

O-001-11

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2496632

BY

MR STEVEN MORGAN

TO REGISTER THE TRADE MARK:

ASTROLAWN

IN CLASSES 1, 17 AND 27

AND

THE OPPOSITION THERETO

UNDER NO 99066

BY

TEXTILE MANAGEMENT ASSOCIATES, INC

Trade Marks Act 1994

**In the matter of application no 2496632
by Mr Steven Morgan
to register the trade mark:**

ASTROLAWN

**in classes 1, 17 and 27
and the opposition thereto
under no 99066
by Textile Management Associates, Inc**

1) On 3 September 2008 Mr Steven Morgan filed an application to register the above trade mark (the trade mark). The trade mark was published in the *Trade Marks Journal*, for opposition purposes, on 6 February 2009 with the following specification:

glue for joining artificial grass;

adhesive tape used for carpets;

artificial grass.

The above goods are in classes 1, 17 and 27 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. On 10 December 2010 Mr Morgan filed a form TM21 to amend the class 1 and 27 specifications of the application to:

glue for joining artificial grass for use in domestic gardens;

artificial grass for use in domestic gardens; not including artificial grass for use in relation to sports pitches.

At a hearing in relation to the case, a “fall back” specification for the class 17 goods was also submitted, namely: *adhesive tape used for carpets, for use in a home.*

2) On 6 May 2009 Textile Management Associates, Inc (TMA) filed a notice of opposition to the registration of the trade mark. TMA relies upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act).

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

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

.....

(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.”

Section 5(3) of the Act states:

“(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) 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.”

Section 5(4)(a) of the Act states:

“(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”.

The principles of the law of passing-off were summarised by Lord Oliver in *Reckitt & Colman Products Ltd v. Borden Inc* [1990] RPC 341 at page 406:

“The law of passing off can be summarised in one short, general proposition: no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the

plaintiff. ... Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

4) TMA, in relation to sections 5(2)(b) and 5(3) of the Act relies upon the following trade mark registrations:

- United Kingdom registration no 902750 of the trade mark ASTROTURF. The application for registration was filed on 8 December 1966. It is registered for the following goods:

matting simulating grass.

The above goods are in class 27 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

- United Kingdom registration no 955903 of the trade mark ASTROGRASS. The application for registration was filed on 26 February 1970. It is registered for the following goods:

surface coverings simulating grass, in the nature of carpets, for indoor use or outdoor use.

The above goods are in class 27 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

- Community registration no 3537107 of the trade mark ASTROTURF. The application for registration was filed on 12 November 2003 and the registration process was completed on 30 March 2005. It is registered for the following goods:

synthetic turf systems consisting of layers of man-made grasses of fibres and filaments and surface coverings of fibres or filaments; synthetic carpets, rugs, mats and matting including golf driving range mats, putting greens and chipping mats; matting simulating grass; floor coverings; artificial turf; artificial grass.

The above goods are in class 27 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

- Community registration no 1210103 of the trade mark ASTROGRASS. The application for registration was filed on 17 June 1999 and the registration process was completed on 27 November 2000. It is registered for:

surface coverings of synthetic fibers for filaments for indoor and outdoor use; artificial turf surfaces with elastic underlayer shock-absorbing system made of rubber, aggregate and polyurethane binder.

The above goods are in class 27 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

- Community registration no 2030369 of the trade mark ASTROPLAY. The application for registration was filed on 8 January 2001 and the registration process was completed on 4 April 2002. It is registered for:

matting simulating grass; surface coverings in the nature of carpets, for use in sports and athletics; artificial turf surfaces; synthetic turf systems consisting of layers of manmade grasses of fibres and filaments; surface coverings of fibres and filaments.

The above goods are in class 27 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

TMA claims that it has used the trade marks the subjects of registration nos 902750, 955903, 1210103 and 2030369 on all of the goods of the registrations and that the trade marks have a reputation in respect of all of the goods of the registrations. It is claimed that the trade mark the subject of registration no 3537107 has a reputation in respect of all of the goods of the registration. Prior to the hearing TMA had also relied upon United Kingdom registration no 926797, at the hearing it abandoned reliance upon this registration.

5) TMA claims that all of the goods of its registrations are similar or identical to the goods of the application and that the trade marks the subjects of its registrations are similar to the trade mark of the application. Consequently, there is a likelihood of confusion. TMA states that it is the proprietor of a number of United Kingdom and Community trade mark registrations for the trade mark ASTROTURF and other ASTRO prefixed trade marks. It claims that these trade marks have been used and continue to be used extensively in the United Kingdom. At the hearing TMA did not amend its position owing to the amendment of the specifications of the application.

6) TMA claims that use of Mr Morgan's trade mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of the trade marks the

subjects of its earlier registrations. Consequently, registration of the trade mark would be contrary to section 5(3) of the Act.

7) TMA claims that it has used the signs ASTROTURF, ASTROGRASS and ASTROPLAY in the United Kingdom since the 1970s in relation to artificial grass. Owing to this use, TMA claims that use of Mr Morgan's trade mark on all of the goods of the application is liable to be prevented by the law of passing-off and so registration of the trade mark would be contrary to section 5(4)(a) of the Act.

8) Mr Morgan filed a counterstatement. In the counterstatement he requires proof of use of the trade marks the subjects of registration nos 902750, 955903, 1210103 and 2030369 as per section 6(A) of the Actⁱ. Mr Morgan denies that the trade marks of TMA are similar to his trade mark. He accepts that artificial grass in registration no 3537107 is identical to the artificial grass in his application but denies that the remaining goods in his application are similar or identical to the goods of the earlier registrations of TMA. Mr Morgan denies the grounds of opposition under sections 5(2)(b), 5(3) and 5(4)(a) of the Act and puts TMA to proof of its claim of substantial use of its trade marks and reputation in the trade mark ASTROTURF and other ASTRO prefixed trade marks.

9) Only TMA filed evidence.

10) A hearing was held on 13 December 2010. Mr Morgan was represented by Mr Roger Grimshaw of Mewburn Ellis LLP. TMA was represented by Ms Jessie Bowhill of counsel, instructed by Berwin Leighton Paisner LLP.

Witness statement of Mr Andy Belles

11) Mr Belles is brand manager of AstroTurf LLC, a subsidiary of TMA.

12) The ASTROTURF trade mark was first used in 1966 by the United States company Chemstrand Company (now the Monsanto Textiles Company). Its artificial turf product was first developed with the aim of creating an urban playing surface that would rival grass. Subsequently, it attracted the interest of major sporting leagues. In 1994 the ASTROTURF brand was purchased by Southwest Recreational Industries, Inc. This company was purchased by American Sports Products Group Inc. In 2004 TMA acquired the ASTROTURF brand and other ASTRO prefixed brands, together with other assets and intellectual property from American Sports Products Group Inc.

13) Mr Belles "believes" that the first sales of ASTROTURF products in Europe took place in 1970. He understands that ASTROTURF was installed at the German Sports Academy Sportschule Hennef in 1970. TMA's subsidiary, AstroTurf, LLC, handles the marketing of ASTRO branded products in Europe through arrangements with European distributors. ASTRO branded products have been sold in the United Kingdom since 1980 by TMA's predecessors in title

and its United Kingdom based distributors. There have been more than 3,000 installations of ASTROTURF and other ASTRO branded artificial grass products in more than 50 countries.

14) Exhibited at AB1 is a page from astroturf.com, downloaded on 29 January 2010. As this emanates from after the date of application and is not jurisdictionally specific, it is not of assistance in this case. Exhibited at AB2 is a page from the same website, downloaded on the same date, relating to ASTROPLAY; this shares the same deficiencies as AB1 in relation to the current proceedings. Exhibited at AB3 is a page from the same website relating to ASTROGRASS, which shares the same deficiencies as AB1 and AB2. Exhibited at AB4 is a page from the same website relating to ASTROLAWN, which suffers from the same deficiencies as AB1. Exhibited at AB5 is a copy of a brochure for ASTROLAWN. The brochure has a United States telephone number and lacks an indication as to when it was published. Consequently, it is not of assistance in this case. Exhibited at AB6 is a schedule of TMA's trade marks, together with details of United Kingdom, Community and United States trade mark registrations.

15) Exhibited at AB7 is a press release relating to a special event in New York City on 12 December 2006. As this relates to the United States it does not have a bearing upon these proceedings.

16) Mr Belles states that in the United Kingdom TMA's distributor is McArdle Sport-Tec Limited (McArdle), which markets its products through the websites mcardle-astroturf.co.uk (aimed at commercial customers) and astro-turf.net, where retail customers can purchase ASTROTURF products online. Mr Belles goes on to comment on TMA's United States website, which does not have a bearing upon these proceedings. Exhibited at AB9 are copies of pages from TMA's website, downloaded on 29 January 2010 entitled Affiliations. These refer, inter alia, to ASTROPLAY N55 football surface installed at the University of Kent, there is no indication as to the date of the installation. The pages refer to a sponsorship agreement with the European Hockey Federation. The pages also include a reference to McArdle and McArdle ASTROTURF. There is a hyperlink to mcardle-astroturf.co.uk.

17) TMA is one of the manufacturers approved by the International Hockey Federation (FIH). Exhibited at AB10 is a document from the FIH dated January 2010 listing certified pitches. In the European Union, manufacturers listed are: Domo Sports, Desso Sports Systems, Polytan, Tiger Turf, Astroturf LLC (for surfaces in Birmingham, Edinburgh, and Wrexham), Lano Sports, Sports Technology International. The only listings in the European Union for Astroturf LLC are the three locations in the United Kingdom. In the United Kingdom Polytan has installed surfaces at 4 locations, Tiger Turf at 4 locations, Lano Sports at 3 locations and Sports Technology International at 1 location. In the European Union, excluding the United Kingdom, Domo has installed surfaces at

3 locations, Desso Sports Systems at 8 locations and Polytan at 2 locations. Domo has used the trade marks Domo Hockey Xtreme and Domolympics; Desso has used the trade mark Sportilux; Sports Technology has used the trade mark Poligras Olympia; Polytan has used the trade marks TerraGrass, Megagrass and Megaturf; Tiger Turf has used the trade marks Challenger and Tiger Turf Wett; Lano has used the trade marks Excelsior and Interplay.

18) The ASTROTURF brand is marketed in Europe through TMA's subsidiary, AstroTurf LLC, which has a number of arrangements with European distributors. These are generally non-exclusive arrangements, allowing TMA the right to sell ASTRO branded products directly in these territories. All ASTRO branded products are produced by TMA to the specification of the relevant licensee and then shipped overseas to be installed at the customer's site. Exhibited at AB11 are specifications for products for McArdle. The documents are dated 22, 24 and 28 August 2007 and emanate from McArdle. They bear the trade marks ASTROTURF and ASTROPLAY. The specifications are for synthetic grass carpets for football.

19) In addition to its United Kingdom distributor, through AstroTurf LLC, TMA has arrangements with a number of other European distributors, including Lano Sports NV in Belgium, France, Italy and the Netherlands, OPSA in Spain and Portugal and Infloortech GmbH in Germany and eastern Europe. Exhibited at AB12 are copies of marketing materials produced and distributed by TMA's European distributors. These comprise:

- *Astro Football News* from 2001. This is a publication of AstroTurf Europe on the Netherlands. The publication refers to ASTROPLAY artificial football surface. The reader is told that Schalke 04 (Germany), Real Madrid, Manchester United and Porto (Portugal) have chosen to install ASTROPLAY pitches. The publication advises that McArdle are installing three ASTROPLAY pitches for Manchester United. The publication advises that Oxford United have installed an ASTROGRASS pitch. ASTROGRASS is a combination of natural grass and synthetic turf. The publication also shows use of ASTROTURF.
- Promotional material from Interfloortech GmbH of Germany. There is no indication as to from when this material emanates. The material promotes ASTROTURF and ASTROGRASS for hockey pitches.
- Promotional material for ALPHASAN, it bears a United States address and there is no indication of the date of its production.

20) TMA's ASTRO branded products have been sold in the United Kingdom since 1980. Its relationship with McArdle commenced in 1998, McArdle has a non-exclusive distribution agreement for the United Kingdom for ASTRO branded products. Exhibited at AB13 are pages downloaded from astro-turf.net on 29 January 2010. One page advises that the website is the only place in the United Kingdom that ASTROTURF artificial grass can be purchased online. The

banners on the pages refer to patios, caravans and self install. The end uses of the product are identified as: patios, balconies, pathways, roof gardens, verandas, caravans, pool surrounds (ASTROTURF Leisure), golf putting practice, exhibition flooring (ASTROTURF Super SD), heavy duty kick-about areas, playgrounds (ASTROTURF Super SF), luxury lawns, garden features, play areas and nurseries (ASTROTURF Deluxe). Exhibited at AB15 is a page from the same website downloaded on 29 January 2010 showing photographs of ASTROTURF products, which Mr Belles "understands" have been installed in the United Kingdom. Further pages from the website are exhibited at AB16 and AB17, all of which were downloaded on 29 January 2010.

21) A copy of McArdle's brochure downloaded from mcardle-astroturf.co.uk is exhibited at AB18. There is no indication as to from when this brochure emanates and/or when it was downloaded. There is use of McArdle and ASTROTURF in combination and separately. ASTROPLAY also appears in the brochure. There is a reference to the City of Manchester Stadium for the 2002 Manchester Commonwealth Games having a McArdle ASTROTURF surface. Mr Belles understands that the website receives 70,000 hits per month. There is no indication as to the number of unique visitors or where the visitors are based. Exhibited at AB19 is a screen shot of the website taken on 29 January 2010. A further screen shot is exhibited at AB20, at the bottom of the page "01.12.00" appears.

22) Exhibited at AB21 are further pages downloaded from mcardle-astroturf.co.uk on 29 January 2010. These identify the following products: ASTROPLAY, ASTROTURF and ASTROGRASS, all of these are used for surfaces upon which sport is played; association football, rugby football and hockey. Exhibited at AB22 is a further marketing brochure downloaded from mcardle-astroturf.co.uk, again there is no indication of when it was downloaded. The trade marks ASTROPLAY and ASTROTURF appear in the brochure. Further brochures which have been downloaded from the same website, with no indication of date, are exhibited at AB23 and AB24. These brochures relate to the use of ASTROTURF and ASTROGRASS for hockey pitches. AB24 includes a list of sand filled surfaces, sand dressed surfaces and hockey surfaces. Mr Belles states that these references relate to customers who have purchased different ASTROTURF products for hockey. AB25 consists of two items, neither of which is identified by date of emanation. One is for AstroTurf Online which has the domain name astro-turf.net (see paragraph 16) and which offers ASTROTURF for sale. The other is for ASTROPLAY, which is identified with the domain name astroplay.com. ASTROPLAY is promoted as a service for playing rugby. AB26, is a page, without any indication of provenance, relating to the installation of a hockey pitch for Oxford University; ASTROTURF appears on the page. Reference is made to the installation by Southwest Recreational Industries Inc, which purchased the ASTROTURF brand in 1994 and was later purchased by American Sports Products Group Inc. Mr Belles describes AB27 as consisting of further marketing materials which McArdle have provided.

Pages 174 and 175 relate to ASTROGRASS and ASTROPLAY for association football use. ASTROTURF also appears upon page 174. There is no indication of date of production of the page. Pages 176 and 177 are identified with 1995. The pages promote ASTROTURF for hockey purposes. AB28 is a page downloaded from mcardle-astroturf.co.uk on 29 January 2010 relating to the installation of ASTROPLAY playing surfaces for Manchester United. The installation was completed in 2002 and had a value of £700,000. AB29 is a page downloaded from mcardle-astroturf.co.uk on 29 January 2010 relating to the installation of an ASTROPLAY synthetic football pitch for the University of Kent, the project was completed prior to 22 August 2005 and was worth £1.0 million. AB30 consists of two pages downloaded from mcardle-astroturf.co.uk on 29 January 2010 relating to the installation of an ASTROPLAY pitch at Round Diamond Primary School in Hertfordshire. The project value was £150,000. There is no indication of when the installation took place in this exhibit, however, Mr Belles refers to the date in relation to exhibit AB38.

23) Exhibits AB31 and AB32 are pages downloaded from mcardle-astroturf.co.uk on 29 January 2010, they list projects undertaken by McArdle. ASTROTURF appears on both pages. Page 186 shows ASTROTURF hockey systems, which were installed in Reading and Slough in 2003, in Wrexham in 2003, and in Dublin and East Grinstead in 2005. The Slough and East Grinstead projects used ASTROGRASS. Page 188 is headed "AstroPlay® - Soccer & Rugby Surfaces". It shows the installation of surfaces for Manchester United and Sheffield United in 2002; for the University of Kent and Testwood Sports College (Southampton) in 2005; for Hull University and a school in Milton Keynes in 2006; for Preston College, the University of Brighton, Leesbrook Community Sports College in Derby and West Park Leeds in 2007. The system type is identified as ASTROPLAY for 5 of the projects. The other projects are identified as MXS 45, Profoot Final, Rugby Pro 65, Profoot Premier and Challenger 3G (Challenger appears to be a trade mark of Tiger Turf, see paragraph 17). AB33 is a page downloaded from mcardle-astroturf.co.uk on 29 January 2010 relating to the opening of an ASTROTURF pitch in Durham. There is no indication as to the date of the opening. AB34 is a page downloaded from mcardle-astroturf.co.uk on 29 January 2010 relating to the opening of an ASTROTURF pitch in Tameside, the official opening took place on 22 September but there is no indication as to which year. AB35 is a page downloaded from mcardle-astroturf.co.uk on 29 January 2010. It relates to football camps run at the Sheffield United Academy, it refers to the camps using ASTROPLAY pitches. AB36 is a page downloaded from mcardle-astroturf.co.uk on 29 January 2010 relating to the opening of an ASTROTURF pitch at Steyning Grammar School on 12 January 2007 by Sally Gunnell. AB37 is a page downloaded from mcardle-astroturf.co.uk on 29 January 2010 relating to the opening of an ASTROTURF hockey pitch in Wrexham. The reader is advised of a competition that is to take place in July 2007. AB38 is the same as page 183 of AB30; Mr Belles states that it was "published" in March 2007. AB39 is a page downloaded from mcardle-astroturf.co.uk on 29 January 2010 relating to the opening of an

ASTROTURF sand filled pitch at Chatham House Grammar School. There is no indication as to when the opening took place.

24) Mr Belles states that AB40 consists of photographs of an installed ASTROTURF product in East Grinstead. None of the trade marks of TMA appear in the photographs. AB41 consists of the specifications for ASTROLAWN 40. It is described as being designed for the leisure market. The pages bear the date January 2003.

25) Exhibited at AB42 are copies of purchase orders and invoices relating to the sale of ASTRO branded products by TMA to McArdle. Pages 210 – 225 and 245 - 251 all emanate from after the dates of application and publication. The details of the invoices exhibited at pages 226, 227, 230, 231, 232, 233, 234, 235, 236, 237, 238, 239, 240, 241, 242, 243, 244 are included in exhibit AB45. The transaction included in pages 229 and 230 bears the invoice number of 155530, this appears to be recorded in AB45 as invoice number 155526; it has the same date, is for the same amount and is for the same products. The purchase orders and invoices from prior to the date of publication show products being delivered to Aberdeen Sports Village, Peppermill Playing Fields in Edinburgh and Ball Packaging of Rugby.

26) Mr Belles states that since 1998 McArdle has consistently spent between £150,000 and £200,000 a year on marketing the ASTROTURF and other ASTRO brands in the United Kingdom. He states that McArdle has also entered into arrangements with Loughborough University and Imperial College to sponsor sports kit. Exhibited at AB43 is a photograph of a pair of shorts which bear the names ASTROTURF and McArdle. There is no indication as to when this sponsorship commenced. Mr Belles states that McArdle also exhibits products at trade shows and sporting events. AB44 is a copy of a photograph of a banner which was used by McArdle at trade shows and sporting events during 2009. ASTROTURF and McArdle appear at the top of the banner. Mr Belles states that in 2009, in conjunction with AstroTurf LLC, McArdle was a headline sponsor at the Independent Schools Bursars Association conference and ASTROTURF branding was featured at the exhibition stand. There is no indication as to when in 2009 this took place.

27) The revenue generated by sales of ASTRO branded products by TMA to McArdle during the period from February 2004 to October 2009 totalled nearly \$1,750,000. Mr Belles states that the sales of products by McArdle directly to end customers would have been significantly higher than this. Exhibited at AB45 is a schedule showing details of sales by TMA to McArdle of ASTRO branded products. The sales shown include sales made after the dates of application and publication. The details of sales made on or before 6 February 2009 are as follows:

Date	Product	Amount in \$US
4 October 2004	A0007 ASTROTURF 5012	222,515.51
25 October 2004	P0011	2,319.06
2 November 2004	G0007	106,493.20
22 June 2005	AS513 KNITTED 55OZ 13MM	67,703.28
30 June 2005	AS513 KNITTED 55OZ 13MM	65,750.28
29 April 2006	AXD55 ASTROTURF 55 OZ	226,541.40
4 August 2006	GXD38 ASTROGRASS	51,978.52
4 August 2006	GXD38 ASTROGRASS	52,997.76
4 August 2006	THRED SEWING THREAD	1,750.00
11 September 2006	GXD38 ASTROGRASS	4,416.48
9 March 2007	GXD38 ASTROGRASS	4,416.48 -
13 March 2007	TMINV TEXTILEMGMMISCINVE	
13 March 2007	TMINV TEXTILEMGMMISCINVE	1653.12
3 April 2008	AXD55 ASTROTURF 55OZ	7119.40
2 July 2008	A5012 AXB5012	85,994.10
2 July 2008	A5012 AXB5012	79,851.60
2 July 2008	A5012 AXB5012	92,609.40
22 July 2008	TL100 TEE LINE	7,678.48
29 July 2008	GXD38 ASTROGRASS	53,591.45
29 July 2008	GXD38 ASTROGRASS	51,167.50
5 August 2008	THRED SEWING THREAD	2,380.00
5 August 2008	THRED SEWING THREAD	2,380.00
15 September 2008	A5012 AXB5012	9,554.90
24 October 2008	A5012 AXB5012	9,554.90-
10 December 2008	GXD38 ASTROGRASS	53,591.45
11 December 2008	GXD38 ASTROGRASS	51,167.50

Mr Belles explains that products with codes beginning with a G are ASTROGRASS products and products with codes beginning with an A are ASTROTURF products. The entries for 9 March 2007 and 24 October 2008 appear to be re-imburements or refunds for the entries for 11 September 2006 and 15 September 2008. The highlighted dates indicate that invoices for these transactions can be found at AB42, all of these invoices bear the name ASTROTURF.

Witness statement of Mark Freeman

28) Mr Freeman is the contracts director of McArdle. He states that McArdle is the United Kingdom distributor of ASTROTURF and other ASTRO prefixed branded artificial turf products on behalf of AstroTurf LLC, a subsidiary of TMA.

29) McArdle is a civil engineering company that “focuses” in particular on sports construction. Since 1998 McArdle has had an agreement with Southwest Recreational Industries, Inc and subsequently AstroTurf LLC for the distribution of ASTROTURF and other ASTRO branded products in the United Kingdom. McArdle has sold ASTRO branded products to residential customers, schools, colleges, local authorities, sports clubs and parks. It has sold products to high profile customers in the United Kingdom sporting industry, including Manchester United.

30) Exhibited at MF1 is a copy of a McArdle brochure, which has also been exhibited at AB18. Again there is no indication as to from when this brochure emanates. Exhibited at MF2 are pages downloaded from macardle-astroturf.co.uk on 12 March 2010, so after the dates of publication and application.

31) Mr Freeman states that McArdle has used the brand ASTROLAWN for selling artificial turf products targeted at residential customers. Exhibited at MF3 is what Mr Freeman describes as a copy of a brochure advertising McArdle’s ASTROLAWN synthetic grass product. It is one page. There is no indication as to the date that the page was produced. Mr Freeman states that the “brochure” was first distributed to potential customers in the United Kingdom in 2000. Advertisements for ASTROLAWN were published in the newspapers *The Evening Advertiser* and *The Gazette and Herald*, local Wiltshire publications, on 21 November 2002. Exhibited at MF4 is a copy of an advertisement from *The Gazette and Herald* on 21 November 2002. The advertisement is for ASTROLAWN. It is described as “the newest product from the makers of AstroTurfAstroPlay and NeXturf™”. Exhibited at MF5 is a copy of a product specification for the ASTROLAWN 40 product, bearing the date of January 2003. ASTROLAWN 40 is described as “a revolutionary new synthetic grass system designed specifically for the leisure market segment”. Exhibited at MF6 is a copy of a schedule of prices sent to Blackford’s Contractors on 29 October 2002. Included in the schedule are prices for ASTROLAWN 40, ASTROLAWN seaming tape and ASTROLAWN rubber infill.

32) Mr Freeman states that McArdle spends between £150,000 and £200,000 a year marketing ASTRO branded products in the United Kingdom.

Material dates

33) In relation to the claim to reputation under section 5(3) of the Act the material date is the date of the application for registration, ie 3 September 2008. In relation to registration nos 902750, 955903, 1210103 and 2030369, TMA must establish that genuine use of the trade marks has been made between 7 February 2002 and 6 February 2009. A similar provision to section 5(4)(a) of the Act is to be found in Article 8(4) of Council Regulation 40/94 of December 20,1993. This was the subject of consideration by the General Court (GC) in

Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Joined Cases T-114/07 and T-115/07, in which the GC stated:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.”

The reasoning of the GC, *mutatis mutandis*, is followed in relation to the Act; so TMA must establish a protectable goodwill as of the date of application, ie 3 September 2008. As Mr Morgan has not furnished any evidence, no further dates have to be considered re the passing-off issue; eg there is no question of senior user or concurrent goodwill.

Findings of fact

34) To benefit from the provisions of section 5(3) of the Act the trade mark(s) must be known by a significant part of the public concerned by the products or services covered”. The Court of Justice of the European Union (CJEU) in *General Motors Corporation v Yplon SA* stated how a party would establish this reputation:

“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.”

In *PAGO International GmbH v Tirol Milch registrierte Genossenschaft mbH* Case C-302/07 the CJEU considered the requirements for establishing a reputation in respect of a Community trade mark:

“30 The answer to the first question referred is therefore that Article 9(1)(c) of the regulation must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, a Community trade mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of

the territory of the Community, and that, in view of the facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community.”

35) A fundamental problem with the evidence of TMA is that there is no indication of the size of the market in artificial grass, there is consequently no parameters in which to consider the sales of TMA’s products. There is no indication of the volume of sales of ASTROPLAY products. The number of sales and the scale of the sales shown at AB45 do not appear to be particularly large; although without any context into which place them it is impossible to say what they represent in the market. The products are primarily sold for non-domestic use, it would in this circumstance have been helpful to have had evidence from the trade as to the position of TMA and its trade marks. Exhibit AB10 shows that there are a number of undertakings who supply a number of artificial grass products under a number of trade marks and so the contextualisation of TMA’s position amongst the competitors would have been helpful.

36) A large part of the evidence furnished cannot be identified by date or is after the date of application and/or after the date of publication or emanates from before the five year use period. By far the best evidence is exhibited at AB45. The sales for the years 2004 to 2008 were:

2004	\$US 331,327	£180,917
2005	\$US 133,453	£73,404
2006	\$US 333,266	£181,143
2007	\$US 1,653	£826
2008	\$US 487,572	£265,682

(The sterling equivalents have been calculated using the average \$US £sterling interbank rate for each year, as calculated by Oanda. The rates given were:

2004: .54604;
2005: .55004;
2006: .54354;
2007: .49987;
2008: .54491.)

These figures exclude invoices for 11 September 2006 and 9 March 2007 and 15 September 2008 and 24 October 2008 which appear to cancel themselves out. The invoices for 12 October and 12 November 2008 emanate from after the date of application and so whilst they have relevance in relation to proof of use, they cannot have a bearing on the issues of reputation for the purposes of section 5(3) of the Act and the establishment of goodwill, for the purposes of passing-off. These two invoices, both for ASTROGRASS, amount to a total of \$US 104,758/£57,083.

37) The specifications exhibited at AB11 bear the trade marks ASTROTURF and ASTROPLAY. They relate to synthetic grass carpets for football and are dated 22, 24 and 28 August 2007. AB29 relates to the installation of an ASTROPLAY synthetic football pitch for the University of Kent, the project was completed prior to 22 August 2005; the inference from the document is that the work was completed in the vicinity of this date (this is in keeping with the contents of AB32). AB31 shows the installation of ASTROTURF hockey systems in 2005 and 2006 in West Sussex and Wrexham respectively. (It also shows the installation of an ASTROTURF hockey system in Dublin in 2005, which is of relevance to the Community trade mark registrations.) The West Sussex installation is described as using ASTROGRASS. AB32 is headed "AstroPlay® - Soccer & Rugby Surfaces". It shows the installation of surfaces; for the University of Kent and Testwood Sports College (Southampton) in 2005; for Hull University and a school in Milton Keynes in 2006; for Preston College, the University of Brighton, Leesbrook Community Sports College in Derby and West Park Leeds in 2007. The system type is identified as ASTROPLAY for 5 of the projects. The other projects are identified as MXS 45, Profoot Final, Rugby Pro 65, Profoot Premier and Challenger 3G. AB36 relates to the opening of an ASTROTURF pitch at Steyning Grammar School on 12 January 2007 by Sally Gunnell. The article relating to the ASTROPLAY pitch at Round Diamond Primary School in Hertfordshire, AB30 and AB38, emanates from March 2007.

38) As is the convention the trade marks relevant to these proceedings have been written in upper case. In many of the cases the format is for the ASTRO element to begin with a capital letter and then to be in lower case and the second element to begin with a capital and then to be in lower case eg AstroTurf. Mr Grimshaw did not raise any issue as to this form of use not supporting use of the trade marks as registered in block capitals or potentially supporting the claim for goodwill in relation to the signs that had been identified in block capitals. Owing to the clear delineation between the two elements of the trade marks, whether in upper case or in a mixture of upper and lower case, it is not considered that anything turns upon this matter.

39) As Mr Grimshaw pointed out at the hearing, there is an absence of detail of how McArdle spent its promotional budget. The promotional items that have been adduced are of a very limited nature.

40) ASTROTURF is clearly the primary trade mark of TMA, where ASTROPLAY and ASTROGRASS are used it is also often used. ASTROTURF appears upon all of the invoices.

41) TMA has strongly asserted the reputation of its trade marks. However, the evidence in support of this assertion has major deficiencies; in particular the absence of contextualisation of sales. It is quite possible that the market, for instance, for artificial grass for sports facilities has so few trade marks used and/or so few companies involved, that in this arena a producer will not have to

have a large turnover to be known by a significant part of the public concerned. However, the evidence shows that there are certainly a number of undertakings involved in supplying artificial playing surfaces for hockey. Section 5(3) of the Act gives exceptional rights to a trade mark owner, it is necessary for a party claiming such rights to put forward a strong case. The absence of particularisation and the absence of contextualisation in this case mean that TMA has not established that it has the requisite reputation in relation to any of the three trade marks upon which it relies under section 5(3) of the Act. **Consequently, the ground of opposition under section 5(3) is dismissed.**

42) Owing to the finding in relation to section 5(3) and the finding below in relation to section 5(2)(b) of the Act, it is not necessary to consider the proof of use issue. Ms Bowhill stated that the family of trade marks argument was only being run in relation to section 5(4)(a) of the Act and so this does not have an impact on section 5(2)(b) of the Act.

43) How goodwill is to be established has been dealt with in several judgmentsⁱⁱⁱ. *Phones 4u Ltd v Phone4u.co.uk. Internet Ltd* [2007] RPC 5 establishes that one cannot just follow a formula or demand certain predetermined requirements to be met. Prior to the date of application there had been use of the signs ASTROTURF, ASTROPLAY and ASTROGRASS in relation to artificial playing surfaces for sporting activities. There is no doubt that at the date of application TMA enjoyed a goodwill in relation to artificial playing surfaces for sporting activities by reference to these signs. In the evidence reference is made to use of ASTROLAWN by TMA, reliance upon this sign has not been pleaded and so cannot be taken into account. However, if it had been pleaded the evidence of use prior to the material date is so small and so distant that TMA could not rely upon it. There is no indication that there were ever any sales of this product and the evidence of advertising is limited to two advertisements in local papers in Wiltshire on 21 November 2002.

Section 5(2)(b) of the Act – likelihood of confusion

44) Owing to the nature of the trade mark and the breadth of the specification, if TMA cannot succeed in relation to Community registration no 3537107, it will not succeed in relation to the other trade marks upon which it relies. Consequently, it is not necessary to consider the proof of use of the other earlier trade mark registrations. Community registration on 3537107 is not subject to proof of use.

Average consumer, nature of purchasing decision and standard for likelihood of confusion

45) The average consumer “is deemed to be reasonably well informed and reasonably circumspect and observant”^{iv}. *Artificial grass*, whether for domestic or commercial use, will be purchased on a very occasional basis by end consumers and so is likely to be the subject of a careful purchasing decision. If purchased

by contractors, who are installing an artificial surface, the purchasing process is also likely to be careful and considered and also educated, the purchaser being a professional. Consequently, the effects of imperfect recollection will be limited. *Glue for joining artificial grass*, whether for domestic use or not, is a specialist product that will have particular properties and, so, the purchasing process is likely to be careful, limiting the effects of imperfect recollection. *Adhesive tape used for carpets* is not necessarily a specialist product and could be bought without a great deal of thought or care, this would be even more so in relation to such tape being *for use in a home*; consequently the scope for imperfect recollection is increased. It is to be noted that the evidence shows that artificial grass is referred to as grass synthetic carpets, see AB11, there is no evidence to indicate that such reference is atypical. So when the term carpet is considered, it must, in the context of this case, be interpreted as relating to the internal carpet and artificial playing surfaces. Consequently, adhesive tape for use in relation to carpet must be considered within this context. If the tape is limited to *for use in a home*, this consideration does not apply.

46) In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03 the General Court (GC) stated:

“49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

There is no indication that artificial grass and products in use in relation to it are generally available in DIY stores and the like. Such goods are likely to be bought from specialist distributors, this could be via the Internet, through a catalogue or equally by the telephone. Consequently, it is considered that aural and visual similarity have the same weight when considering the likelihood of confusion. *Adhesive tape used for carpets for use in a home* will normally be bought in a DIY store from a shelf and so visual similarity will be of greater importance than aural similarity.

Similarity of trade marks

47) The trade marks to be compared are:

ASTROLAWN

ASTROTURF

48) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details^v. 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 distinctive and dominant components^{vi}. Consequently, there cannot be an artificial dissection of the trade marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant^{vii}. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public^{viii}.

49) Mr Morgan's trade mark is in green. This does not have a bearing on the issue of similarity as TMA's trade mark is registered without regard to colour, therefore, the presence of colour in Mr Morgan's trade mark cannot create a significant difference, the matter must be assessed on the similarity between the respective words without regard to colour^{ix}.

50) The respective trade marks fall naturally fall into two parts ASTRO and LAWN and ASTRO and TURF. In relation to artificial grass products and goods used in relation to them, LAWN and TURF are clearly descriptive. ASTRO is neither allusive nor descriptive of the goods. The attention of the consumer is usually directed to the beginning of the word^x. Owing to the distinctiveness and dominance of the ASTRO element of the trade marks this rule of thumb holds in this case. ASTRO is the distinctive and dominant element of the respective trade marks.

51) The stylisation of Mr Morgan's trade mark is very limited, it is very much a word trade mark. The first two syllables of each mark are phonetically identical. The perception of the average consumer is likely to be fashioned by experience of the common prefix ASTRO and so visually the first two syllables are likely to be perceived and remembered as ASTRO, consequently they are visually highly similar. In the context of the trade marks in their entirety ASTRO had no clear meaning. In making a lawn turf or seeds can be used, consequently, there is a conceptual link between LAWN and TURF, even if the terms are not synonyms. Whilst bearing in mind the distinctive and dominant components in the respective trade marks, the comparisons have to be made on the basis of their trade marks

in their entirety. Despite the difference in the last syllable of each trade mark, the trade marks are visually and phonetically similar and there is a slight conceptual link. Conceptually, the respective trade marks are certainly not dissonant. **The respective trade marks are similar to a reasonable degree.**

Comparison of goods

52) In “construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade^{xii}”. Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaning^{xii}. Consideration should be given as to how the average consumer would view the goods or services^{xiii}. The class of the goods and services in which they are placed may be relevant in determining the nature of the goods^{xiv}. In assessing the similarity of goods it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary^{xv}. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06* the General Court (GC) explained when goods were complementary:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed^{xvi}.

53) *Artificial grass for use in domestic gardens; not including artificial grass for use in relation to sports pitches* is included in *artificial grass* at large of the earlier registration. **The respective goods are identical.**

54) *Artificial grass* is indispensable to *glue for joining artificial grass for use in domestic gardens* in such a way that a customer would think that responsibility for the goods lies with the same undertaking. The respective goods are complementary. The end user of both products is the person who wishes to lay artificial grass, and so is the same. The intended purpose of the respective goods is the same, to obtain an artificial grass surface. The respective goods are not in competition or of the same nature. Owing to the specialist nature of the

goods they are likely to use the same channels of trade. **The respective goods are similar to a high degree.**

55) The specification of the Community trade mark includes *floor coverings* and *synthetic carpets*, which includes carpets for use in the home. *Carpets* are indispensable to *adhesive tape used for carpets* (whether qualified *for use in a home* or not) in such a way that a customer would think that responsibility for the goods lies with the same undertaking. The respective goods are complementary. The end user of both products is the person who wishes to lay carpet. The intended purpose of the respective goods is to provide a carpeted surface. The respective goods are not in competition or of the same nature. **The respective goods are similar to a reasonable degree.**

Conclusion

56) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa^{xvii}. In this case the trade marks are similar to a reasonable degree. The respective goods are identical, similar to a high degree and similar to a reasonable degree. In considering the likelihood of confusion it is also to be noted that the respective trade marks are formed in the same manner. They commence with the distinctive two syllable element ASTRO and end with a one syllable word that relates to some aspect of grass.

57) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion^{xviii}. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public^{xix}. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings^{xx}. Owing to the ASTRO element, which is the dominant and distinctive component of TMA's trade mark, TMA's trade mark has a greater capacity to identify the goods of the registration. The inadequacies of the evidence mean that TMA is not in a position to pray in aid a reputation to enhance the distinctiveness.

58) In his submissions Mr Grimshaw referred to TMA trying to monopolise the prefix astro. In relation to section 5(2)(b), Ms Bowhill did not pray in aid a family of trade marks so there is no claim to monopolise the astro element. The decision on the respective trade marks is made on the basis of a trade mark to trade mark, goods to goods comparison. The average consumer, whether a retail customer or a contractor, would believe that the goods of the application

emanate from the same or economically linked undertaking^{xxi}. **There is a likelihood of confusion and the application is to be refused in its entirety.**

Section 5(4)(a) of the Act – passing-off

59) It has been decided that at the date of application TMA enjoyed a goodwill in relation to artificial playing surfaces for sporting activities by reference to the signs ASTROTURF, ASTROPLAY and ASTROGRASS. This goodwill in particular relates to artificial grass. ASTROPLAY and ASTROGRASS are identified with ASTROTURF. The relevant consumer will be aware that all three signs relate to the same undertaking. TMA has a family of trade marks which is formed by ASTRO being followed by descriptive one syllable word. The relevant customer encountering Mr Morgan's trade mark in relation to artificial grass products or goods related to them will believe that the goods emanate from TMA, consequently, there will be a misrepresentation. Damage in passing-off can take a number of forms. In this case taking into account the reputation of the earlier signs and the respective goods and services damage is likely to occur:

- by the injury which is inherently likely to be suffered by any business when on frequent occasions it is confused by customers or potential customers with a business owned by another proprietor or is wrongly regarded as being connected with that business;
- the erosion of the distinctiveness of TMA's signs.

If the class 17 goods were limited to *adhesive tape used for carpets, for use in a home* owing to the distance between the respective goods and the channels of trade there would be neither misrepresentation nor damage. However, these goods, with or without the qualification, have been refused under section 5(2)(b) of the Act.

60) The application is refused in its entirety under section 5(4)(a) of the Act, with the proviso in relation to the class 17 goods.

Costs

TMA having been successful it is entitled to a contribution towards its costs. It is taken into account that a lot of TMA's evidence was ill focused in relation to both jurisdiction and date. Costs are awarded on the following basis:

Opposition fee:	£200
Preparing a statement and considering the other side's statement:	£500
Preparing evidence:	£300

Preparation for and attendance at a

hearing:	£1,000
Total	£2,000

Mr Steven Morgan is to pay Textile Management Associates, Inc the sum of £2,000. This sum is 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 6 day of January 2011

**David Landau
For the Registrar
the Comptroller-General**

ⁱ Section 6A of the Act reads:

“(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Under Section 100 of the Act the onus is upon the proprietor of the earlier trade mark(s) to show genuine use:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

ⁱⁱ *General Motors Corporation v Yplon SA* Case C-375/97.

ⁱⁱⁱ *South Cone Inc v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19, *Loaded BL O/191/02, Phones 4u Ltd v Phone4u.co.uk. Internet Ltd* [2007] RPC 5 and *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat).

^{iv} *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* Case C-342/97.

^v *Sabel BV v Puma AG* Case C-251/95.

^{vi} *Sabel BV v Puma AG* Case C-251/95.

^{vii} *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97.

^{viii} *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

^{ix} *Mary Quant Cosmetics Japan Ltd v Able C & C Co Ltd* BL O/246/08 Mr Geoffrey Hobbs QC, sitting as the appointed person:

“10. The present oppositions under Section 5(2)(b) are based on the rights conferred by registration of a device mark recorded in the register in black-and-white. It follows that colouring is immaterial to the distinctiveness of the Opponent’s device mark as registered and therefore irrelevant for the purposes of the assessment of similarity in both oppositions.”

^x *Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-336/03:

“75 It should be noted in this regard that the attention of the consumer is usually directed to the beginning of the word (Joined Cases T-183/02 and T-184/02 *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II-0000, paragraph 83).”

^{xi} *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

^{xii} *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

^{xiii} *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use”

^{xiv} *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

^{xv} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc Case C-39/97*.

^{xvi} He considered that the following should be taken into account when assessing the similarity of goods and/or services:

(a) The respective uses of the respective goods or services;
(b) The respective users of the respective goods or services;
(c) The physical nature of the goods or acts of service;
(d) The respective trade channels through which the goods or services reach the market;
(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

^{xvii} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc Case C-39/97*.

^{xviii} *Sabel BV v Puma AG Case C-251/95*.

^{xix} *Rewe Zentral AG v OHIM (LITE) Case T-79/00*.

^{xx} *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97.

^{xxi} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc Case C-39/97*.