

O/742/21

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003338049

BY GALA TENT LIMITED

IN CLASSES 6 AND 22

AND OPPOSITION THERETO UNDER NO. 414830

BY MCD HOME & GARDEN (UK) LTD

AND IN THE MATTER OF REGISTRATION NO. UK00003361797

IN THE NAME OF MCD HOME AND GARDEN (UK) LTD

IN CLASSES 6, 19 AND 22

AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO

UNDER NO. 502756 BY GALA TENT LTD

AND IN THE MATTER OF REGISTRATION NO. UK00003056256

IN THE NAME OF GALA TENT LIMITED

IN CLASSES 6 AND 22

AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO

UNDER NO. 502936 BY MCD HOME & GARDEN (UK) LIMITED

BACKGROUND AND PLEADINGS

1. On 12 September 2018, Gala Tent Limited (“Gala”) applied to register the trade mark **Pro Tent** in the UK (application no. 3338049) (“the 049 Mark”). The 049 Mark was published for opposition purposes on 21 September 2018 and registration is sought for the following goods:

Class 6 Gazebos [Metal Gazebo Structures] Foldable Gazebo; Collapsible Gazebo; Scissor Action Gazebo.

Class 22 Foldable Marquee; Collapsible Marquee; Scissor Action Marquee.

2. The application for the 049 Mark was opposed by MCD Home & Garden (UK) Ltd (“MCD”) on 21 December 2018. The opposition is based upon sections 5(4)(a), 3(1)(b), 3(1)(c) and 3(1)(d) of the Trade Marks Act 1994 (“the Act”).

3. For its opposition based upon section 5(4)(a) of the Act, MCD relies upon the signs **PRO TENT** and **MCD PRO TENT** which it claims to have used throughout the UK since 1 June 2016 in relation to:

“Transportable buildings of metal; metal gazebos; portable gazebos primarily of metal; canopies (structures of metal); parts, fittings and accessories for the aforesaid goods; metal tent, gazebo and marquee frames, stakes, pegs, poles, ground bars.

Non-metallic transportable buildings; marquees being structures not of metal or textiles; portable gazebos not primarily of metal; parts, fittings and accessories for the aforesaid goods.

Marquees of textile materials; tents, awnings, tarpaulins, canopies; textile covers for gazebos and marquees; parts, fittings and accessories for the aforesaid goods; ropes for tents and marquees.”

4. For its opposition based upon sections 3(1)(b) and (c), MCD states that PRO will be recognised as an abbreviation for “professional” and is descriptive of the nature and/or intended use/user of the products and/or is laudatory. MCD states that TENT is a descriptive word for all of the goods specified, as a “tent” will be seen as a reference to a collapsible shelter and is synonymous with the marquees and gazebos covered by the application. For its opposition based upon section 3(1)(d), MCD states that due to the meaning of these words as set out above, the mark consists of signs which are customary in the trade.

5. Gala filed a counterstatement denying the claims made.

6. MCD is the registered proprietor of UK trade mark no. 3361797 for the mark **MCD PRO TENT** (“the 797 Mark”). The 797 Mark was filed on 18 December 2018 and was registered on 15 March 2019. It stands registered for the following goods:

Class 6 Transportable buildings of metal; metal gazebos; portable gazebos primarily of metal; canopies (structures of metal); parts, fittings and accessories for the aforesaid goods; metal tent, gazebo and marquee frames, stakes, pegs, poles, ground bars.

Class 19 Non-metallic transportable buildings; marquees being structures not of metal or textiles; portable gazebos not primarily of metal; parts, fittings and accessories for the aforesaid goods.

Class 22 Marquees of textile materials; tents, awnings, tarpaulins, canopies; textile covers for gazebos and marquees; parts, fittings and accessories for the aforesaid goods; ropes for tents and marquees.

7. On 6 August 2019, Gala applied to invalidate the 797 Mark pursuant to section 47 of the Act. The application for invalidation is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Act.¹

¹ See pleadings issues below.

8. Under sections 5(2)(b) and 5(3) of the Act, Gala relies upon UK trade mark no. 3056256 for the trade marks **Pro 50**, **Pro50** and **Pro-50** (series of 3) (“the 256 Marks”). The 256 Marks were filed on 20 May 2014 and were registered on 31 October 2014. They stand registered for the following goods:

Class 6 Gazebos [metal structures]; Foldable Gazebo; Collapsible Gazebo; Scissor Action Gazebo.

Class 22 Foldable Marquee; Collapsible Marquee; Scissor Action Marquee.

9. Under section 5(2)(b), Gala claims that there is a likelihood of confusion because the marks are similar and the goods are identical or similar.

10. Under section 5(3), Gala claims that it has a reputation for all goods for which the 256 Marks are registered and that use of the 797 Mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or repute of the 256 Marks.

11. Under section 5(4)(a), Gala relies upon unregistered rights in the signs **Pro 50**, **Pro-50** and **Pro50** which it claims to have used throughout the UK since 2006 in relation to “gazebos [metal structures]; foldable gazebos; collapsible gazebo; scissor action gazebo; foldable marquee; collapsible marquee; scissor action marquee”.

12. MCD filed a counterstatement denying the claims made.

13. On 4 December 2019, MCD also filed an application for invalidation pursuant to section 47 of the Act in relation to the 256 Marks. MCD originally relied upon sections 3(1)(b), 3(1)(c), 3(1)(d) and 3(3)(b) of the Act. However, the sections 3(1)(d) and 3(3)(b) grounds were struck out.² Consequently, the application proceeds on the basis of sections 3(1)(b) and 3(1)(c) only.

14. In relation to the section 3(1) grounds, MCD states:

² See pleadings issues below.

- The word “PRO” will be understood by the English speaking public and/or the relevant public in the trade as an abbreviation for “professional” and is therefore descriptive of the nature and/or intended use/user of the products and/or is laudatory.
- The “50” element describes the dimension of the legs of the various gazebos/marquees specified, being an abbreviation for 50 millimeters.
- In its totality, the mark will be seen as a reference to professional grade temporary gazebos/marquees which have legs that are 50mm wide.
- Consequently, MCD claims that the registration should be invalidated because it is devoid of distinctive character and/or descriptive.

15. Gala is unrepresented and MCD is represented by Freeths LLP. Both parties filed evidence. Neither party requested a hearing, but both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

16. MCD filed evidence in the form of the witness statement of Martin Blacksell dated 10 June 2019, which is accompanied by 13 exhibits. Mr Blacksell is the Director of MCD, a position he has held since the company was first incorporated on 8 September 2015. MCD’s evidence was accompanied by written submissions dated 10 June 2019.

17. Gala filed evidence in the form of the witness statements of Jason Mace and Brendon Flint, both dated 31 July 2019. Mr Mace is the Managing Director of Gala, a position he has held for 20 years. Mr Mace’s statement was accompanied by 10 exhibits. Mr Flint is an Integrated Technology Developer and Team Leader for Gala, a position he has held for 4 years. Gala’s evidence was accompanied by written submissions dated 31 July 2019. Mr Mace also filed a subsequent witness statement dated 19 February 2020, which was accompanied by 10 exhibits.

18. MCD filed written submissions in lieu of a hearing dated 23 April 2021.

19. Following the Case Management Conference (“CMC”) discussed below, both parties also filed further written submissions in lieu. MCD’s written submissions were dated 23 July 2021 and Gala’s were dated 26 July 2021. I will return to the admissibility of Gala’s submissions below.

PLEADINGS ISSUE

20. The evidence filed by MCD, the witness statement of Mr Flint and the first witness statement of Mr Mace were filed in relation to opposition no. 414830. However, when the invalidations were subsequently filed, the parties were given a further opportunity to file additional evidence. Gala did so. However, this was originally overlooked and this Tribunal gave a preliminary view that MCD’s section 3(1)(d) and 3(3)(b) grounds and Gala’s section 5(3) and 5(4)(a) grounds should be deemed withdrawn due to a lack of evidence. However, neither party was given an opportunity to be heard in relation to this preliminary view.

21. Consequently, on 10 June 2021, the Tribunal wrote to the parties as follows:

“The Registry notes that adverse decisions have been made against both parties in the above proceedings:

- i) the decision to strike out Gala Tent Ltd’s section 5(3) and 5(4)(a) grounds
- ii) the decision to strike out MCD Home & Garden (UK) Ltd’s 3(1)(d) and 3(3)(b) grounds.

Ordinarily, the parties would have been given an opportunity to be heard in respect of this. However, having reviewed the file, it appears that this was overlooked. This is an irregularity in procedure which should be corrected.

Consequently, a Case Management Conference (CMC) will take place on Friday 25 June 2021 at 10:00 to discuss the strike out decision. This will give the parties an opportunity to make submissions as to whether these grounds should be struck out, before a final decision on the strike out is made. [...]”

22. The CMC took place before me and both parties attended. I set out my directions following the CMC in the below letter:

“I write further to the Case Management Conference (“CMC”) which took place before me today, by telephone conference. MCD Home & Garden (UK) Ltd (“MCD”) was represented by Mr Lloyd Lane of Freeths LLP. Gala Tent Limited (“Gala”) was self-represented by Mr Jason Mace, its Managing Director.

The purpose of the CMC was to address the strike out decision that had been made by the Registry in respect of MCD’s sections 3(1)(d) and 3(3)(b) grounds in the 502936 invalidation and Gala’s section 5(3) and 5(4)(a) grounds in the 502756 invalidation.

At the CMC, Mr Lane confirmed that, although MCD had not been given the opportunity to be heard following its objection to the preliminary view, it was content for its 3(1)(d) and 3(3)(b) grounds to remain struck out.

Mr Mace confirmed that Gala wished to pursue its sections 5(3) and 5(4)(a) claims and that it had filed evidence on 19 February 2020, which it considered demonstrated use of the mark/sign relied upon.

It appears that the evidence in question had not been uploaded to the lead electronic case file but has now been located. Mr Lane confirmed that MCD had received a copy of this evidence.

The purpose of consolidation is to minimise the cost and time incurred in the course of proceedings that deal with overlapping issues. It seems to me that the evidence filed by both parties in the consolidated opposition case, should also stand in the consolidated invalidations. Similarly, **the evidence filed by Mr Mace on 19 February 2020 is admitted as evidence in the consolidated cases.**

I note Mr Lane’s position that MCD does not consider the evidence filed by Gala sufficient to prove goodwill/reputation, but that is a matter for assessment upon

the final determination of this case. As evidence has been filed it would be inequitable to strike out the grounds and prevent Gala from pursuing the claims to a full substantive decision.

Consequently, I direct that Gala's sections 5(3) and 5(4)(a) grounds be reinstated.

As Mr Lane indicated at the CMC that he was content for the sections 3(1)(d) and 3(3)(b) grounds of invalidation to remain struck out, the case will now proceed on that basis.

Neither party has requested a substantive hearing and the deadline for filing written submissions in lieu has expired. However, in light of my directions above, **the parties will have 14 days to confirm whether they wish to file further written submissions relating to Gala's section 5(3) and 5(4)(a) grounds only i.e. on or before 9 July 2021. If so, they will have a further 14 days in which to file those submissions i.e. on or before 23 July 2021.**

The case will then be passed to me for a substantive decision."

LATE SUBMISSIONS

23. As noted above, both parties duly filed further submissions. However, Gala did not file its further submissions until 26 July 2021 i.e. after the deadline for filing those submissions had passed. I have given consideration as to whether these submissions should be taken into account. In reaching this decision, I have borne in mind that the submissions were only 1 working day late and that there does not appear to be any prejudice caused to MCD by this slight delay. Consequently, I consider the written submissions should be admitted.

PRELIMINARY POINT

24. I note that Mr Mace gives evidence that the Director of MCD was previously employed by Gala. Mr Mace states that they parted on acrimonious terms and that this

has led to MCD having a vendetta against Gala. This is summarised by Gala as follows:

“3. The Tribunal is directed to the fact that Party A’s Managing Director Mr Martin Blacksell was an employee of Party B before setting up a competitive company and copying the range of products knowing the product and the trademark value and as a result has passed off the name for gain in the same market space. Attention was given to the fine detail to win google and Ebay searches when adding other words to product listings and descriptions such, 50mm to the name MCD PRO Tent is evidence in the bundle and Party A has had many listing violations against them with a high level of similarity.”

Throughout the evidence, Mr Mace discusses a pattern of behaviour on the part of MCD which he states has been a deliberate attempt to disrupt Gala’s business. I note that bad faith has not been pleaded. I do not, therefore, consider it necessary to assess this alleged pattern of behaviour in any detail. However, I recognise that an intention to deceive may be relevant to a passing off claim and, if it is necessary to do so, I will refer to this below.

DECISION

25. Given its impact upon the 502756 invalidation, I will begin by assessing the application for invalidation against the 256 Marks.

THE INVALIDATION AGAINST THE 256 MARKS

26. In invalidation proceedings, section 3 of the Act has application because of the provisions of section 47(1) which reads:

“47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

27. Section 3(1)(b) and 3(1)(c) read as follows:

“3(1) The following shall not be registered –

(a) [...]

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of product of goods or of rendering of services, or other characteristic of goods or services,

(d) [...]

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

28. The relevant date under sections 3(1)(b) and (c) is the date of filing of the contested mark i.e. 20 May 2014.

29. I bear in mind that the above grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c) but still be objectionable under section 3(1)(b): *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P at [25].

30. The position under the above grounds must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect:

Matratzen Concord AG v Hukla Germany SA, Case C-421/04. The average consumer will vary depending on the particular goods and services concerned. In this case, the average consumer is likely to include both members of the general public and business users (such as hotels or other hospitality establishments). I recognise that the cost of the goods are likely to vary in price and that they are unlikely to be particularly frequent purchases. On balance, I consider that at least a medium degree of attention is likely to be paid during the purchasing process for the goods given that factors such as aesthetics, durability and safety are all likely to be relevant factors.

Section 3(1)(c)

31. I will begin with the application under section 3(1)(c). Section 3(1)(c) prevents the registration of marks which are descriptive of the goods, or a characteristic of them.

32. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728

[2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-

2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended

purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

33. The 256 Marks against which this invalidation are directed are **Pro 50**, **Pro50** and **Pro-50** (series of 3).

34. I agree with MCD that the word "Pro" is likely to be seen as an abbreviation for "professional". In my experience, this is a commonly used abbreviation which is used in day to day language. Consequently, I also consider it likely to be recognised as such

by the average consumer. It seems that this is accepted by Gala as, in his evidence, Mr Mace states “It is admitted that the Pro element will be understood by the English-speaking public as an abbreviation for professional”.

35. MCD states that the “50” element of the marks indicate the dimension of the legs of the various gazebos/marquees specified, being an abbreviation for 50millimetres. Indeed, it seems that this is accepted by Gala as, in his evidence, Mr Mace states “it is admitted that the 50 element describes the dimensions of parts of the frame”. However, I do not take this to be an admission that this meaning will be understood by the relevant public. Whilst that might be what the number 50 is intended to describe, I consider it unlikely that this meaning will be grasped by the average consumer; simply including the number 50 does not, in my view, mean that the mark will be recognised as indicating the diameter of the legs of the gazebos/marquees. The mere inclusion of the number 50 leaves a lot left unsaid. I note that there is no evidence that either members of the general public or professional users would identify this meaning. Taking all of this into account, I do not consider the mark as a whole to be descriptive.

36. The application for invalidation based upon section 3(1)(c) of the Act fails.

Section 3(1)(b)

37. I now turn to the application under section 3(1)(b) of the Act. Section 3(1)(b) prevents registration of marks which are devoid of distinctive character. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

38. I have already found that Gala's marks are not descriptive. I accept that this does not, of itself, mean that Gala's marks cannot be objectionable under section 3(1)(b). However, descriptiveness is the only claim that MCD has pleaded under this ground as to why Gala's marks are devoid of distinctive character. In any event, I can see no reason, not being descriptive of the goods, as to why Gala's marks would be incapable of identifying the goods as originating from a particular undertaking.

39. The application for invalidation based upon section 3(1)(b) of the Act fails.

40. I will now turn to consider Gala's application for invalidation.

THE INVALIDATION AGAINST THE 797 MARK

41. Sections 5(2)(b), 5(3) and 5(4)(a) have application in invalidation proceedings pursuant to section 47 of the Act. Section 47 reads as follows:

"47(1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground –

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) [...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered –

(i) within the period of 5 years ending with the date of application for the declaration; and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) [...]

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection 2B or 2C to the United Kingdom shall be construed as a reference to the European Union.

(2DA) [...]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c).

[...]

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) [...]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

Section 5(2)(b)

42. Section 5(2)(b) of the Act reads as follows:

“5(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.”

43. By virtue of their earlier filing date, the 256 Marks qualify as earlier trade marks pursuant to section 6 of the Act. As the 256 Marks had not completed their registration process more than 5 years before the date of the application for invalidity, the 256 Marks are not subject to proof of use pursuant to the provisions of section 47 of the Act.

44. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, is not sufficient;

(j) 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;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

45. The competing goods are as follows:

Gala's goods The applicant for invalidation (the 256 Marks)	MCD's goods The proprietor (the 797 Mark)
<p><u>Class 6</u> Gazebos [metal structures]; Foldable Gazebo; Collapsible Gazebo; Scissor Action Gazebo.</p> <p><u>Class 22</u> Foldable Marquee; Collapsible Marquee; Scissor Action Marquee.</p>	<p><u>Class 6</u> Transportable buildings of metal; metal gazebos; portable gazebos primarily of metal; canopies (structures of metal); parts, fittings and accessories for the aforesaid goods; metal tent, gazebo and marquee frames, stakes, pegs, poles, ground bars.</p> <p><u>Class 19</u> Non-metallic transportable buildings; marquees being structures not of metal or textiles; portable gazebos not primarily of metal; parts, fittings and accessories for the aforesaid goods.</p> <p><u>Class 22</u> Marquees of textile materials; tents, awnings, tarpaulins, canopies; textile covers for gazebos and marquees; parts, fittings and accessories for the aforesaid goods; ropes for tents and marquees.</p>

46. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

47. In the *Treat* case, [1996] R.P.C. 281, Jacob J. (as he then was) identified the following factors for assessing similarity:

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

Class 6

Transportable buildings of metal; canopies (structures of metal)

48. In my view, these terms in MCD’s specification are identical on the principle outlined in *Meric* with “gazebos [metal structures]” in Gala’s specification.

Metal gazebos; portable gazebos primarily of metal

49. These terms in MCD's specification are identical on the principle outlined in *Meric* with "gazebos [metal structures]" in Gala's specification.

Parts, fittings and accessories for the aforesaid goods; metal tent, gazebo and marquee frames, stakes, pegs, poles, ground bars

50. These terms in MCD's specification are parts and fittings for "gazebos [metal structures]" in Gala's specification. Whilst they will clearly differ in nature and method of use, there will be overlap in trade channels as the same supplier is likely to provide both the finished product and the parts and fittings as replacements. The users are likely to be the same, although I recognise that the goods differ in purpose. The goods are important or indispensable for each other, such that you would expect them to be provided by the same undertaking. Consequently, I consider them to be complementary.³ Taking all of this into account, I consider the goods to be similar to between a medium and high degree.

Class 19

Non-metallic transportable buildings; marquees being structures not of metal or textiles; portable gazebos not primarily of metal

51. These terms in MCD's specification include types of temporary structure which have structures not made of metal. Consequently, they will differ in nature to "gazebos [metal structures]" in Gala's specification, which are clearly made of metal. However, the purpose will be the same as both are used as temporary structures. The method of use will also overlap. The users are likely to be the same and there is likely to be competition between them, as a user could choose to buy a gazebo made of metal or some other material. There is no complementarity. However, I recognise that the same undertakings may provide different types of gazebo and, consequently, there may be an overlap in trade channels. Taking all of this into account, I consider the goods to be highly similar.

³ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

Parts, fittings and accessories for the aforesaid goods

52. These terms in MCD's specification are parts and fittings for types of temporary structure which are not made of metal. Clearly, these will differ in nature and method of use to Gala's goods. However, there is still likely to be an overlap in trade channels as the same businesses are likely to sell different types of temporary structures and their parts and fittings. The users will clearly overlap. The goods are not important or indispensable for each other, as they relate to different types of temporary structure. Consequently, there is no complementarity. I also do not consider there to be any competition between the goods. Taking all of this into account, I consider the goods to be similar to a medium degree.

Class 22

Marquees of textile materials

53. This term in MCD's specification is identical on the principle outlined in *Meric* to "foldable marquee" in Gala's specification.

Tents, awnings, tarpaulins, canopies

54. The term "tents" in MCD's specification would, in my view, include all types of tents (both for personal use, such as those used in camping, and for large-scale use such as marquees). Consequently, I consider this term to be identical on the principle outlined in *Meric* to "foldable marquee" in Gala's specification.

55. I recognise that the terms "awnings, tarpaulins, canopies" in MCD's specification are not the same as marquees. However, they serve the same purpose as all are intended to provide protection from the elements on a temporary basis. They are also likely to overlap in user and method of use. There will also be an overlap in nature, as all of these goods typically include some form of canvas covering. I consider it likely that all of the goods will be sold through the same trade channels. I do not consider the goods to be complementary, although there may be a degree of competition as

users may select different types of temporary structure. Consequently, the goods will be similar to a high degree.

Textile covers for gazebos and marquees; parts, fittings and accessories for the aforesaid goods; ropes for tents and marquees.

56. These terms in MCD's specification could all include parts and fittings for Gala's class 22 goods. Whilst they will clearly differ in nature and method of use, there will be an overlap in trade channels as the same supplier is likely to provide both the finished product and the parts and fittings as replacements. The users are likely to be the same, although I recognise that the goods differ in purpose. The goods are important or indispensable for each other, such that you would expect them to be provided by the same undertaking. Consequently, I consider them to be complementary. Taking all of this into account, I consider the goods to be similar to between a medium and high degree.

Average consumer and the nature of the purchasing act

57. As the case law above indicates, it is necessary for me to determine who the average consumer is for the parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

58. The average consumer for the goods will be members of the general public or business users. I recognise that the cost of the goods is likely to vary and that they are likely to be purchased relatively infrequently. However, various factors will be taken into account such as aesthetics, durability and safety. Taking all of this into account, I consider that at least a medium degree of attention is likely to be paid during the purchasing process.

59. The goods are likely to be purchased by self-selection from a retail outlet or from an online equivalent. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural consideration to the purchase given that advice may be sought from retail assistants.

Comparison of trade marks

60. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

61. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

62. The respective trade marks are shown below:

<p style="text-align: center;">Gala's Marks Applicant for Invalidation (the 256 Marks)</p>	<p style="text-align: center;">MCD's mark The proprietor (the 797 Mark)</p>
<p style="text-align: center;">Pro 50 Pro50 Pro-50 (series of 3)</p>	<p style="text-align: center;">MCD PRO TENT</p>

63. Gala's marks are a series of 3. They differ only in the presence of a gap (or the absence thereof) between the words Pro and the number 50 or in the presence of a hyphen between those elements. I do not consider that any of these alterations alter the marks' distinctive character and, consequently, I will apply the same comparison to all three. The overall impression of the 256 Marks lies in the combination of the elements Pro and 50.

64. The 797 Mark consists of the letters MCD and the words PRO TENT. The words PRO and TENT are descriptive of the goods, being an abbreviation for "professional" and a well-known word used to describe different types of canvas temporary structures. Consequently, the letters MCD are the dominant and distinctive element of the mark.

65. Visually, the marks coincide in the presence of the word PRO which is present in both parties' marks. However, the 256 Marks have the addition of the number 50 which has no counterpart in the 797 Mark. Further, the 797 Mark has the addition of the letters and word MCD and TENT which have no counterpart in the 256 Marks. Taking all of this into account, I consider the marks to be visually similar to a low degree.

66. Aurally, the 256 Marks will be pronounced as PRO-FIFTY. The 797 Mark will be pronounced as EMM-SEE-DEE-PRO-TENT. Only one syllable overlaps and it is in a

different position in each mark. Taking all of this into account, I consider the marks to be aurally similar to a low degree.

67. Conceptually, the marks will overlap to the extent that they both convey the meaning “professional” as a result of the shared abbreviation “pro”. However, the word TENT in the 797 Mark and the number 50 in the 256 Marks will act as points of conceptual difference. I do not consider that the letters MCD will convey any meaning for the average consumer. Taking all of this into account, I consider the marks to be conceptually similar to a medium degree.

Distinctive character of the earlier marks

68. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

69. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

70. I will begin by assessing the inherent distinctive character of the 256 Marks. The 256 Marks consist of the word Pro and number 50. I recognise that one of the marks in the series contains a hyphen and there is some difference in the spacing between the words/numbers. However, I do not consider that this will impact upon the distinctive character of the marks and so the same finding will apply to each of them. The word PRO is a recognised abbreviation for professional. Consequently, I consider it to be descriptive. The number 50 is unlikely to be recognised by the relevant public as having a connection with the goods in question, but is relatively low in distinctiveness. Taking the marks as a whole, I consider the 256 Marks to be inherently distinctive to a low degree.

71. I note that Gala has filed a Structure Assembly & Care Guide for the PRO 50. However, this is undated.⁴ A print out from a website has been provided which shows the PRO 50 gazebo advertised. However, the print out is undated.⁵ A number of invoices have been provided which show use of the mark PRO 50.⁶ These are dated between October 2006 and September 2019. In total, sales of PRO 50 products amount to over £37,000. As the relevant date is in 2018, not all of this is prior to the relevant date. Mr Mace's evidence is that Gala sells over 15,000 tents and marquees each year, along with around 90,000 related accessories. He states that they have supplied customers such as the NHS, the military and police services. However, no breakdown is given as to what proportion of these sales relate to goods sold under the Pro 50 marks. I note that Gala has won a number of awards, but these do not appear to relate to products sold under the 256 Marks.⁷

⁴ Exhibit PRO6

⁵ Exhibit PRO8

⁶ Exhibit PRO10

⁷ Exhibit PRO1

72. I note that an article dated 10 March 2014 lists Gala as having an annual turnover of £5million, but again, there is no breakdown in relation to the relevant goods sold under the relevant marks.⁸ This ties in with a letter provided from Gala's accountant which sets out details of yearly sales and advertising figures for Gala.⁹ This evidence shows that sales rose from around £200,000 in 2000 to over £7million in 2017. This is supported by Mr Mace's narrative evidence. However, no breakdown is provided as to what proportion of these figures relate to the relevant goods sold under the relevant marks. Mr Flint gives evidence that Gala has over 270,000 clients on file. However, there is no information as to how many of these clients purchased the goods in question (or when) and whether any goods sold relate to the marks in issue. Mr Mace has provided Google Analytics information for the number of views his webpages have received between 1 January 2010 and 19 July 2019.¹⁰ Consequently, not all of these views will relate to the period prior to the relevant date. I note that a number of these pages do not appear to refer to the marks relied upon. However, I note that one page which includes the words PRO 50 in the domain name has been viewed over 100,000 times during that period. That amounts to around 11,000 views per annum on average.

73. Taking all of this into account, I am not satisfied that Gala has established the 256 Marks have acquired enhanced distinctiveness through use.

Likelihood of confusion

74. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater

⁸ Exhibit PRO8

⁹ Exhibit GT10

¹⁰ Exhibit GT7

degree of similarity between the goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the 256 Marks, the average consumer for the goods and the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

75. I have found the marks to be visually and aurally similar to a low degree and conceptually similar to a medium degree. I have found the 256 Marks to be inherently distinctive to a low degree. I have found the average consumer to be a member of the general public or a professional user who will purchase the goods predominantly through visual means (although I do not discount an aural component). I consider that at least a medium degree of attention will be paid during the purchasing process for the goods. I have found the goods to vary from identical to similar to a medium degree.

76. Bearing in mind that the purchasing process will be predominantly visual, I consider that the visual differences between the marks will be sufficient to prevent them from being mistakenly recalled or misremembered as each other. I do not consider that the number 50 in the 256 Marks or the words MCD and TENT in the 797 Mark will be overlooked. Consequently, I do not consider there to be a likelihood of direct confusion.

77. In considering whether there is a likelihood of indirect confusion, I bear in mind the decision of the CJEU in *L'Oréal SA v OHIM*, Case C-235/05 P, in which the court confirmed that weak distinctive character of the earlier trade mark does not preclude a likelihood of confusion. However, I also bear in mind the comments of Mr Iain Purvis Q.C., sitting as the Appointed Person, in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

78. It is, therefore, the distinctiveness of the common element which is key. In this case, the common element is the word PRO. I have found this word to be descriptive. In my view, the common use of this descriptive word will be viewed by the average consumer as a coincidence rather than as indicating that the goods are provided by the same or economically linked undertakings. Taking all of this into account, I do not consider there to be a likelihood of indirect confusion.

79. The application for invalidation based upon section 5(2)(b) of the Act is dismissed.

Section 5(3)

80. Section 5(3) of the Act states:

“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 European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

81. As noted above, the 256 Marks qualify as earlier trade marks and are not subject to proof of use.

82. I bear in mind the relevant case law which can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The relevant date for the assessment under section 5(3) of the Act is the date of the application for the contested mark i.e. 18 December 2018.

83. I can deal with this ground relatively swiftly. In order to be successful under section 5(3), Gala is required to demonstrate that it had a reputation in the UK for the 256 Marks at the relevant date. I have summarised the evidence of use above. I have no evidence regarding overall turnover figures for goods sold under the 256 Marks and no evidence of advertising expenditure for these particular goods/marks. The sales information I do have is relatively low scale. Taking all of this into account, I am not satisfied that Gala has established that it had a reputation in the 256 Marks at the relevant date. In any event, I consider that the common use of the descriptive word ‘PRO’ will be viewed as a coincidence rather than giving rise to a link, without which there can be none of the adverse consequences for Gala contemplated by this section of the Act.

84. The application for invalidation based upon section 5(3) of the Act fails.

Section 5(4)(a)

85. Section 5(4)(a) of the Act states 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, where the condition in subsection (4A) is met,

aa) [...]

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”.

86. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

87. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

88. In terms of the relevant date for my assessment under this section, I bear in mind that MCD claims to have been using the mark MCD PRO TENT since 1 June 2016. However, I will begin my assessment by considering the position at the prima facie relevant date in the first instance (18 December 2018), returning only to consider an earlier relevant date if it is necessary to do so.

89. Again, I can deal with this ground relatively swiftly. I have summarised Gala's evidence of use above. Gala, as a business, clearly has a reasonable degree of goodwill in relation to marquees and gazebos. Its overall turnover figures are not insignificant. I also consider it likely that the sign PRO 50/PRO50/PRO-50 has become distinctive of that goodwill, albeit the evidence in relation to the use of these particular signs is less clear.

90. However, even proceeding on that basis, for the same reasons set out above, I consider the differences between the mark and the signs to be too great to result in misrepresentation. The common use of the word PRO is far more likely to be viewed as a coincidence, given its descriptive nature, than leading the relevant public to believe that the goods of MCD are those of Gala. Consequently, I do not consider there to be a misrepresentation and, as a result, there can be no damage.

91. The application for invalidation based upon section 5(4)(a) of the Act fails.

92. Finally, I will now consider MCD's opposition against Gala's application for the 049 Mark.

THE OPPOSITION AGAINST APPLICATION NO. 3338049

93. The opposition is based upon sections 5(4)(a), 3(1)(b), 3(1)(c) and 3(1)(d). I will begin by assessing the section 3(1)(c) ground.

Section 3(1)(c)

94. I have already set out the relevant legislation and case law for this ground above and have taken it into account in reaching my decision.

95. The relevant date is the date of filing of the application i.e. 12 September 2018.

96. I consider that the same assessment in relation to the average consumer will apply here as set out above.

97. For the same reasons set out above, I consider the word “pro” to be a recognisable abbreviation for the word “professional”. Consequently, I consider that it will be viewed by the average consumer as a reference to goods which are of professional quality.

98. The word “tent” is defined in Collins English Dictionary as follows:

“A tent is a shelter made of canvas or nylon which is held up by poles and ropes, and is used mainly by people who are camping.”

“A portable shelter of canvas, plastic, or other waterproof material supported on poles and fastened to the ground by pegs and ropes” (British English)

99. The Oxford English Dictionary defines the word “tent” as:

“A portable shelter or dwelling of canvas (formerly of skins or cloth), supported by means of a pole or poles, and usually extended and secured by ropes fastened to pegs which are driven into the ground; used by travellers, soldiers, nomads, and others; a pavilion; also, a similar shelter erected on a travelling boat or wagon.”

100. These definitions broadly accord with my own understanding of the word and are likely, in my view, to be the definition attributed to the word tent by the average consumer.

101. In my view, the word “tent” as defined above could include both those small personal tents typically used for camping and those larger tents which are more specifically known as marquees and gazebos. I recognise that the word ‘gazebo’ can also be used to refer to more permanent structures (such as those made of wood) erected in gardens or parks. However, in my experience, it also includes temporary forms of the same structure which are typically made of canvas-type materials.

102. When taking the mark as a whole, it is my view that it will be seen as indicating a tent (whether it be a marquee or gazebo) which is of professional quality. This seems to me to be a descriptive term which should be kept available for other traders to use.

103. Taking all of this into account, I consider the mark Pro Tent to be descriptive of the goods applied for.

104. Gala's evidence of use does not appear to me to suggest that the mark Pro Tent has acquired distinctiveness through use.

105. The opposition based upon section 3(1)(c) succeeds in its entirety.

Section 3(1)(b)

106. I have already found Gala's mark to be descriptive under section 3(1)(c). For the same reasons, it will also be devoid of distinctive character. MCD's pleadings do not present any alternative reason (other than descriptiveness) as to why Gala's mark would be non-distinctive.

107. Consequently, the opposition based upon section 3(1)(b) also succeeds in its entirety.

Section 3(1)(d)

108. As I have already found in favour of MCD in relation to the sections 3(1)(b) and 3(1)(c) grounds, I do not consider it necessary to go on to consider this ground any further.

Section 5(4)(a)

109. In the event that I am wrong in my finding that the words Pro Tent are descriptive, I will consider whether Gala's application for the 049 Mark is liable to be prevented by the law of passing off.

110. I have set out the law in relation to section 5(4)(a) above and, whilst I do not intend to repeat it here, I have taken it into account in reaching this decision.

111. As noted above, there is no evidence of Gala having used the mark Pro Tent prior to the application date for the 049 Mark. Consequently, I have only the prima facie relevant date to consider i.e. 12 September 2018.

Goodwill

112. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in customers. It is the one thing which distinguishes an old-established business from a new business at its first start.”

113. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

114. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

115. MCD has filed an instruction manual dated 1 June 2016 which Mr Blacksell states would have been circulated at that time in the UK.¹¹ This displays the words MCD PRO TENT. Mr Blacksell also gives evidence that MCD has sold £293,151.57 worth of goods between 1 June 2016 and 12 September 2018 under the MCD PRO TENT brand. These goods are marquees, gazebos, tents and other related products. MCD has also provided a sample of invoices relating to the period 1 June 2016 to 12 September 2018.¹² These invoices amount to sales of over £30,000. They all refer to the sign MCD PRO TENT, with the exception of 3 which refer to PRO TENT only. All of the invoices relate to gazebos, marquees and parts and accessories for those goods. I bear in mind that the customer information has been completely redacted and, consequently, it is not possible to confirm that all of these invoices relate to UK-

¹¹ Exhibit MB2

¹² Exhibit MB3

based customers. MCD operates a website at mcdprotent.co.uk which displays the following sign:¹³



116. Mr Blacksell has provided a Google Analytics report which he states relates to this website.¹⁴ This confirms that between 1 January 2018 and 11 September 2018, MCD's website had over 120,000 views. Mr Blacksell states that MCD spent over £10,000 on an advertising campaign up to 11 September 2018 which resulted in MCD's adverts being seen by Google users over 8million times.

117. Bearing all of this in mind, I am satisfied that MCD had a reasonable degree of goodwill at the relevant date in relation to gazebos, marquees and parts and accessories for those goods. There is very little use of the words PRO TENT alone. However, I consider that the sign MCD PRO TENT was distinctive of MCD's goodwill at the relevant date.

Misrepresentation and damage

118. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] *R.P.C. 341 at page 407* the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the

¹³ Exhibit MB5

¹⁴ Exhibit MB6

public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]"

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

And later in the same judgment:

"... for my part, I think that references, in this context, to "more than *de minimis*" and "above a trivial level" are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion."

119. The parties are clearly operating in the same field of activity. Gala's mark is Pro Tent and MCD's sign is MCD PRO TENT. The entirety of Gala's mark is replicated in MCD's sign, with the only difference being the addition of the letters MCD at the start. In my view, this will result in at least a medium degree of similarity. I bear in mind that I have found MCD to have a reasonable degree of goodwill. Taking all of this into account, if I proceed as noted above on the basis that PRO TENT does have some degree of distinctiveness (contrary to my primary finding), I consider that a substantial number of members of the relevant public would be misled into purchasing Gala's goods in the mistaken belief that they are the goods of MCD. Damage through diversion of sales is easily foreseeable.

120. The opposition based upon section 5(4)(a) succeeds in full.

CONCLUSION

121. The opposition against application no. 3338049 is successful and the application is refused.

122. The application for invalidation against trade mark no. 3361797 fails.

123. The application for invalidation against trade mark no. 3056256 fails.

COSTS

124. Both parties have each been successful in an invalidation; any costs awarded for the invalidations will cancel each other out and, consequently, I decline to make an award of costs in respect of the invalidations.

125. However, I note that MCD has also been successful in relation to the opposition. Consequently, I will make an award of costs for the opposition only based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award MCD the sum of **£1,350** as a contribution towards its costs as follows:

Preparing a statement of case and considering Gala's statement	£250
Preparing evidence and considering Gala's evidence	£550
Preparing written submissions in lieu	£350
Official fee	£200
Total	£1,350

126. I therefore order Gala Tent Limited to pay MCD Home & Garden (UK) Ltd the sum of £1,350. This sum should be paid within 21 days of the expiry of the appeal

period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 6th day of October 2021

S WILSON

For the Registrar