

**O-428-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF DECISIONS  
O/415/17 AND O/630/17**

**IN RESPECT OF REGISTRATION NO. 3083440**

**IN THE NAME OF**

**FARM AND GARDEN MACHINERY LIMITED**

**FOR THE TRADE MARK**

**HARRY**

**IN CLASS 7**

**AND**

**AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO**

**UNDER NO. 500877**

**BY GREEN & GREEN S.A.**

## SUPPLEMENTARY DECISION

1. On 6 September 2017, I issued a decision (O/415/17) in which I found in favour of Green & Green S.A. (“the Applicant”) in its application, under section 47 of the Trade Marks Act 1994 (“the Act”), for a declaration of invalidity against the UK trade mark “HARRY” registered under No. 308440 by Farm and Garden Machinery Limited (“the Registered Proprietor”) for goods in class 7.
2. The Applicant owns an earlier identical mark, being an international trade mark registration (“IR” No. 1232089) which designates the European Union, based on the priority of a Swiss trade mark (No. 664357). Relying on that earlier mark, I found that the Applicant succeeded in its claim for a declaration of invalidity on the basis of section 5(1) and 5(2)(a) of the Act. However, that earlier mark itself faced a challenge before the EUIPO<sup>1</sup> filed by the Registered Proprietor on 20 October 2015. Consequently, my finding of the Applicant’s success on the basis of sections 5(1) and 5(2)(a) was provisional pending the outcome of that opposition at the EUIPO.
3. My decision (O/415/17) therefore also dealt with the Applicant’s claim under section 3(6) of the Act, which, being an absolute ground, was not contingent on an earlier mark. However, in view of an administrative error that resulted in my not having before me certain submissions filed by the Registered Proprietor, I published a supplementary decision on 7 December 2017 (O-630-17) to set aside the outcome of the section 3(6) claim.
4. The provisional decision in O/415/17 remained in place in so far as it related to section 5 of the Act. The supplementary decision (O/630/17) explained that if the Registered Proprietor failed at the EUIPO in its opposition to the Applicant’s IR designating the EU, then the Applicant would clearly have a valid earlier mark. In that event the UK Registry would confirm its provisional decision on the section 5 ground and invalidate the UK trade mark in question.
5. On 9 July 2018, the Applicant’s legal representatives wrote to the Registry (with copy to the Opponent) relaying the relevant decision of the EUIPO Opposition

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<sup>1</sup> The European Union Intellectual Property Office, which deals with applications for protection of trade mark rights on a unitary basis in all EU Member States.

Division dated 5 July 2018 in relation to EUIPO Opposition No. B 596 966. The key part of that EUIPO decision states as follows:

*“[the Applicant’s] contested international registration designating the European Union No 1 232 089 has an international registration date of 08/10/2014, which, even without taking into account the right of priority claimed, is earlier than the filing date of the opposing trade mark (27/11/2014). The extract containing the details of United Kingdom trade mark registration No 3 083 440 does not contain any indications (e.g. claim of priority) to the contrary.*

*Consequently, the right on which the opposition is based is not earlier within the meaning of Article 8(2) EUTMR.*

*[...]*

*The opposition must therefore be rejected as unfounded.”*

6. Costs were awarded.

## **OUTCOME**

7. In view of the above finding by the EUIPO, I now confirm my decision of 6 September 2017 (O/415/17) on the basis of the section 5 grounds and **the Registered Proprietor’s UK trade mark under registration number 3083440 is therefore declared invalid in its entirety and is deemed never to have been made.** It will consequently be cancelled as from its date of application (27 November 2014).

## **COSTS**

8. In their letter of 9 July 2018 the Applicant’s legal representatives asked that the Registry consider revising the award of costs to the Applicant, on the basis that the Registered Proprietor and/or its advisers knew at all times that the trade mark on which it relied in its opposition against the Applicant’s IR designating the EU was not an earlier trade mark - as confirmed by the EUIPO in its decision.
9. It is the Applicant’s position that the Registered Proprietor and its representatives deliberately prolonged these proceedings, thereby putting the Applicant to additional expense by needlessly challenging my original decision of 6th September 2017. It

is submitted in the letter that the Proprietor's representatives have the knowledge and expertise to have realised that the opposition proceedings against the Applicant's IR designation of the EU would ultimately never succeed due to the fact that it was based on a later mark. The letter describes the Registered Proprietor's opposition at the EUIPO as "frivolous and vexatious" and "*a blatant abuse of process which had financial knock on consequences for the Applicant in these proceedings. In the circumstances, the Registered Proprietor could have withdrawn its opposition against the Applicant's EUTM earlier and saved the Applicant considerable expense and further delay in these proceedings.*"

10. While I understand the Applicant's frustration at the delay caused by a fundamentally flawed opposition against its earlier mark, I do not consider it appropriate, on the basis of an opposition before another Registry, to upwardly revise the costs that I awarded to the Applicant in my initial decision (O/415/17). This is because the Applicant's complaint is mainly directed at the proprietor's actions before the EUIPO. It is not appropriate to cover that matter in the costs awarded in these UKIPO proceedings. To the extent that it is suggested that the EUIPO proceedings were a delaying tactic in these proceedings which was bound to fail, I note that both sides are legally represented and it would have been open to either party to point out or acknowledge that the opposition at the EUIPO was unfounded. I therefore consider it appropriate to maintain the original provisional costs award, despite the setting aside of the bad faith decision. **I therefore repeat the contributory award of costs in favour of the Applicant** based upon the scale published in Tribunal Practice Notice 2/2016. The award breakdown is as follows:

Official fee for Form TM26(I)	£200
Preparing a statement and considering the other side's counterstatement	£200
Preparation of evidence and considering and commenting on the other side's evidence	£1000
Preparation of submissions in lieu of oral hearing	£300
<b>Total</b>	<b>£1700</b>

11. I order Farm and Garden Machinery Limited to pay Green & Green S.A. the sum of £1700 (one thousand seven hundred pounds) which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

**Dated this 16<sup>th</sup> day of July 2018**

*Matthew Williams*

**For the Registrar**

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