

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

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**DECISION**

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**INTRODUCTION**

1. This is an appeal from the decision of C J Bowen whereby he rejected the opposition to registration of the mark AGADOR by Syngenta Participations AG (Syngenta). The mark was opposed by Rotam Agrochem International Co. Ltd (Rotam) was based on its prior registration of the CTM 9448747 SEGADOR in respect of “Insecticides; fungicides; herbicides; paraciticides; preparations for destroying vermin; all of the aforesaid for agricultural use”.
2. Syngenta offered to limit the specification to “Nematicides for turf”. The Hearing Officer held, and I agree, that “nematicides for turf” were identical goods to parasiticides on the basis that the former goods were included in the larger more general category. The real debate in the case was whether the marks SEGADOR and AGADOR were confusingly similar, having regard to the nature of the marks, the circumstances of selection and purchase and the nature of average consumer for the goods in question.

## APPROACH TO APPEAL

3. I address the three criticisms of the Hearing Officer's decision below. In doing so it is necessary to bear in mind the recent reminders of the role of an appellate court, particularly in the context of decisions of specialist tribunals such as the Comptroller.
4. This appeal is a review of the hearing officer's Decision. Robert Walker LJ (as he then was) said of such appeals:

"...an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance to interfere in the absence of a distinct and material error of principle" (*Reef Trade Mark* [2003] RPC 5 at [28]; see also *BUD Trade Mark* [2003] RPC 25).

5. Mr Justice Arnold recently summarised the principles in the light of the more recent authorities from the Court of Appeal and the Supreme Court as follows in *Shanks v Unilever Plc & Ors* [2014] EWHC 1647 (Pat) (23 May 2014) at [27]-[28]:

### "The role of the appeal court"

27. The role of the appeal court was recently reviewed by Lewison LJ in *Fine & Country Ltd v Okotoks Ltd* [2013] EWCA Civ 672, [2014] FSR 11, where he said:

"50. The Court of Appeal is not here to retry the case. Our function is to review the judgment and order of the trial judge to see if it is wrong. If the judge has applied the wrong legal test, then it is our duty to say so. But in many cases the appellant's complaint is not that the judge has misdirected himself in law, but that he has incorrectly applied the right test. In the case of many of the grounds of appeal this is the position here. Many of the points which the judge was called upon to decide were essentially value judgments, or what in the current jargon are called multi-factorial assessments. An appeal court must be especially cautious about interfering with a trial judge's decisions of this kind. There are many examples of statements to this effect. I take as representative Lord Hoffmann's statement in *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2000] 1 WLR 2416, 2423:

'Secondly, because the decision involves the application of a not altogether precise legal standard to a combination of features of varying importance, I think that this falls within the class of case in which an appellate court should not reverse a judge's decision unless he has erred in principle.'

51. Where the appeal is (or involves) an appeal against a finding of fact, the role of an appeal court is as stated by Lord Mance in *Datec Electronics Holdings Ltd v United Parcels Service Ltd* [2007] UKHL 23 [2007] 1 WLR 1325 at [46] approving a passage from the judgment of Clarke LJ in *Assicurazioni Generali SpA v Arab Insurance Group* [2003] 1 WLR 577, 580 – 581 as follows:

'14. The approach of the court to any particular case will depend upon the nature of the issues kind of case determined by the judge. This has been recognised recently in, for example, *Todd v Adams & Chope* (trading as Trelawney Fishing Co) [2002] 2 Lloyd's Rep 293 and *Bessant v South Cone Inc* [2002] EWCA Civ 763. In some cases the trial judge will have reached conclusions of primary fact based almost entirely upon the view which he formed of the oral evidence of the witnesses. In most cases, however, the position is more complex. In many such cases the judge will have reached his conclusions of primary fact as a result partly of the view he formed of the oral evidence and partly from an analysis of the documents. In other such cases, the judge will have made findings of primary fact based entirely or almost entirely on the documents. Some findings of primary fact will be the result of direct evidence, whereas others will depend upon inference from direct evidence of such facts.

15. In appeals against conclusions of primary fact the approach of an appellate court will depend upon the weight to be attached to the findings of the judge and that weight will depend upon the extent to which, as the trial judge, the judge has an advantage over the appellate court; the greater that advantage the more reluctant the appellate court should be to interfere. As I see it, that was the approach of the Court of Appeal on a 'rehearing' under the RSC and should be its approach on a 'review' under the CPR 1998.

16. Some conclusions of fact are, however, not conclusions of primary fact of the kind to which I have just referred. They involve an assessment of a number of different factors which have to be weighed against each other. This is sometimes called an evaluation of the facts and is often a matter of degree upon which different judges can legitimately differ. Such cases may be closely analogous to the exercise of a discretion and, in my opinion, appellate courts should approach them in a similar way.'

52. I would add to that citation the statement of Lord Steyn in *Smith New Court Securities Ltd v Citibank NA* [1997] AC 254, 274:

'The principle is well settled that where there has been no misdirection on an issue of fact by the trial judge the presumption is that his conclusion on issues of fact is correct. The Court of Appeal will only reverse the trial judge on an issue of fact when it is convinced that his view is wrong. In such a case, if the Court of Appeal is left in doubt as to the correctness of the conclusion, it will not disturb it.'

53. This corresponds with the test under CPR Part 52.11(3)(a)."

28. I would add that the Comptroller-General of Patents is a specialist tribunal, and therefore the warning given by Baroness Hale of Richmond in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49, [2008] 1 AC 678 at [30], which was approved by Sir John Dyson SCJ giving the judgment of the Supreme Court in *MA (Somalia) v Secretary of State for the Home Department* [2007] UKSC 49, [2011] 2 All ER 65 at [43], is apposite in this context:

" ... This is an expert tribunal charged with administering a complex area of law in challenging circumstances. To paraphrase a view I have expressed about such expert tribunals in another context, the ordinary courts should approach appeals from them with an appropriate degree of caution; it is probable that in understanding and applying the law in their specialised field the tribunal will have got it right: see *Cooke v Secretary of State for Social Security* [2002] 3 All ER 279, para 16. They and they alone are the judges of the facts. It is not enough that their decision on those facts may seem harsh to people who have not heard and read the evidence and arguments which they have heard and read. Their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts or expressed themselves differently. ... "

6. These general principles are just as much applicable to appeals from the Comptroller as to other appeals and I have therefore borne them in mind in addressing the grounds of appeal.

### **Principles applied by the Hearing Officer**

7. The Hearing Officer referred to the relevant case law and applied the approach to evaluation under s.5(1)(b) which was summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *La Chemise Lacoste SA v. Baker Street Clothing Ltd* namely:

"(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 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 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."

8. No criticism is made of the Hearing Officer's summary of the law. The criticism is of its application under three heads with which I deal in turn.

**(1) Acknowledgement of confusing similarity**

9. First, Rotam contends that, in its counterstatement, Syngenta admitted that the marks were confusingly similar, particular when used in respect of goods likely to be sold to the general public. Rotam referred to the passage in the Counterstatement which says the following:

“Even if the two names could be considered as confusingly similar, it is unlikely that the co-existence of both names in the marketplace could cause confusion of the public

....Likelihood of confusion is therefore lower as in the consumer business.”

10. In the statement, Syngenta emphasised that the reason was particularly of the nature of the goods for which the mark would be used and the market for it among professional turf-keepers. However, as Rotam points out, the market is not confined to such professionals and contends that the passage amounts to an acknowledgement that, in other less professional markets, confusion is likely. Rotam therefore submitted that the Hearing Officer should have taken this concession into account and that it was erroneous in principle not to do so.
11. I am not persuaded by that argument. The passage in the Counterstatement must be read in the context of the earlier passage in that document which Syngenta denies that there will be confusion, points out that their beginnings of the marks are different and contends that the meaning of the respective marks is dissimilar.
12. The point Syngenta was making in the paragraph I have quoted is, as I interpret it, that even if the marks may be regarded as similar, the similarity is not such as is likely to cause confusion. That is reinforced by the point it made about the primary market being professional. I do not read the passage as acknowledging that, for more general consumers, confusion is likely. Accordingly, the Hearing Officer was not wrong not take account of this alleged concession. It should be noted that the Hearing Officer took specific account of the fact that the market for the products was both professional and non-professional in his global assessment (see decision para. 18).
13. I therefore reject this ground of appeal.

**(2) Failure to take sufficient account of aural similarity**

14. Second, Rotam submits that the Hearing Officer did not (or did not properly) take account of the fact that there were at least some customers who would not select the goods in question by seeing a mark on a pack but would do so as a result of, for example, oral recommendation or order. For those customers, it is said, the aural similarity would play a more important role and the visual differences identified by the Hearing Officer would not be enough to obviate any risk of confusion, given the Hearing Officer’s finding that there was a reasonable degree of aural similarity. Rotam therefore submits that this group of “oral/aural selectors” is significant and that is sufficient for there to be a relevant likelihood of confusion.

15. The argument also raises a point which commonly arises in trade mark disputes resulting from the fact that the public for the goods or services in question is diverse and the situations in which the goods or services may be encountered are various. That presents a potential difficulty for evaluation because, for trade mark infringement and for opposition based on a prior registration, liability must be determined, not by considering the number of members of the public (of the proportion) who are likely to be confused but considering a global question from the perspective of the notional (singular) “average consumer”.

16. Thus, in *Interflora v. Marks & Spencer* [2012] EWCA Civ 1501 (20 November 2012), Lewison LJ who gave the leading judgment in the Court of Appeal said:

33. I should also refer to *Reed Executive Plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40. In the course of his judgment in that case Jacob LJ (with whom Auld and Rix LJ agreed) said (§ 82):

"Next the ordinary consumer test. The ECJ actually uses the phrase "average consumer" (e.g. *Lloyd* paras [25] and [26]). The notion here is conceptually different from the "substantial proportion of the public" test applied in passing off (see e.g. *Neutrogena Corp v Golden Ltd* [1996] RPC 473). The "average consumer" is a notional individual whereas the substantial proportion test involves a statistical assessment, necessarily crude. But in the end I think they come to the same thing. For if a "substantial proportion" of the relevant consumers are likely to be confused, so will the notional average consumer and vice versa. Whichever approach one uses, one is essentially doing the same thing—forming an overall ("global") assessment as to whether there is likely to be significant consumer confusion. It is essentially a value judgment to be drawn from all the circumstances. Further conceptual over-elaboration is apt to obscure this and is accordingly unhelpful. It may be observed that both approaches guard against too "nanny" a view of protection—to confuse only the careless or stupid is not enough."

34. I agree entirely that the average consumer (in trade mark infringement) is conceptually different from the substantial proportion of the public test (in passing off). What I find difficult to accept is that they come to the same thing. If most consumers are not confused, how can it be said that the average consumer is? I do not think that this particular paragraph of Jacob LJ's judgment is part of the ratio of the case and, with the greatest of respect, despite Jacob LJ's vast experience of such cases I question it. In some cases the result will no doubt be the same however, the question is approached; but I do not think that it is inevitable."

17. However, the fact that some members of the public are likely to be confused is a relevant consideration in the evaluation. In this connection, Rotam draws particular attention to the

judgment of Arnold J in *Samuel Smith Old Brewery (Tadcaster) v. Philip Lee (trading as "Cropton Brewery")* [2011] EWHC 1879 where he said at [106]:

“In my view the majority of consumers will not be confused. Overall, however, I am persuaded that there is a likelihood that some consumers will be confused...”

18. In that case, the finding that some but not most would be confused was sufficient for there to be infringement.

## **Discussion**

19. In my judgment, this argument, attractively presented as it was, suffers from an element of over-analysis of the global question that the cases from the CJEU require the relevant authorities to undertake and which the Hearing Officer performed in this case. I consider that the Hearing Officer’s evaluation was not open to criticism for the following reasons.

20. First, Rotam rightly contends that it is important to have regard to the range of possible ways in which goods or services may be encountered, selected and purchased and the diversity of actual consumers for the goods and services in question. However, in my judgment, this is what the Hearing Officer did in the decision (see especially paras. 17-18, where he discusses the average consumer and the nature of the purchasing decision).

21. The Hearing Officer thought that visual comparison was ordinarily of particular importance given the nature of the goods. He found (and I consider that he was reasonable to find) that

“...visual considerations are likely to dominate the selection process”.

That is particularly so in the light of the factors to which he referred in paras.17-18. Rotam does not contend that he was wrong to say that these would be primary considerations. Its point is that there are some consumers in some situations for which this would not be true.

22. The Hearing Officer took this into account in para. 26 and gave it weight by saying “while visual considerations will dominate the selection process, aural considerations will also play a part”. The Hearing Officer rightly drew attention to the aural differences in the marks (decision para. 23) as well as the reasonable degree of similarity. It should be noted that Rotam did not contend at the hearing that mere fact there was aural similarity would, in the



present context, automatically give rise to confusion. Nor did Rotam suggest that it would suffice if a very small number of actual consumers might be confused.

23. In my judgment, in those circumstances, it was reasonable to reach a conclusion that there was no real risk of confusion from the perspective of the average consumer, who was assumed primarily to pay attention to the visual differences. The weight to be given to the various factors making up the global appreciation was a matter for the Hearing Officer and I am not persuaded that he did not take relevant factors into account in evaluating the risk of confusion.
24. Second, I bear in mind that, in a context of this kind, a Hearing Officer is entitled to come to a view, taking all of the relevant factors into consideration as a whole, as to whether there is a likelihood of confusion for the average consumer. If only a small number of actual consumers would be likely to use aural signals as their sole point of reference for the goods or services in question and only a small number of those would be confused because there are important differences as well as similarities in the marks from an aural perspective, a Hearing Officer is, in my judgment, able to take that into account in determining whether the average consumer would be confused and in making a global assessment of whether confusion is likely.
25. As Jacob LJ said in *Reed* in the passage from *Interflora* cited above, a Hearing Officer is entitled to approach the evaluation on the foot that trade mark law should not take an overly “nanny” approach in the assumptions that it makes about the propensity of the marketplace to discriminate between marks. That is so provided the tribunal does not lose sight of the overarching point made in *Canon* at [29] and frequently repeated (inter alia by Arnold J in *Interflora Inc & Anor v Marks and Spencer Plc & Anor* [2013] EWHC 1291 (Ch)) that “the risk that the public *might* believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion” (emphasis added by Arnold J).
26. Third, in my judgment, Arnold J in *Samuel Smith* was doing no more than saying that, in that particular case there was a sufficient likelihood of confusion among users who would encounter the mark in normal circumstances for there to be infringement. He was not, as I

understand that case, purporting to lay down a general rule that, as soon as the court determines that any number (no matter how small) of actual individuals might be confused in a given situation (even though that situation may not usually arise) a finding of likelihood of confusion for the purpose of determining registrability was inevitable on the basis that some people might be confused in some contexts.

27. Having regard to those considerations, the Hearing Officer did not in my judgment make an error of principle in the multi-factorial assessment of likelihood of confusion nor was his conclusion plainly wrong. I therefore reject this ground of appeal.

### **(3) Visual similarity of the marks**

28. Third, Rotam argues that the Hearing Officer incorrectly applied the general principle that, when comparing marks the beginnings are of greater significance with the result that he underestimated (in particular) the visual similarity.

29. There is no doubt that tribunals often place greater weight on the earlier part of marks and that this may be an appropriate starting point but it is justifiably said by Rotam that it is not a rigid rule and several cases in the domestic and European courts have paid greater attention to suffixes of marks (see *Wagamama v. City Centre Restaurants* [1995] FSR 713 and *Devinlec Development* T-147/03[2006] ECR II-11).

30. Rotam contends that, having regard to the fact that the prefix “AG” is common to the trade in agrochemicals, the main distinguishing part of the mark is the “ADOR” suffix which, in this context would be given greater weight. Rotam argues that, in consequence, the visually similarity was greater than the Hearing Officer thought there was.

31. I am again unpersuaded by this argument. It is true that the Hearing Officer did not expressly say that he was not applying a rigid rule but there is nothing in his decision to indicate that he was treating the first part as more important in a rigid way. Indeed in para. 22, he made an overall evaluation which noted but did not place particular weight on the fact that the differences lay in the earlier part of the marks. Indeed, he expressed this part of his consideration as supplementary to the overall evaluation of the marks as a “unified whole” (see para. 27).

32. Moreover, to the extent that “AG” does have a conceptual meaning relating to agriculture, that could be seen as an additional point of distinction between the marks since it is not contended that “SEG” has a similar meaning and so the argument cuts both ways.
33. In my judgment, this criticism of the Hearing Officer suggests that he should have approached the question by dividing up the marks in a way in which the average consumer is not assumed to do. I do not accept that argument. The Hearing Officer was justified in proceeding on the basis that, in this case, the marks would be seen as a whole and differentiated on this basis (see decision paras. 21 and 27).
34. I therefore also reject this ground of appeal.
35. Finally, I step back and consider the Hearing Officer’s evaluation taken as a whole. In my judgment, he reached a decision which was one that a reasonable tribunal could have reached on the material before him. He approached the assessment of the marks as a whole (decision, para. 21). He took into account the visual, aural and conceptual similarities and differences (decision, paras 22-24) and their respective distinctive character (decision, para. 25). He evaluated the likelihood of confusion with the correct considerations in mind (decision, paras. 26-27) and in particular, the manner in which the average consumer was likely to encounter the marks in question, based on his specific evaluation of this issue (decision, paras 17-18).

## **CONCLUSION AND COSTS**

36. In summary, the Hearing Officer applied the right law and took the relevant factors into account in so doing. He came to a conclusion which was within the bounds of reason and I am far from convinced that he was wrong. The appeal must therefore be dismissed.
37. There is no tangible sign of the respondent’s active participation in this appeal. There is no explicit claim for costs and would not be appropriate in those circumstances to make any award of costs which would, in any event, be minimal.

DANIEL ALEXANDER QC

Appointed Person

27 May 2014

**Representation**

Christian Ziar of N J Akers for the Appellant

The Respondent was not represented