

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK
APPLICATION m 2001945 BY K & F INTERNATIONAL
TO REGISTER THE MARK

Royal  Botania

AND

IN THE MATTER OF OPPOSITION
THERE TO UNDER OPPOSITION m 43061
BY RBG KEW ENTERPRISES LTD

TRADE MARKS ACT 1994

IN THE MATTER of trade mark
application m 2001945 by +
K & F International

5 and

IN THE MATTER OF opposition
thereto under opposition m 43061
by RBG Kew Enterprises Ltd

DECISION

10 K & F International (hereafter “K & F”) applied on 15 November 1994 to register the mark shown below in class 20 in respect of “Furniture, Garden furniture”.



The application is opposed by RBG Kew Enterprises Ltd. I summarise the grounds of opposition as follows:

- 15 Ž The opponent claims that the mark should be refused under section 3(5) because it falsely implies that the applicant has, or has recently had, Royal patronage.
- Ž The mark in question is similar to the opponent’s registered trade marks. Because of the likelihood of confusion on the part of the public, the application should be refused under section 5(2).
- 20 Ž Having regard to the opponent’s reputation in their mark in the United Kingdom, use of the applicant’s mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of their mark. Consequently the application should be refused under section 5(3).
- 25 Ž The opponent further claims to have a sufficient reputation in their trade mark, ROYAL BOTANIC GARDENS KEW, to be able to prevent the applicant from using the mark by virtue of the law of passing off. This ground goes to section 5(4).
- 30 Ž It is also alleged that the opponent’s use of the mark entitles them to protection under the Paris Convention as a well known trade mark. As such, their mark is said to be an earlier trade mark as defined in section 6(1)(c), and therefore registration should be refused under section 5.

Ž Finally, the opponent contends that the adoption of this mark is an attempt to capitalise on the reputation and goodwill which the opponent has established in their mark ROYAL BOTANIC GARDENS KEW, and that the application ought to be refused under section 3(6) on the grounds that it was made in bad faith.

5 The relevant details of the opponent's registered marks are as follows:-

<u>No</u>	<u>Class</u>	<u>Jrnl/Pge</u>	<u>Goods</u>
1511300	3	5999/6941	Perfumery; soaps; essential oils; cosmetics; hair lotions; all included in Class 3.
1511301	8	6001/7257	Hand tools and implements (hand operated); garden tools; all included in Class 8.
1511302	16	5999/6985	Stationery; printed matter; printed publications; calendars; diaries; notebooks; notepaper; address books; writing books; writing implements and containers; writing paper; postcards; greeting cards; packaging bags; wrapping paper; all included in Class 16.
10 1511303	21	6101/9873	Glassware; porcelain and earthenware; tableware; all included in Class 21.
1511304	24	6101/9875	Fabrics and textile piece goods; table linen; cloths; household linen; bath linen; bed linen; curtains; textile place mats; textile serviettes; table cloths (not of paper); textile wall hangings; all included in Class 24.
1511305	31	6002/7498	Seeds; seedlings; bulbs; plants; flowers; shrubs; bushes; trees; all included in Class 31.

In each of these registrations, the mark is as shown below:

ROYAL
BOTANIC
GARDENS
KEW

15 In response, the applicant filed a counterstatement admitting the existence of the opponent's prior registrations, but denying each of the grounds pleaded.

Both parties seek an award of costs in their favour.

Both parties also filed evidence in these proceedings, and agreed that the Registrar should make his decision on the basis of the written evidence without the need for a hearing. Acting on the Registrar's behalf and after a careful study of the papers, I now give this decision.

Opponent's Evidence

5 This comprises two statutory declarations; one by Christine Brindle, the Managing Director of RBG Kew Enterprises Ltd, and another by Timothy George Pendered, the Registered Trade Mark Agent acting for the opponent in these proceedings. Both declarations are dated 10 October 1996.

10 Ms Brindle states that RBG Kew Enterprises Ltd was set up in 1993 and is a wholly owned subsidiary of the Royal Botanic Gardens, Kew. Nothing turns on the relationship between the parent company and its subsidiary; hereafter I shall refer to them both simply as RBG Kew. According to Ms Brindle, Kew has been the site of a botanical garden since 1759 when Augusta, Dowager Princess of Wales and mother of George III laid out part of her estate. The botanic gardens were developed and extended until they were handed over to the state in 15 1840. They have historically been known as the Royal Botanic Gardens because they were originally Royal Gardens.

RBG Kew acts as a centre for research and a repository for information about plants. It holds the largest and most diverse collection of living plants and the most comprehensive research collection of plant material in the world. The gardens at Kew have been open to the public since 1840 and are visited each year by up to a million people from the United Kingdom and 20 overseas. RBG Kew regularly publishes a range of material including research papers, information on plant species and articles on matters affecting the plant world. A bundle of such material is exhibited at CB1 to Ms Brindle's declaration.

25 Also exhibited to Ms Brindle's declaration are a wide range of brochures and leaflets promoting the gardens and advertising the various projects and sponsorships which RBG Kew has undertaken.

Ms Brindle says that there has been a shop at Kew since the 1970's selling a range of goods, mainly souvenirs, stationery, books, household items and toiletries which are branded with the trade mark ROYAL BOTANIC GARDENS KEW. These branded products are also sold 30 through a number of retail outlets, eg WH Smith, John Lewis, House of Frazer, Thresher, McKenzie, Cafe Bean, Fowlers, Dillons, Blackwell.

RBG Kew has featured in a number of television and radio programmes, has staged numerous events and received official visits from members of the Royal Family on many occasions. Ms Brindle goes on to list some of these events in detail, but I see no need to refer to each of 35 them, or the exhibits that support them, in detail. It is clear to me, on the basis of the evidence before me, that RBG Kew has a significant reputation in its field and among the wider public.

Finally, Ms Brindle declares that RBG Kew has historically endorsed certain products. She provides as examples, a weed control product called Plantex to which RBG Kew lent its name and support in 1993. More recently, RBG Kew has endorsed a product called Seramis which

is an environmentally sound alternative growing system for indoor plants. Ms Brindle fears that use of the applicant's mark, Royal Botania will be detrimental to RBG KEW because it will detract from the distinctiveness of the name and mark ROYAL BOTANIC GARDENS KEW. In particular she suggests that the public may wrongly assume that RBG Kew has endorsed the applicant's garden furniture products. According to Ms Brindle, such confusion may arise because of the renown of the name and mark ROYAL BOTANICGARDENSKEW in relation to plants and gardens. Moreover, if the mark is used on goods of inferior quality, or goods which are in some other way incompatible with the aims of RBG Kew (eg if they are not made from sustainable sources of wood), then RBG Kew's reputation could be damaged.

Mr Pendered's evidence concerns a survey of forty three (43) individuals who were selected because of their particular knowledge of horticulture, gardens and/or retailing. In response to his letters, Mr Pendered received twenty five (25) completed questionnaires, copies of which are exhibited to his declaration. Of those who completed questionnaires, seventeen (17) were of the view that use of the applicant's mark would be likely to cause some confusion or association with RBG Kew, eight (8) thought that no confusion was likely to occur. Three(3) of those who replied declined to express an opinion on this point. Four (4) of the respondents agreed to confirm their views in a formal declaration, and these declarations are exhibited to Mr Pendered's declaration. On the basis of this survey, Mr Pendered submits that RBG Kew is well known and held in high regard, and that use of the applicant's mark in relation to furniture would give rise to a significant risk of confusion or association with RBG Kew.

Applicant's Evidence

This also comprises two statutory declarations; one by Kris Van Puyvelde, a Director of K & F, and another by Teresa Anne Bucks, a Registered Trade Mark Agent at the firm of Boulton Wade Tennant who act for the applicant in these proceedings.

In his declaration, dated 9 May 1997, Mr Van Puyvelde says that the mark in suit was first used by K & F (his company) in the United Kingdom in 1994 in relation to "furniture, garden furniture", and has been used continuously in relation to the goods in the United Kingdom since that date. He exhibits (at KVP1) a catalogue showing how the trade mark is used in relation to the goods. He says that the mark is printed on a brass and enamel plate which is screwed onto each piece of furniture produced by the applicant.

Mr Van Puyvelde provides the following turnover figures for the years 1994-1996:

Year	Turnover (£)
1994	49, 382
1995	69, 135
1996	99, 382

K & F's products bearing the Royal Botania mark are distributed in the United Kingdom by a local distributor, Indian Ocean Trading (155-163 Balham Hill, London).

5 Mr Van Puyvelde says that he is not familiar with Kew Gardens or the Royal Botanic Gardens, and neither is he aware of any confusion having arisen as a result of his company's use of the mark in suit. He concludes by saying that his company adopted the mark because ROYAL is an indication that the goods sold under the mark are good quality products, and BOTANIA is suggestive (though not, according to Mr Van Puyvelde, descriptive) of things for use in the garden, eg garden furniture. He submits that the distinctiveness of the mark comes from the whole combination of the crown logo and the special lettering in conjunction with the words.

10 Ms Bucks' evidence (dated 13 May 1997) concerns the results of a survey she conducted herself, some research into the subject of botanical gardens conducted on her behalf by a trainee assistant, and a trade mark search report prepared by the search department of Boulton Wade Tennant.

15 Taking these items in order, the survey comprised a total of fifteen (15) questionnaires circulated to members of staff employed at Boulton Wade Tennant. Ms Bucks says she chose a mix of secretaries, clerical staff and trainee patent agents. According to Ms Bucks, the survey shows that nearly everyone knows the opponent's gardens at Kew as "Kew Gardens", and not as "Royal Botanic Gardens, Kew".

20 Ms Bucks' account of the research conducted by her trainee assistant appears to me to be entirely hearsay, although the opponent has not objected to it. It concerns a visit to the Royal Horticultural Society's library, and a book found there entitled 'The Collins Guide to the Botanical Gardens of Britain'. Copies of the relevant pages of this guide are exhibited to Ms Bucks' declaration. The applicant relies upon this evidence to support two particular facts. Firstly, at least twenty two (22) gardens (apart from the gardens at Kew) call themselves
25 ROYAL, or BOTANICAL, or BOTANIC gardens. Secondly, whilst Kew Gardens is one of the better known botanic gardens, it is not the oldest. That honour goes to the Oxford University Botanic Garden which was founded in the early seventeenth century. The second oldest is apparently the Royal Botanic Garden in Edinburgh; the Royal Botanic Gardens, Kew being the third oldest in the Kingdom.

30 The trade mark search report relates to a search of all trade mark applications and registrations containing words having the prefix BOTANIC. The report is exhibited at TAB3 to Ms Bucks' declaration. As she points out, the list includes a registration of the mark BOTANICAL GARDEN in the name of the British Soap Company Ltd (for goods in class 3),
35 and a series of registrations containing the words BOTANIC GARDEN in the name of Portmeirion Potteries Ltd (for a variety of tableware and culinary utensils).

Opponent's Evidence in Reply

The opponent filed a further two declarations in reply to the applicant's evidence. A second declaration from Timothy George Pendered, and a declaration from Robert Lionel Cook. Both declarations are dated 13 October 1997.

Mr Pendered's second declaration relates primarily to a survey comprising eleven (11) questionnaires distributed among various members of staff at his firm (R G C Jenkins & Co). In essence, the subjects of this survey were asked whether they knew of a Royal Botanic Garden. If they did, they were asked to state its name. Most responded with the name Kew, or Kew Gardens. None of those included in the survey knew of any other Royal Botanic Gardens.

Not surprisingly, Mr Pendered is critical of the applicant's evidence. In particular he regards the overall sales indicated by Mr Puyvelde as "de minimis", and questions how he (Mr Puyvelde) would have become aware if a member of the public had purchased some of the applicant's furniture in the mistaken belief that it was in some way connected with the opponent. Consequently, in Mr Pendered's view, the applicant's evidence does not prove that there has been no confusion to date; neither does it show that there would not in fact be a likelihood of confusion if the applicant continues to use the mark. As Mr Pendered puts it,

".... they have failed to discharge their onus of showing that there would not in fact be a likelihood of confusion with RBG Kew's name and mark"

Mr Cook's Evidence

Mr Cook is an independent consultant. His declaration exhibits two reports concerning investigations he conducted into the activities of K & F, specifically as to any use by them of the mark in suit in the United Kingdom in relation to furniture. His first report is dated 10 January 1996, and confirms that the applicant has sold garden furniture in the United Kingdom through an agent - Indian Ocean Trading Company. The first delivery of stock, two large containers of various items of garden furniture, was shipped in 1995. In the course of his enquiries, Mr Cook spoke to a partner at the Indian Ocean Trading Company who later sent him a brochure and price list. Copies of these documents are appended to Mr Cook's report, but as he points out, they contain no reference to ROYAL BOTANIA products. Finally, Mr Cook notes that the Indian Ocean Trading Company did not know whether they would be receiving any fresh supplies from the applicant in 1996.

Mr Cook's second report concerns some follow-up investigations he made at the premises of the Indian Ocean Trading Company. In short, he spoke to staff at two of the company's premises (London & Chester), and also visited the London address which he describes as a very large retail unit displaying dozens of different pieces of high quality hardwood garden furniture. His report states that none of the showroom stock he examined bore any reference to ROYAL BOTANIA, and when he spoke to staff (firstly at London and later at Chester) they replied that they did not sell any furniture bearing the name ROYAL BOTANIA.

That completes my review of the evidence filed in these proceedings.

Section 3(5)

I shall begin by considering the opposition under section 3(5). The section reads:

"(5) A trade mark shall not be registered in the cases specified, or referred to, in section 4 (specially protected emblems)."

The only part of section 4 which appears to be relevant in the particular circumstances of this case is subsection (1) which reads:

“4. (1) A trade mark which consists of or contains—

5 (a) the Royal arms, or any of the principal armorial bearings of the Royal arms, or any insignia or device so nearly resembling the Royal arms or any such armorial bearing as to be likely to be mistaken for them or it,

(b) a representation of the Royal crown or any of the Royal flags,

(c) a representation of Her Majesty or any member of the Royal family, or any colourable imitation thereof, or

10 (d) words, letters or devices likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation,

shall not be registered unless it appears to the registrar that consent has been given by or on behalf of Her Majesty or, as the case may be, the relevant member of the Royal family.”

15 The Notice of Opposition does not clearly indicate which part of section 4 the opponent relies upon in relation to this ground of opposition. Nevertheless, the language used by the opponent corresponds with that used in subsection (1)(d), and since this seems to me to be the only pertinent part of the section, I propose to deal with this ground under that section alone - ie section 4(1)(d).

20 The Registrar’s practice in relation to section 4 is set out in the addendum to chapter 6 of the registry’s Work Manual. The passage concerning use of the word ROYAL is at page 75:

ROYAL

25 Section 4 relates to the use of any words, in such a manner as to be likely to lead persons to think that the applicant either has or recently has had Royal Patronage or authorization. In the ROYAL Case (1961 RPC 84) authority was given for objecting to ROYAL as a laudatory and descriptive term under Sections 3(1) and 3(5). The question of raising an objection under Section 3(5) might only arise when the evidence of use is considered. In particular cases objection under Section 3(3) might also arise. The practice to be adopted when considering ROYAL marks is:

30 (a) ROYAL alone and closely similar words, e.g. ROYALE, are open to objection prima facie and should only be registered upon evidence of distinctiveness.

(b) ROYAL in combination with words which give the mark a meaning which does not imply Royal Patronage, e.g. ROYAL STAG, ROYAL FLUSH, can be accepted prima facie.

35 (c) ROYAL in combination with another registrable word or device, e.g. RAYBURN ROYAL or ROYAL HARTEX, can be accepted.

(d) ROYAL in combination with a descriptive word, surname or other unregistrable term or device would, in totality, be objected to prima facie, e.g. ROYAL FOAM for foamed plastics materials or ROYAL MCLEOD for whisky.

40 (e) ROYAL in combination with a word which implies royal patronage should be objected to Section 3(5) and Section 3(3), apart from other sections of the Act,

e.g. ROYAL BALMORAL for any goods or services and ROYAL CHEF for foodstuffs, suggesting that the goods were used by the Royal Household Chefs.

- 5 (f) ROYAL in combination with a geographical name is often used, and is therefore devoid of any distinctive character in respect of tableware, especially china and glass. Such marks can be accepted on evidence of use.

In my view, the mark in suit most closely matches the category described in paragraph (c) above. That is, the word ROYAL in combination with another registrable word or device. Although in this case the word ROYAL appears in combination with both a word
10 (BOTANIA) and a device, the device is chiefly a crown and does not (of itself) add much to the distinctiveness of the word ROYAL. Nevertheless, BOTANIA does appear to be an invented word and even though it is only one letter away from BOTANIC, the combination would appear to be acceptable in view of registry practice as stated in the Work Manual (above). The opposition under section 3(5) fails accordingly.

15 *Section 5(2)*

Whereas above I considered the registrability of the applicant's mark in absolute terms and concluded that persons seeing the mark would not be misled into thinking that the applicant enjoys Royal patronage, under section 5(2) the question to be determined is whether there is a likelihood that the public might think the applicant's goods are in some way associated with
20 the opponent, RBG Kew.

Firstly, there can be no doubt that the mark in suit is not identical to the opponent's marks, and thus I need only consider sub-paragraph (b) of section 5(2).

Section 5(2)(b) reads:

- 25 “(2) A trade mark shall not be registered if because -
(a)
(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.”

30 I begin by comparing the goods in respect of which these marks are registered and proposed for registration. Guidance on how this comparison should be made is to be found in the “Treat” case¹. At page 294 and line 20, Jacob J says:

- “The questions arising under section 10(2)(a) are:
(1) Is the mark used in the course of trade?
35 (2) Are the goods for which it is used similar to those covered by the registration?
(3) Is there a likelihood of confusion because of that similarity?”

¹British Sugar PLC v James Robertson & Sons Ltd [1996] RPC 281

5 The first of these questions causes no difficulty here. The problems arise under the second and third questions. British Sugar seek to elide the questions of confusion and similarity. Their skeleton argument contends that there is “use in relation to a product so similar to a dessert sauce that there exists a likelihood of confusion because the product may or will be used for identical purposes.” I do not think it is legitimate to elide the question in this way. The sub-section does not merely ask “will there be confusion?”: it asks “is there similarity of goods?”, if so, “is there a likelihood of confusion?” The point is important. For if one elides the two questions then a “strong” mark would get protection for a greater range of goods than a “weak” mark. For instance “Kodak” for socks or bicycles might well cause confusion, yet these goods are plainly dissimilar from films or cameras. I think the question of similarity of goods is wholly independent of the particular mark the subject of registration or the defendant’s sign.”

For any who wish to pursue this further, I will simply note that Mr Justice Jacob goes on to show how this approach would appear to be supported by the recitals to the trade marks Directive².

15 I note also that in the “Treat” case Jacob J was concerned with infringement provisions under section 10(2), whereas I am considering registrability under section 5(2), and that he had already concluded that the marks involved were identical - thus he was applying paragraph(a) of section 10(2), and I am applying paragraph (b) of section 5(2). Nevertheless, the language used in these separate provisions is essentially the same, and the question to be determined in each case is the same - that is to say, are the goods similar to those for which the earlier trade mark is registered.

25 The only fundamental difference between the approach adopted by Jacob J in the “Treat” case and the appropriate approach under section 5(2) is that here I am not concerned whether or not the mark has been used in the course of trade. This was Jacob J’s first question, but it clearly does not matter under section 5(2).

I therefore approach the question of similarity of goods - Jacob J’s second question - without having regard to either the mark in suit or the opponent’s marks. As regards this question, Jacob J says, at page 296 line 25:

30 “I think the sort of considerations the court must have in mind are similar to those arising under the old Act in relation to goods of the same description. I do not say this because I believe there is any intention to take over the conception directly. There plainly is not. But the purpose of the conception in the old Act was to prevent marks from conflicting not only for the irrespective actual goods but for a penumbra also. And the purpose of similar goods in the Directive and Act is to provide protection and separation for a similar sort of penumbra. Thus I think the following factors must be relevant in considering whether there is or is not similarity:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;

²Council Directive m 89/104/EEC of 21st December 1988 to approximate the laws of the Member States relating to trade marks.

- (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 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 good 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 of industry, put the good or services in the same or different sectors.

This is rather an elaboration on the old judicial test for goods of the same description¹⁷. It seeks to take account of present day marketing methods. I do not see any reason in principle why, in some cases, goods should not be similar to services (a service of repair might well be similar to the goods repaired, for instance). I do not pretend that this list can provide other than general guidance. The fact is that the Directive and hence our Act have introduced an area of uncertainty into the scope of registration which in many cases can only be resolved by litigation.”

Footnote reference

¹⁷ See per Romer J. in *Jellinek's Application* (1946) 63 R.P.C. at p.70, approved by the House of Lords in *DAIQUIRI RUM Trade Mark* (1969) R.P.C. 600 at page 620.

The applicant seeks registration of his mark in respect of furniture and garden furniture in class 20. The opponent's registrations cover, inter alia, garden tools (class 8), tableware (class 21) in addition to seeds, flowers, plants, shrubs, bushes and trees in class 31. Taking the factors one by one, I see no *substantial* connection between the respective **uses** of the goods, other than that garden tools and garden furniture may both be used in the garden, and tableware would generally be used on furniture (eg tables). As for the respective **users**, again the only area of overlap would appear to be that proportion of the gardening public who take time to sit back and enjoy the fruits of their horticultural labours. The physical nature of the goods are, in my view, quite different, although the respective trade channels through which the goods reach the market are potentially the same. I am aware from my own knowledge and experience that garden furniture is often sold in garden centres (and some DIY superstores) where plants and bushes etc are also stocked - though these items would not usually be found on the same shelf. Finally, I do not see that the respective goods could be described as competing with each other in any way.

Taking all these factors set out in the “Treat” test quoted above, into account, I find no similarity between the goods covered by the opponent's registrations and those proposed for registration by the applicant. The opposition under section 5(2)(b) fails accordingly.

Section 5(3)

I turn now to the opposition under section 5(3), which reads:

“(3) A trade mark which

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

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

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, 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.”

I have already decided in relation to section 5(2) that the goods at issue are not similar, and neither are the two marks identical. Consequently I now have to decide whether the applicant's mark is similar to the opponent's mark. If it is, (and only if it is) I must go on to consider whether the opponent's mark has a reputation in the United Kingdom, and if so, what is the extent of that reputation.

With this in mind, I turn to the approach to be adopted when considering similarity of marks in relation to section 10 which was set out by Jacob J in *Origins Natural Resources Inc. v Origin Clothing Limited* [1995] FSR 280, in which he said:-

‘section 10 of the Trade Marks Act presupposes that the plaintiff's mark is in use or will come into use. It requires the court to assume the mark of the plaintiff is used in a normal and fair manner in relation to the goods for which it is registered and then to assess the likelihood of confusion in relation to the way the defendant uses its mark, discounting external added matter or circumstances. The comparison is mark for mark.’

Laddie J further developed the approach laid down by Jacob J in the *Origins* case (above) in *Wagamama Ltd v City Restaurants plc* [1995] FSR 713. He said:-

‘A judge brings to the assessment of marks his own, perhaps idiosyncratic, pronunciation and view or understanding of them. Although the issue of infringement is one eventually for the judge alone, in assessing the marks he must bear in mind the impact the marks make or are likely to make on the minds of those persons who are likely to be customers for goods or services under the marks. Not all customers are the same. It is therefore sometimes of assistance for the court to hear evidence from witnesses who will help him to assess the variety of ways in which members of the target market will pronounce the marks and what, to them, will be the visual or phonetic impact of the marks. When considering infringement it is also necessary to bear in mind the possible impact of imperfect recollection on the part of members of the target market.’

Again I acknowledge that this is guidance given by the Court in relation to the infringement provisions of section 10, but, as with the comparison of goods, the same language is used in section 5 and section 10. Guidance provided by the Court in relation to section 10 will therefore often be applicable to matters arising under section 5.

It is also appropriate that I have regard to the decision of the Court of Justice of the European Communities in *Sabel v Puma*³, and in particular paragraph 23 which reads:

“23. That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive — “... there exists a likelihood of confusion on the part of the public ...” — shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.”

For convenience I reproduce the two marks below, side-by-side to aid comparison.

Royal Botania

ROYAL
BOTANIC
GARDENS
KEW

The opponent has filed evidence from a number of persons, some of them well known people having a reputation for their horticultural expertise, who have declared that if they saw the applicant’s mark (above left) applied to garden furniture, they would assume a connection with RBG Kew. It is true that some of the opponent’s witnesses are a little less direct. At least two say that they believe there would be confusion, but they do not (as I read their evidence) state that they would be misled themselves. Much the same can be said of the survey responses - ie some say that they personally would be confused, others merely that there would (or could) be confusion.

Mr Van Puyvelde says in his declaration that there has been no confusion since K & F began using the mark in the United Kingdom in 1994, but I am inclined to accept Mr Pendered’s description of the applicant’s use during this period as de minimis. Moreover, the evidence of Mr Cook suggests that staff at K & F’s agent in the United Kingdom, Indian Ocean Trading Company, do not agree that **Royal Botania** has been used as the trade mark of a particular brand of garden furniture they retail on behalf of K & F. Thus I am not persuaded that an absence of actual confusion implies that the marks are not confusingly similar.

If I were in some doubt as to whether these two marks are similar, the evidence of the opponent’s gardening experts would most likely have swayed me in their direction. In the circumstances however, I have examined the two marks closely, both as to the overall impression each conveys, and as to the distinctive or dominant component(s) of each, and I am satisfied that the two marks are not similar.

³*Sabel BV v Puma AG, Rudolf Dassler Sport* [1998] ETMR 1

In reaching this conclusion, I have not ignored the opinions expressed by the opponent's witnesses; neither have I sought in any way to belittle the wealth of experience they represent. But the simple fact is that they are not experts in determining whether two trade marks are similar, and at the time they expressed their opinions they did not have all the relevant facts before them as I do now. Mr Pendered, in his second declaration, submits that the applicant has not discharged the onus of showing that there would not be a likelihood of confusion if the mark in suit is registered and continues to be used. But this opposition was filed under the Trade Marks Act 1994. To the extent that either side in these proceedings bears the onus of establishing (or refuting) a likelihood of confusion, I believe that the burden is upon the opponent who brings such an action to make out his case.

As I have found that the marks are not similar, it follows that the opposition under section 5(3) fails.

Section 5(4)

I turn now to the opposition under Section 5(4), which reads as follows:-

5 (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.

The opponent claims to have a sufficient reputation in their trade mark to be able to prevent the applicant from using the mark in suit by virtue of the law of passing off. In order to succeed in an action for passing off, a plaintiff must first establish a number of facts. These requirements are described in the Jif Lemon case⁴, and are summarised conveniently in the head note to that decision. For convenience, I reproduce the relevant paragraph from page 342 below:

"(1) The law of passing off could be summarised in one short, general proposition: no man may pass off his goods as those of another. More specifically, it could be expressed in terms of the three elements, each a question of fact, which a plaintiff had to prove in order to succeed. These were (a) that there was a goodwill or reputation attached to the goods or services which he supplied in the mind of the purchasing public by association with their identifying get-up, (b) that there was a misrepresentation to the public likely to lead the public to believe the goods or services offered by him were the goods or services of the plaintiff, and (c) that he was suffering or was likely to suffer damage by

⁴Reckitt & Colman Products Ltd v Borden Inc and others [1990] RPC 341

reason of the erroneous belief engendered by the defendant's misrepresentation. It was irrelevant whether or not the public was aware of the plaintiff's identity as the manufacturer or supplier of the goods in question, as long as they were identified with a particular source (p.406)."

5 In particular I note the second of the three elements: a misrepresentation to the public, which need not be intentional, but which is likely to mislead the public as to the origin of the goods. Having already found (above) that the applicant's mark is not similar to the opponent's mark, I have little difficulty in concluding that it could not be said to be a 'misrepresentation' as defined in the law of passing off. The opposition under section 5(4) fails accordingly.

10 *Section 6(1)(c) - Well Known Mark*

The opponent also claims that their use of their mark entitles them to protection under the Paris Convention as a well known trade mark. The substantive ground of opposition here is section 5. However, the opponent already has valid registrations in six classes of goods, and there is nothing in the Notice of Opposition or the evidence filed in these proceedings to
15 suggest that RBG Kew has established a reputation in respect of goods outside the scope of these registrations. In any case, my finding that the marks concerned are not similar would appear to rule out any possibility of the opposition succeeding even if I were to hold that the opponent's mark is a well known mark. In the circumstances, I choose not to decide whether RBG Kew's mark is a well known mark, because nothing in the proceedings before me
20 depends upon it.

Section 3(6) - Bad faith

This section of the Act reads:

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

25 The opponent contends that K & F adopted the mark in an attempt to capitalise on the reputation and goodwill which the opponent enjoys in the name and mark ROYAL BOTANIC GARDENS KEW, and that the application was made in bad faith.

This ground of opposition has not been supported in evidence, and thus I cannot conclude that the application was made in bad faith. The opposition under section 3(6) therefore fails.

30 The applicant, having been successful in these proceedings, is entitled to a contribution towards the costs of defending the application. I therefore order the opponent to pay to the applicant the sum of **£435**.

Dated this 26th day of March 1998

35 **Mr S J Probert**
Principal Hearing Officer
for the Registrar, the Comptroller-General