

O-195-06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 82028
BY GREAPO POWER TOOLS (SUZHOU) CO. LTD
FOR A DECLARATION OF INVALIDITY
IN RESPECT OF TRADE MARK No 2304212
STANDING IN THE NAME OF
NORVAD LTD**

BACKGROUND

1) The registered proprietor has the trade mark GARDENWORKS registered in the UK, with effect from 2 July 2002, in respect of the following:

In Class 7: Machines and apparatus all for agricultural, horticultural or garden purposes; lawnmowers, hedge trimmers, edge trimmers, pruning machines, lawn rakes, lawn rollers and lawn aerators; brush-cutters; garden tractors and rotavators; mowing machines; power-operated saws; parts and fittings for all the aforesaid goods; all included in Class 7.

In Class 8: Hand tools and implements; tool heads; secateurs; shears; scissors; plant feeders; fertilizer spreaders and sprayers; all the aforesaid goods for garden use; garden tools; rakes; hoes; cultivators; rake heads; hoe heads; cultivator heads; grubbers; weeders; lawn edgers; garden trowels; hand forks; spades; garden forks; shovels; flower gatherers; fruit pickers; all included in Class 8.

2) By an application dated 2 February 2005 Greapo Power Tools (Suzhou) Co. Ltd applied for a declaration of invalidity in respect of this registration. The grounds are, in summary:

a) The applicant is the registered proprietor of the following trade marks:

Mark	Number	Effective Date	Class	Specification
	M828837	19.12.03	7	Agricultural machines; woodworking machines; planing machines; saws (machines); engraving machines; electric kitchen machines; elevating apparatus; cutting machines; apparatus for dressing; metalworking machines; machine tools for drilling; machines and apparatus for polishing (electric); hand-held tools, other than hand-operated; spray guns for paint; starters for motors and engines; pumps (parts of machines, engines or motors); electric welding machines; machines and apparatus for cleaning (electric); electric shoe polishers; electric disintegrators; hydraulic door openers and closers (parts of machines).

			8	Abrading instruments (hand instruments); agricultural implements (hand-operated); garden tools (hand-operated); hand-operated hand tools; drills; hand-operated guns for the extrusion of mastics; hand-operated lifting jacks; lawn clippers (hand instruments); pruning knives; table cutlery (knives, forks and spoons).
	CTM 1866656	13.09.00	7	Agricultural machines; lawnmowers; woodworking machines; engraving machines; cutting machines; portable power tools; AC drills; DC drills; electric hammers; electric drills; electric shears; electric saws; electric grinders; electric angle grinders; electric sanders; electric wrenches; electric screwdrivers; electric planers; electric routers; electric branch cutters; electric hedge trimmers; electric tackers; electric rotary hammers; electric breakers; electric marble cutters; electric wet grinders; electric sprayguns; electric plastics welders; grass shears; garden tools; pumps.

b) The applicant has used its marks throughout the UK on the goods for which it is registered and has from such use acquired a substantial reputation. The mark has therefore been registered in breach of Section 5(2)(b) of the Trade Marks Act 1994 and invalidity is sought under Section 47(2)(a) of the Trade Marks Act 1994.

3) The registered proprietor filed a counterstatement denying the above ground.

4) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 20 June 2006 when the applicant was represented by Mr Fiddes of Messrs Urquhart Dykes Lord. The registered proprietor was not represented.

APPLICANT'S EVIDENCE

5) The applicant filed a witness statement, dated 21 November 2005, by Bill Yang a Director of the applicant company. He states that his company began developing its WORX range of products during 2000. At exhibit 1 he provides examples of the way that his company uses the mark WORX in relation to garden tools. The mark is shown

on the actual product and also the case that it is packaged in, which is how the consumer would see the item on the shelf of the retail outlet. Also in this exhibit is a copy of parts of a HOMEBASE magazine dated Autumn 2004, which shows a range of WORX power tools such as drills, sander, grinder and saw, and also a range of strimmers and hedge trimmers including brand names such as Bosch, Black and Decker and Worx. In all cases the mark shown is a stylised version but not precisely as registered as it appears to lack the device element.

6) Mr Yang states that its first sales in the UK under its marks were made in 2002 when a shipment of hammerdrills were provided to B&Q Plc. He states that the range was further extended to include other products and finally extended to cover gardening tools, although he admits that sales of gardening tools did not commence until April 2004.

7) Mr Yang claims that it is common for companies which produce power tools for the DIY market to extend their range of products under the same brand to cover garden products. He therefore claims that a consumer who was familiar with his company's DIY products would assume a connection if they saw the registered proprietor's goods. At exhibit 2 he provides extracts from the websites of Black & Decker and Bosch which shows that tool manufacturers often produce garden tools. These are dated September 2005 and show that each manufacturer offers a range of powered garden tools such as mowers, vacuums, hedge trimmers etc.

REGISTERED PROPRIETOR'S EVIDENCE

8) The registered proprietor filed a witness statement, dated 14 February 2006, by David Norton a Director of the registered proprietor company. He states that the registered proprietor first used their trade mark GARDENWORKS in the UK in 2002 and they have continued to offer their goods via outlets such as Empire Stores catalogues and garden centres. At exhibits 1 & 2 he provides examples of a page from a catalogue showing use of the mark on garden tools and also an example of packaging.

9) That concludes my review of the evidence. I now turn to the decision.

DECISION

10) The request for the declaration of invalidity is made under the provisions of Section 47(2)(a) of the Act. The relevant part states:

“47 (2) The registration of a trade mark may be declared invalid on the ground -

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

(b).....

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

11) The action is brought under section 5(2)(b) which 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,

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

12) An “earlier trade mark” is defined in section 6, the relevant parts of which state:

“6.-(1) In this Act an "earlier trade mark" means -

(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,”

13) The applicant for invalidity is relying upon its trade marks M828837 and CTM 1866656 which have effective dates of 19 December 2003 and 13 September 2000 respectively. As the mark in suit was filed on 2 July 2002, the applicant can only rely upon CTM 1866656 as an earlier trade mark. This was accepted by the applicant at the hearing.

14) As the mark that the applicant for invalidity is relying upon was not registered more than five years prior to the request for invalidity I do not need to consider whether the applicant has fulfilled the requirement to show that genuine use of the mark has been made.

15) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *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.

16) 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 judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally, and I need to address the degree of visual, aural and 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. Furthermore, I must compare the registered proprietor’s mark and the applicant’s mark 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.

17) The applicant’s mark is inherently distinctive. However, I must also consider the use of the mark and consider whether the mark has acquired distinctiveness as a result of this use. The applicant has not provided evidence of turnover or market share. It has barely provided use of the word WORX and none in the exact format of the mark registered. Therefore, the applicant’s trade mark has not acquired a reputation, such that it should benefit from enhanced protection.

18) I will first consider the specifications of the two parties which are as follows:

Applicant’s specification for mark CTM 1866656	Registered Proprietor’s specification
<p>In Class 7: Agricultural machines; lawnmowers; woodworking machines; engraving machines; cutting machines; portable power tools; AC drills; DC drills; electric hammers; electric drills; electric shears; electric saws; electric grinders; electric angle grinders; electric sanders; electric wrenches; electric screwdrivers; electric planers; electric routers; electric branch cutters; electric hedge trimmers; electric tackers; electric rotary hammers; electric breakers; electric marble cutters; electric wet grinders; electric sprayguns; electric plastics welders; grass shears; garden tools; pumps.</p>	<p>In Class 7: Machines and apparatus all for agricultural, horticultural or garden purposes; lawnmowers, hedge trimmers, edge trimmers, pruning machines, lawn rakes, lawn rollers and lawn aerators; brush-cutters; garden tractors and rotavators; mowing machines; power-operated saws; parts and fittings for all the aforesaid goods; all included in Class 7.</p>
	<p>In Class 8: Hand tools and implements; tool heads; secateurs; shears; scissors; plant feeders; fertilizer spreaders and sprayers; all the aforesaid goods for garden use; garden tools; rakes; hoes; cultivators; rake heads; hoe heads; cultivator heads; grubbers; weeders; lawn edgers; garden trowels; hand forks; spades; garden forks; shovels; flower gatherers; fruit pickers; all included in Class 8.</p>

19) Clearly, the goods in Class 7 are identical. The applicant’s specification includes the terms “agricultural machines” and “garden tools” which cover the whole of the registered proprietor’s specification. With regard to the registered proprietor’s class 8 specification there are similarities between the goods covered in the specification and the applicant’s goods in that they are all for use in horticultural pursuits. Therefore, I regard the goods in Class 7 of the registered proprietor’s specification to be identical to the applicant’s Class 7 specification; whilst the registered proprietor’s Class 8 specification is similar to the applicant’s Class 7 specification.

20) I now move to compare the marks of the two parties which are reproduced below for ease of reference.

Registered proprietor’s mark	Applicant’s mark
<p>GARDENWORKS</p>	

21) The applicant contends that the word GARDEN in the registered proprietor's mark is non-distinctive as it describes the place in which the goods would be used. The contention is that I should compare WORKS with WORX. I do not accept that I should ignore the first part of the registered proprietor's mark. It is well accepted that marks must be considered as wholes. Whilst the goods may indeed be capable of use in the garden, it is clear that they can, and indeed are designed to be used, for agriculture purposes and also in parks etc which would not be construed as garden use. Even if they were only for use in the garden, then I would still not ignore the first part of the mark.

22) Visually the marks are different in that the applicant's mark is very short, it is in a stylised font complete with shadows and has a device element within it. The registered proprietor's mark is much longer and is in plain font. The applicant's mark is incorrectly spelt and although it would be seen as a play on the word WORKS the average consumer would take note of the fanciful nature of the spelling. Whilst the applicant's mark and the ending of the registered proprietor's mark are similar the overall impression is different. I have to take into account that the beginnings of marks are the most important.

23) Aurally, the applicant's mark is a single syllable word whilst the registered proprietor's mark is three syllable. Only the final syllable of the registered proprietor's mark is similar to the applicant's mark. Overall they are very different.

24) Conceptually they do have similarities. Both allude to the fact that their goods perform or work. It could also be used in a strapline as in "It works /x". However, the registered proprietor's mark alludes to gardens and conjures up a different image of a more leisurely pastime or hobby.

25) In summary having regard to visual, aural and conceptual considerations, and making due allowance for the fact that the goods are identical or very similar I have come to the view that there is no likelihood of confusion. I have also considered whether the public might nevertheless have reason to think that goods offered under the marks came from the same or economically linked undertakings. But again I have come to the view that this is unlikely to be the case. Accordingly the invalidity fails.

COSTS

26) As the applicant was unsuccessful the registered proprietor is entitled to a contribution towards its costs. I order the applicant to pay the registered proprietor the sum of £1200. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 14th day of July 2006

**George W Salthouse
For the Registrar,
the Comptroller-General**