

O-148-22

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 915543747
IN THE NAME OF SMART GARDEN PRODUCTS LTD
IN RESPECT OF THE TRADE MARK**



IN CLASSES 8, 12, 20, 21, 24 AND 25

AND

**IN THE MATTER OF AN APPLICATION FOR INVALIDATION THERETO
UNDER NO. 503659
BY WESTLAND HORTICULTURE LIMITED**

Background and pleadings

1. The following trade mark is registered in the name of Smart Garden Products Ltd (“the proprietor”):

Mark No. 915543747



Colour Claim: White; Beige; Green (“Pantone 389C”); Orange (Pantone 021C”); Blue (“Pantone 292C”)

Filing date: 16 June 2016

Registration date: 17 February 2017

Class 8: *Hand operated horticulture and garden tools; horticulture and gardening equipment; spades; trowels; forks; weeding tools; hoes; rakes; gardening string; filled tool bags; filled tool pouches; accessories and parts and fittings for all the aforesaid hand tools.*

Class 12: *Wheelbarrows.*

Class 20: *Cushions; garden kneeler cushions.*

Class 21: *Containers; tin mugs; tins; string tins; seed tins; watering cans; flower pots; herb pots; gardening gloves; gloves for gardening; water proof gloves; brushes, garden brooms.*

Class 24: *Blankets for outdoor use; picnic blanket.*

Class 25: *Headwear; footwear; clothing; boots; wellington boots; garden shoes; clogs; socks; boot warmers; boot socks; scarves; hats; gloves; tops; shirts; tee shirts; long sleeve tee shirts; fleeces.*

2. The registration is a comparable trade mark based on an EU Trade Mark registered on 17 February 2017 and was entered on the UK register on 31 December 2021.

3. On 17 February 2021, Westland Horticulture Limited (“the applicant”) applied to invalidate the registration. The invalidation is based upon section 3(1)(b) and section 3(1)(c) of the Trade Marks Act 1994 (“the Act”). The applicant asserts that the word “kids” is a generic and universal informal descriptive term for children and that no single entity should have any form of monopoly in the term “kids”. It adds that the devices of gardening tools contained in the mark depict goods that are protected under the registration’s Class 8 goods and, therefore, emphasise the descriptive nature of the mark. These goods could easily be used on a children’s range of clothing suitable for gardening or any of the goods protected by the registration. It concludes that the word “kids” and pictorial elements of the mark are totally devoid of distinctive character and are descriptive in relation to all of the goods.

4. The proprietor filed a counterstatement denying the claims made. It points to the fact that the word “kids” is presented in a stylised way with the differently coloured letters contributing to its distinctive character. Further, it asserts that visual juxtapositions of the three colours and the arrangement of each of the three devices of tools all add to the distinctive character of the mark. It also denies that the devices of tools reinforce the meaning of the word “kids”.

5. Only the applicant filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. The parties both filed written submissions that I keep in mind and I will refer to as and where appropriate during this decision.

6. A Hearing took place on 5 January 2022, with the applicant represented by Ms Beth Collett of Counsel, instructed by Murgitroyd & Company. The proprietor was represented by Mr Tom St Quintin of Counsel, instructed by Baron Warren Redfern.

7. 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. That is why this decision continues to refer to EU trade mark law.

Evidence

8. The applicant's evidence takes the form of the witness statement of Mr Keith Nicholson, Marketing Director of the applicant, and exhibits KN1 – KN4. Mr Nicholson provides evidence in support of the applicant's claim that the term "KIDS" is used descriptively in trade to indicate goods specifically aimed at children, that goods aimed at children are almost exclusively presented with bright or fluorescent colours, and that "cartoonish" depictions of the goods are commonly used in respect of children's goods. I discuss this evidence in more detail later.

Legislation

9. Section 3(1) reads:

"3.— Absolute grounds for refusal of registration

(1) The following shall not be registered—

(a) ...

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

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

(d) ...

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

10. Section 3(1) is relevant in invalidation proceedings because of section 47 of the Act, the relevant part of which states:

“47. (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration). Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

[...]

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

[...]

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

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

Section 3(1)(c)

11. I find it convenient to begin by considering the ground based upon section 3(1)(c). The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

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

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

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

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

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

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

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

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

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

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a

description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

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

12. Ms Collett submitted that the proprietor should not be entitled to a monopoly right in its mark that extends to any children’s goods and that all the goods listed can include such children’s goods. She made reference to High Court proceedings between the parties where the proprietor relies upon goodwill in respect of gardening tools and clothing made specifically for children,¹ claiming this illustrates that these are the exact goods for which the proprietor intends to use its mark. I note this but it has no direct bearing on my considerations because I must consider the grounds in a notional way based on the list of goods in the contested registration and not in respect of which the mark has been put to use.

13. Ms Collett addresses the proprietor’s reliance upon state of the register evidence and in particular a number of comparable marks (with registration numbers beginning with the numeral 9). She pointed out that such marks have been created on the UK register as part of Brexit arrangements and have not undergone the scrutiny of the UKIPO’s examination procedures. The existence of these comparable marks or otherwise on the register is not persuasive because I do not know the circumstances regarding their registration or whether, for example, they are registered because they have acquired distinctive character.²

14. Mr Nicholson provided the following relevant evidence:

¹ See para 5 of the Particulars of Claim in IP-2021-000058.

² See, for example, *Zero Industry Srl v OHIM*, Case T-400/06.

Descriptive use of the term “KIDS”:

- Extracts from the proprietor’s own website promoting a “Kids Range” of “Gloves & Wellies” and “Kids Tool Sets” (with an image of a watering can, gardening fork, trowel, hand rake and bag). The extract contains a copyright date of 2021;³
- Extracts from third party websites showing use of the word “kids” being used descriptively;⁴
- A further Internet extract from a website entitled “Mother&Baby” (describing itself as “the UKs #1 trusted pregnancy and parenting site”⁵) showing an article entitled “The best kids’ gardening sets” reviewing 6 gardening sets, four of which are available at Amazon.co.uk, one at Etsy.com/uk and one at notonthehighstreet.com;⁶

Use of Bright Colours in marketing children’s goods:

- An article discussing the attractiveness of bright colours to children, dated 23 April 2018;⁷
- Undated extracts from the online retail offerings from Smyths illustrating numerous toys for babies and toddlers mainly from a single manufacturer, Fisher-Price.⁸ The evidence illustrates such toys are in bright colours;
- Extracts from a further un-named and undated website showing further brightly coloured children’s toys but not gardening goods⁹;

Use of cartoonish depictions of the goods when marketing children’s goods:

³ Pages 2 and 3 of Exhibit KN1.

⁴ Ditto, pages 4 - 17.

⁵ Ditto, page 25.

⁶ Ditto, pages 18 - 24.

⁷ Exhibit KN2, pages 2 – 8 (an article from an unknown source last updated 23 April 2018).

⁸ Ditto, pages 14 - 45.

⁹ Ditto, pages 46 – 50.

- Extracts from orchardtoys.com (with a company address in Nottingham) showing a “Smelly Wellies Game” depicting cartoon characters on the front of the box;¹⁰
- Extracts from the website TheWorks.co.uk showing various “educational toys”. These representations are relatively small thumbnails with only one obviously showing cartoon characters (on the front of the box);¹¹
- Extracts from the Ocado website showing a product called “My first mini Greenhouse” with cartoon-style design on the front of the box. The extract contains a 2021 copyright notice.¹²

Commercialisation of garden tools for children:

- Numerous extracts from Amazon.co.uk showing the results of a search for “children + gardening + tools”. Ten gardening sets are shown;¹³
- Extracts from the website of the retailer “B&M” showing Children’s garden tool set, gardening gloves for children, kids’ watering cans and kids’ shovels, rakes and brushes;¹⁴
- Further various children’s gardening tool sets, wheelbarrows, gloves, watering cans and wooden planting tools being offered for sale on ebay with prices shown in pounds sterling.¹⁵

15. Mr St Quintin criticised Mr Nicholson’s evidence, submitting that it fails to support the application. He accepted that the word “kids” can be used to refer to children or products for use by children but submitted that the mark is not just this word.

16. The exhibited article (footnote 7) of unknown provenance that states that “children tend to be attracted to ... bright colours” and “for this reason, ...the toy industry ... use[s] bright colors to market children’s products.” The American spelling of the word “color” may be a clue to the geographical origin. A US focused article may not have

¹⁰ Exhibit KN3, page 2

¹¹ Ditto, pages 4 - 8

¹² Ditto, page 9

¹³ Exhibit KN4, pages 2 - 7

¹⁴ Ditto, pages 11 - 17

¹⁵ Ditto, pages 18 - 34

been made available to UK consumers. At the hearing, Mr St Quintin made numerous other criticisms such as whether it had been peer reviewed and that the credentials of the author are unknown. I agree with these criticisms and accept that, on its own, this article adds little to the applicant's case.

17. Mr St Quintin challenged the assertion that Mr Nicholson's evidence supports the proposition that bright colours are attractive to consumers from a purchasing perspective. He submitted that, insofar as it is intended to demonstrate that children are more attracted to bright colours, it supports the distinctiveness of marks that contain bright colours where the consumers are children. I do not agree. I note that this falls short of Mr St Quintin claiming that the evidence fails to support the claim that children are attracted to bright colours. There are certainly faults with this evidence, most noticeably it is undated and mainly from one toy manufacturer (Fisher-Price). However, it is consistent with Mr Nicholson's claim. It is also consistent with my own experiences as a member of the general public who cannot fail to see that children's products are often brightly coloured. I disagree with Mr St Quintin when he submits that this fact supports the distinctiveness of marks containing bright colours. Rather, the use of bright colours is used in a non-origin specific way to attract the attention of children and, where representations of the goods (or related goods) are shown in such colours it is likely to be perceived as merely showing the goods themselves in colours that are attractive to children.

18. I also note that Mr Nicholson has stated that "in [his] capacity as Marketing Director for [the applicant], [he] knows that goods aimed at children are almost exclusively presented with bright fluorescent colours."¹⁶ Ms Collett pointed out that Mr Nicholson is highly experienced in the industry and his evidence, therefore, is highly relevant. I note he has been with the applicant for 16 years, 12 of which as Managing Director and I accept that he is very experienced in this trade. He is, of course, not impartial. Nevertheless, taking account of the evidence, Mr St Quintin's absence of a denial and my own experience as a member of the general public, I accept the premise that children's goods are often presented in bright colours of the kind used in the contested mark.

¹⁶ Mr Nicholson's witness statement, para 7

19. Turning to the issue of “cartoonish depictions”, whilst Mr Nicholson has provided evidence to support the applicant’s claim that use of such depictions is commonplace in promoting children’s goods. I do not find the figurative elements of the contested mark to be particularly “cartoonish”. Rather, they are relatively accurate depictions of garden tools where the stylisation is negligible. Consequently, I find that this evidence takes the applicant no further forward.

20. Mr Nicholson also provides evidence to support the claim that there is commercialisation of garden tools for children. He states that “within the market of horticulture or gardening for children, the choice of a trowel, fork and rake as a set is very common as these tools form the basis of what is required at a fundamental level to start gardening.”¹⁷ Mr St Quintin criticises the supporting evidence as being dated in 2021 and not before the relevant date of 16 June 2016 and as being selective and not being a complete audit. Whilst this identifies several defects in this evidence, none totally undermines the evidence. There is nothing to suggest that this area of trade is particularly fast moving. On the contrary, gardening is an established pastime and it is easily foreseeable that children will wish to recreate this aspect of adult activity as part of their play. Consequently, despite being some 5 years after the relevant date, this does not relegate the evidence to irrelevance. Further, section 3(1)(c) applies to marks where it is foreseeable that they will designate a characteristic of the goods. In this respect, the post-dated evidence supports a view that it was foreseeable at the relevant date that the mark may be used on, for example, children’s gardening sets even if it was not already the case at the relevant date. Clearly, the evidence is selective, but this fails to advance Mr St Quintin’s argument because by its very nature, all evidence is selective. Mr Nicholson was only attempting to demonstrate his point and would naturally not include evidence that did not do that.

21. Further, Mr St Quintin submitted that the evidence fails to establish a proposition that sets containing only trowel, fork and rake are commonplace. He countered that the evidence, in fact, establishes that there is no fixed “set” of tools. The evidence does illustrate sets consisting of numerous different combinations of gardening tools, gloves, aprons, tool bags as well as watering cans and mist sprays but all contain at

¹⁷ Ditto, para 9

least a hand trowel, hand fork and a hand rake of the same or similar kind as depicted in the contested marks. In all of the examples shown, the blades of the tools are brightly coloured. The fact that the mark could be used on goods or sets of goods that are not represented in the mark or in respect of sets of goods that include other goods in addition to those depicted in the mark is not fatal. The overriding descriptive message conveyed by the mark is the twin themes of gardening and children and that may be sufficient to fall within the scope of section 3(1)(c).

22. I note that in *Johnson & Johnson's Application*, Case BL O/105/06, Mr Richard Arnold Q.C. as the Appointed Person upheld the registrar's decision to refuse to register a device of flowers for toiletries and medicated products for topical application on the grounds that the device was descriptive of a characteristic of such products, namely those with a floral fragrance. He said:

"12..... In my view the mark is a realistic representation of flowers rather than an abstract device. In any event, however, I consider that the hearing officer was entitled to come to the conclusion that the message that the mark would convey to the average consumer of the goods in question was that they incorporated a floral fragrance".

23. Therefore, it is clear that section 3(1)(c) can apply to figurative marks.

24. In the current case the figurative elements of the contested mark consist of a stylised representation of a hand fork, a trowel and a hand rake. These are all items that are used whilst gardening. They have negligible stylisation beyond the colours used that are orange, pale blue and lime green for the colour of the blades respectively. Whilst the evidence suffers from a number of defects it provides some support for the applicant's pleadings. The individual elements of the contested mark combine to designate gardening goods adapted for use by children. I see no reason why the tools represented in colours cannot accurately reflect the colour of such goods or that the colours are chosen to be attractive to children. The handle of the tools represented in the mark are all coloured pale brown, giving the impression of wooden handles. These figurative elements when used together are likely to be perceived as designating the activity of gardening and I disagree with Mr St Quintin insofar as he

was suggesting that these figurative elements can only designate the individual tools themselves. I also disagree with the proprietor's view¹⁸ that the figurative elements "comprise abstract representations ... arranged in an eye catching and unusual manner ...with unique and distinctive set of colours..." . It is my view that the relevant consumer will merely perceive the colours as being of the type that is attractive to children and will not analyse whether they are unique and the position of the figurative elements within the mark does not dilute their purely descriptive message.

25. As noted earlier, Mr St Quintin accepted that the word "kids" is descriptive but he submitted that the word is highly stylised because it includes three colours and a stylised font and the initial letter "k" is not capitalised. Ms Collett submitted that the word will indicate that the goods are for children, or alternatively, the intended purpose and end user of the goods. I do not consider that the stylisation of the word is such as to overcome its descriptive meaning. Rather, the choice of colours will reinforce the message that the goods are aimed at children. The visual impact of the stylisation of the letters is low and very much secondary to the message carried by the word itself.

26. Taking all of the above into account and when viewing the mark as a whole, I find that it designates the intended purpose (i.e. for gardening) and intended user (i.e. children). The colours do no more than reinforce who the intended user is because they are of the kind that is used to be attractive to children and the consumer is familiar with these types of colours being used for such a purpose. Any stylisation of the figurative elements or the word has a low visual impact and does not detract from this. The colours used and any slight stylisation that may be perceived will further enhance the message that the goods are aimed at children.

27. Ms Collett submitted that, at the very least, goods should be limited to expressly exclude goods for children and Mr St Quintin submitted that, if I were minded to cancel the mark, it should only be in respect of children's goods and the specifications should be so limited. I reject this approach because such a limitation applied to the specifications of goods would do no more than make the mark deceptive.

¹⁸ Expressed in its written submissions, para 2.9.

28. In summary, I find that neither the figurative elements, nor the colours, nor the stylisation of the word, nor the combination of the three are sufficient to divert the average consumer's attention away from, or to modify, the descriptive message conveyed by the combination of the word "kids", the figurative elements and the colours. Consequently, I find that the mark consists exclusively of a sign or indication which may serve, in trade, to designate the intended purpose and/or the intended user of the goods, namely gardening goods for children.

29. This finding extends to all the goods listed in Class 8, 12 and 20. In respect of "cushions" in Class 20, this can include garden kneeler cushions.

30. In respect of the Class 21 goods, my finding self-evidently extends to *string tins*, *seed tins*, *watering cans*, *flower pots*, *herb pots*, *gardening gloves*, *gloves for gardening* and *garden brooms*. In respect of *containers*, *water proof gloves and brushes*, these are broad terms that include goods for the activity of gardening and my finding extends to these terms also. In respect of *tins* this includes *string tins* and *seed tins* and my finding extends to this term also. In respect of Finally, in respect of tin mugs, it is not obvious to me what, if any, connection they have to gardening. Consequently, my finding does not extend to these goods.

31. In respect of the proprietor's Class 24 goods, these are not obviously for use in gardening and, consequently, my finding does not extend to these terms.

32. In respect of the proprietor's Class 25 goods, there is no submission, nor is there any evidence to suggest that *headwear*, *socks*; *boot warmers*; *boot socks*; *scarves*; *hats*; *gloves*; *tops*; *shirts*; *tee shirts*; *long sleeve tee shirts*; *fleece*s are adapted for or intended to be used when gardening. Gardening gloves are covered by the proprietor's Class 21 and, therefore, *gloves* in Class 25 do not cover such goods. Consequently, my finding does not extend to such goods. In respect of the term *clothing*, this can include clothing adapted for or intended to be used when gardening such as the various aprons shown in the evidence¹⁹ and my finding extends to this term. In respect of *wellington boots*, *garden shoes*, these are generally regarded as typical gardening footwear and, therefore, my finding extends to these terms. Finally, in respect of

¹⁹ For example at Exhibit KN4, pages 3, 42

footwear, boots, and clogs are broad terms that include the goods listed in the previous sentence and, consequently, my finding extends to these terms.

33. In summary, the application for invalidation succeeds in respect of the following goods:

Class 8: *Hand operated horticulture and garden tools; horticulture and gardening equipment; spades; trowels; forks; weeding tools; hoes; rakes; gardening string; filled tool bags; filled tool pouches; accessories and parts and fittings for all the aforesaid hand tools.*

Class 12: *Wheelbarrows.*

Class 20: *Cushions; garden kneeler cushions.*

Class 21: *Containers; ...; tins; string tins; seed tins; watering cans; flower pots; herb pots; gardening gloves; gloves for gardening; water proof gloves; brushes, garden brooms.*

Class 25: *clothing ... footwear; ... boots; wellington boots; garden shoes; clogs; ...*

34. The application fails in respect of the following goods:

Class 21: *tin mugs*

Class 24: *Blankets for outdoor use; picnic blanket.*

Class 25: *Headwear; ... socks; boot warmers; boot socks; scarves; hats; gloves; tops; shirts; tee shirts; long sleeve tee shirts; fleeces.*

Section 3(1)(b)

35. As stated in *Starbucks (HK) Ltd v British Sky Broadcasting Group plc* (at para

46) descriptive signs are also devoid of any distinctive character. It, therefore, follows that to the extent that the application for invalidation has succeeded, it must also succeed based upon its section 3(1)(b) grounds.

36. In addition, as confirmed by Ms Collett, the applicant makes no independent claim as to why the mark is non-distinctive other than because it is claimed to be a descriptive sign. This points to there being no need to consider the section 3(1)(b) ground separately to the section 3(1)(c) ground (see the comments of Anna Carboni, sitting as the Appointed Person in O-363-09 *COMBI STEAM Trade Mark*).

37. Therefore, whilst recognising that section 3(1)(b) and section 3(1)(c) are independent of each other, the circumstances in this case are such that it is not necessary for me to consider separately the ground based upon section 3(1)(b).

38. I conclude that the ground based upon section 3(1)(b) succeeds to the same extent as the ground based upon section 3(1)(c) of the Act.

Summary

39. The application partially succeeds, and the contested registration is invalidated in respect of the goods listed in paragraph 33.

COSTS

40. The applicant has been partially successful, and he is entitled to a contribution towards his costs. At the hearing, Ms Collett requested the following scale costs:

Preparing and filing TM7 and considering the counterstatement:	£600
Preparing and filing written submissions:	£1200
Attendance at hearing:	£1600

Total: £3400

41. There is nothing unusual regarding the scope, size or complexity of this case. The volume of evidence is reasonably light, and I see no reason to go beyond the middle of the scale of costs. Further, the amount requested in respect of the hearing itself is the maximum scale cost for a full day hearing despite the current hearing being less than half a day. Finally, the applicant has been successful in respect of approximately half of the goods and it would be appropriate to reduce the award by 50%. Consequently, whilst I keep Ms Collett's submission in mind, I make an award of £900 as a contribution to the applicant's costs on the following basis:

Official fee:	£200
Preparing and filing TM7 and considering the counterstatement:	£400
Preparing and filing written submissions:	£400
Preparing for and attending hearing:	£800
Reduced by 50% for partial success	(£900)
Total:	£900

42. I, therefore, order Smart Garden Products Ltd to pay Westland Horticulture Limited the sum of **£900**. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 21st day of February 2022

Mark Bryant
For the Registrar,
The Comptroller-General