

O-091-06

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION  
NO. 2342398 IN THE NAME OF TEG ENVIRONMENTAL PLC  
TO REGISTER A SERIES OF TWO TRADE MARKS IN CLASS 1**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 92333 IN THE NAME OF  
OMS INVESTMENTS, INC**

**Trade Marks Act 1994**

**IN THE MATTER OF Trade Mark application  
No. 2342398 in the name of Teg Environmental Plc  
to register a series of two trade marks in Class 1**

**And**

**IN THE MATTER OF opposition thereto  
under No. 92333 in the name of OMS Investments, Inc.**

**BACKGROUND**

1. On 4 September 2003, Teg Environmental Plc made an application, to register a series of two trade marks in Class 1 in respect of the following goods:

Fertilisers; fertiliser products and preparations; compost; soil improvers; grass and plant feeders; soil conditioners and feeders; top soil dressings, mulch; organic fertiliser; organic fertiliser products; organic fertiliser preparations, organic compost, organic soil improvers, organic grass and plant feeders, organic soil conditioners and feeders, organic top soil dressings, organic mulch.

2. The marks applied for are as follows:



3. The applicant claims the colours red and green as an element of the second mark in the series.

4. On 27 February 2004, OMS Investments, Inc. filed notice of opposition to the application, the grounds of opposition being as follows:

- 1. Under Section 5(2)(b)** because the opponents are the proprietors of earlier marks that are similar to the mark applied for, and the goods for which registration is sought are identical or similar to those of the earlier marks.
- 2. Under Section 5(4)(a)** by virtue of the law of passing off.
- 3. Under Section 5(3)** The subject application has been applied for in respect of goods that are not the same or similar, and in respect of a mark that is similar to the opponents' earlier marks, but in view of the opponents' reputation, use of the mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of their earlier marks.
- 4. Under Section 56** because the opponents' earlier marks are well known within the meaning of Article 6 of the Paris Convention, and the mark applied for being similar, it is likely to cause confusion.

5. Details of the earlier marks relied upon by the opponents are shown as an annex to this decision.

6. The applicants filed a counterstatement in which they deny the grounds on which the opposition is based.

7. Both sides ask that an award of costs be made in their favour.

8. Both sides filed evidence in these proceedings. The matter came to be heard on 26 October 2005, when the opponents were represented by Ms Fiona Clark of Counsel. The applicants were not represented but filed written submissions in lieu of attending.

### **Opponents' evidence**

9. This consists of a Witness Statement and a Statutory Declaration, both dated 3 November 2004, from John H A Wyatt, Managing Director of The Scotts Company (UK) Limited. Mr Wyatt begins his Statement by explaining that his company was incorporated on 29 April 1994, and is a subsidiary of The Scotts Company, a company incorporated in Ohio, USA. He says that his company is the UK distributor for various horticultural products produced and/or distributed by the parent company.

10. Mr Wyatt recounts that in September 2000, his company introduced compost products into the UK under the name MIRACLE-GRO PLANT & GRO Multipurpose compost. In September 2003, and potentially after the relevant date in these proceedings, his company

expanded its compost product line to include MIRACLE-GRO PLANT & GRO Ericaceous Compost. He states that in the first month of its launch, 31,000 units of multipurpose compost were sold to Homebase. Mr Wyatt says that the products have sold throughout the UK, and is currently stocked by over 1,300 retailers, Exhibit AA1 being a list of the major retailers currently selling the composts, including Homebase. Exhibit AA2 consists of a page downloaded from the Homebase website confirming the number and geographical spread of their stores.

11. Exhibit AA3 consists of an example of the packaging for the composts, which show MIRACLE GRO as the main title, placed over a large solid, predominantly black circle, the words Plant & Gro being shown some way beneath, sandwiched between the words “Multi-Purpose” and “Compost”, and “Ericaceous” and “Compost”, the whole giving the impression of a unified description of the contents rather than use of a sub-brand. The packaging does also show MIRACLE GRO PLANT & GRO used together.. .

12. Mr Wyatt gives turnover figures for the years 2000 to 2003, which ranges from £775,000 in 2000, rising to £4,924,000 in 2003. He says that the products have been advertised extensively in the UK, giving the approximate annual spend on such activities as £1,580,000 in 2001, and £1,419,000 in 2002. Mr Wyatt says that in 2003, the composts were advertised as part of an overall advertising campaign of the MIRACLE-GRO brand, apportioning the approximate UK spend in this campaign as £1,651,000. He goes on to say that advertising has been carried out by means of point-of-sale materials and by television advertising. Exhibit AA4 consists of a CD containing a television advertisement for composts that was broadcast 6,245 times between mid-April 2001 and early-June 2002, reaching an audience of over 160 million. The advertisement relates to MIRACLE-GRO compost; there is no mention of PLANT N GRO or PLANT & GRO. The exhibit also includes details of a brochure that was distributed to retailers at the same time as the broadcasts.

13. Exhibit AA5 consists of product catalogues distributed in the UK in the years 2001, 2002 and 2003. These include details of the Plant & Gro compost, and various Miracle-Gro plant foods.

14. In his second Statement, Mr Wyatt explains that The Scotts Company (UK) Limited, and the opponents, OMS Investments, Inc. are both wholly owned subsidiaries of The Scotts Company. He states that OMS is the registered owner of the UK and European trade marks MIRACLE-GRO, MIRACLE-GRO SHAKE & FEED, and MIRACLE-GRO PLANT N GRO. Mr Wyatt says his company is licensed by OMS to use these trade marks in the UK.

### **Applicants' evidence**

15. This consists of a Witness Statement dated 1 December 2004, from Richard Crossley Bilborough, Managing Director of Teg Environmental Plc, a company incorporated in 1995, with its primary business being the development, manufacture and sale of composting cages, and a producer of compost that is sold under the registered trade mark ENVIGRO.

16. Mr Bilborough explains that in 2003 his company decided to manufacture a peat-free organic compost, selecting the name POTNGRO for the product, the inspiration being the

television characters Bill and Ben. He recounts having approached a trade mark agent who arranged a prior rights search, stating that this did not reveal any apparent obstacles. He says that the agent advised that the word POTNGRO would be considered non-distinctive and that a pictorial component should be added.

### **Opponents' evidence in reply**

17. This consists of a Witness Statement dated 27 June 2005, from John H A Wyatt.

18. Mr Wyatt asserts that pictorial components of the type forming part of the applicants' marks are common to the trade, and as such would not serve to distinguish it from his company's PLANT N GRO product. In support of this contention, as exhibit AA6 he provides various advertising and packaging materials depicting his company's products, including PLANT & GRO compost, photocopies of the covers of two books relating to plants, and photocopies of two till receipts for the purchase of some of these items on 30 May 2005. Mr Wyatt asserts that the exhibit shows that his company makes extensive use of the colours red and green. He goes on to state that his company's compost products are bulky, and as a consequence customers will have to ask shop assistants for help, and in doing so will ask for the product PLANT N GRO rather than MIRACLE GRO because there are many products bearing the house mark. Mr Wyatt says that the fact that the applicants have chosen to spell the word GROW in the same way that his company does, adds to the possibility of confusion. He ends his Statement by referring to exhibit AA7, which consists of extracts from a dictionary for the words PLANT and POT, Mr Wyatt noting that they can have the same meaning.

19. That concludes my summary of the evidence insofar as it is relevant to these proceedings.

### **DECISION**

20. I turn first to consider the ground under Section 5(2)(b). The relevant part of the statute reads:

“5.-(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.”

21. An earlier trade mark is defined in Section 6 of the Act as follows:

“6.- (1) In this Act an earlier trade mark means-

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the

trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

22. I take into account the well established guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

23. The opponents rely on a number of marks, all of which are, or incorporate the words

MIRACLE –GRO (or MIRA-CLE GRO) with other elements, pictorial and textual. In her skeleton arguments, Ms Clark put the opponents’ case as follows:

“The Opponents have placed reliance upon a portfolio of registrations comprising or including MIRACLE-GRO. The registrations upon which particular reliance is placed fall into essentially four categories- (i) registrations of word mark MIRACLE-GRO itself, (ii) registrations of MIRACLE-GRO displayed against the background of a solid circle of colour, (iii) the registration of MIRACLE-GRO PLANT N GRO and (iv) other registrations comprising MIRACLE-GRO in combination with other words. Of these, reliance is placed primarily upon the marks in the first three categories and particular emphasis is placed upon those which are registered in respect of goods in Class 1.”

24. Turning first to the opponents’ MIRACLE-GRO marks. The word MIRACLE has laudatory connotations, conveying the idea of something that has amazing or superior capabilities. The letters GRO are the phonetic equivalent of the ordinary English word GROW, which, when used, as the opponents do in connection with horticultural products, is sufficiently obvious to be unlikely to escape the notice of the consumer. In combination the mark conveys the message of a product that will get results in growing plants, which is no doubt the opponents’ intention. Whilst I do not go so far as to say that the mark MIRACLE-GRO is devoid of distinctive character, it is, prima facie, not the most distinctive of marks for the goods for which it is used.

25. This, of course, only takes into account the inherent characteristics of the trade mark, and as a used mark I must have regard to whether it has become any more distinctive by virtue of its exposure to the public. The opponents claim their MIRACLE-GRO plant foods are market leaders in the UK. Whilst the applicants challenge this, in paragraph 3 of their Counterstatement they accept that the opponents’ mark MIRACLE-GRO is well known in the horticultural retail sector of the market. I am not quite sure what the extent of this concession is meant to be? Are they saying the mark is well known amongst retailers in the horticultural sector, or that it is so amongst the relevant consumer of horticultural products? Whatever their intention, in paragraph 6 they go on to describe the “Opponent’s well known and distinctive house mark MIRACLE-GRO” without any form of limitation.

26. Whatever the applicants’ views, the opponents have undoubtedly made extensive use of MIRACLE-GRO in relation to plant foods and composts. Whilst Mr Wyatt has not provided turnover figures for all goods sold under the MIRACLE-GRO brand in evidence, these have been detailed in the Statement of Case. Whilst these show a very substantial trade, they also indicate that there has been advertising on a significant level, an extremely useful measure in assessing whether, and to what extent, a mark is likely to have become known to the buying public. In the two years prior to the year in which the relevant date falls, the opponents embarked on an extensive advertising campaign. In 2003 the scale of advertising increased, although as the relevant date is September of that year, only part of that year would be of interest. Whilst it seems likely that the majority of the advertising would have occurred over the nine months leading up to the relevant date, I cannot be certain of this, and accordingly cannot take the activity in 2003 into account. But in any event, I do not see that disregarding the unsafe period detracts from the opponents’ position. In the period April 2001 to June 2002, they spent over £3 million on promotion, and more importantly, advertisements for MIRACLE-GRO hit the television screens many thousands of times. According to the figures that they have provided, these

advertisements were seen by an estimated 74% of the public, a very significant number by any measure.

27. If I have any criticism, it is that these figures have been provided with no explanation of where they come from, or how they have been compiled or calculated. However, the applicants have not seen fit to challenge them, and in the absence of evidence to the contrary, I consider it proper to take them at face value. I therefore reach the view that at the relevant date, the opponents' trade mark MIRACLE-GRO had acquired a reputation and had achieved a strong distinctive character as a result of the use made of it.

28. The opponents have provided figures for goods sold under the name MIRACLE-GRO PLANT & GRO, and even without evidence of the size of the market for composts, the amounts indicate a significant trade. However, it is not clear whether the details given by Mr Wyatt relating to the promotion of the PLANT & GRO product is solely for that product, or a general MIRACLE-GRO campaign. That Mr Wyatt refers to the brochure at exhibit AA4 as containing "a television advertisement for the product" whereas the advertisement relates to MIRACLE-GRO compost adds to the uncertainty. The use shown in the evidence leaves open the question of whether any resulting reputation accrues to the MIRACLE-GRO house mark, PLANT & GRO as a sub brand, or both, and the problem of how am I to answer this?

29. The evidence shows that MIRACLE GRO and PLANT & GRO are used some way apart with no unifying feature. However, on the packaging provided, PLANT & GRO is placed between the words "Multi-Purpose" and "Compost", and "Ericaceous" and "Compost". To the consumer these are words that will have no other meaning than as a description of the contents. The catalogues, flyers, etc, show PLANT & GRO separated from MULTIPURPOSE/ERICACEOUS, but otherwise placed above, and in close proximity to the word COMPOST. Even without being used with non-trade mark matter, the relevance of PLANT & GRO for the goods for which it is used is fairly obvious. But using it in the middle of, or in conjunction with purely descriptive words creates a good deal of uncertainty as to whether the consumer will see PLANT & GRO as just another part of the description rather than an indication of trade origin. It does not help that the opponents use descriptions such as "HANGING BASKET", "HOUSEPLANT" and "SEED & CUTTING" in the same manner and position in relation to composts for these specific purposes.

30. If the opponents are looking to benefit from a reputation, the onus is firmly upon them to provide the supporting evidence. They have not done so and I do not see that I can infer that they have a reputation in respect of PLANT & GRO solus, or MIRACLE-GRO PLANT & GRO. There is also the matter that the mark that the opponents have used is not the mark as registered. In use, the joining letter "N" in the registered version has been replaced by an ampersand. This is not an invention of the opponents; the use of a letter "N" as a shortening form for the word "AND" such as in "Rock' n Roll" has been around for some time. However, whilst an ampersand is a typographical symbol denoting the word AND, a letter "N" is not, and I take the view that the substitution of the ampersand creates a mark that differs in its material particulars to the mark as registered, and casts even more doubt on the likelihood of the opponents having established any reputation in PLANT N GRO, with, or without MIRACLE-GRO.

31. Ms Clark submitted that in relation to the opponents' MIRACLE GRO marks, the word GRO and the solid circle of colour are distinctive and dominant components, and that there "is no

evidence that any other trader in this field was using these prior to the date of the application in suit”. But neither is there any evidence that other traders were not using these or similar elements. By inference, the opponents appear to be claiming that their reputation extends to these elements. The circle is used as no more than a background to the words MIRACLE GRO. As far as being the first to use the spelling GRO rather than GROW, this does not, of itself mean that this has made what is a fairly obvious misspelling of a wholly descriptive word any more distinctive or has become indicative of the opponents. Mr Wyatt also seems to infer in his evidence that through use, the colours red and green would be distinctive of the opponents but there is no evidence to support such a contention.

32. Turning to the respective marks. It is my experience that goods of the type covered by the respective marks will more usually be obtained by self-selection, and accordingly, it is how similar the marks look that is of primary importance. But even so, I cannot ignore the question of whether the marks would sound similar in normal use, or the idea that they may convey and be retained by the consumer.

33. The earlier marks relied upon by the opponents are not identical to the mark applied for, so the question is one of similarity. In any analysis it is inevitable that reference will be made to the elements of which a mark is composed, and particularly so where, as in this case, the mark complained of consists of a number of parts. This is not at odds with the case law which requires that consideration be given to the distinctiveness and dominance of the component parts. However, it must be remembered that the consumer does not embark on a forensic analysis of trade marks and it is the marks as a whole that must be compared. It is also generally accepted that in a composite mark that contains a word with some figurative element, it will be the word that the consumer will use as a point of reference, but this does not mean that I can disregard the pictorial element in the overall comparison.

34. In her submissions Ms Clark referred me to a case of *John-Pierre Koubi v OHIM; Fabricas Lucia Antonio Betere, SA (FLABESA)* intervening [2004] E.T.M.R. 61, concerning an appeal against the decision of the OHIM Board of Appeal to allow an opposition to an application to register CONFORFLEX as a Community trade mark. The opposition had been based on earlier Spanish registrations for figurative marks containing the word FLEX. The Court of First Instance considered FLEX to be the “dominant element in the overall impression created by the earlier mark” and clearly “dominates the figurative part, which is negligible and even insignificant”.

35. The opponents’ trade marks consist of the words MIRACLE-GRO in conjunction with graphical matter, namely, a circle, and also with words which, with the exception PLANT N GRO, only serve to move the respective marks further apart. The applicants’ marks consist of the words POT N GRO with the image of an amaryllis plant positioned in the circle of the letter “O” in the word POT, but is still, nonetheless, a POT N GRO mark.

36. Self-evidently, these marks have the word GRO in common, and if only to this extent there is some degree of visual and aural similarity. However, all of the marks have other matter that is both individually, and in the whole they contribute to, different in sound and appearance. Whilst using GRO twice, as in MIRACLE-GRO POT & GRO may increase the prominence of this particular element, I cannot accept that the result will be anything near to a dominance that renders the other elements insignificant.

37. Ms Clarke argued that because of the descriptive relevance of POT and POT N, the latter being “visually similar to and phonetically almost identical to the word “Potting”, this part of the applicants’ marks is unlikely to be regarded as distinctive, and consequently, the part most likely to stick in the mind of customers as indicating source origin is the word GRO and the solid circle of colour. In relation to the goods for which the respective marks are registered, or sought to be registered, GRO is no more than a phonetic equivalent of a word that has as obvious a connection with the goods as any of the other elements; it is indicative of their purpose.

38. In the case cited above, the CONFOR prefix to the applicants’ mark was considered wholly descriptive, and that in principle words dominate figurative elements. But having reached this position, the CFI went on to conclude that even though the respective marks have the same dominant element, when considered “globally” the addition of CONFOR made them aurally and visually dissimilar. As I see it, if the marks MIRACLE-GRO and/or PLANT N GRO, and POT N GRO possess any inherent distinctiveness, it rests in their whole. No single element is any more dominant or distinctive, and when viewed as such they are visually and aurally distinct, with the other MIRACLE-GRO marks with additional text even further apart.

39. There is the question of the pictorial element to the applicants’ marks. It may well be that as Ms Clarke says, in relation to horticultural goods there is nothing individually distinctive about an amaryllis per se, but the manner in which it is used does have an impact on the overall appearance of the applicants’ marks, and detracts from its visual similarity to the opponents’ earlier mark.

40. It may well be that the opponents have a circle as part of some of their marks, and that the applicants’ marks also contain a circular element, but that is as far as the similarity goes. The applicants’ use is as a letter whereas the opponents use the circle as a backdrop to the words MIRACLE-GRO. To say that they are similar because both are circular in shape and solid in appearance is going too far, even when the applicants’ marks are represented in monochrome and the circular element is coloured black. The opponents notionally have rights in their marks represented in the same colours used in the mark applied for. Whilst I do not consider that use of MIRACLE-GRO in these colours would impact to any significant extent on its similarity to the mark applied for, if the PLANT N GRO element were to be represented in the same way as the applicants’ mark, the visual similarity of this element would be enhanced.

41. Apart from a reference to “growing” I do not consider that MIRACLE-GRO and POT N GRO say the same, or even a similar thing, and perhaps with the exception of PLANT N GRO, the opponents’ marks with additional text are even further apart in the ideas they convey. Ms Clark argued that “POT N” is likely to be taken as an indication that the product in question is for use for plants in pots, and that “the verbs pot and plant are often interchangeable in the context of the husbandry of plants.” The dictionary references indicate that POT generally means to put a plant in a flower pot, whereas to plant involves placing the plant in the ground; both mean to put a plant somewhere to enable it to grow. To the horticulturalist their exact meaning will refer to different ways or method of planting, but to the average man in the street, these are two ordinary English words that convey if not the same, then a similar meaning. This, of course, is a comparison of only part of the applicants’ mark, but given that each has the same “GRO” suffix attached, the conceptual similarity of POT N GRO and PLANT N GRO does not change when the marks are viewed as a whole. This, of course, ignores the fact that in the opponents’ mark,

PLANT N GRO is preceded by the words MIRACLE-GRO.

42. The goods covered by the opponents' earlier marks, and most importantly, by their MIRACLE-GRO PLANT N GRO registration, are clearly identical to those of the disputed application. The descriptions of goods are notionally capable of covering simple, ready-to-use products that the consumer will buy for a particular task, to the sophisticated and specialised products that a farmer, green-keeper or horticulturalist would use. Whether amateur or professional, that the product is being bought for a specific purpose means that the purchase is likely to be deliberate and considered, and in the case of the professional, made by a person with skill and knowledge. There is nothing in the specifications that places them in different manufacturing sectors, or shows that the goods are provided in different markets. Therefore, I must notionally assume that the opponents and the applicants share the same channels of trade, from manufacture to retail, and sell to the same end consumer.

43. Mr Wyatt says that his company's product MIRACLE-GRO PLANT N GRO is sold in large plastic sacks that are quite heavy and which many customers will have difficulty in lifting or transporting. He says that as a consequence, customers will have to request help, and will ask for the product using PLANT N GRO rather than MIRACLE-GRO because there are other MIRACLE-GRO products. I do not think there is anything unreasonable in the contention that bags of compost are heavy and that some customers will ask for assistance in transporting them, but this does not mean that they will necessarily ask for the product by name, or if they do, that they will use PLANT N GRO rather than the more well known mark. Of course Mr Wyatt is focusing his comments on the actual products on which they actually use the mark and not the range of goods covered by the earlier marks, many of which may be in small, easy to transport containers, and where no assistance is required.

44. Why should the consumer ignore the MIRACLE-GRO name? Ms Clark takes the view that the consumer would see PLANT N GRO as a form of sub-brand, and it is in support of this contention that the CONFORFLEX case was primarily brought to my attention. In that case the CFI stated:

“61 Furthermore, it is quite possible for an undertaking active on the market for bedding and bedroom furniture to use sub-brands, that is to say signs that derive from a principal mark and which share with it a common dominant element, in order to distinguish his various lines from one another, particularly in terms of the quality of the goods concerned. As OHIM stated in its pleadings, it is therefore conceivable that the targeted public may regard the goods designated by the conflicting signs as belonging to two, admittedly distinct, ranges of products but as coming, none the less, from the same manufacturer (see, to that effect, *Fifties*, para.[49]).”

45. The “*Fifties*” case referred to is *Claudia Oberhauser v. Office for Harmonisation* [2003] E.T.M.R. 58, the relevant paragraph reading as follows:

“49. It must further be observed, with regard to the conditions in which the products in question are marketed, that it is common in the clothing sector for the same mark to be configured in various different ways according to the type of product which it designates. It is also common for the same clothing manufacturer to use sub-brands,

that is to say signs that derive from a principal mark and which share with it a common dominant element, in order to distinguish his various lines from one another (women's, men's, youth). In such circumstances it is conceivable that the targeted public may regard the clothing designated by the conflicting marks as belonging, admittedly, to two distinct ranges of products but as coming, none the less, from the same manufacturer.”

46. In that case, an application had been made to register the trade mark FIFTIES for clothing, which was opposed by the proprietors of an earlier mark, MISS FIFTIES that had been registered for identical goods. Perhaps not surprisingly the opposition was successful, one of the factors being that it was considered common for the same clothing manufacturer to use sub-brands, derived from, and sharing a common dominant element in order to distinguish different groupings of goods from the same lines, for example, men’s, women’s, etc. Even though it could possibly be seen as a reference to a decade, the word FIFTIES was accepted as the distinctive and dominant part of the earlier mark. The word MISS is no more than an indication of a subset of goods, from the FIFTIES range.

47. I do not see that the same position exists in this case. The common element is the word GRO, which I have already stated to be a mere phonetic variation of a wholly descriptive word, and there is no evidence that the opponents have made it distinctive of them. Ms Clark argued that the consumer will take POT N as an indication of the product in question, If that is the case, why then should they then regard PLANT N any differently, it is all but the word PLANTING. Whilst the opponents’ evidence shows that sub-brands are a feature of the relevant trade, it also highlights the opponents’ practice of using other, very obvious product descriptions in the same manner and positioning on their packaging.

48. If the opponents have a case, it exists in my view in the argument that there may be confusion through imperfect recollection. This relies upon the proposition that the consumer familiar with the opponents’ MIRACLE-GRO PLANT N GRO, on seeing the applicants’ goods marked POT N GRO, will ignore the graphical element, overlook or forget the trade mark MIRACLE-GRO which is accepted as having a wide recognition, and through poor recollection will be confused into thinking that POT N GRO is a product from or connected with the opponents. This sounds a very contrived scenario to me. But in any event, in the *SABEL- PUMA* case it was said “The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details”. Taking this with the fact that GRO is not a dominant, distinctive component, and applying it to the facts of this case, would support the view that there is little likelihood of confusion.

49. But even if the consumer were to travel this unlikely route, the words PLANT N GRO consist of a non too covert allusion to the goods for which it is used, and would be recognised as such by the public. It has a low threshold of distinctiveness. In *The European Limited v The Economist Newspaper Limited* [1998] ETMR 307, Millett LJ said:

“Where descriptive words are included in a registered trade mark, the courts have always (and rightly) been exceedingly wary of granting a monopoly in their use.@

50. Whilst the *European* case refers to descriptive words, I do not consider that it is going too far

to say that the principle is just as applicable to phonetics and obvious misspellings of descriptive words. To be successful the opponents would have needed to establish that PLANT N GRO or GRO had a separate life as a trade mark in the mind of the consumer, or, that the consumer would recognise the “N” construction as being indicative of the opponents; they have not done so.

51. Adopting the Aglobal@ approach advocated and weighing all of the similarities against the differences, I find that on the balance of probability, use of the marks applied for in a trade in respect of the goods for which the applicants seek registration would not cause the public to wrongly believe that the goods are those of the opponents or that they come from some economically linked undertaking. Consequently there is no likelihood of confusion and the opposition under Section 5(2)(b) fails accordingly.

52. Turning next to the ground under Section 5(3). That section reads as follows:

“5.-(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, 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.”

53. The European Court of Justice in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* (C-292/00) which was confirmed by its decision in *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* (C-408/01) determined that Article 5(2) of the Directive granted a right to the proprietor of an earlier trade mark with a reputation, to prevent others from using an identical or similar trade mark in relation to goods or services where such use would, without due cause, take unfair advantage or be detrimental to the distinctive character of the earlier trade mark.

54. The opponents’ rely on their earlier marks that include goods in Class 8, namely, MIRACLE-GRO, MIRACLE-GRO SHAKE & FEED, MIRACLE-GRO & device, MIRACLE-GRO 3 IN ONE and MIRACLE-GRO NO CLOG.

55. The first requirement to be met under Section 5(3) is for the earlier trade mark to be identical or similar to the trade mark that is the subject of these proceedings. In my determination of the grounds under Section 5(2)(b), I found the mark MIRACLE-GRO to be identical in respect of one element, but as a whole, to be visually, aurally and conceptually different from the mark applied for. The opponents’ earlier marks all consist of the words MIRACLE-GRO, either with a circular device, or other words that describe a characteristic of the goods for which they are used, and which take these marks even further apart in terms of similarity.

56. The next requirement is that the opponents’ mark possesses a reputation in the UK to the extent set out by the ECJ in *General Motors Corporation v. Yplon SA* [1999] E.T.M.R. 122 (Chevy). The court concluded that the requirement implies a certain degree of knowledge

amongst the public, and that the required level would be considered to have been reached when the earlier mark is known by a significant part of the relevant sectors of the public.

57. In deciding whether this requirement is fulfilled all relevant factors should be considered, including, 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 promoting it; the stronger the reputation and distinctive character, the easier it will be to accept that detriment has been caused to it.

58. The evidence shows that from at least 1990, and well before the relevant date, the applicants have used the trade mark MIRACLE-GRO in the UK in relation to plant foods on a very significant scale, and have widely promoted the brand to the extent that they describe themselves as market leaders. In 2000 they introduced a compost under the name MIRACLE-GRO PLANT & GRO which again appears to have achieved substantial sales, and which may have enhanced the opponents' reputation.

59. As I see it, the opponents have a strong reputation in respect of plant foods and composts. There is no evidence that confirms that this reputation extends to the goods covered by Class 8 of their earlier marks, or if it does, from when and to what extent, although I accept that there may be some spill over owing to some of the goods in that class being closely related to their plant foods. The opponents' reputation has been established under the mark MIRACLE-GRO, and also these words used in conjunction with other matter of varying degrees of distinctiveness and descriptiveness, but in all cases these are different marks to that of the application. The consequence of this is that whilst I accept that the opponents' MIRACLE-GRO marks may have achieved a wide recognition and reputation, being different marks this would not lead to there being advantage gained by the applicants' use of their mark, or detriment to the opponents' marks or their reputation. I therefore dismiss the ground under Section 5(3).

60. Moving to the ground under Section 5(4)(a). That section 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) ...

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.”

61. Mr Geoffrey Hobbs QC, sitting as the Appointed Person set out a summary of the elements of an action for passing off in his decision in the *WILD CHILD* Trade Mark case [1998] RPC 455. Mr Hobbs summarised the requirements as follows:

“(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.”

62. I have accepted that the opponents’ marks MIRACLE-GRO and MIRACLE-GRO PLANT & GRO have a strong reputation in the UK, the former in respect of plant foods and compost, and to a lesser extent, the latter in relation to compost. On the facts before me it is not unreasonable to accept that they have achieved a level of goodwill commensurate with this reputation. However, I again have to say that, for the reasons that I have given in some detail in my determination of the ground under Section 5(2), the respective marks are not similar, and consequently, I do not see that there can be a misrepresentation, or that the opponents will suffer any damage by the applicants’ use of POT N GRO. The ground under Section 5(4)(a) fails accordingly.

63. This leaves the ground under Section 56 relating to well known marks. This section entitles the proprietor of a qualifying mark to prevent a trade mark which, or the essential part of which is at least similar to his mark, from being registered in respect of identical or similar goods, where this is likely to cause confusion. The assessment of the likelihood of confusion is a “global” test akin to that used to determine oppositions under Section 5(2). For the reasons that I gave in my determination of that ground, I do not see that the opponents are in any better position, a fact acknowledged by Ms Clark, who in her skeleton argument put it as succinctly as “It is not believed that this adds anything to the other grounds relied upon.” I agree and this ground is also dismissed.

64. The opposition having failed on all grounds, the applicants are entitled to costs. I order the opponents to pay the applicants the sum of £1,750 as a contribution towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 30<sup>th</sup> day of March 2006**

**Mike Foley  
for the Registrar  
the Comptroller-General**