

O-630-17

TRADE MARKS ACT 1994

**IN THE MATTER OF DECISION O/415/17
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 (no. 1232089) which designates the European Union, based on the priority of a Swiss trade mark (no. 664357). Relying on that earlier mark, 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 faces a challenge filed before the EUIPO¹ on 20 October 2015 by Farm and Garden Machinery Limited. Consequently the Applicant’s success on the basis of sections 5(1) and 5(2)(a) is provisional pending the outcome of that opposition before the EUIPO.
3. My decision (O/415/17) therefore also considered the Applicant’s claim under section 3(6) that Farm and Garden Machinery Limited had acted in bad faith when it applied to register HARRY as a UK trade mark. On the papers before me I again found in favour of the Applicant, and since bad faith is an absolute ground for invalidity, that finding was not contingent on establishing the validity of the earlier right. Consequently, the Registered Proprietor’s UK trade mark under registration number 3083440 was declared invalid in its entirety and deemed never to have been made.
4. However, shortly after the publication of the decision (O/415/17), it came to light that although the Registry had taken receipt of submissions in lieu of a hearing made on behalf of the Registered Proprietor, as a consequence of a scanning error by the Registry, those submissions were not successfully uploaded to the

¹ 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.

electronic case file. The submissions were therefore not before me when I considered the case and made my decision.

5. Although it is unclear whether or not the submissions would have altered the outcome, it is clear that there has been a material procedural error in this case. Since it is possible that the decision may not have fully addressed the points as expressed in those submissions in lieu, and taking account of all relevant factors, the Tribunal has decided that the decision published under the reference O-415-17 should be set aside as to the outcome of the section 3(6) Trade Marks Act 1994 ground (the bad faith ground).
6. The published decision addresses all relevant considerations as to sections 5(1) and 5(2)(a) and the submissions could not affect the findings as to those grounds. Consequently the decision shall remain in place in so far as it relates to section 5 of the Act.
7. The Registry gave the parties an opportunity to comment on this way forward, notably by their attendance at a case management conference held before me on 23 October 2017. Whilst the delay arising from the error is regrettable, there is good reason to aside the bad faith decision and to maintain the provisional status of the invalidity on the basis of section 5.
8. The legal representative for the Registered Proprietor is Mr Paul Kelly of FR Kelly. Mr Kelly acts for Farm and Garden Machinery Limited in respect both of its defence against the invalidity action, and in its opposition before the EUIPO against the Applicant's earlier mark. Mr Kelly has informed the Registry that a cooling off period agreed between the parties was due to expire on 24 November 2017. Mr Kelly has agreed to inform the UKIPO (and the Applicant's legal representative) as soon as he becomes aware of the outcome of those related proceedings resumed before the EUIPO.
9. If the Registered Proprietor does not succeed in its opposition to the Applicant's mark for international registration purposes at the EUIPO, then the Applicant will have a valid earlier mark and the UK IPO will confirm the provisional decision in

the present case (O-415-17) and will invalidate the trade mark in question. In the event that the Registered Proprietor succeeds in its opposition before the EUIPO, the UKIPO will at that stage consider the bad faith ground afresh.

OUTCOME

- 10. The decision published under the reference O-415-17 is set aside as to the outcome of the section 3(6) Trade Marks Act 1994 ground (the bad faith ground). The decision shall remain in place in so far as it relates to section 5 of the Act.**

Dated this day of December 2017

Matthew Williams

**For the Registrar,
the Comptroller-General**
