

O/0470/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATIONS NOS. 3756077 AND 3760642

BY DERRY GREEN

FOR THE TRADE MARKS

The Secret Garden Glamping

AND



AND

CONSOLIDATED OPPOSITIONS THERETO
UNDER NOS. OP000433951 AND OP000434340
BY BACKWOODSMAN LIMITED

Background and pleadings

1. These proceedings concern two consolidated oppositions brought by Backwoodsman Limited (“the opponent”) against two trade mark applications filed by Derry Green (“the applicant”).

The ‘077 application

2. On 17 February 2022, the applicant applied to register trade mark no. 3756077 (“the ‘077 mark”) in the UK, which appears as follows:

The Secret Garden Glamping

3. The application for the ‘077 mark was published on 04 March 2022 and registration is sought for the following services:

Class 43: *Holiday lodgings; Holiday accommodation services; Arranging holiday accommodation; Camp services (Holiday -) [lodging]; Rental of holiday homes; Holiday camp services [lodging]; Letting of holiday accommodation; Rental of holiday accommodation; Holiday planning services [accommodation]; Rental of holiday cabins; Services for reserving holiday accommodation; Booking services for holiday accommodation; Providing temporary lodging at holiday camps; Booking agency services for holiday accommodation; Arranging of accommodation for holiday makers; Providing temporary accommodation in holiday homes; Temporary accommodation services provided by holiday camps; Rental of temporary accommodation in holiday homes and flats; Hotels, hostels and boarding houses, holiday and tourist accommodation; Reservation of temporary accommodation in the nature of holiday homes.*

The ‘642 application

4. On 01 March 2022, the applicant applied to register trade mark no. 3760642 (“the ‘642 mark”) in the UK, which appears as follows:



5. The application for the '642 mark was published on 18 March 2022 and registration is sought for the following services:

Class 43: *Letting of holiday accommodation; Holiday lodgings; Rating holiday accommodation; Holiday accommodation services; Arranging holiday accommodation; Rental of holiday homes; Holiday camp services [lodging]; Camp services (Holiday -) [lodging]; Provision of holiday accommodation; Arranging of holiday accommodation; Rental of holiday accommodation; Holiday planning services [accommodation]; Rental of holiday cabins; Services for reserving holiday accommodation; Booking services for holiday accommodation; Accommodation letting agency services [time share]; Providing temporary lodging at holiday camps; Booking agency services for holiday accommodation; Arranging of accommodation for holiday makers; Providing temporary accommodation in holiday flats; Providing temporary accommodation in holiday homes; Temporary accommodation services provided by holiday camps; Rental of temporary accommodation in holiday homes and flats; Hotels, hostels and boarding houses, holiday and tourist accommodation; Providing on-line information relating to holiday accommodation reservations; Reservation of temporary accommodation in the nature of holiday homes.*

6. On 01 June 2022 and 20 June 2022 respectively, the opponent opposed the applicant's applications. The applications are opposed on the basis of Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").

7. The opponent relies upon the two trade marks set out below for the purposes of both oppositions under Section 5(2)(b):

1. UK00002542311 (series of two)(“the 311 earlier mark”)

THE SECRET GARDEN PARTY

SECRET GARDEN PARTY

Filing date: 18 March 2010

Date of entry in register: 20 August 2010

2. UK00801066674 (“the 674 earlier mark”)

THE SECRET GARDEN PARTY

Filing date: 17 September 2010

Date of entry in register: 05 January 2012

8. Under these marks the opponent relies on some of the registered services, namely:

Class 43: *Restaurant, cafe, fast food catering, snack-bar, pub and bar services; reservation services for temporary accommodation; information relating to all the foregoing provided by telephone, mobile telephone, on-line from a computer database or via the Internet; consultancy, advisory and information services relating to the foregoing.*

9. The trade marks upon which the opponent relies qualify as earlier trade marks pursuant to Section 6 of the Act. As both earlier marks had completed their registration process more than 5 years before the application date of the marks in issue, they are subject to proof of use pursuant to Section 6A of the Act.

10. Under Section 5(2)(b) the opponent claims that the marks are similar and that the services are identical or similar, meaning that there is a likelihood of confusion.

11. Under Section 5(3), the opponent relies on the same earlier marks set out above and claims reputation for the same services plus the following services:

Class 41: *Organising and staging musical events, shows, concerts, festivals, gigs and live band performances; hospitality services (entertainment); information relating to all the foregoing provided by telephone, mobile telephone, on-line from a computer database or via the internet; consultancy, advisory and information services relating to the foregoing.*

12. The opponent states that use of the applicant's marks would, without due cause, take unfair advantage of or be detrimental to the distinctive character or repute of the earlier marks.

13. Under Section 5(4)(a), the opponent relies on the sign 'THE SECRET GARDEN PARTY' and claims to have used it throughout the UK since 2002 in relation to *organising and staging musical events, festivals* (Class 41) and *provision of temporary accommodation; provision of camping services* (Class 43). The opponent claims that it has established goodwill through extensive use of the sign in the UK and that use of the contested marks would be a misrepresentation likely to cause damage to that goodwill.

14. The applicant filed counterstatements in which it denies the claims made and put the opponent to proof of use for the services relied upon. In particular, the applicant:

- States that use of the words 'the secret garden' are not unique to either the applicant or the opponent, and that several other marks use this phrase as part of their marks;
- Denies that the services are similar because:
 - (a) The applicant provides temporary holiday accommodation in permanent structures which are available to book for most days of the year. Conversely, the opponent provides temporary accommodation in non-permanent structures during the duration of its four-day The Secret Garden Party festival which takes place once a year;

- (b) The applicant's predominant trade channels, in addition to its own website and social media, are Airbnb and TripAdvisor, which is expected for a business offering year-round holiday accommodation. It is not possible to book accommodation with the opponent outside of the festival dates or via any other means other than their website;
- (c) The applicant's target consumers are those wishing to have a glamping experience in the Northwest of the UK, whereas the opponent's target consumers are festival goers;
- (d) The parties' marks only share one class and within that class (41), the only similarity shared is "reservation services for temporary accommodation." As outlined above at (b), that term is applied to quite different services in real terms and no reasonable consumer would confuse the two services or assume that the marks are one and the same. Furthermore, the term only states that the opponent is providing 'reservation services' not the accommodation itself. Providing holiday accommodation is the applicant's primary service and their main reason for seeking registration is to protect the mark in this specific sector;
- Whilst the applicant admits that the opponent's mark is renowned for an annual festival, he also states that "*when the applicant started trading as The Secret Garden Glamping (2020), the opponent had not held a festival for four years (since 2017) and the applicant had no reason to think that the festival would return*". The applicant also states that the applicant has been trading for two years, during which it has built its own goodwill and reputation.

15. Both parties filed evidence during the evidence rounds. The opponent also filed written submissions dated 14 October 2022. I shall refer to the evidence and submissions to the extent that I consider necessary.

16. The opponent is represented by Lewis Silkin LLP and the applicant by The Trademark Helpline. Neither party asked to be heard nor did they file submissions in lieu. This decision is taken following a careful perusal of the papers.

EU Law

17. 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 Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

The evidence

18. The opponent's evidence consists of a witness statement by Freddie John Fellowes who is the director of the opponent's company. Mr Fellowes' witness statement is dated 14 October 2022 and is accompanied by eleven exhibits (FJF1-FJF11).

19. The applicant's evidence consists of a witness statement by Steve Dobson who is the director of The Trademark Helpline, the firm representing the applicant in these proceedings. Mr Dobson's witness statement is dated 14 December 2022 and is accompanied by seven exhibits (DG1-DG7).

DECISION

Proof of use

Section 6A:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

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

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) 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.

(5)-(5A) [Repealed]

(6) 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.”

20. As the earlier '674 mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

21. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

22. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114. [...] The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v*

Office for Harmonisation in the Internal Market (Trade Marks and Designs) [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or

services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

23. The relevant periods for the assessment of proof of use are the five-year period ending with the filing dates of the contested applications, namely 18 February 2017 to 17 February 2022 (in the opposition to the ‘077 application) and 2 March 2017 to 01 March 2022 (in the opposition to the ‘642 application).

24. As the ‘674 earlier mark is a comparable mark based upon an earlier EUTM, use of the mark in the EU prior to IP Completion Day (being 31 December 2020) is relevant to the present assessment. This means that for the periods until 31 December 2020, the relevant jurisdiction for the proof of use assessment is the EU. However, for the period 1 January 2021 to 17 February 2022 (in the opposition against the ‘077 mark) and 1 January 2021 to 1 March 2022 (in the opposition against the ‘642 mark), the relevant territory for the proof of use assessment is the UK only. On the point of use in the EU, I refer to the case of *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, wherein the Court of Justice of the European Union (“CJEU”) noted that:

“It should, however, be observed that ... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

25. Proven use of a mark which fails to establish that “*the commercial exploitation of the mark is real*” because the use would not be “*viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services protected by the mark*” is not, therefore, genuine use.

Assessment of proof of use

26. The applicant’s counterstatements and evidence contain two concessions, namely (a) that the opponent’s mark is renowned for an annual music festival and (b) that the opponent provides temporary accommodation in non-permanent structures. It also appears to me that these conclusions are borne out by the opponent’s evidence. This shows that the names ‘Secret Garden Party’ and ‘The Secret Garden festival’ have been used in relation to a festival which started as an unbranded private party organised by the opponent’s director at his house and developed into an annual event held in the summer. The first official festival was launched in 2004. The main difference between the opponent’s festival and other more traditional festivals is that the opponent also offers ticketholders luxury accommodation options - something not typically associated with festival life or culture. The opponent has provided camping facilities at its festival since 2004, and boutique camping (also known as glamping) since 2008.

27. The opponent has won a number of awards since 2005, including the UK Festival Awards’ Best Small Festival (2005 and 2008), Best Medium Sized Festival (2011), Live Music Business Awards (2011, 2012, 2014) and the Act of Independence Award

from the Association of Independent Festivals (AIF). The opponent's director, in a personal capacity, also won the Outstanding Contribution Award at the UK Festival Awards (2017).

28. In March 2017, the opponent announced that the 2017 festival would be its last one. This was held on 20 - 23 July 2017. However, in August 2021 the opponent announced that 'The Secret Garden Party' would return in the summer of 2022. Upon announcement of its return, over 70,000 participants pre-registered for tickets and once tickets were released for sale on 26 September 2021, they sold out in two hours.

29. The opponent has used the trade marks 'SECRET GARDEN PARTY' and 'THE SECRET GARDEN PARTY' since 2004. Marketing spend is provided only for two years, amounting to £158,610 in 2017 and £47,439 in 2022. Examples of press coverage about the opponent's festival are produced, including an article from the BBC dated 1 September 2021 – which is within the relevant period - titled "*Secret Garden Party: Festival returns after five-year break*". The article states that about 30,000 people attended the festival held in July 2017 and that the festival will return from 21 to 24 July 2022. Another article from 2016 states that the festival normally takes place on the last weekend of July, it lasts for four days, is held in Huntingdon, Cambridgeshire, England, and costs £190 per ticket.

30. The opponent provides the numbers of followers of its social media pages. These are 176,438 (Facebook), 50,100 (Twitter) and 50,700 (Instagram). However, it is not clear whether these figures are within the relevant periods. Screenshots taken from the opponent's official website (www.secretgardenparty.com) are also produced; they show images of the opponent's festivals for the years 2012, 2013, 2015, 2016 and 2022, however, I note that the pages relating to 2017 are missing. The pages from 2016 and 2022 display pictures of tents which are shown below:



Secret Garden Party

23 July 22

Photo credit: Galen Smith



Secret Garden Party 2016

21 July 16

Boutique Camping

Photo credit: Giles Stuart

31. Annual revenue generated from the sales of (a) tickets to the festival, (b) provision of food and drink and (c) provision of boutique glamping services - where available - is provided for the years 2013, 2014, 2015, 2016, 2017 and 2022:

Year of Event	Revenue Category	Amount (GBP)	Comments
2013	Boutique camping (glamping)	£180,597.00	-
2014	Boutique camping (glamping)	£177,719.79	-
2015	Boutique camping (glamping)	£270,763.51	-
2016	Boutique camping (glamping)	£252,278.01	-
2017	Ticket sales	£3,193,035.00	Introduced at Exhibit FJF7 is a breakdown of ticket sales for the 2017 SGP festival.
2017	Concessions (provision of food and drink)	£328,128.00	-
2017	Boutique camping (glamping)	£308,149.00	-
2022	Ticket sales	£4,038,067.76	Introduced at Exhibit FJF8 is a breakdown of ticket sales for the 2022 SGP festival.
2022	Concessions (provision of food and drink)	£1,938,188.93	-
2022	Boutique camping (glamping)	£800,237.00	Of this figure, £768,689.00 was generated by 1 March 2022. Introduced at Exhibit FJF9 is a breakdown of monthly bookings of boutique camping accommodation provided under the SGP Marks.

32. The number of tickets sold at each festival from 2013 to 2022 is as follows:

Year of Event	Number of Adult Tickets sold
2013	17,172
2014	23,534
2015	24,322
2016	16,970
2017	21,852
2022	21,272

33. However, the only revenue which is relevant for the proof of use is that relating to the year 2017 and, as I will say below, the year 2022.

34. Mr Fellowes says that all entry tickets include camping accommodation as standard. He also refers to the opponent organising coaches to collect and return

participants, however, these would be transport services which are not covered by the specifications relied upon.

35. There is no issue with the way the marks have been used, as there are many examples of use of the marks as registered.

36. Although the opponent's period of non-activity coincides with most of the relevant periods, the festival held in July 2017 fall within the relevant periods. In 2017, the opponent sold 21,852 tickets, generating a turnover of £3,193,035 from the sale of the tickets, £308,149 from the provision of boutique camping and £328,128.00 from concessions (provision of food and drink). In August 2021, the opponent announced that 'The Secret Garden Party' would return in the summer of 2022; although the event took place in July 2022 (after the relevant periods), the tickets were released for sale on 26 September 2021 (within the relevant periods) and were sold out in two hours generating a revenue of £4,038,067. In addition, a total of £768,689.00 was generated from the sale of accommodation, namely boutique camping (glamping) by 1 March 2022 (within the relevant periods). Taking into account (a) the amount of tickets sold within the relevant periods (which amounts to 43,124), (b) the revenue generated by the sale of tickets and accommodations within the relevant periods (which amounts to over £8.3million), (c) the marketing spend which is dated within the relevant period (this amounts to £158,610 in 2017 but most of the marketing spend for 2022 appears to be dated after the relevant period)¹, (d) the geographical spread of the opponent's customers, who appears to come mostly from England, but also from Scotland and Wales,² and (e) the press coverage, I am satisfied that the opponent has shown genuine use of the earlier marks within the relevant period.

Fair specification

37. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

¹ JFJ2

² JFJ10

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

38. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

39. I shall start with the services relied upon under Section 5(2)(b).

Class 43: *Restaurant, cafe, fast food catering, snack-bar, pub and bar services; reservation services for temporary accommodation; information relating to all the foregoing provided by telephone, mobile telephone, on-line from a computer database or via the Internet; consultancy, advisory and information services relating to the foregoing.*

40. Although the opponent states that it generated some turnover in 2017 from concessions (provision of food and drink), I understand this to relate to the opponent contracting the right to sell food to third parties. This seems to be confirmed by an article about The Secret Garden Party which refers to food sold under third party's brands:

“What food can I eat there?

What can't you eat there, that's the real question. OK fine, we've heard that you need to check out Annie Mae's for their array of mac n' cheese flavours and Smokeshack do a banging pulled pork burger. For the more upmarket amongst you, this year they've even got a proper 80-cover restaurant with actual real life cutlery and glassware which former head chef of a Michelin star restaurant, Chris Gillard, will be running. Oh, and obviously you can take your own grub in

too but that bumper crate of baked beans and mini stove always seems like a far better idea before you actually get there”

41. Consequently, I find that the evidence does not establish that the earlier marks have been used during the relevant periods in relation to the following registered services, which relate to the provision of food and drinks:

Class 43: *Restaurant, cafe, fast food catering, snack-bar, pub and bar services; information relating to all the foregoing provided by telephone, mobile telephone, on-line from a computer database or via the Internet; consultancy, advisory and information services relating to the foregoing.*

42. As regards *reservation services for temporary accommodation*, the evidence shows use of the opponent’s marks in relation to the provision of campground accommodation (which would include related reservation services as the accommodation is booked in advance) and related information provided online. Accordingly, I find that the term *reservation services for temporary accommodation* is too broad, as it would cover any type of accommodation including, for example, hotels and I consider that a fair specification which reflect the use made is:

Class 43: *reservation services for campground accommodation; information relating to all the foregoing provided on-line from a computer database or via the Internet.*

43. As the applicant requested proof of use in respect of all services relied upon under the mark, the present assessment must also deal with those services relied upon solely under the Section 5(3) ground.

44. Under Section 5(3) the opponent relies on additional services, namely:

Class 43: *organising and staging musical events, shows, concerts, festivals, gigs and live band performances; hospitality services (entertainment); information relating to all the foregoing provided by telephone, mobile*

telephone, on-line from a computer database or via the internet; consultancy, advisory and information services relating to the foregoing.

45. The only use shown by the evidence is in relation to organising and staging festivals. There is also evidence of the opponent providing related information services provided on-line from a computer database or via the internet. Accordingly, I consider that a fair specification which reflects the use made is:

Class 43: *organising and staging festivals; information relating to all the foregoing provided on-line from a computer database or via the internet.*

Section 5(2)(b)

46. Section 5(2)(b) of the Act is as follows:

“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”.

47. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

48. The following principles are gleaned from the decisions of the EU courts 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.

(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 great 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 might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of services

49. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the CJEU stated that:

“23. 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 complementary.”

50. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] RPC 281. At [296], he identified the following relevant factors:

(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.

51. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods (though it equally applied to services) are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa.

52. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] there is a 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.”

53. The services to be compared are as follows:

The applicant's services	The opponent's services
<p>The '077 mark</p> <p>Class 43: <i>Holiday lodgings; Holiday accommodation services; Arranging holiday accommodation; Camp services (Holiday -) [lodging]; Rental of holiday homes; Holiday camp services [lodging]; Letting of holiday accommodation; Rental of holiday accommodation; Holiday planning services [accommodation]; Rental of holiday cabins; Services for reserving holiday accommodation; Booking services for holiday accommodation; Providing temporary lodging at holiday camps; Booking agency services for holiday accommodation; Arranging of accommodation for holiday makers; Providing temporary accommodation in holiday homes; Temporary accommodation services provided by holiday camps; Rental of temporary accommodation in holiday homes and flats; Hotels, hostels and boarding houses, holiday and tourist accommodation; Reservation of temporary accommodation in the nature of holiday homes.</i></p> <p>The '642 mark</p> <p>Class 43: <i>Letting of holiday accommodation; Holiday lodgings; Rating holiday accommodation; Holiday accommodation services; Arranging</i></p>	<p>Class 43: <i>reservation services for campground accommodation; information relating to all the foregoing provided on-line from a computer database or via the Internet.</i></p>

<p><i>holiday accommodation; Rental of holiday homes; Holiday camp services [lodging]; Camp services (Holiday -) [lodging]; Provision of holiday accommodation; Arranging of holiday accommodation; Rental of holiday accommodation; Holiday planning services [accommodation]; Rental of holiday cabins; Services for reserving holiday accommodation; Booking services for holiday accommodation; Accommodation letting agency services [time share]; Providing temporary lodging at holiday camps; Booking agency services for holiday accommodation; Arranging of accommodation for holiday makers; Providing temporary accommodation in holiday flats; Providing temporary accommodation in holiday homes; Temporary accommodation services provided by holiday camps; Rental of temporary accommodation in holiday homes and flats; Hotels, hostels and boarding houses, holiday and tourist accommodation; Providing on-line information relating to holiday accommodation reservations; Reservation of temporary accommodation in the nature of holiday homes.</i></p>	
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54. In his counterstatements the applicant refers to some differences between the parties' services as they are provided in real life, for example, it states that (a) the

applicant provides temporary holiday accommodation in permanent structures which are available to book for most days of the year, whereas the opponent provides temporary accommodation in non-permanent structures during the duration of its four-day festival and (b) the applicant's predominant trade channels, in addition to its own website and social media, are Airbnb and TripAdvisor, whereas it is not possible to book accommodation with the opponent outside of the festival dates or via any other means other than their website.

55. These points are irrelevant because the particular segment of the market in which the opponent has so far chosen to trade does not deprive the opponent's marks of the normal level of protection afforded to every registered trade mark; this means that I must consider notional and fair use of the opponent's marks across all segments of the markets for the services for which it is registered (and has been genuinely used). Likewise, so far as the applicant's proposed use of his mark is concerned, when assessing the likelihood of confusion in the context of registering a new trade mark it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered.³ Neither of the points raised by the applicant are reflected in the marks' specifications and, accordingly, I dismiss the applicant's arguments.

56. The contested *Services for reserving holiday accommodation; Booking services for holiday accommodation; Booking agency services for holiday accommodation; Reservation of temporary accommodation in the nature of holiday homes* (in the specification of the '077 mark) encompass the opponent's *reservation services for campground accommodation*. These services are identical on the principle outlined in *Meric*.

57. The same applies to *Services for reserving holiday accommodation; Booking services for holiday accommodation; Booking agency services for holiday accommodation; Reservation of temporary accommodation in the nature of holiday homes*, (in the specification of the '642 mark). These services are identical on the principle outlined in *Meric*.

³ See Case C-533/06

58. The following services in the specification of the '077 mark: *Holiday lodgings; Holiday accommodation services; Arranging holiday accommodation; Camp services (Holiday -) [lodging]; Rental of holiday homes; Holiday camp services [lodging]; Letting of holiday accommodation; Rental of holiday accommodation; Holiday planning services [accommodation]; Rental of holiday cabins; Providing temporary lodging at holiday camps; Arranging of accommodation for holiday makers; Providing temporary accommodation in holiday homes; Temporary accommodation services provided by holiday camps;* are similar to a high degree to the opponent's *reservation services for campground accommodation*, as they have the same purpose, usually coincide in relevant public and distribution channels, and are complementary. The same applies to the following services in the specification of the '642 mark: *Letting of holiday accommodation; Holiday lodgings; Holiday accommodation services; Arranging holiday accommodation; Rental of holiday homes; Holiday camp services [lodging]; Camp services (Holiday -) [lodging]; Provision of holiday accommodation; Arranging of holiday accommodation; Rental of holiday accommodation; Holiday planning services [accommodation]; Rental of holiday cabins; Accommodation letting agency services [time share]; Providing temporary lodging at holiday camps; Arranging of accommodation for holiday makers; Providing temporary accommodation in holiday homes; Temporary accommodation services provided by holiday camps.* These services are similar to a high degree.

59. The contested *Rental of temporary accommodation in holiday homes and flats; Hotels, hostels and boarding houses, holiday and tourist accommodation* (in the specification of the '077 mark) are similar to a medium degree to the opponent's *reservation services for campground accommodation*, because although they are not complementary, they still have the same purpose, i.e. booking/provision of temporary accommodation, and usually coincide in relevant public and distribution channels. The same applies to the following services in the specification of the '642 mark: *Providing temporary accommodation in holiday flats; Rental of temporary accommodation in holiday homes and flats; Hotels, hostels and boarding houses, holiday and tourist accommodation.* These services are similar to a medium degree.

60. This leaves *Providing on-line information relating to holiday accommodation reservations* and *Rating holiday accommodation* (in the specification of the '642 mark).

The contested *Providing on-line information relating to holiday accommodation reservations* and the opponent's *reservation services for campground accommodation* are similar to a very high degree, as they target the same users, i.e. those who wish to make a reservation, coincide in distribution channels and are complementary.

61. Finally, the contested *Rating holiday accommodation* are services that consist of ratings given in the field of holiday accommodation. These services and the opponent's *reservation services for campground accommodation* are thus aimed at the same public, i.e. holiday makers, have a similar purpose, in the sense that they assist those who wish to make a reservation in choosing what accommodation to book, and might be provided by the same undertakings, for example, it is common in the trade for providers to have their own ratings options on their websites. Therefore, these contested services are similar to a medium degree to the opponent's services.

Average consumer

62. 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: *Lloyd Schuhfabrik Meyer*, Case C-342/97. 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.”


63. The average consumer for the parties' services is a member of the general public or a business user. The services will be selected from visual media (such as prospectuses, promotional material and websites) so visual considerations are likely to dominate the selection process. However, I do not discount aural considerations in the form of advice sought by telephone or word-of-mouth recommendations. There will be various factors taken into consideration when purchasing the services, such as official rating of the service provider, location, ease of use and suitability for the customer's particular requirements. Consequently, even for those services which may incur a lower cost, there will still be a medium degree of attention paid during the purchasing process. Where a greater cost may be involved, I recognise that the level of attention paid may be higher than medium.

Comparison of marks

64. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....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.”

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

The applicant's marks	The opponent's mark
<p data-bbox="301 360 724 450">The Secret Garden Glamping (‘077 mark)</p>  <p data-bbox="384 958 603 992">(the ‘642 mark)</p>	<p data-bbox="906 472 1374 506">THE SECRET GARDEN PARTY</p> <p data-bbox="906 580 1299 613">SECRET GARDEN PARTY</p>

66. I will base my comparison on the opponent's 'THE SECRET GARDEN PARTY' mark which is closer to the applicant's marks.

67. The opponent's mark consists of the words 'THE', 'SECRET', 'GARDEN', 'PARTY'. The words will be seen as a single complete phrase, no single word or words dominating the mark.

68. The applicant's '077 mark consists of the words 'The', 'Secret', 'Garden', 'Glamping'. The words will be seen as a single complete phrase, no single word or words dominating the mark.

69. The applicant's '642 mark is a figurative mark consisting of a circular device incorporating the words 'The', 'Secret', 'Garden' and a figurative element which represents two trees, a camping pod and a tub. In my view, as the figurative element reinforce the words (see below) the latter plays the strongest role in the overall impression of the mark.

70. Visually and aurally, the '077 Mark and the opponent's mark overlap to the extent that they both include the words 'The Secret Garden/THE SECRET GARDEN'. As both marks are word marks, they may be used in upper- or lower-case letters. Consequently, no weight can be attached to the use of title case letters in the applicant's mark and upper-case letters in the opponent's marks. The marks differ in the presence of the word 'Glamping' at the end of the applicant's mark, and 'PARTY' at the end of the opponent's mark. Taking into account that (a) the marks coincide in three out of four words, (b) the shared elements are placed at the beginning of the marks, (c) the beginning of marks are normally more focused upon,⁴ and (d) the distinguishing element 'Glamping' in the applicant's mark is descriptive for the services at issue, which consists of or encompasses the provision of glamping accommodation, I consider the marks to be visually and aurally similar to a medium to high degree. Conceptually, the marks share the concept of a 'secret garden' but differ in that the opponent's mark conveys the concept of a party held in a secret garden and the applicant's mark conveys the concept of glamping in a secret garden, glamping referring to a form of camping in which participants enjoy physical comforts associated with more luxurious types of holiday – which is descriptive of the services at issue. The marks are conceptually similar to a high degree.

71. Turning to the '642 mark, visually the marks coincide to the extent that they both include the words 'The Secret Garden/THE SECRET GARDEN'. However, the marks differ in that the opponent's mark contains the additional word 'PARTY' and the applicant's mark contains a figurative element which represents two trees, a camping pod and a tub - this will be perceived as a reference to the services, in the sense that it represents a type of holiday accommodation, as well as a reference to the verbal element of the mark, in the sense that it represents a natural landscape which will be understood as being 'the secret garden'. The marks are visually similar to a low degree. Aurally, as the figurative elements will not be verbalised, the only difference between the marks is the additional word 'PARTY' at the end of the opponent's mark. The marks are aurally similar to a high degree. Conceptually, the marks share the concept of a 'secret garden' but differ in that the opponent's mark conveys the concept of a party held in a secret garden, whilst the figurative element of the applicant's mark

⁴ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

conveys the concept of a camping pod in natural landscape. The marks are conceptually similar to a high degree.

Distinctive character of earlier mark

72. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, 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).”

73. Registered trade marks possess various 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 distinctiveness of a mark can be enhanced by virtue of the use made of it.

74. The earlier mark consists of the words 'THE SECRET GARDEN PARTY'. The mark being perceived a reference to a party held in a secret garden is not descriptive or laudatory in relation to the services for which genuine use has been shown. I find that the earlier mark has a medium degree of inherent distinctiveness.

75. Whilst I have found that the use shown by the opponent is sufficient for the opponent to rely on reservation services for campground accommodation (as the purchase of campground accommodation by the opponent's customers included the reservation of the accommodation itself) the opponent did not provide separate turnover figures for the provision of reservation services and most of the evidence relates to the provision of festival services. Hence, I am not satisfied that the distinctiveness of the opponent's marks has been enhanced through use in relation to the services relied upon under Section 5(2)(b).

Likelihood of confusion

76. 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. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

77. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where 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)."

78. Earlier in this decision I found that:

- some of the competing services in class 43 are identical, some are similar to a high degree and some are similar to a medium degree;
- the relevant consumers of the goods at issue are holiday makers who are members of the general public or a business user;

- the purchasing process will be predominantly visual although I do not discount aural considerations. The services will be selected with an average degree of attention;
- the earlier marks and the '077 mark are visually and aurally similar to a medium to high degree and conceptually similar to a high degree;
- the earlier marks and the '642 mark are visually similar to a low degree, aurally similar to a high degree and conceptually similar to a high degree;
- the earlier mark is inherently distinctive to a medium degree and although there has been some use of the mark, it has not materially increased its distinctiveness.

79. I shall start with the '077 mark. Although the applicant states that the words 'the secret garden' are used by other traders, no evidence has been filed which would demonstrate widespread use of the phrase in the context of the services at issue. Consequently, the phrase is distinctive for the services at issue. Considering that the shared element 'THE SECRET GARDEN' is the longest part of the respective marks, it is distinctive for the services at issue, and it is placed at the beginning of the marks, I consider that consumers will pay more attention to the element 'THE SECRET GARDEN' which will be retained in their minds more. In those circumstances, given the identity or similarity of the services at issue, I consider that the average consumer is likely to confuse one mark for the other, when imperfect recollection is factored in. The differences introduced by the words 'Glamping' and 'PARTY' are not sufficient to avoid the likelihood of confusion arising from the shared element 'THE SECRET GARDEN' and the conceptual, visual and aural similarity this element creates. There is a likelihood of direct confusion.

80. Moving to the '642 mark, although the marks are visually similar to only a low degree, they coincide in the verbal element 'THE SECRET GARDEN' which is distinctive for the services at issue. Although the opponent's mark contains the additional word 'PARTY', the element 'THE SECRET GARDEN' will be retained in their minds more and both marks will be perceived as having the concept of 'the secret garden'. The figurative element of the applicant's mark reinforces the verbal element 'THE SECRET GARDEN' whilst being seen as a reference to the services, so it does

not introduce any conceptual difference between the marks. Having weighted all of these factors, my conclusion is that the presence of the figurative element in the applicant's mark and the word 'PARTY' in the opponent's mark do not offset the similarities characterising the marks at issue and are not sufficiently significant, when considered overall, to exclude the possibility that the relevant public may believe that the services covered by the applicant's mark and those covered by the earlier mark have a common origin. There is a likelihood of indirect confusion.

81. The opposition under section 5(2)(b) succeeds.

Section 5(3)

82. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

83. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected”.

84. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L’Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L’Oreal v Bellure*).

85. The relevant dates for the assessment under Section 5(3) are the filing dates of the applications at issue, being 17 February 2022 and 01 March 2022.

Reputation

86. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

87. In its counter statement and written submissions, the applicant admits that the opponent's mark is renowned for an annual festival. It states:

"As outlined above the Opponent's mark is renowned for an annual music festival. The Applicant has not applied for anything outside of class 43 or any term unrelated to temporary holiday accommodation"

88. I take this as an admission that the opponent had a reputation for organising and staging festivals (in class 41) at the relevant dates. Although the opponent also relies on other services in class 41 and 43, I find that it has no reputation in relation to any other services. In particular, for the services in class 43, although I found that there has been genuine use of the earlier marks for reservation services for campground accommodation, the use is not sufficient to show a reputation for these services, given the absence of any specific turnover figures, marketing figures and market share.

Link

89. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

- *The degree of similarity between the conflicting marks.* The earlier marks and the '077 mark are visually and aurally similar to a medium to high degree and

conceptually similar to a high degree. The earlier marks and the '642 mark are visually similar to a low degree, aurally similar to a high degree and conceptually similar to a high degree;

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public. The contested services in class 43 consist of the provision of holiday accommodation and related reservation and booking services. Although the evidence shows that the opponent has offered camping accommodation as part of the festival experience, the opponent itself says that this something not typically associated with festival life or culture. On that basis, I find that there is no convergence in the market that could justify a finding of complementarity. The services differ in nature and purpose, one offering the experience of attending a festival the other offering holiday accommodation, target different consumers, namely holiday makers and festival goers, do not share trade channels and are neither complementary nor in competition. These services are dissimilar.

The strength of the earlier mark's reputation. The opponent's marks have a reputation in relation to festivals. However, the opponent did not trade for five years before the relevant date whilst it announced that the event would come back less than one year before the relevant date. I therefore find that the opponent's reputation at the relevant date was small.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use. The earlier marks are inherently distinctive to a medium degree. Given the size of the opponent's reputation, if that reputation has increased the distinctiveness of the marks to any extent, it cannot be more than to an above medium degree (certainly not high).

Whether there is a likelihood of confusion. As I found that the respective services are dissimilar, there would be no likelihood of confusion.

90. Taking all of the above factors into account, particularly the small size of the opponent's reputation and the distance between the services,⁵ I am not convinced that a link would be made. In any event, even if I were wrong, and a link would be made, the opponent's case under Section 5(3) is based on the likelihood of confusion, a claim that given the differences in the services involved, could not succeed because the likelihood of confusion requires a degree of similarity between the goods and services. In its Form TM7 the opponent states:

"Use of the Applicant's Sign may mislead the average consumer into believing that the services provided by the Applicant under its Sign are those of the Opponent, or are granted under licence by the Opponent, resulting in confusion"

"The likelihood of association in the mind of the consumer between the marks at issue is particularly damaging to the Opponent's reputation because the Opponent will have no control over the quality of the services provided under the Applicant's Sign. Consumers may experience a negative experience when using the Applicant's services and, under a mistaken assumption that they originate from or are economically linked to the Opponent, choose not to repeat the experience with the Opponent".

91. The opposition based upon Section 5(3) fails.

Section 5(4)(a)

92. Section 5(4)(a) states:

"(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

⁵ *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA)

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

(c) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

93. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

94. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

Goodwill, misrepresentation and damage

95. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

96. The relevant date for the assessment under Section 5(4)(a) is normally the filing date of the application at issue, being 17 February 2022 and 01 March 2022.⁶ In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of Section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’

97. The applicant filed evidence stating that it has been trading under the name ‘THE SECRET GARDEN’ since April 2020, however, none of the published articles it produced refers to the ‘THE SECRET GARDEN’ in a trade mark sense, but they say

⁶ *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11

that the applicant turned his back garden into a Love Ireland replica (and a glamping site open for booking) and that his children refer to it as the secret garden. That it is not use as a trade mark. The first use of the words 'THE SECRET GARDEN GLAMPING' as a trade mark appears in a number of awards that the applicant won in 2021, however, it is not possible to determine the exact date. Hence, I will proceed on the basis that the relevant dates are the filing dates of the applications.

98. Based on the evidence filed by the opponent, in particular the turnover figures generated by the provision of temporary accommodation and camping services which amount to approximately £1.2million in the period 2013-2017 and £768,689 in the period between 26 September 2021 to 1 March 2022, I am satisfied that the opponent had sufficient goodwill in these services at the relevant dates to sustain an action for passing off. I extend the same finding to the provision of the related reservation services. Although the goodwill also extends to the festival services (given the concession of the applicant), it doesn't really further this ground, so I will say no more about it.

99. I recognise that the test for misrepresentation is different to that for likelihood of confusion because misrepresentation requires "a substantial number of members of the public are deceived" rather than considering whether the "average consumer is confused". However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. I believe that to be the case here. Further, the opponent's case under this ground is stronger than that under Section 5(2)(b) because all of the services at issue are identical or highly similar. Accordingly, I find that a substantial number of the opponent's customers will be misled into purchasing the applicant's services in the belief that they are those of the opponent, for essentially the same reasons that I set out when considering the likelihood of confusion under Section 5(2)(b). Damage is made out. The opposition under Section 5(4)(a) succeeds.

OUTCOME

100. The opposition is successful, and the applied-for marks are refused registration.

COSTS

101. As the opponent has been successful, it is entitled to a contribution towards its costs. Based upon the scale in Tribunal Practice Notice 2/2016, I award the opponent the sum of £1,250 as a contribution towards the cost of the proceedings. This sum is calculated as follows:

Preparing a statement and considering the applicant's statement:	£200
Filing evidence:	£650
Preparing submissions	£200
Official fees:	£200
Total	£1,250

102. I therefore order Derry Green to pay Backwoodsman Limited the sum of £1,250. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 18th day of May 2023

Teresa Perks
For the Registrar