



Neutral Citation Number: [2025] EWHC 2229 (Ch)

IN THE HIGH COURT OF JUSTICE  
BUSINESS AND PROPERTY COURTS  
OF ENGLAND AND WALES (ChD)  
INTELLECTUAL PROPERTY LIST

Claim No. IL-2023-000155

Royal Courts of Justice, Rolls Building  
Fetter Lane, London, EC4A 1NL

Before:

**DEPUTY HIGH COURT JUDGE LANCE ASHWORTH KC**

BETWEEN:

**EASYGROUP LIMITED**

Claimant

-and-

**PREMIER INN HOTELS LIMITED**

Defendant

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**Simon Malynicz KC, Stephanie Wickenden and Niamh Herrett** (instructed by **Stephenson Harwood LLP**) for the **Claimant**

**Emma Himsworth KC and Beth Collett** (instructed by **White & Case LLP**) for the **Defendant**

Hearing dates: 1<sup>st</sup>, 2<sup>nd</sup>, 3<sup>rd</sup>, 7<sup>th</sup> and 8<sup>th</sup> April 2025

Further written submissions: 15<sup>th</sup> August 2025

Draft Judgment circulated: 26<sup>th</sup> August 2025

Judgment: 29<sup>th</sup> August 2025

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**JUDGMENT**  
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This judgment was handed down remotely at 10.30 am on 29 August 2025 by circulation to the parties or their representatives by e-mail and by release to the National Archives.

Lance Ashworth KC:

Introduction

1. This is a claim brought by easyGroup Ltd (“**easyGroup**”) against Premier Inn Hotels Limited (“**Premier Inn**”) for trade mark infringement under section 10(2) and 10(3) of the Trade Marks Act 1994 (the “**1994 Act**”).
2. The original claim was commenced by a claim form issued on 5 September 2023 and was a claim brought solely under s.10(3) of the 1994 Act in respect of easyGroup’s UK trade marks numbered:
  - (a) 2246286B for a series of 2 word marks “EASYHOTEL” and “easyHotel” (the “**easyHotel UKTM**”) registered as of 21 September 2000 in respect of among others the following services (the “**easyHotel UKTM Services**”) in Class 42 of the Nice Classification: *“Temporary accommodation; providing hotel accommodation; reservation services for hotel accommodation; computerised hotel reservation services”*; and
  - (b) 3362833 for the stylised series marks set out in the left hand column of the table at paragraph 7 below (the “**easy UKTM**”) registered as of 29 March 2019 in respect of among others the following services (the “**easy UKTM Services**”) in class 43 of the Nice Classification: *“temporary accommodation; provision of holiday accommodation; hotel services; hotel reservation services”*.
3. By amendment in March 2024, a claim was added solely under s.10(2) of the 1994 Act in respect of UK trade mark number 3515715 for a word mark REST EASY APARTMENTS (the “**Rest Easy Apartments UKTM**”) registered as of 25 July 2020 in respect of among others the following services (the “**Rest Easy Apartments UKTM Services**”) in Class 36 of the Nice Classification: *“Accommodation bureau services [apartments]; Letting of apartments; Management of apartments; Rental of apartments”*. easyGroup had acquired the Rest Easy Apartments UKTM by an assignment dated 24 January 2024 in settlement of a trade mark infringement claim brought by easyGroup against the former trade mark owner. The former owner had not asserted any trade mark infringement by Premier Inn.
4. Premier Inn is the registered proprietor of UK trade mark number 3601725 for a series of 2 figurative marks set out in the right hand column of the table at paragraph 7 below (the “**Premier Inn UKTM**”) registered as of 26 February 2021 in respect of the following services in class 43 of the Nice Classification: *“Services for providing food and drink; temporary accommodation services; hotels; motels; café, bar and restaurant services; hotel reservations and booking services; rental of meeting rooms; rental of temporary accommodation; self-service restaurants; snack bars”*.
5. In addition to the Premier Inn UKTM, Premier Inn has since 2007 advertised and promoted its hotel and related services under and by reference to its distinctive anthropomorphic moon and star device on a purple background (Pantone 261 C) (“**Moon Device**”) together with the sign PREMIER INN, together known as the “**Premier Inn Device**”. The shape of the Premier Inn Device changed in 2015, but is still in use today. Since 12 April 2021, Premier Inn has also advertised, promoted and offered its services under and by reference to 2 devices which contain the words below Premier Inn “Rest easy” with a capital “R” and a lowercase “e”. They are set out in the middle column of the table at paragraph 7 below. This is said to infringe the easyGroup UKTMs as is the Premier Inn UKTM. They are all

used as signs. In this judgment I shall refer to these generally as the “**Premier Inn Rest Easy Device**” and/or the “**Premier Inn Signs**”.

6. From 12 April 2021, as well as the Premier Inn Rest Easy Device, Premier Inn have been using the words “REST EASY” in advertising campaigns and on its website, social media pages, YouTube videos, signage and in-hotel posters. This use is also said by easyGroup to infringe their UKTMs. The extent of such use and whether the words have been used alone or as part of the Premier Inn Rest Easy Device and/or alongside and/ or in conjunction with the Moon Device and/or the Premier Inn Device and/or the sign “PREMIER INN” (as pleaded at paragraph 27 of the Re-re-amended Defence and Counterclaim) has been the matter of some debate before me and I will have to return to it in due course.
7. Accordingly, the claims I have to consider are as between the 3 registered marks of easyGroup and the Signs used by Premier Inn as follows:

| The Registered Marks                                                                                                                             | Signs Complained of                                                                 | UKTM used as signs complained of                                                      |
|--------------------------------------------------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------------------------|---------------------------------------------------------------------------------------|
| EASYHOTEL easyHotel<br>(a word mark series of two)<br>(“the <b>easyHotel</b> UKTM”)                                                              |   |    |
| <br>(a device mark series of two)<br>(“the <b>easy</b> UKTM”) |  |  |
| Rest Easy Apartments<br>(“the <b>Rest Easy Apartments</b> UKTM”)                                                                                 | REST EASY                                                                           |                                                                                       |

8. There is therefore a claim under s.10(2) of the 1994 Act for infringement of the Rest Easy Apartments UKTM by use of the Premier Inn Signs and a separate claim under s.10(3) of the 1994 Act for infringement of the easyHotel UKTM and the easy UKTM by use of the Premier Inn Signs. This is not a case where the s.10(2) and s.10(3) allegations are in respect of the same trade marks as many of the cases to which I have been referred are. It will be important to bear this in mind.
9. In addition, easyGroup claim that by virtue of its earlier rights:
  - (a) in the easyHotel UKTM and the easy UKTM, Premier Inn’s UKTM is liable to be declared invalid by virtue of s.5(3) of the 1994 Act for the same reasons as those in respect of the infringement under s.10(3) of the 1994 Act; and/or
  - (b) in the Rest Easy Apartments UKTM, Premier Inn’s UKTM is liable to be declared invalid by virtue of s.5(2) of the 1994 Act for the same reasons as those in respect of the infringement under s.10(2) of the 1994 Act.

10. Premier Inn has included a counterclaim that the easyHotel UKTM and/or easy UKTM are liable to be declared invalid under s.47 of the 1994 Act because each of those marks being series marks is not a sign (in the sense of being a single sign) and/or is not graphically represented in a clear, precise, unequivocal and/or objective way and each was therefore registered contrary to Section 3(1)(a) of the 1994 Act. However, in light of the decision of the Court of Appeal in *Comic Enterprises Limited v. Twentieth Century Fox Film Corporation* [2016] EWCA Civ 455, this is not pursued at first instance, Premier Inn reserving its rights to do so should the matter go on appeal to the Court of Appeal. I therefore do not need to address this further.
11. At trial easyGroup has been represented by Simon Malynicz KC, Stephanie Wickenden and Niamh Herrett and Premier Inn has been represented by Emma Himsworth KC and Beth Collett. All counsel are very experienced in the law relating to trade marks, as are their instructing solicitors, and I am grateful for the assistance that they provided me with. All junior counsel undertook some oral advocacy during the trial, including witness handling, and did so very deftly. I have not addressed every submission made to me or every one of the very substantial number of authorities which I was taken to and/or asked to read following the hearing (which I did), but only those which I believe to have been necessary for the purposes of giving judgment.

#### The Parties

12. easyGroup is a holding company established in 2000. It is now the owner and licensor of all registered and unregistered intellectual property rights in the various “easy” businesses founded by Sir Stelios Haji-Iannou, the best known of these being the airline easyJet. I have been referred to quite a number of earlier cases involving easyGroup, a number of which set out the history of the easyJet business, and the incorporation of easyGroup, it being a frequent litigator in protection of its trade marks. Rather than repeat those matters here, the general history can be found in the early decisions of *W3 v. easyGroup* [2018] EWHC 7 (Ch) and *easyGroup v. EasyLife* [2021] EWHC 2150 (Ch). I will set out the background which is particularly relevant to this case below.
13. In a number of the other cases brought by easyGroup, it has sought to place reliance on various other “easy” businesses connected with (and now licensed by) easyGroup as being the “easy family” of businesses or brands. For reasons which will become apparent, it is not open to them to do so in this case. Nonetheless, there has been reference to the “easy Travel Family”, which is said (in paragraph 3 of the Re-re-amended Particulars of Claim) to comprise “EASYJET, EASYCAR, EASYBUS, EASYHOTEL and the easy UKTM”, which I will address in due course.
14. Premier Inn is the UK's largest hotel brand with more than 840 hotels and over 83,500 rooms all of which can only be booked directly with it, either online or by telephone, not through third-party websites. It is substantially larger than easyHotel. It has traded since 2007, using the Premier Inn Device. It has advertised significantly over the years, perhaps most memorably using Sir Lenny Henry sleeping in one of their beds (as evidenced in episode 1 of the latest series of Clarkson’s Farm). In 2021, Premier Inn updated its branding to add an end line in stylized handwriting script. This is a common logo addition used by many other brands, such as Tesco, IKEA, Nokia, and Nike to name but a few. The endline,

used after the name “Premier Inn” and alongside the moon device, is the words “Rest easy”. The rationale for doing this is addressed in the evidence.

### Procedural History

15. On 27 February 2023 (almost 2 years after the launch of the “Rest Easy” campaign), easyGroup’s solicitors wrote to Premier Inn, setting out at some length the development of the easy family of brands and complaining about the use by Premier Inn of the term “Rest easy”. The letter said that it was important to easyGroup that any likelihood of confusion or link between Premier Inn’s Rest easy branding and easyGroup’s brand was removed. This was before easyGroup had acquired the Rest Easy Apartments UKTM. The response from Premier Inn’s then solicitors in their letter dated 8 March 2023 was robust stating that the concerns raised were entirely without merit. It was said there was no likelihood of confusion or association between the respective brands and the letter went on to detail why this was the case. This led to a further lengthy letter from easyGroup’s solicitors dated 5 May 2023 again relying extensively on the easy family of brands. That letter asserted infringement under both s.10(2) and s.10(3) of the 1994 Act. Premier Inn’s then solicitors were not drawn into further correspondence, with the result that the next thing to happen was that on 5 September 2023 these proceedings were issued, seeking relief in respect of alleged infringement only under s.10(3) of the 1994 Act. Once easyGroup had acquired the Rest Easy Apartments UKTM, they amended to add the s.10(2) claim in respect of that trade mark.
16. There was a Costs and Case Management Conference before Master Brightwell in April 2024 at which he gave directions, including as to a split trial of liability and quantum. In September 2024, Premier Inn’s then solicitors sought clarification as to whether easyGroup was relying on a family of marks/family of brands argument. On 14 October 2024, easyGroup’s solicitors confirmed that easyGroup was not seeking to rely on the family of marks doctrine, but was relying on the fact that when the easyHotel UKTM and the easy UKTM had been used in relation to hotel accommodation, they had been used and promoted as part of the wider portfolio of easy brands some of which have a significant reputation in the budget hotel and travel sector, in particular easyJet and easyCar. The letter continued that the context enabled those marks to gain, more quickly, an enhanced distinctiveness and reputation. As such, it was said, the reputation of the easyHotel UKTM and the easy UKTM should not be considered in a vacuum, detached from the easy family, as that would be artificial and not properly reflect the state of their reputation.
17. Shortly thereafter easyGroup’s solicitors wrote to Premier Inn’s then solicitors to say that they had instructed Graham Williams of Dynata to conduct 2 pilot surveys to identify consumer reaction to the easy UKTM (not the easyHotel UKTM) and to draw statistically based conclusions from the responses obtained. They issued an application notice for permission to adduce survey evidence.
18. The question of whether easyGroup was actually placing reliance on the family of marks principle continued to be canvassed in correspondence between the parties’ solicitors. I do not need to detail this further as it ultimately led to an application to re-re-amend the Particulars of Claim. It was said that the purpose of this proposed amendment was to narrow the issues not to introduce anything new.

19. The application for permission to amend and the application for permission to adduce survey evidence came before me on 21 January 2025. On the basis of confirmation given by easyGroup (1) as to the costs of the surveys, (2) that it was not seeking to rely on the Family of Marks doctrine and (3) that reliance on the survey was only for the purpose of demonstrating the reputation and enhanced distinctiveness of the easy UKTM as was recorded in paragraph 46.4 of the third witness statement of Robert Jacob, I gave permission to amend and permission to adduce survey evidence on the terms set out in my order of that date.
20. My approved judgment which sets out the background to those applications in more detail has neutral citation number [2025] EWHC 231 (Ch) (the “**Application Judgment**”). One of the points taken by Ms Himsworth on the amendment application was that the reputation and distinctiveness of marks other than those the immediate subject of this claim were irrelevant. As I said at paragraph [22] of the Application Judgment, I could see the force of that submission, but that I was not being asked to deal with a summary judgment or strike out application in respect of any version of the Particulars of Claim, so that if the application to amend was to narrow and clarify the case, it was not open to me to say that they were not arguable, coherent and properly particularised or had no real prospect of success. Given that the original pleading was, in my judgment, undoubtedly wider than the proposed amended pleading, permission to amend ought to be given. If I had not allowed the amendment, the result would have been that easyGroup would still be able to run the case under the pre-amendment pleading which was much wider. I made it clear that would still allow Ms Himsworth to argue at trial that none of this is relevant, as she has done.
21. As to the survey evidence, having been taken to the relevant authorities, I said that doing the best I could on the evidence then before me, the evidence did just satisfy the test for granting permission, that was to say I was satisfied that the survey evidence was likely to be of real value given the way the case was put. So, albeit not without some hesitation, I gave permission.
22. The matter came back before me on 11 March 2025 for the pre-trial review. Among other directions, I struck out some parts of each side’s witness statements, granted permission for a late statement on behalf of easyGroup and directed that the parties should agree a legal primer on the relevant law, in so far as they were agreed on it. This they helpfully did in so far as they were agreed on the law to be applied. Each party supplemented this with references to other authorities in support of their submissions. After I reserved judgment, the Supreme Court gave judgment on 24 June 2025 in *Iconix Luxembourg Holdings SARL v. Dream Paris Europe Inc* [2025] UKSC 25. Counsel for Premier Inn directed my attention to certain passages in that judgment, although no submissions were made to the effect that any alteration to the principles set out in the agreed legal primer is necessary.
23. Further I noted in the course of drafting this judgment that on 24 July 2025, the Court of Appeal gave judgment in *easyGroup Ltd. v Easy Live (Services) Ltd.* [2025] EWCA Civ 946 and in *easyGroup Ltd. v Easyfundraising Ltd* [2025] EWCA Civ 1000. I invited the parties to make further submissions to me on the relevance, if any, of these decisions to the issues I have had to decide. They each filed further submissions on 15 August 2025, which I have considered fully.
24. The trial took place over 5 sitting days at the beginning of April, of which only 2 days involved live evidence, the rest being taken up with detailed submissions. At the end of the

trial, I was provided with a reading list of authorities, which I was told would take me 2-3 days to read. Unfortunately, it has taken me substantially longer to work through those on the reading list spread across 4 volumes of authorities. There are in addition 26 files in electronic format making up the trial bundle. I was taken through a relatively small fraction of the documents in those files in the course of the trial, but the parties' written submissions and lengthy Narrative Documents make extensive reference to documents from the bundles. I have reviewed a large number of the documents referred to in the Narrative Documents, but have not been to all of them, as I do not believe it to be necessary in order to determine the issues that I have to, and would have taken me very many more days to have done so.

25. The parties also produced an agreed List of Issues for trial, although easyGroup made little cross-reference to it. I set out at Appendix 2 to this judgment the answers to each of the issues on the List of Issues in so far as they remain relevant, but the reasoning for those answers is set out in this judgment.

### Legal Principles

26. Much of what follows is taken from the legal primer which Counsel agreed. I have sought to address the other authorities referred to by each party in so far as they were relied on to qualify the agreed legal principles in the course of addressing the submissions.
27. The relevant parts of the 1994 Act for the purposes of this case are:

#### ***3 Absolute grounds for refusal of registration***

*(1) The following shall not be registered –*

...

*(b) trade marks which are devoid of any distinctive character*

...

*Provided that a trade mark shall not be refused registration by virtue of paragraph*

*(b) ... above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.*

#### ***5 Relative grounds for refusal of registration.***

*(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.*

*(2) A trade mark shall not be registered if because—*

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

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

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

*(3) A trade mark which—*

*(a) is identical with or similar to an earlier trade mark, and*

*...*

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

### **9 Rights conferred by registered trade mark.**

*(1) The proprietor of a registered trade mark has exclusive rights in the trade mark which are infringed by use of the trade mark in the United Kingdom without his consent. The acts amounting to infringement, if done without the consent of the proprietor, are specified in subsections (1) to (3) of section 10.*

*...*

### **10 Infringement of registered trade mark.**

*...*

*(2) A person infringes a registered trade mark if he uses in the course of trade a sign where because—*

*(a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered, or*

*(b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered,*

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

*(3) A person infringes a registered trade mark if he uses in the course of trade, in relation to goods or services, a sign which—*

*(a) is identical with or similar to the trade mark, ...*

*where the trade mark has a reputation in the United Kingdom and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.*

*(3A) Subsection (3) applies irrespective of whether the goods and services in relation to which the sign is used are identical with, similar to or not similar to those for which the trade mark is registered.*

...

#### **47 Grounds for invalidity of registration.**

*(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground—*

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

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

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

28. In *SkyKick UK Ltd v Sky Ltd* [2024] UKSC 36; [2025] Bus LR 251, at [54], Lord Kitchen JSC (with whom the other Justices agreed) outlined the essential function of a registered trade mark as being:

*“... in particular, to guarantee the identity of the origin of the goods or services in relation to which it is used. In more colloquial terms, it is a badge of origin and its purpose is to permit the consumer, without any possibility of confusion, to distinguish the goods or services of one undertaking from those of another.”*

#### Relevant Dates

29. The relevant date for assessment of infringement is the date the complained of action commenced, see *Levi Strauss & Co v Casucci SpA Case* (C-145/05) [2006] ETMR 71.

30. Where there is a challenge to the validity of a trade mark, the relevant date for assessment is the date that the application for that mark was made, and if the trade mark is found to have been invalidly registered for any of its goods and services, it is deemed never to have been made (s.47(6) TMA 1994).

31. In this case the parties are agreed that:

(a) The relevant start date for assessment of infringement is 12 April 2021 (the “**Relevant Start Date**”);

(b) The relevant date for assessment of invalidity is 26 February 2021 (the “**Relevant Filing Date**”).

#### Average Consumer

32. A number of assessments of trade mark law are to be assessed from the perspective of the average consumer (in particular, what the sign is, distinctiveness, a likelihood of confusion

under s.10(2) and a link under s.10(3)). In *Lidl v Tesco* [2024] FSR 17, Arnold LJ summarised the principles for assessing the average consumer:

15. ... *It is firmly established that many issues in trade mark law, including the issues arising on claims for infringement, must be assessed from the perspective of the "average consumer" of the relevant goods and/or services, who is "deemed to be reasonably well informed and reasonably observant and circumspect": see Case C-342/97 Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV [1999] ECR I-3819 at [26] and many subsequent authorities. Discussion of the characteristics and role of the average consumer occupies the whole of Chapter 3 in Kerly's Law of Trade Marks and Trade Names (17th ed). For present purposes I would highlight the following points, authority for which can be found in the cases discussed in Kerly.*

16. *First, the average consumer is both a legal construct and a normative benchmark. They are a legal construct in that consumers who are ill-informed or careless and consumers with specialised knowledge or who are excessively careful are excluded from consideration. They are a normative benchmark in that they provide a standard which enables the courts to strike a balance between the various competing interests involved, including the interests of trade mark owners, their competitors and consumers.*

17. *Secondly, the average consumer is neither a single hypothetical person nor some form of mathematical average, nor does assessment from the perspective of the average consumer involve a statistical test. They represent consumers who have a spectrum of attributes such as age, gender, ethnicity and social group. For this reason the European case law frequently refers to "the relevant public" and "average consumers" rather than, or interchangeably with, "the average consumer": see, for example, Case C-252/07 Intel Corporation Inc v CPM United Kingdom Ltd [2008] ECR I-8823 at [34]. It follows that assessment from the perspective of the average consumer does not involve the imposition of a single meaning rule akin to that applied in defamation law (but not malicious falsehood). Thus, when considering the issue of likelihood of confusion, a conclusion of infringement is not precluded by a finding that many consumers of whom the average consumer is representative would not be confused. To the contrary, if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, then a finding of infringement may properly be made.*

18. *Thirdly, assessment from the perspective of the average consumer is designed to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence. I shall return to the last of these considerations below.*

19. *Fourthly, the average consumer's level of attention varies according to the category of goods or services in question.*

20. *Fifthly, the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must*

*instead rely upon the imperfect picture of the trade mark they have kept in their mind.*

33. The parties are agreed in this case that the average consumer is an ordinary member of the public. Such a consumer is accustomed to using the internet for the purposes of booking hotel accommodation. The average consumer's level of attention in this case is medium.

#### Distinctive Character

34. S.3(1)(b) of the 1994 Act (set out above) requires that a trade mark must have distinctive character in order to be registered. The distinctive character is the ability of a mark to perform its primary role as a trade mark, namely to denote a particular brand origin.
35. In *TVIS Ltd. v. Howserv Services Ltd* [2024] EWCA Civ 1103; [2025] ETMR 2, one of the grounds of appeal was that the trial judge had wrongly found that the trade mark was descriptive and therefore lacking in any distinctive character. It was argued that as the validity of the trade mark had not been challenged, it was not open to the judge to find that the trade mark was lacking in distinctive character, relying on *Formula One Licensing BV v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (C-196/11 P [EU:C:2012:314] at [41]). While Arnold LJ did not expressly deal with this argument, as he found that there was distinctiveness in any event, he had previously held at first instance in *Whyte & Mackay Ltd. v. Origin Wine UK Ltd.* [2015] EWHC 1271 (Ch); [2015] FSR 33 at [28], that the *Formula One* case establishes that where validity has not been challenged, the trade mark must nevertheless be deemed to have the minimum degree of distinctive character for it to be validly registered; but not more than that. I do not understand him to have been saying anything to the contrary or by way of further explanation in *TVIS Ltd. v. Howserv Services Ltd* (supra).
36. Counsel before me were agreed (as set out in the agreed legal primer) that unless challenged by way of an invalidity attack, it cannot be argued that a registered trade mark has **no** distinctive character at all, which includes the characterisation of the sign as descriptive or generic. That is in accordance with the above analysis, however, it is for me to determine what level the average consumer would assess the distinctiveness of each of the easyGroup marks to be, and whether that would be more than the minimum degree of distinctive character for it to be validly registered.
37. Arnold J (as he then was) reviewed the case law on acquiring distinctiveness in *W3 Ltd v easyGroup Ltd* [2018] EWHC 7 (Ch) (which has been subsequently endorsed in several cases) at [156ff]:

*156. ... I reviewed the law on acquired distinctiveness in Société des Produits Nestlé SA v Cadbury UK Ltd [2014] EWHC 16 (Ch), [2014] ETMR 17 ("Nestlé v Cadbury I") at [39]-[48] and Enterprise v Europcar at [151]-[152]. The following propositions of law are settled by the decisions of the CJEU which I cited in those judgments.*

*157. First, for a trade mark to possess distinctive character, it must serve to identify the goods or services in respect of which registration is applied for as originating*

*from a particular undertaking and thus to distinguish the goods or services from those of other undertakings.*

*158. Secondly, the distinctive character of a trade mark must be assessed by reference to (i) the goods or services in respect of which registration has been applied for and (ii) the perception of the average consumer of those goods or services, who is deemed to be reasonably well-informed and reasonably observant and circumspect.*

*159. Thirdly, the criteria for assessment of distinctive character are the same for all categories of trade marks, but nevertheless the perception of the relevant public is not the same for all categories of trade marks and it may therefore be more difficult to establish distinctive character in relation to some categories (such as shapes, colours, personal names, advertising slogans and surface treatments) than others.*

*160. Fourthly, in assessing whether a trade mark has acquired a distinctive character the competent authority must make an overall assessment of the relevant evidence, which in addition to the nature of the mark may include (i) the market share held by goods bearing the mark, (ii) how intensive, geographically widespread and long-standing the use of the mark has been, (iii) the amount invested by the proprietor in promoting the mark, (iv) the proportion of the relevant class of persons who, because of the mark, identify the goods or services as emanating from the proprietor, (v) evidence from trade and professional associations and (vi) (where the competent authority has particular difficulty in assessing the distinctive character) an opinion poll. If the relevant class of persons, or at least a significant proportion of them, identifies goods or services as originating from a particular undertaking because of the trade mark, it has acquired a distinctive character.*

*161. Fifthly, with regard to the acquisition of distinctive character through use, the identification by the relevant class of persons of the product or service as originating from a given undertaking must be as a result of the use of the mark as a trade mark. The expression "use of the mark as a trade mark" refers solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the product as originating from a given undertaking.*

*162. Sixthly, a trade mark may acquire a distinctive character in consequence of the use of that mark as part of, or in conjunction with, another trade mark (which may itself be a registered trade mark).*

*163. Seventhly, it is not possible to state in general terms, for example by referring to predetermined percentages relating to the degree of recognition attained by the mark within the relevant section of the public, when a mark has acquired a distinctive character through use. Nor can the results of a consumer survey be the only decisive criterion to support the conclusion that a distinctive character has been acquired through use.*

38. It follows that distinctive character can be acquired and/ or enhanced through use. Distinctive character whether inherent or acquired can range from very low to very high, but there is no requirement to categorise it in this way.

Section 10(2) of the 1994 Act

39. The fundamental question was set out by Kitchin LJ (as he then was) in *Comic Enterprises Limited v. Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41; [2016] ECC 24 at [79]:

*“... the question in every case remains the same, namely whether, having regard to a notional and fair use of the mark in relation to all of the goods or services for which it is registered and the actual use of the sign, there is a risk that the average consumer might think that the goods or services come from the same undertaking or economically linked undertakings, and that is all.”*

40. In order to establish infringement under section 10(2) of the 1994 Act six conditions must be satisfied: (i) there must be use of a sign by a third party within the UK; (ii) the use must be in the course of trade; (iii) it must be without the consent of the proprietor of the trade mark; (iv) it must be of a sign which is at least similar to the trade mark; (v) it must be in relation to goods or services which are at least similar to those for which the trade mark is registered; and (vi) it must give rise to a likelihood of confusion on the part of the public (*Easygroup Limited v Nuclei Ltd* [2023] EWCA Civ 1247; [2024] F.S.R. 9 [74] per Arnold LJ).

41. In this case there is no issue as to conditions (i) and (iii). The issues are as to (ii), (iv), (v) and (vi).

42. As to condition (iv) similarity of the sign, the principles applicable to the assessment of similarity of mark and sign were summarised by Floyd LJ in *JW Spear & Sons v Zynga* [2015] EWCA Civ 290, [2015] FSR 19 at [60], cited by Joanna Smith J in *Thom Brown Inc v. Adidas AG* [2024] EWHC 2990 (Ch) [2025] ETMR 4 at [387]:

*(i) The court should assess the phonetic, visual and conceptual similarity of mark and sign and decide whether, overall, mark and sign would be perceived as having any similarity by the average consumer.*

*(ii) If no overall similarity at all would be perceived, the court would be justified in declining to go on and consider the likelihood of confusion applying the global appreciation test, as art.9(1)(b) [s.10(2)] is conditional on the existence of some similarity. Such situations are not likely to occur often in contested litigation, but where they do occur, it is not legitimate to take account of any enhanced reputation or recognition of the mark.*

*(iii) Where the average consumer would perceive some overall similarity, however faint, the court must go on to conduct the global appreciation test for the likelihood of confusion, taking account where appropriate of any enhanced reputation or recognition of the mark.*

*(iv) In conducting the global appreciation test the court must take forward its assessment of the degree of similarity perceived by the average consumer between mark and sign.*

43. As to condition (v) similarity of goods and services, and the interpretation of goods/services specifications, these were reviewed in detail recently by the Court of Appeal in *Extreme Networks Ltd v Extreme E Ltd* [2024] EWCA Civ 1386 per Arnold LJ (with whom Asplin and Baker LJJ agreed):

*11. Article 39(7) of Directive 2015/2436 and Article 33(7) of Regulation 2017/1001 both provide:*

*"Goods and services shall not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification. Goods and services shall not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification."*

*Although Article 39(7) of Directive 2015/2436 has not been specifically implemented in the 1994 Act, the principle it codifies is equally applicable under the 1994 Act.*

*12. In Canon the CJEU stated at [23]:*

*"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."*

*The CJEU has repeated this in numerous subsequent judgments: see, for example, Case C-416/04 P The Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs) [2006] ECR I-4237 at [85] and Case C-16/06 P Les Éditions Albert René SARL v Office for Harmonisation in the Internal Market (Trade Marks and Designs) [2008] ECR I-10053 at [65].*

*13. As Advocate General Jacobs explained in his Opinion in Canon at [45], the UK Government submitted that the following factors should be taken into account in assessing the similarity of goods or services:*

*"(a) the uses of the respective goods or services;  
(b) the users of the respective goods or services;  
(c) the physical nature of the goods or acts of service;  
(d) the 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 in competition with each other; that 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."*

14. As the Advocate General explained in footnote 17 of his Opinion, this list of factors was taken from *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 ("TREAT") at 296-297 (Jacob J).

...  
20. In *Sky plc v SkyKick UK Ltd* [2020] EWHC 990 (Ch), [2020] RPC 16 I considered a number of authorities on the interpretation of specifications of goods and services, and summarised the applicable principles at [56] as follows:

*"(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.*

*(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.*

*(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.*

*(4) A term which cannot be interpreted is to be disregarded."*

21. Sub-paragraph (2) of this summary is based on *Reed Executive Plc v Reed Business Information Ltd* [2004] EWCA Civ 159, [2004] RPC 40. In that case Jacob LJ cited at [43] what he had said when sitting at first instance in *Avnet Inc v Isoact Ltd* [1998] FSR 16 at 19".

44. As to condition (vi) the likelihood of confusion, a summary of the Court of Justice's principles applicable to infringement under s. 10(2) has been developed by the UKIPO and is regularly applied by the UKIPO and the courts. It has been endorsed several times by the Court of Appeal including recently in *Morley's (Fast Foods) Ltd v Nanthakumar & ors* [2025] EWCA Civ 186 at [7] and [8] (and repeated in the very recent decisions of the Supreme Court in *Iconix Luxembourg Holdings SARL v. Dream Paris Europe Inc* [2025] UKSC 25 at [38]-[39] and by the Court of Appeal in *easyGroup Ltd. v Easy Live (Services) Ltd.* [2025] EWCA Civ 946 at [21]-[22] and *easyGroup Ltd. v Easyfundraising Ltd* [2025] EWCA Civ 1000 also at [21]-[22]):

*7. The manner in which the requirement of a likelihood of confusion should be assessed is set out in a standardised summary of the applicable principles, expressed in terms referable to the registration context. The current version of this summary is as follows:*

*(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, in certain circumstances, be dominated by one or more of its components;*

*(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater degree of similarity between the marks, and vice versa;*

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

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

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

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

8. *The same principles are applicable when considering infringement, but it is necessary for this purpose to consider the actual use of the sign complained of in the context in which the sign has been used. As Kitchin LJ put it in *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] EWCA Civ 24, [2012] FSR 19 at [87]:*

*"In my judgment the general position is now clear. In assessing the likelihood of confusion arising from the use of a sign the court must consider the matter from the perspective of the average consumer of the goods or services in question and must take into account all the circumstances of that use that are likely to operate in that average consumer's mind in considering the sign and the impression it is likely to make on him. The sign is not to be considered stripped of its context."*

45. A likelihood of confusion can arise in different ways. Arnold LJ summarised previous case law in *Liverpool Gin Distillery Ltd v Sazerac Brands LLC* [2021] EWCA Civ 1207; [2021] E.C.C. 25:

*10. It is well established that there are two main kinds of confusion which trade mark law aims to protect a trade mark proprietor against (see in particular Sabel BV v Puma AG (C-251/95) [1997] E.C.R. I-6191; EU:C:1997:528; [1998] 1 C.M.L.R. 445; [1998] C.E.C. 315; [1998] E.T.M.R. 1 at [16]). The first, often described as “direct confusion”, is where consumers mistake the sign complained of for the trade mark. The second, often described as “indirect confusion”, is where the consumers do not mistake the sign for the trade mark, but believe that goods or services denoted by the sign come from the same undertaking as goods or services denoted by the trade mark or from an undertaking which is economically linked to the undertaking responsible for goods or services denoted by the trade mark.*

*11. In LA Sugar Ltd v Back Beat Inc (O /375/10) Iain Purvis QC sitting as the Appointed Person said:*

*“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’.*

*17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:*

*(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).*

*(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).*

*(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."*

*12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition. For example, one category of indirect confusion which is not mentioned is where the sign complained of incorporates the trade mark (or a similar sign) in such a way as to lead consumers to believe that the goods or services have been co-branded and thus that there is an economic link between the proprietor of the sign and the proprietor of the trade mark (such as through merger, acquisition or licensing).*

*13. As James Mellor QC sitting as the Appointed Person pointed out in Cheeky Italian Ltd v Sutaria (O /219/16) at [16] "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Mr Mellor went on to say that, if there is no likelihood of direct confusion, "one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion". I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.*

*14. "Likelihood of confusion" usually refers to the situations described in para.[10] above. As this court held in Comic Enterprises, however, it also embraces situations where consumers believe that goods or services denoted by the trade mark come from the same undertaking as goods or services denoted by the sign or an economically-linked undertaking (sometimes referred to as "wrong way round confusion")*

46. On the question of the need for evidence of actual confusion, Arnold LJ in *Match Group LLP v. Muzmatch Ltd* [2023] EWCA Civ 454; [2023] FSR 18 at [39] with the agreement of Nugee LJ and Lord Burnett of Maldon CJ, held that absence of evidence of actual confusion is not necessarily fatal to a claim under s.10(2). The longer the use complained of has gone on in parallel with use of the trade mark without such evidence emerging, however, the more significant it is. In considering the weight to be attached to this factor, it is relevant to consider what opportunity there has been for confusion to occur and what opportunity there has been for any such confusion to have been detected.

### Section 10(3)

47. In order for such a claim to succeed, the following requirements must be satisfied: (i) the registered trade mark must have a reputation in the UK; (ii) there must be use of a sign by a third party in the UK; (iii) the use must be in the course of trade; (iv) it must be without the consent of the proprietor; (v) it must be of a sign which is identical with or similar to the trade mark; (vi) it must be in relation to goods or services; (vii) it must give rise to a link between the sign and the trade mark in the mind of the average consumer; (viii) it must give rise to one of three types of injury, that is to say, (a) detriment to the distinctive character of the trade mark, (b) detriment to the repute of the trade mark, or (c) unfair advantage being taken of the distinctive character or repute of the trade mark; and (ix) it must be without due cause (*Lidl Great Britain Limited, Lidl Stiftung & Co KG v Tesco*

*Stores Limited Tesco Plc* [2024] EWCA Civ 262; [2024] E.T.M.R. 25 at [13] per Arnold LJ).

48. In this case, there is no issue as to conditions (ii) or (iv). As to condition (viii), easyGroup rely on sub-conditions (a) and (c).

49. As to (i) reputation, I was referred to the decision of Fancourt J in *Sazerac Brands LLC v Liverpool Gin Distillery Ltd* [2020] EWHC 2424 (Ch); [2020] ETMR 62:

*33. Establishing a reputation for the purposes of article 9(2)(c) [s.10(3)] is not a particularly onerous requirement, as has often been stated, but it must nevertheless be proved on the basis of some evidence. The enhanced protection afforded by art. 9(2)(c) in a case where the offending sign is used on dissimilar goods or services depends on a sufficient reputation having been established through use. Reputation here is used in the sense of knowledge of the goods, not their repute among those who do know them. The general principles that apply are those set out by the CJEU in (Case C-375/97) General Motors Corporation v Yplon SA [2000] RPC 572 :*

*"... It cannot be denied that, in the context of a uniform interpretation of Community law, a knowledge threshold requirement emerges from a comparison of all the language versions of the Directive.*

*23. Such a requirement is also indicated by the general scheme and purpose of the Directive. In so far as Article 5(2) of the Directive, unlike Article 5(1), protects trademarks registered for non-similar products or services, its first condition implies a certain degree of knowledge of the earlier trade mark among the public. It is only where there is a sufficient degree of knowledge of that mark that the public, when confronted by the later trademark, may possibly make an association between the two trademarks, even when used for non-similar products or services, and that the earlier trade mark may consequently be damaged.*

*24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.*

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

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

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

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

34. The relevant public which must have some knowledge of the earlier trade mark is therefore that concerned by it. That must mean the part of the public that has had contact with or exposure to the goods or services on which the owner of the mark has used it. The extent of the public that must have some knowledge of the trade mark therefore depends on the product or service marketed by its owner. But not all of that sub-set of the public needs to have knowledge: it suffices that a significant part of the public concerned has knowledge.

50. In order for there to be s.10(3) infringement, it must be shown among other matters that the average consumer draws a "link"; and that there is one of the three types of harm, in this case whether there is unfair advantage or detriment. Link and detriment were considered among other matters by Joanna Smith J in a summary in [73](12) to (19) of *Lidl v Tesco* [2023] EWHC 873 (Ch); [2023] FSR 15 (which was accepted as accurate by the Court of Appeal at [14] of its judgment in that case at [2024] EWCA Civ 262; [2024] ETMR 25) as follows:

***A Link between mark and sign (Condition vii)***

12) Infringement under section 10(3) requires a degree of similarity between the mark and the sign such that the average consumer makes a connection between them. It is not necessary that the degree of similarity be such as to create a likelihood of confusion, but it must be such that the average consumer establishes a link between the mark and the sign, and this is to be assessed globally having regard to all the circumstances of the case: *Specsavers* at [120]; *Adidas-Salomon*. The fact that for the average consumer the sign would call the mark to mind is tantamount to the existence of such a link (*Specsavers* at [122]; *Intel Corp Inc v CPM United Kingdom Ltd* (C-252/07) [2008] E.C.R. I-8823; [2009] R.P.C. 15 at [60] and *Comic Enterprises* at [110]).

13) Factors relevant to all the circumstances of the case will include: (i) the degree of similarity between the conflicting marks; (ii) the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public; (iii) the strength of the earlier mark's reputation; (iv) the degree of the earlier mark's distinctive character, whether inherent or acquired through use; and (v) the existence of the likelihood of confusion on the part of the public (*Intel Corp Inc* at [42]).

14) Insofar as likelihood of confusion is to be considered as a relevant factor in assessing whether there is the necessary link, "the court must consider the matter from the perspective of the average consumer of the goods or services in question and must take into account all the circumstances of that use that are likely to operate in that average consumer's mind in considering the sign and the impression it is

*likely to make on him. The sign is not to be considered stripped of its context” (Specsavers at [87]).*

***Detriment (Condition viii(a))***

*15) Detriment is caused when the mark’s ability to identify the goods or services for which it is registered and used as coming from the proprietor of that mark is weakened, since use of the later mark leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is notably the case when the earlier mark, which used to arouse immediate association with the goods and services for which it is registered, is no longer capable of doing so (PlanetArt at [31] referring to Comic Enterprises at [113] and the decision of the CJEU in Intel at [29]).*

*16) Detriment will be established where there is evidence of a change in the economic behaviour of the average consumer of the goods or services for which the trade mark is registered or a serious likelihood that such change will occur in the future (Argos Ltd v Argos Systems Inc [2018] EWCA Civ 2211 at [107]). Detriment to the distinctive character of the mark is caused when its “ability to identify the goods or services for which it is registered and used as coming from the proprietor of that mark is weakened, since use of the later mark leads to dispersion of the identity and hold upon the public mind of the earlier mark” (Intel at [76]).*

*17) It is immaterial for the purposes of assessing whether the use of the later mark is or would be detrimental to the distinctive character of the earlier mark, whether or not the proprietor of the later mark draws real commercial benefit from the distinctive character of the earlier mark (PlanetArt at [31] referring to Comic Enterprises at [115]).*

*18) “A serious risk of detriment may be established by deduction, but any such deduction cannot be supposition and must instead be founded properly on all the circumstances of the case and the nature of the trade in issue” (PlanetArt at [31] referring to Comic Enterprises at [118]). Actual evidence of a change in the economic behaviour of consumers is often difficult to obtain. Moreover, where the distinctiveness of a mark is whittled away, the detrimental impact can, in some circumstances, be reflected just as much in the evasive action that a proprietor needs to take to re-establish distinctiveness. Where a rival creeps up on a brand, a proprietor is sometimes forced to edge away from the new-comer at some cost or devote resources to amplifying its brand message to avoid its distinctiveness being drowned out by the alleged infringer. Where the evidence, taken as a whole, shows that damage of that kind is sufficiently likely, it is a corollary of the statement of principle in Comic Enterprises that it is not invariably necessary for there to be actual evidence that consumers have changed their behaviour as a result of the adoption of the rival mark (PlanetArt at [32]).*

*19) Descriptiveness of the respective marks is the key element. A trader has less right to complain that its brand is being diluted if it has chosen a mark which is of limited distinctiveness in the first place. Nor can a trader complain that precisely because its brand is so vulnerable to loss of distinctiveness and swamping by a newcomer using it descriptively that this gives rise to a claim for dilution,*

*Nonetheless, these propositions must have regard to the precise marks in issue and the extent to which they only consist of descriptive terms (PlanetArt at [34]).*

51. More recently the Court of Appeal considered unfair advantage in *Thatchers Cider Company Ltd v Aldi Stores Ltd* [2025] EWCA Civ 5. Having confirmed that the leading case on unfair advantage was the CJEU's decision in *L'Oreal v Bellure* (at [42]), Arnold LJ (with whom Phillips and Falk LJ agreed) summarised the key aspects of that case at [46]-[48]:

*"46. The Court of Justice explained the correct approach to determining whether unfair advantage has been taken of the distinctive character or repute of the trade mark as follows:*

*"44. In order to determine whether the use of a sign takes unfair advantage of the distinctive character or the repute of the mark, it is necessary to undertake a global assessment, taking into account all factors relevant to the circumstances of the case, which include the strength of the mark's reputation and the degree of distinctive character of the mark, the degree of similarity between the marks at issue and the nature and degree of proximity of the goods or services concerned. As regards the strength of the reputation and the degree of distinctive character of the mark, the Court has already held that, the stronger that mark's distinctive character and reputation are, the easier it will be to accept that detriment has been caused to it. It is also clear from the case-law that, the more immediately and strongly the mark is brought to mind by the sign, the greater the likelihood that the current or future use of the sign is taking, or will take, unfair advantage of the distinctive character or the repute of the mark or is, or will be, detrimental to them (see, to that effect, Intel Corporation, paragraphs 67 to 69).*

*45. In addition, it must be stated that any such global assessment may also take into account, where necessary, the fact that there is a likelihood of dilution or tarnishment of the mark.*

*...*

*48. In the general assessment which the referring court will have to undertake in order to determine whether, in [the] circumstances [of the instant case], it can be held that unfair advantage is being taken of the distinctive character or the repute of the mark, that court will, in particular, have to take account of the fact that the use of packaging and bottles similar to those of the fragrances that are being imitated is intended to take advantage, for promotional purposes, of the distinctive character and the repute of the marks under which those fragrances are marketed.*

*49. In that regard, where a third party attempts, through the use of a sign similar to a mark with a reputation, to ride on the coat-tails of that mark in order to benefit from its power of attraction, its reputation and its prestige, and to exploit, without paying any financial compensation and without being required to make efforts of his own in that regard, the marketing effort expended by the proprietor of that mark in order to create and maintain the image of that mark, the advantage resulting from such use must be considered*

*to be an advantage that has been unfairly taken of the distinctive character or the repute of that mark."*

47. Accordingly, the Court held at [50] that the answer to the fifth question was that:

*"Article 5(2) of Directive 89/104 must be interpreted as meaning that the taking of unfair advantage of the distinctive character or the repute of a mark, within the meaning of that provision, does not require that there be a likelihood of confusion or a likelihood of detriment to the distinctive character or the repute of the mark or, more generally, to its proprietor. The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of the mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image."*

48. It is clear both from the wording of the relevant provisions and from the case law of the Court of Justice and General Court interpreting them, in particular *L'Oréal v Bellure*, that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and General Court and of the domestic courts and tribunals that the defendant's conduct is most likely to be regarded as unfair where the defendant intends to take advantage of the reputation of the trade mark. Nevertheless, in *Jack Wills Ltd v House of Fraser (Stores) Ltd* [2014] EWHC 110 (Ch), [2014] FSR 39 I concluded at [80] that there was nothing in the case law to preclude the court from holding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation. Counsel for Aldi did not challenge that conclusion. I must nevertheless return to this topic later in this judgment."

52. Arnold LJ returned to this at paragraphs [90]-[92] of his judgment where he said:

90. *In considering these contentions, the starting point is to consider the relevance of the defendant's intention. It is common ground that, in the context of section 10(2) and passing off, the defendant's intention is only of evidential relevance.*

91. *I considered the authorities on this question, including the judgment of Kitchin LJ in *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] EWCA Civ 24, [2012] FSR 19 ("*Specsavers (CA)*", in the context of passing off in *Glaxo Wellcome UK Ltd v Sandoz Ltd* [2019] EWHC 2545 (Ch), [2014] RPC 27 at [182]-[187]. It is clear from the authorities that, if it is proved that the defendant intended to deceive consumers, then that assists the claimant to establish a likelihood of confusion (section 10(2)) or deception (passing off). As to "living dangerously" (also referred to as "sailing close to the wind"), I concluded at [188]:*

*"If it is proved that the defendant was aware of the risk of deception and proceeded recklessly, then that is capable of supporting the conclusion that deception was likely even if the defendant did not intend to deceive. If, however, what is proved is that the defendant was aware of the risk, but thought that he had done sufficient to avoid it materialising, then that is not supportive of the conclusion that deception was likely, but rather of the reverse."*

*Neither party took issue with this statement of the law.*

92. *It is also common ground that, in the context of section 10(3), the defendant's intention is also of evidential relevance in a similar way. The rationale for this is that an experienced trader like Aldi is presumed to understand its target market and therefore to know how the consumers in that market are likely to react: see Glaxo v Sandoz at [185] and [188].*

### Surveys

53. In this case, easyGroup seeks to rely on the evidence from the surveys for which I gave permission at the hearing in January 2025. Premier Inn makes various criticisms of the surveys as well as disputing what easyGroup says the surveys show. Surveys for use in UK trade mark and passing off proceedings must comply with the Whitford Guidelines, formulated by Whitford J in *Imperial Group Plc v Philip Morris Ltd* [1984] R.P.C. 293. They have been endorsed and summarised in *Interflora Inc v Marks & Spencer Plc* [2012] EWCA Civ 1501, [2013] F.S.R. 21, [2013] ETMR 11 per Lewison L.J. at [61] as follows:

*"(i) if a survey is to have any validity at all, the way in which the interviewees are selected must be established as being done by a method such that a relevant cross-section of the public is interviewed;*

*(ii) any survey must be of a size which is sufficient to produce some relevant result viewed on a statistical basis;*

*(iii) the party relying on the survey must give the fullest possible disclosure of exactly how many surveys they have carried out, exactly how those surveys were conducted and the totality of the number of persons involved, because otherwise it is impossible to draw any reliable inference from answers given by a few respondents;*

*(iv) the questions asked must not be leading; and must not direct the person answering the question into a field of speculation upon which that person would never have embarked had the question not been put;*

*(v) exact answers and not some sort of abbreviation or digest of the exact answer must be recorded;*

*(vi) the totality of all answers given to all surveys should be disclosed; and*

*(vii) the instructions given to interviewers must also be disclosed."*

## Family of Brands

54. easyGroup expressly disavowed any intention to rely on the “family of brands” or “family of marks” principle at the hearing before me on 21 January 2025 and continues to do so. Nonetheless they have sought to rely on the reputation in the public minds of brands within the easy Travel Family, namely EASYJET, EASYCAR and EASYBUS being known for offering low-cost services in the travel sector as a basis for saying that the EASYHOTEL UKTM has managed to gain a reputation for low cost hotel services because of its association with the wider easy Travel Family. Premier Inn say that the only way in which such services could have any relevance would be if easyGroup was relying on the family of brands argument.
55. The family of brands argument is one that easyGroup have run in a number of other cases with differing levels of success. Therefore, in order to understand what it is that they are not relying on in this case, it is necessary to consider what the family of brands argument is. In *W3 Ltd. v. easyGroup Ltd.* [2018] EWHC 7; [2018] ETMR 40, Arnold J (as he then was) said in this respect:

*“234. ... Where it is shown that the trade mark proprietor has used a “family” of trade marks with a common feature, and a third party uses a sign which shares that common feature, this can support the existence of a likelihood of confusion. As the Court of First Instance (as it then was) explained in Case T-287/06 Miguel Torres v Office for Harmonisation in the Internal Market [2008] E.C.R. II-3817:*

*“79. As regards the applicant’s argument that its earlier marks constitute a ‘family of marks’ or a ‘series of marks’, which can increase the likelihood of confusion with the mark applied for, such a possibility was recognised in BAINBRIDGE and confirmed in Case C-234/06 P Il Ponte Finanziaria [2007] E.C.R. I-7333.*

80. According to that case-law, there can be said to be a ‘series or a ‘family’ of marks when either those earlier marks reproduce in full the same distinctive element with the addition of a graphic or word element differentiating them from one another, or when they are characterised by the repetition of the same prefix or suffix taken from an original mark (BAINBRIDGE, paragraph 123). In such circumstances, a likelihood of confusion may be created by the possibility of association between the trade mark applied for and the earlier marks forming part of the series where the trade mark applied for displays such similarities to those marks as might lead the consumer to believe that it forms part of that same series and therefore that the goods covered by it have the same commercial origin as those covered by the earlier marks, or a related origin. Such a likelihood of association between the trade mark applied for and the earlier marks in a series, which could give rise to confusion as to the commercial origin of the goods identified by the signs at issue, may exist even where the comparison between the trade mark applied for and the earlier marks, each taken individually, does not prove the existence of a likelihood of direct confusion (BAINBRIDGE, paragraph 124). When there is a ‘family’ or a ‘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 and considers erroneously that that trade mark is part of that family or series of marks (Il Ponte Finanziaria, paragraph 63).*

81. However, according to the above case-law, the likelihood of confusion attaching to the existence of a family of earlier marks can be pleaded only if both of two conditions are satisfied. First, the earlier marks forming part of the 'family' or 'series' must be present on the market. Secondly, the trade mark applied for must not only be similar to the marks belonging to the series, but also display characteristics capable of associating it with the series. That might not be the case, for example, where the element common to the earlier serial marks is used in the trade mark applied for either in a different position from that in which it usually appears in the marks belonging to the series or with a different semantic content (BAINBRIDGE, paragraphs 125 to 127)."

### Role of the Trial Judge

56. Before turning to the evidence and consideration of the submissions, I remind myself of the role of the trial judge on the assessment of likelihood of confusion (and by extension to link) in trade mark cases, being the passage from the judgment of Jacob J in *Neutrogena v. Golden* [1996] R.P.C. 473; (1996) 19(4) I.P.D. 19028 CA (Civ Div) at page 482 cited with approval by Arnold LJ in *Lidl v. Tesco* (supra) at [121]:

*"The judge must consider the evidence adduced and use his own common sense and his own opinion as to the likelihood of deception. It is an overall 'jury' assessment involving a combination of all these factors, see 'GE' Trade Mark [1973] R.P.C. 297 at page 321. Ultimately the question is one for the court, not for the witnesses. It follows that if the judge's own opinion is that the case is marginal, one where he cannot be sure whether there is a likelihood of sufficient deception, the case will fail in the absence of enough evidence of the likelihood of deception. But if that opinion of the judge is supplemented by such evidence then it will succeed. And even if one's own opinion is that deception is unlikely though possible, convincing evidence of deception will carry the day.... Reckitt & Colman... is a recent example where overwhelming evidence of deception had that effect. It was certainly my experience in practice that my own view as to the likelihood of deception was not always reliable. As I grew more experienced I said more and more 'it depends on the evidence'."*

### The Witnesses and their evidence

57. Each side called a number of witnesses in addition to which I received some witness statements which Premier Inn accepted without the need for cross-examination of the authors of those statements. The cross-examination of the witnesses did not involve any (or at least any significant) attack on their credibility but was by way of clarification of their evidence and to obtain evidence on matters which had not been addressed in the witness statements. I felt that all of the witnesses were honest and doing their best to assist the court with their recollection of events, although a couple, as set out below, were called to give evidence as to which they had no first-hand knowledge.

58. I also received Civil Evidence Act notices in respect of a lot of documents that were put before me and in respect of a witness statement and the cross-examination of David Hansel

from the case of *easyGroup Ltd v. Easyfundraising Ltd*. That witness statement annexed a 12-page table setting out details of a large number of companies called easy and a further name either in one word or as two words, which were not easyGroup companies.

59. I shall list the witnesses and what, in my judgment, were the most relevant parts of their evidence below. I have been back through the witness statements and the transcripts of the evidence for this purpose, so have considered all of their evidence, not just those parts identified below.

60. easyGroup called the following witnesses to give live evidence:

(a) Anthony Anderson – is now an external consultant who worked for easyJet between May 1995 and November 1998, easyCafe between December 1998 and March 1991 and for easyGroup between April 1999 and March 2000. Since 2017 his role has been to chronicle the history of easyGroup and he has created and updated the “easyHistory”. He has given evidence in other cases brought by easyGroup, this being the seventh. He has been paid by easyGroup to give evidence. I have noted what has been said by other judges about his evidence, but that is not of any significance to his evidence in this case, which is what I have to consider. He provided some useful background to the businesses, albeit that much of it was things he has learned about rather than having first-hand knowledge. Some of what he said, for example as to his beliefs of what the easy brand had come to be a byline for and why licensees want to join the easy family of brands was opinion evidence which is not admissible and which I have ignored. In a short cross-examination he accepted (perhaps having learned from previous judicial criticism) that “easy” is an ordinary English word that is naturally the type of word used in advertising materials, including by some of easyGroup’s licensees.

(b) Nicholas Wait – is now “Head of Proposition” at easyJet, a role he has had since June 2021, having been with easyJet in other roles since October 2011. He has responsibility for many of easyJet’s ancillary services. He clarified by way of evidence in chief that contrary to what was said in his statement, he does not have responsibility for hotel bookings, including the partnership with booking.com; rather these have been managed by easyJet Holidays since 2019 and he was not privy to the data for those. He does have access to the hotel booking figures up to 2019, but not thereafter. In his statement, he explained the four ways in which easyJet customers were able to book hotel accommodation through the easyJet website from 2011, explaining that the relationship with booking.com started in April 2012. In cross-examination, he confirmed that it was not and never had been part of his job to deal with hotel bookings and that therefore everything in his statement as to how this was done was based on what he had been told by others (whom he had not identified in his statement) and his “awareness as an employee”. He said that he had told easyGroup’s solicitors that there might be somebody who could provide more on hotels than him, but he did not know why they were not giving evidence rather than him. In light of his failure to identify the source of his information, it seemed to me that much of his evidence on these topics is strictly inadmissible, and at the least of little weight. He confirmed that easyJet does not have any of its own hotels and the bookings were done by booking.com for which easyJet received a commission. He also accepted the propositions put to him by Ms Collett that “easy” is just an ordinary English word, meaning not difficult or simple and that “rest easy” was an idiom he was aware of used in normal, ordinary, English sentences.

- (c) Nicholas Moffatt – is the Chief Commercial Officer of easyHotel and has been since January 2024. Prior to that he had held senior roles in easyHotel since 1 October 2019, becoming a director on 21 October 2022. He had previously given evidence in another easyGroup case. He had taken over easyHotel’s digital marketing in September 2022, being responsible for the technical aspects of digital marketing upon the departure of a colleague. He fairly said he was not an expert in this area. Pictures and advertisements, including on social media were not within his remit, but were dealt with by an offline marketing team, who report into a colleague of his, not to him. He set out in his statement that customers can book with easyHotel through third-party intermediaries, such as booking.com, AirBnB and Expedia, directly on the easyHotel website, or in person at the hotel or via the group sales team. easyHotel has 44 hotels, 18 of them being in the UK (although in cross-examination he suggested it was only 13 hotels in the UK, with 34 abroad). He produced some data from Google analytics, which showed 9,805,840 people had landed on easyhotel.com in what he thought was the period 1 December 2021 to 19 November 2024, although he was not sure about the date range. The turnover of the whole business is approximately £67 million, of which £28 million was from the UK and £39 million from the rest of the world. Turnover has grown substantially over recent years, in particular from September 2021 onwards in both the UK and the rest of Europe. The easyHotel marketing spend has been between £755,000 for 2021 to approximately £1.2 million in 2023 and roughly the same on a pro rata basis for 2024. As with all in the hospitality sector, marketing spend during the Covid pandemic was reduced. In June 2020 as the country was beginning to emerge for the first time since Covid, easyHotel rolled out a marketing campaign using the slogan “Stay easy, Stay safe”. He did not suggest that any of the marketing spend was to counter any effects of the rebranding by Premier Inn to add the strapline “Rest easy”. Mr Moffatt explained the requirement to conform with brand guidelines, being the use of the Cooper Black font and the orange and white colours, save where a local authority will not allow those colours to be used, in which case Cooper Black font is used in black on a white background. This had happened at 4 sites in the UK. As with the previous witnesses called by easyGroup, Mr Moffatt agreed that “easy” is an ordinary English word, which means not difficult or simple. He also agreed that it does not mean low-cost. Mr Moffatt was taken to a number of examples of the ordinary use of the word “easy” within easyHotel’s own materials. He accepted that the expression “rest easy” meant sleep easy or not to worry and that it did not have anything to do with low cost. In addition, he was taken through a number of bits of advertising from hotel chains other than easyHotel and Premier Inn where the idiom “rest easy” was used. He sought to draw a distinction between it being used in advertising copy as opposed to in a strapline as Premier Inn use it.
- (d) Gavin Richardson – a professional graphic designer, who had been employed by easyEverything from 1999-2002, for easyGroup UK Ltd from 2002 to 2008 and for easyGroup IP Licensing Ltd (which was the then name of easyGroup) from 2008-2011. He had a period of having no involvement with easyGroup but in the last three or so years had done some paid external consulting for easyGroup including on the easyHistory project and for previous court cases. He has given evidence in five cases, including this, for easyGroup. He was being paid for his time in preparing the statement and giving evidence. He had been very involved in the development of the easyGroup brand manual from its inception, in particular in the section on the easy visual identity. He described this as predominantly the colour scheme (orange, white and black) and the typeface used to go with it (Cooper Black font for the brand name). He also set out

his involvement with the easy.com website, easy.com having started as a free email service. He had worked with easyHotel in the prelaunch state in late 2003/early 2004. Marketing for easyHotel was mainly done on their own channels to begin with. He had designed the map and banner that hung off the side of the first easyHotel, which was in South Kensington in December 2004. In cross-examination he was taken to the detail of the brand manual from 2010 about the “Getup” being an essential part of the easyJet Brand Licence and “*is set in stone*”. He explained the colours adopted, how to get as close to that colour as possible, and the Cooper Black font. He confirmed that in the business logos there was never a space between easy and the word of the business. He also explained the importance of the exclusion zone or safe space around the presentation of the marks. Mr Richardson had produced from his own archive guidance specifically for easyHotel, which also made express reference to the importance of the exclusion zone around the mark. He was shown the current brand manual in cross-examination and agreed it had essentially not changed.

Sir Stelios was not called to give evidence, but while Mr Anderson was asked why not, Premier Inn did not develop any submissions as to the significance, or otherwise, of this.

61. In addition to these witnesses who were called to give evidence, I had the benefit of witness statements on behalf of easyGroup from the following who were not required to attend for cross-examination:

- (a) Jonathan Wright – is the in-house web designer at easyGroup and has been since November 2011. He provided evidence as to the addition to the websites of licensees the slogan “part of the **easy** Family of Brands”, as to the easy.com website which he described as a portal to the easy family of brands, and produced some reports from Google Analytics as to “sessions” for each of easy.com and easyHotel.com for the period 5 November 2023 to 5 November 2024.
- (b) Simon Champion – he had been the CEO of easyHotel between June 2013 and June 2015, having been brought in by Sir Stelios to assist in an IPO of the easyHotel business. This occurred during 2014, with some £30 million being raised, which was described in one Financial Times article as half the initial goal. He sets out the strategy he adopted at the time of being in the “super budget” market, suggesting this was a lower market than that in which Premier Inn worked. He says he saw Premier Inn as a competitor to easyHotel. His evidence related to a period some 6-8 years prior to the commencement by Premier Inn of the use of the strapline “Rest easy”.
- (c) Robert Jacob, the partner at easyGroup’s solicitors with conduct of the case, who gave evidence in his fourth witness statement (the earlier witness statements having been prepared for interim hearings) as to various internet downloads he had undertaken to establish that there were no other hotel brands in the UK which included the word “easy”. As I set out below, Mr Jacob was cross-examined in relation to the survey evidence, but not in respect of the contents of this statement.

62. easyGroup did not call any witnesses to give evidence as to Rest Easy Apartments Ltd or provide any witness statements going to this.

63. Premier Inn called the following witnesses to give live evidence:

- (a) Neil Henderson – is the CEO and owner of St Luke’s an independent creative agency. He has worked in the advertising industry for over 35 years. St Luke’s were one of those who pitched to develop a new brand platform for Premier Inn in 2020. Although its pitch was unsuccessful, St Luke’s proposed the “Rest Easy” endline (as did the successful bidder, Leo Burnett). Mr Henderson expressed his views based on his experience in the advertising industry that Premier Inn had branding that stood out from the crowd. He dealt with the process by which St Luke’s pitched based on two documents prepared by Premier Inn, a Request for Information for Marketing Services (the “**RFI**”) entitled “Putting Premier Inn back on the map” dated 3 February 2020 and a Request for Proposal (the “**RFP**”) entitled “Putting Premier Inn back on the map in a post-COVID 19 world” dated 30 April 2020. He recorded that the main challenge the RFI noted was the changing nature of the market, with Premier Inn having to face competition from online travel agencies and AirBnB. The RFP was more detailed, listing competitive brands and among others AirBnB. It did not list easyHotel as competition and he says it was never mentioned in subsequent meetings he had with Premier Inn. easyJet was included among a more general list of other value brands which had done a good job of communicating value in their respective markets. He recounted the tissue meetings that had taken place to discuss the brief with Premier Inn in detail. He set out the rationale behind coming up with the endline “Rest Easy”, having initially alighted on “Rest. Assured”. That was rejected as being too close to a mattress company called “Rest Assured” (without a full stop between the words). He says they did not have any concerns about the “Rest Easy” endline and a possible connection to easyGroup, easyHotel or any entity within the “easy family of brands”. At no point did anyone at Premier Inn suggest that they wanted the Premier Inn branding to be close to any company within the easyGroup. In cross-examination, he confirmed that the pitch was for the new “brand platform” (not a total re-brand). He explained that a brand platform was one consistent overall story, a set of words that sums up the meaning of the brand and the benefit of the brand. The idea was to create something which will prevail through different campaigns and will give instant recognition of particular values. He was referred to the examples of “Just Do It” which is Nike’s brand platform and “Every Little Helps” which is Tesco’s and accepted that what St Luke’s was trying to achieve was something equivalent for Premier Inn, although it might take a long time for that sort of recognition to happen.
- (b) James Millers – is an Executive Creative Director at the advertising agency, Leo Burnett. He has been working in the advertising industry for 19 years. He was part of the team which came up with the “Rest Easy” endline and that developed the “Rest Easy” campaign in April 2021. His instructions were to develop a new brand platform that would build upon Premier Inn’s existing brand positioning, which was well-known for its focus on sleep, comfort and its partnership with Sir Lenny Henry. He says that they were looking for a long-running brand position for Premier Inn that would reflect peace of mind that guests get from staying at a Premier Inn hotel. In his cross-examination he explained that it was important for Leo Burnett to show that they understood who Premier Inn were as a brand, which was in the value brand rather than the premium hotel market. Leo Burnett presented four options to Premier Inn, but Leo Burnett’s favoured one was the phrase “Rest Easy”, which they viewed as almost synonymous with “peace of mind”. In preparation for the pitch meeting, they considered competitors but those did not include easyHotel as they did not consider it as a relevant comparator for the purposes of Premier Inn’s brand positioning. They instructed a typographer to create a handwritten font that would be unique to the new

brand platform. They also developed the physical positioning of the endline in relation to the Premier Inn logo; it being agreed that the endline would always be secondary to the moon and stars logo and the Premier Inn word mark. Mr Millers was also involved in the development of the brand guidelines for the use of the endline, which provided that “Rest Easy”, with the exception of marketing copy, should not be used on its own. He was taken to examples of marketing copy in cross-examination which he confirmed were in accordance with the brand guidelines. He was unable to recall an email chain from April 2021 from Yasmin Mukhida-Olushola at Premier Inn just before the “Rest Easy” campaign went live in which she asked the question “what if easyJet/easyHotels come at us tomorrow on Social with a ‘Thanks Premier Inn for the free advertising’ type tweet ...”. He did not reply to it, but his fellow creative director Andrew Long did.

- (c) Katherine Roe – is a senior insight manager at Whitbread Group plc (“**Whitbread**”), the owner of Premier Inn. Her responsibilities include collating, analysing and reporting on customer insights and customer feedback for Premier Inn. She manages a team of 10 who try to understand how Premier Inn customers feel and behave before, during and after visiting a Premier Inn hotel as well as how consumers respond to Premier Inn advertising campaigns. She explained how third party agencies are instructed to conduct targeted research projects with consumer groups and identified 4 such agencies. According to the YouGov Brand Index she said that at November 2024 Premier Inn had a brand awareness rating of 91.9% i.e. that 91.9% of the UK population was aware of Premier Inn. The main source of customer insight used by her team is customer surveys, for which they use a platform called Spotlight. All customers (other than those who have opted out) are sent a survey the day after they checkout. Approximately 16% of customers return them. Between 12 April 2021 and 8 November 2024, Premier Inn received 4,069,961 survey responses and 888,033 customer reviews on Tripadvisor and Google. She explained that if a customer had raised a concern about how Premier Inn’s “Rest Easy” brand platform reminded them of easyHotel or one of the easyGroup companies that would have been flagged and brought to the attention of her team. She had never encountered any instances of a customer drawing a parallel between the “Rest Easy” brand platform and easyHotel or any of the easyGroup companies. In none of the survey responses (which did not include any specific questions about the “Rest Easy” brand platform), nor in any of the Tripadvisor and Google reviews had any comments been made of this nature. She had conducted a keyword search in respect of the survey responses and Tripadvisor and Google reviews using “EASYHOTEL”. “EASY HOTEL”, “EASY GROUP” “EASYGROUP”, “REST EASY APARTMENT” and “REST EASY”. As to the survey responses, these produced only a very small number of returns, of which even fewer related to the easyHotel brand, mainly by way of comparing the standards of Premier Inn favourably with easyHotel. None of the responses drew any parallels between “Rest Easy” and the easyHotel branding or between the “Rest Easy” and easyGroup branding. There were no results for “EASYGROUP” or for “REST EASY APARTMENT”. As to the Tripadvisor and Google reviews, there were similarly small returns, none of which drew any parallels between “Rest Easy” and the easyHotel branding or between “Rest Easy” and easyGroup branding. There were no results for the terms “EASY GROUP” “EASYGROUP” or “REST EASY APARTMENT”. Ms Roe highlighted one comment on 6 April 2022 left on the Tripadvisor page for the Premier Inn London City (Old Street) Hotel, which referred to having booked in for 3 nights “*at the Easy Hotel, 80 Old St, Shoreditch, London*”. That is an easyHotel, not

the Premier Inn, but this was the only comment among the 3,975 Tripadvisor reviews of the Premier Inn London City (Old Street) Hotel where someone had mistakenly left a review of the easyHotel on the Premier Inn Tripadvisor page. She said that where there had been comments about “Rest Easy” they had been positive and negative as to whether the experience had lived up to the slogan “Rest Easy”. In her cross-examination, Ms Roe quite properly accepted that the Premier Inn customer survey did not ask customers to think specifically about any brand, but they are asked open questions so that they can tell Premier Inn about anything on their mind.

- (d) Jamie Hughes – is Head of Guest Support at Whitbread, the owner of Premier Inn, and has been since April 2022. His role includes overseeing the guest relations team of some 94 colleagues, 80 of whom manage queries and complaints received via online web forms and email and who also operate the phonelines. He refers to these as unsolicited customer communications from customers who have contacted Premier Inn and volunteered information. Every customer interaction is reviewed by at least one member of Mr Hughes’ team and categorised depending on its subject matter. If a new issue arises which has not previously been encountered a new complaint category will be created. Mr Hughes said that he has never encountered any incidents where consumers have notified Premier Inn about similarities between Premier Inn’s “Rest Easy” branding and the branding of easyHotel or any other company in the easyGroup. Mr Hughes reviewed the Microsoft Dynamics platform to determine how many customer interactions there had been between 1 April 2021 and 17 October 2024. In total there were 1,032,191 interactions, which he broke down into 11 categories, the top three categories being web form, email and telephone call, together accounting for just under 1 million of the reactions. He says that in none of these customer interactions since the launch of the “Rest Easy” campaign, has any customer raised a complaint or expressed confusion or concern about the “Rest Easy” branding in so far as it relates to the easyGroup or easyHotel branding or anyone else. He did a keyword search using the same keywords as Ms Roe had done on her data, the returns of which were two references to ‘EASYHOTEL’, five references to ‘EASY HOTEL’ and one reference to “EASY GROUP”. He set out in his witness statement each of these references, none of which had anything to do with the “Rest Easy” branding; rather they were complaints about service issues at Premier Inn hotels. He had got 37,987 results in respect of the “REST EASY” keyword search. He explained in cross examination that this was such a high number because, among other matters, when someone from Premier Inn writes back to a client, they will use the phrase *“you can rest easy should you stay with us again”*. These results were then subjected to a proximity search, which turned up 10 results, each of which Mr Hughes analysed as having nothing to do with the Premier Inn “Rest Easy” branding or the easyGroup branding. He set these out commenting correctly that they were because the word “orange” was used, mainly in the context of orange squash rather than orange juice having been supplied. In cross-examination, Mr Hughes provided further support for what he had done. He also confirmed that if, for example, someone had written on Twitter that it looked as if Premier Inn were taking advantage of the easy name, someone from his team would have responded to that and it would have been included in the dataset that he interrogated. There were no such instances.
- (e) Tamara Strauss – was the Global Customer Director at Whitbread, the owner of Premier Inn, between November 2019 and October 2024. She is no longer employed by Premier Inn, but nonetheless came to give evidence. She had worked for easyJet Holidays

between November 2018 and March 2019. She was the person responsible at Whitbread for overseeing the development and implementation of Premier Inn's "Rest Easy" brand platform in 2020/2021. She set out the process by which the Leo Burnett advertising agency was eventually selected as the agency to develop and run the launch of the "Rest Easy" brand platform, including the development of the RFI and RFP. She had not been able to attend the tissue meetings herself but one of her team, Yasmin Mukhida-Olushola, had provided her with a detailed summary of what had been discussed. She did not remember easyJet being a major consideration at the time. She viewed "rest easy" as meaning "to be carefree and untroubled by worries". Although the issue of whether "Rest Easy" was too close to "easyJet" was raised, she did not think "Rest Easy" was a problem, and neither of the agencies who were asked to stress-test this thought that easyGroup's use of the word "Easy" should prevent Premier Inn from using "Rest Easy" as an endline. She did not envisage any confusion between the brands. The first campaign launched with the "Rest Easy, From Booking To Bed" strapline. She was involved with Leo Burnett in developing the "Rest Easy" brand guidelines. She said that Premier Inn would use "Rest Easy" as part of the lock up below Premier Inn in the device. It either uses the words "Rest Easy" with the logo, or it is written in copy. They do not use the words "rest" or "easy" on their own. She did not remember the May 2020 email or the April 2021 email from Yasmin Mukhida-Olushola, the latter from just before the launch in which she raised among other potential concerns, the question of what reaction there might be from easyGroup when Premier Inn launched its campaign. She said they cannot have caused her any concern. Had they done so, she would have taken it further. She was not aware of any complaints or mention in the press drawing a connection between the "Rest Easy" strapline and the easyGroup branding. Nor was she aware of any issue of that nature in the 3.5 years that the "Rest Easy" brand platform had been operational by the time she left Whitbread. She confirmed that at the time the RFP was produced, it was felt that Premier Inn had not been playing as a value brand, and they wanted to make sure that they were seen as value for money for customers, which is why there was reference to value brands, including easyJet in the RFP.

64. easyGroup appeared to make something of the absence of Yasmin Mukhida-Olushola as a witness. I was told, and I accept, that she is on maternity leave. No criticism can properly be levelled at her not being called as a witness in those circumstances. It does mean that I do not have any evidence from the author of the emails in May 2020 and April 2021, which I will have to bear in mind when reviewing those emails in the context of the s.10(3) claim. I did hear from people who were recipients, who were unable to remember them. The evidence from them, and in particular Ms Strauss, was that none of the issues raised in those emails caused concern.
65. In addition to the lay evidence, each party called an expert to address the survey evidence. I shall deal with their evidence when I come to consider the relevance and weight, if any, of the survey evidence. I shall also deal at that point with the cross examination of Robert Jacob, the partner at easyGroup's solicitors with conduct of the case, which went solely to the survey evidence.

### **The s.10(2) Claim**

66. easyGroup's claim is pleaded in one paragraph of the Re-Re-Amended Particulars of Claim, paragraph 34AA:

*“In the alternative, the Defendant's Signs are each similar to the Rest Easy [Apartments] UKTM and have been used in relation to services which are each identical or highly similar to the Rest Easy [Apartments] UKTM Services. By reason of such identity or similarity, there exists a likelihood of confusion on the part of the average consumer. In the premises, the Defendant has infringed the Rest Easy [Apartments] UKTM under section 10(2) of the Act.”*

67. The claim here is as between the Rest Easy Apartments UKTM and Premier Inn’s signs:

| The Registered Mark                                       | Signs Complained of                                                                                                                                                                          | UKTM used as signs complained of                                                                                                                                               |
|-----------------------------------------------------------|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Rest Easy Apartments<br>(“the Rest Easy Apartments UKTM”) | <br><br><br><br>REST EASY | <br><br> |

68. I found Mr Malynicz’s submissions on this topic somewhat confusing. It appeared from easyGroup’s opening and closing written submissions to be its case that the use of the words “Rest Easy” outside of the Premier Inn Device and the Premier Inn UKTMs by Premier Inn is an infringement under s.10(2), because it was said that what one needed to compare was the Rest Easy Apartments UKTM with the word sign “REST EASY” (see paragraph 41 of the written submissions). And that because that is an infringement, it followed that the use by Premier Inn of those words in the lock up is also an infringement. Ms Collett dealt with this in her oral closing submissions on behalf of Premier Inn to seek to demonstrate that the use of the words “Rest easy” outside of the lock up was everyday use. In his reply submissions, Mr Malynicz appeared to take the opposite stance to his initial submissions, saying that if there were no lock up i.e. no Premier Inn Rest Easy Device, easyGroup would have no complaint if Premier Inn used the expression “Rest Easy” in its marketing content. He said there was “no way” that if I dismissed the claim on the locked-up logo that they would have a claim in respect of the textual use.

69. Accordingly, it appears now to be common ground between the parties that I need to look at the lock up in the Premier Inn Rest Easy Device initially and only if I were to determine that there was infringement under s.10(2) in that respect would I need to go on to consider whether the use of “Rest Easy” in Premier Inn’s marketing material was also an infringement, because it was being used with or alongside the Premier Inn Rest Easy Device.

70. As the REST EASYAPARTMENTS UKTM is a word mark, it covers all fonts and all colours, so it does not matter in what form the words REST EASY appear if their use would otherwise be an infringement. I turn to the conditions in dispute between the parties.

Condition (ii) – use in the course of a trade

71. The words complained of have to be being used in the course of a trade, that is in the trade mark sense as a badge of origin. easyGroup’s case, as confirmed in paragraph 30 of its written closings, is that each and every use of the signs identified in paragraph 29 of, and appendix 10 to, the Re-Re-Amended Particulars of Claim has been a use as an indicator of trade origin. Premier Inn’s pleaded case at paragraph 29 of the Re-Re-Amended Defence is that the screenshots and extracts at paragraph 29 of, and appendix 10 to, the Re-Re-Amended Particulars of Claim are from the Premier Inn Website and social media pages. But it was not admitted that all the use in Annex 10 aside from the use of the Premier Inn Device is use by Premier Inn of a sign as an indicator of origin, giving an example of the use of “rest easy” as use of the words in an ordinary English phrase. Premier Inn refers back to paragraph 27 of the Re-Re-Amended Defence, where it is pleaded that since 12 April 2021 the words “REST EASY” have been used in advertising campaigns and on their website, social media pages, YouTube videos and in-hotel posters. It is pleaded that such use has been part of the Premier Inn Rest Easy Device and/or alongside and/or in conjunction with Premier Inn’s Moon Device and/or the sign Premier Inn. It is pleaded that the use in marketing materials is use of the words as an ordinary English phrase. Accordingly, it is said that the words “Rest Easy” alone are not being used in a branded sense.
72. It follows that as to condition (ii), Premier Inn admit the use of “Rest Easy” locked up in the Premier Inn Rest Easy Device has been use in the course of trade as a badge of origin. But that they assert that the use of the words “rest easy” otherwise than in the locked up form, has been use of the words as an ordinary English phrase.
73. easyGroup contend that where Premier Inn uses the words “rest easy” in marketing copy, that use is also branded use. Of the three examples identified in their written closing submissions, two were in fact from a pitch pack by one of the advertising agencies, Leo Burnett, and there is no evidence that they were used by Premier Inn. easyGroup rely on what Premier Inn’s witnesses said about the creation of a brand platform, with the aim of “REST EASY” becoming as well known as the endlines “Just do it” or “Every little helps”, in particular the evidence of Mr Millers, Mr Henderson and Ms Strauss. They rely on the witnesses accepting that when used in marketing copy, it was being used in accordance with Premier Inn’s brand guidelines.
74. Premier Inn put in evidence a large number of examples of the phrase “rest easy” being used in public facing documents, one for each decade since 1800 to 2000 and thereafter 24 pieces of use since 2000. These included magazine or newspaper articles or letters to the paper, books or journal extracts and dictionary definitions of the phrase “rest easy”. They demonstrated (in the course of the cross-examination of Mr Moffatt) that the phrase had been as at the Relevant Start Date, and is still being, used in a number of other advertising campaigns including across the hotel sector. They also rely on the agreement in cross-examination by easyGroup’s witnesses that it is an ordinary English phrase and there is nothing wrong with it being used in advertising copy.

75. Within the bundles there are very many examples of marketing copy from Premier Inn, sometimes on the same page as the Premier Inn Rest Easy device, sometimes not. On some occasions the phrase appears just once, for example *“From our hotel to your home, rest easy with a pair of our new and improved Premier Inn pillows”*. On others it appears more than once for example *“Rest easy from booking to bed ... Rest easy with Premier Inn ... From booking to bed, Premier Inn are here to help the nation rest easy”*. On others, it appears multiple times *“From booking to bed, we’re here to help you rest easy. Every time you stay at Premier Inn you can rest easy knowing you’ll have a deep, satisfying sleep. Rest easy knowing you’ve got choice AND flexibility. Rest easy knowing you’ll have the same top-quality experience as ever. Rest easy knowing you’re safe, our hotels are cleaned to the highest of standards and that we genuinely care about you and our teams. And the best bit? Rest easy knowing you get all of this for a great price, just a click away.”*
76. No matter what the witnesses say, it is ultimately a matter for me to determine if the use of the phrase in marketing copy is branded use. It is right to note that in some examples, the phrase is repeated time after time, rather than simply being used on a single occasion in the copy. Nonetheless, in my judgment the phrase is a normal English idiom and where it is simply being used in marketing copy and not as part of the lock up with the Premier Inn Rest Easy Device or the Premier Inn Rest Easy Apartments UKTM, it is not being used in a trade mark sense. It follows that, in my judgment, simple use of the words alone in marketing copy does not satisfy condition (ii). As set out at paragraph 68 above, that seemed to be Mr Malynicz’s final position too.

#### Condition (iv) – similarity of sign

77. The use must be of a sign which is at least similar to the trade mark. In this regard, the task is to compare the Rest Easy Apartments UKTM with the sign as used by Premier Inn. For these purposes the sign does not include the use of the words “Rest Easy” alone given my finding above, rather the sign is the Premier Inn Rest Easy Device and the Premier Inn UKTM.
78. As set out above, the task for the Court is to assess the phonetic, visual and conceptual similarity of the trade mark and the sign and decide whether, overall, on a multifactorial global assessment, the mark and sign would be perceived as having any similarity by the average consumer.
79. In this case, easyGroup do not rely (nor has it pleaded reliance) on any use of the Rest Easy Apartments UKTM in support of its case under s.10(2), although it does get a passing mention in easyGroup’s closing submissions. Accordingly, its distinctiveness must derive from the mark alone. It is accepted by Premier Inn (and follows from the *Formula One* decision) that the fact that the trade mark has been registered and its validity has not been challenged means it has the minimum degree of distinctive character for it to be validly registered. However, it is argued on the basis of *Whyte & Mackay Ltd. v. Origin Wine UK Ltd.* [2015] EWHC 1271 (Ch); [2015] FSR 33 at [28], that the lack of challenge to its validity does not mean that the trade mark has more than that minimum degree of distinctiveness.
80. The question is therefore what the average consumer would believe the degree of distinctiveness of the Rest Easy Apartments to be. easyGroup submits that the word “Apartments” is merely descriptive of the service and therefore the distinctiveness is to be

found in the words “Rest Easy”. It submits that this expression can mean many things (there is not a single meaning) including “rest assured” or “don’t worry” and this is suggestive or allusive and therefore not descriptive of the services provided; rather it indicates some positive qualities about potentially the experience that the guest could have, but it is not describing the service in question. Mr Malynicz’s submission was that it was of average distinctive character.

81. For Premier Inn, Ms Himsworth submitted that such distinctiveness as the trade mark has (and she accepted it had to have at least the minimum degree) comes from the combination of all 3 words, not from just “Rest Easy”. She submits that the distinctiveness is at the very minimum level required for registration of the whole phrase.
82. I prefer the submissions of Ms Himsworth on this. In my judgment the average consumer would perceive there to be a very low level of distinctiveness in the Rest Easy Apartments UKTM and that which it does have is as a combination of all 3 words together, rather than just the words “Rest Easy”. She would not consider that the distinctiveness lies in the words “Rest Easy”, but rather in the whole expression. But even if I am wrong in that, and the distinctiveness lies only in the words “Rest Easy”, again in my judgment the average consumer would not regard these as having more than minimal distinctiveness. She would not consider that those words, which are an English idiom, would be of average distinctiveness, as easyGroup submitted.
83. When undertaking the multifactorial comparison for the purposes of assessing similarity, the average consumer will consider the overall impression given by the mark and compare that with the sign. Given that the Rest Easy Apartments UKTM is a word mark and therefore not limited by stylisation, the comparison to be made is between “Rest Easy Apartments” and “Premier Inn Rest Easy” with the Moon Device. In this case, there is a measure of aural or phonetic similarity in that both the mark and the Premier Inn’s sign include the words “Rest Easy”. In my judgment, the additional word “Apartments” in the mark on the one hand and the Moon Device and the Premier Inn name in the sign on the other hand with the words “Rest Easy” appearing as the last words means that the level of similarity would not be considered by the average consumer to be great. The idiom “Rest Easy” would not be seen by the average consumer as a dominant component of the Premier Inn Rest Easy Device. The dominant component is the Moon Device and/or the words Premier Inn. In my judgment, the average consumer would consider the overall level of similarity between the Rest Easy Apartments UKTM and the Defendants’ Signs to be low. There would be even less similarity if one were allowed to take into account the colour, but for the purposes of this exercise that is not permitted (*easyGroup v. Easyway SBH* [2021] EWHC 2007 (IPEC) at [67]) and I do not do so.

#### Condition (v) – similar goods

84. The use of the sign must be in relation to goods or services which are at least similar to those for which the trade mark is registered. In this context, it is the actual use of the sign that has to be compared with the specification of the trade mark.
85. The Rest Easy Apartments UKTM is registered under Class 36 of the Nice Classification: “*Accommodation bureau services [apartments]; Letting of apartments; Management of apartments; Rental of apartments*”.

86. The evidence as to the actual use of Premier Inn's Signs is for hotel services provided by Premier Inn. The unchallenged evidence was that Premier Inn hotels can only be booked directly with Premier Inn and that Premier Inn does not provide any separate hotel reservation services.
87. In my judgment, there is no similarity of services between "*Management of Apartments*" with the hotel services provided by Premier Inn. As to "*Accommodation Bureau Services*", not interpreting this widely, but confining it to the core of the possible meanings attributable, this is a service of finding accommodation for its clients by whoever might provide such accommodation, as opposed to merely allowing online booking of its own accommodation. In my judgment finding accommodation for clients is not similar to the use which Premier Inn have been making of the sign. Nor are these complementary services. One should therefore, for the purposes of condition (v) be comparing the "*Letting of apartments*" and the "*Rental of apartments*" with the provision of hotel services by Premier Inn.
88. The factors to be considered include, among others, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary. As to factors identified in paragraph [13] of *Extreme Networks Ltd v Extreme E Ltd* (supra), easyGroup adduced very little evidence as to these, but such evidence as there was demonstrated as follows:
- (a) **the uses of the respective goods or services:** all of the relevant uses in respect of Premier Inn's Signs are within the UK. So, the relevant comparison is between the provision of hotel services within the UK with the rental or letting of apartments also within the UK. The main (but not sole) purpose of the provision of hotel services is for overnight sleeping or temporary accommodation. As Arnold J (as he then was) held in *W3 v easyGroup* [2018] EWHC 7 (Ch); [2018] E.T.M.R. 40 at [180] "*Hotels are a species of the genus temporary accommodation, albeit that the genus also includes other forms of accommodation which are temporary rather than permanent*". The provision of temporary accommodation is also at least part of the function of the rental or letting of apartments. It may be that generally those looking for an apartment to rent or to take a letting might be seeking a longer term than those looking for hotel accommodation, but with the rise of businesses such as AirBnB, that cannot be universally true. It is well known, and I believe I can take judicial notice of this, that many people make use of AirBnB for a single night or for a few nights as they might do when booking a hotel, rather than for an extended period of time. There was evidence put before me of hotels who offer apartments under the same name, such as Holiday Inn Stalybridge Suites, Apartments Marriott and Hyatt Studio, as well as many others who offer apartments under different names. Accordingly, in my judgment there is a level of similarity. What one does not tend to get with rental of apartments is the provision of the "extras" that come with hotel services, such as food, staff or parking, all of which are offered by Premier Inn, but that does not make the letting/rental of apartments dissimilar;
- (b) **the users of the respective goods or services:** there was no evidence led on who the users of Rest Easy Apartments are (probably because what Rest Easy Apartments actually does, as opposed to what is covered by the Rest Easy Apartments UKTM Services it strictly irrelevant) or who the users of Premier Inns hotels are. In my judgment it is clear that there will be some overlap between those who make use of the

types of services covered by the Rest Easy Apartments UKTM in terms of the letting/rental of apartments, in particular on a very short term basis, and those who use hotels. Taken from the standpoint of the average consumer identified in this case (see paragraph 33 above), those looking to book hotels on the internet are, in my judgment, also likely to consider short term rental options, such as AirBnB. That was undoubtedly the view taken by Premier Inn when they put together the RFI and RFP and identified, among others, those using AirBnB as the target audience. As it was said in the RFP, Premier Inn competes “*with anyone who sells a room*”. Accordingly, while I do not accept the submission on behalf of easyGroup that the users are identical, as there will be many users of Premier Inn who would not book an apartment, there is a significant level of overlap;

- (c) **the physical nature of the goods or acts of service:** while I accept easyGroup’s submission that the rental or letting of apartments and hotel services are both services which provide temporary accommodation, including by way of rooms, there is a difference between them, given the lack of the complementary services of staff, parking and food which are not offered (or at least as to which no evidence was put before me to show that they were offered) in letting or rental of apartments, but which are offered by Premier Inn;
- (d) **the trade channels through which the goods or services reach the market:** Premier Inn’s hotels can be booked online. It is not relevant what Rest Easy Apartments actually did as at the Relevant Start Date as that is not what is being compared with what Premier Inn actually does/did (although I note in passing that it is not clear on the evidence before me if Rest Easy Apartments offered internet bookings as at the Relevant Start Date). It is clear that the letting/rental services for which the Rest Easy Apartments UKTM was registered could be delivered through the same trade channels as those actually used by Premier Inn, namely online, but so can almost all goods or services;
- (e) **self-serve consumer items:** are not relevant in this context;
- (f) **the extent to which the respective goods or services are in competition with each other:** as I have set out above, there is, in my judgment, a level of competition between Premier Inn’s hotel services and rental/letting of apartments, as was acknowledged by Premier Inn in both the RFI and the RFP. In a market where price is an important factor, it is likely that at least some customers will consider both options before deciding where to book.

89. On behalf of Premier Inn, Ms Himsworth accepted that it could not be said that there was no similarity but submitted that there was low similarity, and that what was provided by Premier Inn at the Relevant Start Date was qualitatively different to the services provided through the rental or letting of apartments, even if confined just to short term lets. While I accept that there are qualitative differences between the provision of hotel services and the rental or letting of apartments, I am unable to accept that the similarity is as low as Ms Himsworth submitted. Rather, it follows from the above analysis of the matters identified in the *Extreme* case that in my judgment there is a not insignificant degree of similarity of services. I do not accept easyGroup’s submissions, which were made without supporting evidence, that the services are identical or that there is a very high level of similarity. In my judgment undertaking the global assessment of all of the matters above, the average consumer would consider there was a medium level of similarity between the rental/letting

of apartment services covered by the Rest Easy Apartments UKTM and what Premier Inn provided by way of hotel services under use of the sign.

Condition (vi)

90. In light of my findings that there is some overall similarity, I have to address the likelihood of confusion. This has to be assessed by reference to the factors identified at paragraph [7] of the *Morley's (Fast Foods) Ltd v Nanthakumar* judgment (supra). It is common ground between the parties that I need to approach this on the hypothetical basis that the average consumer is aware of the Rest Easy Apartments UKTM, although she will not have sight of the mark but will be relying on her imperfect recollection of that mark. She will know that the mark is in relation to the rental of apartments, but will not have heard of “Rest Easy” as previously having anything to do with Premier Inn. She will know Premier Inn as a hotel company. What she will be doing is considering the actual use of the sign complained of in the context in which it is used while having imperfect recollection of the Rest Easy Apartments UKTM.
91. However, she will perceive the mark as a whole and the sign as a whole and will not proceed to analyse their various details. In my judgment, in doing this the average consumer will do so taking into account the very low level of distinctiveness in the Rest Easy Apartments UKTM, that the level of similarity between the mark and the sign is low, and the level of similarity between the rental/letting of apartment services covered by the Rest Easy Apartments UKTM and what Premier Inn provided by way of hotel services under use of the Signs is medium.
92. In my judgment, she will form the view that the overall impression conveyed by the Premier Inn Signs is dominated by the Premier Inn words and the Moon Device and, for the reasons set out below, will not form the view that the Rest Easy Apartments UKTM (or the “Rest Easy” part of it) retains an independent distinctive role in the Signs. When seeing the Signs, it will be in the context of Premier Inn either in physical adverts or online.
93. As to the interdependence principle, as it was put by easyGroup, namely that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa, given the findings above as to the low level of similarity between the mark and the Signs on the one hand and the medium level of similarity between the goods or services, she would not, in my judgment, conclude that these would offset each other. Mere association is not sufficient for confusion.
94. Rather, given the findings as to similarity above, namely that the only similarity between the mark and the Signs arises from common elements which have low distinctiveness (alone and as a combination) that tends to weigh against a finding of likelihood of confusion. Such a situation does not preclude a finding of likelihood of confusion but it is a relevant factor and in an appropriate case it may be decisive (*Nicoventures Holdings Ltd v. The London Vape Co.* [2017] EWHC 3393 (Ch) at [27]).
95. No evidence of actual confusion was adduced by easyGroup, that is to say that there was no evidence before me of any member of public (or indeed anyone) confusing Rest Easy Apartments with Premier Inn, whether as a result of the use of the Signs or at all. Given that no reliance is placed on actual use of the Rest Easy Apartments UKTM, this may not be surprising. Despite the criticisms made by easyGroup of the evidence of Ms Roe and

Mr Hughes and the fair observation that the nature of their respective roles and the data they hold and which they have analysed might be unlikely to give rise to anyone suggesting that they were confused (see the observations of Recorder Douglas Campbell in *easyGroup v. Easyway SBH* (supra) at [80] and those of Nicholas Caddick KC in *Match Group LLC v. Muzmatch Ltd.* [2022] EWHC 941 (IPEC) at [99], having referred to a number of earlier authorities on the topic), their extensive searches of the voluminous data disclosed no evidence at all of any confusion.

96. As set out above, absence of evidence of actual confusion is not necessarily fatal to a claim under s.10(2). The longer the use complained of has gone on in parallel with use of the trade mark without such evidence emerging, however, the more significant it is. In this case, there was a period of almost 4 years from the Relevant Start Date until trial during which the sign was being used by Premier Inn. If there was any actual confusion, it is likely in my judgment that some evidence of it would have become apparent in that period.
97. The thrust of the argument on behalf of easyGroup was that the most likely form of confusion was “wrong way round” confusion, that is to say that someone seeing the Rest Easy Apartments UKTM would think that services denoted by that mark come from the same undertaking as goods or services denoted by the Premier Inn Signs or an economically-linked undertaking. Mr Malynicz submitted that that person (who must be the average consumer for these purposes) would see the Premier Inn Rest Easy Device, which includes the words “Rest Easy” and think “Oh, that is a sub-brand or a spin-off of Premier Inn”, and therefore think that the sub-brand or spin-off included Rest Easy Apartments. He submitted that “obviously” the average consumer is going to think something like that, although he did not limit himself to this as being the only likelihood of confusion, it not mattering how confusion takes place.
98. In this connection, he relied on the decision of the CJEU in *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* (C-120-04) [2006] ETMR 13. In that case the relevant mark was the word “LIFE”, which was owned by Medion. Thomson marketed identical products under the name “THOMSON LIFE”. The CJEU held that the equivalent of s.10(2) was to be interpreted as meaning that where goods are identical, there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein. Accordingly, THOMSON LIFE did infringe Medion’s rights in the mark “LIFE”.
99. In that case, not only were the goods identical, but the entirety of the earlier registered mark i.e. “LIFE” was used in the composite sign “THOMSON LIFE” as opposed to just a part of it; the mark “LIFE” was of normal distinctiveness; the only addition to make up the composite mark was the company name “THOMSON”, without any other elements (such as the Moon Device in this case); even having made the assessment as to the similarity between the mark and the composite sign, it was still necessary to conclude whether in the context of the global impression, there was a likelihood of confusion.
100. Warren J in *Rousselon Frères et Cie v Horwood Homewares Ltd* [2008] EWHC 881 (Ch); [2008] R.P.C. 30 held that: “*there will be a likelihood of confusion if the earlier mark retains an **independent distinctive role** in the later composite mark*” (emphasis added). However, even in cases where part of the composite mark has an independent distinctive

role, the conclusion that there is a risk of confusion is not automatic: it is still necessary “to carry out a global assessment taking into account all relevant factors” (per Arnold J, as he then was, in *Whyte & Mackay Ltd. v. Origin Wine UK Ltd* (supra) at [19] and [21]). Mr Malynicz referred me to paragraphs [18] and [20] of that judgment, for the principles that what was established in *Medion* was not confined to the situation where the composite trade mark for which registration was 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, but that it does not apply where the average consumer would perceive the composite mark as a unit as having a different meaning, which includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name.

101. I was also referred to *Aveda Corp v. Dabur India Ltd* [2013] EWHC 589 (Ch); [2013] ETMR 33, in which Arnold J found a likelihood of confusion between “UVEDA”, which he held to have significance independently of “DABUR UVEDA”, and “AVEDA”, which word he held had a distinctive character. I have read that decision, including Arnold J’s review of six of the cases after *Medion* at [23]-[39]. I do not need to repeat his analysis, but note that at [46] he commented that a consumer will only be misled into believing that there was a connection between undertakings where she perceives the relevant part of a composite sign to have significance independently of the whole.
102. I was also referred by Mr Malynicz to the decision of Adam Johnson J in *Combe International LLC v. Dr August Wolff GmbH & Co KG Arzneimittel* [2021] EWHC 3347 (Ch); [2022] FSR 13. In that case at [280]-[288] Adam Johnson J set out the relevant principles as to how in law to treat a composite sign or mark, which had been examined in a number of authorities and which he said was now well-settled. The authorities he referred to were the cases of *Medion*, *Russelon Frères* and *Whyte & Mackay*, each of which I have addressed above. Adam Johnson J held that “VAGISAN” was likely to be confused with the earlier mark “VAGISIL” and the addition of Dr Wolff’s before “VAGISAN” did not negate that on the basis that “VAGISAN” retained its own independent, distinctive role even in the composite phrase and was very similar to the word “VAGISIL”. That conclusion was reinforced by the fact that Dr Wolff was not and never had been a well-known brand name in the UK. I note that when the case went on appeal ([2022] EWCA Civ 1562; [2023] Bus LR 532) Arnold LJ accepted that in general, the distinctive character of the composite sign is irrelevant to the assessment of likelihood of confusion, but held that the Judge’s reasoning was sound, before saying that even if Dr Wolff’s had been well known to the average consumer, “that would not necessarily have avoided the risk of confusion” (emphasis added). In my judgment that indicates that the fact that the start of the composite sign is a well-known brand name may avoid the risk of confusion if it was otherwise present, but will not necessarily do so. It must be part of the total global assessment to be undertaken.
103. In my judgment, undertaking the multifactorial assessment that has to be done, the average consumer would not think that there was a likelihood of confusion. Even with imperfect recollection, she would not understand the words “Rest Easy” appearing in the sign as being the entirety of the Rest Easy Apartments UKTM (and I note that in the examples of other hotel chains using their names for apartment rentals, they each include that in the name e.g. Apartment Marriott), but even the part of it which does appear in the sign is an idiom, of very low distinctiveness and not at all dominant. The words do not retain an independent, distinctive role within the sign, which is dominated by the words

Premier Inn (as accepted by easyGroup in its closing submissions) and the Moon Device. The words Premier Inn and the Moon Device have no counterpart in the mark and are distinctive. In my judgment, these factors point to the conclusion that the average consumer would not be likely to be confused, including into thinking that Premier Inn had taken over the Rest Easy Apartments business or that Rest Easy Apartments and Premier Inn were economically linked. Rather, even with an imperfect recollection of the Rest Easy Apartments UKTM, the average consumer looking at the Premier Inn Moon Device would see the very significant differences in the sign and not be in any way confused by them. The decision in *Medion* (supra) as applied in subsequent cases does not drive me to any other conclusion as to the likelihood of confusion. For the reasons set out above, “Rest Easy” does not have an independent, distinctive role in the sign, even if the sign is treated as a composite phrase. Premier Inn is a very well-known brand name in the UK, which would negate any likelihood of confusion. Even if “Rest Easy” does have an independent, distinctive role, it would still be necessary to carry out a global assessment taking into account all relevant factors, being those set out above, and in my judgment the same conclusion would be reached, namely that there was no likelihood of confusion on the part of the average consumer.

#### Conclusion on s.10(2) claim

104. It follows that easyGroup’s claim under s.10(2) that the Rest Easy Apartments UKTM has been infringed by Premier Inn’s use of the sign fails.

#### The s.10(3) claim

105. easyGroup’s pleaded claim in respect of the s.10(3) claim is rather more detailed. The claim here is as between the following marks and signs:

| The Registered Marks                                                                                                                                                                                                                 | Signs Complained of                                                                 | UKTM used as signs complained of                                                      |
|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------------------------|---------------------------------------------------------------------------------------|
| EASYHOTEL easyHotel<br>(a word mark series of two)<br>(“the <b>easyHotel</b> UKTM”)                                                                                                                                                  |  |  |
|  <br>(a device mark series of two)<br>(“the <b>easy</b> UKTM”) |  |  |
|                                                                                                                                                                                                                                      | REST EASY                                                                           |                                                                                       |

106. The claim under s.10(3) does not require proof of a likelihood of confusion. It is not surprising that a claim is not brought in respect of the easyHotel UKTM or the easy UKTM under s.10(2) as it is, in my judgment, inconceivable that the average consumer would confuse those marks with Premier Inn’s signs.

## The Pleadings

107. Ms Himsworth, in her opening submissions, made the point that it is important to see what easyGroup has pleaded and to exercise precision and rigour in holding easyGroup to that pleading.
108. At paragraph 8 of the Re-Re-Amended Particulars of Claim, easyGroup plead that the easyHotel UKTM and the easy UKTM have been extensively used in relation to the services for which they are registered under classes 42 and 43 respectively, such that they have each acquired and retained an enhanced distinctive character and reputation in respect of (at least) hotel, travel, hotel-related and/or travel-related services as at the date of their filing, alternatively at a later date to be determined by the Court.
109. At paragraphs 9 to 12, easyGroup sets out the basis for the claim to “*a very significant enhanced distinctiveness and reputation in relation to the easyHotel UKTM*”. At paragraph 9A, by amendment, it was pleaded that: “*the easyHotel UKTM has been used and presented to the public in addition to and/or in conjunction with, other marks in the easy Travel Family. Each of the brands in the easy Travel Family (including the easyHotel UKTM) offer, and have become known for offering, low cost travel related services*” and by an amendment to paragraph 10 the reputation pleaded is “*specifically budget hotel services*”.
110. At paragraphs 13 to 23, easyGroup defines the “**easy Mark**” as being the use of the word “easy” in white Cooper Black font used against an orange background, including use of the easy UKTM, having been used by Sir Stelios in 1994 and by easyGroup and its licensees thereafter in addition to and/or in conjunction with other marks in the easy Travel Family. The pleading sets out the basis for the claim of the easy Mark (that is the Mark including its use before the easy UKTM was registered) as having “*the benefit of an enhanced distinctiveness and a significant reputation in relation to the hotel and travel sector*”. At paragraph 15A, by amendment, it was pleaded that “*the easy UKTM has been used and presented to the public in addition to and/or in conjunction with, other marks in the easy Travel Family. Each of these brands in the easy Travel Family (including the easyHotel UKTM) offer, and have become known for offering, low-cost travel related services ... By reason of the aforementioned promotion, marketing and/or provision of services, the easy Mark has the benefit of enhanced distinctiveness and a significant reputation in relation to the hotel and travel sector in particular, which is owned by*” easyGroup. It is therefore said that at the date of filing the easy UKTM, it already benefitted from acquired and enhanced distinctiveness and a substantial reputation in the UK in respect of the easy UKTM Services. Paragraph 18 sets out particular facts and matters on which easyGroup relies, a number of which are not the use of the easy UKTM by itself but the use of the easy Mark and/or the word easy with other marks which are owned by easyGroup, such as easyHotel.com, easy.com, easyfly.co.uk, easysky.co.uk, easybooking.holiday and easyHotel.
111. Paragraphs 19 to 22 set out the provision of “low cost” airline services using the EASYJET mark, “low cost” rental and hire of vehicles under and by reference to the name and mark EASYCAR and “low cost” passenger land transport facilities, in particular airport transfers, under or by reference to the name and mark EASYBUS, all of which are said to have been part of the development of the easy Travel Family. In the case of each of these

services, it is pleaded that the easy UKTM has been deployed in relation to the promotion and advertisement of those services.

112. As to the alleged infringement this is pleaded at paragraphs 31 to 34 of the Re-Re-Amended Particulars of Claim. It is said that Premier Inn's Signs are each similar to each of the easyHotel Mark and easy Mark (which must in this context be a reference to the easyHotel UKTM and the easy UKTM). easyGroup says its marks have reputation, but that owing to the similarity, the relevant public will form a link with the use of Premier Inn's Signs, which without due cause takes unfair advantage of and/or is detrimental to the distinctive character of each of easyGroup's marks. Particulars of the link are pleaded at paragraph 32. These include an assertion that owing to the reputation in the easyHotel UKTM and easy UKTM, "EASY" even when used with other words or symbols, will retain independent distinctive character. It is therefore said that use by Premier Inn of its Signs, whether alone or as part of a composite mark, is likely to lead a substantial number of members of the public in the UK to call to mind easyGroup's marks.
113. The particulars of unfair advantage are set out in paragraph 33 of the Re-Re-Amended Particulars of Claim. First, it is said that Premier Inn benefits from the association of the strong reputation and values attaching to the easyHotel UKTM and the easy UKTM and *"rides on the coat-tails of that reputation, in particular in respect of quality low-cost services"*. Secondly, that Premier Inn must have known that the use of "easy" as part of its Signs for identical services would cause the link in the mind of the public, that many of its prospective customers would be considering whether to purchase their services or the services of easyHotel, so that it must be assumed that Premier Inn intended to benefit from that link. Further or alternatively, it is said that bearing in mind the reputation in each of the easyHotel UKTM and the easy UKTM, it was inconceivable that prominent branding use of a sign including "easy" by Premier Inn would not risk a conflict between the sign and the marks and that at the very least Premier Inn must have made a deliberate decision to live dangerously, being reckless or ambivalent as to taking advantage of the easyHotel UKTM and the easy UKTM. (In passing, it was not suggested in submissions that "being ambivalent" meant something different from "being reckless" and therefore I will use the word "reckless" hereafter to cover both.). There is then reference to the letter of 22 February 2023 from easyGroup's solicitors and the objections to use of the words "REST EASY" by Premier Inn, such that Premier Inn has chosen to continue to use the signs even once they were well aware of the reputation of the easyHotel UKTM and the easy UKTM so as to exploit the reputations.
114. As to the particulars of detriment to distinctive character, these are pleaded in paragraph 34. The complaint is that use by Premier Inn of its Signs risks damaging the distinctive character and/or the reputation of the easyHotel UKTM and the easy UKTM by indicating to the public that the word "easy" whether alone or joined to one or more other words when used in the hotel sector is generic rather than indicating easyGroup or its licensees. It goes on to say that the use threatens easyGroup's extant licensing agreement in respect of the easyHotel UKTM and risks damaging the distinctiveness and licensing capacity of each of the easyHotel UKTM and the easy UKTM, both in general and in relation to hotel, travel, hotel-related and travel-related services, *"in particular thereby creating a real likelihood of change in economic behaviour"*. Finally, it is pleaded that the use also risks damaging the other functions of the word "easy", including the investment function and the advertising function of each of the easyHotel UKTM and the easy UKTM in respect of hotel services, again *"creating a real likelihood of change in economic behaviour"*.

115. The Re-Re-Amended Defence at paragraph 8 admits that at the relevant times easyGroup has had reputation in “EASYHOTEL” and “easyHotel” for providing hotel accommodation, but otherwise paragraph 8 of the Re-Re-Amended Particulars of Claim is not admitted. At paragraph 9, in response to the claims of reputation and enhanced distinctiveness, it is admitted that easyHotel had reputation from the beginning of 2021, but not admitted that the easyHotel UKTM had enhanced distinctive character.
116. As to the pleading of the easy Travel Family, its relevance is said not to be understood, but it is averred that in so far as there could be any legal impact, it could only be through the family of marks doctrine, which easyGroup had expressly disavowed.
117. As to the easy UKTM, it is denied that the easy Mark (i.e. the pre-registration mark) is a property right which can acquire enhanced distinctiveness, reputation and/or any other trade mark rights. It is also denied that easyGroup has any rights in the word “easy” *solus*, it being pleaded that the word is a common descriptive word which denotes a quality or characteristic of goods and/or services, including the services for which the easyHotel UKTM and easy UKTM had been registered. It is also expressly denied that easyGroup has acquired enhanced distinctiveness and/or a reputation in the easy UKTM by reason of the alleged use of the mark “easyHotel” or any other mark in the easy Travel Family.
118. Admissions are made as to the use of easyJet UK2016785 (the “**easyJet UKTM**”) and easyCar UK910735553, but the relevance of these and/or easyBus UK2112956 is said not to be understood. At paragraph 17, it is said that easyGroup is “*required to prove (1) that the easy UKTM has been used and/or licenced for use with respect of the easy UKTM Services, and (2) whether as a result of such use that the easy UKTM has acquired and retained an enhanced reputation in the UK for the easy UKTM Services*”.
119. As to the pleading of infringement, Premier Inn denies that there is any distinctive similarity between the Premier Inn Rest Easy Device and words “rest easy” or any of them and the easyHotel UKTM and/or the easy UKTM, alternatively any similarity is very low. It is said that “easy” is a common descriptive word which also denotes a quality or characteristic of goods and services, including hotel, hotel-related, travel and travel-related services, which has no or alternatively very low distinctiveness. The pleaded case is that the distinctive character of the mark in respect of the easyHotel UKTM lies in the fact it is a single composite word and “easyHotel” includes the grammatically incorrect and distinctive capitalisation of the letter H. It is visually, conceptually and aurally distinct from, and dissimilar to, the ordinary English phrase “rest easy” and/or the Premier Inn Rest Easy Device.
120. As to the easy UKTM, the distinctive character of that in respect of the easy UKTM Services resides in the distinctive Cooper Black font and the orange (Pantone ref 021C) and white colours. It too is said to be visually, conceptually and aurally distinct from, and dissimilar to, the ordinary English phrase “rest easy” and/or the Premier Inn Rest Easy Device.
121. The particulars of link are denied, save that it is admitted that Premier Inn’s services are identical to the easyHotel UKTM Services of providing hotel accommodation and the easy UKTM Services of provision of holiday accommodation and hotel services. It is

expressly denied that “easy” when used on its own or with other words or symbols retains independent distinctive character in the hotel sector.

122. Premier Inn denies that the use of the Premier Inn Rest Easy Device and/or “rest easy” in any way takes advantage of or benefits from any distinctive character, repute or attraction of the easyHotel UKTM and/or easy UKTM. It is admitted that Premier Inn intends to continue the use of its Signs and averred that Premier Inn has sought throughout its advertising, marketing and promotion, including by use of the Premier Inn Rest Easy Device to differentiate its offering from any other hotel chain.

123. Against this somewhat lengthy review of the pleadings, I turn to the conditions in dispute between the parties in respect of the s.10(3) claim. But it is important to note that in their closing submissions, easyGroup:

(a) accepts that there is no action against the use of normal words unless they are used to denote origin, namely as part of branding; and

(b) disavowed any attempt to assert a monopoly over the word “easy” alone and it is not asserted over any descriptive use of “easy”. Rather the only claim based on the easy UKTM (not the word “easy” on its own but in stylized and coloured form) falls under section 10(3), and again, not against the use by Premier Inn of “easy” on its own, but against “REST EASY”, with or without Premier Inn’s branding. It is said that blanket indiscriminate protection that would amount to a monopoly over “easy” cannot be delivered. Accordingly, it is submitted, that if the court was to find infringement under s. 10(3) it would mean only that the court considered that Premier Inn’s use of REST EASY which is being used to promote not only similar services but also competing in the same budget/value sector is too close. It would not follow, so easyGroup say, that another trader’s use of “easy” also in the hotel sector would necessarily infringe.

124. As against this, reliance is placed on the evidence of Mr Jacob that no one else in the hotel market uses the word “easy” and that easyGroup businesses are (and should therefore continue to be) the only ones to use “easy” in branded use for budget hotel services (in at least paragraphs 19, 57 and 152 of its closing submissions). At times, it certainly seemed to me that in its submissions, easyGroup was trying to claim exclusive rights to “easy” solus within the hotel market, while asserting it was not seeking to do so.

#### Condition (i) - reputation

125. Reputation and distinctive character are not the same. Reputation needs to be established and distinctive character, being the ability of a mark to distinguish itself from other signs and to operate as a badge of origin, is a factor to take into account if a party seeks to rely on it, as easyGroup did in this case. In those circumstances, Premier Inn put easyGroup to proof of enhanced distinctiveness.

126. The reputation of each of the easyHotel UKTM and the easy UKTM must be considered separately. In doing so, the assessment the Court has to make is as of the Relevant Start Date as regards the goods or services for which that mark was registered. It is not a particularly onerous requirement (although far from trivial - *TVIS Ltd. v. Howserv Services Ltd* (supra) at [46]), but it must be established by evidence. Reputation means knowledge of the goods and services, not their repute amongst those who do know them. The degree

of knowledge required must be considered to be reached when the earlier mark is known by a sufficient part of the public concerned by the goods or services covered by that trade mark (see *Sazerac Brands LLC v Liverpool Gin Distillery Ltd* (supra)).

127. As to the easyHotel UKTM, Premier Inn has admitted that easyGroup has a reputation for providing hotel accommodation. It has not admitted (and therefore easyGroup is required to prove) it has a reputation for the other services it is registered for, namely *“Temporary accommodation; reservation services for hotel accommodation; computerised hotel reservation services”*.
128. As to the easy UKTM, Premier Inn has not admitted (and therefore easyGroup is required to prove) it has a reputation for any of the services it is registered for, namely *“temporary accommodation; provision of holiday accommodation; hotel services; hotel reservation services”*.
129. On behalf of easyGroup, Mr Malynicz submitted that both the easyHotel UKTM and the easy UKTM had a reputation which conveys *“no frills, low cost and quality services in travel, specifically hotels”*. As “travel” is not one of the services for which these marks are registered, I am unable to see the relevance to this case of any reputation in “travel” generally. The reputation which has to be established is as to those matters identified in paragraph 2(a) and 2(b) of this Judgment. If, for example, the average consumer would understand that the easy UKTM has a reputation in travel, but not in hotels, that does not assist easyGroup in the s.10(3) claim.
130. Turning to the evidence adduced as to reputation of the easyHotel UKTM, Mr Moffat on behalf of easyGroup has provided detail of easyHotel’s UK turnover for 2016 to 2021, demonstrating turnover increasing from just over £5 million to a peak of £12.7 million in 2019 before falling back to £9 million in 2020 and 2021 (no doubt affected by the COVID pandemic). There is no breakdown of these figures as between hotel accommodation and the other services for which the easyHotel UKTM is registered.
131. In easyGroup’s narrative document produced for trial, substantial quotations are set out from easyHotel’s annual reports explaining how easyHotel believed it was performing. By October 2021 (the closest reporting date to the Relevant Start Date) there were 18 UK hotels. easyHotel had been advertising online and by way of physical adverts for a number of years prior to the Relevant Start Date, examples of which are set out in the narrative document. In 2020, easyHotel introduced a campaign with the strapline “Stay easy, stay safe”. Mr Moffat gave evidence as to the marketing spend by easyHotel for 2019 through to October 2024 (the latter expenditure potentially being relevant to condition (viii) which I will address below), as well as to the use of the easyHotel app, which has been downloaded approximately 170,000 times between 2020 and 2024. There was also extensive reference to internal documents, business records and presentations. As these are not directed at the public, they are of limited significance. In almost all of the public facing uses of the easyHotel UKTM, it was used in the form dictated by the brand guidelines, namely in Cooper Black font with white writing on an orange (Pantone 021c or as close as possible) background. Both Mr Richardson and Mr Moffatt confirmed that this was the form in which the mark had to be used. Mr Richardson gave evidence that as far as he was aware easyHotel always complies with the guidelines, save in circumstances where it is not possible, for example due to planning requirements which applied to 5 of easyHotel’s hotels (in Mr Moffatt’s witness statement he had said 4, but it was shown there were 5), in which

case the colour scheme adopted was black lettering on a white background, but still in the Cooper Black font.

132. In my judgment, the evidence taken as a whole establishes reputation of easyHotel for the provision of hotel accommodation. As hotel accommodation is temporary accommodation, as I have set out above, this reputation extends to that service. But no sufficient evidence has been put before me as to the other services for which the easyHotel UKTM is registered, namely “*reservation services for hotel accommodation; computerised hotel reservation services*” to establish that the easyHotel UKTM has a reputation for those.
133. As to enhanced distinctiveness, the starting point is the inherent distinctiveness of the easyHotel UKTM. Given it has been registered and its validity not challenged, it has some measure of distinctiveness (see paragraph 35 above). It is a word sign, but in itself, in my judgment, the average consumer would find it to have a low level of distinctiveness. Given my finding that easyHotel has a reputation in respect of hotel accommodation and temporary accommodation, it follows that it had acquired at least some additional distinctive character over and above its low level of inherent distinctive character and to that extent had an enhanced distinctive character (*TVIS Ltd. v. Howserv Services Ltd* (supra) at [46]). But the enhanced distinctiveness arises out of use and the use has almost exclusively been in the white script on the orange background. It is therefore in this form that the enhanced distinctiveness has been established. In my judgment, the average consumer would overall think the easyHotel UKTM had a moderate level of distinctive character at the Relevant Start Date.
134. As to the easy UKTM, it is important to keep in mind that the UKTM is not easy.com, but “easy”. It is a figurative mark as opposed to a word mark. Having been registered and its validity not challenged, the easy UKTM has some measure of distinctiveness (see paragraph 35 above). I accept Ms Himsworth’s submission that as the word part of the mark is the ordinary English word “easy”, the inherent distinctiveness which the easy UKTM has must be derived from the non-word elements, namely the text stylisation, device and/or colour and not from the word “easy”. I have had regard to the other easyGroup cases referred to by Premier Inn in their closing submissions where the Courts have had to consider the word “easy” *solus* and the findings in those cases as to the lack of any distinctiveness in the word “easy”. For example, in *easyGroup Ltd. v. Beauty Perfectionists Ltd.* [2024] EWHC 1441 (Ch); [2024] ETMR 36, Bacon J held that the “easy” element of the “easyJet” word mark had no inherent distinctive character, but that it was a descriptive word, indicating that the services are easy to use. I am not bound by those decisions but, forming my view independently of the earlier findings, I come to the conclusion that “easy” has no inherent distinctiveness.
135. As to reputation and enhanced distinctiveness, easyGroup relies on the evidence set out in paragraphs 8 and 9 of its narrative document and in the lengthy table which follows, as well as the survey evidence. It submits, in particular, that the easy UKTM has been used as part of the stylised use of the EASYHOTEL and EASYJET marks, as pleaded in paragraph 15A of the Re-Re-Amended Particulars of Claim and paragraphs 5A(i) and 5C of the Amended Reply and Defence to Counterclaim. I agree with Premier Inn’s submission that easyGroup therefore appears to rely on 3 categories of use: (1) the use of the easy UKTM *solus*; (2) use of easy UKTM as part of either easyHotel or easyJet; and (3) use in addition to and/or in conjunction with easyJet, easyCar, easyBus and easyHotel.

136. As to use of the easy UKTM *solus*, the witness evidence adduced by easyGroup did not address this in any detail. Rather the evidence on that is what is in easyGroup's narrative document. It is not accepted by Premier Inn that all of the documents referred to in this were subject to easyGroup's Civil Evidence Act Notice, but accepts that they are all admissible, just of limited probative value for the Court's assessment.
137. The first category of evidence relied on is the number of views of the easy.com online portal. In my judgment, that is of no assistance to easyGroup (or the Court) as it is not evidence of use of the easy UKTM, let alone in connection with the services for which it is registered. It is merely evidence of use of that different portal for access to all other brands within the easyGroup.
138. The second category is newspaper articles over the period 2000 to 2016. These substantially pre-date the Relevant Start Date and do not, as far as is set out in the narrative document, actually use the easy UKTM, but some of them use the word "easy" or the "easy brand". They are not use of the easy UKTM at all and certainly not in respect of the services for which the easy UKTM is registered.
139. The third category is website screenshots from 2004 until 2024. Those which post-date the Relevant Start Date are not relevant save in so far as they show reputation or enhanced distinctiveness as at the Relevant Start Date. In my judgment they do not do so. A number are screenshots of the easy.com website. Promotion of other easy companies, including easyHotel, on the easy.com website is not use of the easy UKTM *solus* for any service, let alone those it is registered for. Likewise, the evidence from Mr Richardson that the  device was meant to be a computer key on a keyboard and was used on the easyHotel.com website from June 2005 is not evidence of any use of the easy UKTM on that date or at any time subsequent before the Relevant Start Date. There is reference in the website screenshots to "the easy® family" or "the easy® family of brands" on other "easy" websites in 2018 and 2019 (and after the Relevant Start Date), but that does not amount to use of the easy UKTM for the services offered by those other "easy" companies, rather it is stating that those other "easy" companies, such as easyHotel, are part of the easy family.
140. The next category relied on in easyGroup's narrative document is "Social Media", it being said that the easy Travel Family is marketed on easyGroup's social media. The screenshots from the social media provided (which appear to be LinkedIn posts) do include the easy UKTM next to "easyGroup" and (in most cases in very small script so that it is barely legible) the words "part of the easy® family of brands", in each case promoting one of the "easy" businesses, easyHotel, easyJet, easyCar, easyBus, easyCleaning, easyFood etc. That does not, in my judgment, amount to use of the easy UKTM for the services for which it is registered. Within this category, I was directed to one response from easyHotel to a Tripadvisor comment where the response commenced "Dear easy customer", but that was not use of the easy UKTM, just the word "easy". It was further pointed out that the easyHistory is made available in easyHotel rooms and reception. That includes on its front page and first inside page the wording "The easy® family of brands photo album". However, in my judgment merely making available a photo album or the whole easyHistory to a customer staying at an easyHotel, who may or may not chose to read it (and there is no evidence of customers having read it) is not evidence of use of the easy UKTM for "*temporary accommodation; provision of holiday accommodation; hotel services; hotel reservation services*".

141. Next, easyGroup relies on a “marketing” category of uses. The examples are from 2004 to 2024. As to those which pre-date the Relevant Start Date, some are directed at investors or franchise applicants as opposed to members of the public and only one of which seems to use the easy UKTM *solus*, some refer to easy.com which is not relevant for the reasons set out above and some refer to the “easy® portal” with an immediate reference to easy.com, which is not use of the easy UKTM for the services the subject of this action. There are examples which refer to easyHotel, saying “from Stelios, the founder of easyJet” or “NEW from Stelios and ”, without any use of the easy UKTM *solus*. There are some examples of advertisements from the easyJet Traveller in-flight magazine promoting easyHotel, which have an orange background and do use the word “easy” alone in what may be Cooper Black font. However, this looks very much like advertising copy and not use of the easy UKTM as such. In my judgment, nothing in this category demonstrates use of the easy UKTM for the services the subject of this action.
142. easyGroup also relies on the admission of “easy” to the Museum of Brands in May 2017, which was promoted in easyJet Traveller. While there is reference in the easyJet Traveller extract to “the easy brand” and “the easy ® family of brands”, this does not show the easy UKTM *solus* being used for the services the subject of this action.
143. The reliance on key rings, pens and pads of paper referring to “the easy ® family of brands”, is not evidence of the easy UKTM *solus* being used for the services the subject of this action. None of those are “*temporary accommodation; provision of holiday accommodation; hotel services; hotel reservation services*”.
144. Finally, from easyGroup’s narrative document in this respect, reliance is sought to be placed on documents from 2005 setting out easyGroup’s brand values. I do not follow how this is said to be use of the easy UKTM *solus* (which is not used), let alone in respect of hotel services etc.
145. The other evidence which might go towards establishing the reputation and enhanced distinctiveness of the easy UKTM *solus* is the survey evidence. I have set out at paragraphs 19 and 21 above the circumstances in which and the basis on which I was just satisfied enough to give permission to easyGroup to rely on the survey evidence. Paragraph 46.4 of the third witness statement of Mr Jacob dated 14 January 2025, which is expressly referred to in the recital to the Order of 21 January 2025, stated that easyGroup “*relies upon the surveys simply to demonstrate the reputation and enhanced distinctiveness of the easy UKTM*”. It was only for that purpose that permission was granted and therefore it is only in that context that it falls to be considered.
146. The surveys were undertaken under the project management of Graham Williams, a research director, at Dynata, who has been involved over the years in the process of considering evidence in relation to surveys in a number of trademark disputes, although it appears not in respect of any case in the last 12 or so years. He provided evidence in his second and third statements (the first had been used on the application for permission). He was responsible for ensuring that the surveys took place in accordance with the Whitford guidelines (taken from the case of *Imperial Group plc v Philip Morris Ltd* [1984] RPC 293) and there is no suggestion that he failed in this respect. He set out in his second witness statement how the surveys were conducted, being online surveys, the potential issues with

using online surveys, and the steps used by Dynata to try to address such issues. He also set out the steps taken to exclude the answers from respondents who did not satisfy the screening criteria and respondents who were deemed, by him, to have given unsuitable or suspicious answers.

147. Dynata undertook 2 surveys, each done in 2 waves, with Mr Williams setting out the questions used in each. In survey 1, the interviewees were shown the easy UKTM and asked, "Have you seen this before in relation to hotels?" and if they answered yes, they were then asked "Where have you seen it before? Please write what you can." Whether they answered "yes" or "no" to the first question, they were asked "Is there anything else you can tell us about this in relation to hotels?" They were then asked if they had booked a budget hotel in the last 10 years and whether they would consider booking a budget hotel in the near future, before being asked some exclusionary questions and details about themselves.
148. In survey 2, the interviewees were again shown the easy UKTM but this time were asked: "What, if anything, can you tell us about what you are looking at? Please write in what you can." They were then asked "Is there anything else you can tell us about what you are looking at? Please write in what you can." Again, they were then asked if they had booked a budget hotel in the last 10 years and whether they would consider booking a budget hotel in the near future, before being asked some exclusionary questions and details about themselves.
149. Mr Williams exhibited the verbatim answers in three documents, the first for the non-excluded respondents for survey 1, the second for the non-excluded respondents for survey 2, and the third for the excluded respondents from surveys 1 and 2, explaining whose responses had been excluded and why. I have read through the results for both waves of surveys 1 and 2 in exhibits GW11 and GW12, which are the first two of these three documents, but cannot set them out in detail here. It is fair to say that in both exhibits there are references to easyHotel and to hotels, but the most common responses are references to easyJet and airlines, albeit some of them include package holidays. There are references to "cheap" and "low budget" hotels as well as "no frills" in addition to "cheap", "cheap prices", "budget" and similar with reference to flights in particular, but also car rental and cruises. There is no doubt that the responses to survey 2, where there was no reference to hotels in the questions, elicited fewer comments about hotels.
150. In his statement, at paragraph 9 Mr Williams addressed the coding of the responses, producing an exhibit GW14 which set out an analysis that easyGroup's solicitors wanted of answers that made it clear that the respondent knew the image related to a specific brand or company. In fact, Mr Williams had not undertaken this coding but rather it had been undertaken by Mr Jacob of easyGroup's solicitors. Mr Williams had not made this clear in his second statement, but did so in his third statement saying that he had reviewed GW14 and was satisfied they were selected sensibly. Based on that coding, various percentages were set out in his analysis.
151. Premier Inn called evidence from Sara Bennison, a witness with extensive experience and expertise in the world of brand management and marketing, who has worked for over 35 years in global advertising agencies, major companies and as a consultant. She made it clear in her statement that she was neither a lawyer nor a trade mark expert. She was therefore interpreting the data as a brand and marketing expert. She identified a very small

number of responses which she would have excluded in addition to those excluded by Mr Williams. She referred to the Market Research Guidelines for Questionnaire Design and pointed out some deviations by Mr Williams from those guidelines, saying it was unclear why Mr Williams had tolerated those deviations. Another of her criticisms was that quantitative surveys, such as this one was intended to be, use questions with “closed” answers, that is they use closed questions. She did not set out in her statement what appropriate closed questions would have been for the survey.

152. Ms Bennison went on to make various criticisms as to alleged flaws in the surveys themselves. These were adopted by Premier Inn in their closing submissions. The right to make such criticisms was expressly reserved in the recitals to the order of 21 January 2025, in accordance with the practice set out in *Enterprise Holdings, Inc v Europcar Group UK and Another* [2015] EWHC 17. The survey questions in this case were said to be based on the questions in that case. Ms Bennison pointed to differences between the surveys in this case and those in the *Enterprise* case. The differences identified included that in that case it was an on street survey conducted by interviewers in person, whereas in this case the survey was done online with respondents familiar with surveys and likely expecting an incentive for having taken part. Additionally, complaint is made that in the *Enterprise* case, the interviewees were only shown the relevant image for 5 seconds before being asked questions, whereas in this case the easy UKTM was shown for an initial period of 15 seconds and remained on screen throughout the survey. This compared with a typical estimate of “dwell time”, being the time that consumers spend looking at an advert online of between 4-6 seconds and possibly as low as 2 seconds. Ms Bennison also pointed out some further differences between the *Enterprise* surveys and the surveys in this case. Overall, she said that there were material differences which meant that a direct comparison between the 2 sets of surveys could not be made reliably.
153. As to interpretation, she explained her methodology in undertaking her own coding exercise. She went through every answer given and set out her analysis, including separating out the answers where the first mention of easyHotel specifically or hotels generally in survey 2 (where the interviewees were not prompted that it was to do with hotels) was in response to the second question i.e. those who failed to mention either until effectively asked the question a second time. She also counted the number of times across questions 1 and 2 in survey 2 that easyHotel and/or hotels were mentioned where the interviewee made **no** mention of easyJet and/or airlines and found that it was only on 11 occasions (or less than 1%) of interviews where this occurred. She concluded that therefore virtually no one made the connection between the sign they were shown and easyHotel/hotels without the connection being made through the familiarity with easyJet.
154. As to survey 1, where the interviewees were asked if they had seen the sign in connection with hotels, in light of the very low spontaneous mentions of hotels in response to the open question in survey 2, Ms Bennison noted that although the question was about hotels, almost half of the respondents who answered question 1 “yes” mentioned an airline. She says that reinforces her conclusion made in respect of survey 2 that any limited connection that respondents made to hotels was largely through the lens of easyJet and its association with travel. At paragraph 9.2 of her statement, Ms Bennison noted that out of the total sample of 1,091 responses to survey 1, there were 136 mentions of easyHotel which equates to 12.5% of the total sample. She concluded that the results of survey 1 meant very little.

155. Overall Ms Bennison concluded that there was no reliable evidence from survey 2 to support the notion that the visual i.e. the easy UKTM triggers direct spontaneous links of any scale with hotels. She stated her: *“clear opinion based on the evidence that it is easyJet which dominates responses both directly, in terms of specific mentions, and even when the question is framed as being around hotels. By comparison, mentions of easyHotel specifically or hotels generally which are triggered by showing the Visual are objectively small at a spontaneous level and also rarely exist in isolation from easyJet. I cannot therefore find any evidence in these surveys to support the notion that the Visual triggers reliable links of any scale with hotels in the minds of consumers whose perceptions and associations are evidently shaped by their familiarity with easyJet, particularly its orange colour.”*
156. I asked the parties to collate the coding analyses of the two experts which they have done and which is included at Appendix 1 to this judgment.
157. I was invited by Ms Himsworth to disregard in its entirety exhibit GW14 which is the coding exercise undertaken on behalf of easyGroup, but not by Mr Williams, rather by easyGroup’s solicitor, Mr Jacob. This is because the material, as opposed to the coding of that material, was included in exhibit GW11 and GW12. The permission that was given was for the surveys to be carried out by an expert, Mr Williams on the basis that it would provide the Court with evidence similar to that provided in the *Enterprise* case (supra). That included an analysis of the results of the survey being provided to the Court by the expert. I did not understand, when granting permission, that the coding which had already been done at the time of the application for permission had been done by easyGroup’s solicitor nor that it was intended to be done by him in respect of the second wave of the survey which had been done but not reported on. Accordingly, I have not been provided by coding undertaken by an expert, but someone who is partisan in terms of being a solicitor retained by a party to the litigation and who owes his duties to his client and not to the Court under Part 35 of the CPR. The coding of results is a subjective exercise and it therefore may be said that it is not really an exercise which needs to be done by an expert. The results could be presented in their native form and counsel could make submissions as to what they show. However, if that had been intended that should have been made clear when permission was being sought and in those circumstances it may well have been that permission would not have been granted. It would have led to a longer trial as it is difficult to conceive how counsel could have made such submissions within the time allowed for the trial given the length of the other submissions.
158. I therefore agree with Ms Himsworth that the coding analysis which appears in exhibit GW14 should be excluded. I accept the coding results set out in the evidence of Ms Bennison, which have been undertaken by an expert, who I am satisfied gave independent evidence cognisant of her duties to the Court. I am not convinced that it matters to any great extent because the coding results from Ms Bennison in terms of percentages were not a million miles away from those in GW14, albeit in my judgment they were conducted with greater scrutiny.
159. I do not think there is much substance in some of the criticisms made by Ms Bennison and adopted in Premier Inn’s closing submissions, in particular those as to the deviations from the Market Research Guidelines for Questionnaire Design, the asking of open questions as opposed to closed questions, the conducting of the interview online with respondents familiar with surveys and likely to be expecting an incentive for having taken

part, and the length of time for which the interviewee saw the easy UKTM. While these may be valid criticisms of a survey conducted out of the sphere of litigation, had Mr Williams conducted the survey in the way Ms Bennison suggested, he would have fallen foul of the Whitford guidelines and no doubt, his report would have been criticised for that. I am satisfied that the surveys do comply with the Whitford guidelines.

160. However, that does not mean that the results of the surveys tell me very much of relevance to the issues that I have to decide. While Ms Bennison’s coding identifies in statistical terms what percentage of interviewees mentioned easyJet and easyHotel, and made generic references to airlines, this is (as she says) a very superficial way of reviewing the answers. Even on this basis, in survey 2, which did not have the prompt about hotels, it is noticeable that only 9.2% in total mentioned easyHotel and hotels more generally. But fewer than 1% did so without mentioning easyJet or airlines. These percentages are, in my judgment, too low to establish that the easy UKTM has a reputation or enhanced distinctiveness, as are those from survey 1 set out above.
161. But even if they might be thought to be sufficient as bare percentages, I accept the evidence of Ms Bennison that the answers when properly analysed do not support the notion that the easy UKTM triggers reliable links of any scale with hotels in the minds of consumers. What was triggered was reference principally to easyJet. Essentially, the results of the surveys do not provide me with answers as to the reputation and any enhanced distinctiveness of the easy UKTM in connection with the registered services the subject of this case. This is not to be seen as a criticism of Mr Williams for the design of the survey, but rather a realistic assessment of the difficulty of designing a survey which both complies with the Whitford guidelines and provides meaningful answers.
162. Although I expressed the view when granting permission that the evidence before me then did just satisfy me that the survey evidence was likely to be of real value, that has not turned out to be the case. This demonstrates the difficulties with permitting survey evidence in a case like this to establish distinctiveness.
163. It follows that I do not find the survey evidence to support the submission that there has been any use of, and therefore reputation in and enhanced distinctiveness of, the easy UKTM *solus* in respect of the services which are the subject of this claim.
164. The second way in which easyGroup says that the easy UKTM has a reputation and enhanced distinctiveness is by use of easy UKTM as part of either easyHotel or easyJet. The easyHotel UKTM is a word mark, not a mark in the stylised form and the same is true of the easyJet UKTM. Therefore, the marks cover the uses of easyHotel and easyJet in any stylised form.
165. Mr Malynicz argued that each of easyJet and easyHotel had reputation and enhanced distinctiveness in the services relevant to this claim for which the easy UKTM is registered. He submitted that as a matter of fact easyHotel and easyJet have been used in the same stylised form as the easy UKTM. There is substantial evidence that easyHotel and easyJet have been used in Cooper Black font on the orange background with white writing. He relied on the CJEU case of *Société des Produits Nestlé SA v. Mars UK, case C-353/03*, in which Nestlé, having registered the slogan “Have a break ... Have a Kit Kat” and the name “KIT KAT”, applied for registration in the UK of the words “HAVE A BREAK” as a mark in the same class. Mars objected. The Court of Appeal referred to the CJEU the question

whether the distinctive character of a mark (which is necessary for registration) can be acquired following or in consequence of the use of that mark as part of or in conjunction with another mark. The CJEU held that the expression “use of the mark as a trade mark” must be understood as referring solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the product or service as originating from a given undertaking. Yet, such identification, and thus acquisition of distinctive character, may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service, designated exclusively by the mark applied for, as originating from a given undertaking. The CJEU made it clear that this is one part of the global assessment which has to be undertaken. Accordingly, the CJEU’s answer to the question was that “*the distinctive character of a mark [which is necessary for registration] may be acquired in consequence of the use of mark as part of or in conjunction with a registered trade mark*”. In that case, the mark applied for “HAVE A BREAK” was part of the mark registered in the same category for the same products.

166. Mr Malynicz submitted that when people see the expression “Have a break” they fill in the rest i.e. the “have a Kit Kat”. He says that is what people are doing when they see the easy UKTM, namely they are adding in the rest i.e. Jet to make easyJet, which he says is demonstrated by the results of the survey. Therefore, he says it follows that the easy UKTM has the necessary enhanced distinctiveness.
167. In the Court of Appeal in *Société des Produits Nestlé SA v Cadbury UK Ltd* [2017] EWCA Civ 358; [2017] Bus LR 1832 Kitchin LJ (with whom Sir Geoffrey Vos C and Floyd LJ agreed) said at [52] that “*the mark must have come to identify the relevant goods as originating from a particular undertaking and so to distinguish those goods from those of other undertakings*”. He went on to say at [77] that “*the CJEU has held that it is not sufficient for the applicant to show that a significant proportion of the relevant class of persons recognise and associate the mark with the applicant’s goods*”. He also said at [98] that it was “*clear from the decision of the CJEU*” that “*it is not necessary to show that the public have relied upon the trade mark*”. He went on to consider the *Nestlé v. Mars* case, saying at [83] that “*in such a case and were the mark to be used alone, consumers would not only perceive the goods or services designated by the mark as originating from a particular undertaking but would also rely upon it for that purpose in making or confirming their transactional decisions*”. He therefore agreed with the judge that it was legitimate to consider whether the relevant class of persons would rely upon the sign as denoting the origin of the goods or services if it was used on its own.
168. Mr Malynicz also seeks to derive support for his proposition in relation to an easyGroup case, *W3 v. easyGroup Ltd*. [2018] EWHC 7 (Ch); [2018] ETMR 40. For the purposes of this part of his submissions, it is to be noted that the trade mark that Arnold J (as he then was) was considering was the word mark EASY, not the easy UKTM in stylised form which is the mark in this case. Arnold J held that the word EASY denoted a quality or characteristic of the services and therefore was invalid unless the trade mark had acquired a distinctive character through use. The judge recorded at [174] easyGroup’s contention that EASY had acquired a distinctive character in two ways: first as a result of the use of EASY as part of easyGroup’s other trade marks, and in particular EASYJET and EASY.COM; and second, as a result of the use of EASY on its own. At [176] he considered the use of EASY as part of easyGroup’s other trade marks, holding that there could be no

doubt that there had been extensive use of “easy-” prefixed trade marks by easyGroup and its licensees. The responsive submission was that there had been no significant use of such trade marks in relation to the relevant services. Arnold J, however, held (in respect of an earlier date than the Relevant Start Date in this case) at [180]-[181] that easyGroup had demonstrated use of a number of its trade marks in relation to both “advertising” and “temporary accommodation” and in the case of easyJet the scale of use had been substantial, particularly in relation to temporary accommodation. He also held that there had been substantial use of easyHotel in relation to temporary accommodation. However, he rejected easyGroup’s submission that the similarities in form in which easyGroup’s trade marks had been used had contributed to the acquisition of distinctive character by the EASY trade mark, on the basis that the easyGroup brand licences and brand manual ensured that licensees used their marks in the stylised form of Cooper Black font printed in white on orange. He said: *“I have no difficulty in accepting that a significant proportion of consumers of both advertising and temporary accommodation in the UK had come, by October 2017, to perceive signs having these characteristics as being imbued with trade mark character even if the second word was descriptive of the service being provided (as in easyHotel). It does not follow that such consumers would have the same reaction to the word EASY on its own and regardless of font and colour”*. He went on to hold that the use of EASY on its own did not evidence that it was capable of having distinctive character. He therefore held that easyGroup had not established that EASY as a word mark had acquired a distinctive character in relation to advertising or temporary accommodation.

169. Mr Malynicz says that despite the Judge finding against easyGroup on the facts, he did not hold that as a matter of principle it was not open to easyGroup to argue that EASY had acquired a distinctive character as a result of it being used as part of the easyJet and easyHotel marks. Quite the contrary, he submits that Arnold J clearly accepted it was open to easyGroup to establish enhanced distinctiveness in this way. It was merely because it was a word mark and not the stylised mark that the claim failed. In my judgment, this analysis is correct. It is no doubt not a coincidence that it was only following that judgment that easyGroup registered the easy UKTM i.e. the stylised form.
170. Although Premier Inn in its closing submissions drew attention to the way in which the pleading of the issue had changed over time, and has argued that on the evidence in this case easyGroup’s claim in this respect does not succeed, Ms Himsworth did not seek to say that Arnold J was wrong to have undertaken the analysis he did in the *W3* case as set out above.
171. I therefore accept Mr Malynicz’s submission that it is possible for the easy UKTM to have acquired distinctiveness if it has been used as part of easyJet or easyHotel for the services for which it has been registered. Whether or not it has been used as alleged and even if it has whether it has acquired distinctiveness depend on the evidence in the case.
172. Premier Inn relied in their written closing submissions on the requirements in the easyGroup brand manual that there must be an exclusion zone or ‘safe space’ around the business logos when used, including the easy UKTM, and that each business logo was differentiated by a different descriptive word or words after the word easy without a space between them. Therefore, any use with a space between easy and Jet would be contrary to easyGroup’s own guidance for use of the business logo easyJet, as confirmed by Mr Richardson in his evidence. And the absence of any space demonstrates that the easy UKTM is not being used in the easyJet or easyHotel stylisation.

173. Mr Malynicz responded to this latter point to say that it is a completely fanciful argument, which cannot be right in light of the facts of the *Specsavers* case, where the logo which was registered as a mark had text superimposed, but that this did not stop it being use of the logo. Further, he submits that when it comes to acquired distinctiveness, the law tolerates a degree of immaterial variant in the use, citing the judgment of Birss J (as he then was) in *Thomas Pink Ltd. v. Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) at [95] where having commented that proprietors do not always and consistently use a mark in precisely the form as registered, and that using it in a form with a minor variation was allowed to be taken into account in order to avoid revocation of the mark for non-use said: *"If such use can be relevant to avoid non-use it would be unfair to the proprietor to ignore the same use of a mark from the point of view of acquiring distinctiveness merely because it was not absolutely identical to the registered mark"*. Ms Himsworth did not address this in her oral closing submissions.
174. On this issue, I prefer the submissions of Mr Malynicz. In my judgment the lack of a safe space between "easy" and "Jet" in easyJet does not mean that when "easyJet" appears in the stylised form, it cannot be use of the easy UKTM. To so hold would be unfair on easyGroup as proprietor of the easy UKTM, as this would be use of the easy UKTM with a minor variation. Accordingly, I hold that when "easyJet" appears in the stylised form, it can be use of the easy UKTM. That does not mean it necessarily is use; rather that depends on the evidence.
175. Ms Himsworth for Premier Inn submits that the use of easyJet and/or easyHotel is not use of the easy UKTM and that consumers would recognise those marks as a whole as a badge of origin. They would not perceive the first element of either of the signs i.e. the stylised word easy as an independent badge of origin. She submits that easyJet is not "easy" and "Jet", rather it is one distinctive mark with the distinctiveness residing wholly in the combination of the two elements into a single sign. She submits that in order for the easy UKTM to have been used in either of easyHotel or easyJet, it must retain its own independent distinctive character. Further, that there is no evidence, she submits, that consumers see the easy element as having a separate origin function.
176. easyGroup relies on the survey results as evidence that the easy UKTM has acquired distinctiveness, because of the references to easyJet and easyHotel. I accept that the survey evidence does demonstrate that in the minds of a material number of consumers, there is an association of the easy UKTM with easyJet and easyHotel. However, it does not, in my judgment, go as far as to demonstrate that the easy UKTM has acquired enhanced distinctiveness in the registered services. There is no sufficient evidence from the survey that consumers were of the view that the easy UKTM was being used as part of the easyJet or easyHotel logo as such. They were associating it with easyJet and airline travel and to a much lesser extent with easyHotel and/or hotels, usually in conjunction with easyJet. That is not evidence that the easy UKTM itself had enhanced distinctiveness. Association is not sufficient to establish enhanced distinctiveness.
177. Ms Himsworth makes the further point that even if use of easyJet could be said to be use of the easy UKTM, easyGroup must show that such use is in respect of the easy UKTM services in the UK. This, she submits, they cannot do. First, in respect of *"temporary accommodation; provision of holiday accommodation; hotel services"*, easyJet does not have or run any of its own hotels, as confirmed by Mr Wait in his evidence. easyJet's brand

licence prohibits them from owning, leasing or franchising hotels and in the context of package holidays, there can be no easyJet branding at any hotels that are sold as part of the package “*other than a discreet sign at the reception subordinated to the main brand of the hotel that welcomes easyJet holidays (sic) customers*”.

178. Second, as to “*hotel reservation services*”, easyJet itself does not provide any hotel booking services. As Mr Wait explained in his cross-examination and was demonstrated by reference to the documents in the bundle, all it provides is a redirect to booking.com and it then receives a commission for bookings made via booking.com. It is labelled as booking.com from the start and it is clear that the booking is with booking.com. Providing a link to a booking.com website is not use of easyJet and therefore the easy UKTM in relation to hotel reservation services.
179. In my judgment, there is force in Ms Himsworth’s submissions, limited as they are to easyJet. easyGroup have not adduced evidence of the easy UKTM being used through easyJet for any of the registered services in the UK. It might seem at first blush that this is at odds with the finding of Arnold J in the *W3* case supra at [180] that the provision of a package holiday which includes hotel accommodation amounts to the provision of (among other services) temporary accommodation. However, Arnold J’s finding was in respect of package holidays being provided across Europe, whereas in this case I am only concerned with use in the UK. No evidence has been adduced of easyJet providing package holidays in the UK.
180. The same point cannot apply to easyHotel, which has been used for the provision of hotel and temporary accommodation services, so it is possible for easy UKTM to have obtained some enhanced distinctiveness in this way, although that has not been demonstrated through the survey as having occurred, given the low figures of people associating the easy UKTM with easyHotel (as opposed to easyJet).
181. The third way in which it is said that the easyHotel UKTM and the easy UKTM have obtained enhanced distinctiveness is because they benefit from the fact that each is presented as part of the easy Travel Family and seen as such in the public mind. It is submitted that the other members of the easy Travel Family, easyJet, easyBus and easyCar offer, and have become known for offering, no frills quality travel related services, and that their reputation in the sector has, as a result, helped the easyHotel UKTM and the easy UKTM reach the level of reputation each has, and affected what qualities are associated with it.
182. Ms Himsworth described this issue as being a bit like the Cheshire Cat and that it has come in and out like a mirage throughout the litigation at the whim of easyGroup. That is, in my judgment, a not unfair description.
183. In his oral closing submissions, Mr Malynicz described this as a new member of the easy Travel Family coming along and getting a sort of rocket booster effect so that they get instant fame, albeit that they do not get reputation and enhanced distinctiveness until they have started to trade. He said that this was not a family of brands argument (although it had been advanced in pre-action correspondence in support of both the claims then intimated by easyGroup under s.10(2) and s.10(3)), but an entirely orthodox way of putting a case like this. He did not take me to any authority where this has been held to have happened.

184. Premier Inn submits that this in fact a family of brands argument. They say the argument is that the reputation of a trade mark can be enhanced by its use within the context of multiple registered trade marks sharing the same distinctive element(s), thereby increasing the scope of the individual rights falling within and thereby protected by that family. This is not the context within which it was discussed by Arnold J in *W3 v. easyGroup* (supra) at [234] where the context was likelihood of confusion (as it was in *Il Ponte Finanziaria SPA v. OHIM* Case C -234/06 P [2008] ETMR 13 at [62]-[63]). As likelihood of confusion is a concept under s.10(2) not under s.10(3), and it is only the latter which requires reputation, it does not seem to me that Arnold J was considering it in the context of reputation. I also note that it only seems to appear in Kerly's Law of Trade Marks in the section dealing with likelihood of confusion.
185. However, in *Decathlon v EUIPO* T-139/9 EU T 2020 488 [2021] E.T.M.R. 11 (which was also a confusion case), the General Court did refer to the family of marks in the context of demonstrating the enhanced distinctive character of an earlier mark for the goods in issue. The Court said that a finding that enhanced distinctive character had not been established could not be invalidated by the argument that the earlier mark was an "umbrella brand" for its other marks, stating "*Insofar as the argument should be understood as invoking the existence of a family of marks, it cannot be accepted, in the absence of a common characteristic which makes it possible for the applicant's marks to be regarded as part of a family or series of marks*".
186. And in *easyGroup Ltd. v. Easyfundraising Ltd* [2024] EWHC 2323 (Ch); [2024] ETMR 44, Fancourt J held that the issue of a family of marks (which was relied on by easyGroup in that case) was material both on issues of confusion under s.10(2) and reputation under s.10(3). This was not commented on by the Court of Appeal when giving its very recent judgment in that case.
187. In my judgment, although Mr Malynicz has sought to dress it up as something else, this is actually a family of marks argument, directed at establishing reputation for the purposes of the s.10(3) claim. Accordingly, I accept Ms Himsworth's submission that it is not open to easyGroup to run this argument, having expressly disavowed it at the hearing before me on 21 January 2025.
188. However, if I am wrong about this, and it is not actually a family of brands or family of marks argument, it is not an argument which assists easyGroup on the facts of this case. easyGroup have not adduced evidence that the other members of the easy Travel Family have reputations or enhanced distinctiveness in the services for which the easyHotel UKTM and easy UKTM are registered. I have dealt with easyJet above. easyCar is a car rental operation, not a company providing hotel accommodation etc. By 2020 easyBus, which had started out operating low-cost airport transfers to and from city centres, was selling low cost bus seats on many hundreds of routes all over Europe and beyond. Again, this was not providing hotel accommodation etc.
189. Given the lack of reputation or enhanced distinctiveness in the relevant services, in my judgment, association with these brands cannot confer on the easyHotel UKTM or the easy UKTM the reputation and enhanced distinctiveness in the relevant services which is necessary for a claim under s.10(3). If it were otherwise, there would be no magic in limiting this to the easy Travel Family. It would logically apply to all of the "easy" brands

as they all claim to offer low-cost, no frills service. To hold that a trade mark could obtain reputation and enhanced distinctiveness in particular services because of an association with trade marks sharing some similarity, but registered for and/or trading in different services would be to extend the protection given by trade marks well beyond the protection provided for under statute.

190. Having dealt with the three ways in which the claim to reputation and enhanced distinctiveness under condition (i) separately and at some length was advanced, it is appropriate to stand back and make the global assessment. Pulling all of the above threads together, in my judgment the average consumer would think that as at the Relevant Start Date, easyHotel had a reputation and moderate enhanced distinctiveness, but only in part of the services it is registered for, namely hotel accommodation and temporary accommodation. However, the average consumer would conclude that easy UKTM did not as at the Relevant Start Date have a reputation or enhanced distinctiveness in respect of any of the services for which it is registered.

191. As the easy UKTM cannot satisfy the first condition, easyGroup's claim under s.10(3) in respect of that mark falls to be dismissed.

#### Condition (iii) – use in the course of trade

192. I have dealt above in the context of the s.10(2) claim with the use by Premier Inn of the Signs. The conclusions there apply equally to the claim under s.10(3). The use of "Rest Easy" locked up in the Premier Inn Rest Easy Device has been use in the course of trade as a badge of origin, but simple use of the words "Rest Easy" alone in marketing copy has not.

#### Condition (v) use of a sign which is identical with or similar to the trade mark

193. Premier Inn's Signs to be considered are set out in the table at paragraph 105 above, other than the simple use of "REST EASY" in marketing copy. As to the marks, in light of my findings as to the lack of reputation and enhanced distinctiveness in the easy UKTM, this question does not need to be asked of that mark, nevertheless in case I am wrong on that issue, I will consider both of easyGroup's marks. The comparison of the signs is one that must be done through the eyes of the average consumer. This is a separate question from the issue of whether the similarity of the sign gives rise to a link between the sign and the trade mark in the mind of the average consumer, which is condition (vii), and in my judgment the two conditions, while they obviously impact each other, should not be rolled into one. The comparison is as to visual, aural and conceptual similarities. The average consumer looks at the mark and the Signs as a whole and does not analyse their various details.

194. It is not suggested that the signs are identical to the marks. easyGroup argues that the distinctive and dominant component of each of its marks is the word "easy". I do not accept this argument. "easy" in "easyHotel" is descriptive, it describes simplicity. The fact that the second part of the conjoined word "Hotel" is descriptive does not compel the conclusion that "easy" is descriptive or dominant (a finding also made by Arnold J in the *W3* case at [243(ii)]). As has been held in earlier easyGroup cases, "easy" is a description of what the business provides and aims to provide. These findings are not binding on me, and I have come to the same conclusion independently of them. A finding to the contrary would fly in the face of the decision of Arnold J (as he then was) to declare the "EASY" word mark

invalid. As I have already held, it is the figurative element of the easy UKTM which provides its not more than minimal distinctiveness, not the word “easy”. It would be an impossible conclusion that notwithstanding this finding, the word “easy” is nonetheless the dominant element of the easy UKTM.

195. Premier Inn accepts that there is *some* visual and aural similarity because the word “easy” appears in both the marks and the signs. However, Premier Inn submits that there are very substantial differences between the marks and the signs. In my judgment, that overall submission is correct, even though I do not accept all of the grounds for the submission, but rather just those that follow. First, the Premier Inn Rest Easy Device/Signs use colours and figurative elements, which are not present in the marks. Secondly, the orange and white in the easy UKTM has no comparison in the Signs, where the colour purple is used. Thirdly, the Cooper Black font used in the easy UKTM is not used in the Signs. Fourthly, the word “easy” appears at the end of the phrase Premier Inn Rest Easy, whereas it is the first part of the easyHotel UKTM and the only word in the easy UKTM. Fifthly, the word “easy” in the Signs is qualified by the word “Rest” so that it will be understood as the English phrase “Rest easy” rather than as “Rest” and “easy”. Sixthly, in the Signs the word “Rest easy” are always in the handwritten script specifically designed for Premier Inn.

196. I accept Ms Himsworth’s submissions on behalf of Premier Inn that the marks and the signs therefore have only a very low level of similarity visually and aurally. In my judgment, they would have no conceptual similarity in the mind of the average consumer. In my judgment, but for authority, I would have concluded that this very low level of similarity should not be sufficient to make them “similar” for the purposes of condition (v). However, given the principles summarised by Floyd LJ in *JW Spear & Sons v Zynga* [2015] EWCA Civ 290, [2015] FSR 19 at [60], albeit in the context of a confusion claim, to the effect that it is only if there is “no overall similarity”, that one does not go on to consider likelihood of confusion in a s.10(2) claim and given that the test for a link under s.10(3) is a lower one than for a likelihood of confusion, I am bound to hold that this very low level of similarity between the marks and the relevant Premier Inn signs is nonetheless sufficient for the purposes of satisfying condition (v) in the s.10(3) analysis. This is consistent with the decision of the CJEU in *Ferrero SpA v. OHIM* (C-552/09 P) [2011] ETMR 30 at [66].

#### Condition (vi) – in relation to goods or services

197. Although Premier Inn made submissions as to the similarity or identity of goods or services (it admits that its services are identical to providing hotel accommodation for which the easyHotel UKTM is registered), section 10(3) applies irrespective of whether the goods and services in relation to which the sign is used are identical with, similar to or not similar to those for which the trade mark is registered (s.10(3A)). Accordingly, I do not need to consider Premier Inn’s submissions under this condition as it cannot be disputed that the Signs are used in relation to goods or services.

#### Condition (vii) - link

198. The requirement is for easyGroup to establish there to be a link between the sign and the trade mark in the mind of the average consumer. Again, I shall consider the easy UKTM as well as the easyHotel UKTM in case I am wrong about the former not having established the necessary reputation and enhanced distinctiveness for the purposes of condition (i).

199. This flows from the similarity that I have found above, which is a very low level. The similarity has to be of such a degree that the average consumer makes a connection between the trade mark (not another trade mark) and the sign, but it is not necessary that the degree of similarity is such as to create a likelihood of confusion. It must be assessed globally having regards to all of the circumstances of the case. The fact that for the average consumer the sign would call the mark to mind is tantamount to the existence of such a link.
200. easyGroup has adduced no evidence at all of a link being made by any consumers. I was taken to easyGroup's Disclosure Review Document, which showed that easyGroup searched over 17 million emails, over 14 million files and over 120 terabytes of data. Those searches produced no evidence of any link actually being made by a consumer. In his witness statement, Mr Anderson addressed the easy.com portal at paragraph 12. During the relevant period, easyGroup has maintained on the easy.com website the "easyGroup Brand Protection", among other things inviting members of the public to email any information about people disguising themselves as an easyGroup company or trying to piggy back in any way, asking them to help protect both the consumer and the brand. There has been no disclosure of any material obtained as a result of consumers using that page to indicate any link has been made by any of them.
201. As far as Premier Inn is concerned, I have referred to the evidence of Ms Roe and Mr Hughes above. The roughly 6 million pieces of customer feedback and/or customer interaction produced no evidence of such a link. There was one occasion where a Tripadvisor review provided a review of the wrong hotel as set out at paragraph 63(c) above, but that was plainly a case of calling up the wrong hotel on Tripadvisor and was, in my judgment, an error rather than evidence of a link being made between the signs and the trade mark. While it might be said that it is unlikely that Premier Inn's customers would raise any concerns or comments about a link between the signs and easyGroup's trade marks in the context of the information which was analysed by Ms Roe and Mr Hughes, it is striking that there is not one reference to this.
202. Although permission was given for the survey evidence, purely as a statistical exercise, I have noted that not one of the interviewees having been shown the easy UKTM made any reference to Premier Inn. While that would be making a link the other way, it would not be surprising for someone seeing the easy UKTM and especially when asked about hotels to say that he had seen the Premier Inn Rest Easy Device, if the Premier Inn Rest Easy Device was such as to cause consumers to call to mind easyGroup's marks. This is not particularly significant evidence, but it adds some weight to Premier Inn's position that there is no evidence from any consumers on this topic.
203. What easyGroup do seek to rely on are some comments made in internal emails from employees of easyGroup/easyHotel, as well as some comments which were made prior to the launch of the Premier Inn rebrand in April 2021.
204. As to the internal emails from employees of easyGroup/easyHotel, easyGroup have only identified 3 emails, none of the authors of which were called to give evidence and none of whom could be described as an "average consumer":

- (a) An email dated 12 January 2023, just short of 2 years after the launch of the rebrand, from a financial controller at easyGroup to among others Mr Anderson saying, "Even premier Inn using Rest Easy in their tv campaign".
  - (b) An email dated 1 April 2023, over 2 years after the launch of the rebrand, to among others Mr Karim Malak, the chief executive of easyHotel, from Alessandron Pagliaro, who easyGroup have asserted is an easyHotel employee, "Can they do this? <https://www.premierinn.com/gb/en/home.html>"; and
  - (c) An email dated 5 May 2021 from the franchise director at easyHotel to among others Mr Moffatt, "This is getting too close for comfort however, legally they could justify it on the basis of using the word "easy" is a generic term in common parlance" and separately to easyGroup's inhouse lawyer "Your views on this would be appreciated". When asked about this, despite having said in his witness statement that if he saw something concerning, he would speak to the marketing team, the CEO and the legal team, Mr Moffatt said he could not remember it, nor had he followed it up beyond a mention to the CEO. This is indicative of the view of easyHotel that this was not actually causing a link to be drawn between it and Premier Inn.
205. It also took almost 2 years after the launch of the rebrand for easyGroup to write its first letter of complaint to Premier Inn with a further 3 months passing before the letter before action was sent, again an indication that there was no concern at easyGroup and/or at easyHotel that there was confusion being caused or that a link was being made in the necessary sense.
206. As to the comments which were made prior to the launch of the Premier Inn rebrand in April 2021, easyGroup rely on 2 email chains in March and May 2020 when Premier Inn were in the process of considering pitches by advertising agencies and one email on 15 April 2021 on the eve of the launch of the first Rest Easy campaign. None of the participants in such emails was an average consumer. None of Premier Inn's witnesses who was a party to these emails had any particular recollection of them, which in itself may be significant as to how they were viewed, so I have to construe them.
207. On 31 March 2020 (not on 31 May 2020 as Premier Inn stated in their closing submissions) Yasmin Mukhida sent an email to Ms Strauss summarising the tissue meetings which had taken place with three agencies, St. Lukes, Pablo and Leo Burnett. In respect of Leo Burnett who had already alighted on the phrase "Rest Easy", Ms Mukhida wrote "*Route 1: flagged "easy" vs easyjet but their view was that Rest Easy is a saying so don't think it was a problem*". There is no link being drawn here between the easyHotel UKTM or the easy UKTM and "Rest Easy", but rather between easy within "Rest Easy" and easyJet.
208. On 20 May 2020, Lois Wright, a marketing manager at Premier Inn wrote an email to Ms Mukhida and Ms Strauss on the subject of "Creative Agency Pitches" setting out the bigger questions/thoughts she had for the agencies, Leo Burnett and St Luke's, who were both by this stage advancing "Rest Easy". One of her 14 points for Leo Burnett was: "*Is there a danger or threat with rest easy from easyJet? Do we see them using something similar with a play on their name when it is safe to fly again, i.e. Fly Easy?*" The same point was made as one of her 6 points for St. Luke's. There is no mention of easyHotel or the easyHotel UKTM or the easy UKTM. The issue raised is, in my judgment, one from a marketing perspective as to how easyJet might seek to make a play on its own name which might impact the efficacy of Premier Inn's use of "Rest Easy". It does not evidence any

issue or concern about confusion with the easyHotel UKTM or the easy UKTM or a link being drawn by the average consumer between “Rest Easy” and those marks. While Ms Strauss was unable to recollect the email, she said that they would always “*vet whatever is happening and have conversations, and if it had been a concern, we would have pursued, but we did not*”.

209. On 15 April 2021, the day before the Rest Easy campaign was to go live, Ms Mukhida emailed various people at Leo Burnett, including Andrew Long (who was not called to give evidence) and James Millers (who was), copying in, among others, Ms Strauss and Ms Wright with the subject line “Easy...” which led to an exchange in the following terms (which I set out in full because of the reliance placed on this by easyGroup):

*“Hi team,*

*As we head into go live tomorrow (can’t quite believe it, super excited), I’ve started doing the usual ‘what if’ scenarios going around in my head, leading to terrible sleep!*

*We’ve covered off from a Prince Phillip funeral perspective and UM are doing all they can to ensure our purple print ads don’t sit next to any ‘rest in peace’ coverage in the papers.*

*I suddenly thought...what if easyjet/easy hotels come at us tomorrow on Social with a ‘Thanks Premier Inn for the free advertising’ type tweet....*

*Would it be possible to get heads together to just prep us with some thoughts on how we might handle this in a witty way?*

*Thank you!*

*Yasmin”*

Mr Long responded within 30 minutes:

*Hey guys, Hope you’re all well.*

*So excited to be able to finally see this work out in the world – not like I need an excuse to watch Celeb Catchphrase!!*

*Think it’s always good to have a response to hand for this kind of thing because it allows us to be part of that conversation and can be an opportunity to have some fun and show our personality as a brand.*

*Think we would need to find the right tone, and ensure we feel warm and kind, but there might be a simple response around the fact people are making the best of a bad situation at the moment while air travel is a no no.*

*We can’t wait to get back on a plane, but until then, rest easy knowing we’re here for everyone who wants a break in the UK!*

*If we did want to be a little punchier, we could have a bit of a joke about the specific anxieties of easyjet.*

*The only thing worse than finding a cat in your room, is eating a dry sandwich with no leg room!*

*Or we just make a virtue of the fact that we both use the word easy.*

*Wouldn’t it be great if everything else in life was as easy?*

*Given their situation at the mo, not sure we would expect them to weigh in, but think it’s great to be prepared. Let us know if you want us to think anymore too!*

*Also, at some point, if you guys are comfortable, would be great to get together in person now we’re allowed again and raise a glass to a great (and long) production process!!*

*Chat soon*

*Andy”*

This led to Ms Mukhida sending what seems to have been an initial response:

*“Thanks very much Andy – as easyjet have hotels ‘easyhotels’ – I think”*  
 And then a fuller response:  
*“Thanks very much for the quick response Andy.  
 It was mostly in relation to easyhotels rather than easyjet (though I love the  
 legspace one!)...  
 Perhaps a tiny dig at the fact you have to pay all the extras and don't get the  
 same flexibility that you do at PI... let us know if you have any thoughts on a  
 preference or an idea.  
 And lastly — yes yes and yes. We definitely need to celebrate the campaign,  
 outdoors somewhere when the sun is shining.”*

Ms Strauss finished this chain of emails as follows:

*“Andy — thank you for making me giggle out loud this afternoon. The dry  
 sandwich lines is brilliant  
 As for outdoor drinking — absolutely! I can't wait to see you guys in person for  
 a celebration  
 Until then — thank you for all the amazing work and effort that has gotten us to  
 this point. Excited to see the reactions tomorrow”*

210. In my judgment, this is not a concern that consumers might draw a link between the easyHotel UKTM or the easy UKTM and “Rest Easy” as it was going to be used in the signs, let alone evidence that the average consumer would draw such a link. It was a discussion between marketing people as to how they might react if easyJet came at them with a *‘Thanks Premier Inn for the free advertising’* type of tweet i.e. what they would do by way of marketing in response to any such tweet, so as not to lose the impact of the launch. As it happens there was no such reaction from easyJet or easyHotel or even easyGroup as the brand protector, which supports the submission made by Premier Inn that there was no such link actually drawn by the average consumer. If easyGroup did not draw a link at this stage, it is difficult to see an average consumer doing so.
211. In the absence of any evidence, what easyGroup has done is make submissions as to what an average consumer “will call to mind” when seeing the sign. This is no more than an assertion, which is not supported evidentially. easyGroup say that there has been a period of only 3.5 years from launch until the serving of witness statements and that is too short a time for the Court to draw any adverse inferences from a lack of evidence clearly demonstrating confusion or that consumers have drawn parallels between REST EASY and the relevant marks of easyGroup. In my judgment 3.5 years (or indeed 4 years until trial, as I have no doubt that if evidence had come to light after the service of witness statements and before trial, easyGroup would have brought that to the Court’s attention) is more than sufficient for some such evidence to have come to light.
212. As to the factors set out by Joanna Smith J in paragraph 73(13) of her judgment in *Lidl v. Tesco* (supra), (i) there is only a very low level of similarity visually and aurally and no conceptual similarity; (ii) the goods or services, being hotel accommodation under the easyHotel UKTM and the easy UKTM are identical to that being marketed under the sign, and similar to the temporary accommodation under the easyHotel UKTM, but there is no similarity between the other services the marks are registered for; (iii) the easyHotel UKTM has a reputation, whereas the easy UKTM does not have any reputation; (iv) the easyHotel UKTM has moderate enhanced distinctiveness, whereas the easy UKTM does not have any; (v) there is no evidence of any likelihood of confusion on the part of the public – indeed easyGroup have abandoned any claim that there is a likelihood of confusion, in my

judgment rightly so. There is no realistic possibility of anyone looking at Premier Inn's signs being confused, even with only an imperfect recollection of the easyHotel UKTM or the easy UKTM.

213. Undertaking the necessary global assessment in light of the evidence put before the Court and not stripping the sign of its context, in my judgment the average consumer would not make a link between Premier Inn's signs and the easyHotel UKTM or the easy UKTM.
214. Accordingly, easyGroup's claim under s.10(3) does not satisfy condition (vii) in respect of either of the marks and falls to be dismissed.

Condition (viii) – detriment and unfair advantage

215. In light of my findings above, this does not arise. But in case I am wrong in my earlier findings, I will go on to consider conditions (viii)(a) and (c) which are the 2 types of injury alleged by easyGroup.
216. As to detriment under condition (viii)(a), the requirements for this were summarised by Joanna Smith J in her judgment in *Lidl v. Tesco* (supra), as set out at paragraph 50 above.
217. easyGroup's submissions rest on the assertion that it has exclusivity in the hotels sphere for "easy" (as set out in paragraph 152 of its written closing submissions). Therefore, it is said that this is a classic dilution case. It is asserted that easyHotel pay significant sums to easyGroup to use the easy brand and that if others were able to use "easy" for free it clearly diminishes the value of the licence. The difficulty with this argument is at least twofold: first, that the licence has been granted by easyGroup to easyHotel for 50 years, the payment for which is a percentage of turnover (which as set out below has gone up, not down) so there is no evidence that its value has been or might be affected; secondly, that easyGroup does not, in my judgment, have exclusivity in the hotels sphere for "easy" of a kind which garners protection under trade mark law. In the course of the evidence, "Rest easy" was shown to be a phrase which has been used by other hotels both pre and post the Relevant Start Date, so while easyHotel may have been the only hotel company to use "easy" in its name as at the Relevant Start Date, it cannot be said that all uses of "easy" within the hotels sphere are exclusive to easyHotel or the easyGroup.
218. As Lewison LJ said in his judgment in the Court of Appeal in the *Lidl v. Tesco* case at [202]: "*Section 10(3) expands the scope of trade mark protection beyond the traditional functions of guaranteeing trade origins and quality. But in applying the provisions of that sub-section it is important to remember that it is in the interests of consumers that there be competition between providers of goods and services.*" What, in my judgment, easyGroup are seeking to do is illegitimately to prevent such competition, by claiming exclusivity of the word "easy" in the hotels sphere, contrary to the interests of consumers.
219. Even if easyGroup did somehow have exclusivity in the use of the word "easy" within the hotels sphere, the use by Premier Inn of that word only in the phrase "Rest easy" would not, in my judgment, dilute the word "easy" when used alone. "easy" and "Rest easy" do not mean the same thing and the average consumer would not understand them to mean the same thing, let alone in the context in which they were being used.

220. Further easyGroup has not adduced any evidence of a change in the economic behaviour of the average consumer of the goods or services for which the trade mark is registered or a serious likelihood that such change will occur in the future. easyGroup has referred me to the CJEU's decision in C-383/12 P, *Environmental Manufacturing LLP (Wolf Head) v Office for Harmonisation in the Internal Market* at [42] to [43]. In that judgment at [36], the CJEU made it clear that without adducing evidence that this condition is met, the detriment or risk of detriment to the distinctive character of a mark cannot be established. At [42]-[43], the CJEU said that case law did not require evidence to be adduced of actual detriment (which as other authorities have noted is often difficult to obtain), but also admit the serious risk of such detriment, allowing the use of logical deductions. But such deductions must not be the result of mere suppositions; they must be founded on an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case.
221. In *Lidl v. Tesco* (supra) Joanna Smith J held at [158] that in circumstances where Tesco had launched its campaign well over 2 years before trial, it was not sufficient for Lidl to contend that there was a serious likelihood of a change in the economic behaviour of the average consumer occurring in the future; in her judgment Lidl had to establish that there was in fact evidence of a change in economic behaviour since the launch, noting that actual evidence of change is often difficult to obtain. This was not challenged on appeal (see [69] of the judgment of Arnold LJ in the Court of Appeal), nor was there any suggestion that it should have been.
222. In this case it was almost 4 years from the launch of the Rest Easy campaign by Premier Inn until trial. I agree with Joanna Smith J that in a case where there has been such a long period, the trademark holder i.e. easyGroup, has to establish there is in fact evidence of a change in economic behaviour since the launch and cannot contend that there is a serious likelihood of such change in the future.
223. By contrast to *Lidl v. Tesco*, in this case easyGroup has adduced no evidence that it or easyHotel Ltd. has undertaken a responsive advertising campaign or it has found it necessary to take evasive action in the form of a corrective advertising. Mr Moffatt did provide evidence in his witness statement of the amount spent by easyHotel Ltd. on advertising, explaining the increase in 2022 and 2023 being because little had been spent in 2020 and 2021 due to the effect of COVID. He did not suggest that any part of the increase in advertising spending was to combat the Rest Easy campaign launched by Premier Inn. No such figures were produced by easyGroup itself. Although easyGroup submitted that "*the effect will be for [easyGroup] to have to engage in a significant marketing campaign to 'right the wrong'*", this has not happened in the past 4 years and it is too late for it to be undertaken now and amount to evidence of the necessary sort.
224. There was no other evidence before me of a change in economic behaviour on the part of the average consumer. There was no evidence from easyHotel to show that there had been a reduction in hotel revenue following the launch of the Rest Easy campaign, the figures put in evidence only going until September 2021. The accounts of easyHotel Ltd. published and filed at Companies House for the 15 months to December 2022 and the year to December 2023 show very substantial increases in revenue on a like for like basis year on year. While there may be explanations for this which were not explored before me, this tends to suggest that there was no change in economic behaviour of the average consumer

as a result of the utilisation by Premier Inn of the Premier Inn Rest Easy Device/Signs evidencing any detriment.

225. There is no equivalent exercise that can be done in respect of the easy UKTM as there are no separate financial figures which can be seen for its use.
226. The submissions made by easyGroup as to detriment are not, in my judgment, based on evidence, but are mere suppositions.
227. Accordingly, easyGroup have not established detriment which satisfies the requirements of condition (viii)(a).
228. As to unfair advantage under condition (viii)(c), what has to be considered was addressed in *Thatchers Cider Company Ltd v Aldi Stores Ltd* [2025] EWCA Civ 5 and is set out at paragraphs 51 to 52 above.
229. Premier Inn has also referred me to *Argos Ltd. v. Argos Systems Inc* [2018] EWCA Civ 2211; [2019] Bus LR 1728 and the discussion in the judgment of Floyd LJ (with which Sir Colin Rimer and Lord Kitchin JSC agreed) of “unfair advantage”. That restated that merely commercial or economic advantage is not sufficient to render the taking of advantage unfair, there must be an added factor of some kind for that advantage to be categorised as unfair (at [104] and [108]) and established that it should be sufficient to show a change in economic behaviour of customers for the defendant’s (i.e. the alleged infringer’s) goods or services in order to show that the use of the sign is taking unfair advantage at [107].
230. easyGroup submit that this is a similar case to *Lidl v. Tesco* in that rather than the alleged infringing signs transferring a luxury image, they are conveying the image of value. This “trading down” is just as much riding on the coat tails as would be an attempt to take advantage of a luxury image to “trade up”. It is submitted that by adopting a sign that calls to mind the easyHotel UKTM and the easy UKTM, Premier Inn is able to instantly convey similar associations of super-budget, no frills hotels and is able to do so without the investment of time or money in configuring its business actually to supply such an offering.
231. Premier Inn had terminated their contract with their previous marketing company, Lucky Generals in early 2020 before drawing up the RFI. They did not identify easyHotel as a competitor that they were seeking to compete with, given Premier Inn’s much larger offering in terms of numbers of beds and the superior quality of their rooms. Premier Inn had seen a correlation between when it had stopped spend on brand media (e.g. TV, radio and press) but continued with digital investment in around 2018 and a drop in the rate of new customer acquisition. Ms Strauss said that they were looking at how the brand was perceived by Premier Inn’s customers and how they could grow appeal to new business and leisure customers. Premier Inn were selling exactly the same product as they had previously been selling. There was no evidence brought to my attention to suggest that Premier Inn reduced the quality of the product on offer or sought to introduce amendments to its offering so that it matched that being offered by easyHotel, which easyGroup says was “no frills, super budget”, or that they sought to undercut or even match easyHotel’s prices.

232. Reliance is placed by easyGroup on the fact that “Rest Easy” was intended to have brand significance, which was confirmed in the evidence of Mr Henderson, Mr Millers and Ms Strauss. It is clear on the evidence that Premier Inn did intend to use the “Rest Easy” branding to convey value to its customers, it having been set out in the RFP that Premier Inn had not been playing as a value brand, and they wanted to make sure that they were seen as value for money for customers. This is why there was reference to value brands, including Aldi, Lidl and easyJet in the RFP.
233. easyGroup asserted in its closing submissions, that “*Premier Inn is thus able to attract customers it would not otherwise have reached, without actually making the investment or cutting its margins and passing on savings as a genuine no frills business might do*” and also that the “Rest Easy” rebrand has been “*enormously successful*”. However, there was no evidence put before me to support the assertion that Premier Inn had been able to attract customers they would not otherwise have reached, nor that the rebrand had been “enormously successful”, for example an analysis of increase in revenue on the part of Premier Inn, flowing from the rebrand.
234. easyGroup point to paragraphs [109] and [114] of the judgment of the Court of Appeal in *Thatchers v. Aldi* (supra) saying that as in that case Premier Inn has not sought to adduce any evidence demonstrating that the success of the rebranding was not as a result of the transfer of image of the “easy” value brands. This is not, in my judgment, a correct analysis. In the *Thatchers v. Aldi* case, what Aldi were selling was an entirely new product for them and the evidence was that they achieved significant sales in a short period of time without any promotion and the product appeared to have sold better than the nearest comparator in its Taurus range (see paragraphs [103]-[104]). In those circumstances, it is understandable why the Court should take the view that what was effectively an evidential burden lay on Aldi to prove that it would have made the same volume of sales without use of the sign, but rather with a design which was consistent with the house style of the Taurus range (see paragraphs [109] and [114]). Before one could reasonably expect Premier Inn to put in evidence to prove it would have made the same volume of sales without the “Rest Easy” rebrand, it would be necessary first to show with evidence how, if at all, sales volumes increased and over what period. Only, if that exercise had been done, could there be any question of an evidential burden shifting to Premier Inn. A media post on its parent company’s website that “The “Rest Easy” brand platform has been successfully doubling down on what sets Premier Inn apart as a beacon of comfort and consistency since April 2021” is not a sufficient basis for this. Accordingly, easyGroup have not, in my judgment, established on the evidence that there was a change in economic behaviour of Premier Inn’s consumers, such as to make any advantage unfair.
235. As to the question of intention, easyGroup’s primary pleaded case is that Premier Inn intended to benefit from the link with the easyHotel UKTM and the easy UKTM. I accept the evidence of Ms Strauss that Premier Inn did not view easyHotel as a competitor. The RFI and RFP are silent as to easyHotel. I also accept that there was no intention to take advantage of the easyHotel UKTM or the easy UKTM. They were not present in the minds of either of the two advertising agencies who independently came up with “Rest Easy”. As I have set out above, when Ms Mukhida flagged “easy” vs “easyJet” in early 2020, this was not a reference to easyHotel or the easyHotel UKTM or the easy UKTM. Even when on the eve of the launch, Ms Mukhida was not concerned about taking advantage of easyHotel, but rather how they would meet any counter advertising. This is not indicative of any

intention to take advantage of the easyHotel UKTM or the easy UKTM or to deceive consumers.

236. However, as is clear from the decision of Arnold J (as he then was) in *Jack Wills Ltd v House of Fraser (Stores) Ltd* [2014] EWHC 110 (Ch), [2014] FSR 39 the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation of the trade mark can amount to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation. Further, if a party “lives dangerously” or “sails close to the wind”, that is capable of supporting the conclusion that deception was likely even if the defendant did not intend to deceive. By contrast if what is proved is that he was aware of the risk but thought he had done sufficient to avoid it materialising, that is not supportive of the conclusion that deception was likely but rather of the reverse.
237. easyGroup submits that even if Premier Inn did not intend to take unfair advantage or to deceive consumers, it was aware of the risk and proceeded recklessly, that is to say that it lived dangerously (and this is pleaded in paragraph 33.3 of the Re-Re-Amended Particulars of Claim). It relies on the emails that I addressed at paragraphs 207 to 209 above as showing that Premier Inn recognised the risk and then did nothing about it, such as taking advice from trade mark lawyers. In so acting, it is submitted, Premier Inn was reckless and this supports the conclusion that deception was likely.
238. I am unable to accept this submission. In my judgment, those emails cannot be read as recognising a risk of an average consumer making a link between Premier Inn’s Signs and the easyHotel UKTM and/or the easy UKTM, for the reasons set out in the discussion of those emails. Further, this is not a case where Premier Inn were oblivious to trade mark issues. St. Luke’s initially came up with “Rest. Assured”, which Premier Inn liked. However, they said there was a potential problem as there is a mattress manufacturer called “Rest Assured” and therefore they told St Luke’s they could not use it and they should come up with alternative suggestions. They did and came back with “Rest Easy” (which Leo Burnett also did). This did not spark a similar reaction. In my judgment, that demonstrates that Premier Inn did not see there as being any risk with using “Rest Easy”, as had it thought there was such a risk, Premier Inn would have raised it and told the advertising agencies to come up with something else. It follows that this is not a case of Premier Inn recognising a risk and acting recklessly. It is also not a case of Premier Inn recognising a risk and thinking it had done sufficient to avoid it materialising. Premier Inn simply did not consider that there was any risk.
239. In my judgment, undertaking the multifactorial assessment weighing the matters set out above, there was not taking of an unfair advantage by Premier Inn. Rather, Premier Inn was launching its own rebrand by way of fair competition.
240. Therefore, easyGroup has not established unfair advantage which satisfies the requirements of condition (viii)(c).
241. Having not established detriment under condition (viii)(a) or unfair advantage under condition (viii)(c), had easyGroup’s claim not failed prior to this stage, it would fail at this stage and therefore fall to be dismissed.

### Condition (ix) – due cause

242. This does not arise in the circumstances. If I had otherwise found in favour of easyGroup on its claim under s.10(3), it is difficult to see how it could be said that Premier Inn used the sign with due cause (see Arnold LJ's similar observation in *Lidl v. Tesco* at [168]). I note the different approach taken by Lewison LJ in the same case at [209]. I do not need to decide between the two approaches in light of my earlier findings and therefore do not do so.

### Invalidity Application

243. easyGroup has also sought a declaration of invalidity of the Premier Inn UKTM under s.5(2) and/or s.5(3) of the 1994 Act on the basis of the alleged infringements under ss.10(2) and (3). This is to be considered as at the Relevant Filing Date as opposed to the Relevant Start Date, but easyGroup accepts that nothing turns on this. As I have not found any infringement under either section by the Premier Inn Signs, which includes the Premier Inn UKTM, it is my understanding that easyGroup accepts that its claim to a declaration of invalidity falls away. I accordingly dismiss it.

### Conclusion

244. easyGroup's claim under s.10(2) for infringement of the Rest Easy Apartments UKTM fails, as do its claims under s.10(3) for infringement of the easyHotel UKTM and the easy UKTM. Further, its claims for declarations of invalidity also fail.

245. In the circumstances, easyGroup's claim is dismissed. I have not been asked to and do not rule on Premier Inn's counterclaim.

246. I ask that Counsel prepare a draft Order reflecting the contents of this judgment for my approval. In so far as there are matters which are not capable of agreement between the parties, I will deal with these either in writing or at a short hearing at a time which is convenient to Counsel.

29<sup>th</sup> August 2025

## APPENDIX 1

### EXPERT REPORT CODING

This document is agreed between the parties save for the Claimant's additions **in green** and the Defendant's additions **in red**.<sup>1</sup>

#### Survey 1<sup>2</sup>

|                                                             | Williams  |                                   | Bennison <sup>3</sup> |                      |
|-------------------------------------------------------------|-----------|-----------------------------------|-----------------------|----------------------|
|                                                             | Total no. | Percentage (of 1091) <sup>4</sup> | Total no.             | Percentage (of 1091) |
| Q1 - Have you seen this before in relation to hotels? (YES) | 699       | 64%                               | 699 <sup>5</sup>      | 64%                  |
| Q2/Q3 - easyJet (specific mentions)                         | 394       | 36%                               | 436                   | 40%                  |
| Q2/Q3 - easyHotel (specific mentions)                       | 136       | 12%                               | 136                   | 12.5%                |

#### **Williams 2 [E/1/14-15]<sup>6</sup>:**

|                                                               | Total            | Percentage |
|---------------------------------------------------------------|------------------|------------|
| Have you seen this before in relation to hotels? (YES)        | 699              | 64%        |
| Total respondents referencing easyJet                         | 394              | 36%        |
| Total respondents referencing easyHotel                       | 136              | 12%        |
| Total respondents referencing easyGroup                       | 11               | 1%         |
| Total respondents referencing easyJet / easyHotel / easyGroup | 483 <sup>7</sup> | 44%        |

<sup>1</sup> Whilst this document is agreed between the parties, the Defendant considers Annex B of its Closing Skeleton Argument to be a more helpful and clearer summary of the results of Ms Bennison's coding of responses to the Surveys. The Defendant therefore requests the Judge also reviews the Defendant's Annex B.

<sup>2</sup> Verbatim responses at GW11 [O/10]

<sup>3</sup> Figures rounded to one decimal place as per Bennison.

<sup>4</sup> Percentages each rounded to the nearest whole percentage.

<sup>5</sup> See Bennison, paragraph 4.5 [E/2/27].

<sup>6</sup> For explanation of coding see Williams 2, paragraph 9.2 [E/1/13-14]

<sup>7</sup> This figure is not the total of the preceding three rows as, for example, a respondent may have referenced both easyJet and easyHotel but would only be counted once for this coding.

|                                                                                                                                                                                 |     |     |
|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-----|-----|
| Total respondents that were aware that the image related to a specific brand or company <sup>8</sup>                                                                            | 644 | 59% |
| Total respondents that were aware that the image related to a specific brand or company AND responded YES to Q1 (Have you seen this before in relation to hotels?) <sup>9</sup> | 565 | 52% |

Bennison did not include the coding in green above and so this is not included in the summary of the Defendant's coding or the comparison of the Experts' Survey 1 coding above.

The last two rows of the above table are based on coding as set out in GW14 and carried out by Stephenson Harwood LLP, not by Williams [E/1/14] [E/3/54]. It is the Defendant's position that these should not be referred to or included in this document which is intended to be a comparison of the respective experts' coding.

**Bennison [E/2/43-44]:**

|                                                     | From the 699 respondents who responded 'yes' to Question 1, how many mentioned the key word in either Question 2 or Question 3 | From the 699 respondents who responded 'yes' to Question 1, what percentage mentioned the key word in either Question 2 or Question 3 | From the 392 respondents who responded 'no' to Question 1, how many mentioned the key word in either Question 2 or Question 3. | From the 392 respondents who responded 'no' to Question 1, what percentage mentioned the key word in either Question 2 or Question 3. |
|-----------------------------------------------------|--------------------------------------------------------------------------------------------------------------------------------|---------------------------------------------------------------------------------------------------------------------------------------|--------------------------------------------------------------------------------------------------------------------------------|---------------------------------------------------------------------------------------------------------------------------------------|
| easyJet mentions <sup>10</sup>                      | 319                                                                                                                            | 45.6%                                                                                                                                 | 117                                                                                                                            | 29.8%                                                                                                                                 |
| airline generic mentions                            | 45                                                                                                                             | 6.4%                                                                                                                                  | 36                                                                                                                             | 9.2%                                                                                                                                  |
| Total easyJet specific and airline generic mentions | 364                                                                                                                            | 52%                                                                                                                                   | 153                                                                                                                            | 39%                                                                                                                                   |

<sup>8</sup> An indication of a specific brand or company being a measure of distinctiveness. For explanation of coding see Williams 2, paragraph 9.4 [E/1/14]. The full list of these selections is set out at GW14 [O/13].

<sup>9</sup> Ibid

<sup>10</sup> 319 + 117 = 436 and 436/1091 = 40%

**Bennison [E/2/44-45]:**

Para. 9.2 "*Out of the total of 1091 responses to Survey 1, there were 136 mentions of easyHotel which equates to 12.5% of the total sample*".

**Bennison [E/2/46]:<sup>11</sup>**

| <b>Definition of 'hotel' used by respondents who answered 'yes' to Question 1</b> | <b>From the 699 respondents who responded 'yes' to Question 1, how many mentioned this definition</b> | <b>From the 699 respondents who responded 'yes' to Question 1, what percentage mentioned this definition</b> |
|-----------------------------------------------------------------------------------|-------------------------------------------------------------------------------------------------------|--------------------------------------------------------------------------------------------------------------|
| easyJet Package holidays                                                          | 88                                                                                                    | 12.6%                                                                                                        |
| Booking websites for hotels                                                       | 21                                                                                                    | 3%                                                                                                           |
| Airport hotels                                                                    | 8                                                                                                     | 1.1%                                                                                                         |
| Clear links to an actual easyHotel e.g. through location                          | 110                                                                                                   | 15.7% <sup>12</sup>                                                                                          |

Williams 2 and 3 did not include this coding and so this is not included in the summary of the Claimant's coding or the comparison of the Experts' Survey 1 coding above.

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<sup>11</sup> For an explanation of coding, see Bennison, paragraph 9.8 [E/2/46].

<sup>12</sup> This count is higher than the 136 respondents / 12% referred to in the first table because it includes respondents whose description made it very clear that they were talking about an actual easyHotel even if they did not use the name (e.g. through location or specific features such as the windowless rooms). See Bennison, paragraph 9.7 [E/2/45].

### Survey 2<sup>13</sup>

|           | Williams  |                      | Bennison <sup>14</sup> |                                     |
|-----------|-----------|----------------------|------------------------|-------------------------------------|
|           | Total no. | Percentage (of 1135) | Total no.              | Percentage (of 1135 <sup>15</sup> ) |
| easyJet   | 730       | 64% <sup>16</sup>    | 702                    | 61.9%                               |
| easyHotel | 51        | 4%                   | 50                     | 4.4%                                |
| easyGroup | 25        | 2%                   | 87                     | 7.7%                                |

#### Williams 2 [E/1/16-17]<sup>17</sup>:

|                                                               | Total             | Percentage |
|---------------------------------------------------------------|-------------------|------------|
| Total respondents referencing easyJet                         | 730               | 64%        |
| Total respondents referencing easyHotel                       | 51                | 4%         |
| Total respondents referencing easyGroup                       | 25                | 2%         |
| Total respondents referencing easyJet / easyHotel / easyGroup | 736 <sup>18</sup> | 65%        |

#### Bennison [E/2/39]<sup>19</sup>:

|         | Respondents mentioning the key word |                                |
|---------|-------------------------------------|--------------------------------|
|         | Number out of 1135 respondents      | Percentage of 1135 respondents |
| easyJet | 702                                 | 61.9% <sup>20</sup>            |

<sup>13</sup> Verbatim responses at GW12 [O/11]

<sup>14</sup> Figures rounded to one decimal place as per Bennison. There is a difference in coding approach between Ms Bennison and Mr Williams which accounts for the discrepancies between the two experts' results. Ms Bennison included all responses which could conceivably have been describing easyJet / easyHotel / easyGroup even if the respondents didn't mention the brand name specifically (see Bennison, paragraph 8.2 [E/2/37]). Mr Williams coded on the basis of specific mentions only (see Williams 2, paragraphs 9.2 and 9.3 [E/1/13]).

<sup>15</sup> See Bennison, paragraph 8.3 [E/2/38].

<sup>16</sup> Percentages each rounded to the nearest whole percentage.

<sup>17</sup> For explanation of coding see Williams 2, paragraph 9.2 [E/1/13-14].

<sup>18</sup> This figure is not the total of the preceding three rows as, for example, a respondent may have referenced both easyJet and easyHotel but would only be counted once for this coding.

<sup>19</sup> For explanation of coding see Bennison, paragraph 8.2 [E/2/37-38]

<sup>20</sup> As respondents could mention more than one of the listed key words (e.g. airlines and hotels), or none at all, these percentages could never total 100%. See Bennison, paragraph 38 of [E/2/38].

|                                            |     |      |
|--------------------------------------------|-----|------|
| Airline category only (no easyJet mention) | 58  | 5.1% |
| Total easyJet and airline                  | 760 | 67%  |
| easyHotel                                  | 50  | 4.4% |
| Hotel category only (no easyHotel mention) | 54  | 4.8% |
| Total easyHotel and hotel category         | 104 | 9.2% |
| easyGroup (no easyJet/easyHotel mention)   | 87  | 7.7% |

## APPENDIX 2

### RESPONSE TO LIST OF ISSUES

**1. Whether and to what extent the Claimant's easy UKTM has a reputation in relation to easy UKTM Services, all in class 43, in the UK.**

The easy UKTM does not have a reputation in relation to any of the easy UKTM Services in class 43 in the UK.

**2. Whether and to what extent the Claimant's easy UKTM has enhanced distinctiveness in relation to easy UKTM Services, all in class 43, in the UK.**

The easy UKTM does not have enhanced distinctiveness in relation to any of the easy UKTM Services in class 43 in the UK.

**3. Whether and to what extent the Claimant's easyHotel UKTM has a reputation in relation to temporary accommodation, reservation services for hotel accommodation and/or computerised hotel reservation services, all in class 42, in the UK.**

The easyHotel UKTM has a reputation in relation to temporary accommodation and hotel accommodation in class 42 in the UK. It does not have a reputation in relation to reservation services for hotel accommodation and/or for computerised hotel reservation services.

**4. Whether and to what extent the Claimant's easyHotel UKTM has enhanced distinctiveness in relation to the easyHotel UKTM Services, all in class 42, in the UK.**

The easyHotel UKTM has moderate enhanced distinctiveness in relation to temporary accommodation and hotel accommodation in the UK. Otherwise, it has no enhanced distinctiveness.

**5. Whether each and every use of the words "rest easy" pleaded in paragraph 29 RAPoC and shown in Annex 10 is use as an indicator of trade origin.**

The use of the words "rest easy" in simple marketing copy is not use as an indicator of trade origin. The use of the Signs with the lockup, including the words "Rest easy" is a use as an indicator of trade origin.

**6. Whether the word "easy" even when used with other words or symbols in the hotel sector has independent distinctive character in respect of the Claimant's Marks or either of them, at least to such an extent as to create a link between the Defendant's Signs and the Claimant's Marks.**

The word "easy" does not have independent distinctive character in respect of either of the easyHotel UKTM or the easy UKTM, such as to create a link.

**7. The extent to which UK consumers know the meaning of the phrase "rest easy".**

This is not a necessary question to answer as it is common ground that the phrase may mean a number of things. It does not mean the same as "easy" alone.

**8. Whether the Defendant's Signs or any of them are similar to the Claimant's Marks.**

The Defendant's Signs have a very low visual and aural similarity to the easyHotel UKTM and the easy UKTM, but no conceptual similarity.

**9. Whether the Defendant's services are identical or highly similar to:**

**(1) the following easyHotel UKTM Services in class 42: temporary accommodation; reservation services for hotel accommodation and/or computerised hotel reservation services; and/or**

**(2) the following easy UKTM Services in class 43: temporary accommodation and/or hotel reservation services.**

Premier Inn's services are identical to "hotel accommodation" under the easyHotel UKTM and the easy UKTM and similar to the "temporary accommodation" under the easyHotel UKTM, but there is no similarity between the other services the marks are registered for.

**10. Whether the Defendant intentionally sought to benefit from the Claimant's reputation in each of the Claimant's Marks or whether it made a deliberate decision to live dangerously, being reckless or ambivalent as to taking advantage of the Claimant's Marks.**

The Defendant did not intentionally seek to benefit from the Claimant's reputation in either of the Claimant's Marks. The Defendant did not make a deliberate decision to live dangerously, being reckless or ambivalent as to taking advantage of the Claimant's Marks or either of them.

**11. Whether the Defendant's use of the Defendant's Signs damages or risks damaging the functions or any of them, of each of the Claimant's Marks.**

The use of the Defendant's Signs does not damage or risk damaging the functions or any of the functions of either the easyHotel UKTM or the easy UKTM.

**12. Whether the Defendant's use of the Defendant's Signs creates a real likelihood of a change in economic behaviour of members of the public in the UK encountering the Claimant's services.**

No, the Defendant's use of the Defendant's Signs has not created a real likelihood of a, or an actual, change in economic behaviour of members of the public in the UK encountering the Claimant's services (or the services of easyHotel Ltd).

**13. Whether the Defendant's Signs or any of them would result in the average consumer making a link with the easyHotel UKTM and easy UKTM or either of them.**

The Defendant's Signs would not result in the average consumer making a link with the easyHotel UKTM or with the easy UKTM.

**14. Whether the Defendant's use of the Defendant's Signs and each of them is without due cause and takes unfair advantage of and/or is detrimental to the distinctive character of each of the Claimant's Marks.**

No, the Defendant's use of the Defendant's signs is not without due cause (although had I found otherwise in favour of the Claimant on its claim under s10(3), it is difficult to see how it could be said that the Defendant used the signs with due cause) and does not take unfair advantage of and/or is not detrimental to the distinctive character of each of the Claimant's Marks.

**15. Having regard to the answers to issues 1 – 14, whether there has been infringement under s 10(3) of the Act.**

There has been no infringement under s.10(3) of the Act.

**16. Whether the Defendant's UKTM is liable to be declared invalid by virtue of s.5(3) of the Act by virtue of the Claimant's earlier rights in the easyHotel UKTM and the easy UKTM.**

The Defendant's UKTM is not liable to be declared invalid by virtue of s.5(3) of the Act.

**17. Whether and to what extent the Defendant's Signs or any of them are similar to the Claimant's Rest Easy Apartments UKTM.**

There is similarity, but only low similarity, between the Defendant's Signs and the Claimant's Rest Easy Apartments UKTM.

**18. Whether the Defendant's services are identical or similar to the Rest Easy Apartments UKTM Services in class 36.**

The Defendant's services are similar to "*letting of apartments; rental of apartments*" within the Rest Easy Apartments UKTM Services in class 36. That level of similarity is medium. Otherwise, there is no similarity with the other services the mark is registered for.

**19. Whether there is a likelihood of confusion on the part of the average consumer between the Claimant's Rest Easy Apartments UKTM and the Defendant's use of the Defendant's Signs.**

There is no likelihood of confusion on the part of the average consumer between the Claimant's Rest Easy Apartments UKTM and the Defendant's use of the Defendant's Signs.

**20. Having regard to the answers to issues 17– 19, whether there has been infringement under s 10(2) of the Act.**

There has been no infringement under s.10(2) of the Act.

**21. Whether the Defendant's UKTM is liable to be declared invalid by virtue of s.5(2) of the Act by virtue of the Claimant's earlier rights in the Rest Easy Apartments UKTM.**

The Defendant's UKTM is not liable to be declared invalid by virtue of s.5(2) of the Act.

**22. Whether the Claimant has suffered and/or is likely to suffer loss or damage.**

The Claimant has not suffered and/or is not likely to suffer loss or damage.

**23. Whether the Claimant is entitled to the claimed or any relief in the claim.**

The Claimant is not entitled to the claimed or any relief in the claim.