

# TRADE MARKS ACT, 1996

## Decision in Hearing

IN THE MATTER OF an application for registration of Trade Mark No. 226996 and in the matter of opposition thereto.

**COLIN JARRETT**

**Applicant**

**EASYGROUP IP LICENSING LIMITED**

**Opponent**

### Application for registration

1. On 9 April, 2003, Colin Jarrett, an Irish citizen of Killinvoy House, Knckroghery, Co. Roscommon, made application (No. 2003/00651) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the following series of four trade marks in respect of the specification of goods and services in Classes 16 and 39 listed below.



EASYMOVES

EASYMOVE

*Class 16: Paper and cardboard packaging; cardboard flat pack box used in packaging and storage; articles of cardboard for use in packaging; cardboard boxes (packaging) in collapsible form.*

*Class 39: Collection, packaging, storage, sending, delivery (transportation) of goods.*

2. The application was accepted for registration and advertised accordingly under No. 226996 in Journal No. 1975 on 20 August, 2003.

3. Notice of opposition to the registration of the series of marks pursuant to Section 43 of the Act was filed on 14 November, 2003 by easyGroup IP Licensing Limited of The Rotunda, 42-43 Gloucester Crescent, Camden, London NW1 7DL, United Kingdom. On 17 February, 2004, the Applicant filed a counter-statement against the opposition and also requested that the application be amended by the deletion of the first two marks in the series. That amendment was accepted and published in Journal No. 1991 on 7 April, 2004 and the Opponent was notified accordingly. Evidence was subsequently filed by the parties under Rules 20, 21 and 22 of the Trade Marks Rules, 1996 (“the Rules”).
4. The matter became the subject of a hearing before me, acting for the Controller, on 8 March, 2007. The parties were notified on 18 April, 2007 that I had decided to dismiss the opposition and to allow the series of marks, as amended, to proceed to registration. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Opponent in that regard pursuant to Rule 27(2) filed on 24 May, 2007<sup>1</sup>.
5. Throughout this statement of grounds, I refer to the Applicant’s trade mark as EASYMOVES/EASYMOVE, intending, of course, either of the marks in the series (as amended) used individually.

### **Scope of the opposition**

6. The opposition is based primarily on the Opponent’s proprietorship and use of a number of trade marks commencing with the word EASY. The notice of opposition includes a list of such marks (see Appendix I), which are either registered as Community Trade Marks or were the subject of applications for registration as such<sup>2</sup>. On the basis of these earlier marks, the Opponent raises objection against the present application under Sections 10 and 61 of the Act.

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<sup>1</sup> The request for a written statement of grounds of the decision was filed outside of the time specified in Rule 27(2) but the time in question was extended pursuant to Rule 63(4) upon receipt of a satisfactory explanation of the delay in requesting an extension.

7. The notice of opposition also includes a number of so-called “absolute grounds” of opposition under Section 8 of the Act, to the effect that the mark applied for is not capable of distinguishing the goods and services in question, that it is of such a nature as to deceive, that its use is prohibited by law and that the application for registration was made in bad faith by the Applicant. It is also claimed that the Applicant does not use or have a *bona fide* intention of using the mark in relation to all of the goods and services of the application and that the application should be refused under Sections 37(2) and 43(4) of the Act.

### **The evidence<sup>3</sup>**

#### *Rule 20*

8. Evidence submitted by the Opponent under Rule 20 consisted of –
- a statutory declaration (and Exhibits JR1-JR23) dated 31 March, 2005 of James Rothnie, Director of Corporate Affairs of easyJet Airline Company Ltd. and a number of related companies, and
  - a statutory declaration (and Exhibits MROC1 and MROC2) dated 30 March, 2005 of Mary Rose O’Connor, Trade Mark Agent of Cruickshank & Co.
9. The principal relevant facts to emerge from Mr. Rothnie’s declaration are as follows:
- the Opponent is a member of a group of companies, which includes easyJet Airline Company Ltd., easyCar (UK) Limited, easyValue Limited, easyGroup (UK) Limited and easyInternetCafe Limited,
  - the Opponent holds and administers the intellectual property rights generated by these companies, which Mr. Rothnie refers to as “the ‘easy’ brand”,

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<sup>2</sup> The notice of opposition also includes reference to several series of trade marks that have been the subject of applications for registration in the United Kingdom but these are not relevant to the proceedings in this jurisdiction.

<sup>3</sup> review of the evidence confined to matters or relevant fact or claimed fact

- easyJet airline was launched in November, 1995 as a low cost scheduled service based at “easyLand” near Luton Airport in the United Kingdom, which takes its bookings primarily via the internet with confirmation and booking references being emailed to the customer,
- easyJet has been a huge commercial success achieving dramatic increases in the number of routes flown and passengers carried in the period prior to the date of filing of the opposed application for registration (the relevant date) and it has been the subject of advertising and promotion on a massive scale throughout the European Community,
- in addition to passenger services, easyJet airline provides a range of airline services under various “easy” prefixed bands – “easyKiosk” in-flight catering, “easyJet ramp” baggage handling, “easyTech” aircraft repair and maintenance,
- easyJet has won numerous awards in recognition of its commercial success and customer satisfaction rating and the brand name has acquired a high level of recognition in the United Kingdom and is associated with the concept of a low cost, “no frills” easily accessed online service,
- that brand identity has been built upon by diversification into other areas of commerce under “easy” prefixed trade marks, including “easyRentacar” (subsequently renamed “easyCar”) car rental services, “easyEverything” internet café chain, “easy.com/easydotcom” email services, “easyValue” online price comparator services and “easyMoney” financial services,
- these ventures have also achieved commercial success, which is attributable to some degree to mutual cross-promotion of the respective services via their individual websites, the effect of which is to maximise the potential of the “easy” brand,
- the “easy” brand identity is preserved across the various trade marks in use by the consistent use of the initial “e” in lower case, the conjoining of the word “easy” with another word or words that is related to the services in question,

the capitalisation of the initial letter of that other word and the use of a distinctive “fat” font (all of which features may be seen in a number of the Community Trade Marks listed in the Appendix).

10. In her declaration, Ms. O’Connor refers to email correspondence sent on behalf of the Applicant to the Opponent in February, 2003 proposing a collaboration in the promotion of the “Easymoves” service, including through links from the easyJet website. She exhibits photographs sent to the Opponent at that time showing the use of the trade mark in the manner **easyMoves**, i.e., similar to the manner in which the Opponent uses its trade marks and to the style of the first two trade marks in the series as originally applied for by the Applicant.

*Rule 21*

11. Evidence submitted under Rule 21 consisted of a statutory declaration (and Exhibits CJ1 – CJ6) dated 9 August, 2005 made by the Applicant, Mr. Jarrett. He says that,

- he has been involved in the goods transportation industry for over thirty years and, more specifically, in providing specialised goods transportation solutions for global companies such as Dell and Microsoft,
- in the year 2000, his daughter left the family home to study in London and the cost and time expended in her relocation prompted him to devise a low cost solution for the transportation of peoples’ personal effects,
- that business involves the supply to the customer of a flat pack cardboard carton which the customer fills and which the company then collects, transports and delivers to the specified destination,
- the selection of the trade mark EASYMOVES for that service reflects the fact that the purpose of the service is to move the customer’s personal belongings in a manner that is effortless or easy for the customer,

- there has been trading under the mark in Ireland since February 2001 and turnover in the period 2001-2004 amounted to approximately €93,000,
- promotion of the business has been on a modest scale, including the production of a brochure and the printing of the name on the side of the cardboard flat pack,
- the photographs sent to the Opponent in February, 2003, and referred to by Ms. O'Connor in her declaration, were doctored to illustrate a manner of use of the trade mark EASYMOVES that could be made if a relationship, as proposed, was established between the Applicant and the Opponent; the trade mark is not used in that manner.

#### *Rule 22*

12. Evidence submitted by the Opponent under Rule 22 consisted of a statutory declaration (undated) made by Kirsten Doherty, in house Trade Mark Attorney of the Opponent, which does not add anything of significance to the facts already in evidence.

#### **The hearing**

13. At the hearing the Opponent was represented by Jonathan Newman, BL instructed by Cruickshank & Co., Trade Mark Agents and the Applicant by Shane Smyth, Trade Mark Agent of F.R. Kelly & Co..
14. Mr. Newman argued the case in support of the opposition on the basis of what he claimed was the Opponent's very substantial reputation in "easy" prefixed marks as shown by the evidence. The consumer's familiarity with the "easy" brand, particularly in relation to air transport services, would lead to the assumption that services of the kind specified in the application for registration offered under the trade mark EASYMOVES emanated from the Opponent or were offered under its authority by an economically linked undertaking. All of the Opponent's trade marks are formed by the conjoining, in a capricious manner, of the word "easy" with a word or words that describe the relevant service. That idiosyncratic juxtaposing of words is also to be found in the series of marks propounded for

registration. The likelihood of confusion is increased by the fact, as shown by the Applicant's own evidence, that the EASYMOVES service is accessible via an internet website, which emphasises the low cost, no frills business model being pursued by the Applicant. The evidence shows that the Applicant was aware of the Opponent's extensive application of that business model when it filed the application for registration and had gone so far as to actively try to benefit from the Opponent's reputation by seeking to have its service promoted via the Opponent's website. That constitutes evidence of a dishonest intention on the part of the Applicant in that he sought to get a "free ride" on the Opponent's reputation such that the application should be regarded as having been filed in bad faith by the Applicant.

15. In response, Mr. Smyth denied that there was a likelihood of confusion between the series of marks, as amended, and any of the earlier trade marks owned by the Opponent because the element shared in common by the respective marks – the word "easy" – is so obviously descriptive and laudatory in nature that the average consumer would not assume a commercial connection between goods/services marketed by different undertakings on the sole basis of the use in relation to them of that word. The fact that the word "easy" has such a descriptive character in relation to a vast range of services means that it cannot be regarded as the distinctive element of the Opponent's trade marks and its inclusion in the Applicant's series of marks is an insufficient basis on which to infer a likelihood of confusion. The Applicant is engaged in a different field of activity to that for which the Opponent claims a reputation under its trade mark EASYJET and there is no reason to believe that consumers would make a connection between the two simply because of their common use of the descriptive word "easy". The Opponent's assertion that the Applicant has acted in bad faith in filing the application has not been proven. The Applicant has explained in his evidence the circumstances that led to the depiction of the EASYMOVES trade mark in a style similar to that used by the Opponent in its correspondence with the Opponent in February, 2003 and the application has been amended to remove any such stylistic similarity in the appearance of the Applicant's trade mark.

## Grounds of decision

16. Although the notice of opposition cites several grounds of opposition under a number of different Sections of the Act and Mr. Newman did not abandon any of those grounds when specifically challenged on the point at the hearing, I am satisfied that it is sufficient for me to address in detail only those grounds of opposition arising under Section 8(4)(b), Section 10(2)(b) and Section 10(3) of the Act. Those were the only grounds pursued with any vigour at the hearing and are, in my opinion, the only grounds in respect of which a *prima facie* case has been established by the Opponent. In particular, I would observe that the Opponent's references in the notice of opposition to Section 61 of the Act, which concerns the protection of well-known trade marks under the Paris Convention, do not advance its case in any material respect. Section 61 does not provide a ground of objection against an application for registration. Nor is the inclusion of well-known trade marks within the definition of "earlier trade mark" at Section 11(1)(c) of the Act of any material significance in this case as several of the Opponent's Community Trade Mark Registrations constitute earlier trade marks as against the present application by virtue of Section 11(1)(a) and the Opponent does not, therefore, need to rely on Section 11(1)(c). Nor do I believe that any separate ground of objection, *per se*, arises from the Opponent's claim that it has "*a long and well established reputation in the use of the mark EASY combined with another often descriptive term*" and has "*prior rights in the use of the term EASY and the use of the term EASY combined with another descriptive element*". Whether that claim is justified and, if so, the consequences of it, may be considered as part of the determination of the objection under Section 10(2)(b).

### *Section 8(4)(b) – bad faith*

17. Section 8(4)(b) of the Act provides that a trade mark shall not be registered if, or to the extent that, the application for registration is made in bad faith by the applicant. The allegation of bad faith is notified in the notice of opposition at paragraph 11 thereof and is particularised in the evidence given by Ms. O'Connor, Trade Mark Agent, concerning the correspondence sent on behalf of the Applicant to the Opponent in February, 2003. The particulars of the charge as expressed in Ms. O'Connor's statutory declaration are that, (i) the Applicant had knowledge of the Opponent's business at the time of filing the application for registration



(contrary to his denial at paragraph 3 of the counter-statement filed against the notice of opposition), (ii) the Applicant had the Opponent's easyJet business and business model in mind when he developed the EASYMOVES name and business and, (iii) the similarity between the series of marks applied for and a number of United Kingdom applications filed by the Opponent shows that the application was made in bad faith.

18. As to the first matter, the statement made by the Applicant at paragraph 3 of the counter-statement is that he has "*no knowledge of the extensive use claimed by the Opponent in paragraph 2 of the notice of opposition*", i.e., extensive use of the long list of Community Trade Marks detailed in that paragraph. Accordingly, he requires proof of that use. In my opinion, that is a perfectly fair and reasonable statement on the part of the Applicant and its veracity is in no way called into question by the evidence subsequently given by the Opponent. The correspondence exhibited in the Opponent's evidence shows only that the Applicant was aware at the relevant time of the Opponent's passenger airline service operated under the name Easyjet and the statements made on behalf of the Applicant in that correspondence are not at all in conflict with the Applicant's subsequent statement that he did not know of the Opponent's claimed use of a large number of other trade marks, including easyKiosk, easyEverything, EASYCAFE, EASYMONEY, etc., etc. I do not accept that the Applicant's denial of knowledge of the Opponent's claimed use of all of those trade marks was false or misleading or that it provides any basis on which to find that the application for registration was made in bad faith by the Applicant.

19. With regard to the second ground on which the charge of bad faith is advanced, viz., that in developing its EASYMOVES business the Applicant was seeking to copy the Opponent's low-cost, no frills business model, I think it is obvious that that argument is fundamentally flawed. The Opponent does not have a monopoly in the use of the business model in question and the suggestion that the implementation of that business model by a third party under a trade mark that is allegedly similar to the Opponent's is necessarily indicative of a lack of *bona fides* is simply unsustainable. In my opinion, the evidence does not suggest that the Applicant "had in mind" the Opponent's business model when he developed his

business under the name EASYMOVES but, even if he did, there would be nothing whatsoever improper in that. In fact, it appears from the evidence that the Applicant's business was up and running for almost two years before an approach was made to the Opponent and the thinking behind that approach is apparent from the statements made on behalf of the Applicant at the time. In the correspondence sent to the Opponent in February, 2003, it is stated that the Applicant believes its product "*has a synergy with Easyjet*" and that "*there could be mutual benefits if we work on this with Easyjet purely from a promotional point of view*". I construe that approach as nothing more than a rather naïve attempt by the Applicant to build up its business by tapping into a potential new customer pool. It does not suggest that the Applicant acted in bad faith in adopting the name EASYMOVES/EASYMOVE or in applying for its registration as a trade mark.

20. Finally, in relation to the suggestion that the present series of marks is similar to certain trade marks that are, or were, the subject of applications made by the Opponent in the United Kingdom, I find it sufficient to say that such a contention, even if it had been shown to be true, would not, of itself, provide a basis for an allegation of bad faith in the making of the application for registration. If it did, then every application for registration of a trade mark that was similar to a mark owned by another would be liable to be refused as having been made in bad faith. That is neither the purpose nor the effect of the Act.
21. In my opinion, the evidence filed in this case, when viewed in the round, indicates that the Applicant invented and adopted the word EASYMOVES as a trade mark for a somewhat specialised removals service purely for its inherent attractiveness as a trade mark for such a service. He did so independently of any use that the Opponent had made of its trade marks and not with a view to profiting from any reputation that the Opponent had under those marks. The Applicant's reaction to the Opponent's implied allegation of trade mark infringement (Exhibit CJ6 to Mr. Jarrett's statutory declaration filed under Rule 21) is consistent with this assessment. The representation of the EASYMOVES trade mark in a style similar to that used by the Opponent in several of its marks in the photographs sent to the Opponent in February, 2003 was clumsy and commercially naïve but it was not done with improper intent and does not affect the legitimacy of the Applicant's

adoption of the trade mark some two years prior to that. The representation of the trade mark in that manner in the first two marks in the series as originally filed was questionable but the application was immediately amended by the deletion of those marks upon the Applicant becoming aware of the Opponent's objection to the application. In all of the circumstances, I think it would be wrong to conclude that the application for registration was filed in bad faith by the Applicant and I have decided, therefore, that the opposition under Section 8(4)(b) of the Act should be rejected.

*Section 10(2)(b) – likelihood of confusion*

22. Section 10(2)(b) of the Act prohibits the registration of a trade mark if, because it is similar to an earlier trade mark and would be registered for goods or services in respect of 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 of the later trade mark with the earlier trade mark. As noted above, several of the Community Trade Marks cited in the notice of opposition constitute earlier trade marks as against the present application by virtue of Section 11(1)(a) of the Act and several of those are protected in respect of goods and services in Classes 16 and 39. A number of the Community Trade Marks listed in the notice of opposition do not stand as obstacles to the registration of the present mark, either because they are not “earlier trade marks” within the meaning of the Act or because the goods and services in respect of which they are protected are not similar to those covered by the application for registration. These latter include Community Trade Marks Nos. 2140812, 1243948, 931790, 1902394, 1383157, and 1360981 and the opposition must be rejected insofar as it is based on those trade marks. Of the remaining Community Trade Marks cited in the notice of opposition, all except Nos. 1128743, 1196138, 848424 and 1132596, are protected in respect of both goods in Class 16 and services in Class 39 that are the same as or similar to those covered by the present application. Each of those four Community Trade Marks is protected in respect of either similar goods or similar services to those covered by the application but not both but, in my opinion, nothing turns on the distinction.

23. Several of the Opponent's earlier Community Trade Marks contain figurative elements but those elements do not materially alter the overall impression created by the words of which the marks are composed. It is the words that give the trade marks their identity. Those words are –

- EASYJET
- EASYJET.COM
- EASYJET GIFTS
- EASYJET.COM THE WEB'S FAVOURITE AIRLINE
- EASYEVERYTHING
- EASY
- EASYMONEY
- EASYVALUE
- EASYHOTEL
- EASYPOINTS
- EASYTECH
- EASYKIOSK
- EASYLIFE
- EASYEXTRAS
- EASY.COM
- EASYJET SERVICES
- EASYJET RAMP
- EASYSERVICES
- EASYRAMP
- EASYCAR
- EASY DOT COM.

*The EASYJET marks*

24. Each of the trade marks that contains the word EASYJET is, in my opinion, primarily identified by that word and the other word or words contained in those marks are of much less importance in terms of the overall identity of the marks. Insofar as the opposition is based on those trade marks, I think it is sufficient, therefore, to consider the question of whether there is a likelihood of confusion as

between the Opponent's EASYJET and the Applicant's EASYMOVES/EASYMOVE. In considering that question, I have, as always, kept in mind the guidance given by the European Court of Justice in several well-known cases<sup>4</sup> to the effect that the likelihood of confusion must be appreciated globally having regard to all of the relevant factors, including the degree of similarity between the respective trade marks and the respective goods/services, the degree of distinctiveness of the earlier trade mark, the nature of the goods/services and the likely perception of the average consumer of them, who must be treated as being reasonably observant and circumspect but who rarely has the chance to make a direct comparison of the trade marks and must rely instead on the imperfect picture of them that he keeps in his mind.

25. As regards the trade marks EASYJET and EASYMOVES/EASYMOVE, I take the view that, like most word marks, the conceptual significance of those marks is their most memorable feature and is considerably more important than their visual or aural identity in determining the overall impression given by them. In other words, it is the meaning of the words rather than the look or the sound of them that is likely to register first and foremost with the average person. I also believe that the respective meanings of the words are quite different. As Mr. Newman observed at the hearing, the word EASYJET constitutes an idiosyncratic juxtaposing of concepts which conjures a somewhat oblique reference to qualities of the services offered under the mark. EASYMOVES/EASYMOVE, on the other hand, is a fairly obvious reference to the essential purpose of the Applicant's service and the word would not require any great mental effort on the part of the average person to discern its meaning. Indeed, the feature of the Opponent's EASYJET that makes it particularly distinctive, i.e., the combination of the adjective EASY with a noun, JET, with which it does not naturally fit, is not replicated at all in the term EASYMOVES/EASYMOVE, which term is syntactically correct.

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<sup>4</sup> *Sabel BV –v- Puma AG and Rudolf Dassler Sport* (Case No. C-251/95), *Canon Kabushiki Kaisha –v- Metro-Goldwyn-Mayer Inc.* (Case No. C-39/97), *Lloyd Schuhfabrik Meyer & Co. GmbH –v- Klijsen Handel BV* (Case No. C-342/97)

26. Of course, it is true that both trade marks convey the notion of easiness but I agree with the submission made at the hearing on behalf of the Applicant to the effect that that concept is so obviously attractive in any trade mark as laudatory of the goods/services concerned that the average person is unlikely to infer a commercial connection between the Opponent and the Applicant based only on its inclusion in both marks. In this regard, an analogy may be drawn with the reasoning of the Court of First Instance of the European Communities in the case of *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) and Hukla Germany SA*<sup>5</sup> in which the Court stated that *a complex trade mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark, unless that component forms the dominant element within the overall impression created by the complex mark*. Similarly, it seems to me that EASYMOVES/EASYMOVE should not be regarded as being particularly similar to EASYJET unless the word EASY is the dominant element within the overall impression given by the word EASYJET. I do not believe that it is. It is the peculiar combination of the word EASY with the word JET that creates the overall impression given by the word EASYJET and, as I have said, no such peculiarity is to be found in EASYMOVES/EASYMOVE.

27. Nor do I accept the argument made on behalf of the Opponent to the effect that the average consumer's familiarity with the Opponent's services offered under the trade mark EASYJET would lead him to suppose that services such as those covered by the present application marketed under the trade mark EASYMOVES/EASYMOVE must emanate from, or be linked with, the Opponent. Even allowing that EASYJET was established in the mind of the average consumer here as of the relevant date (the date of filing of this application) as a trade mark of the Opponent used in connection with airline services – a fact that I accept as having been proven by the evidence given by the Opponent - it does not follow that any trade mark used in relation to goods transportation services and commencing with the word EASY would necessarily be assumed to be connected with the Opponent. In my opinion, confusion of that

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<sup>5</sup> Case T-6/01, paragraph 33 of judgement dated 23 October, 2002

nature should only be inferred if the trade mark under consideration were of such a nature as to call to mind the name EASYJET, either because it was highly similar to that word or because it evoked a concept that might be understood as being derived from it. Neither is true of EASYMOVES/EASYMOVE.

28. I do not believe that the average consumer of the goods or services covered by this application would infer any connection between those goods and services marketed under the trade mark EASYMOVES/EASYMOVE and the like goods and services marketed under the trade mark EASYJET. The only real element of similarity between the two marks is a word and concept – EASY – which is not apt to convey an origin-specific message as regards the respective goods and services. It will, rather, be understood by consumers as a marketing device whose purpose is to promote a positive image of the products. In my view, the Applicant’s mark will be viewed by the average consumer of the goods and services in question for what it is, namely, a catchy but fairly obvious name intended to convey in a clear and readily understood manner the nature and purpose of the goods/services on offer. It will not cause the average person to be reminded of the Opponent’s EASYJET trade mark and its use will not, therefore, lead to confusion on the part of the public.

*EASYEVERTHING*

29. The Opponent’s trade mark EASYEVERTHING is also quite different, conceptually, from EASYMOVES/EASYMOVE. It creates an impression of “everything being easy” or “a world of easiness” and is quite removed from the very specific message conveyed by the Applicant’s trade mark. As with EASYJET, EASYEVERTHING is a linguistic oddity and its distinctive character as a trade mark is not replicated in EASYMOVES/EASYMOVE nor likely to be evoked by the latter.

*EASY, EASY.COM, EASY DOT COM*

30. In view of the fact that it designates in common parlance a desirable characteristic of the goods and services in respect of which it is protected, the trade mark EASY must be seen as having a very low level of distinctiveness. In Case No. C-251/95, Sabel BV –v- Puma AG and Rudolf Dassler Sport, the European Court of Justice

noted that the more distinctive the earlier trade mark is, the greater will be the likelihood of confusion arising from the use of a similar trade mark. The reverse must also hold and it may be assumed, therefore, that a relatively slight difference between the present mark and the Opponent's trade mark EASY should be sufficient to obviate any likelihood of confusion arising. In my opinion, the difference between EASYMOVES/EASYMOVE and EASY is more than slight. The former is a specific and defined message of ease in relation to movement (of goods) while the latter evokes the notion of easiness in an unspecified and unlimited way. It does not seem likely that EASYMOVES/EASYMOVE would evoke recollection of EASY, *per se*, or that the average consumer would assume a connection between the two.

31. The same comments apply in respect of EASY.COM and EASY DOT COM, which are both really no more than the trade mark EASY combined with the well-known generic top-level domain (.com) used on the internet and signifying commercial entities.

*EASYMONEY, EASYHOTEL*

32. EASYMONEY and EASYHOTEL each have very specific connotations that are entirely different to those of EASYMOVES/EASYMOVE. Indeed, these are examples of trade marks which, while visually very alike (majority of letters the same and identically arranged), are, nevertheless, readily distinguishable and could not possibly be mistaken or confused by the average, reasonably observant consumer.

*EASYVALUE, EASYPOINTS, EASYLIFE, EASYEXTRAS, EASYSERVICES*

33. None of these trade marks looks or sounds similar to EASYMOVES/EASYMOVE and none conveys a similar meaning to it. None is a similar trade mark to EASYMOVES/EASYMOVE within the meaning of the Act.

*EASYTECH*

34. The distinctive feature of EASYTECH, i.e., its conceptual implication of "easy technology", is not hinted at in any way in EASYMOVES/EASYMOVE.



*EASYKIOSK, EASYRAMP, EASYCAR*

35. Each of these marks displays the same kind of syntactic novelty as EASYJET and I think it equally unlikely that anyone would assume a connection between any of them and EASYMOVES/EASYMOVE.

*Use of EASY + descriptive word*

36. For the reasons that I have outlined, I do not consider it likely that the use of the Applicant's trade mark EASYMOVES/EASYMOVE will result in confusion on the part of the public with any of the earlier trade marks relied on by the Opponent, when compared with and considered in relation to each of those marks individually. The Opponent has also argued that a likelihood of confusion arises from the fact that it has used a suite of trade marks, each consisting of the word EASY combined with another word or words that is/are suggestive of the relevant goods/services, and that, by virtue of that use, consumers have come to associate trade marks of that nature with the Opponent and will be confused by the use of a similarly constructed trade mark by the Applicant. For that argument to succeed, it must first be shown that, prior to the date of filing of the present application for registration, consumers here were familiar with the use by the Opponent of a number of EASY-prefixed trade marks and understood those trade marks to be connected, in the sense that they constituted members of a "family" of trade marks used in relation to goods and services having a common commercial origin. It is for the Opponent to establish that fact and, in my opinion, it has failed to do so. While I accept that the evidence filed by the Opponent shows, on the balance of probabilities, that consumers here would have been familiar at the relevant date with the trade mark EASYJET and the very extensive and successful business operated under that mark, I am not persuaded that the same can be said of the other trade marks referred to in the evidence filed by the Opponent. Insufficient information has been provided with regard to the extent of the use that was made of those trade marks prior to the relevant date to enable me to infer, as a matter of probability, that they were known to consumers in this jurisdiction and, furthermore, known to them as being related or connected trade marks. I do not accept, therefore, that a family of EASY-prefixed trade marks had become established in the public perception here at the relevant date. It follows that I do

not agree with the Opponent's contention that the Applicant's trade mark EASYMOVES/EASYMOVE would be perceived as another member of that family and I find that there is no likelihood of confusion arising on that basis either.

*Section 10(3)(a) – unfair advantage*

37. Section 10(3) of the Act that a trade shall not be registered if it is similar to an earlier trade mark, which has a reputation in the State (or in the European Community, in the case of a Community Trade Mark) and if the use of the trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark. I understood the argument made at the hearing on behalf of the Opponent on this ground of opposition to be to the effect that the use by the Applicant of the trade mark EASYMOVES/EASYMOVE, even if it does not lead to outright confusion, will gain an illicit benefit for the Applicant by taking unfair advantage of the extensive advertising and promotion that the Opponent has invested in its EASY-prefixed trade marks.

38. I reject that argument for two reasons. Firstly, I do not accept that the Opponent's EASY-prefixed trade marks constitute, collectively, an "*earlier trade mark (that) has a reputation*" within the meaning of Section 10(3) of the Act. In other words, the Section does not provide a ground of objection based on the Opponent's claim that it enjoyed a reputation at the relevant date in the concept of trade marks formed by the conjoining of the prefix EASY and a descriptive word or words. An objection under the Section may be based only on a specified earlier trade mark or trade marks, in respect of which the requisite reputation must be shown. Secondly, as regards the only one of the earlier trade marks cited by the Opponent that may have had the requisite reputation, viz., EASYJET, I do not believe that the degree of similarity between that mark and the Applicant's trade mark EASYMOVES/EASYMOVE is sufficient to cause consumers to establish a link between them. The linking of the respective marks in the mind of the consumer is a necessary pre-requisite to any unfair advantage that might be taken of the earlier trade mark and, in the absence of such a link, the objection under Section 10(3) must fail. As I have said already, the mere inclusion of the word EASY at the

start of the Applicant's trade mark is not enough to suggest that consumers will be caused to recall the Opponent's EASYJET or to make any connection between the respective trade marks.

**Procedural matter**

39. At the hearing, Mr. Smyth raised a question in relation to a procedural matter which I wish to comment on briefly for the benefit of parties to proceedings before the Controller. Referring to Rule 61(5) of the Rules, which requires a party to *inter partes* proceedings to notify the other party and the Controller in advance if it intends to refer at the hearing to any document not already mentioned in the proceedings, Mr. Smyth noted that the Opponent had not furnished in advance a list of the case-law that was referred to by Mr. Newman in his submissions in support of the opposition. He did not raise a formal objection on the point but merely sought a direction as to whether the Rule required parties to indicate in advance the cases to which they intended to refer in argument, as he himself had done prior to the hearing. Mr. Newman observed that, in his experience, Rule 61(5) had never been construed as requiring advance notification of case-law to be relied upon in argument, that same was not required in proceedings before the High Court and that he had not considered himself to be under any obligation in that regard.

40. Having considered the matter since the hearing, I have come to the view that proposed references to earlier decisions of courts or other competent authorities do not fall within the matters covered by Rule 61(5) and are not, therefore, subject to the requirement that they be notified in advance. In relying in argument on any such earlier decision, a party to a hearing before the Controller is not referring to the document, *per se*, in which that decision is recorded but to the content of the decision itself or, more particularly, to the principles of interpretation established by it. It seems to me that the kinds of documents covered by Rule 61(5) would include academic or reference works and official publications, which may contain material of relevance to the arguments on the proceedings at hand but which would not require to be proven by evidence given in the course of those proceedings. It is sensible to require that a proposed reference to any such document be notified in advance so that the other party and the hearing officer


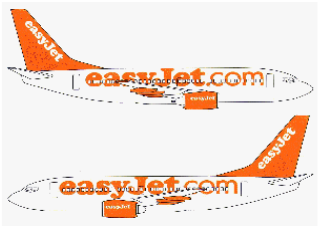

will have the opportunity to consult it as part of their preparations in advance of the hearing. There is, however, no provision in the legislation requiring parties to hearings to disclose in advance the nature of the arguments that they propose to present at a hearing by the filing of outline legal submissions. If the filing of submissions of that nature was required by the legislation, then it might be expected that it would extend to the notification of the authorities on which such submissions were grounded. But in the absence of any such requirement, it does not appear to me that Rule 61(5) should be interpreted as requiring advance notification of the authorities that are to be relied upon in argument at a hearing.



41. I note that the corresponding provision of the United Kingdom patents legislation (Rule 88(3) of the U.K. Patents Rules, 1995, as amended) makes an exception in respect of “*a report of a decision of any court or of the comptroller*” but I do not think that the absence of such an exception in Rule 61(5) should be taken as implying that the Rule contemplates advance notification of legal authorities. The overall legislative framework is somewhat different in the United Kingdom (including as regards the filing of skeleton arguments in advance of hearings) and, in my opinion, such an exception is unnecessary in the Irish context.

Tim Cleary  
Acting for the Controller

12 July, 2007

## Community Trade Marks listed in Notice of Opposition

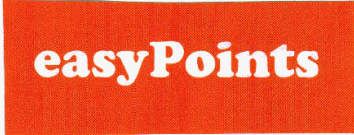
Number	Filing Date	Mark	Classes
1232909	01/07/1999	EASYJET	3, 9, 16, 18, 25, 29, 30, 32, 33, 34, 38, 39, 41, 42
1593326	31/03/2000		3, 9, 16, 18, 25, 30, 32, 33, 34, 35, 38, 39, 41, 42
1983667	22/11/2000	easyJet Gifts	3, 9, 12, 14, 16, 18, 25, 28, 29, 30, 32, 33, 34, 35, 38, 39, 41, 42
1984079	22/11/2000		3, 9, 14, 16, 18, 25, 28, 29, 30, 32, 33, 34, 35, 38, 39, 41, 42
2015287	15/12/2000	easyJet.com the web's favourite airline	3, 9, 12, 14, 16, 18, 25, 28, 29, 30, 32, 33, 34, 35, 38, 39, 41, 42
2140812	09/03/2001	easyKiosk	3, 14, 25, 28, 29, 30, 31, 32, 33
1243948	13/07/1999		9, 35, 38, 41, 42

Number	Filing Date	Mark	Classes
931790	16/09/1998	EASYCAFÉ	9, 29, 30, 32, 33, 35, 38, 42
1590561	04/04/2000	EASYEVERYTHING	9, 16, 26, 35, 36, 38, 39, 41, 42
1699792	09/06/2000	EASY	16, 35, 36, 39, 41, 42
1731223	29/06/2000	EASYMONEY	9, 16, 35, 38, 39, 41, 42
1857705	18/09/2000	easyValue	9, 16, 35, 38, 39, 41, 42
1866706 <sup>6</sup>	21/09/2000	easyHotel	9, 16, 25, 32, 33, 35, 36, 38 39, 41, 42
1902394 <sup>7</sup>	16/10/2000	easyOdds	9, 16, 28, 38, 41, 42
1976679	17/11/2000 <sup>8</sup>		16, 28, 35, 36, 39
2153575	22/03/2001		16, 36, 38, 39, 41, 42

<sup>6</sup> surrendered in respect of Classes 9 and 38

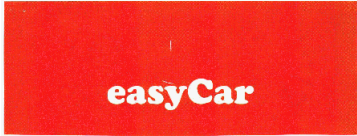


<sup>7</sup> application withdrawn

<sup>8</sup> notice of opposition gives the date as 1 July, 1999 but that appears to be an error

Number	Filing Date	Mark	Classes
2181667 <sup>9</sup>	05/04/201		9, 16, 29, 30, 32, 33, 35, 36, 38, 39, 41, 42
1128743 <sup>10</sup>	29/03/1999	easyTech	12, 37, 39
1196138	01/06/1999	easyKiosk	16, 42
1343359	06/10/1999	easyLife	16, 35, 39
848424	05/06/1998	easyExtras	16, 18, 36, 39, 42
1343300	06/10/1999	easy.com	16, 35, 39
1383157	08/11/1999	easyJet tours	42
1472273	19/01/2000	easyJet Services	16, 39, 42
1661834	10/05/2000	easyJet ramp	16, 39
1796564	07/08/2000	easyLife	16, 35, 36, 39
1821354	15/08/2000	easyServices	16, 39, 42
1821370	15/08/2000	easyRamp	16, 39
2168714	03/04/2001	easyCar	16, 39,42

<sup>9</sup> incorrect number (218167) cited in notice of opposition

<sup>10</sup> incorrect number (2128743) cited in notice of opposition

Number	Filing Date	Mark	Classes
2168763	03/04/2001		16, 39, 42
1132596	29/03/1999	easyJet. the web's favourite airline	39, 41
1360981 <sup>11</sup>	26/10/1999		39
1588326	31/03/2000		9, 16, 35, 36, 38, 39, 41, 42

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<sup>11</sup> application withdrawn