

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NOS. 3756077 AND 3760642  
IN THE NAME OF DERRY GREEN**

**AND CONSOLIDATED OPPOSITION NOS. OP000433951 AND OP000434340 BY  
BACKWOODSMAN LIMITED**

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**DECISION**

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**Introduction**

1. This is an appeal against a Decision of Teresa Perks, acting on behalf of the Registrar of Trade Marks, dated 18 May 2023 (O-0470-23)(“*the Decision*”). In the Decision the Hearing Officer allowed two consolidated oppositions brought by Backwoodsman Limited (“*the opponent*”) to Trade Mark Application Nos 3756077 and 3760642 made in the name of Derry Green (“*the applicant*”).
2. On 17 February 2022, the applicant filed an application to register Trade Mark Application No 3756077 (“*the ‘077 application*”) for the words ‘The Secret Garden Glamping’ with respect to certain services in class 43.
3. On 1 March 2022, the applicant filed an application to register Trade Mark Application No 3760642 (“*the ‘642 application*”) for the sign set out below with respect to certain services in class 43.



4. On 1 June 2022 and 20 June 2022 the opponent opposed the applications on the basis of sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“*the 1994 Act*”). For the purposes of this appeal only the section 5(2)(b) and section 5(3) grounds of opposition are relevant and I therefore say not more about the section 5(3) ground of opposition in this decision.
5. For the purposes of section 5(2)(b) the opponent relied upon two earlier registered trade marks:

- (1) UK00002542311 (series of 2)(“*the ‘311 earlier mark’*”)

THE SECRET GARDEN PARTY  
SECRET GARDEN PARTY

Filed on 18 March 2010 and registered on 20 August 2010.

- (2) UK00801066674 (“*the ‘674 earlier mark’*”)

THE SECRET GARDEN PARTY

Filed on 17 September 2010 and registered on 5 January 2012.

6. Under these earlier marks the opponent relied upon a some of the registered services that were registered in Class 43.
7. Both marks were subject to the proof of use requirements pursuant to section 6A of the 1994 Act.
8. Under section 5(4)(a) the opponent relied upon the sign ‘THE SECRET GARDEN PARTY’ and claimed to have used the sign throughout the UK since 2002 in respect of ‘*organising and staging musical events, festivals*’ (Class 41); and ‘*provision of temporary accommodation; provision of camping services*’ (Class 43). The opponent maintained that it had established goodwill through extensive use of the sign throughout the UK and that the use of the contested marks would be a representation likely to cause damage to that goodwill.
9. The applicant filed counterstatements in which it denied the claims made and put the opponent to proof of its services.
10. Both parties filed evidence during the evidence rounds and written submissions dated 14 October 2022 were filed on behalf of the opponent.
11. The opponent was represented by Lewis Silkin LLP and the applicant by The Trademark Helpline. Neither party asked to be heard. Written submissions in lieu of attendance were filed on behalf of the opponent. Accordingly the Hearing Officer took her decision on the papers before her.

### **The Hearing Officer’s Decision**

12. I turn to the Hearing Officer’s Decision in so far as it is relevant for the purposes of the present appeal.
13. The Hearing Officer first considered proof of use of the earlier registered trade marks under section 6A of the 1994 Act. At paragraph [36] of the Decision the Hearing Officer held that there had been genuine use of the marks within the relevant period. The Hearing Officer then turned to the question of what the fair specification and

concluded in paragraph [42] that a fair specification on the basis of the use made or the marks was:

**Class 43:** *reservation services for campground accommodation; information relating to all the foregoing provided on-line from a computer database via the internet.*

14. The Hearing Officer then considered the section 5(2)(b) ground of opposition and found:
  - (1) That with respect to all of the services in issue that they were either: (a) identical (paragraphs [56] and [57] of the Decision); or (b) similar to a very high or high degree (paragraphs [58] and [60] of the Decision); or (c) similar to a medium degree (paragraphs [59] and [61] of the Decision).
  - (2) That the average consumer for the parties' services were holiday makers who are members of the general public or business users. That the purchasing process would be predominately visual; and that the average consumer would pay at least a medium degree of attention and in the case of higher cost services a higher than medium degree of attention (paragraph [63] of the Decision).
  - (3) That with respect to the '077 application the marks were visually and aurally similar to a medium to high degree; and conceptually similar to a high degree (paragraph [70] of the Decision).
  - (4) That with respect to the '642 application the marks were visually similar to a low degree; aurally similar to a high degree; and conceptually similar to a high degree (paragraph [71] of the Decision).
  - (5) That the earlier marks were inherently distinctive to a medium degree but that the distinctive character had not been enhanced through use (paragraphs [74] and [75] of the Decision).
  - (6) That there was a likelihood of direct confusion with the '077 application (paragraph [79] of the Decision); and a likelihood of indirect confusion with the '642 application (paragraph [80] of the Decision).
15. The opposition under section 5(2)(b) was therefore upheld (paragraph [81] of the Decision).
16. As to the section 5(4)(a) ground of opposition the Hearing Officer first considered the relevant date for the assessment and found in paragraph [97] as follows:
  97. The applicant filed evidence stating that it has been trading under the name 'THE SECRET GARDEN' since April 2020, however, none of the published articles it produced refers to the

‘THE SECRET GARDEN’ in a trade mark sense, but they say that the applicant turned his back garden into a Love Ireland replica (and a glamping site open for booking) and that his children refer to it as the secret garden. That it is not use as a trade mark. The first use of the words ‘THE SECRET GARDEN GLAMPING’ as a trade mark appears in a number of awards that the applicant won in 2021, however, it is not possible to determine the exact date. Hence, I will proceed on the basis that the relevant dates are the filing dates of the applications.

17. The Hearing Officer then went on to find at paragraph [98] that the opponent had sufficient goodwill in relation to the provision of temporary accommodation and camping services at the relevant dates to sustain an action for passing off (paragraph [98] of the Decision).

18. In paragraph [99] the Hearing Officer concluded as follows:

99. I recognise that the test for misrepresentation is different to that for likelihood of confusion because misrepresentation requires “a substantial number of members of the public are deceived” rather than considering whether the “average consumer is confused”. However, as recognised by Lewinson (sic) L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. I believe that to be the case here. Further, the opponent’s case under this ground is stronger than that under Section 5(2)(b) because all of the services at issue are identical or highly similar. Accordingly, I find that a substantial number of the opponent’s customers will be misled into purchasing the applicant’s services in the belief that they are those of the opponent, for essentially the same reasons that I set out when considering the likelihood of confusion under Section 5(2)(b). Damage is made out. The opposition under Section 5(4)(a) succeeds.

19. The outcome of the consolidated oppositions was that the applied for marks were refused registration (paragraph [100] of the Decision).

### **The Appeal**

20. On 15 June 2023 a form TM55P together with a Continuation Sheet containing a statement of the reasons for appeal were filed on behalf of the applicant. The reasons for appeal are in narrative form but are broadly:

(1) Section 5(2)(b):

- (a) That the Hearing Officer has placed too much weight on the aural similarities between the disputed marks;
- (b) That the Hearing Officer erred in concluding that the words ‘glamping’ and ‘party’ were negligible in distinguishing between the contested marks;
- (c) That the Hearing Officer was wrong to describe the word ‘glamping’ as descriptive of the services and therefore not a dominant feature of the marks in suit; and
- (d) That the word ‘party’ is equally descriptive of the opponent’s services and is a key indicator of what the mark is used for namely an annual summer festival.

Had the Hearing Officer not made these errors she would not have concluded that there was a likelihood of confusion.

(2) Section 5(4)(a):

- (a) That the Hearing Officer erred in disregarding the evidence that showed usage of the applicant’s marks prior to 2022; and
- (b) That on the same basis a relied upon under section 5(2)(b) the Hearing Officer should not have held that there was a likelihood of misrepresentation or damage.

Had the Hearing Officer not made these errors she would not have concluded that the section 5(4)(a) ground of opposition had been made out.

- 21. No Respondent’s Notice was filed.
- 22. The hearing of the appeal took place via video link on 16 November 2023. At that hearing the applicant was represented by Mr Steve Dobson of The Trademark Helpline who had also filed a skeleton of argument in advance of the hearing. The opponent did not appear and was not represented having taken no part in the appeal proceedings.

**The Standard of Review on Appeal**

- 23. An appeal against decisions taken by the Registrar is by way of review. Neither surprise at a Hearing Officer’s conclusion, nor a belief that he or she has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is

warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong. See Reef Trade Mark [2003] RPC 5; and Actavis Group PTC v. ICOS Corporation [2019] UKSC 1671 at [78] to [81].

24. Moreover, where the decision below involves the making of a value judgment the decision maker on appeal must be especially cautious about interfering with that judgment on appeal: see most recently Actavis (above) at [80]:

80 What is a question of principle in this context? An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. What is the nature of such an evaluative error? In this case we are not concerned with any challenge to the trial judge's conclusions of primary fact but with the correctness of the judge's evaluation of the facts which he has found, in which he weighs a number of different factors against each other. This evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible:

*Assicurazioni Generali SpA v Arab Insurance Group (Practice Note)* [2002] EWCA Civ 1642; [2003] 1 WLR 577, paras 14-17 per Clarke LJ, a statement which the House of Lords approved in *Datec Electronic Holdings Ltd v United Parcels Service Ltd* [2007] UKHL 23; [2007] 1 WLR 1325, para 46 per Lord Mance.

25. Sir Anthony Mann in Stitch Editing Limited v. TikTok Information Technologies Ltd [2023] EWHC 1167 (Ch) conveniently summarised the approach in cases such as the present at paragraphs [6] to [8]:

6. The correct approach to appeals such as this has recently been confirmed in the decision of Richards J in *Instagram LLC v Meta 404 Ltd* [2023] EWHC 436 (Ch) . In that case (which was another trade marks appeal case) the judge followed the guidance to be applied in appeals generally and set out in *Volpi v Volpi* [2022] EWCA Civ 464

- “i) An appeal court should not interfere with the trial judge's conclusions on primary facts unless it is satisfied that he was plainly wrong.
- ii) The adverb "plainly" does not refer to the degree of confidence felt by the appeal court that it would not have reached the same conclusion as the trial judge. It does not matter, with whatever degree of certainty, that the appeal court considers that it would have reached a

different conclusion. What matters is whether the decision under appeal is one that no reasonable judge could have reached.

iii) An appeal court is bound, unless there is compelling reason to the contrary, to assume that the trial judge has taken the whole of the evidence into his consideration. The mere fact that a judge does not mention a specific piece of evidence does not mean that he overlooked it.

iv) The validity of the findings of fact made by a trial judge is not aptly tested by considering whether the judgment presents a balanced account of the evidence. The trial judge must of course consider all the material evidence (although it need not all be discussed in his judgment). The weight which he gives to it is however pre-eminently a matter for him.

v) An appeal court can therefore set aside a judgment on the basis that the judge failed to give the evidence a balanced consideration only if the judge's conclusion was rationally insupportable.

vi) Reasons for judgment will always be capable of having been better expressed. An appeal court should not subject a judgment to narrow textual analysis. Nor should it be picked over or construed as though it was a piece of legislation or a contract.”

7. So far as the decision below is evaluative, an appellate court should also approach the appeal with caution:

"76. So, on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out a balancing task afresh but must ask whether the decision of the judge was wrong by reason of some identifiable flaw in the judge's treatment of the question to be decided, "such as a gap in logic, a lack of consistency, or a failure to take account of some material factor, which undermines the cogency of the conclusion". ( *Re Sprintroom Ltd* [2019] EWCA Civ 932)

8. And last, as Richards J observed in *Instagram* , proper respect should be paid to the decision of an expert tribunal in the field in question:

"26. Finally, it is relevant to observe that this is an appeal from a tribunal with particular expertise. As Lady Hale observed in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49 at paragraph 30 , the court should approach the appeal on the basis that it is probable that an expert tribunal,

charged with applying the law in their specialist field, has probably got it right."

I shall approach this appeal with those principles in mind.

26. I have kept these principles firmly in mind in considering the issues before me.

### **Decision**

#### **Section 5(2)(b)**

27. There are two preliminary points under this point.

28. First, it is not suggested on this appeal that the Hearing Officer failed to identify the relevant case law that set out the relevant principles for assessment under section 5(2)(b) of the 1994 Act. Rather it is suggested that the Hearing Officer misapplied the principles to the multifactorial assessment that she was required to make.

29. Second, in so far as submissions were made before me based upon differences between the actual or 'real life' business activities of the applicant and the opponent these are not relevant for the purposes of the assessment for the reasons correctly explained by the Hearing Officer at paragraph [55] of the Decision as follows (footnotes excluded):

55. These points are irrelevant because the particular segment of the market in which the opponent has so far chosen to trade does not deprive the opponent's marks of the normal level of protection afforded to every registered trade mark; this means that I must consider notional and fair use of the opponent's marks across all segments of the markets for the services for which it is registered (and has been genuinely used). Likewise, so far as the applicant's proposed use of his mark is concerned, when assessing the likelihood of confusion in the context of registering a new trade mark it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. Neither of the points raised by the applicant are reflected in the marks' specifications and, accordingly, I dismiss the applicant's arguments.

30. The first criticism of the Decision is that the Hearing Officer placed too much weight on the aural similarities between the disputed marks however the applicant did not identify any part of the Decision where it was suggested that this was the case. In fact it seems to me that the Hearing Officer did not do so. In the case of the comparison of the marks in issue the Hearing Officer correctly analysed the issue from each of a visual, aural and conceptual perspective and made findings. In the case of the Hearing Officer's assessment of the likelihood of confusion the only particular reference to the verbal element was in the context of '642 mark and that was only to correctly note that the only coincidence between the marks in issue was in the verbal element 'THE SECRET GARDEN'.

31. The second criticism of the Decision is that it is said that the Hearing Officer erred in finding that the words ‘glamping’ and ‘party’ were negligible in distinguishing between the contested marks. The Hearing Officer made no such finding.
32. At paragraphs [67] and [68] the Hearing Officer made clear that she considered that the words in the marks would be ‘*seen as a single composite phrase, no single word or words dominating the mark*’. She then went on to make the assessment of similarity and clearly considered the words ‘glamping’ and ‘party’ in that context. It is fair to say that the Hearing Officer considered as one element of that comparison that the word ‘glamping’ was descriptive for the services which she had found were the relevant ones for the purposes of the comparison but that was something that as a matter of principle it was open to her to do.
33. Moreover, that is not surprising given the submissions made at the appeal hearing before me (although not in evidence before the Hearing Officer or before me) that the word ‘glamping’ had been included in the Oxford English Dictionary since 2016. Given that submission it seems to me that there is also nothing in the third criticism made by the applicant.
34. Lastly, for the reasons set out above by reference to paragraph [55] of the Decision the fact that the real life use by the opponent of its mark was with respect to an annual summer festival is not something that was relevant to the assessment that the Hearing Officer was required to make.
35. Further, it seems to me that against this background that if the points raised by the applicant were to be considered afresh by me then as stated by Geoffrey Hobbs QC sitting as the Appointed Person in NICO LONDON Trade Mark (O-338-20) at paragraph [36]:
- . . . the Decision would end up being re-taken by this Tribunal under the guise of reviewing it for error. However, it is necessary in order to maintain the required distance between the role of decision taker at first instance and the role of decision taker on appeal for this Tribunal to proceed on the basis that the Decision below should stand unless the matters on which the Opponent relies are by force of what they reveal sufficient to establish that the Decision is vitiated by error.
36. I have reviewed the Decision in the light of the alternatives put forward by the applicant. Having done so I am satisfied that none of the points relied upon reveal any errors on the part of the Hearing Officer which taken either individually or together establish that the conclusion she reached under section 5(2)(b) is one that is vitiated by error. Rather it is one that it seems to me that it was open to the Hearing Officer to reach for the reasons that she gave.

Section 5(4)(a)

37. At paragraph [96] of the Decision the Hearing Officer identified the relevant principles applicable to determining the relevant date for the assessment under section 5(4)(a) of the 1994 Act. She did so by reference to a decision of Daniel Alexander QC sitting as the Appointed Person in Advanced Perimeter Systems Limited v. Multisys Computers Limited (O-410-11). Quite rightly there is no suggestion on this appeal that the Hearing Officer failed to identify the correct principles to be applied.
38. However the point that is taken on this appeal is that the Hearing Officer did not correctly apply the principles and that rather than make the assessment on a date when the applicant first used the mark 'THE SECRET GARDEN GLAMPING'; the Hearing Officer instead made the assessment by reference to the application dates namely 17 February 2022 with respect to the '077 application and 1 March 2022 with respect to the '642 application.
39. In particular what is said on behalf of the applicant is that there was evidence before the Hearing Officer contained in Exhibits DG3 and DG4 which showed *inter alia* that the applicant had been given an award by Lancashire Tourism Board dated 2021.
40. It is clear from paragraph [97] of the Decision that the Hearing Officer was aware of this evidence relating to the awards as she expressly refers to it. What she found in relation to this material was as follows '*The first use of the words 'THE SECRET GARDEN GLAMPING' as a trade mark appears in a number of awards that the applicant won in 2021, however, it is not possible to determine the exact date. Hence, I will proceed on the basis that the relevant dates are the filing dates of the applications*'.
41. I have reviewed the witness statement filed on behalf of the applicant together with the exhibits. It seems to me that on the basis of the evidence before the Hearing Officer it was open to her to find that there was no material before her that enabled her to determine the exact date or dates upon which the awards were made. I further note that there is no challenge on this appeal to the finding by the Hearing Officer that the first use of the words 'THE SECRET GARDEN GLAMPING' as a trade mark was with respect to a number of awards in 2021. Against that background it seems to me that it was also open to the Hearing Officer to take the view that it was appropriate for her to proceed to make the assessment as at the filing dates of the applications in issue as no other *specific* date or dates having been the subject of evidence.
42. I am further confirmed in my view by the fact that the evidence of filed on behalf of the applicant contained no specific date or dates in relation to the awards in circumstances where in paragraph [98] of the Decision that the Hearing Officer made findings in relation to turnover between two periods the first 2013 and 2017 and the second between 26 September 2021 and 1 March 2022 on the basis of the evidence filed on behalf of the opponent. That is to say it was clear that evidence of the precise

date or date(s) on which the first use was alleged to have been made by the applicant were material to the findings that the Hearing Officer was being asked to make.

43. It would also seem that even if the earlier date could be relied upon by the applicant i.e. a date in 2021 the findings of the Hearing Officer in paragraph [98] would suggest that the opponent's would have nonetheless have succeeded being able to rely upon the evidence of use between 2013 and 2017. However nothing turns on this and therefore I make no finding with respect to the same.
44. The second ground of appeal in respect of section 5(5)(a) of the 1994 Act was that the appeal should be allowed on the same basis as the appeal under section 5(2)(b) of the 1994 Act should be allowed. As I have dismissed the appeal against the Hearing Officer's finding under the section 5(2)(b) ground it follows that the appeal on the section 5(4)(a) grounds should likewise be dismissed.

### **Conclusion**

45. For the reasons set out above it does not seem to me that the applicant has identified any error of principle or material error in the Hearing Officer's Decision. Moreover, it is not in my view appropriate to interfere with the evaluations that the Hearing Officer made in reaching the decision that she did. In the result the appeal fails and is dismissed.
46. As the appeal has been dismissed the opponent is entitled to a contribution towards its costs. However, as noted above, the opponent has elected to play no part in the appeal and must therefore be taken not to have incurred any costs in that regard. I therefore make no order for costs on the appeal.
47. The Hearing Officer ordered the applicant to pay the opponent a contribution of £1,250 with respect to its costs at first instance. In those circumstances I order Derry Green to pay £1,250 to Backwoodsman Limited on or before 4 pm on Tuesday 12 December 2023.

Emma Himsworth KC

Appointed Person

21 November 2023