

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION Nos. 2159942 and 2166950
TO REGISTER SERIES OF TRADE MARKS
IN THE NAME OF MAGIGROW INTERNATIONAL LIMITED
IN CLASS 1**

**AND IN THE MATTER OF CONSOLIDATED OPPOSITION THERETO
UNDER Nos. 49180 and 49583
BY SCOTTS MIRACLE-GRO PRODUCTS, INC**

**AND IN THE MATTER OF AN APPEAL
TO THE APPOINTED PERSON
BY THE OPPONENT
AGAINST THE DECISION OF MR J. MACGILLIVRAY
DATED 30 MAY 2001**

DECISION

Introduction

1. This appeal concerns two applications to register two series of two trade marks and two oppositions to those applications that were subsequently consolidated.
2. Application Nos. 2159942 and 2166950 were filed by Magigrow International Limited (“the applicant”) on 5 March 1998 and 18 May 1998 respectively in Class 1 for the following goods:

Fertilisers for plants; liquid fertilisers for plants; solid fertilisers for plants; boron; iron; copper; manganese; molybdenum; zinc; phosphorous pentoxide; potassium oxide; inorganic nitrates; inorganic sulphates; ammonium citrate; urea; manure; and plant food.

3. Application No. 2159942 comprises the series of word marks:


**MAGIGROW
MAGI-GROW**

4. Application No. 2166950 contains two figurative marks with the colours red, yellow, black, green and white claimed as elements of the second mark in the series:



5. Opposition Nos. 49180 and 49583 were filed by Clifford Chance on behalf of Scotts Miracle-Gro Products, Inc. (“the opponent”), a company incorporated in the state of New York, USA, on 12 November 1998 and 15 March 1999 respectively. In summary, the opponent contended that registration should be refused in each case because the applicant’s series of marks was:
- (i) applied for in bad faith contrary to section 3(6) of the Trade Marks Act 1994 (“TMA”);
 - (ii) within the area of protection afforded to the opponent’s earlier trade marks by section 5(2)(b) of the TMA;
 - (iii) liable to be prevented in use by virtue of the law of passing off under section 5(4)(a) of the TMA.
6. Application No. 2159942 was additionally opposed on the grounds that the marks were non-distinctive and exclusively descriptive within the meaning of section 3(1)(b) and (c) of the TMA. But those grounds were abandoned at the hearing of the opposition.
7. The opponent cited seven earlier trade marks in support of its grounds of opposition: three in Class 1; and four in Class 8. In the event the opponent relied only on those registered in Class 1:

Registration No.	Mark	Goods	Registration Date
953945	MIRA-CLE-GRO	Chemical products included in Class 1 for use in agriculture and horticulture; and fertilizers	21.01.1970

1519227	MIRACLE-GRO	Chemical products for use in horticulture and agriculture; fertilisers; plant foods; fertiliser spikes; preparations for controlling the acidity of soil; all included in Class 1	18.11.1982
1519229		Chemical products for use in horticulture and agriculture; fertilisers; plant foods; fertiliser spikes; preparations for controlling the acidity of the soil; all included in Class 1	18.11.1982

The opponent's four Class 8 registrations are reproduced at the Appendix to this decision.

8. There is one further registration I should mention. Registration No. 1118360 has a registration date of 27 July 1979 in Class 31 for composts for use as mulches and consists of the figurative trade mark shown below:



Registration No. 1118360 was originally owned by J. K. Peters and Co. Limited but assigned to the applicant in 1998.

Evidence of the Opponent

9. The evidence in support of the opposition consisted of an affidavit of H. L. Reichart dated 20 July 1999. He is the Advertising Vice-President of the opponent, a position that he has held with the opponent or its predecessor in title for over 20 years. He gave evidence as to the nature and extent of his company's trading activities in the UK. His evidence deals compendiously with what he calls the MIRACLE-GRO trade marks, that is, MIRACLE-GRO, MIRACLE-GRO DEVICE, MIRACLE-GRO 3 IN ONE and MIRACLE-GRO NO CLOG not only in respect of Class 1 goods – chemical products for use in horticulture and agriculture, fertilizers, plant foods, fertilizer spikes and preparations for controlling the acidity of soil – but also Class 8 goods – sprayers for use in watering and applying fertilizers to flowers, plants and the ground and parts and fittings for such sprayers. No details are included of any use of the opponent's MIRA-CLE-GRO trade mark.
10. Mr Reichart states that the opponent first used the MIRACLE-GRO trade marks in the UK in 1989. In the period 1990 - 1998, the total turnover in goods provided under the marks was £46, 903, 000. There was a 50 per cent increase in sales in 1993 that remained constant thereafter. Mr Reichart particularly points to the launch of MIRACLE-GRO lawn food in 1992, which he says: "... proved a great success and seized a large share of the lawn fertilizer market". Mr Malynicz, appearing at the appeal on behalf of the opponent, drew my attention to a mistake in Mr Reichart's declaration. Mr Reichart says: "My company's market share in the branded soluble plant food market grew from £13 million in 1989 to £32 million in 1997". What he is in fact describing is an overall growth in the branded soluble plant food market. A pie chart contained in a leaflet distributed to the opponent's dealers and exhibited at HLR4 could be taken to indicate that MIRACLE-GRO occupied 42 per cent of the branded soluble plant food market in 1997. However, the pie chart is equivocal when read with the accompanying text, which possibly accounts for the error in Mr Reichart's declaration.
11. Advertising spend in 1990 – 1998 was approximated by Mr Reichart at £9,796,000 including television advertising during peak viewing times. Exhibit HLR3 contains print outs of schedules of advertising for the years 1990-93 and 1997-99 that Mr Reichart says are representative of television campaigns over the years. On appeal, Mr Fernando, appearing on behalf of the applicant, criticised the evidence of television advertising as relating in the main to periods after the filing dates of the applications in suit. It transpires that the major part of HLR3 was not copied into paginated appeal bundles prepared by the opponent's representatives. However, it is clear to me that the whole of HLR3 was before the hearing officer and in any event the staging of earlier television campaigns is supported by HLR4 in leaflets distributed to the opponent's dealers. At exhibit HLR6 are examples of advertising and feature articles mentioning MIRACLE-GRO products published between 1989 and 1997 in magazines and newspapers ranging from Amateur Gardening to The Sun. Other types of advertising included a MIRACLE-GRO City bus for the National Garden Festival, Gateshead, 1990 (HLR7) and sponsorship of gardening competitions (HLR8 - HLR9).

12. Much of the exhibited promotional material relating to the MIRACLE-GRO trade marks also bears the mark ICI. Mr Reichart explains that from 1990 – 93 the goods were distributed exclusively in the UK by ICI. Zeneca became the UK exclusive distributor from 1993 – 95 and then Miracle Garden Care from 1995 – 98. Nevertheless, the hearing officer concluded that the opponent’s business “is being conducted with ‘Miracle-Gro’ being prominently displayed as a trade mark on the goods, albeit often with an ICI house mark (not adjacent) on the packaging”. I did not understand Mr Fernando to seriously challenge that finding of the hearing officer on appeal.
13. In order to demonstrate public recognition of the MIRACLE-GRO trade marks, Mr Reichart exhibits at HLR11 extracts of reports in Marketing magazine covering Adwatch surveys for the gardening sector. The first of these in Marketing magazine, June 1991 relates to ICI Miracle Gro compost not fertiliser/plant food. The second in Marketing magazine, June 1993 reports: “In the non-mechanical plant care sector ... we see some widely varying performances, with ICI’s Miracle Gro leading the field with 50 per cent awareness giving it some 16 per cent more than the next placed product, ICI Weedol”. No indication is given on how these awareness scores are calculated. Moreover, a chart on the same page entitled “Top ten brands prompted recall: garden products” indicates only a 21 per cent prompted awareness of “Miracle Gro”. A further chart in the same issue of Marketing magazine – “The Top 20: Prompted Recall” – indicates a 31 per cent prompted awareness of “Miracle Gro” lawn food advertisements. Exhibit HLR12 presents the results of an RSGB Omnibus survey carried out in 1997. This puts prompted awareness of MIRACLE-GRO at 60 per cent. Mr Fernando criticised the survey evidence both on appeal and at the hearing below as failing to satisfy the criteria set out in *Imperial Group plc v. Philip Morris* [1984] RPC 293. I did not understand Mr Malynicz to rely too heavily on the survey evidence.
14. Mr Reichart concludes by exhibiting at HLR14 dictionary definitions of “magic” and “miracle”, which he asserts confirm the overall conceptual similarity of the marks: “i.e. a connection with the supernatural being used in a fanciful way to describe plant food”.

Evidence of the Applicant

15. The evidence in answer to the opposition consisted of statutory declarations of Robert Gault and David Montgomerie dated 21 December 1999. Mr Gault is managing director and David Montgomerie administration manager of the applicant, which was incorporated in September 1995.
16. Mr Gault deals with the background to the present applications. First use of the MAGI-GROW marks occurred in June 1995 when the applicant’s predecessor in title Premier Way Limited launched a new soluble plant fertiliser under the marks at the Glee gardening trade show. MAGI-GROW fertiliser is an own-brand product sold only to and publicly available only from traders (usually independent garden centres) who are members of the

PREMIER retail organisation. Mr Gault exhibits at RG4 a list of PREMIER outlets as at December 1998 extending throughout the UK. He also exhibits at RG4 summaries of individual orders from PREMIER members for MAGI-GROW plant food in the years 1996, 1997 and 1998 showing the annual turnover for those years as £46,169.57, £19,468.88 and £3,170.54 respectively. Figures for 1998 are given until April 1998 only.

17. As to the words “magic” and “miracle”, Mr Gault says the dictionary definitions provided by Mr Reichart illustrate their different meanings. Further, the applicant’s marks are not MAGICGROW/MAGIC-GROW but MAGIGROW/MAGI-GROW. “Magi” refers to the wise men from the East who came to do homage to the infant Jesus. He exhibits at RG7 an extract from the Concise English Dictionary, 1998 Edition to that effect. No instance of confusion between MIRACLE-GRO and MAGI-GROW has come to his attention. He exhibits at RG6 a number of magazine articles, which compare *inter alia* the two products including an article in Gardening Which?, Jan/Feb 1997 voting “Magi-Grow Plant Food” Best Buy for the year. At RG8 he exhibits letters from satisfied customers again he says displaying no evidence of confusion.
18. Mr Gault makes reference to his company’s acquisition of Registration No. 1118360 for MAGIGROW and TREE DEVICE. He states that the assignments first to Premier Way Limited and then to the applicant took place in 1995 although I note that the registry database gives 6 March 1998 as the effective date of the assignment to the applicant. Any discrepancy is not in my view relevant to the outcome of the case.
19. Mr Montgomerie exhibits at DM3 copies of completed questionnaires on the MAGI-GROW product returned by PREMIER members listed at DM2. Mr Montgomerie makes the point that although the questionnaires require comparison with MIRACLE-GRO and PHOSTROGEN products there is no evidence of confusion in the replies.

Evidence of the Opponent in Reply

20. The evidence in reply to the applicant’s evidence consisted of an affidavit of William Dittman dated 9 June 2000. He is the Senior Vice-President of the opponent, a position that at the time he had held for six months.
21. Mr Dittman refers in particular to an article entitled “Premier Way makes lucky find in Magi-Grow” in DIY Week, March 29/April 5 1996 as illustrating the likelihood of confusion between MAGI-GROW and MIRACLE-GRO.

The Hearing Officer’s Decision

22. The opposition proceeded to a hearing before Mr John MacGillivray acting on behalf of the registrar of Trade Marks on 23 April 2001. In a written decision dated 30 May 2001, Mr MacGillivray rejected the opposition under sections 5(2)(b), 5(4)(a) and 3(6) of the TMA.

23. In summary, Mr MacGillivray's reasons for arriving at that decision were as follows:

- (i) under section 5(2)(b), notwithstanding the identity of goods and reputation of the opponent's marks:

On a global appreciation and after taking into account the possibility of imperfect recollection, the overall differences between the marks makes, I believe, the possibility of confusion sufficiently remote and it cannot be regarded as a likelihood. The opponents have failed to discharge the onus placed upon them and I conclude that the opposition under Section 5(2)(b) fails;

- (ii) under section 5(4)(a), at the date of the applications in suit notwithstanding the opponent's goodwill in the UK in the MIRACLE-GRO trade marks:

... the applications in suit and the opponent's registrations were not confusable. ... In my opinion use of the applicant's mark, on a notional and fair basis does not amount to a misrepresentation resulting in passing off its products as those of the opponent. Accordingly, the opposition under Section 5(4)(a) of the Act must fail;

- (iii) under section 3(6), notwithstanding the applicant when searching for a name for its soluble plant food may have looked to identify names like or similar to Miracle-Gro:

While it is well established that a tribunal should not be astute to find there is no dishonesty where there is evidence that the applicant set out to deceive, it does not follow that the adoption of a mark with some similarity to a market leader is prima facie evidence of intention to deceive and association, in the strict sense, can be used as a means of denoting a products suitability as an alternative to the market leader's product. The question in each case is whether there is likelihood of confusion and if there is not, the use is not objectionable and there is no bad faith. The objection under Section 3(6) fails.

The Appeal

24. On 27 June 2001 the opponent gave notice to appeal to an Appointed Person under section 76 of the TMA. In its notice of appeal the opponent seeks an order that the decision of the hearing officer be reversed, that the applications in suit be refused by the registrar of Trade Marks, appropriate further or other relief or directions and an award of costs.

25. Mr Fernando reminded me that the approach I should adopt towards this appeal is as set out by Pumfrey J. in *South Cone Inc. v. Bessant*, 25 July 2001. The appeal is limited to review:

Findings of primary fact will not be disturbed unless the hearing officer made an error of principle or was plainly wrong on the evidence. His inferences from the primary facts may be reconsidered, but weight will be given to his experience. No question of the exercise of discretion arises. In this way, error will be corrected but a different appreciation will not be substituted for that of the hearing officer if he arrived at his conclusion without error.

Section 5(2)(b)

26. Mr Malynicz challenged the hearing officer's decision under section 5(2)(b) on five main grounds.

Particularly distinctive character

27. First, he says, the hearing officer failed to give any (or sufficient) weight to the principle that a mark can have a particularly distinctive character, and therefore a broader sphere of protection, as a result of the use made of it. He takes issue with the hearing officer's finding on the evidence that the opponent had (merely) a "large share of the market" and (merely) "a reputation".
28. Referring to *Sabel BV v. Puma AG*, Case C-251/95 [1997] ECR I-6191 (ECJ), para. 24, Mr MacGillivray directed himself that for the purposes of section 5(2)(b):

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.

29. Turning to the present case, Mr MacGillivray continued (emphasis provided):

The reputation of a mark is an element to which importance may be attached in Section 5(2) considerations and at the hearing Mr Malynicz drew attention to the opponent's sales, advertising and publicity spend and the "survey results" contained in or attached to the exhibits accompanying Mr Reichart's statutory declaration of 20 July 1999, which he claimed meant that Miracle-Gro mark had achieved a particularly distinctive character, notwithstanding that, on a prima facie basis, the mark was "fairly weak". In response, Mr Fernando pointed out, quite rightly, that evidence of extensive use alone is not sufficient to demonstrate substantial reputation, that the "survey evidence" was flawed in that this evidence was not collected as part of a properly controlled or conducted exercise, that the Miracle-Gro mark was often used with the ICI house mark and that on, a prima facie basis the opponent's Miracle-Gro marks are weak in that they consist of terms ("Miracle" and "Gro") which individually lack distinctiveness. While

I take due cognisance of Mr Fernando's criticisms, it seems to me that overall, the evidence demonstrates that the opponents possess a large share of the market for plant fertilizers and the business is being conducted with "Miracle-Gro" being prominently displayed as a trade mark on the goods ... Furthermore, the opponent has spent considerable sums on promoting and advertising their mark on a national basis, through peak period television advertising, national newspapers, general and special periodicals. It is also apparent that Miracle-Gro has been subject to considerable press-comment e.g. in articles. While I do not place any great weight on the "survey evidence", its conclusions are consistent with the use and promotion of the Miracle-Gro mark. In my view the opponent's have established a reputation in their mark and I will take this into account in my decision.

30. It is clear from the above that Mr MacGillivray employed the term "reputation" to equate with high distinctive character through use in accordance with the guidance provided by the European Court of Justice in *Sabel v. Puma* at para. 24. Moreover, his finding that the opponent possessed a "large share of the market" was not intended by him to be understood diminutively. Indeed, later in his decision, Mr MacGillivray refers to the opponent as being "a market leader" in plant foods.
31. The key to the hearing officer's eventual conclusion under section 5(2)(b) lies in his correct reference to the further guidance on enhanced distinctive character issued by the Court of Justice in *Marca Mode CV v. Addidas AG and Addidas Benelux BV*, Case C-425/98, [2000] 2 CMLR 1061, para. 41:

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 likelihood of association in the strict sense.

32. I am unable to accept Mr Malynicz's first ground of appeal against the hearing officer's decision under section 5(2)(b).
33. I should add that at the hearing before me, Mr Malynicz expanded on his first ground by stating that the hearing officer did not apply the factors for assessing distinctive character set out by the Court of Justice in *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, Case C-342/97, [1999] ECR I-3830, at para. 23. Mr Malynicz acknowledged that the hearing officer covered in his decision market share, use, advertising and recognition of the MIRACLE-GRO marks. Furthermore, in assessing inherent distinctive character, Mr MacGillivray expressly stated that he took account of Mr Malynicz's concession that the opponent's marks were "fairly weak" (a concession from which I did not understand Mr Malynicz to depart on appeal

despite submissions on *Procter & Gamble Company v. OHIM (BABY-DRY)*, Case C-383/99P, 20 September 2001 (ECJ)) and Mr Fernando's arguments relating to the inherent non-distinctiveness of individual elements making up the marks. In my view, there is no substance in Mr Malynicz's expanded challenge on particularly distinctive character.

Identity of goods

34. Second and fourth, Mr Malynicz criticises the hearing officer for disregarding when comparing the marks:

- (a) the identity of the goods and the circumstances in which they are marketed; and
- (b) the principle of interdependence of factors enunciated by the Court of Justice in *Canon Kabushiki Kaisha v. MGM Inc.*, Case C-342/97, [1998] ECR I-5507, para. 17).

35. The ways in which Mr Malynicz's second and fourth grounds are expressed suggest some misunderstanding of the correct approach to section 5(2)(b) of the TMA. The relevant question to be addressed under section 5(2)(b) is whether there exists a likelihood of public confusion (*RALEIGH INTERNATIONAL Trade Mark* [2001] RPC 202, *10 ROYALBERKSHIRE POLO CLUB* [2001] RPC 643, *The Infamous Nut Company Ltd.'s Trade Mark Application*, SRIS O/411/01) taking into account all the circumstances of the case (recital 10, Council Directive 89/104/EEC, *Sabel BV v. Puma AG*, supra.).

36. Mr MacGillivray states at paragraph 31 of his decision:

In the light of the opponent's prior registrations in Class 1 it was common ground ... that identical and similar goods are involved. Furthermore, Mr Malynicz pointed out that the goods in issue are not a sophisticated or expensive product and that such goods are sold side-by-side on the shelves of retail outlets. I will take this into account in my decision.

37. Mr MacGillivray continues at paragraph 34:

In essence, the test under section 5(2)(b) is whether there are similarities in marks and goods which combine to create a likelihood of confusion. In this case I accept that identical goods [are] involved ...

and at paragraph 35:

The likelihood of confusion must be appreciated globally and I need to address the degree of visual, oral or conceptual similarity between the marks, evaluating the importance to be attached to those different

elements, taking into account the category of goods in question and how they are marketed.

38. As to the principle of interdependence of factors, Mr MacGillivray instructed himself that:

... 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-Meyer Inc.*, paragraph 17.

39. In argument, Mr Malynicz appeared to suggest that a finding of identity of goods should *per se* have resulted in a finding of likelihood of confusion in this case. But as Mr Geoffrey Hobbs QC sitting as the Appointed Person remarked in *RALEIGH INTERNATIONAL Trade Mark* [2001] RPC 202 at 211:

Similarities between marks cannot eliminate differences between goods or services; and similarities between goods and services cannot eliminate differences between marks. So the purpose of the assessment under section 5(2) must be to determine the net effect of the given similarities and differences.

40. I fail to see how the hearing officer can be said to have fallen into error. Mr Malynicz's second and fourth grounds against the hearing officer's decision under section 5(2)(b) are also unsuccessful.

Imperfect recollection

41. Mr Malynicz's third ground is that the hearing officer incorrectly applied the doctrine of imperfect recollection.

42. Mr MacGillivray correctly directed himself that in making the requisite global assessment of likelihood of confusion:

... the matter must be judged through the eyes of the average consumer of the goods/services in question ... who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them that he has kept in his mind; *Lloyd Schufabrik Meyer & Co. GmbH v. Klijsen Handel BV*, paragraph 27 [sic – para.26].

43. On this issue the hearing officer said:

Mr Malynicz sought to equate MAGI with the dictionary word MAGIC (which has a similar connotation to the word MIRACLE) and he argued this would lend to confusion through imperfect recollection. In relation to visual or aural use, I accept that the average customer may well take the word MAGI as an allusion to the word MAGIC, which in turn, could lead them to think of the opponent's marks when they see or hear the marks applied for. However, it does not follow

that a likelihood of confusion would exist and in my view the customer is likely to recognise and retain the idea of the allusion when recollecting the applicant's mark.

Finally, I turn to a conceptual comparison of the marks bearing in mind Mr Malynicz's argument about MAGI equating to or being very close to the word MAGIC which is conceptually identical or very close to the word MIRACLE in that both words have similar dictionary definitions and would be viewed as purporting to a claim that the product would assist plant growth in a manner beyond the laws of science. In response to this point I consider it likely that many people encountering the applicant's mark will, upon reflection, take the word MAGI as an allusion to the word MAGIC and could then be reminded of the opponent's mark. In my opinion for this to then go on and result in a likelihood of confusion involves taking a step too far. MIRACLE is a well known dictionary word which is unlikely to be imperfectly recollected and the [word] MAGI is, in my view, unlikely to be imperfectly recollected as MIRACLE. The marks MAGI-GROW/MAGIGROW and MIRACLE-GRO are likely to be distinguished in trade.

44. There is some justification in Mr Malynicz's third ground of criticism. The question is not whether MIRACLE would be imperfectly recollected or whether MAGI would be imperfectly recollected as MIRACLE. It is a matter of overall impression.
45. Imperfect recollection is a factor that needs to be taken into account in the global appreciation of likelihood of confusion under section 5(2). It proceeds on the assumption that the consumer does not see products bearing the earlier and later trade marks side-by-side. Instead the consumer has only a general recollection of the earlier trade mark. So the question is whether on seeing the later trade mark, the consumer is likely mistakenly to believe that products sold under the later trade mark derive from the same or economically linked source as those sold under the earlier trade mark, of which the consumer has only general recollection (*Sandow Ltd's Application* (1914) 31 RPC 196 per Sargant J. at 201 cited with approval by Luxmore L.J. in *Aristoc Ld v. Rysta Ld* (1943) 60 RPC 87, CA at 91. See also *Aristoc Ld v. Rysta Ld* (1945) 62 RPC 65, HL, at 72-73, Viscount Maugham. Although these cases were decided under the old law I can see no reason why as to imperfect recollection they should not remain relevant for the TMA).
46. That said, I am satisfied that any error is a matter of expression in the decision and that the hearing officer applied the right tests. In any event, I note Mr Malynicz's submission both at the opposition hearing and in his skeleton argument on appeal that the goods in issue are sold side-by-side in retail outlets. The doctrine of imperfect recollection has, of course, little role to play in such circumstances.

Evidence of confusion

47. Mr Malynicz's fifth ground is that hearing officer overlooked evidence of direct confusion exhibited at DM3 to the statutory declaration of David Montgomerie dated 21 December 2001.
48. Exhibit DM3 contains completed questionnaires on the MAGI-GROW product sent out by the applicant to its PREMIER retailers. The questionnaire seeks information on its performance in comparison with competing MIRACLE-GRO and PHOSTROGEN products.
49. Mr Fernando says that the hearing officer specifically referred to the PREMIER questionnaires in his review of the evidence. He cannot therefore be said not to have considered them. In fact, the questionnaires were relied on by the applicant as evidence of lack of likelihood of confusion between the applicant's and the opponent's marks.
50. Mr Malynicz first relies on a completed questionnaire by Endsleigh Garden Centre who states that it has "a large stock of Miraclegrow". Mr Malynicz accepted at the hearing of the appeal that this was nothing more than an example of misspelling.
51. Next, Mr Malynicz referred me to a response from Trelawney Garden Centre, which reads: "Should say Premier on the front. The lack of this has made it impossible to present as part of our 'own brand' image". All this is stating is that Trelawney GC would like to see the house mark of the PREMIER organisation additionally on the MAGI-GROW product.
52. Finally, Mr Malynicz took me to the Monkton Elm Garden Centre replies. Under "Any Other Comments" there is the following entry: "General comment is Magi-grow has latched onto Miracle Grow name". Mr Malynicz tried to persuade me that this entry indicated that customers of Monkton are confused. Of course, it does no such thing. It is merely a comment from Monkton who, it is clear, is not confused.
53. In view of the above, I am not surprised that the hearing officer did not deal with the questionnaires as evidence of direct confusion.

Additional criticisms

54. Mr Malynicz made two further criticisms of the hearing officer's decision under section 5(2)(b):
 - (i) he wrongly concluded that the device mark (1519229) did not add to the opponent's case;
 - (ii) he did not set out in his decision the differences between the marks.
55. Both these criticisms lack substance and I did not understand Mr Malynicz to pursue them with any vigour at the appeal.

56. Regarding Registration No. 1519229, Mr MacGillivray's finding was as follows:

I do not overlook that ... one of the Miracle-Gro marks [in Class 1] is shown on a black circle. In my view this does not add to the opponent's case. The marks applied for consist of the word MAGIGROW, the dictionary words MAGI and GROW hyphenated, the dictionary words MAGI and GROW hyphenated, within a background device of a chrysanthemum plant contained within a circle, one version of the last mark has a colour limit. It is, of course, possible to overanalyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course of trade ...

57. Thereafter, Mr MacGillivray conducted a detailed comparison of the marks both in their individual elements and their totalities. I do not believe it was then incumbent upon him to repeat that exercise by setting out the differences.

Section 5(4)(a)

58. Here Mr Malynicz says that the hearing officer fell into error by refusing to compare the packaging of the products in order to determine the applicability of section 5(4)(a).

59. Section 5(4)(a) of the TMA states:

A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

- (a) by virtue of any rule (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade.

60. In *WILD CHILD Trade Mark* [1998] RPC 455, Mr Geoffrey Hobbs QC sitting as the Appointed Person said that the relevant question for section 5(4)(a) is:

... whether normal and fair use of the [trade marks in suit] for the purpose of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

61. In *WILD CHILD* there was no prior use on the part of the applicant for registration. By contrast the applicant has used the MAGI-GROW trade marks since 1995. The present case therefore raises the additional question of whether the actual presentation of the trade marks in suit should be taken into account.

62. As far as I am aware, no case has discussed that additional question for the purposes of section 5(4)(a) of the TMA. However, the point was decided by the Court of Appeal in relation to section 11 of the Trade Marks Act 1938 in *OPEN COUNTRY Trade Mark* [2000] RPC 477. An application to register OPEN COUNTRY for clothing was opposed by the proprietor of OPENAIR in respect of identical goods. Both marks were in use at the date of the application. The opponent sought to rely on the way applicant's mark had been used as an illustration of normal and fair use. On appeal from the registry, the judge rejected that approach:

It seems to me that in making the comparison, the section and authority of *Re BALI* and, in particular, the speech of Lord Upjohn, require a comparison between the opponent's mark as used and the applicant's mark in notional fair use. It does not seem to me that it is appropriate to compare the way in which the marks were actually presented, the actual contention being that what was in fact being done was an attempt to pass off the goods of the applicant as the goods of the respondent because the marks were similarly presented. It does not seem to me to be logical or right to use that argument as a reason to oppose registration.

On further appeal, Aldous L.J., at p. 482, disagreed:

The test laid down in *Smith Hayden*, adapted in accordance with the speech of Lord Upjohn in *BALI*, is the test applicable whether the applicant has or has not used his trade mark. However, no court would be astute to believe that the way that an applicant has used his trade mark was not a normal and fair way to use it, unless the applicant submitted that it was not. It does not follow that the way that the applicant has used his trade mark is the only normal and fair manner. However in many cases actual use by an applicant can be used to make the comparison. I believe that this is such a case.

63. The differences between on the one hand, section 11 of the 1938 Act and on the other hand, section 5(4)(a) of the TMA are well known, in particular, that under section 11 it was unnecessary prove passing off and it was for the applicant to show its mark was registrable. Nevertheless, it seems to me, that the ratio of Aldous L.J. above is equally applicable to the determination of normal and fair use under section 5(4)(a) of the TMA. Remarks by Pumfrey J. in *South Cone Inc. v. Bessant*, 25 July 2001 appear to support that view although the applicant's mark in that case had not been used at the application date.
64. The *OPEN COUNTRY* case does not appear to have been drawn to the hearing officer's attention. He felt constrained when considering normal and fair use to have regard only to use of the marks "in traditional or common fonts or backgrounds e.g. a disc shaped background". Nonetheless, in the event he was wrong in that view, Mr MacGillivray did compare the respective packaging of the products and concluded:

However, in my view the evidence in the present case does not demonstrate that the "get-up" of the applicant's product is a misrepresentation or that confusion would result. The words Miracle-Gro and MAGI-GROW are very strong elements in the overall appearance and while the respective packaging contains flowers and similar product descriptors, the overall impression is of different products. I would add that the opponent has not submitted any evidence of actual confusion in the market place or that trade customers or the public would expect the marks to be economically linked.

65. I too have compared the packaging or get-up of the products. My overall impression is the same as the hearing officer's. Mr Malynicz further criticised the hearing officer's mention here of lack of evidence of actual confusion. That, Mr Malynicz says, contradicts what the hearing officer said earlier in relation to section 5(2)(b). But, as Mr Hobbs QC sitting as the Appointed Person said in *CORGI Trade Mark* [1999] RPC 549 at 557, objections in section 5 based on an "earlier trade mark" should not be assimilated with those based on "earlier rights".

Intention to deceive

66. Mr Malynicz's final grounds of appeal are that the hearing officer failed to take account of evidence of alleged deliberate intent to deceive on the part of the applicant for the purposes of sections 5(4)(a) and 3(6) of the TMA.

67. The evidence relied upon by the opponent is at Exhibit RG6 to the Statutory Declaration of Robert Gault dated 21 December 1999. RG6 contains a copy of an article entitled "Premier Way makes lucky find in Magi-Grow" in DIY Week of March 26/April 5 1996 in which Mr Gault is reported as stating:

You would think all the names like Miracle-Gro had been registered by Miracle, or that they would fight a similar name for passing off, but we went through the process of researching similar names ourselves.

68. I am mindful of the comment by Millett L.J. in *The European Limited v. The Economist* [1998] FSR 283 in relation to section 10(2) but in my view, equally applicable in the present context:

A degree of similarity is tolerable; the question is whether there is confusing similarity.

69. The marks in suit have not been found to be confusingly similar to the opponent's MIRACLE-GRO marks either under sections 5(2)(b) or 5(4)(a) of the TMA. The opponent's remaining grounds of appeal based on deliberate intention to deceive also fail. The opponent has not proved bad faith in Application Nos. 2159942 and 2166950 within the meaning of section 3(6).

Conclusion


70. In the result, the appeal fails. I have perused the papers and see no reason to depart from the normal rule that costs should follow the event. Mr MacGillivray ordered that the opponent should pay the applicant the sum of £800.00 in respect of the opposition and I direct that a further sum of £800.00 be paid to the applicant towards the costs of this appeal, to be paid on the same basis as indicated by Mr MacGillivray.

Mr Simon Malynicz, instructed by Clifford Chance, appeared on behalf of the opponent

Mr Giles Fernando, instructed by Murgitroyd & Co., appeared on behalf of the applicant

Professor Ruth Annand, 19 December 2001

APPENDIX

Registration No.	Mark	Goods	Registration Date
1519228	MIRACLE-GRO	Sprayers for use in watering and applying fertilizer to flowers, plants and the ground; parts and fittings for sprayers; all included in Class 8	18.11.1992
1519230		Sprayers for use in watering and applying fertilizer to flowers, plants and the ground; parts and fittings for sprayers; all included in Class 8	18.11.1992
1519284	MIRACLE-GRO 3 IN ONE	Sprayers for use in watering and applying fertilizer to flowers, plants and the ground; parts and fittings for sprayers; all included in Class 8	18.11.1992
1519318	MIRACLE-GRO NO-CLOG	Sprayers and sprinklers, all for watering and applying fertilizer to flowers, plants and/or the ground there around; parts and fittings for all the aforesaid goods	31.10.1994