

**TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 1513351
BY ALIMENTOS MARINOS S.A. ALIMAR TO
REGISTER THE MARK ALIMAR SPECIAL
IN CLASS 31**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No 42599 BY NOVUS INTERNATIONAL INC**

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**IN THE MATTER OF Application No 1513351 by
Alimentos Marinos S.A. Alimar to register the
mark Alimar Special in Class 31**

10 **and**

**IN THE MATTER OF Opposition thereto under
No 42599 by Novus International Inc**

15

DECISION

20 On 12 September 1992 Alimentos Marinos S.A. Alimar of Santiago, Chile applied to register
the mark ALIMAR SPECIAL for a specification of goods comprising “fish meal produced for
animal and human consumption”.

The application is numbered 1513351.

25 On 8 June 1995 Novus International, Inc of St Louis, Missouri, USA filed notice of
opposition to this application. In summary the grounds of opposition are as follows:-

- 30 (i) under Section 12(1) by reason of the opponents’ registration of the mark
ALIMET (No 1153427) in Class 1 for “chemical preparations for use as
additives to animal foodstuffs during the course of manufacture”;
- (ii) under Section 11 by reason of the opponents’ use of and reputation in the mark
ALIMET;
- 35 (iii) under Sections 9 and 10 of the Act;
- (iv) under Section 17 in that the applicant is not the bona fide proprietor of the
mark at issue;
- 40 (v) under Section 68 of the Act;
- (vi) under the provisions of EC directive 89/104.

45 The applicants filed a counterstatement denying these grounds and asking that the Registrar’s
discretion be exercised in their favour.

Both sides ask for an award of costs in their favour. Only the opponents filed evidence. The matter came to be heard on 14 May when the opponents were represented by Mr A Leitch of S J Berwin, their solicitors. The applicants were not represented at the hearing.

5 By the time this matter came to be heard, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provisions of the old law.

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Opponents' evidence (Rule 49)

The opponents filed a statutory declaration dated 1 July 1996 by Thad W Simons, their Vice President and General Counsel. He says that the opponents are one of the world's leading producers and suppliers of animal feed additives.

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The opponents first manufactured and supplied goods using the trade mark ALIMET in 1979. Since the product's launch, Mr Simons claims it has been recognised by the majority of feed manufacturers as the most effective, practical and best value-for-money source of methionine activity and is used on hundreds of sites in over 50 countries worldwide, supplying over one third of the world market.

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Annual sales of the product using the Trade Mark currently stand at over £200 million and are expected to continue to grow.

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Products using the Trade Mark were first sold in the United Kingdom at least as early as 1982.

The opponents' annual turnover in the United Kingdom for products using the Trade Mark are as follows:

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| Year | Amount (£) |
|-------------|-------------------|
| 1991 | 1,235,290 |
| 1992 | 2,728,230 |
| 1993 | 2,823,330 |
| 1994 | 3,136,660 |
| 1995 | 4,922,660 |

35

40 Mr Simons says that the opponents have spent between £26,660 and £33,330 in print promotion of their products, including products using the Trade Mark. Examples are exhibited at TWS1.

The opponents advertise their products in trade publications distributed both in the UK and throughout Europe including Feed International, Feed Mix, International Poultry Production, Poultry International and World Poultry. Examples are exhibited at TWS2.

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Mr Simons notes that the applicants' mark ALIMAR SPECIAL is filed in respect of fish meal for animal and human consumption. He says that fishmeal is a natural animal protein source with a high methionine content. Liquid methionine is the primary basis of goods sold under the opponents' mark. As a result he submits that the goods are confusingly similar.

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He concludes by saying:

10 "I believe that by virtue of the opponents' pre-eminent place in the UK market in respect of animal feeds, particularly goods using the Trade Mark, potential customers will be deceived by use of the Trade Mark ALIMAR SPECIAL into believing that goods using the Trade Mark ALIMAR SPECIAL are goods from the same "family" as those using the Trade Mark. I believe that these marks are confusingly similar and that confusion between them could arise in the marketplace."

15 The opponents filed a further statutory declaration in support of their case by Robert Cook, a commercial investigator. Mr Cook's declaration is dated 1 July 1996.

20 Mr Cook says that he was instructed to investigate any use of the trade mark ALIMAR SPECIAL by the applicants in the United Kingdom. His enquiries with the "Companies Register", the Chilean Embassy and the Chilean Chamber of Commerce produced no information on the applicants or any of their activities in this country. He also examined several leading food trades and pet food directories but found no reference to the applicants or the trade mark. He exhibits (RC/1) extracts from 'Food Trades Directory of UK and Europe', 'The Grocer', and 'Pet Trade & Industry Association Year Book & Buyers Guide' by way of
25 confirmation.

30 He goes on to say that on 25 April 1996 he telephoned the applicants and spoke to Sergio Munoz, who was introduced as a Director. Mr Munoz informed him that the applicants produce fish meal and fish oil. Mr Munoz also said that the applicants had no sales agent in the UK and that the last time the applicants exported anything was in April 1995 to China. Mr Munoz said that he had sold products to the UK in the past but not frequently and that if the applicants sold in the future in the UK it would be through their German agents.

35 Mr Cook subsequently contacted the German agent, Alfred Topfer & Co, and spoke to Mr Uwe Schmidt. He says that Mr Schmidt confirmed having dealt infrequently with the applicants in the past but was not familiar with any goods using the trade mark ALIMAR SPECIAL. Mr Schmidt said he had never sold any of the applicants' products to the UK.

40 As a result of these enquiries Mr Cook is of the view that the applicants are not at present marketing their products in the United Kingdom and that there is no evidence in support of past use.

That completes my review of the evidence.

45

At the hearing Mr Leitch indicated that the main grounds on which he sought to rely were those under Section 11, 12(1) and 17.

I will deal firstly with the ground based on Section 11 of the Act. This section reads as follows:-

“11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.”

The established test for objections under this section is set down in Smith Hayden & Co Ltd’s application (Volume 1946 63 RPC 101) as adapted by Lord Upjohn in the BALI trade mark case [1969] RPC 496. Adapted to the matter in hand the test may be expressed as follows:

Having regard to the user of the opponents’ mark ALIMET, is the tribunal satisfied that the mark applied for, ALIMAR SPECIAL, if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

The opponents have been using their mark in this country since 1982. They have supplied turnover figures for more recent years. Some of this information refers to periods after the material date in these proceedings but I am satisfied that they have used their mark on a not insubstantial scale. The supporting trade brochures and advertising features clearly demonstrate how the mark is used.

A particular feature of the opponents’ goods is that they provide a source of methionine which is used, inter alia, to alleviate heat stress in pig and poultry production. In the context of the issues before me it is convenient to reproduce an extract from Novus’s ALIMET Biochemistry brochure contained in Exhibit TWS1:-

“If methionine is not adequately present in the diet, pigs and poultry will not grow or produce protein at optimum rates. Feeds must therefore be supplemented; however, the use of feed ingredients rich in methionine, such as fishmeal and corn gluten meal, is limited by cost and availability.”

It seems, therefore, that both the opponents’ goods and goods within the specification applied for by the applicants function as additives or supplements to animal and poultry feeds. I take it from the evidence before me that the opponents’ products are synthetic substitutes for other naturally occurring substances. As fishmeal is said to be one of the principal alternative providers of the key active ingredient, methionine, I judge the respective sets of goods to be very closely associated indeed. I should reiterate at this point that the applicants have filed no evidence to counter the opponents’ case so the latter’s evidence is in effect unchallenged.

In considering the marks themselves I do not think the position in this case is significantly different as between Sections 11 and 12. The following remarks therefore apply to both Sections.

5 The marks themselves are ALIMET (opponents' mark) and ALIMAR SPECIAL (applicants' mark). The word SPECIAL is so obviously laudatory in nature that it must be held to contribute nothing of substance to the distinctive character of the mark. To put it another way the essential or distinguishing feature of the applicants' mark is the word ALIMAR (see Saville Perfumery v June Perfect 58 RPC 147 at page 162 lines 18 to 20). Both ALIMET and
10 ALIMAR are self evidently three syllable words made up of an equal number of letters and sharing the first four letters in common. It is well established that in a comparison of word marks the beginnings of words are generally most important (see TRIPCASTROID Trade Mark 1925 RPC 264). I also bear in mind Mr Leitch's comments in relation to the ERECTIKO case 1935 RPC 136. None of this is to say that the words cannot be
15 distinguished on the basis of a careful side by side comparison. However as Lord Radcliffe stated in De Cordova and Others v Vick Chemical Co 1951 RPC 103 at page 106 lines 17-23:

20 "The likelihood of confusion or deception in such cases is not disproved by placing the two marks side by side and demonstrating how small is the chance of error in any customer who places his order for goods with both the marks clearly before him, for orders are not placed, or are often not placed, under such conditions. It is more useful to observe that in most persons the eye is not an accurate recorder of visual detail, and that marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole."

25 The same point was made in the case of Aristoc v Rysta [1945] 62 RPC 65. The following passage comes from Viscount Maughan's speech in that case:

30 "The answer to the question whether the sound of one word resembles too nearly the sound of another so as to bring the former within the limits of section 12 of the Trade Marks Act, 1938, must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived or confused. It is the person who only knows the one word and has perhaps an imperfect recollection of it who is likely to be deceived or confused. Little assistance, therefore, is to be obtained
35 from a meticulous comparison of the two words, letter by letter and syllable by syllable pronounced, with the clarity to be expected from a teacher of elocution. The Court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description but also of the shop assistant ministering to that person's
40 wants."

Bearing the above considerations and authorities in mind it seems to me that there could be direct visual confusion between the marks because of their similarity of length, structure and common initial letters. Even more importantly, perhaps, there is a risk of confusion through
45 imperfect recollection particularly as each of the words ALIMET and ALIMAR appear to be

invented and, therefore, are not distinguishable in the same way that they might be if they were common dictionary words.

5 In short, having regard to the marks themselves, the user of the opponents' mark and the commercial context within which that use takes place, I find that there is a real risk of confusion and that the opposition under Section 11 succeeds accordingly.

I turn now to the Section 12 ground. The relevant part of this Section reads as follows:-

10 "12 - (1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

15 a. the same goods

b. the same description of goods, or

20 c. services or a description of services which are associated with those goods or goods of that description."

The reference in Section 12(1) to a near resemblance is clarified by Section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

25 The established test for objection under this Section is again that set down in Smith Hayden and Company Ltd's application (see above). Adapted to the matter in hand the test may be expressed as follows:-

30 Assuming user by the opponents of their mark ALIMET in a normal and fair manner for any of the goods covered by the registration of that mark, is the tribunal satisfied that there will be no reasonable likelihood of deception amongst a substantial number of persons if the applicants use their mark ALIMAR SPECIAL, normally and fairly in respect of any goods covered by their proposed registration?

35 As indicated above my view on the issue of comparison of marks carries over to the consideration under Section 12 as well. So far as the respective sets of goods are concerned I must consider whether they are of the same description (they are in different classes and so, self-evidently, cannot be the same goods). The test under Section 11 is not restricted in this way so it does not automatically follow that my finding under Section 11 necessarily determines the matter under Section 12.

40 In this particular case the comparison is between the opponents' "chemical preparations for use as additives to animal foodstuffs during the course of manufacture" and the applicants "fishmeal produced for animal and human consumption". Mr Leitch, rightly I think, referred me to JELLINEK'S application 1946 RPC 59 (the PANDA case) in relation to the standard

test which requires me to consider the nature, purpose and channels of trade. In terms of the case before me he also relied on INVICTA Trade Marks 1992 RPC 541. I have found myself to be somewhat hampered in my consideration of the elements of the JELLINEK test by the fact that there is no evidence from the applicants as to the form their goods take and, particularly, the channels of trade. Consequently I consider that I must take a broad view of the possibilities. The opponents' trade literature suggests that goods sold under their mark are in liquid form but the specification of their registration No 1153427 is not restricted in this way and could of course be in powder or other form. What is rather more clear is that the purpose of the respective goods is the same or least directly overlapping. There is scant information on channels of trade. It seems likely that the opponents' goods are sold directly to feed mill operators for incorporation into animal feeds. This is also borne out by their Class 1 specification which refers to "use during the course of manufacture". The applicants' specification suggests that their fishmeal is a food product in its own right but there is no reason to suppose that it could not be an ingredient in, or supplement to, animal feeds generally. On balance the latter seems more likely. As such the channels of trade could in my view be the same as the opponents' goods. I have, therefore, come to the view that in terms of the JELLINEK test goods of the same description are involved. I am reinforced in this view by the fact that the opponents' goods are in effect a synthetic substitute for the naturally derived product fishmeal. This, it seems to me, is in the circumstances of this case, a reasonable indicator of the close relationship that exists between the respective sets of goods. Given also my finding in relation to the marks the opposition succeeds also under Section 12.

The other main plank of the opponents' case is the ground based on Section 17 of the Act. This reads:

"17 - (1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it must apply in writing to the Registrar in the prescribed manner for registration either in Part A or in Part B of the register."

There are in effect two aspects to the opponents' challenge under this head. In their statement of grounds they suggest that the applicants are not the true proprietors of the mark. I do not consider that any evidence has been put forward in support of this claim.

I, therefore, reject this ground of attack.

In their evidence and in submissions at the hearing it was also suggested that there was no intention to use the mark. A party's intentions at any point in time are, of course, notoriously difficult to determine. The opponents have pointed to Mr Cook's evidence in support of their claim. The applicants had previously said in their counterstatement that the mark had been used in the United Kingdom continuously since 1985 but no evidence has been filed to substantiate the point. I do not find the material before me to be conclusive. I note that Mr Cook records Mr Munoz (of the applicants) as saying that he had sold products to the UK in the past. Mr Leitch criticised Mr Munoz's comments and pointed out that there is no reference to the mark as such. I bear in mind, however, that Mr Munoz was responding to enquiries from a commercial investigator so this exchange needs to be

treated with some caution. On balance I do not think the opponents' succeed under this ground.

5 Mr Leitch confirmed that the other grounds referred to above were not being pursued at the hearing. I, therefore, dismiss those grounds.

10 There remains the matter of the Registrar's discretion. However as the consequence of my findings under Sections 11 and 12 are mandatory no exercise of discretion is possible or appropriate.

15 There is one other matter arising from the specification of goods applied for to which further consideration should in my view be given in the event of a successful appeal by the applicants against this decision. The specification as it stands covers "fish meal produced for animal and human consumption" Fish meal for human consumption is likely to be appropriate to Class 29 rather than Class 31. It may, therefore, be necessary for the applicants to consider an amended specification to reflect this.

20 As the opponents have been successful they are entitled to a contribution towards their costs. Mr Leitch submitted that in the light of the applicants' failure to either withdraw from the proceedings or to file evidence or be represented at the hearing I should consider an award of costs at the higher end of the scale.

25 I note his comments but am not persuaded that a significantly higher award is called for. I order the applicants to pay the opponents the sum of **£800**.

Dated this 29th day of May 1998

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M REYNOLDS
For the Registrar
35 the Comptroller-General