

O-175-13

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 1087676 IN THE
NAME OF SYNGENTA PARTICIPATIONS AG**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 72358 BY ROTAM AGROCHEM INTERNATIONAL CO. LTD**

BACKGROUND

1. On 26 July 2011 (claiming priority from a filing in Switzerland dated 13 July 2011), Syngenta Participations AG (“SP”) requested protection in the United Kingdom of the International Registration (IR) of the trade mark **AGADOR**.

2. The United Kingdom Trade Marks Registry (“TMR”) considered the request satisfied the requirements for protection and particulars of the IR were published on 16 September 2011 for the following goods:

Class 1: Chemical products, only for agricultural, horticultural and forestry use.

Class 5: Pesticides; insecticides; nematocides; fungicides; herbicides.

3. On 15 December 2011, Rotam Agrochem International Co. Ltd (“RAI”) filed a notice of opposition which, following amendment, consists of a single ground based upon section 5(2)(b) of the Trade Marks Act 1994 (as amended) (“the Act”). RAI’s opposition, which is directed against all of the goods in SP’s designation, is based upon the following trade mark:

Trade Mark	No.	Application Date	Registration Date	Goods
SEGADOR	CTM 9448747	15/10/10	25/3/11	Insecticides; fungicides; herbicides; parasiticides; preparations for destroying vermin; all of the aforesaid for agricultural use.

4. In its notice of opposition RAI said, inter alia:

“[The competing trade marks] are highly similar when considered visually, phonetically and conceptually. Each consists of three syllables the last two of each being identical. Both of the first syllables end in the letter G. Overall the marks are highly similar.

There is identity in relation to the goods in class 5...”

5. On 21 February 2012, SP filed a counterstatement in which it said:

“The beginnings of the names AGADOR and SEGADOR are not similar; they only share the same ending. It is known that for the consumer the beginning of a word is more important than the ending. Thus, the first characters are most important to estimate the similarity of the two names.

Furthermore, the meaning of both words is not similar at all; AGADOR, contrary to the prior trademark SEGADOR, is a coined word with no meaning at all. The word SEGADOR on the other hand means “the mower” in Spanish. Even if the two names should be considered as confusingly similar, it is unlikely that the co-existence of both names on the market place could cause confusion of the public since the product sold under the name AGADOR is a very specific product, namely a nematicide in the turf field, which will not be sold in the consumer business but only to professional turf keepers. Professional turf keepers are expert consumers, who are very well informed and know their products very well. Likelihood of confusion is therefore lower as in the consumer business. [SP] is anyhow willing to restrict their specification in cl. 5 to “nematicides in the turf field.”

6. Neither party filed evidence, asked to be heard or filed written submissions in lieu of attendance at a hearing. In a letter dated 7 February 2013, SP wrote to the TMR. In that letter it said:

“...please find enclosed a copy of a form MM6(F), which was filed with WIPO on 8 February 2013, requesting the recordal of a limitation of goods of [SP’s designation] in the United Kingdom to the following extent:

Class 01: to be deleted entirely

Class 05: Nematicides for turf...”

7. In a letter dated 28 February 2013, the TMR wrote to RAI to establish whether this limitation disposed of the opposition. In a letter dated 5 March 2013, RAI confirmed that it did not.

DECISION

8. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

9. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

10. In these proceedings RAI is relying upon the trade mark shown in paragraph 3 above, which qualifies as an earlier trade mark under the above provisions. Given the interplay between the date on which SP’s designation was published and the date on which RAI’s earlier trade mark completed its registration procedure, the earlier trade mark is not subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004.

Section 5(2)(b) – case law

11. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117; Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

The principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

Comparison of goods

12. The goods to be compared are:

RAI's goods	SP's goods (following amendment)
Insecticides; fungicides; herbicides; parasiticides; preparations for destroying vermin; all of the aforesaid for agricultural use.	Nematicides for turf.

13. A nematicide is defined in Collins English Dictionary as:

“a pesticide substance or preparation used to kill roundworms (nematodes)”

14. A nematode is defined in the same dictionary as:

“any unsegmented worm of the phylum (or class) Nematoda, having a tough outer cuticle. The group includes free-living forms and disease-causing parasites, such as the hookworm and filaria Also called: nematode worm, roundworm”.

15. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-133/05 the GC said:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

16. Bearing in mind the definitions above, SP’s “nematicides for turf” are, on the principles outlined in *Meric*, identical in my view to the “parasiticides” in RAI’s earlier trade mark. However, even if I am wrong in that regard, given the similarities in the users, nature, intended purpose, method of use and trade channels, SP’s goods are, in my view, highly similar to all of the other goods in RAI’s specification.

The average consumer and the nature of the purchasing decision

17. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade.

18. Although in its counterstatement SP refers to what it considers to be the specialist nature of the average consumer for its goods, in reaching a conclusion, I must keep in mind that its amended specification is not, insofar as the users of its goods are concerned, limited in any way. Approaching the matter on this basis, the average consumer of the goods at issue will be either a member of the general public buying the goods for use, in, for example, a garden, allotment or small holding, or a business/specialist user buying the goods for use on a commercial basis. As the goods at issue are, I think, most likely to be selected from a shelf in, for example, a garden

centre or specialist trade supplier or from a specialist catalogue or website, visual considerations are likely to dominate the selection process. That said, as the average consumer may, in an appropriate setting, make oral enquiries before selecting a particular product, aural considerations will also come into play, albeit, in my view, to a lesser extent. While the cost of the goods is unlikely to be terribly high (except perhaps when bought on a commercial scale), as the average consumer will need to ensure it is selecting the correct product to kill, for example, the parasite at issue, whilst ensuring that the product will not have a negative impact on other flora and fauna, it suggests to me that he will pay at least a reasonable level of attention when making his selection.

Comparison of trade marks

19. The trade marks to be compared are:

SEGADOR v AGADOR

20. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

21. As both parties' trade marks consist of a single word no part of which is highlighted or emphasised in any way, there are no distinctive and dominant elements; the distinctiveness lies in each of the trade marks as a whole.

Visual similarity

22. The competing trade marks consist of 7 and 6 letters respectively, all of which are presented in upper case; the last 5 letters in each trade mark i.e. GADOR are identical. However, in my view, the visual difference created by the letters SE at the beginning of RAI's trade mark as opposed to the letter A at the beginning of SP's trade mark, are, in circumstances where the letters GADOR form part of a unified whole in both trade marks highly significant, resulting in only a low degree of visual similarity overall.

Aural similarity

23. I agree that both parties' trade mark consist of three syllables. However, once again the aural differences between the competing first syllables i.e. SEG v AG are, in my view, important. Overall, I consider there to be a reasonable degree of aural similarity between the competing trade marks.

Conceptual similarity

24. SP's AGADOR trade mark is, it explains, a coined word. Absent evidence to the contrary, I am prepared to accept that this is the case; it will, as a consequence, convey no meaning to the average consumer. While SP explains that RAI's trade mark means "the mower" in Spanish and while I accept that Spanish is taught in many British schools and many UK citizens visit Spain on both business and pleasure, I am not persuaded this is a word whose meaning will be well known to average consumers in the UK; more likely, in my view, they will treat it as an invented word. As both parties' trade marks are, in my view, likely to be treated by the average consumer as invented words, the conceptual position is neutral.

Distinctive character of RAI's earlier trade mark

25. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. As I have already concluded that RAI's trade mark will be treated by the average consumer as an invented word, it follows that it is possessed of a high degree of inherent distinctive character.

Likelihood of confusion

26. In determining whether there is a likelihood of confusion, 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 trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of RAI's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision I concluded that:

- the goods at issue are identical or highly similar;
- the average consumer of the goods is a member of the general public or a business/specialist user;

- while visual considerations will dominate the selection process, aural considerations will also play a part;
- there are no distinctive or dominant components in either parties' trade marks. The distinctiveness is in the trade marks as wholes;
- there is a low degree of visual similarity, a reasonable degree of aural similarity and the conceptual position is neutral;
- RAI's SEGADOR trade mark is possessed of a high degree of inherent distinctive character.

27. Although the competing trade marks have the last five letters in common, they are not highlighted or emphasised in any way; rather, they form part of a unified whole. In addition, it is, as SP argues, well established that when comparing trade marks the beginnings take on greater significance. I am satisfied, notwithstanding what I consider to be the identity in the goods and the high degree of inherent distinctive character RAI's earlier trade mark possesses, that the nature of the goods at issue, the importance of the visual comparison to the selection process and the reasonable degree of care the average consumer will take when selecting the goods, is sufficient to militate against either direct or indirect confusion; RAI's opposition fails.

Overall conclusion

28. RAI's opposition to SP's restricted specification in class 5 i.e. "Nematicides for turf" has failed.

Costs

29. SP has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to SP on the following basis:

Preparing a statement and considering RAI's statement:	£200
Total:	£200

30. I order Rotam Agrochem International Co Ltd to pay to Syngenta Participations AG the sum of **£200**. 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 30th day of April 2013

**C J BOWEN
For the Registrar
The Comptroller-General**