

TRADE MARKS ACT 1994

**IN THE MATTER of Trade Mark no. 2198058
in the name of NRS Tools Marketing Ltd**

and

**IN THE MATTER of application for invalidity
No. 11860 by Gardena Kress + Kastner GmbH**

Background

1. On 24 May 1999, NRS Tools Marketing Ltd applied under the Trade Marks Act 1994 to register the following as a series of two trade marks



2. Following amendment, the specification of goods reads:

Class 08:

Garden and general purpose hand tools.

Class 18:

Bags, holdalls, belts, pouches.

Class 20:

Articles manufactured from plastics; storage boxes, tool boxes, caddies, carts.

3. The application was accepted and published. The application proceeded to registration on 5 November 1999. On 1 September 2000, Gardena Kress + Kastner GmbH filed an application for a declaration of invalidity of the registration. The action was filed on Form TM26(I) together with the appropriate fee. The statement of case accompanying the application set out three grounds of action, these can be summarised as follows:

- (a) under section 47(2)(a) of the Trade Marks Act 1994, in that the trade mark in suit is similar to the applicants' earlier trade marks GARDENA, details of which are shown in an Annex to this decision, and is registered for goods which are identical or similar to those which the applicants' earlier trade marks are protected and contrary to the provisions of section 5(2)(b) of the Act.
- (b) under section 47(2)(b) of the Trade Marks Act 1994, in that by virtue of the

use made of the trade mark GARDENA, the applicants enjoy goodwill and reputation in the trade mark such that use of the trade mark in suit at the date of the application by the registered proprietor in relation to all the goods in its registration would have been likely to lead to confusion with the applicants' goods and would thus registration could have been prevented by virtue of the law of passing off contrary to the provisions of section 5(4)(a) of the Act.

- (c) under section 47(1) of the Trade Marks Act 1994, in that at the date of application for the registration in suit, the registered proprietor did not have a bona fide intention to use the trade mark in relation to any of the goods for which the mark is registered, and that the trade mark was registered in breach of section 3(6) of the Act.

4. The registered proprietor filed a counterstatement denying the grounds of invalidity. The counterstatement was accompanied by documents from the registered proprietor. I will mention this further below. The applicants for invalidity also sought an award of costs.

5. After reading the pleadings and the evidence I asked for the Office to issue a letter indicating that I was of the view that an oral hearing was not required in these proceedings. The parties were given a period of time within which to request a hearing or to file written submissions. Neither party filed such submissions. Therefore, in reaching a decision on this case, I have taken careful note of the pleadings and evidence and give this decision.

The Applicants' Evidence

6. Various witness statements have been adduced into the proceedings. I first turn to the witness statement of Mr Stewart Anderson dated 29 January 2001. Mr Anderson is the Sales Director of Gardena UK Ltd, a wholly-owned subsidiary of Gardena Kress + Kastner GmbH.

7. In this witness statement, Mr Anderson states that GARDENA watering and sprinkling apparatus and parts thereof have been sold in the United Kingdom since as early as 1972 and since then other goods have been added to the range. At SA1 he exhibits the Gardena '99 catalogue showing the full range of products sold under the GARDENA trade mark in the United Kingdom. Mr Anderson adds that catalogues of this type have been published annually and distributed in the trade for approximately the past 10 years.

8. Mr Anderson says that the approximate annual turnover for goods sold under the trade mark GARDENA in the United Kingdom for the five years preceding the date of the application in suit were:

Year	Amount in £
1994/95	4.5 million
1995/96	4.5 million
1996/97	4.3 million
1997/98	4 million
1998/99	3-4 million

9. Mr Anderson also says that the approximate amount spent annually on promoting the goods sold under the GARDENA trade mark in the United Kingdom are:

Year	Amount in £
1994/95	315,000
1995/96	315,000
1996/97	301,000
1997/98	280,000
1998/99	238,000

10. Mr Anderson states that the goods have been promoted continuously in the United Kingdom by way of sales representation and participation at exhibitions. He goes on to state that the GARDENA garden equipment and accessories have been sold through garden centres and nurseries situated in all parts of the United Kingdom and are also sold through major DIY retailers such as B & Q, Great Mills, Wickes and Do It All. At SA2 Mr Anderson exhibits a list of garden centres which stock the GARDENA garden equipment and accessories.

11. The next witness statement is that of Ms Joanne Elaine Batty. Ms Batty is a Trade Marks Assistant at W.P. Thompson & Co who are representing the applicants in this matter. Ms Batty states that on 18 January 2001 she telephoned all of the garden centres listed at exhibit JEB 1 to ask the persons referred to in page 1 of that exhibit, a number of questions. Shown at JEB 2 are a list of the questions she asked. I will not list these here but will discuss them as part of my decision. Copies of the completed questionnaires are shown at JEB3.

12. Witness statements from 10 of the respondents are also provided. For reasons that I will explain later I will not summarise these.

Registered Proprietor's Evidence

13. In accordance with the provisions of rule 33(6), on receipt of the applicants' evidence, the registered proprietor was given six weeks from that date, within which to file evidence in support of their registration. No evidence was filed. However, as mentioned, attached to the registered proprietor's counter-statement were various documents which the registered proprietor refers to as supporting 'evidence'. The issue of written evidence before the registrar is governed by the Trade Mark Rules 2000; the relevant rules are rules 55(1) and 55(3). These provide for evidence before the registrar to be in the form of statutory declarations, affidavits or witness statements. Whilst the TM8 accompanying the registered proprietor's counter-statement contains a statement of truth, that does not, in my view, allow me to find that the counter-statement and accompanying documents should be treated as evidence in the proceedings. Indeed, the official letter of 26 October 2000 acknowledging receipt of the counter-statement stated that if the registered proprietors wished the accompanying documents to be considered as evidence then they should be submitted at the evidence stages in the proper format. The letter also directed the registered proprietor to the relevant guidance notes. The registered proprietor was given an opportunity to file evidence in the proceedings but none was filed. Consequently the only effect that the counter-statement has in the instant proceedings is to outline the defence of the registered proprietor.

14. That concludes my review of the evidence.

Decision

15. The applicants claim that the registration in suit should be declared invalid as per section 47 of the Act on the basis of the provisions of sections 5(2)(b), 5(4)(a) and 3(6). The relevant parts of the Act are as follows:

“47.- (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

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

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

(3)

(4)

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.

5.- (1)

(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)
- (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -
 - (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
 - (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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

- 3.- (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

16. The term “earlier trade mark” is defined in section 6 of the Act as follows:

- “6.- (1) In this Act an “earlier trade mark” means -
 - (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

17. I will deal first with the applicants’ ground of invalidity under section 5(2)(b). In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG*

[2000] E.T.M.R. 723. It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, 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 that he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27.
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctiveness and dominant components; *Sabel BV v. Puma AG* page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice-versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Meyer Inc* page 132, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 224;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind is not sufficient for the purposes of Section 5(5); *Sabel BV v. Puma AG* page 224;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 133 paragraph 29.

18. Under section 5(2), the test is a composite one, involving a global appreciation taking into account a number of factors. With these comments in mind I proceed to consider the applicants' case under section 5(2)(b).

19. The applicants' have ten earlier trade marks within the definition of section 6 of the Act, these are set out in an Annex to this decision. They are all United Kingdom registrations for the trade mark GARDENA and cover goods in classes 6, 7, 8, 9, 11, 17, 20 and 21. It seems to me that the applicants' best case falls to be determined by reference to 1355194 and 1355198 for the trade mark GARDENA. These two registrations cover goods in classes 8 & 20 which seem to me to be the closest to those for which the proprietor's mark is registered. However, I will also assess the question under section 5(2)(b) by reference to the applicants' other United Kingdom registrations where I see them to be in a better position. The registered proprietor's mark and the applicants' earlier marks are reproduced below.

Registered Proprietor's trade mark



Class 8

Garden and general purpose hand tools

Class 18

Bags, holdalls, belts, pouches

Class 20

Articles manufactured from plastics;
storage boxes, tool boxes, caddies, carts

Applicants' trade mark

1355194

GARDENA

Class 8

Hand tools and implements; tool heads; secateurs; shears; scissors; plant feeders; fertilizer spreaders and sprayers; all the aforesaid goods for garden use; garden tools; rakes; hoes; cultivator heads; grubbers; weeders; lawn edgers; garden trowels; hand forks; shovels; flower gatherers; fruit pickers; all included in Class 8.

1355198

GARDENA

Class 20

Handles for garden tools or implements
or
for brushes or brooms; edging strips; racks for garden tools or implements or for brushes or brooms; clips for pipes and hoses; taps and valves; hose reels; all included in Class 20.

Inherent Distinctiveness/Reputation of the Applicants' Earlier Trade Marks

20. The case law outlined above indicates that the distinctive character of a mark, either inherent or because of the use that has been made of it, is a factor to take into account when reaching a decision under section 5(2)(b). Each of the applicants' trade mark GARDENA appears to be the word GARDEN with the addition of the letter A. The goods for which the trade mark GARDENA are registered, those listed above and those listed in the Annex to this decision include products which can be used in a garden. Indeed, the trade mark GARDENA seems to me to be a phonetic equivalent to the word "Gardener". As such, it seems to me that the mark GARDENA contains a clear reference to the nature of the goods and, therefore, in my view has inherently a low degree of distinctive character.

21. I go on to consider whether, on the basis of the evidence before me, the applicants' trade marks have acquired a distinctive character through use. Their turnover figures show an approximate annual turnover in excess of £4 million for the years 1994 through to 1998. It appears that early sales related to watering and sprinkling apparatus but Mr Anderson states that from 1998 the trade mark GARDENA has been used in relation to a range of gardening tools. This is also supported by the 1999 catalogue submitted at exhibit SA1 and by the list of garden centres which stock the GARDENA equipment and accessories at exhibit SA2. However, all I have are the turnover figures and evidence showing use of the mark, I have no information or evidence as to the market share that these figures represent. Further, as noted, the applicants trade was originally centred on watering and sprinkling apparatus. Whilst the 1999 catalogue submitted in evidence does show use on goods in class 8, it seems to me that their primary use is still in the field of watering apparatus. The turnover figures given are global figures, and I have no way of knowing how much of this use relates to use on the goods in classes 8 and 20 or indeed to those goods in classes 17 and 21.

22. I should state that in my view I can take no account of the evidence of Ms Batty enclosing the results of her interviews with various persons employed by garden centres. It follows that I can take no account also of the supplementary witness statements signed by those she interviewed. This is because the survey suffers from several serious defects. The survey at question 5 asks the interviewee to speculate as to the likelihood of confusion. Indeed the opening statement indicates that the whole purpose of the questionnaire is to find out whether two names could be confused or not. As such, it appears to me to lead the interviewee and suggest the response which the applicants' seek. Therefore, on the basis of the evidence before me I am unable to conclude that the low inherent distinctive character of the mark will have been improved through use.

Comparison of the Trade Marks

23. I will now consider the visual, aural and conceptual similarities between the trade marks by reference to the overall impression created by the marks but taking into account their distinctive and dominant components. The question must be assessed through the eyes of the average consumer taking into account the fact that the average consumer rarely has an

opportunity to make a direct comparison between the trade marks; so called imperfect recollection. Taking into account the goods in question, the average consumer would be ordinary members of the public.

24. Visually, the applicants' earlier trade mark is GARDENA, the registered proprietor's is GARDENIER. There are some obvious visual similarities between the two trade marks. Both marks start with the word GARDEN. However, as noted above, in relation to goods in Classes 8 and 20 the element GARDEN is in my view a clear reference to the nature and intended purpose of the goods be they garden forks or handles for garden tools. The visual differences occur at the end of the two marks. The applicants' mark ends with the letter A whilst the registered proprietor's ends with the letters IER. Whilst it is true that in general the beginnings of trade marks are visually the most prominent, where as is the case here, the trade marks contain elements descriptive of the goods then the endings must assume more importance. I do, nevertheless, consider the mark as a whole taking into account their dominant and distinctive components. Thus, it seems to me that whilst GARDEN is a prominent element in both marks the endings A and IER, even though they occur at the end of the word present a visual and different point of reference for the average consumer. As such, I find that although there is some visual similarity between the marks it is not as high as might first appear.

25. Aurally the two marks are again GARDENA and GARDENIER and both refer to the nature of the goods. I have no indication before me as to how the marks would be pronounced so I must judge the matter for myself. It seems to me that in oral use the applicant's mark GARDENA might be pronounced "gardener", which is an ordinary English word, or "gardeenea". The registered proprietor's mark GARDENIER might be pronounced "gardeneair" (as in Bombardier) or Gardeneair (as in Jardiniere). Again it has long been held that in oral use the beginnings of words assume more importance. Here, both trade marks share the same first six letters being the word GARDEN. In oral use one is left trying to differentiate between the ending EENA or AR in the case of GARDENA and EAR or EAIR in the case of GARDENIER. On any view of how the marks would be pronounced, it seems to me that there is a high degree of aural similarity between the marks.

26. Conceptually, the applicants' trade mark GARDENA appears to be the phonetic equivalent of the ordinary English word GARDENER. The registered proprietor's trade mark GARDENIER would, if pronounced as GARDEN-E-AR would appear to indicate a French origin from the word JARDINIERE, a French word which has made its way into the English language meaning "jardiniere 1. an ornamental pot or trough for plants 2. a garnish of fresh vegetables, cooked, diced, and served around a dish of meat" (Collins English Dictionary). Either way, it seems to me that as both seek to use the element garden, there is some conceptual similarity between the two trade marks.

27. To conclude on this point, I reach the view that there is some visual and conceptual similarity between the marks and a high degree of aurally similarity.

Identity/Similarity of Goods

28. The registration is for goods within Classes 8, 18 and 20. Which if any, of the goods

falling within these classes are similar or identical to the goods covered by the applicants' earlier trade marks? As noted above, the likelihood of confusion must be assessed globally. In *Canon*, the ECJ indicated that this implied some interdependence between the relevant factors. Accordingly, a lesser degree of similarity between the marks (and vice versa); *Canon* paragraph 17, page 132.

29. That said, it has been recognised by the ECJ that section 5(2), (Article 4(1)(b) of the Directive) requires that the goods/services are similar. In particular in *Canon* at paragraph 22 the Court stated:

“22. It is however, important to stress that, for the purposes of applying Articles 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar”.

30. Mr Hobbs Q.C., sitting as the Appointed Person in *Raleigh International* [2001] R.P.C. 11 has stated:

“Similarities between marks cannot eliminate differences between goods or services; and similarities between goods or services cannot eliminate differences between marks. So the purpose of the assessment under section 5(2) must be to determine the net effect of the given similarities and differences.”

31. In order to assess the similarity of the goods, I note the test set out by Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at page 296. Adapted to the instant case, it can be stated as:

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

32. These factors were referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45 - 48. In its judgement, the ECJ stated at paragraph 23:

“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 end

users and their method of use and whether they are in competition with each other or are complementary.”

33. In these proceedings, the statement of case filed by the applicants states that all the goods in the registration are considered to be identical or similar to the goods for which their trade marks are registered. The registered proprietor's in their counter-statement make no admissions on this matter. I will look at each class in turn and consider the applicants' claim.

Class 18

34. The registration covers “Bags, holdalls, belts, pouches”. The applicants' do not have a registration in class 18. Looking at the applicants' registrations set out in the annex to this decision, they have registrations in classes 6, 7, 8, 9, 11, 17, 20, and 21. I have studied these specifications which cover a variety of goods in these classes. However, it seems to me that the uses, users, physical nature and trade channels for the goods in suit are all different to those for which the earlier marks are protected. I can find no similarity between “bags, holdalls, belts, pouches” and “handles and tubular handles, all for brushes”, in class 6, “plant feeding apparatus” in class 7, “hand tools” in class 8 “computer and controls” in class 9, “apparatus and installations, all for water supply” in class 11, or “hoses for garden and for household use” in class 17. As there is no similarity of goods, the provisions of Section 5(2)(b) do not apply in so far as the registration covers goods in class 18.

Class 8

35. The registration covers “Garden and general purpose hand tools”. The applicants' earlier registration 1355194 covers “Hand tools and implements; tool heads; secateurs; shears; scissors; plant feeders; fertilizer spreaders and sprayers; all the aforesaid goods for garden use; garden tools; rakes; hoes; cultivators; rake heads; hoe heads; cultivator heads; grubbers; weeders; lawn edgers; garden trowels; hand forks; spades; garden forks; shovels; flower gatherers; fruit pickers”; all included in Class 8.

36. The term “Garden hand tools” in the specification of the registration would seem to me to cover goods identical to goods covered by the terms “Hand tools and implements; secateurs; shears; scissors; all the aforesaid for garden use; garden tools;.....”, in the specification of the applicants' earlier registration 1355194.

37. The term “General purpose hand tools” in the specification of the registration would seem to me to be broader but nevertheless cover items similar to those included within “Hand tools and implements; tool heads; all for garden use..... hand forks; spades;.....shovels”, in the specification of the applicants' earlier registration 1355194.

38. Thus some of the registered proprietors' goods in Class 8 will be identical to the goods falling within the applicants' specifications, others will be similar. The applicants also have registrations covering goods in classes 17 and 21 covering hoses and watering apparatus for use in the garden. Whilst the users and channels of trade for these products may be the same as those for garden tools, it seems to me that there is a greater degree of similarity between the applicants' goods in class 8 and I will consider the question under section 5(2)(b) by

reference to the applicants' registration in that class.

Class 20

39. The registration covers "Articles manufactured from plastics; storage boxes, tool boxes, caddies, carts". The applicants' earlier registration 1355198 covers "Handles for garden tools or implements or for brushes or brooms; edging strips; racks for garden tools or implements or for brushes or brooms; clips for pipes and hoses; taps and valves; hose reels"; all included in Class 20.

40. The term "Articles manufactured from plastics" in the specification of the registration would seem to cover goods identical to the terms "Handles for garden tools or implements or for brushes or brooms; edging strips; clips for pipes and hoses; hose reels" in the specification of the applicants' earlier registration 1355198.

41. The remaining terms in the specification of the registration are "Storage boxes, tool boxes, caddies, carts". The applicants' mark covers racks for garden tools or implements. It seems to me that looking at the uses and users, and the trade channels, there would be some similarity between a storage box and tool box and a rack used for garden tools. That said, the similarity between caddies and carts and the goods for which the earlier mark is protected is it seems to me less apparent. I have no evidence directed to the similarity or otherwise of the goods in question. Whilst the products might be used in a garden they could also have other applications. Absent further evidence directed to this point, I cannot find that there is a similarity of goods in so far as the registration covers caddies and carts. The remaining goods in class 20 are either identical or similar to the goods for which the applicants' earlier registration 1355198 is protected.

42. Thus some of the registered proprietors' goods in Class 20 will be identical to the goods falling within the applicants' specifications others will be similar.

Conclusions under section 5(2)(b)

43. Together with my finding that the applicants' earlier trade mark possesses an inherently low distinctive character, how do my findings in respect of the similarities of the marks and the similarities of the goods come together under section 5(2)(b)? As noted above, the ECJ has stated that a lesser degree of similarity between the goods or services can be offset by a greater degree of similarity between the marks (or vice versa).

44. Mr Hobbs, Q.C., sitting as the Appointed Person in *Balmoral Trade Mark* [1998] R.P.C. 297 at page 301, found that section 5(2) raised a single composite question. Adapted to this case it can be stated as follows:

Are there similarities (in terms of marks and goods) which would combine to create a likelihood of confusion if the "earlier trade mark" GARDENA and the registered trade mark GARDENIER, were used concurrently in relation to the goods for which they are respectively registered?

45. In my view this question must be answered in the affirmative. Although the applicants' mark does not possess a high degree of inherent distinctiveness and will therefore have a relatively low penumbra of protection, it seems to me that the visual and conceptual similarities together with the high degree of aural similarity taken together with the identity/similarity of the goods result in a finding of a likelihood of confusion if the trade marks were used on identical or similar goods. The primary means for choosing such products would, it seems to me, be visual however, I do not discount the fact that my own experience that when shopping for such products it is often common to ask a shop assistant "Do you stock GARDENIER products?". Alternatively one might ask "Where can I find GARDENIER products?". The likelihood of confusion in this case can only be increased if, as I must, I take into account the danger of imperfect recollection.

46. In the light of my findings, the applicants' ground of invalidity under Section 5(2)(b) is made out in so far as the registration covers goods in Classes 8 and made out in part in so far as it covers goods in class 20. The application for invalidity in respect of Class 18 is dismissed. I will deal with the consequences of my decision below.

Section 5(4)(a)

47. The applicants also seek to rely on the ground of objection under section 5(4)(a) of the Trade Marks Act 1994. The requirements for this ground of invalidity have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to invalidity proceedings, the three elements that must be present can be summarised as follows:

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

Goodwill and Reputation

48. In considering the question under Section 5(2)(b) I dealt with the applicants' evidence showing use of their mark and found that it was insufficient to find that the mark had acquired a reputation through use. In my view the same criticisms apply here and I am unwilling on the basis of the evidence before me to find that the applicants' trade mark possess the necessary goodwill and reputation to found a passing off action. **The applicants' ground of invalidity under Section 5(4)(a) falls at the first hurdle and is dismissed.**

Section 3(6)

49. No evidence has been filed to support this ground.

50. Recent case law has indicated that bad faith is a serious allegation. In *Royal Enfield* BL 0/363/01 Mr Simon Thorley QC, sitting as the Appointed Person, held:

“An allegation that a trade mark has been applied for in bad faith is a serious allegation. It is an allegation of a form of commercial fraud. A plea of fraud should not be lightly made (see Lord Denning M.R. in *Associated Leisure v. Associated Newspapers* (1970) 2 QB 450 at 456) and if made should be distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts (see *Davy v. Garrett* (1878) 7 Ch. D. 473 at 489). In my judgement precisely the same considerations apply to an allegation of lack of bad faith made under section 3(6). It should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctively proved and this will rarely be possible by a process of inference. Further I do not believe that it is right that an attack based upon section 3(6) should be relied on as an adjunct to a case raised under another section of the Act. If bad faith is being alleged, it should be alleged up front as a primary argument or not at all.”

51. No evidence having been adduced by the applicants on this ground it is dismissed.

Conclusions

52. I have found that the applicants' grounds of invalidity under section 5(2)(b) have been made out in so far as the registration cover goods identical or similar to those for which the earlier marks are protected.

53. Therefore, the registration is declared invalid in respect of Class 8 and in Class 20 in so far as it covers “Articles manufactured from plastics; storage boxes, tool boxes”. In accordance with section 47(6) of the Trade Marks Act 1994 the registration is deemed never to have been made in respect of those goods.

54. The registered proprietor has one month from the expiry of the appeal period within which to file form TM23 restricting the specification of his mark to that shown below.

Class 18

Bags, holdalls, belts, pouches

Class 20

Caddies, carts

Costs

55. The application for invalidity was in respect of all the Classes covered by the registration. The applicants have succeeded in their application for invalidity in respect of Class 8 and in part in Class 20. It seems to me that given these findings, they are entitled to a contribution towards their costs. I order that the registered proprietor pay the applicants for invalidity the sum of £750 as a contribution towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 13 day of June 2002

**S P Rowan
For the Registrar
the Comptroller General**

Annex

United Kingdom Trade Mark registration number: 1355192

GARDENA

Class 6

Handles and tubular handles, all for brushes and brooms and for garden tools or implements; pipes; pipe and hose clips; pipe fittings; taps and valves; jets and spray nozzles; hose reels; hooks and racks; connectors and couplings, all for hoses or reels; all included in Class 6.

United Kingdom Trade Mark registration number: 1355193

GARDENA

Class 7

Plant feeding apparatus; fertilizer spraying and spreading apparatus; pumps for garden and household use; electric shears; electric hedge trimmers; electric rotary trimmers; electric lawn mowers; electric motors for all the aforesaid goods; hand driven lawn mowers; parts and fittings for all the aforesaid goods; grass boxes for lawn mowers; all included in Class 7.

United Kingdom Trade Mark registration number: 1355194

GARDENA

Class 8

Hand tools and implements; tool heads; secateurs; shears; scissors; plant feeders; fertilizer spreaders and sprayers; all the aforesaid goods for garden use; garden tools; rakes; hoes; cultivators; rake heads; hoe heads; cultivator heads; grubbers; weeders; lawn edgers; garden trowels; hand forks; spades; garden forks; shovels; flower gatherers; fruit pickers; all included in Class 8.

United Kingdom Trade Mark registration number: 1355195

GARDENA

Class 9

Computers and controls, all for garden and horticultural watering systems; soil moisture

meters; water timers; electric cables for use with the aforesaid goods and with garden and household tools or implements; all included in Class 9.

United Kingdom Trade Mark registration number: 1355196

GARDENA

Class 11

Apparatus and installations, all for water supply; installations of pipes for use with liquids; filters; shower valves; water pressure regulators; water pressure reducers; all for garden and for household use; outdoor showers for bathing; pipe and hose fittings; all included in Class 11.

United Kingdom Trade Mark registration number: 1004015

GARDENA

Class 17

Hoses for garden and for household use and parts and fittings for such hoses, all included in Class 17.

United Kingdom Trade Mark registration number: 1355197

GARDENA

Class 17

Water pipes and hoses, all for garden or household use; parts and fittings for all the aforesaid goods; elbow joints; articulated pipe connectors; hose clips; hose connectors; hose couplings; sealing rings for pipes and hose fittings; connectors and couplings, all for hoses or tubes; all included in Class 17.

United Kingdom Trade Mark registration number: 1355198

GARDENA

Class 20

Handles for garden tools or implements or for brushes or brooms; edging strips; racks for garden tools or implements or for brushes or brooms; clips for pipes and hoses; taps and valves; hose reels; all included in Class 20.

United Kingdom Trade Mark registration number: 1004016

GARDENA

Class 21

Watering apparatus and sprinkling apparatus, all for grass and for garden use; manually and pressure operated sprayers for garden and household use; all included in Class 21; brushes for washing vehicles; and parts and fittings included in Class 21 for all the aforesaid goods.

United Kingdom Trade Mark registration number: 1355199

GARDENA

Class 21

Watering apparatus and sprinkling apparatus, all for grass and for garden use; sprayers for garden and for household use; nozzles; brushes and brushheads for washing vehicles; brushes, brooms, brushheads, broomheads and squeegees, all for household and domestic use; soap dispensers for use with carwash hoses and brushes; fertilizer dispensers for use with garden watering and sprinkling apparatus; parts and fittings for all the aforesaid goods; sponges; all included in Class 21.