

O-049-04
TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 2248462
BY GLENSIDE ORGANICS LIMITED TO REGISTER
THE TRADE MARK BI-AGRA IN CLASS 1

AND

IN THE MATTER OF OPPOSITION No. 90587
BY PFIZER INC

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2248462
by Glenside Organics Limited to register
the Trade Mark BI-AGRA**

and

**IN THE MATTER OF Opposition No. 90587
by Pfizer Inc**

Background

1. On 13 October 2000 Glenside Organics Limited applied to register the mark BI-AGRA for a specification of goods in Class 1 which reads “Chemical products for use in agriculture, horticulture and forestry; fertilising preparations, fertilisers and manure; biological preparations; soil conditioners and plant nutrients; additives.”

The application is numbered 2248462.

2. On 30 April 2002 Pfizer Inc. filed notice of opposition to this application. They are the proprietors of the following registrations:

No.	Mark	Class	Specification (most relevant Class only)
2169595 (UK)	VIAGRA	1	Chemicals used in the pharmaceutical and veterinary industries.
847814 (CTM)	VIAGRA	1	Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.

3. Both registrations cover other Classes but in the circumstances of this case it is not suggested that this improves the opponents’ position in any material way.

4. The opponents object under Section 5(2)(b) of the Act on the basis that there is a likelihood of confusion arising from the identity or similarity of the respective sets of goods and the similarity in the marks.
5. The applicants filed a counterstatement denying the above ground.
6. Both sides ask for an award of costs in their favour.
7. Both sides filed evidence (the opponents' being in reply to the applicants' evidence in chief).
8. The matter came to be heard on 26 January 2004 when the applicants were represented by Mr C Finn of Fitzpatrick's and the opponents by Mr P Harris of Gill Jennings & Every.

Evidence

9. Nander Robertson, the applicants' Managing Director, has filed a witness statement which in summary:
 - argues that the goods of the application are neither identical or similar to those of Pfizer's UK registration;
 - exhibits (NR1) a copy of the examination report to show that the examiner did not consider BI-AGRA to be similar to VIAGRA;
 - exhibits (NR2) a technical information sheet on the BI-AGRA product which is sent to prospective customers;
 - confirms that no instances of customer confusion have come to light.
10. Philip Warren Harris, the opponents' trade mark attorney has replied to the above. I will take his submissions into account where necessary in my decision below.
11. I note the following additional comments by Mr Harris in relation to Exhibit NR2:

“On the evidence, the Registrar is now on notice that the Applicant's intention to use its mark is confined to humic acid concentrates for use in soil fertility and the Registrar should of his own motion consider whether the application should be refused in whole or in part ex-parte under the provisions of Section 3(6) Trade Marks Act 1994.

Insofar as the Registrar declines to consider whether, prima facie, and ex parte, that the Applicants have shown the requisite intention to use, by virtue of the contents of Exhibit NR2, the Applicants are hereby put to proof that their intention to use extends beyond “humic acid concentrate”.”

12. Under cover of a letter dated 10 December 2003 the applicants filed a further witness statement by Nander Robertson addressing the above point as to whether the applicants' intention to use goes beyond humic acid concentrates.

13. Mr Harris' evidence suggested that the Registrar should raise the matter of his own motion. There has been no request to amend the grounds in this inter partes action to reflect any such objection and I indicated at the hearing that I did not consider it appropriate to raise the matter of my own volition even if I had the power to do so (which I doubt) in my role as Hearing Officer for the opposition. If the suggestion is that I should remit the matter to the Registry's examination section for further consideration then I can only say that I would decline to do so on the basis of the information available to me. Clearly, however, it remains open to the opponents to raise the matter by way of observation under the provisions of Section 38 of the Act at any time before registration. As matters stand, therefore, the Section 3(6) point is not before me in this action and, as a further consequence, there was no need to admit Mr Robertson's further witness statement dealing with it.

14. I, therefore, turn to the objection under Section 5(2)(b) of the Act. This reads:

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

(a)

(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.”

15. The opponents are the proprietors of two registrations both of which are earlier trade marks within the meaning of Section 6(1)(a) of the Act. It was common ground at the hearing that the opponents' CTM registration offered them a broader basis of attack in view of the fact that the Class 1 specification is based on the Class heading in the Nice Classification. There is also no dispute about the authorities I must have in mind, these being the following European Court of Justice cases, *Sabel BV v Puma AG* [1998] R.P.C. 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 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

The parties' submissions

16. Mr Harris' submissions, on behalf of the opponents, were in summary that both marks consisted of six letters with five being in common; that B and V are pronounced similarly and will be confused in telephone ordering; that, furthermore, the hyphen in the applied for mark will play no role when the mark is spoken; that, being invented words, the marks have no concept as such save for the association with the opponents' well known mark; that the goods are identical or closely similar; and that, accordingly, there is a likelihood of confusion.

17. Mr Finn, for the applicants, submitted (again in summary) that the marks were visually different having regard to the presence of the hyphen in BI-AGRA and the different first letters (he reminded me of the importance of first elements – see *TRIPCASTROID* 42 RPC 264); that BI-AGRA would be pronounced with a pause between the two elements; that there are conceptual differences as VIAGRA has no meaning whilst BI means either two or biological and AGRA stems from the word agriculture; and that there was no likelihood of confusion taking a global view of the matter.

Comparison of goods

18. Given the breadth of the opponents' CTM registration there can be little doubt that identical and/or closely similar goods are concerned. The applicants' 'chemical products for use in agriculture, horticulture and forestry' are matched by the opponents' chemicals used in agriculture, horticulture and forestry'. The remainder of the applied for specification consists of goods which fall within these broad terms.

Comparison of marks

19. The visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel v Puma*, paragraph 23). The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel v Puma*, paragraph 23). The distinctive character of a mark may be either inherent or acquired (*Sabel v Puma*, paragraph 24). The opponents' earlier trade mark is an invented word. Although no use has been claimed in relation to Class 1 goods that does not prevent the mark VIAGRA having a high degree of distinctiveness.

20. Visually, it is clear that the respective marks are composed of six letters and that they have the last five in common. However, the different first letter is readily apparent on the printed page and the presence of the hyphen and its effect in splitting the applied for mark in two cannot be ignored. I find that there is some overall visual similarity but the marks are not visually similar on this account to a particularly high degree.

21. From an aural point of view I find the marks much less easy to separate. The difference between a 'b' and a 'v' sound is not that great and, allowing for the normal imperfections of speech, would in my view be difficult to distinguish. Precise and careful articulation might mitigate the possible effects but in normal trading circumstances that is unlikely to occur. Nor do I accept Mr Finn's contention that BI-AGRA will be pronounced with a pause between the elements. That seems improbable and contrary to the normal pattern of speech. In short I find the marks to be aurally similar to a high degree.

22. Conceptually, it has been suggested that the marks can be distinguished because VIAGRA is wholly invented whereas BI-AGRA will have the meanings suggested in Mr Finn's submission. I am not aware that BI (as opposed to BIO) is an accepted abbreviation for biological. It can mean two but that meaning has no obvious significance or relevance in relation to the remainder of the mark. –AGRA may or may not be taken as alluding to agricultural. Mr Harris suggested

it would not because the natural abbreviation or combining form would be ‘agro-‘ or possibly ‘agri-’. The point is arguable but not it seems to me of crucial importance. If the allusion is present at all it is present in both marks albeit more obviously in the applicants’ mark and would be a point of conceptual similarity. However the guidance from *Sabel v Puma* is that consumers do not approach trade marks in a spirit of analysis. They are unlikely to dissect or seek to understand these marks if, indeed, any underlying meaning is present at all. On the whole I take the view that with invented words of this kind conceptual considerations are less important than they would be in the case of marks that consist of, or are made up from, known dictionary words. The position on conceptual similarity seems to me to be broadly neutral.

Likelihood of confusion

23. This is a matter of global appreciation taking all relevant factors into account (*Sabel v Puma*, paragraph 22). There was a suggestion at the hearing that the applicants’ goods would be for sale on a “business to business” basis rather than to consumers at large. That may be so but there is nothing in the applied for specification which restricts the nature of the customer base or the marketing methods to be used. I must, therefore, assume normal and fair use across the full range of goods applied for.

24. In any case, I am not reassured that the likelihood of confusion would be lessened if the goods were sold on a ‘business to business’ basis. The latter has not in practice been explained in evidence but I take it to mean that the goods (soil conditioners etc) would be sold to farmers or other large users such as forestry concerns or parks departments. The nature of the goods is that they are industrial consumable items. They are likely to be ordered in reasonably large quantities (I note from NR2 that the humic acid concentrate product is sold in 18 litre containers). It is in the nature of such goods that they may be the subject of telephone ordering and re-ordering from farmers etc. rather than selection by, say, visual inspection on the shelves at a garden centre. Thus whilst a ‘business to business’ trade may point to an informed and knowledgeable customer base it also suggests that oral ordering can be expected to play a part in the sales process.

25. In summary I have found that identical goods are in play; that the opponents’ earlier trade mark is a highly distinctive one; that there is limited visual similarity but a significant measure of aural similarity; and that conceptual similarity is unlikely to be a determining factor. It was held in *Sabel v Puma* that:

“It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public.”

26. It is not necessary, therefore, that visual, aural and conceptual similarity must be present. In *David West v Fuller Smith & Turner Plc*, O/136/00 the Hearing Officer paid particular regard to the importance of aural similarity between the marks ESB and ESP Eastenders Strong Pils. In doing so he recognised that the trade in beers (at least in public houses) still relies to a large extent on word of mouth orders and that it was correct to consider all the main avenues of trade in the goods concerned.

27. However, although a likelihood of confusion may be found on the basis of aural similarity alone (and visual or conceptual similarity likewise) it is not an automatic consequence. The result in any particular case will depend on a global appreciation taking all factors into account. I have hesitated over the outcome of this case because I have limited information on the nature of the trade. But it seems to me that the trade in agricultural fertilisers, chemicals etc. will include (even lend itself to) ordering and re-ordering of these bulk consumable products by telephone. Farmers can be expected to conduct this sort of business over the phone as much as by visiting agricultural merchants or suppliers. Allowing for such circumstances of trade I find that the consequence of aural confusion must be given due weight. Accordingly there is a likelihood of confusion and the opposition succeeds under Section 5(2)(b).

Costs

28. The opponents have been successful and are entitled to a contribution towards their costs. Mr Harris invited me to reflect a delay in the start of the hearing in my costs award. The delay occurred because of Mr Finn's travel difficulties in coming down from Scotland. The delay (approximately half an hour) was unfortunate but so far as I can see unavoidable. In all the circumstances I do not think I need to penalise the applicants on this account. There was also some inconvenience the other way as a result of the failure to transmit the whole of Mr Harris' skeleton argument.

29. Mr Finn in turn submitted that I should allow for the fact that the opponents had amended their grounds (to include their CTM registration) thus requiring the applicants to amend their counterstatement. He further suggested that the opponents had asked for a hearing when it was not considered necessary.

30. The request to amend the grounds was decided in the opponents' favour and cannot in itself have caused the applicants significant additional work. So far as I am aware no request was made at the time to leave any related costs issue open for determination at a later date. As for whether a hearing was necessary, the opponents have a statutory entitlement in this respect and should not be penalised for exercising that right. It is for the other side in such circumstances to decide whether or not to attend the hearing or to offer written submissions in lieu of such attendance. My costs award will, therefore be based on the published scale and be a standard award. I order the applicants to pay the opponents the sum of £1500. 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 24th day of February 2004

M. REYNOLDS
For the Registrar
the Comptroller-General