Suing for infringement of a descriptive trade mark isn't easy (Easygroup v Easylife)

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IP analysis: This is the latest in the series of reported English court rulings on the so-called 'easy+' portfolio of trade marks, of which the brand easyJet is by far the best-known. This case was brought in attempt to prevent a retailing business called Easylife Ltd and its director from (among other things) using various brands incorporating the word 'easy'. However, the claimant not only lost its cases for trade mark infringement and passing off, but also suffered the revocation of various of its UK trade marks on the grounds of non-use, and even the registration for easyJet itself took some punishment. Written by Dr Jonathan Cornthwaite, solicitor, consultant at Wedlake Bell LLP, a member of the University of Bournemouth's Department of Law, and a member of LexisPSL's Case Analysis Expert Panels.

EasyGroup Ltd v Easylife Ltd (formerly Easylife Group Ltd) and another [2021] EWHC 2150 (Ch)

What are the practical implications of this case?

The High Court's decision contains two very valuable lessons for brand owners.

The first is to ensure that trade mark registrations have not become vulnerable to revocation due to their non-use. Particularly in infringement proceedings, it is a common tactic for a defendant to supplement its defence with a counter-claim for revocation. This is precisely what happened in the instant case, with the defendants' counterclaim causing one of the registrations in suit to be revoked, inflicted damage on two more, and constrained the claimant to throw a fourth overboard.

The other cautionary tale is perhaps even more important: it is that if you choose to register as your trade mark a word from the English vocabulary that is ordinary, descriptive and non-distinctive, you may well find it difficult to persuade English courts that it has been the subject of infringement or passing off. In this connection the court could hardly have been clearer, stating that 'In my judgement the word "easy" is not distinctive. It is a descriptive word…The use of this adjective is not distinctive, or if it has a distinction [it] is of low value' (at para [266]).

What was the background?

Easygroup Ltd, the claimant, acts as an umbrella company for the intellectual property rights in the 'easy+' series of brands, including (among others) easyJet, easyGroup, easyLand and easy4men, which it owns and profitably licenses to associated entities.

Easylife Ltd, the first defendant, deals in the retail sale of a variety of clothing, homewares, household goods, gadgets, motoring accessories and health and mobility items targeting the 65-year-old-plus demographic. The second defendant is its principal director.

Sued in the High Court for trade mark infringement and passing off on the basis of their use of the brands easylife, easyclean, easycare and easy green, they denied the claimant's allegations and counterclaimed for revocation of its trade mark registrations on the grounds of non-use.

What did the court decide?

Trade mark infringement

Before it could decide on whether the claimant's trade mark registrations had been infringed, the court naturally had to rule on the defendants' counterclaim for their revocation. That counterclaim proved to be largely successful, for the court was persuaded to take a knife to various of the registrations in suit.

Following the summary enunciated by Mr Justice Arnold (as he then was) governing revocation of UK trade marks in *The London Taxi Corp Ltd (t/a London Taxi Co) v Frazer-Nash Research Ltd et al* [2016] EWHC 52 (Ch) (which was upheld on appeal), the court revoked two of the claimant's UK registrations in their entirety (easyLand and easy4men) for non-use, and cut down the scope of two others.

The court then considered whether what was left of the trade mark portfolio had been infringed, concluding that it had not.

Two separate subsections of the Trade Marks Act 1994 (TMA 1994) required consideration. Under TMA 1994, s 10(2), citing with approval the principles summarised by Arnold J (as he then was) in *W3 Ltd v Easygroup Ltd* [2018] EWHC 7 (Ch), the court ruled that the parties' respective services were neither identical nor similar, and that the average consumer would not be confused by the defendants' signs.

As for TMA 1994, s 10(3), under which a trade mark registration that enjoys a 'reputation in the UK' can in certain circumstances be infringed even where the defendant's goods or services differ from those listed in the registration's specification, the court concluded that the average consumer would not 'make a link' between the defendants' signs on the one hand and the claimant's registrations on the other, and that the claimant had failed to establish either detriment to its repute or the taking of unfair advantage.

Passing off

Given the outcome of the infringement case, it is unsurprising that the passing off case received short shrift. Relying on the classic definition of passing off in *Reckitt & Colman Products Ltd v Borden* [1990] RPC 341 and applying (among others) the decision in *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697, the court concluded that since the parties' respective activities were 'fields apart' (at para [286]) there was no convincing evidence either that a substantial number of the public would be deceived, or that the defendants' signs would damage the claimant's goodwill.

Case details:

- Court: Business and Property Courts of England and Wales, Intellectual Property List (ChD), High Court of Justice
- Judge: Chief Insolvency and Companies Court Judge Briggs (sitting as a High Court judge)
- Date of judgment: 29 July 2021

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