and aural similarity) in the light of the well-considered nature of the purchase. The likelihood of direct confusion in respect of marks 2 and 3 is even less likely given the lack of any conceptual similarity between either of those marks and the contested mark.

36) I now turn to consider whether there is a likelihood of the consumer believing that the respective services emanate from the same (or linked) undertaking(s) (also known as 'indirect confusion'). In this connection, I note that in *L.A. Sugar Limited v*

*By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

37) Further, in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

38) The judgment in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch) is also of assistance in the instant case where Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

39) Further, in *Annco, Inc. V OHIM*, Case T-385/09, the GC considered an appeal against OHIM’s decision that there was no likelihood of confusion between ANN TAYLOR LOFT and LOFT (both for clothing and leather goods) and found that:

“48. In the present case, in the light of the global impression created by the signs at issue, their similarity was considered to be weak. Notwithstanding the identity of the goods at issue, the Court finds that, having regard to the existence of a weak similarity between the signs at issue, the target public, accustomed to the same clothing company using sub-brands that derive from

the principal mark, will not be able to establish a connection between the signs ANN TAYLOR LOFT and LOFT, since the earlier mark does not include the 'ann taylor' element, which is, as noted in paragraph 37 above (see also paragraph 43 above), the most distinctive element in the mark applied for.

49 Moreover, even if it were accepted that the 'loft' element retained an independent, distinctive role in the mark applied for, the existence of a likelihood of confusion between the signs at issue could not for that reason be automatically deduced from that independent, distinctive role in that mark.

50 Indeed, the likelihood of confusion cannot be determined in the abstract, but must be assessed in the context of an overall analysis that takes into consideration, in particular, all of the relevant factors of the particular case (*SABEL*, paragraph 18 above, paragraph 22; see, also, Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37), such as the nature of the goods and services at issue, marketing methods, whether the public's level of attention is higher or lower and the habits of that public in the sector concerned. The examination of the factors relevant to this case, set out in paragraphs 45 to 48 above, do not reveal, prima facie, the existence of a likelihood of confusion between the signs at issue."

40) Even if I were to accept the applicant's contention that the 'EASY PAY' element of the contested mark plays an independent distinctive role, I do not consider that there is a likelihood of indirect confusion with any of the earlier marks notwithstanding the identical services in play. The word 'easy', of itself, is low in distinctiveness and is not one which the average consumer would expect to be exclusive to one undertaking. The inherent distinctiveness of each earlier mark (which ranges from low to average depending on the mark and services in question) comes from the combination of the two words within it. With these factors in mind, I do not consider that the visual and aural similarities between any of the respective marks, and the medium degree of conceptual similarity between mark 1 and the 'EASY PAY' element of the contested mark, are sufficient to lead an average consumer, making a well-considered purchase, to believe that the respective services come from the same, or linked, undertaking(s). It follows, as per my

comments in paragraph 16, that the application for invalidation fails in its entirety insofar as it is based upon marks 1, 2 and 3.

41) I should add that if my finding that none of the services covered by the 'easyMoney' mark are similar to those of the contested mark is found to be wrong, that registration offers the applicant no stronger prospect of success because i) the services covered by that registration could be no more than similar (rather than identical) to the contested services, ii) the level of aural, visual and conceptual similarity would be no greater for that mark than the 'easycurrency' mark and iii) in the light of the two latter factors, there would be no likelihood of direct or indirect confusion for similar reasons to those given in paragraphs 35 and 40 above, even allowing for an average degree of inherent distinctiveness of that earlier mark in relation to the services covered by it and the possibility that the degree of attention may be less than well-considered.

## **OUTCOME**

42) The application to invalidate the trade mark registration fails.

## **COSTS**

43) As the proprietor has been successful, it is entitled to a contribution towards its costs. Using the guidance in Annex A of Tribunal Practice Notice 2/2016, I award the proprietor costs on the following basis:

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| Reviewing the Application for invalidation<br>and preparing the counterstatement | £300        |
| Written submissions  | £300        |
| <b>Total:</b>  | <b>£600</b> |

44) I order easyGroup Limited to pay Arnold Clark Automobiles Limited the sum of **£600**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated 9 August 2019**

**Beverley Hedley  
For the Registrar,  
the Comptroller-General**

**ANNEX**

| <b>Earlier mark</b> | <b>Goods and services relied upon</b>   |
|---------------------|---|
| EASYCURRENCY        | <p><b>Class 9</b></p> <p>Electrical apparatus and instruments, namely, money receiving and dispensing machines; electronic numeric displays; flat screens; automated banking machines; ticket terminals; automated cash machines; cash dispensing machines; cash registers; calculating machines; apparatus for processing card transactions and data relating thereto and for payment processing; apparatus for verifying data on magnetically encoded cards; magnetic cards; magnetically encoded and smart (programmable) cards; computer software, hardware and firmware; 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 the world wide web; parts and fittings for the aforesaid goods.</p> <p><b>Class 36</b></p> <p>Banking and financial services; computerised banking and financial services; provision of financial information; cash dispensing services; cheque and cash paying in services; rental, hire and leasing of equipment for processing financial cards and data relating thereto; processing of data relating to card transactions and other payment</p> |

transactions; credit card, charge card, cash card, cheque guarantee card, payment card and debit card services; card and cash replacement services; provision of finance, money exchange and money transmission services; currency services, bureau de change services; foreign exchange services; information and advisory services relating to the aforesaid services; unsecured and secured personal loans, car financing, mortgages, ISA's and other investment funds, deposit accounts and credit card services; insurance services; monetary affairs, banking, banking services, real estate affairs; advice and consultancy relating to the aforesaid services.

**Class 39**

Transport; packaging and storage of goods; travel arrangement; travel information; provision of car parking facilities; transportation of goods, passengers and travelers by air, land, sea and rail; airline and shipping services; airport check-in services; arranging of transportation of goods, passengers and travelers by land and sea; airline services; baggage handling services; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft, vehicles and boats; chauffeur services; taxi services; bus services; coach services; rail services; airport transfer services; airport parking services; aircraft parking services; escorting of travelers; travel agency services; tourist office services; advisory and information services relating to the aforesaid services; information services relating to transportation services, travel information and travel booking services provided on-line from a computer database or the Internet.

**Class 42**

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|   | <p>Developing and designing computer hardware, firmware and software for banking, self service banking systems, cash dispensers, automatic teller machines, terminal units, cash register terminals, information terminals, ticket terminals, portable computers provided with display and scanner, money receiving and dispensing machines; computer consultancy services in the field of automated payment services; computer consultancy services in respect of computer software relating to automated payment services; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; posting, creating and maintaining websites for others; Internet 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 and information technology; 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; information, advisory and consultation services relating to all the aforesaid services including such services provided via the Internet.</p> |
|  | <p><b>Class 36</b></p> <p>Real estate affairs; advice and consultancy relating to the aforesaid services.</p> <p><b>Class 39</b></p> <p>Transport; packaging and storage of goods; travel arrangement; travel information; provision of car parking</p>  |

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|                  | <p>facilities; transportation of goods, passengers and travelers by air, land, sea and rail; airline and shipping services; airport check-in services; arranging of transportation of goods, passengers and travelers by land and sea; airline services; baggage handling services; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft, vehicles and boats; chauffeur services; taxi services; bus services; coach services; rail services; airport transfer services; airport parking services; aircraft parking services; escorting of travelers; travel agency services; tourist office services; advisory and information services relating to the aforesaid services; information services relating to transportation services, travel information and travel booking services provided on-line from a computer database or the Internet.</p> |
| <p>EASYGROUP</p> | <p><b>Class 9</b></p> <p>Communications, photographic, measuring, signalling, checking, scientific, optical, nautical, life-saving and surveying apparatus and instruments; consumer domestic electrical and electronic apparatus and instruments, namely, audio disc players, audio disc recorders, compact disc players, compact disc recorders, radio tuners, audio receivers, MP3 players, audio amplifiers, audio speakers, headphones, earphones, microphones, plasma display panel televisions, liquid crystal display televisions, television receivers, liquid crystal displays, liquid crystal display projectors, DVD players, DV recorders, video cameras, digital still cameras, cameras, mobile phones, audio players for automobile use, radio receivers for automobile use, web cameras, car</p>   |

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|  | <p>navigation apparatus, battery chargers; 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 the world wide web; sound and video recordings; sound and video recording and playback machines; coin freed apparatus; televisions and television games apparatus and instruments; photographic and cinematographic films prepared for exhibition; photographic transparencies, electronic publications(downloadable); educational and teaching apparatus and instruments; electronic, magnetic and optical identity and membership cards; sunglasses and sunvisors; mouse mats; protective clothing and headgear; parts and fittings for all the aforesaid goods.</p> <p><b>Class 12</b></p> <p>Scooters, bicycles, vehicles, apparatus for locomotion by land, air or water; parts for land, air or water locomotion apparatus.</p> <p><b>Class 36</b></p> <p>Financial and insurance services; monetary affairs, banking, banking services, real estate affairs; advice and consultancy relating to the aforesaid services.</p> <p><b>Class 39</b></p> <p>Transportation of goods, passengers and travellers by air; airline and shipping services; airport check-in services;</p> |
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arranging of transportation of goods, passengers and travellers by land and sea; airline services; bus transport services, car transport services, coach services, baggage handling services; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft, vehicles and boats; aircraft parking services; aircraft fuelling services, travel reservation and travel booking services provided by means of the world wide web, information services concerning travel, including information services enabling customers to compare prices of different companies; 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 42**

Meteorological information services; consultancy, development, advice, analysis, design, evaluation and programming services relating to computer software, firmware, hardware and information technology; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; hosting, creating and maintaining websites for others; consultancy and advice relating to the evaluation, choosing and implementation of computer software, firmware, hardware, information technology and of data-processing systems; rental of computer software, firmware and hardware; provision of information relating to technical matters and information technology; scientific and technological services and research and design relating thereto, industrial analysis and research services; including but not limited to, all the aforesaid services provided via telecommunications

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|   | <p>networks, by online delivery and by way of the Internet and the world wide web; provision of access to computers.</p>   |
|  | <p><b>Class 36</b></p> <p>Banking; computerised banking; cash dispensing services; cheque and cash paying in services; rental, hire and leasing of equipment for processing financial cards and data relating thereto; processing of data relating to card transactions and other payment transactions; credit card, charge card, cash card, cheque guarantee card, payment card and debit card services; card and cash replacement services; provision of finance, money exchange and money transmission services; currency services, bureau de change services; foreign exchange services; information and advisory services relating to the aforesaid services; unsecured and secured personal loans, car financing, mortgages, ISA's and other investment funds, deposit accounts and credit card services; insurance services; monetary affairs, banking, banking services, computer consultancy services in the field of automated payment services; advice and consultancy relating to the aforesaid services.</p> <p><b>Class 42</b></p> <p>Creation and hosting of platforms on the internet; hosting online web facilities for others for sharing online content; providing online non-downloadable software for use in property transactions.</p> |