

## **TRADE MARKS ACT 1994**

**IN THE MATTER of Application No 2237781  
by Barr Recycling**

**and**

**IN THE MATTER of Opposition thereto under No 52132  
by G. I. Hadfield & Son Limited**

### **Background**

1. On 30 June 2000, Barr Recycling applied under the Trade Marks Act 1994 to register a series of two marks. Following amendment, the application proceeded for the trade mark EASYBED for the following specification of goods:

Class 31

Bedding materials for animals, bedding material for pets.

2. The application was accepted and published and on 13 February 2001, G. I. Hadfield & Son Limited, filed notice of opposition to the application on Form TM7 together with the appropriate fee. The statement of grounds accompanying the notice of opposition set out various grounds of opposition under section 3 of the Trade Marks Act 1994. These can be summarised as follows:

- (a) under section 3(1)(b) in that the mark EASYBED simply describes the nature of the goods, that is, bedding (for animals) that is easy to use or make. The mark is therefore, devoid of distinctive character;
- (b) under section 3(1)(c) in that the mark EASYBED is descriptive of the kind, intended purpose, and characteristic of the goods applied for; and
- (c) under section 3(1)(d) in that the term EASYBED is in common usage throughout the United Kingdom in relation to animal and pet bedding and that the term has become customary in the current language of the animal and pet bedding trade.

3. The applicants filed a Form TM8 and counterstatement denying the grounds of opposition. Both sides seek an award of costs. The matter came to be heard on 10 June 2002. The hearing took place via a three way telephone conference link. The applicants were represented by Mr David Kennedy of Kennedys, the opponents were represented by Mr Bruce Marsh of Wilson Gunn M'Caw.

## Evidence

### Opponents' Evidence

4. The opponents' evidence in chief consists of a single witness statement dated 11 June 2001 by Mr Geoff Hadfield, Managing Director of G. I. Hadfield & Son Limited, the opponents. Mr Hadfield states that he has held this position since 1980 and that his company is involved in the business of recycling various wood waste materials. Some of the recycled material is sold on for a variety of uses one of which is pet or animal bedding. He states that his company has sold recycled material for animal bedding since 1991.

5. Mr Hadfield states that he has been involved in the recycling industry for 21 years and that part of his company's business is to supply recycled material to equine, agricultural and farming businesses for use as animal bedding and that he is well acquainted with that trade.

6. Mr Hadfield states his belief that 'easybed' is a word which has become customary in the current language of the trade. He states that it is taken to mean animal bedding or pet bedding which is easy to use or easy to put down to form a bed. He refers to exhibit GH1 which he states is a photograph of a sign outside a farm selling, "straw, hay, easy bed". He states his view that the photograph shows 'easy bed' is used in the same generic fashion as 'straw' and 'hay'. He then refers to exhibit GH2 which he states is a photograph showing a price list of goods in a farm shop. Again, in his view, this shows 'easybed' being used in the same generic fashion as 'potatoes', 'mushrooms', 'straw bales' etc. Mr Hadfield says that these are typical examples of the way in which farmers and other members of the trade use the word easybed.

7. He concludes by stating his belief that if a customer, wishing to buy animal bedding in a farm shop or from another retailer or wholesaler were to request 'easybed', they would be offered animal bedding from a number of sources, not only that of the applicant.

### Applicants' Evidence

8. This consists of a statutory declaration by Mr William Barr dated 3 September 2001. He states that he is aware of a number of traders in animal and pet bedding, however, he has no knowledge of any other party using the term EASYBED in relation to the relevant goods at the date of application. Mr Barr refers to various exhibits:

- exhibit WB1 - a copy of the Green Pages, a Directory of Agriculture for the United Kingdom published prior to his company's trade mark application. Mr Barr has marked the pages that relate to traders who provide livestock handling equipment, such as animal and pet bedding, and notes that none make use of the term EASYBED;
- exhibit WB2 - a photocopy of the Index section of the *British Equestrian Directory of 1999-2000*. He states that the index shows companies who provide goods for equestrianism beginning with the letter E. There is no mention of EASYBED in any of the entries;

- exhibit WB3 - a copy of the *British Trade Suppliers Directory of 2000-2001*. Marked in the Index section are traders who provide blankets and quilts. None go under the name EASYBED. He has also marked the section entitled “Brand Names” and notes that none of the traders listed in the Directory use the brand “EASYBED”;
- exhibit WB4 - the February 2000 Edition of *Horse and Hound* and the March edition of *Your Horse*. He states that he has marked the “Classified Adverts” for animal bedding, from which he notes that none of the traders are using the term EASYBED as suggested by the opponents;
- exhibit WB5 - a photocopy of pages relating to animal beds and bedding taken from the Third Edition of *Horse & Stable Management*, the second edition of *Feeding and Care of the Horse* and *The Encyclopaedia of Horses*. Mr Barr states that all were published prior to his company’s filing date and that none make use of term EASYBED to describe animal bedding;
- WB6 and 7 - letters from Paul Deasy of Kenmuir Riding School and Kathleen Kyles, a veterinary surgeon. Both state their view that they have not encountered EASYBED as a generic term for animal bedding.

9. Mr Barr states that his company manufactures and sells animal bedding and first made use of the trading name “EASYBED” in August 2000 and has made use of the name ever since. He states that sales of goods branded with the EASYBED mark since first use, are as follows:

1999-2000	Aug - Mar	£8,863
2000-2001	April - Mar	£71,519
2001-2002	April - July	£24,121

10. I note that the figures for Aug-Mar 1999-2000 do not correspond with Mr Barr’s statement that first use of the mark was in August 2000. Mr Barr goes on to state that the mark has been used on goods in Scotland, England and, Northern Ireland, and that the amount spent on promoting the goods on an annual basis is £6,232.10.

11. At WB8, he exhibits packaging in which the animal bedding manufactured by his company is supplied and at WB9 he exhibits his company’s advertising material for the product which carries the EASYBED mark. At WB10 he exhibits a photograph of the goods on which the EASYBED trade mark is used and at WB11 he exhibits copies of advertisements for his company’s product in the September 2000 edition of *Equi-ads* and the August 2000 edition of *The Stirlingshire Stablery* brochure. Finally, he refers to print outs of his company’s website exhibited at WB12.

#### Opponents’ Evidence in reply

12. This consists of a further witness statement by Mr Hadfield, dated 31 January 2002. He confirms that he has studied the declaration of Mr Barr and the accompanying exhibits.

13. Commenting on that evidence, Mr Hadfield notes that exhibits WB1-3 merely list companies taken from various directories and that the absence of the word EASYBED in these directories does not prove that the term EASYBED is not used by agricultural and equine traders.

14. Referring to WB4, a copy of a February 2000 edition of Horse & Hound, he agrees that there is no advertisement showing use of EASYBED. However, at GH1 he exhibits the advertisement pages from the March 2000 edition of Horse & Hound which shows an advertisement for the EASYBED product sold by Albar. GH2 is a printout from the Horse & Hound website showing an advertisement for the Albar's product; this is dated 17 January 2001.

15. As further proof that Albar sell an EASYBED product, Mr Hadfield confirms that the photographs referred to in his earlier witness statement as GH1 were taken on 17 January 2001 at Link Farm, Pulborough, the business place of Albar from which the EASYBED product is sold. At GH3 to his second witness statement, he exhibits a photograph of a pack of the EASYBED product which he states was also taken at Link Farm on that day. Mr Hadfield states that Albar market their product via their website at [www.albars.com](http://www.albars.com) and at GH4 he exhibits a print out from their website; this is dated 16 January 2001. At GH5 he exhibits a business card of Albar which he again says shows use of the name EASYBED. Mr Hadfield states that the name EASYBED is also used by E W Cartons Ltd and he refers to exhibit GH6 which is a print out from their website [www.ewcartons.co.uk](http://www.ewcartons.co.uk) . This is dated 29 January 2002 and shows EasyBed (Cardboard, Paper, Shavings).

16. Mr Hadfield then states that his company uses the name EASIBED to refer to its animal bedding product. At GH7 he exhibits various documents showing his company's use of this mark. The earliest seems to be dated January 2001 and refers to "the Easibed Solway Discovery Championship at Blackdyke Farm's Christmas fixture...". An advertisement for the product, dated June 2001 in the Equestrian Trading News, describe it as "new easibed". In Equestrian Business Monthly from October 2001, it states, "easibed finely-shredded wood fibre bedding for animals is manufactured by Manchester based company Hadfield.....has quickly won a significant share of the bedding market since its launch in March this year". At GH8 he exhibits a table of the costs of the press advertisements for his company's product.

17. Mr Hadfield states that his company also sponsors Richard Davison, the Olympic Dressage Rider and Di Lampard the International Showjumper to endorse the EASIBED product. His company also sponsors the EASIBED Winter Novice Championships and spends approximately £5000 per annum sponsoring this event. He states that for the period April 2001 to date, sales of his company's EASIBED product have totalled approximately £500,000. With an average retail price of £3.00 he states that this represents 167,000 units.

18. Mr Hadfield contends that the mark EASYBED and the phonetically equivalent EASIBED are in common usage throughout the UK in relation to animal and pet bedding. To further support his contention, he refers to exhibit GH9 which comprises printouts of Internet searches using the search engine 'Google' for the terms easybed and easibed. He states that the search highlights several websites which refer to EASYBED products made and sold by at least three different companies. At GH10 he says that he exhibits printouts from some of the sites found by the search, which all refer to EASYBED products not produced by the

applicant.

19. Referring to exhibits WB6 & 7 to Mr Barr's declaration, he says that these letters are not addressed to anyone, nor are they accompanied by any preceding correspondence which may put them into context. He states that they cannot be taken as impartial evidence.

20. Referring to exhibits WB8-12 of the applicants' evidence and paragraphs 15-19 of Mr Barr's declaration, he does not deny that they correspond to the applicants' use of the term EASYBED. Rather, he claims that at least four other companies (including his own company) use the term or its equivalent in relation to animal bedding. As such, he argues that the sign lacks distinctive character and falls foul of sections 3(1)(b) and (c) and has become a common trade term for animal bedding thereby falling foul of section 3(1)(d).

21. That completes my review of the evidence.

### **Decision**

22. The grounds of opposition refer to sections 3(1)(b), (c) and (d) of the Trade Marks Act 1994. The relevant provisions read as follows:

- “3.- (1) The following shall not be registered -
- (a) .....
  - (b) trade marks which are devoid of any distinctive character,
  - (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
  - (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

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

### Preliminary Point

23. Before considering the substantive grounds of opposition, I will comment on the evidence filed in these proceedings. From the summary set out above, it will be clear, in my view, that the opponents' evidence in chief, the first witness statement of Mr Hadfield, failed to provide much information of relevance to these proceedings. The statement is made up of Mr Hadfield's opinions on the use of EASYBED in the field of recycled bedding. In order to support that contention, he refers to two photographs. As noted by Mr Kennedy, during the

hearing, there is no indication in this witness statement as to the date these photographs were taken, where they were taken or by whom they were taken. Further, they do not show how the word EASYBED was used. As such, they are in my view of little evidential value.

24. The applicants' evidence seeks to show that they have been using the mark and that others are not. In reply, the opponents filed a further witness statement of Mr Hadfield together with a large number of documents. Arguably, much of it cannot be considered to be evidence in reply. It is substantive evidence going to the opponents' grounds of objection. What is more, it seems clear from the nature of the evidence and the dates on some of the internet print outs that this evidence was or could have been available to the opponents at the date when their original witness statement was filed. The provenance of the photographs exhibited to the first declaration are also explained.

25. If this second witness statement is not evidence in reply, then it could be argued that I should strike it out and not consider it. If that were so, then this decision would be a short one for it seems to me that without this second witness statement, some of the opponents' grounds of opposition were unsustainable. However, following brief submissions on this issue and with Mr Kennedy's agreement, I concluded that in order to avoid a multiplicity of proceedings and to bring this proceedings to a close as speedily as possible, I would take into account the entirety of the opponents' second witness statement in reaching a decision in this matter.

### Substantive Points

#### Section 3(1)(d)

26. I will deal with this ground of objection first, as I believe that it can be dealt with very quickly. Mr Marsh sought to argue the grounds under sections 3(1)(c) and (d) together but I prefer to deal with them separately as I believe they raise different questions. For the ground of objection under section 3(1)(d) to succeed, the opponents must show that, at the relevant date, the date of application 30 June 2000, the mark EASYBED consisted exclusively of signs or indications which **have become customary** in the current language of the trade.

27. Looking at the evidence, there is use of EASYBED by a number of traders. However, I must assess the question as at the date of application. I must judge whether as at that date, the term had become customary in the current language of the trade. Do I have evidence to show this?

28. In my view, I do not. The only example of use of the term EASYBED in the evidence which pre-dates the date of application is the advertisement for the EASYBED product by Albar in the March 2000 edition of the Horse & Hound magazine. All the other examples of use, by the opponents themselves, by E W Cartons, Albar and other traders are undated or after the relevant date. Mr Marsh asked me to take into account the fact that there is a long lead time between developing a product and launching it on the market. He argued that as there was use by other traders a short time after the relevant date, I should infer that the word EASYBED must have been customary in the trade at a date earlier than this and in particular, at the relevant date. I think that Mr Marsh asks me to infer too much from the evidence. There is a further problem for Mr Marsh. Mr Kennedy argues that all the use shown by third parties is trade mark use and not descriptive use of the term EASYBED. I have some sympathy with

that line of argument. The one example of use by Albar which predates the date of application seems to me to show the term EASYBED being used as a trade mark by Albar. The advertisement at exhibit GH2 to Mr Hadfield's second witness statement is set out thus:

## EASYBED

L Economic  
T Dust Extracted  
E Disposal Made Easier  
R Inhibitor against Moulds/Eating  
N Natural  
A Great to use  
T  
I  
V  
E

29. Mr Kennedy noted, the advert then describes the product as, "PREPARED STRAW HORSE BEDDING", and goes on to offer, "Easyfeed Chaf - Oat or Hay and Hayledge". It gives a direct sales telephone number and indicates, "Nationwide Stockists wanted". The photograph at exhibit GH3 shows the same layout of the mark EASYBED together with the ALBAR trade mark. The opponents' own use, which is after the relevant date, also seems to me to show them using the term EASIBED as a trade mark and not as a descriptor. The opponents' mark is shown in a slightly stylised script with random dots underneath. It is made from "finely shredded wood fibre". The rider, Ms Lampard, in the advert in "Field & Stable May 2001" at exhibit GH7, describes it as a "...fantastic breakthrough...". The page from the "Horse & Rider June 2001" also at exhibit GH7 states, "EASIBED....I am pleased to report that this bedding actually lives up to its name!". The June 2001 "Equestrian Trade News" carries a report on tests of the EASIBED product. It states, "Thumbs up for easibed.....", later it describes the product as, "New easibed...". This use by the opponents themselves and by third parties describing features of the opponents' product, seems to me to be use as a trade mark and not as a descriptor. The last two examples do not say that this is a new type or a new supplier of easibed or easybed products on the market. However, Mr Marsh also argued that the relevant market for these products was very specialised and I should take into account the fact that a large number of traders had sought to use the term EASYBED. However, the evidence does not inform me as to the position at the relevant date.

**30. Therefore, on the basis of the evidence before me, I find the applicants have failed to show that the word EASYBED as at 30 June 2000, was one which had become customary in the current language of those concerned with animal and pet bedding. The ground of opposition under section 3(1)(d) is dismissed.**

### Section 3(1)(c)

31. I will deal now with the objection under sections 3(1)(c). Recent guidance on the interpretation of Article 7(1)(c) of the Regulation (the equivalent of section 3(1)(c) of the Trade Marks Act 1994) has been given by the European Court of Justice in *Procter & Gamble v. OHIM (BABY-DRY)* Case C-383/99P. Both parties referred me to this decision

and made submissions as to the approach this case suggested I should take when considering the registrability of marks.

32. In *BABY-DRY*, the findings of the Court are set out in paragraph 35 et seq of the judgment. The ECJ stated that the provisions in Article 7(1) of the Regulation and those in Article 12 (section 11 of the Trade Marks Act 1994), taken together prevent registration as trade marks, signs which are no different from the usual way of designating the relevant goods or services or their characteristics; paragraph 37. Thus, the ECJ concluded that the provision of Article 7(1)(c), (section 3(1)(c)) excluded signs which may serve in normal usage from a consumer's point of view to designate an essential characteristic of the goods or services concerned. Registration should not be refused unless it comprises no other sign or indication; paragraph 39.

33. Further, the Court found that in relation to trade marks composed of words, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form; paragraph 40.

34. In considering whether a mark consists exclusively of matter covered by the provisions of section 3(1)(c), the ECJ indicated that any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumer to designate the goods or services or their essential characteristic is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark; paragraph 40.

35. It could be said that the decision in *BABY-DRY* represents a step change in the approach adopted in the United Kingdom to the registrability of marks. However, it should be noted that the ECJ in *BABY-DRY*, indicated that the provisions of Article 7(1)(c) and those in Article 12 of the Regulation prevent registration as trade marks, signs which are no different from the usual way of designating the relevant goods or services or their characteristics. Thus, it could be said that the effect of these provisions is to keep free those marks which describe a characteristic of the goods or services. As such, the provisions provide the first line of defence for the honest trader. Terms which are no different from the normal way of designating the goods or a characteristic will be refused registration. Regardless of whether there is a public policy in favour of such an approach, that is the effect of section 3(1)(c). This is logical as such marks cannot perform the function of a trade mark, that of guaranteeing the origin of the goods.

36. At the hearing I also mentioned the decision of the Appointed Person, Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person in *Cycling Is..... Trade Mark* (unreported SRIS O/561/01). Neither representative was familiar with this decision but I will refer to it where necessary.

37. Applying the guidance of the ECJ in *BABY-DRY* to the case before me, I must consider whether the term EASYBED is the normal way of referring to the goods for which registration is sought. Does EASYBED, from a consumer's point of view, serve in normal usage to designate an essential characteristic of the goods? Mr Marsh argued that it does, his position is that the mark is made up of the adjective EASY together with the word BED which is descriptive of animal or pet bedding. The case law tells me that descriptiveness must be



determined, not only in relation to the two words taken separately but as to the whole which they form. Mr Marsh argues that the resultant combination and conjoining of the two words EASY and BED adds nothing to the trade mark and, as such, the term EASYBED may serve in trade to designate a characteristic of the goods namely material that can be easily made into a bed for an animal; animal bedding that is easy to use; an easy bed to make and use.

38. Mr Kennedy's position was that the mark was clearly acceptable for registration. The word EASYBED was not the usual way of referring to pet or animal bedding that might be easy to use. In his view, the term EASYBED was ambiguous, he noted that the examples in the opponents' evidence of use by third parties showed that these third parties had to explain the product EASYBED. Sometimes it was made of straw, sometimes recycled paper, another trader uses it on a manufactured pet bed. The term was, in his submissions, meaningless to the average consumer. The term EASYBED was not one in common parlance of the relevant class of consumer to designate pet bedding or an essential characteristic of pet bedding.

39. I did not understand either party to argue that in determining the question under section 3(1)(c) I should not take account of whether the term EASYBED **may** serve in trade, even if it is not doing so at present. I think that this is right, the provisions of section 3(1)(c) refer to signs which **may** serve in trade, this in my view allows for a degree of foreseeability. Referring to this point in *Cycling is.....*, Mr Hobbs, stated at paragraph 32:

“There is a degree of foreseeability in the conclusion that a syntactically unusual juxtaposition of words in the nature of a lexical invention would not be understood purely descriptively by the relevant class of persons. There is likewise a degree of foreseeability in the opposite conclusion that a sign or indication would simply be perceived by such person as a new form of description. The latter conclusion points to unregistrability. I do not understand the Judgment of the Court in the Baby-Dry case to have decided otherwise and I can see no reason why the exclusion from the registration contained in Article 3(1)(c)/Section 3(1)(c) should make no allowance for the advent of new forms of descriptive expression.”

40. With these considerations in mind, I turn to address the question in hand. As at the relevant date, was EASYBED a sign which may serve in trade to designate a characteristic of the goods? It seems to me that whilst Mr Marsh is correct to point out that the mark is merely the combination of the adjective EASY and the descriptor BED, the combination of the two words conjoined together is sufficient to find that the mark does not consist exclusively of signs which may serve in trade to designate a characteristic of the goods. To use the words of the ECJ in *BABY-DRY*, that word combination (EASYBED), whilst it does unquestionably allude to the function which the goods are supposed to fulfil (bedding that is easy to use), still does not satisfy the disqualifying criteria set out above.

41. Whilst each of the words may form part of expressions used in everyday speech to designate a bed for pets or animals that is easy to make/use, their syntactically unusual juxtaposition is not a familiar expression to designate animal or pet bedding or an essential characteristic of those products. The evidence showing use of the word EASYBED by other traders, even if I ignore the fact that it is after the relevant date, does not in my view assist the opponents. It cannot be said that because such use has occurred, the term as at the relevant

date was one that **may** serve in trade. I return to the point made above in considering the objection under section 3(1)(d), and state that, in my view, the evidence shows a number of traders are indeed using the word EASYBED or EASIBED but that each appears to be attempting to use it as a trade mark. In addition to the examples cited above, Kudos Pet Products appear to produce a range of pet beds called, “EasyMattress, EasyLounger, Easybed, EasyThrow”; see exhibit GH10.

42. The proper place to resolve such matters is in opposition, invalidity or infringement proceedings based on prior trade mark or common law rights. The fact that a number of traders appear to wish to use the term EASYBED does not in my view lead to the conclusion that the mark may serve in trade and so is ineligible for registration.

43. In my view EASYBED has the nature of a lexical invention. A lexical invention which, in the words of Mr Hobbs Q.C., would not be understood purely descriptively by the relevant class of persons. It would not in my view be seen as a new form of description and therefore may not be refused registration under section 3(1)(c). **The opponents’ ground of opposition under section 3(1)(c) is dismissed.**

#### Section 3(1)(b)

44. It could be argued that as I have found that the applicants’ mark should not be refused under section 3(1)(c) this leads inevitably to the view that it should not be refused under section 3(1)(b). This argument is based on the premise that as the mark does not consist exclusively of signs or indications which may serve in trade, the mark cannot be devoid of distinctive character. I do not agree. A mark which does not consist exclusively of such matter may, nevertheless, be devoid of distinctive character if it cannot perform the function of a trade mark, that of identifying the trade origin of the goods or services in question. However, in the circumstances of this case, it seems to me, that if the mark EASYBED does not fall foul of the provisions of section 3(1)(c) then it is not devoid of distinctive character within the meaning of section 3(1)(b).

45. The mark in my view is not “origin neutral”; per Mr Hobbs in *Cycling Is....*. When applied to goods it would in my view perform the function of a trade mark and enable consumers to differentiate between the goods of one trader and another. Again, the fact that a number of traders seem to be seeking to use EASYBED does not detract from its inherent ability to act as a trade mark. In the case of double identity of marks and goods, then in my view confusion as to origin could be assumed. **The opponents’ ground under section 3(1)(b) is dismissed.**

#### Conclusions

**46. The opponents have failed on all three of their grounds of opposition and the opposition is dismissed.**

Costs

47. The applicants have been successful and are entitled to a contribution towards their costs. **I order that the opponents pay the applicants the sum of £1700-00 as a contribution towards their costs.** This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 04 day of July 2002**

**S P Rowan  
For the Registrar  
the Comptroller General**