

**BL O/759/22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3601861**

**BY**

**MYBABYGROW LTD**

**TO REGISTER AS A TRADE MARK**



**IN CLASSES 25 AND 35**

**AND**

**THE OPPOSITION THERETO**

**UNDER NO 426279**

**BY**

**GRO-GROUP HOLDINGS LIMITED**

## BACKGROUND AND PLEADINGS

1. On 27 February 2021, MYBABYGROW LTD ("the applicant") applied to register the above trade mark in classes 25 and 35, for the following:<sup>1</sup>

### Class 25

Clothing; Clothes; Tops [clothing]; Infant clothing; Children's clothing; Childrens' clothing; Babies' clothing; Outer clothing.

### Class 35


Online retail services relating to clothing; Online retail store services relating to clothing; Online retail store services in relation to clothing; Online advertisements; Online marketing; Online advertising; Online ordering services; Retail services relating to clothing; Mail order retail services for clothing.

2. The application was published on 21 May 2021, following which Gro-Group Holdings Limited ("the opponent") filed a notice of opposition against all the goods in the application. It relies on grounds under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (hereinafter "the Act").

3. For the purposes of the 5(2)(b) and 5(3) grounds the opponent relies on the following marks and goods and services:

<b>The opponent's mark</b>	<b>Goods and services relied on</b>
UKTM 2498072: <b>GRO</b> Applied for on 16 September 2008 Registered on 6 July 2012	<b>Class 24</b> sleeping bags (sheeting); swaddling for babies;  <b>Class 25:</b> children's bath robes; children's cuddle robes; dressing gowns; pyjamas; bodysuits

<sup>1</sup> International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

	<p>for babies and toddlers; sleep suits; sleep suits with socks; baby clothing; children's clothing;</p> <p><b>Class 35</b></p> <p>Retail shop services connected to baby sleeping bags, sleeping bags incorporating a cushion for babies, sleeping bags incorporating a pillow for babies, sleeping bags (sheeting); swaddling for babies; children's bath robes; children's cuddle robes; dressing gowns; pyjamas; bodysuits for babies and toddlers; sleep suits; sleep suits with socks; baby clothing; children's clothing;</p>
<p>UKTM 2529376:</p>  <p>Applied for on 20 October 2009 Registered on 14 May 2010</p>	<p>Identical to previous mark.</p>

The 5(2)(b) ground

4. Under this ground the opponent submits that the parties' goods and services are identical or similar. It claims that the marks are highly similar because visually, both marks are dominated by the almost identical words GRO and GROW, which are phonetically identical and share the same concept, meaning or inferring the growth of babies and children. It concludes that imperfect recollection will result in a likelihood of confusion between the two parties' marks.

### The 5(3) ground

5. The opponent claims its GRO marks have been used extensively throughout the UK for the last twenty years and have acquired a reputation. The opponent claims it is known for being an innovator in the baby and infant product market. The opponent claims its reputation is such that consumers, when confronted with the later mark, would create a link with or call to mind the earlier mark. Consequently, use of the applicant's mark would, without due cause, take unfair advantage of the earlier trade mark by free-riding on the opponent's reputation. Further, it is claimed that the opponent would have no control over the applicant's goods sold under the GROW mark which, if of poor quality, would damage the opponent's reputation. Finally, the opponent claims that sale of the applicant's GROW goods would blur the opponent's marks in the mind of the consumer and its own unique character would be lost, in other words, damaging the distinctive character of the opponent's marks.

### The 5(4)(a) ground

6. For the purposes of the 5(4)(a) ground, the opponent relies on the same two marks referred to above, which it claims have been used throughout the UK since 2000, in respect of the same goods and services shown above for which the trade marks relied on are registered.

7. It claims significant goodwill in its business associated with the GRO marks in the UK which, it concludes, would lead a substantial number of the relevant UK consumers, to be misled in to perceiving the applicant's products and/or services as those of the opponent, when they are confronted with the applicant's mark. Consequently, damage would occur through loss of sales and damage to the goodwill of the opponent.

8. The applicant filed a counterstatement in which it denies the grounds of opposition. It put the opponent to proof of use of its earlier trade marks for the claimed goods in classes 24 and 25 and the services in class 35. It disputes the opponent's claim that GRO and GROW are the dominant and distinctive elements of the parties' respective marks. The applicant concludes that due to the lack of similarity the opposition should be rejected on all grounds.

9. The opponent filed evidence. The applicant filed submissions. Both parties filed a skeleton argument in advance of the hearing which took place before me on 13 June 2022.

Ms Lauren Somers of HGF Limited represented the opponent. Mr Chris McLeod of Elkington and Fife LLP represented the applicant.

10. Both sides seek an award of costs in accordance with Tribunal Practice Notice 2/2016.

11. I make this decision having taken full account of all the papers before me and the submissions made by both parties at the hearing.

12. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive and, therefore, this decision continues to refer to the trade mark case law of the EU courts.

## **EVIDENCE**

13. The opponent's evidence is provided by a witness statement of James William Matthew Taylor, who is the chief financial officer for the Mayborn Group (the parent company of the opponent). There are eighteen exhibits attached to Mr Taylor's statement, which is dated 24 January 2022.

14. The applicant accepts the opponent's evidence shows use of its earlier marks in relation to the goods and services on which the opponent relies in this opposition. However, the opponent also claims enhanced distinctiveness under the section 5(2)(b) ground, reputation sufficient to initiate its claim under the 5(3) ground of opposition, and goodwill sufficient to support its passing off claim under section 5(4)(a). I will, therefore, make a brief assessment and provide my conclusions from the evidence filed.

15. The GROBAG baby sleeping bag was launched in 2000. More than 50,000 were sold in the first year on the market. By Autumn 2002, 10,000 were sold per month in the UK. A GROBAG hooded bathrobe was added to the range in 2002.

16. The logo mark was first used in 2009 (hereinafter "the gro company logo").

17. The Gro-Group Companies were purchased by the parent company in 2017, for £22 million.<sup>2</sup>

18. The opponent's goods are sold through the UK website www.tommeetippee.com, the GRO COMPANY amazon store, Argos, ASDA, Boots, John Lewis, Mamas and Papas, Mothercare, Sainsburys, Smyth's toys, Tesco, Home Bargains and Very.

19. Prior to acquisition by the parent company the opponent's goods were also sold through www.gro.co.uk and www.gro-store.com.

### **Turnover and advertising spend**

20. Turnover figures prior to acquisition by the current parent company are as follows:

<b>Year</b>	<b>Turnover</b>
2017	£12,243,000
2016	£12,415,000
2015	£17,558,000
2014	£11,494,000
2013	£10,457,000
2012	£10,945,000
2011	£11,002,000
2010	£9,755,622
2009	£8,547,500
2008	£10,506,371

21. The turnover of sleepwear products sold under the GRO marks in the UK since 2018 and the advertising spend for the same period are as follows:

<b>Year</b>	<b>Turnover</b>	<b>Advertising</b>
2018	£16,500,000	£322,000
2019	£16,600,000	£368,000

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<sup>2</sup> See exhibit JT1.

2020	£16,800,000	£386,000
2021	£16,200,000	£100,000

22. During the period 1 January 2018 to 12 December 2021, approximately 90,000 GRO branded products were sold via the tomme tippee website.

23. Mr Taylor states that the Gro Company logo was first used in 2009. It can be seen in a Christmas catalogue titled 'Bump to 3', dated Christmas 2009.<sup>3</sup> It is the same as the trade mark 2529376 relied on by the opponent in this case.

24. Example pages are provided from the opponent's website, [www.gro.co.uk](http://www.gro.co.uk). These were accessed via 'archive.today'.<sup>4</sup> The first pages are dated 12 May 2013. The gro company logo can be seen in the top left of the page, next to the words, 'the home of safe sleep'. The first page highlights a new design for the 'grobag' product.

25. Additional products listed in those pages are four different bedding designs for toddlers. These are, Swan Lake Gro to Bed, Whale Watching Gro to bed, Ollie the Owl Gro to bed, Many Moons, Gro to Bed.

26. Mr Taylor provides prints of pages accessed via [amazon.co.uk](http://amazon.co.uk). He confirms these were printed in 2021 but points to the 'first available' date for each of the products. These are as follows:<sup>5</sup>

- 'grobag', baby sleeping bag - first available 22 December 2017.
- 'grosnug', swaddle and new born baby grobag – first available 1 January 2018.
- 'groromper', toddler bedding – first available 25 November 2018.
- 'grorobe', hooded toddler bath robe – first available 1 January 2018.
- 'grotobed', toddler zip-in bedding set – first available 1 January 2016.

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<sup>3</sup> See exhibit JT0.

<sup>4</sup> See exhibit JT2.

<sup>5</sup> See exhibit JT3.

27. An article from Insider Media, dated 5 January 2018, refers to the sale of the opponent to the Tommee Tippee brand, for £22m. It states that the Gro Company had pre-tax profits of £1.27m in the previous year and describes the company in the following terms:<sup>6</sup>

*“Gro-Group Holdings, which is behind the baby sleep bag, the Grobag, has since expanded to become a baby sleep brand, offering a range of products for newborns.”*

## **Social media**

28. The opponent has a facebook page which was created in 2011.<sup>7</sup> The gro company logo is shown in the top left with ‘grofriends’ light and sound sleep aid in the featured image at the top.<sup>8</sup> Pages from the account show offers and advertisements posted between January 2016 and January 2020. These include a bundle offer at The Baby Show, posted 2 March 2018, with a discount for the purchase of 2 x grosnugs, 2 x grobags, gro egg and grohush. It also includes advertisements for, inter alia, groromper (posted 17 November 2018 and 3 January 2019), grobath (posted 18 December 2018), grosuits (posted 29 October 2019 and 24 January 2020), grotobed duvet sets (posted 7 August 2019), grotowel (posted 3 October 2019), grorobes (posted 14 May 2019), and a range of Bennie the Bear grofriend products including grobag, grocomforter, groswaddle and grosnug (posted 27 November 2019). The gro company logo is prominently featured in each of the advertisements.

29. The opponent’s holding company has an Instagram page on which it promotes its products, including those of the Gro Company.<sup>9</sup> A competition in August 2019 gave entrants the chance to win a groegg2, a grofriend and a grobag.

30. The opponent’s YouTube account was created in 2009.<sup>10</sup> The pages appear to have been printed after the filing date of the contested application, but the videos shown on the printed pages are in most cases at least two years old. All of the videos have been posted by The Gro Company and the gro company logo features on the front still image of each video. A video titled, ‘An introduction to The Grobag’ has had 51k+ views and is dated 30

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<sup>6</sup> See exhibit JT5.

<sup>7</sup> See exhibit JT8.

<sup>8</sup> This reflects the position at the print date and may not be indicative of how the page has appeared since its creation.

<sup>9</sup> See exhibit JT9.

<sup>10</sup> See exhibit JT10.



September 2013. Grosuit and Groswaddle product demos were posted in 2017 and have had 18.5K views and 435 views, respectively. A grosnug demo is 6 years old and had 53k views. A video introducing the new Grobath range (UK) is dated 2 July 2018 and has had approximately 37k views.

## **Promotion and marketing**

31. Since 2016, the opponent has collaborated with other brands including, inter alia, TRUNKI, MIFFY, Orla Kiely, Royal Devon and Exeter Hospital, PacaPod, Nuna, Tommee Tippee, Walker Books, The Positive Birth Company, Making Memories London, Microscooters UK, The Travel Hack, Naturalmat, Friends of Buburi, The Gloworm Festival and Rob Ryan.<sup>11</sup>

32. Between March 2018 and May 2019 the opponent attended The Baby Show on five occasions. It is described as ‘the largest baby, parenting and pregnancy event’, attracting 70,000 parents.<sup>12</sup> Its Groromper Roadshow was held at various Gymboree Play & Music UK centres on 15,16 and 30 October and 8 and 21 November 2018.<sup>13</sup>

## **Endorsements and awards**

33. The opponent’s grobag, groswaddle and grosnug products were endorsed by the Hip Dysplasia Institute in 2017,<sup>14</sup> and its grobag by the Lullaby Trust in 2018 and 2019. The grosuit was recommended in The Gentle Sleep Book, by Sarah Ockwell-Smith in 2015.<sup>15</sup> The grobag was also reviewed on ‘The Best For Baby’ website, with 26 four and five star customer reviews dated between 28 November 2016 and 4 November 2020.<sup>16</sup> The grobag product was positively reviewed on This Morning on ITV, 28 April 2018 and there is evidence of positive reviews of the grobag products by individual bloggers, such as, myfamilyfever.co.uk, dated 29 February 2016, in which the blogger says: “*We have always used grobags with our babies – in fact it is ten years now since we used our first one...*”<sup>17</sup>

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<sup>11</sup> See exhibit JT11.

<sup>12</sup> See Mr Taylors witness statement, paragraph s 39-40 and exhibit JT12.

<sup>13</sup> See paragraph 39 of Mr Taylor’s witness statement.

<sup>14</sup> See exhibit JT15.

<sup>15</sup> See exhibit JT16.

<sup>16</sup> See exhibit JT17.

<sup>17</sup> See exhibit JT17.

34. The opponent has won the following awards for its GRO products:

2016 Mother and Baby Awards	GOLD AWARD for the THE GRO COMPANY GROBAG
2016 Loved by Parents Award	GOLD BEST SLEEP AID for the THE GRO COMPANY GROSNUG
2016 Best Baby and Toddler Gear Awards	6 awards for the THE GRO COMPANY GROBAG and GROSNUG
2016 Junior Design Awards	SILVER AWARD for the THE GRO COMPANY TRAVEL GROBAG and BRONZE AWARD for the THE GRO COMPANY GROSNUG
2016 Prima Baby and Pregnancy Magazine Awards	GOLD AWARD for the THE GRO COMPANY GROBAG AND GROSNUG
2016 Best Baby and Toddler Gear Awards	GOLD AWARD for the THE GRO COMPANY GROBAG and GROSNUG and CONSUMERS CHOICE AWARD for the THE GRO COMPANY GROBAG
2017 Mother and Baby Awards	GOLD AWARD for the THE GRO COMPANY GROBAG and TRAVEL GROBAG
2018 Made for Mums Awards 2018	GOLD AWARD Parenting Brand of the Year 2018 for the THE GRO COMPANY
2018 Best Baby and Toddler Gear Awards	GOLD AWARD and CONSUMERS CHOICE AWARD for THE GRO COMPANY GROBAG and GORROMPER
2018 Mumsnet Best Baby Sleeping Bag 2018	GROBAG
2021 Made for Mums Awards	SILVER for the GROBAG range
2021 Mother & Baby Awards	SILVER Baby & Child Sleepwear for the GROBAG range

#### How the marks are used

35. The opponent's use of its gro marks is consistently in lower case with the 'gro' element shown in a different colour to the remainder of the product name. For example, the following

are taken from the opponent's amazon store pages and social media pages, which advertise and demonstrate its products:



36. It is shown on the product itself in the following forms:<sup>18</sup>



### Conclusions from the evidence

37. Turnover in the UK for sleepwear in 2020 for the opponent's GRO goods amounted to approximately £16.8 million. Advertising spend for that year was £386,000. Turnover and marketing spend across the opponent's years of trade show a pattern of turnover which has been consistent since 2008. The opponent has updated its range of goods and

<sup>18</sup> These images are taken from the *YouTube* videos already referred to.

introduced new products at fairly regular intervals throughout the period, each of which has been sold by its own name, for example 'groromper' and 'grorobe' under the umbrella of the GRO range of baby and toddler sleepwear and related goods. The opponent operates a website and social media pages which it uses to promote and sell its goods. YouTube, in particular, hosts videos of new products and provides helpful guides such as how to use, for example, the opponent's grosnug and groswaddle products. Again, the evidence shows consistent use of the opponent's social media channels throughout the period for both the promotion of its baby and toddler/young children clothing goods and guidance for the use of those products. The opponent's goods are also available through third party retailers, such as, inter alia, *Tesco*, *Argos* and *John Lewis*.

38. The opponent's gro company logo and GRO prefixed goods have been promoted at baby shows and events, such as the Gloworm Festival as well as through brand tie-ups and collaborations with other well-known baby brands (such as MIFFY and TRUNKI) and designers (such as Orla Kiely and Rob Ryan). The evidence as a whole indicates that marketing spend has been fairly consistent for at least the five years up to the date of these proceedings and there is supporting evidence of new product releases, videos and third party reviews, throughout the period.

39. I have no knowledge of the size of the market for products for babies and toddlers, but what is clear from the evidence is that the opponent's GRO goods form part of that market.

40. GRO solus is used consistently in the opponent's name, The Gro Company, and, prior to takeover of the opponent, to describe the store through which its goods were sold. The marks which consist of GRO and another word, relate to a range of goods which have been added to over the duration of the opponent's business. Use is consistent on the products and in advertising and always features the gro element in a different colour to the additional word, as shown at paragraphs 37 and 38 above. Use in text descriptions and references to the goods shows the gro+ marks in lower case, but commonly in the same colour text.

41. Given the level of turnover, press coverage, advertising and marketing efforts, I have no hesitation in concluding that the opponent has established a considerable reputation for its gro company logo and its GRO+ marks. The evidence as a whole is consistent with a high level of trade under the marks since each of the products was launched.

42. Having carefully considered the opponent's evidence I find that it has enhanced the distinctiveness of its marks through the use made of them, for the following goods and services:

Class 24

Sleeping bags (sheeting); swaddling for babies.

Class 25:

Children's bath robes; children's cuddle robes; dressing gowns; pyjamas; bodysuits for babies and toddlers; sleep suits; sleep suits with socks; baby clothing (nightwear); children's clothing (nightwear).

Class 35

Retail shop services connected to baby sleeping bags, sleeping bags (sheeting); swaddling for babies; children's bath robes; children's cuddle robes; dressing gowns; pyjamas; bodysuits for babies and toddlers; sleep suits; sleep suits with socks; baby clothing (nightwear); children's clothing (nightwear).

43. For the same goods and services, I find that the opponent has a strong reputation in the UK, and I conclude that the goodwill in the opponent's business is identified by those same marks in a way that is sufficient to give it a protectable goodwill for the same goods and services at the relevant date.<sup>19</sup>

**Preliminary issue**

44. In his witness statement, Mr Taylor claims that the opponent has sold a number of products under a 'family of GRO trademarks'. It is not clear under which ground this claim is made, though I note that the only trade marks relied on under the 5(2)(b) and 5(3) grounds are those I have already mentioned in the background to this decision. This point was not pleaded in the opponent's statement of case and no request has been made to add such a claim. Consequently, I cannot give this matter any further consideration.

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<sup>19</sup> The relevant date in this case being the date of filing of the contested application for the purposes of the 5(4)(a) claim. I will return to this if necessary when considering the ground.

## DECISION

### The opposition under section 5(2)(b)

45. Section 5(2)(b) of the Act states:

“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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

46. In making this decision, I bear in mind the following principles 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 great 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 the earlier mark to mind, 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

47. The opponent's marks are earlier marks which are subject to proof of use. This is because, at the date of application of the contested mark, they had been registered for more than five years.<sup>20</sup>

48. The applicant has accepted that the opponent has used its marks for the goods and services for which they are registered.<sup>21</sup>

### **Comparison of goods and services**

49. The applicant accepts that the respective goods and services are identical, similar or complementary. In *Gérard Meric v Office for Harmonisation in the Internal Market*,<sup>22</sup> the General Court stated that:

“29. ...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 fur 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”.

50. The applicant has applied for goods and services including clothing and the retail of clothing. The opponent's earlier marks are registered for, inter alia, baby clothing and child's clothing and the retail of the same. The clothing goods and services of the opponent fall within the broader categories in the application and are therefore identical in accordance with the principle established in *Meric*.

51. I will proceed on the basis of these identical goods and services.

### **The average consumer and the nature of the purchasing act**

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<sup>20</sup> See section 6A of the TMA.

<sup>21</sup> See paragraph 18 of the applicant's submissions dated 4 April 2022.

<sup>22</sup> Case T- 133/05.



52. 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*<sup>23</sup>, 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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

53. The average consumer of these clothing goods and retail services is a member of the general public. Where the clothing is for babies and children then parents and carers of young babies and children will make up the largest proportion of average consumers. However, such goods are also bought by the wider population as, for example, gifts. For all of the goods, the purchasing decision will be influenced more by visual than aural cues, although I accept that the consumer may discuss their purchase with sales staff and so I do not rule out an aural element.

54. The goods are likely to be purchased fairly frequently where they are clothes for babies and young children. For more general clothing, frequency will depend on the nature of the goods. For example, a suit is likely to be purchased less often than a pair of socks. Prices are also likely to vary across the range of goods. I consider that the average consumer would pay a medium degree of attention as they will be conscious of the appearance of the products, their size and price and possibly the method and location of manufacture, where environmental impacts are a concern.

55. Naturally, the same average consumers will access the retail services for the sale of the above mentioned goods. Again, retail services are likely to be encountered visually, either online or on the high street, though I do not rule out an aural element where recommendation places a part in the process. The level of attention paid to the services

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<sup>23</sup> [2014] EWHC 439 (Ch).

will vary but is likely to include factors such as location, delivery options, returns policies, range of goods sold, and so on. Accordingly, it will be at least medium.

### Comparison of marks

Opponent's marks	Applicant's mark
 <p>AND: <b>GRO</b></p>	

56. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.<sup>24</sup>

### Overall impression

57. The largest element in the opponent's earlier gro company logo mark is the three letters 'gro' which are at the centre of the mark. The additional words 'the' and 'company' are subservient in size to the 'gro' element and are less distinctive in the overall mark (one being the definite article and the other describing the nature of a business) if one were to split up the individual words. The word elements are presented in a mid-blue colour. Three petal shapes in shades of green emanate from the top left part of the curve of the letter 'g' in gro. These will not be ignored by the average consumer, particularly as they mark a change in colour from the rest of the mark, but they do not contribute a great deal to the

<sup>24</sup> *Sabel v Puma AG*, para.23.

overall impression, being simply a small decorative embellishment. That said, the construction of 'the gro company' mark is such that the distinctiveness rests, primarily, in the whole mark with the 'gro' element playing a slightly larger role in the overall impression.

58. The opponent's second mark is the three letters GRO. They are presented in capital letters with no additional stylisation. The overall impression rests in the mark as a whole.

59. The applicant's mark is the letters GR followed by a device and then the letter W. The device element is a black lozenge shape with a zip pull in the centre. The top of the lozenge 'edges' has what look to be zip teeth exposed on each side. The presentation of the mark is such that the average consumer is likely to see this zip device element as taking the place of the letter 'O', resulting in the largest part of the mark being the word GROW with a stylized letter 'O'. Underneath this are the words 'MY BABY GROW' in plain black capital letters in a smaller size. These are not descriptive words and whilst they are smaller in presentation they play a role in the overall impression of the whole mark. That said, it is the combination of the letters 'G', 'R' and 'W' with the stylized letter 'O', to form the word GROW which makes the greatest contribution to the mark as a whole.

### **Visual similarity**

60. In its statement of grounds the opponent submits that:

*"8. Visually, both the Opponent's and the Applicant's marks are dominated by the almost identical words GRO and GROW. Within the Applicant's mark, the words MY BABY GROW underneath the much larger word GROW would potentially go unnoticed by consumers, as would the words "the" and "company" within the Opponent's logo mark. So visually, the striking elements of the respective marks are GRO and GROW."*

61. In its written submissions in lieu of evidence the applicant submits:

*"9. Visually, the respective marks bear no overall resemblance, this being more so in the case of the opponent's device mark than its GRO word mark. It is not open to the opponent to decide that the only striking element of the applicant's*

*mark is the word GROW and its logic does therefore not withstand scrutiny. It relies on an artificial dissection which the average consumer would not make.”*

62. The opponent has sought to remove all elements from the visual comparison, other than GRO and GROW. This is not the correct approach to the comparison. As I have already identified, some elements of the marks play a greater role than others, but in making a visual comparison of the marks I will compare both marks as wholes, bearing my earlier conclusions in mind.

#### The earlier logo mark

63. The high point of similarity between the application and the opponent's gro company logo mark is that both could be said to include the letters 'GRO'. However, the opponent's 'gro' is in lower case, while the application begins with large letters 'G' and 'R' in uppercase, which are visually different. The 'O' part of the application is arguably not a letter 'O' being in fact a shape with a zip element. It is only in the context of the surrounding letters GR and W that I find the average consumer is likely to presume the device stands in for the letter 'O'.

64. The remaining elements in the earlier mark are a decorative embellishment and the words 'the', before 'gro' and 'company' after 'gro'. The remaining elements in the application are the letter 'W' and the words 'MY BABY GROW'.

65. Overall, I find these marks visually similar to a very low degree.

#### The earlier word mark

66. The opponent's earlier word mark is the letters GRO. Fair and notional use of this mark allows use in upper or lower case and any reasonable typeface. The 'GR' part of the earlier mark is visually similar overall to the 'GR' part of the application, presented in a slightly stylized typeface.

67. However, the similarity ends there. The 'O' in 'GRO' of the earlier mark is not replicated in the application, the 'O' element being represented by the zip device. The application also includes the 'W' at the end of the word/device part of the mark and the words 'MY BABY GROW' underneath. Neither of these is replicated in the earlier mark. The letters GRO do

feature at the beginning of the smaller word 'GROW' in the application, but I find it highly unlikely that these three letters would be separated from the three words 'MY BABY GROW' and to do so, would likely require side by side analysis of the marks, which is not the correct way to assess them.

68. Overall, I find these marks to be visually similar to a fairly low degree.

### **Aural similarity**

69. Phonetically, the opponent submits that its earlier marks and the application will be pronounced 'grow'.

70. The applicant submits:

*"10. ...A phonetic comparison should rely on how the marks are pronounced as a whole, namely as "groh" and "thu groh cumpanee" versus "groh mai bay-bee groh". There is clearly insufficient similarity for the marks to be considered phonetically similar overall and it is not legitimate for the opponent to base its phonetic assessment on a single word from the applicant's mark."*

### The earlier logo mark

71. The opponent's earlier logo mark will be pronounced, 'the-grow-company'. I see no reason why the average consumer would single out one word from the mark at the expense of others. Whilst 'gro' is the largest word element, it is not the only word element and the construction of the mark is such that I find the average consumer is most likely to verbalise the whole mark.

72. The application may just be pronounced GROW, but I find it more likely that the whole mark will be articulated, resulting in the pronunciation identified by the applicant, of the well-known English words 'GROM MY BABY GROW'. I come to this view on the basis that the words below the largest element in the application follow on from the word grow, they are not simply advertising puffery or non-distinctive hyperbole, which describes the nature of the goods or business. They give rise to a sort of play on words referring to the known product a 'babygrow' and also referring to an encouragement to a person's baby to grow.

73. The comparison to be made is between the applicant's mark, 'the gro company' and the application, 'grow my baby grow'. I find these marks to be aurally similar to a low degree, coinciding only in the sound of the word 'grow', with both including elements that will be verbalized and are not contained in the other mark.

#### The earlier word mark

74. The opponent's earlier word mark will be pronounced 'GROW'. The application will be pronounced, 'grow my baby grow'. I find these marks to be aurally similar to a low to medium degree.

#### **Conceptual similarity**

75. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>25</sup>

76. The opponent submits:

*"10. Conceptually the marks also share the same meaning or inference to the growth of babies and children bearing in mind the goods and services at issue."*

77. The applicant submits:

*"11. The opponent's assessment of conceptual similarity is equally flawed, stating that 'the marks share the same meaning or inference to the growth of babies and children'. The applicant accepts that the GRO/gro element of the opponent's marks arguably alludes to GROW, but this is insufficient for a finding of conceptual similarity. The applicant's mark is both a fanciful exhortation, 'grow, my baby grow!', and, by virtue of the stylised letter O in the first appearance of the word GROW and the consecutive words BABY GROW, an allusion to the generic infant clothing item 'baby grow/babygrow'."*

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<sup>25</sup> This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM [2006]* e.c.r.-I-643; [2006] E.T.M.R. 29.

### The earlier logo mark

78. The opponent's earlier gro company logo mark will be seen as 'the gro company'. Conceptually, the meaning taken from the mark will be that of a company called 'Gro'. It may be seen as relating to the concept of growth, particularly in the context of the goods and services, being clothes for babies and children and retail of the same. Though, it is just as likely to be seen as a company name made up of three letters, with no other meaning.

79. The applicant's mark will be seen as 'GROW MY BABY GROW'. Given that 'grow' is spelled the correct way, it does give the consumer the conceptual message of growth. The mark may be seen as an entreaty or encouragement for the consumer's baby to grow, or, may be seen as a word play on the baby clothing item commonly referred to as a baby grow,<sup>26</sup> or, in fact, both, as these definitions are not mutually exclusive.

80. The high point of conceptual similarity is clearly where both marks evoke a concept of growth. However, this is still in relation to a company, in the earlier mark, and in relation to a play on words in the application. I find there to be, at most, a slightly lower than medium degree of conceptual similarity between these marks. Where the consumer sees 'gro' as simply the name of a company, there is no conceptual similarity.

### The earlier word mark

81. The opponent's earlier GRO mark may be seen as referring to the well understood word 'Grow'. However, in the absence of anything else to qualify it, it is just as likely to be seen as an invented word. I find this mark to be conceptually similar to the application to, at most, a medium degree where the average consumer sees it as reference to the common English word GROW. This finding is caveated by the fact that this will not be the case for all average consumers encountering the respective marks.

### **Distinctive character of the earlier mark**

82. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the services for which it has been used as

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<sup>26</sup> I take judicial notice of the term 'baby grow' used for a type of clothing for babies. I have borne in mind the decision in *Chorkee Ltd v Cherokee Inc.* BL O/048/08.

coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger*.<sup>27</sup>

83. The opponent's gro company logo mark is a combination of elements, already described at length in this decision. The mark as a whole is a normal trade mark capable of distinguishing the opponent's goods and services from those of other undertakings. It has a medium degree of inherent distinctiveness.

84. The earlier word mark 'GRO' may be seen as an invented word and may be seen as akin to the word 'grow'. Where it is seen as an invented word it will have a high degree of inherent distinctiveness. Where the mark is seen as a reference to 'grow' it will be less distinctive in the context of goods for babies and children, though it does not describe characteristics of those goods and services and I still find it to be a normal trade mark of medium inherent distinctiveness.

85. I have already found that due to the consistent use made of these trade marks they have enhanced their distinctiveness to higher than average for at least baby/children's clothes and the retail of the same.

### **Likelihood of confusion**

86. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

87. With regard to the earlier gro company logo mark I have found the marks to be visually similar to a very low degree. Aurally, the marks are similar to a low degree. Conceptually, I have found the high point of similarity to be where the average consumer gives the opponent's 'the gro company' logo a meaning which includes the concept of growth and I

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<sup>27</sup> Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.



have found that it will result in a slightly lower than medium degree of conceptual similarity. For consumers who see 'gro' in the context of the 'the gro company' mark as simply referring to the name of a company and nothing more, there will be no conceptual similarity.

88. With regard to the earlier word mark I have found the marks to be visually similar to a fairly low degree. Aurally, the marks are similar to a low to medium degree and conceptually, I have found the high point of similarity to be medium where the average consumer gives the opponent's GRO mark a meaning of 'growth'. For consumers that see it as an invented word there can be no conceptual similarity.

89. For both earlier marks the average consumer is a member of the general public (including a high number of parents and carers where the goods and services are directed at children and babies), paying at least a medium degree of attention to the purchase, which is primarily a visual purchase, though I do not rule out an aural element. The earlier marks have a medium degree of distinctive character which has been enhanced to higher than average for children's and baby's clothes and retail of the same. This is due to the use made of the marks by the opponent.

90. The types of confusion were explained in *L.A. Sugar Limited v By Back Beat Inc*,<sup>28</sup> by Mr Iain Purvis Q.C., sitting as the Appointed Person:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark."

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<sup>28</sup> BL O/375/10.

91. The opponent's submissions in this case seem to rely on a side by side comparison of the parties' marks, taking account of only the 'GRO' element in both of its earlier rights. Whilst it is true that in making decisions about the likelihood of confusion between competing marks, the decision maker is presented with the marks side by side, that is not the way in which the likelihood of confusion must be assessed. This is particularly pertinent here where it is easy to see how the meaning GROW can be attributed to the opponent's earlier 'gro' marks, where the parties' marks are seen presented next to each other. I must assess the opponent's marks and their likely impressions in the mind of the average consumer in the absence of side by side comparison with the application. This is because that is not how average consumers will encounter the marks. Furthermore, it is not acceptable to engage in artificial dissection of marks in order to arrive at a finding of confusion. In fact, the case law is clear on both of these points.

92. With regard to the opponent's gro company logo mark and the word only mark, I find that there is no likelihood of direct confusion with the application. This is because, for all of the average consumer group, however they interpret the opponent's marks, the differences between the marks are too great for them to be mistaken for each other.

93. I also find that there is no reason for the average consumer to make a connection between the respective marks which would lead to a conclusion that the goods and services of one party originated from or were the responsibility of the other. Having considered the competing submissions and the respective marks carefully, I find that the opponent's case requires too much of the average consumer to take its word mark GRO or its the 'gro' element of its logo mark and carry out the necessary mental gymnastics to arrive at the conclusion that the conflicting marks are in some way connected economically. The GRO element is not replicated in the application other than as part the first three letters of the small word GROW in 'MY BABY GROW'. The main part of the application includes the letters GR and a device. Even where the consumer sees both parties' marks (and this will not be the prevailing view) as referring to a concept of growth, this is not sufficient to overcome the obvious differences between the marks.

94. I have made this assessment based on goods and services which are identical and have found no likelihood of direct or indirect confusion. It follows that for goods and services

which are less similar there will be no likelihood of confusion. Accordingly, I do not intend to consider the opponent's remaining goods and services as they put it in no better position.

### **The opponent's case based on section 5(3) of the Act**

95. Section 5(3) states as follows:

"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...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."

96. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant

consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics

which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

97. Under this ground, the opponent relies on the same marks and evidence as it did in support of its opposition under section 5(2)(b) of the Act. In order to get a case off the ground under section 5(3) the opponent must prove that its earlier mark has a reputation. Given my earlier findings, in the context of the relevant case law outlined above, I find the applicant has demonstrated a fairly strong reputation, in the UK, at the relevant date for clothes for babies and children and the retail of the same.

98. In addition to the earlier mark having a reputation, a link must be made between the mark applied for and the earlier mark. In *Intel Corporation Inc v CPM (UK) Ltd* the CJEU provided guidance on the factors to consider when assessing whether a link has been established. The list includes, as separate factors, the strength of the earlier mark's reputation and the degree of distinctive character, whether inherent or acquired by use. I have already found that the opponent's earlier logo mark and its word mark have a medium degree of inherent distinctive character which has been enhanced through the use made of them.

99. The remaining factors concern the similarity between the parties' respective marks and whether or not there is a likelihood of confusion. Given that I have already found no likelihood of confusion for both earlier marks, the claim that the relevant public will believe that the marks are used by the same undertaking or that there is an economic connection between the users is less likely, though not impossible as it is only one of a number of factors to consider.

100. I bear in mind the reputation that the applicant has shown in respect of its GRO mark and its logo mark for clothing for babies and children and retail of the same. However, the parties' marks contain visual differences which mean that a member of the relevant public encountering the applicant's mark will not bring the earlier marks to mind in any more than the most fleeting manner, which will not be turned into a positive enough link that damage might follow. In other words, any link will be too weak to cause any damage to the earlier

mark's reputation and distinctive character and to give an unfair advantage to the later mark. The same is true of the other heads of damage.

101. The section 5(3) ground fails.

### **The opponent's case under section 5(4)(a) of the Act**

102. Section 5(4) of the Act states:

"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...

(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."

103. Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(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 the 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.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

104. Parker J in *Burberrys v J C Cording & Co Ltd* [1909] 26 RPC 693 said:

"The principles of law applicable to a case of this sort are well known. On the one hand, apart from the law as to trade marks, no one can claim monopoly rights in the use of a word or name. On the other hand, no one is entitled by the use of any word or name, or indeed in any other way, to represent his goods as being the goods of another to that other's injury. If an injunction be granted restraining the use of a word or name, it is no doubt granted to protect property, but the property, to protect which it is granted, is not property in the word or name, but the property in the trade or good-will which will be injured by its use. If the use of a word or a name be restrained, it can only be on the ground that such use involves a misrepresentation, and that such misrepresentation has injured, or is calculated to injure another in his trade or business."

105. 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.”

106. Commenting on *South Cone* 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.”

### **The relevant date**

107. Whether there has been passing off must be judged at a particular point (or points) in time.<sup>29</sup> The filing date of the subject trade mark is 27 February 2021. There is no evidence or claim by the proprietor that it has used its mark prior to this. Accordingly, the matter need

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<sup>29</sup> *Roger Maier and Assos of Switzerland SA v ASOS plc and ASOS.com Limited* [2015] EWCA Civ 220



only be assessed as of that date. The opponent's claim under this ground is based on the same two marks, goods and services as the other grounds I have already considered.

## **Goodwill**

108. The first hurdle for the applicant is to show that it had the required goodwill at the relevant date. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), the Court stated:

“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 custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

109. I have already found that the evidence filed by the opponent is sufficient to show that the opponent had protectable goodwill at the relevant date and that its two registered trademarks were distinctive of that goodwill, being for, at least, clothing for babies and children and retail of the same.

## **Misrepresentation**

110. 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 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.”

111. There is one possible difference between the position under trade mark law and the position under passing off law. In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. As both tests are intended to be normative measures intended to exclude those who are unusually careful or careless (per Jacob L.J. in *Reed Executive Plc v Reed Business Information Ltd* [2004] RPC 40), it is doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes.

112. In making a finding on the issue of misrepresentation, I bear in mind that it is the applicant’s customers or potential customers who must be deceived. In *Neutrogena Corporation and Another v Golden Limited and Another*,<sup>30</sup> Morritt L.J. stated that:

“This is the proposition clearly expressed by the judge in the first passage from his judgment which I quoted earlier. There he explained that the test was whether a substantial number of the plaintiff’s customers or potential customers had been deceived for there to be a real effect on the plaintiff’s trade or goodwill.”

113. There is a difference between mere confusion and deception in passing-off cases. In *W.S. Foster & Son Limited v Brooks Brothers UK Limited*,<sup>31</sup> Mr Iain Purvis QC, as a Recorder of the Court stated that:

“54. Mr Aikens stressed in his argument the difference between ‘mere wondering’ on the part of a consumer as to a trade connection and an actual assumption of such a connection. In *Phones 4U Ltd v Phone 4U.co.uk Internet*

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<sup>30</sup> [1996] RPC 473

<sup>31</sup> [2013] EWPC 18 (PCC)

*Ltd* [2007] RPC 5 at 16–17 Jacob LJ stressed that the former was not sufficient for passing off. He concluded at 17:

‘This of course is a question of degree – there will be some mere wonderers and some assumers – there will normally (see below) be passing off if there is a substantial number of the latter even if there is also a substantial number of the former’.”

114. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. stated:

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant's goods or services.”

115. The opponent’s goodwill rests in clothing for babies and children and retail of the same. The customers in question are likely to be members of the general public including parents and those who care for babies and young children. Taking all the relevant jurisprudence into account and having considered the evidence in detail, I find that use of the applicant’s GROW mark would not lead to a substantial number of the public being deceived as to a connection between the parties and their goods and services. The differences between the marks are such that I do not think even at the high point of connection between the two parties’ respective marks there would be so much as ‘mere wondering’, but even if there were it would not be sufficient for misrepresentation to occur.

116. The application based on section 5(4)(a) of the Act fails.

### **Further comments**

117. I note that even if the opponent has correctly pleaded its ‘family of marks’ argument, it takes its case no further forward. There is nothing about the application that would lead a consumer encountering the applicant’s mark to conclude that it was part of a family of marks connected to the opponent’s undertaking.<sup>32</sup>

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<sup>32</sup> *Il Ponte Finanziaria SpA v OHIM* (“*Bainbridge*”) Case C-234/06 P, EU:C:2007:514.

## **Conclusion**

118. The opposition fails under all of the pleaded grounds.

## **Costs**

119. The opposition having failed, the applicant is entitled to a contribution towards its costs according to the scale of costs provided by Tribunal Practice Notice 2/2016. I have borne in mind that the applicant did not file evidence but did file submissions. The award is as follows:

Preparing a counterstatements and considering the other side's statement:	£400
Considering the other side's evidence:	£600
Preparation for and attending a hearing	£800
<b>Total:</b>	<b>£1800</b>

120. I order Gro-Group Holdings Limited to pay MYBABYGRO LTD the sum of £1800. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 5th day of September 2022**

**Al Skilton**

**For the Registrar,**

**the Comptroller General**