

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2199292 BY  
ATCO-QUALCAST LIMITED TO REGISTER A  
TRADE MARK IN CLASS 7**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER  
NO 50931 BY J C BAMFORD EXCAVATORS LIMITED**

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### **BACKGROUND**

1. On 5 June 1999 Acto-Qualcast Limited applied to register the following series of three trade marks in Class 7:-

FASTRAK  
FASTRAC  
FASTRACK

and the specification of goods applied for reads as follows:-

“Horticultural equipment, machinery and/or apparatus; machines and mechanically operated hand tools and instruments, all for use in horticulture; lawnmowers and grass-cutting machines; lawn rakers; scarifiers; grass collecting apparatus and/or systems for lawnmowers and grass-cutting machines; removable cylinder cassette mechanisms, blade mechanisms and/or lawn raking mechanisms for use with the aforesaid goods; suction machines; garden vacuum machinery and/or apparatus; hedge trimmers and hedge cutters; parts and fittings for all the aforesaid goods, but not including tyres for vehicle wheels, tyre casings, inner tubes or valves; all the aforesaid goods being for domestic use.”

2. The application was accepted by the Registrar and published in the Trade Marks Journal. On 20 April 2000 Forrester Ketley & Co on behalf of J C Bamford Excavators Limited filed a Notice of Opposition against the application. In summary, the grounds of opposition were:-

- (i) Under Section 5(2)(a) of the Act because the mark applied for is identical with earlier trade marks owned by the opponent and is to be registered for goods which are similar to those for which these earlier marks are protected. Details of these earlier marks are listed at Annex One to this decision.
- (ii) Under Section 5(3) of the Act because the trade marks applied for are identical to the above mentioned trade marks owned by the opponent and in the event

that the goods for which the opponent's trade marks are protected are not deemed to be similar, is to be registered for goods and services which are not similar to those for which the opponent's marks are registered, and those trade marks have a reputation so that use of the applicant's mark without due cause would take advantage of or be detrimental to the distinctive character or repute of the earlier marks.

- (iii) Under Section 5(4)(a) of the Act by virtue of the law of passing off.
- (iv) Under Section 3(6) of the Act because the application was made in bad faith as prior to making the application the applicant sought consent from the opponent to registration of the applicant's mark and the opponent indicated its refusal to give such consent.

3. The applicants, through their agent William Jones, filed a Counterstatement denying the grounds of opposition. Both sides have filed evidence and the matter came to be heard on 6 March 2002 when the opponents were represented by Mr Mitcheson of Counsel instructed by Forrester Ketley & Co and the applicants by Mr Roberts of Counsel instructed by William Jones.

### **Opponent's Evidence**

4. This consists of a statutory declaration by Guy Walker Robinson dated 26 March 2001. Mr Walker is the Managing Director of JCB Landpower Limited, a sister company of the opponent which uses the trade mark FASTRAC under the license of, and with the permission of the opponent.

5. Mr Robinson states that the trade mark FASTRAC was first used in the UK in 1991 by JCB Landpower Limited (JCB) under License of the opponent and at Exhibit "GWR 1" to his declaration is a copy of an internal JCB group license formal document between the opponent and JCB. He adds that the trade mark FASTRAC has been continuously used by JCB since 1991 in the UK and confirms that use has been by the opponent and JCB on "agricultural vehicles and tractors, all being wheeled; parts and fittings for all the aforesaid goods; all included in Class 12; but not including tyres for vehicle wheels or any goods of the same description and tyres for vehicle wheels" - the opponent's goods. Mr Robinson draws attention to Exhibit GWR 3 to his declaration comprising the following examples of literature demonstrating current and historic use of the mark FASTRAC - a general brochure on the JCB FASTRAC range dated 11/00, a brochure in respect of the JCB FASTRAC model 3155/3185, dated 11/00 and a brochure of JCB FASTRAC models 150, 155m and 185m dated 9/95. The only brochure which falls within the relevant date is the 9/95 brochure which relates to military tractors.

6. Mr Robinson goes on to state that the UK sales turnover figures (calculated at the wholesale price) for the opponent's goods sold under the FASTRAC mark since 1991 are as follows:-

<b>YEAR</b>	<b>VALUE (£000)</b>	<b>QUANTITY</b>
1999	£12,184	309 units
1998	£ 9,407	238 units
1997	£16,368	441 units
1996	£22,677	597 units
1995	£17,174	473 units
1994	£10,177	260 units
1993	£ 7,259	208 units
1992	£ 3,776	113 units
1991	£ 3,459	110 units

7. Mr Robinson explains that JCB sells the goods throughout a dealer network and at Exhibit GWR 4 to his declaration is a leaflet entitled “where to find your nearest JCB Landpower Dealer” and this exhibit lists 53 dealers who sell FASTRAC products.

8. Turning to marketing and promotion, Mr Robinson states that the following sums have been spent by JCB and the opponent, in promoting sales of the opponent’s goods bearing the trade mark FASTRAC, in the 9 years prior to the date on which the application was filed, by means of (a) Advertising Artwork (b) Advertising Literature (c) Market Research (d) Public Relations (e) Photography (f) Show Expenses (g) Miscellaneous other publicity

<b>Year</b>	<b>(a) (£000)</b>	<b>(b) (£000)</b>	<b>(c) (£000)</b>	<b>(d) (£000)</b>	<b>(e) (£000)</b>	<b>(f) (£000)</b>	<b>(g) (£000)</b>	<b>Total (£000)</b>
<b>1999</b>	56	185		63	1	51		356
<b>1998</b>	16	95		43	8	38		200
<b>1997</b>		331		74	8	85		498
<b>1996</b>		416		93	25	148		682
<b>1995</b>		297		155	26	140		618
<b>1994</b>		238		112		67		417
<b>1993</b>	39	179		51		79	81	429
<b>1992</b>	123	20		48	12	120	25	348
<b>1991</b>		282	58		39	201		580

9. Mr Robinson explains that the dealers of the opponent’s agricultural dealership network, including those listed in Exhibit GWR 4 hereto, do not deal exclusively in the opponent’s goods, and moreover nor do the opponent’s dealers sell only goods which are appropriate to large scale agricultural use. He states it is common for such dealerships to sell a wide range of agricultural and horticultural goods, including general agricultural and horticultural equipment, machinery and/or apparatus, including machines and mechanically operated hand tools, lawnmowers and grass cutting machines, lawn rakers; scarifiers; grass collecting apparatus,

suction machines (pumps), hedge trimmers and hedge cutters and parts and fittings for all such goods. Mr Robinson refers to Exhibit GWR 5" which comprises a list of some of the opponent's dealers listed in Exhibit "GWR 4" which, he states, indicates a range of different manufacturers whose products generally are sold by the respective dealers and he adds that it can be seen that the applicant's products are sold by at least two of the opponent's and JCB's dealers as are products of major competitors of the applicant.

10. Next Mr Robinson refers to his, Exhibit "GWR 6", a collection of brochures and other promotional materials obtained from the dealer at Oliver & Sons Limited, which is listed in Exhibit "GWR 4". He states that these brochures show that the dealer deals in a very wide range of agricultural and horticultural equipment and apparatus of various other manufacturers. These items are:-

- (i) Brochures of goods, namely Allen lawn cutting and treating apparatus - sit upon tractor mowers;
- (ii) Gravely brochure for walk behind agricultural machines - tractor/mowers on back page;
- (iii) Jonsered 2000 brochure for general agricultural/horticultural machinery - lawn mowers on pages 39/40;
- (iv) Tanaka brochure for powered general agricultural equipment;
- (v) Toro small garden tractors for mowing and grass collection;
- (vi) Kawasaki brochure for a range of brush cutters, blowers and hedge trimmers;
- (vii) Kawasaki brochure for all terrain vehicles which are a species of "mini-tractor" and use for exactly the same tasks as a tractor, although on a lighter scale;
- (viii) Toro Greensmaster 3200 brochure featuring "sit-upon mowers (note Toro make tractors too - see 11.4 above);
- (ix) IPU Group commercial mowers brochure

11. Mr Robinson goes on to refer to Exhibit GWR 7 to his declaration which comprises a collection of brochures and other promotional materials obtained from the dealer Stalham Engineering Co Ltd, listed in Exhibit GWR 4. He states that these brochures again show that the dealer deals in a very wide range of agricultural and horticultural equipment and apparatus of various other manufacturers. Those items are:

- (i) Makita Outdoor Power brochure featuring a wide range of agricultural/horticultural equipment including mowers.
- (ii) Flymo brochure of mowers, strimmers, trimmers and vacuums;

- (iii) Qualcast brochure of mowers, strimmers, trimmers and vacuums;
- (iv) Mountfield brochure of mowers;
- (v) Toro mowers.

12. At Exhibit GWR 8 to Mr Robinson's declaration are a collection of brochures and other promotional materials obtained from the dealer G & J Peck Ltd, listed in Exhibit GSR 4. These brochures show that the dealer deals in a very wide range of agricultural and horticultural equipment and apparatus of various other manufacturers. These items are:-

- (i) Honda brochure for lawn and garden equipment including "sit-upon" mowers;
- (ii) Qualcast mowers brochure;
- (iii) Bosch brochure of garden tools including mowers; Allen brochure of power (including "push" and "sit-upon") tractor mowers;
- (iv) Atco brochure featuring a wide range of equipment including lawn mowers etc.
- (v) Honda brochure of power equipment for use on the land, including "power carriers", which are a kind of walk behind "mini" tractor;
- (vi) Husqvarna brochure 2000, for wide range of agricultural and horticultural equipment including tractors, some of which are adapted for mowing;

13. At Exhibit GWR 9 to Mr Robinson's declaration are a collection of brochures and other promotional materials obtained from the general agricultural equipment dealer Framlington Tractors which is part of Trac-Systems Limited. These brochures show that the dealer deals in a wide range of agricultural and horticultural equipment and apparatus of various other manufacturers. These items are:-

- (i) Hayter mowers brochure, including for "sit-upon" tractor mower,
- (ii) Kawasaki LandMec leaflet for general powered agricultural/horticultural equipment;
- (iii) Jonsered 2000 brochure
- (iv) Lawnking brochure for lawn tractors (see cover page and inside),
- (v) Tiga Green Pastures brochure for lawnmowers including "ride-on" mowers.

14. Mr Robinson acknowledges that the opponent's goods primarily are tractors which are for general agricultural use and adds that the FASTRAC tractors currently made and sold include an integral towing hitch of the kind which is commonly used on tractors, for towing various agricultural and horticultural equipment and apparatus in order to perform specific tasks such as ploughing, lawn-mowing, scarifying, pumping and the like. He states that while

neither JCB nor the opponent, make specialised agricultural equipment to perform tasks such as those recited above, such equipment is commonly bought in conjunction with the opponent's goods from dealers.

15. Mr Robinson comments that although the goods covered by the application seeks to distinguish the applicant's goods from those goods for which the identical (series of) trade mark(s) is registered by the opponent in the UK by referring to "horticultural" use and "domestic" use, these terms do not materially distinguish the goods the subject of the application from the opponent's goods in as much as horticulture and agriculture are not clearly distinguished areas either technologically, nor in commerce and trade. Mr Robinson this draws attention to Exhibit "WGR 10", which contains dictionary definitions of these terms which indicate that "agriculture" relates to the science of soil cultivation, while horticulture relates to the art of garden cultivation. He concludes this agriculture is practised by horticulturists and there is no distinction by usage of these terms between products and moreover the restriction in the application to "domestic" use is meaningless in that whereas one may not use a full size tractor, of the kind which the opponent JCB currently sells, in a small domestic garden, even in a relatively small garden one may well use a "sit-upon" tractor, or lawnmower (which are sold alongside the opponent's goods by the opponent's JCB's dealers). However in a large garden (eg on a country estate) one may well use a full size tractor for agricultural/horticultural tasks including lawn-mowing. Mr Robinson adds that the opponent's earlier registrations are not limited in scope to agricultural vehicles of any particular size or kind; the opponent's earlier registrations are not even limited to agricultural vehicles with engines, but cover hand propelled agricultural vehicles, such as for example hand propelled lawn mowers.

16. Mr Robinson concedes that the opponent currently is not developing a smaller tractor type product particularly suitable for use in small gardens, but states that over recent years, the opponent has introduced a range of small excavators and loaders examples of which are shown in Exhibit GWR 11 which comprises brochures illustrating the smaller machines the opponent makes and sell. This includes a brochure on the JCB Agricultural Range (dated 1/99) which refers to JCB FASTRAC models amongst others. He goes on to state that depending on market requirements and the opponent's commercial views, the opponent may well wish at some time in the future to introduce into its product range a smaller "domestic" size tractor product, or indeed other agricultural vehicles, for sale under the opponent's FASTRAC brand and as lawnmowers and the like are already sold under the opponent's house mark "JCB" as shown by Exhibit "SWR 12" to his declaration, which is a leaflet showing a range of "JCB" branded lawnmower and similar "garden" products which are sold by the opponent's dealer G J Peck, alongside the applicant's goods. He opines that there could be real confusion between the applicant's products and the opponent's goods, and primarily because the opponent's goods are already sold alongside the applicant's goods, the potential for real confusion between the opponent's and applicant's goods already exists.

17. Turning to the bad faith ground of opposition, Mr Robinson draws attention to Exhibit "GWR 13" to his declaration which contains copies of correspondence exchanged between the opponent's and applicant's respective trade mark agents, initiated in May 1999 by the applicant's agent. Mr Robinson states that it is clear that the opponent indicated why it was not prepared to grant consent to the applicant to use and register the mark in suit and thus the

applicant must have been aware that the opponent would not accede to its registration. He concludes that the approach by the applicant's agents indicates that a) the applicant itself was of the view that the goods for which the applicant sought permission from the opponent to use and register the trade mark FASTRAC are identical to or at least are too similar to the goods for which the opponent enjoys rights in respect of the trade mark by virtue of the opponent's earlier UK and Community trade mark registrations, and b) the applicant realised that legitimate objections were likely to be raised by the opponent to the applicant's use and registration of the mark the subject of the application which is why permission to use the mark was sought.

### **Applicant's Evidence**

18. This comprises two statutory declarations, one each from Simon Stuart Timms and Susan Sylvia Wall, both dated 26 September 2001.

19. Mr Timms is the Financial Director of Atco-Qualcast Limited, the applicant. He explains that his company carries on a business in the design, manufacture and marketing of garden products, tools and machinery and is well known in the UK for lawnmowers for which it and its predecessor in title Qualcast Limited, built up a reputation since 1920. He attaches a brief company history at Exhibit SST 1 to his declaration.

20. Mr Timms states that his company currently has a 30% share of the UK lawnmower market and in national opinion polls eg in 1989, 40% of those polled who expressed an opinion rated the applicants lawnmowers as the best quality manufacture. He adds that the same surveys awarded his company the highest recognition with over 50% of unprompted brand awareness. Some samples market survey reports are attached as Exhibit "SST 2" to Mr Timms declaration.

21. Mr Timms explains that the majority of his company's total business in garden equipment in the UK is carried out through authorised dealers and at Exhibit "SST 3" to his declaration is an example of a 2001 brochure illustrating the product range, including the FASTRAK 32.

22. Mr Timms states that his company's total business in garden equipment exceeds £40 million per annum of which the proportion represented by the sale of lawnmowers averages 60% per annum. He adds that sales of lawnmowers during the last few years have been as follows:-

<b>YEAR</b>	<b>FIGURES (£)</b>
1997	£28 m
1998	£30 m
1999	£29.6 m
2000	£30.4 m

23. Mr Timms goes on to state that his company has advertised its product range through advertisements placed in newspapers, magazines and radio and television commercials. Samples of these advertisements are attached as Exhibit "SST 4" to his declaration, one of

which dated March 16 2001 refers to the Qualcast Fastrak 32/3200. Mr Timms says that his company spends £0.5 m on advertising per year.

24. Mr Timms states that his company developed the FASTRAK 32 design as a quite running electric rotary mower for inclusion in its year 2000 price lists and that work on this project commenced in September 1998 and thus predated the filing of the application. A 2000 brochure illustrating the introduction of the new FASTRAK model with the other models of the applicant is attached at Exhibit "SST 5". He adds that sales of FASTRAK 32 lawnmowers have been made during the years 2000/01 as shows on the customer order list attached as Exhibit "SST 6", and that the total amount of sales to date of the QUALCAST FASTRAK 32 model is 30109 units.

25. Mr Timms asserts that from his extensive knowledge of the garden equipment trade, it is his belief that purchasers of the applicant's lawnmowers, being for garden use, are not the same purchasers who would wish to acquire a JCB agricultural vehicle, even one towing a grass cutting machine. Conversely he is confident that the customers of JCB would not be likely to purchase a domestic lawnmower instead of the larger scale agricultural and horticultural machinery which that company produces. Mr Timms concludes that his company did not show bad faith given the overall differences in the respective products.

26. Ms Wall is employed by William Jones, the applicant's professional representatives in this matter. She states that on 4 May 1999 an identical trade mark search on behalf of the applicant for a number of marks of which FASTRAC was one and at Exhibit "SSW 1" to her declaration is a copy of the search report produced and in addition to the opponent's registrations she draws attention to the registrations of third parties in Classes 7, 12 and 37. She states that as there were no registrations for lawnmowers or of horticultural machinery of any kind in Class 7 the decision was taken to continue with the use of FASTRAK and to write to the opponents via their trade mark agents to see whether they would be prepared to the use and registration of the applicant's mark if required.

27. Following the application for the mark in suit the applicant, as a result of objections by the Registry, reduced the number of marks applied for in the series and limited their specification of goods. Although the opponent's registrations were originally raised under Section 5 by the examiner, Ms Wall explains that following limitation of the applicant's specification of goods, they were waived. She states that, like the examiner, the applicant's considered that the respective goods were sufficiently different to allow the application to proceed and that there were sufficient differences in terms of consumers, markets and goods to allow all FASTRAK marks to co-exist safely.

28. This completes my summary of the evidence filed in this case and I now turn to the decision.

## **DECISION**

29. Prior to the hearing Mr Mitcheson withdrew the ground of opposition based upon Section 3(6) of the Act.

30. I turn first to the ground of opposition under Section 5(2) which reads as follows:-

"5.-(2) A trade mark shall not be registered if because -

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

31. An earlier right is defined in Section 6, the relevant parts of which state:

6.-(1) .....

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

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

It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (c) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v.*

*Puma AG*, paragraph 23;

- (d) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (e) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (f) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (g) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (h) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

33. The reputation of a trade mark is an element to which importance may be attached in Section 5(2) considerations in that it may enhance the distinctive character of the mark at issue and widen the penumbra of protection afforded to such a mark. The opponent has filed evidence relating to the reputation of the mark FASTRAC covered by their prior registrations and at the hearing Mr Mitcheson drew attention to the opponent's sales and promotion of the mark which, he claimed, were considerable. Mr Roberts for the applicant, conceded that the opponent possessed a limited reputation and goodwill in the mark FASTRAC as a secondary mark (secondary to the JCB housemark) in relation to "full sized" tractors which possess a specialised suspension system designed for (and specifically promoted as) allowing considerable comfort and speed in a range of working applications.

34. Mr Robert's limited acceptance in relation to the opponent's reputation and goodwill is understandable. The details of turnover and promotion provided in Mr Robinson's statutory declaration are somewhat inconclusive in that, while they demonstrate a presence in the market place, they do not indicate the opponent's market share in relation to the goods covered by their registrations and the only examples of use and promotion of the mark are a small number of brochures produced by the opponent which demonstrate use of the sort described by Mr Roberts above. In addition to the lack of information in relation to market share and the paucity of evidence relating to the actual use and promotion of the mark, the opponent has filed no independent trade support, nor documentation such as press cuttings/comment, nor examples of advertisements from general or specialist media e.g. periodicals. As a result I find it difficult to reach positive conclusions in relation to the opponent's repute in the mark FASTRAC. I believe Mr Roberts' definition of the opponent's

repute and goodwill to be very fair and I do not believe that it can be extended further on the basis of the evidence before me.

35. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the recent judgements of the European Court of Justice mentioned earlier in this decision. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural or conceptual similarity between the marks, evaluating the importance to be attached to those different elements, taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. In this case it is accepted that the opponents FASTRAC mark has a reputation, albeit a limited degree. However, it was held in *Marca Mode v Adidas AG* [(2000) ETMR 723:

"The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character (*Canon*, paragraph 18). Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense."

36. Furthermore, in addition to making comparisons which take into account the opponent's actual use (the applicant's have no use prior to the relevant date), I must also compare the marks applied for and the opponent's registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered within the respective specifications.

37. The respective marks are identical. Mr Roberts submitted that any enhanced distinctive character resulting from the use of the opponent's mark FASTRAC would be very limited and that the marks themselves possessed a low level of inherent distinctiveness and thus were only deserving of a narrow penumbra of protection. In support of this claim Mr Roberts argued that the opponent's marks alluded to "fast tractor" or alluded the dictionary meaning of "fast track", therefore inferring that the goods would achieve a quick result for the user. He also drew attention to a number of registrations of FASTRAC owned by third parties (Exhibit SSW1 to Ms Wall's declaration refers).

38. Notwithstanding Mr Roberts submissions, it seems to me that the marks in question, while alluding to a characteristic to the goods, are sufficiently distinctive to deserve a good penumbra of protection, as this allusion made is sufficiently skilful and indirect when the relevant goods are taken into account. Furthermore, I am not assisted by the state of the register evidence and I am guided in this by the following comments of Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281:

"Both sides invite me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word "Treat". I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the

sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the Registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see eg *MADAM Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence."

39. I now turn to a comparison of the applicant's and opponent's goods. At the hearing Mr Mitcheson submitted that, notwithstanding the limitation to domestic use, the applicant's specification covered a wide range of goods and that the term "domestic use" was somewhat vague in that a domestic garden could be extremely large. In particular, Mr Mitcheson drew my attention to that evidence attached to Mr Robinson's declaration at Exhibits GWR6, GWR8 and GWR9 which shows that the same manufacturers produce, sell and promote through the same booklets, sit on/ride on lawn mowers (proper to Class 7) and multifunctional tractors (Class 12), intended for lawn care and general garden, horticultural and clear up uses which are intended (inter alia) to pull trailers and with accessories, to sweep, remove weeds, clear snow, collect, brush, spread and scarify, as well as mowing lawns. These small tractors are suitable for domestic use in larger gardens, or in maintaining municipal parks and gardens, or in maintaining the grounds of commercial premises. Examples of relevant manufacturers are Husquarna and Jonsered. Mr Mitcheson also printed out that those same businesses also produce walk behind mowers and other garden equipment such as powered hedge trimmers.

40. I now turn to my considerations on the similarity of the goods covered within the specifications of the relevant marks and in my determinations on this point I have considered the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (Pages 296, 297) as set out below:

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

41. Whilst I acknowledge that in view of the CANON-MGM judgement by the European Court of Justice (3-39/97) the Treat case may no longer be wholly relied upon, the ECJ said the factors identified by the UK government in its submissions (which are listed in TREAT) are still relevant in respect of a comparison of goods.

42. The goods of the application in suit cover, inter alia, sit on/ride on lawnmowers and the opponent's registrations includes "tractors" which would encompass the sort of small multifunctional tractors intended for general garden or horticultural use which were considered in paragraph 39 of this decision. The uses or purpose of the respective goods overlap in that they can both be used for "sit on" mowing of the lawns of larger properties, albeit that the opponent's goods have other applications. Furthermore, the users of the respective goods would overlap as the relevant customer ie. the possessor of a large garden or a parcel of land who wished to maintain it, would choose whether to buy a product which merely mowed the grass or which, in addition could undertake further tasks. The nature of the goods would be similar in that they comprise powered, wheeled garden or horticultural equipment upon which the user sits. Finally, the opponent's evidence demonstrates that these goods would be sold through the same specialist outlets or channels and they would be competitive in that they offer the customer the choice of "sit on" mowing or "sit on" mowing with capacity for further tasks. On the information before me I take the view that sit on/ride on mowers in Class 7 have a similarity with small multifunctional tractors intended for general garden or horticultural use in Class 12. However, I do not believe this similarity would extend to walk behind mowers or other hand held powered garden equipment because, as a question of degree, the differences in the specific nature and uses of the products are more marked and the respective goods would not be competitive.

43. At the hearing Mr Roberts (correctly in my view) pointed out that the goods at issue, in particular sit on/ride on lawnmowers, were likely to be selected after careful consideration. However, it does not follow that confusion will not occur given the marks are identical and the proximity of sit on mowers and small multifunctional tractors intended for garden and horticultural use.

44. On a global appreciation, taking into account all the relevant factors, I come to the conclusion that the respective marks are identical and the degree of similarity in the goods is such that there is a likelihood of confusion on the part of the public. The opposition under Section 5(2) is successful.

45. As I have found for the opponents under Section 5(2) of the Act, I have no need to consider the grounds of opposition raised under Section 5(3) and Section 5(4). I would only add that I do not believe the opponent to have any stronger case on these grounds, particularly in the light of my earlier findings, on the basis of the evidence submitted, as to the extent of the opponent's reputation in the mark FASTRAC.

46. The opponents are entitled to a contribution towards their costs. I order the applicants to pay them the sum of £900, this sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of the case if any appeal against this decision is unsuccessful.

**Dated this 16 day of April 2002**

**JOHN MacGILLIVRAY**  
**For the Registrar**  
**the Comptroller-General**

**UK REGISTRATION NO:** 1458892

**MARK:** FASTRAC  
FASTRAK  
FASTRACK

(Series of 3)

**REGISTRATION EFFECTIVE:** 20 March 1991

**SPECIFICATION OF GOODS**

**Class 12:**

Agricultural vehicles and tractors, all being wheeled; parts and fittings for all the aforesaid goods; all included in Class 12; but not including tyres for vehicle wheels or any goods of the same description as tyres for vehicles wheels.

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**EUROPEAN COMMUNITY TRADE MARK:** 00041497

**MARK:** FASTRAC

**REGISTRATION EFFECTIVE:** 27 December 1996

**SPECIFICATION OF GOODS**

**Class 12:**

Agricultural vehicles and tractors; parts and fittings for all the aforesaid goods.

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