

O/0164/23

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003626453

**IN THE NAME OF
OMS INVESTMENTS, INC.**

FOR THE TRADE MARK:

AEROGARDEN

IN CLASSES 11, 21, AND 31

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO

**UNDER NO. 504505
BY AERO LIGHT CO., LIMITED.**

BACKGROUND AND PLEADINGS

1. OMS Investments, Inc. (“the proprietor”) applied to register the trade mark shown on the cover page of this decision (“the contested mark”) in the UK on 14 April 2021. It was registered on 24 December 2021 for goods in Classes 11, 21 and 31 (see annex for the full list of goods).

2. On 19 January 2022, AERO LIGHT CO., LIMITED (“the applicant”) applied to have the contested mark declared partially invalid under section 47 of the Trade Marks Act 1994 (“the Act”). The application is based upon section 5(2)(b) of the Act and is directed at all the goods contained in Class 11 of the contested registration.¹

3. Under section 5(2)(b), the applicant relies on the following International UK Trade Mark (“IR”):

No. 0000001450313 for the trade mark **:Aero** which was applied for on 23 November 2018 and which was entered in the UK register on 25 July 2019.

4. The applicant relies upon all the Class 11 goods in its registration.²

5. The applicant’s mark is an earlier trade mark, in accordance with section 6 of the Act. As it had not been registered for five years or more at the filing date of the application for invalidity, it is not subject to the use requirements specified within section 47 of the Act. Consequently, the applicant may rely upon all of the goods for which the earlier mark is registered without having to show use.

6. The applicant claims that the parties’ marks are similar and that the respective goods are identical or similar, resulting in a likelihood of confusion. The proprietor filed a counterstatement in which it denies that there exists a likelihood of confusion or association between the parties’ marks, and it further denies that the goods at issue are identical or similar.

¹ These will be listed in the goods comparison.

² These will be listed in the goods comparison.

7. The applicant is represented by CAROLINA SÁNCHEZ MARGARETO, whereas the proprietor is represented by HGF Limited. Neither party filed evidence or written submissions. Neither party requested a hearing. Only the proprietor chose to file written submissions in lieu. This decision is taken following a careful review of the papers before me, keeping all submissions in mind.

8. 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 case law.

DECISION

9. Section 5(2)(b) of the Act has application in invalidation proceedings pursuant to Section 47 of the Act. Section 47 reads as follows:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), 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) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

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

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D)-(2DA) [Repealed]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) [...]

(4) [...]

(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.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(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 5(2)(b)

10. Section 5(2)(b) of the Act reads as follows:

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

[...]

(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”.

11. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas*

AG & Adidas Benelux BV, Case C-425/98, Matratzen Concord GmbH v OHIM, Case C-3/03, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.

The principles:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

12. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

13. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

14. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(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 service;

(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 practice 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.

15. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market (“OHIM”)*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

16. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods/services. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“...there is close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

17. The competing goods are as follows:

Applicant’s goods	Proprietor’s goods
Class 11 Torches for lighting; searchlights; lamp shades; street lamps; aquarium lights; light-emitting diodes [LED] lighting apparatus; automobile lights; light bulbs; light bulbs, electric; arc lamps; electric lamps; lamps; light diffusers; lighting apparatus and	Class 11 Hydroponic growing systems comprised of light emitting diode (LED) plant grow lights, grow cabinets in the nature of closed environments with integrated misting chambers, and automated controls therefor; LED light bulbs; Light Emitting Diode (LED) plant grow light.

installations; ceiling lights; lamp reflectors; luminous tubes for lighting.	
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18. With regard to the similarity of the goods, in its notification of invalidation the applicant states the following:

“The goods at stake in Class 11, are identical to the ones embodied in the earlier registration, and cannot be sold without entailing a confusion for the targeted consumers.”

19. With regard to the similarity of the goods, the proprietor states the following:³

“The Cancellation Applicant’s goods cover different types of lighting apparatus and connected accessories such as, light bulbs.

It is not disputed that the *“light-emitting diodes [LED] lighting apparatus”* in the Cancellation Applicant’s Goods and the *“LED light bulbs”* covered by the earlier mark are identical. Nor is it disputed that the Cancellation Applicant’s Goods are similar, if only to a low degree to the *“Light Emitting Diode (LED) plant grow light”* covered by the proprietor’s Goods, since the Cancellation Applicant’s Goods do not have any limitation to a particular area.

However, it is submitted that the *“Hydroponic growing systems comprised of light emitting diode (LED) plant grow lights, grow cabinets in the nature of closed environments with integrated misting chambers, and automated controls therefor”* covered by the Proprietor’s Goods are dissimilar to the Cancellation Applicant’s Goods.

[...]

³ Written submissions in lieu.

These goods do not have the same nature or intended purpose as those included in the Cancellation Applicant's goods, they do not have the same method of use nor the same intended customer. A customer intending to purchase a hydroponic growing system, would not purchase the cancellation Applicant's goods.

On the basis of the above, it is submitted that "*Hydroponic growing systems comprised of light emitting diode (LED) plant grow lights, grow cabinets in the nature of closed environments with integrated misting chambers, and automated controls therefor*" are dissimilar to the Cancellation Applicant's goods."

LED light bulbs; Light Emitting Diode (LED) plant grow light

20. The above contested goods are included in the broad terms *light-emitting diodes [LED] lighting apparatus; light bulbs* contained in the applicant's goods and therefore are considered identical in line with the principle set out in *Meric*.

Hydroponic growing systems comprised of light emitting diode (LED) plant grow lights, grow cabinets in the nature of closed environments with integrated misting chambers, and automated controls therefor

21. Hydroponics is a type of soilless gardening that can be done either indoors or outdoors. Indoor *hydroponics growing systems* require artificial lighting. The most common form of hydroponic lighting is LED (light emitting diode) bulbs, on the basis that they are efficient and long lasting, etc. Accordingly, I find that the above contested goods share a degree of similarity with the applicant's broad terms *light-emitting diodes [LED] lighting apparatus; light bulbs* on the basis that as lighting is an essential component in the proprietor's goods, they are dependent on the applicant's goods to function effectively. Since the proprietor's goods have built-in LED lights, it is possible that over time, these lights may need replacing, as such, it seems likely that the same undertaking will provide the replacements. Accordingly, since LEDs are required for the use of hydroponic growing systems, I find the competing goods to be complementary. Whilst the nature and uses of the goods

differ, the users will overlap. Additionally, the goods at issue are likely to be found under the same category online and in the same or adjacent aisles in physical stores. Overall, I find these goods to be similar to a low degree.

The average consumer and the nature of the purchasing act

22. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

23. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

24. The average consumer of the goods at issue is likely to include members of the general public as well as business and specialist users. The goods will mainly be available via retailers, being both general retailers and more specialist ones, and their online or catalogue equivalents. At the retailers' physical premises, the goods will be displayed on shelves and in cabinets being self-selected by the consumer. A similar process will apply when the goods are selected online or via catalogues, in that a consumer will select them after seeing an image, on, for example, a webpage or in a catalogue. In my view, the visual component will dominate all methods of sale, although I do not discount an aural component playing a part given that orders may be placed by telephone or that word-of-mouth recommendations and advice may be

received from sales assistants. Given the range of goods at issue, the price and frequency of purchase will vary depending on their nature and type. In this regard, when selecting the goods at issue, the average consumer is likely to pay at least a medium degree of attention.

Comparison of the marks

25. It is clear from *Sabel BV v. Puma AG* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, that:

“34. [...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

26. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

27. The trade marks to be compared are as follows:

Applicant's mark	Proprietor's mark
:Aero	AEROGARDEN

Overall impression

28. The applicant's mark contains the prefix 'Aero' presented in standard sentence case, with a capital first letter, and lower-case letters following. This word is preceded by a colon. Whilst the colon does contribute to the distinctive character of the mark, the word 'Aero' dominates the overall impression.

29. The proprietor's mark consists of the words 'AERO' and 'GARDEN' conjoined, presented in standard upper-case letters without any stylisation. The overall impression resides in this single element.

Visual comparison

30. With regard to the visual similarity of the marks, in its notification of invalidation, the applicant states the following:

"The visual impact is a very important factor to be taken into account. In the present case, the fact that the trademark AERO is repeated and placed at the beginning of the trade mark, is the most relevant criteria. So, there is a high degree of similarity from the visual point of view."

31. With regard to the visual similarity of the goods, the proprietor states the following:⁴

"It is admitted that the marks both contain the term AERO. However, the addition of the word GARDEN in the Proprietor's Mark, as well as the omission of the colon create a different overall visual impression.

The colon at the very start of the Earlier Mark is an unusual element which would not go unnoticed by consumers. Consequently, its omission would also go unnoticed.

⁴ Written submissions in lieu.

Moreover, the addition of GARDEN which more than doubles the length of the proprietor's Mark – 10 Characters in the Proprietor's Mark vs. (max5) characters in the Earlier Mark – creates a significant visual difference.

Therefore, it is submitted that the marks are overall visually dissimilar or at the very least only similar to a low degree.”

32. Visually the marks coincide insofar as they identically share the same first four-letter word 'Aero / AERO'. This similarity appears at the beginning of the respective marks (save for the colon), being where consumers tend to focus⁵ as this position is generally considered to have more impact due to consumers in the UK reading from left to right. In making my visual comparison of the marks, I bear in mind that notional and fair use of the marks would include use in both upper and lower case,⁶ so letter case is irrelevant to the comparison.

33. The competing marks are visually different in that there is a colon present at the beginning of the applicant's mark which is not replicated in the proprietor's mark. Furthermore, the word 'AERO' in the proprietor's mark is followed by the word 'GARDEN', which is not present in the applicant's mark. This additional word renders the competing marks different in length. Accordingly, weighing up the similarities with the differences, I find the competing marks to be visually similar to a medium degree.

Aural comparison

34. With regard to the aural similarity of the marks, in its notification of invalidation, the applicant states the following:

“From the phonetic perspective, the trademarks share the beginning of the trademark, which is the most relevant when it has to be pronounced by consumers. So, the phonetic degree of similarity is highly proven.”

35. With regard to the aural similarity of the goods, the proprietor states the following:⁷

⁵ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

⁶ *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17

⁷ Written submissions in lieu.

“The relevant consumer would pronounce the Earlier Mark as “colon Aero” thereby placing the term AERO as the suffix within the mark. Meanwhile, the Proprietor’s Mark would be pronounced as “AERO GARDEN”. This places the AERO element as the prefix and follows with the longer term GARDEN.

As a result, it is clear that in pronouncing the marks there is a significant difference between the two and that they are phonetically dissimilar or at least only similar to a low degree.”

36. The applicant’s mark comprises two syllables, i.e., ‘Aer-o’, whereas the proprietor’s mark comprises four syllables, i.e., ‘AER-O-GAR-DEN’. Accordingly, the competing marks aurally coincide in the common syllables ‘Aer-o / AER-O’, which aurally, is the entirety of the applicant’s mark and the first two syllables of the proprietor’s marks. The competing marks aurally differ insofar as the proprietor’s mark has two additional syllables, namely, ‘GAR-DEN’. I am of the view that the colon element in the applicant’s mark will not be verbalised. Overall, I find the competing marks are aurally similar to a medium degree.

Conceptual comparison

37. With regard to the conceptual similarity of the marks, in its notification of invalidation, the applicant states the following:

“From a conceptual point of view, the confronted signs are highly similar. The trademarks share, in first position the word AERO. The objected trademark is followed by the word GARDEN.

AERO is a prefix used in several combinations, which means, according to the Cambridge dictionary *of air or of air travel. AEROGARDEN, will be regarded by the consumers, as a combination of AERO+GARDEN.* And therefore, as a variation of the trademark AERO.

Therefore, there is a high similitude from the conceptual point of view.”

38. With regard to the conceptual similarity of the goods, the proprietor states the following:⁸

“The elements of the Earlier Mark can be defined as follows:

‘:’ a sign used to mark a major division in a sentence, to indicate what follows is an elaboration, summation, implication, etc. of what precedes. ‘Aero’(1) of or for aircraft, (2) of or relating to aeronautics.

The Earlier Mark would therefore be considered by the relevant consumer to mean that the products are connected with Aeronautics and that the term AERO acts as the suffix within the mark, with an expectation that there would be another term added prior to it.

In contrast, the elements of the Proprietor’s Mark would be defined and understood by the consumer to mean as follows:

AERO- a combining form meaning “air”, used in formation of compound words. GARDEN (1) A plot of ground, usually near a house, where flowers, shrubs, vegetables, fruits, or herbs are cultivated, (2) a piece of ground or other space, commonly with ornamental plants, trees, etc., used as a part [sic] or other public recreation area, (3) a fertile and delightful spot or region.

Contrary to the submissions filed by the Cancellation Applicant, these definitions indicate that while the two marks share the element AERO, overall the addition of the colon in the Earlier Mark and the addition of the word GARDEN on the Proprietor’s Mark create very different conceptual meanings, as different definitions are applied to each.

The Cancellation Applicant submitted that the Proprietor’s Mark would be regarded as a variation of the trade mark AERO. However, as discussed above, both visually, phonetically and conceptually this is highly unlikely. The addition of the ‘:’ as a prefix to the Earlier Mark cannot be ignored. Visually, phonetically and conceptually the term AERO is placed as a suffix. If it were to

⁸ Written submissions in lieu.

be combined with another term, the use of : in the Earlier Mark would indicate that grammatically the additional term is more likely to be placed before the ':' rather than after the term AERO.

As a result, it is submitted that the two marks are conceptually dissimilar or at most only conceptually similar to a low degree.”

39. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

40. In my view, the word 'Aero' in the applicant's mark will be given its ordinary dictionary meaning, namely *denoting air or aircraft*.⁹ This has no obvious connection to the goods in the applicant's specification. With regard to the colon present at the start of the mark, I note the proprietor's submissions that due to its presence consumers will expect a word to come before ':Aero', however, this is not a persuasive argument on the basis that there is no other word in the applicant's mark. Accordingly, I find that the colon does not add to the concept of the mark, particularly given that for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.

41. With regard to the proprietor's mark, a proportion of average consumers will perceive 'AEROGARDEN' as an unusual combination of words with no immediate graspable cohesive concept. However, another group of consumers will notice the standalone words *AERO* and *GARDEN* in the word 'AEROGARDEN' and will likely perceive the meaning of 'AERO' as previously discussed, and the word 'GARDEN' to mean, an area of land, usually planted with grass, trees, flowerbeds, etc, adjoining a house.¹⁰

⁹ www.collinsdictionary.com/dictionary/english/aero

¹⁰ www.collinsdictionary.com/dictionary/english/garden

42. Accordingly, for those consumers who perceive the proprietor's mark as an unusual combination of words, the marks will be conceptually different, as one will convey a meaning and the other will be viewed as having no immediate concept. However, for consumers who recognise the word 'AERO' at the start of the applicant's mark, they will immediately think of the dictionary meaning of that word, and therefore, as the marks at issue share a concept with regards to the word 'AERO', I find the marks to be conceptually similar to a medium degree.

Distinctive character of the earlier trade mark

43. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

44. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

45. Although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the applicant has not filed any evidence of use. Consequently, I have only the inherent position to consider.

46. The applicant's mark consists of the word 'Aero' preceded by a colon (punctuation mark). Whilst the word 'Aero' will be understood as a reference to *air* or an *aircraft*, as previously stated, it has no obvious connection with the goods for which the applicant's mark is registered. The punctuation mark (colon) present at the start of the mark will be perceived as just that and as such, whilst the colon does contribute to the distinctive character of the mark, the word 'Aero' dominates the overall impression. On this basis, I find the applicant's mark, as a whole, to be inherently distinctive to a medium degree.

Likelihood of confusion

47. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

48. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related.

49. Earlier in the decision I concluded that the marks are visually, aurally and conceptually similar to a medium degree, and for those average consumers who perceive 'AEROGARDEN' as an unusual combination of words with no immediate graspable cohesive concept, I have found the marks to be conceptually dissimilar. I have found that the applicant's mark has a medium degree of inherent distinctive character for the goods at issue. Furthermore, I found the similarity between the goods at issue to range from identical to similar to a low degree. I have found that average consumers of the goods will include members of the general public and businesses or specialist users. I have found that average consumers will pay at least a medium degree of attention when selecting the goods. I have found that the purchasing process will be largely visual, however, I have not discounted aural considerations.

50. I acknowledge that the word 'Aero / AERO' is identically present in the competing marks. Nevertheless, there is a colon (:) present at the beginning of the applicant's mark which has no counterpart in the proprietor's mark, and there is the additional word 'GARDEN' present at the end of the proprietor's mark which has no counterpart in the applicant's mark. With regard to the colon in the applicant's mark, whilst this will not go unnoticed, I find it unlikely that this element will be articulated and will likely be disregarded by consumers upon a visual inspection of the mark. With regard to the additional word 'GARDEN' present at the end of the proprietor's mark, whilst I keep in mind that the beginnings of marks tend to make more of an impact than the ends being where consumers tend to focus,¹¹ I do not consider it likely that consumers would entirely forget this word as it not only changes the length of the mark but also adds a third and fourth syllable to the mark. Accordingly, I am of the view that the additional word present in the proprietor's mark would not be

¹¹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

overlooked or disregarded by the average consumer upon a visual inspection of the marks, which is of heightened importance given that I have found the purchasing process to be predominantly visual in nature. Due to the impact of this difference, it is unlikely that consumers will mistake them for each other. Moreover, even in circumstances where the goods are purchased aurally, for instance, over the telephone, it is unlikely that consumers would mistake the marks for one another when hearing them uttered aloud or making orders verbally. Accordingly, even when factoring in the principles of imperfect recollection and interdependency, I do not consider there to be a likelihood of direct confusion.

51. Having found no likelihood of direct confusion, I now go on to consider indirect confusion.

52. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but

the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

53. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

54. These examples are not exhaustive but provide helpful focus.

55. I acknowledge that a finding of indirect confusion should not be made merely because the two marks share a common element. However, it is not sufficient that a mark merely calls to mind another mark:¹² this is mere association not indirect confusion.

56. The word ‘Aero / AERO’ is present in both marks and is the only word contained in the applicant’s mark. The proprietor’s mark comprises the words ‘AERO’ and ‘GARDEN’ presented as a single word, though I am of the view that they will be perceived separately, namely as ‘AERO GARDEN’. As previously stated, the colon

¹² *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

present in the applicant's mark, though not negligible, will not be articulated and will likely be disregarded. Subsequently, whilst consumers will recognise that there is a difference between the competing marks, they will also recognise the common word 'Aero / AERO' present at the beginning of both marks, being where consumers tend to focus. Furthermore, the word 'AERO' is not descriptive or allusive in relation to the goods at issue, and the word 'GARDEN' in the proprietor's mark alludes to garden-related goods. It is therefore my view that consumers may consider the addition of the common dictionary word 'GARDEN' to be a sub-brand of the applicant's mark, where for example, the goods may be intended for use in a garden. Accordingly, I find that this will lead to indirect confusion, even where I have found the goods to be similar to a low degree. Furthermore, I find this to be the case even for those consumers who recognise that the proprietor's mark comprises two words conjoined but perceives the combination as unusual with no immediate concept.

Conclusion

57. The application to partially invalidate trade mark 3626453 succeeds under Section 5(2)(b) of the Act. Accordingly, subject to a successful appeal, the mark will be invalidated in respect of the following goods:

Class 11 Hydroponic growing systems comprised of light emitting diode (LED) plant grow lights, grow cabinets in the nature of closed environments with integrated misting chambers, and automated controls therefor; LED light bulbs; Light Emitting Diode (LED) plant grow light.

58. The contested mark will remain on the register in respect of the remaining unchallenged goods, namely:

Class 21 Hydroponic garden kit for home use comprising growing containers and also including hydroponic fertilizers, seeds, substrate, drain components, a book and starting class of DVD and CD instructional materials.

Class 31 Organic gardening kit for indoor and outdoor planting composed primarily of organic seeds for herbs, salads, flowers or vegetables and also including liquid plant food, grow sponges, grow baskets and grow domes.

Costs

59. As the cancellation applicant has been successful, it is entitled to an award of costs in its favour. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 2/2016. Using that TPN as a guide, I award costs to the cancellation applicant on the following basis:

Official fee	£200
Preparing a statement and considering the other side’s statement	£250
Considering the other side’s submissions in lieu	£100
Total	£550

60. I order OMS Investments, Inc. to pay AERO LIGHT CO., LIMITED the sum of £550. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 15th day of February 2023

**Sam Congreve
For the Registrar**

Annex

Class 11 Hydroponic growing systems comprised of light emitting diode (LED) plant grow lights, grow cabinets in the nature of closed environments with integrated misting chambers, and automated controls therefor; LED light bulbs; Light Emitting Diode (LED) plant grow light.

Class 21 Hydroponic garden kit for home use comprising growing containers and also including hydroponic fertilizers, seeds, substrate, drain components, a book and starting class of DVD and CD instructional materials.

Class 31 Organic gardening kit for indoor and outdoor planting composed primarily of organic seeds for herbs, salads, flowers or vegetables and also including liquid plant food, grow sponges, grow baskets and grow domes.