

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION No. 2597646 IN THE NAME
OF SUMITOMO CHEMICAL COMPANY LIMITED**

AND IN THE MATTER OF OPPOSITION No. 102821 BY SYNGENTA LIMITED

DECISION

Introduction

1. This is an appeal from the decision of Mr George Salthouse, acting on behalf of the Registrar, dated 1 March 2013 (O-179-13), in which he rejected the Opposition brought by Syngenta Limited (*'Syngenta'*) against trade mark application No. 2597646 in the name of Sumitomo Chemical Company Limited (*'Sumitomo'*).
2. Trade mark application No. 2597646 was filed for registration on 12 October 2011 requesting registration of the trade mark FORGE in respect of the following goods in Class 5:

Herbicides, fungicides, insecticides, and preparations for killing weeds and destroying vermin.
3. The application was examined and accepted and subsequently published for opposition purposes on 4 November 2011 in Trade Marks Journal No. 6912.
4. On 30 December 2011 Syngenta filed a Notice of Opposition on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (*'the 1994 Act'*).
5. Syngenta is the proprietor of, *inter alia*, Community trade mark registration No. 29572040 for the mark FORCE filed on 12 December 2002 and placed on the register on 21 December 2004 in respect of the following goods:

Class 1

Chemicals used in agriculture, horticulture and forestry; seed treatment preparations.

Class 5

Insecticides, fungicides, herbicides

For the purposes of its attack on the basis of Section 5(2)(b) of the 1994 Act Syngenta relied upon this Community trade mark registration.

6. On 6 March 2012, Sumitomo filed a counterstatement denying that the marks were similar and putting Syngenta to proof of use of its mark.
7. Evidence was subsequently filed on behalf of Syngenta in the form of a witness statement of Alice Davies (a trade mark Attorney at Murgitroyd & Company) dated 6 June 2012; and a witness statement of Joachim Hofmann (senior trade mark attorney for the Syngenta group of companies) dated 22 November 2012.
8. No evidence was filed on behalf of Sumitomo.
9. On 16 January 2013 Sumitomo filed a Form TM21 and restricted its application to '*Herbicides*' in Class 5.
10. Neither side wished to be heard nor did they provide the Hearing Officer with written submissions. Accordingly the opposition was decided on the basis of the pleadings and the evidence filed on behalf of Syngenta.

The Hearing Officer's Decision

11. The Hearing Officer first considered whether Syngenta had fulfilled the requirement to show that genuine use of the Community trade mark upon which it relied in support of the opposition had been satisfied.
12. The Hearing Officer identified the relevant case law as to the approach that he was required to take in assessing whether the requirements for proof of use had been

satisfied in paragraphs 13 and 14 of his Decision. There is no suggestion that the Hearing Officer incorrectly identified the relevant case law on this issue and nor, in my view, could there be.

13. At paragraph 15 of his Decision the Hearing Officer concluded as follows:

The opponent has claimed that it has used its mark on insecticides in the EU and the evidence, which is unchallenged, clearly supports this contention. The opponent does not claim use on any of the other goods for which the marks is registered. To my mind, the only specification possible is: Insecticides.

Quite correctly, there is no challenge to the Hearing Officer's findings on this issue.

14. Having made that finding and on that basis the Hearing Officer then went on to assess the mark for conflict under Section 5(2)(b) of the 1994 Act.

15. In paragraph 16 of his Decision the Hearing Officer correctly identified the relevant case law for the purposes of assessing the likelihood of confusion under Section 5(2)(b) of the 1994 Act. Again there is no suggestion, and nor could there be, that there was any error in the Hearing Officer's summary of the relevant law.

16. The Hearing Officer then went on to decide:

- (1) That Syngenta's earlier mark had a reasonable degree of inherent distinctiveness for the goods for which it was registered but that there was no material before him to support any claim to an enhanced reputation (paragraph 17 of the Decision);
- (2) That the average consumer for the goods was to be regarded as being both the general public and businesses (farmers/corporate landowners and horticultural businesses). That the nature of the goods was such that the average consumer is likely to pay a high degree of attention to their selection (paragraph 18 of the Decision);
- (3) That neither mark has a dominant feature, the distinctiveness lies within the totality of the mark (paragraph 24 of the Decision);

- (4) That the respective marks shared a reasonable level of visual similarity (paragraph 25 of the Decision);
- (5) That the respective marks shared a degree of aural similarity (paragraph 26 of the Decision); and
- (6) That with regard to conceptual similarity both marks were well known English words which (a) have very different meanings; and (b) would be instantly recognised by any consumer (paragraphs 27 and 28 of the Decision).
17. The Hearing Officer also concluded that the goods were not similar or complementary for the following reasons (paragraph 21 of his Decision) (emphasis contained within the original text):

The uses are very different in that an insecticide is used to kill insects whereas a herbicide is used to eradicate weeds or plants. The users have to be regarded as similar as farmers will use both products and so will a percentage of gardeners. Even though I accept that a lot of gardeners will not use pesticides. The physical nature of the goods can also be the same as both would be in liquid or pellet/powder form. I have no evidence of trade channels, but I know from my own experience that garden centres and DIY stores stock both products in reasonable proximity where they are likely to be self selected. Clearly they are not in competition with each other as they carry out completely different roles. There are some similarities between the goods, however, because their uses are so specific and are for completely different purposes I do not consider the goods overall to be similar. Nor do I consider them to be complimentary 'in the *sense that one is indispensable or important for the use of the other in such a way that* customers may think that the responsibility for those goods lies with the same undertaking'

18. On the basis of these findings the Hearing Officer rejected the opposition under Section 5(2)(b) of the 1994 Act. He did so in the following terms (paragraph 29 of his Decision):

I must now take all the above into account and consider the matter globally taking into account the interdependency

principle – a lesser degree of similarity between the trade marks may be offset by a greater degree of similarity between goods and services. I have already found that the goods are not similar or complimentary and that there is a degree of visual and aural similarity in the marks, but that they differ completely in their conceptual meanings. Even when taking into account imperfect recollection, the differences between the marks and goods is such that there is no likelihood of consumers being confused into believing that that goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(2)(b) therefore fails.**

The appeal

19. On 28 May 2013 Syngenta filed a Notice of Appeal to the Appointed Person under Section 76 of the 1994 Act. There was no cross-appeal or Respondent’s Notice filed on behalf of Sumitomo.

Standard of review

20. The appeal is by way of review. Neither surprise at a Hearing Officer’s conclusion, nor a belief that he has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong. See Reef Trade Mark [2003] RPC 5, and BUD Trade Mark [2003] RPC 25.
21. More recently in Fine & Country Ltd v Okotoks Ltd (formerly Spicerhaart Ltd) [2013] EWCA Civ 672; [2014] FSR 11 Lord Justice Lewison said at paragraph [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. . . .

22. On appeals of this nature, it is necessary to bear these principles in mind.

The Grounds of Appeal

23. The Grounds of Appeal contend in substance that there were two errors in the Decision upon which Syngenta wished to rely:
- (1) The failure in the approach of the Hearing Officer to his assessment of the similarity of the goods being herbicides on the one hand and insecticides on the other; and
 - (2) The resulting failure of the Hearing Officer to fully or correctly apply the interdependency principle in reaching his conclusion on the likelihood of confusion.

These contentions were developed in argument at the hearing before me.

24. As noted above the Grounds of Appeal did not seek to challenge the Hearing Officer's finding on the basis of the evidence of use before him that the fair specification for the earlier trade mark relied upon was '*Insecticides*' in Class 5 (see paragraph 15 of the Decision).

Decision

25. The Hearing Officer's assessment of the similarity of the goods in issue was criticised in detail. It was submitted on behalf of Syngenta that the Hearing Officer's errors in relation to the assessment of the similarity of goods fell into two categories.
26. Firstly, that on the basis that '*four of the six factors*' identified by Jacob J. in British Sugar Plc v. James Robertson & Sons Ltd [1996] RPC 28 were found by the Hearing Officer to '*match*' was sufficient in and of itself for a finding of similarity resulting in a likelihood of confusion.
27. Secondly, that herbicides and insecticides share a purpose and are therefore similar or complementary. In that connection it was emphasised on behalf of Syngenta that although herbicides kill unwanted plants and insecticides kill unwanted insects the aim of both products is the same namely a garden or field with unblemished plants or crops.
28. The Hearing Officer identified the legal approach to assessing the similarity of goods in paragraphs 19 and 20 of his Decision. There is no suggestion that the Hearing

Officer miss-stated the relevant law. It is by reference to the factors, which are loosely defined in the case law, that the decision taker assesses the relatedness of the areas of trading activity involved in the comparison. It is ultimately a matter of perception.

29. The need for evidence in relation to this aspect of the objection to registration was emphasised in Case C-39/97 Canon KK v. Metro Goldwyn Mayer Inc [1998] ECR I-5507 at paragraph [22]:

It is, however, important to stress that, for the purposes of applying under Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. . . . Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar.

Such evidence is needed to substantiate the proposition that consumers of the goods or services of the kind in issue would be likely to see a link between them and attribute responsibility for their quality to a single undertaking or economically linked undertakings if they were marketed under the same or similar trade marks.

30. In the present case the evidence that was filed on behalf of Syngenta was solely directed to evidence of use. There was no evidence before the Hearing Officer directed to the issue of the similarity of the goods and/or the issue of whether the goods were complimentary. The Hearing Officer therefore reached his conclusions without the benefit of any evidence as to the similarity between and/or the complementary nature of herbicides and insecticides.
31. In my view the submission that on the basis that ‘*four of the six factors*’ identified by Jacob J. in British Sugar Plc v. James Robertson & Sons Ltd [1996] RPC 28 were found by the Hearing Officer to ‘*match*’ was sufficient in and of itself for a finding of similarity is not the correct approach. The factors identified by Jacob J. are not exhaustive but are factors that may be taken into account. Further as stated in paragraph [23] of Case C-39/97 Canon ‘*In assessing the similarity of the goods or services concerned . . . all relevant factors relating to those goods and services themselves should be taken into account. Those factors include, inter alia, their*

nature, their end users and their method of use and whether they are in competition with each other or are complementary'. Such relevant factors are to be given appropriate weight by the decision taker when making the overall assessment of similarity which is, as stated above, ultimately a matter of perception.

32. In the instant case, it is clear that the Hearing Officer took into account a variety of different factors in reaching his conclusion on similarity of goods. It is also apparent that whilst he recognised there were some similarities between the goods overall he did not regard the goods to be similar or complementary. These findings were based on the Hearing Officer's view that the goods in question had specific uses which were entirely different from one another; that they were not indispensable or important for the use of one another; and that the goods were not in competition. There was undoubtedly room for more than one view as to what the answer to the question should be on approaching it from the perspective identified in the preceding paragraph. However, in the absence of any evidence, it is my view that these were findings that the Hearing Officer was entitled to make. It is also my view that, in the circumstances of the present case, the fact that at some general level the goods can be said to have the same general purpose does not in any way detract from the Hearing Officers findings.
33. The evaluation of '*similarity*', both as between marks and as between goods and services is a means to an end. As Geoffrey Hobbs Q.C. sitting as the Appointed Person said in paragraph Home-Tek International Ltd's Trade Mark Applications (O-144-05) at paragraph [21] it is necessary for the decision taker making an assessment under Section 5(2)(b) of the 1994 Act to enquire whether:

X times Y equals Z

where X is the degree of similarity between the marks in issue,
Y is the degree of similarity between the goods or services in
issue and Z is the existence of a likelihood of confusion.

Mr Hobbs went on to state in the same Decision as follows at paragraph [22]:

In essence, a claim for protection under sub-paragraph (b) raises a single composite question: are there similarities (in terms of marks and goods or services) that would combine to give rise to a likelihood of confusion in the event of concurrent use of the marks in issue in relation to goods or services of the kind specified? The question falls to be determined from the view point of the average

consumer of the goods or services concerned. The average consumer is for this purpose deemed to be reasonably well-informed and reasonably observant and circumspect. Since it is not possible for similarities between marks to eliminate differences between goods/services or for similarities between goods/services to eliminate differences between marks, the purpose of the assessment must be to determine the net effect of the given similarities and differences. These must be given as much or as little significance as the average consumer would have attached to them at the date as of which the relative rights of the parties fall to be determined.

34. The single composite question requires a realistic appraisal of the net effect of the similarities and differences between the marks and the goods or services in issue from the perspective of the average consumer (who is taken to be reasonably well-informed and reasonably observant and circumspect) to be made.
35. This approach does not prevent a finding of ‘*no likelihood of confusion*’ by reason of ‘*no similarity*’ between the goods or services in issue but will, in most cases, require the degree of dissimilarity to be a factor that is to be taken into account as part of the global assessment.
36. In paragraph 29 of his Decision the Hearing Officer expressly stated that in making his assessment of the likelihood of confusion he must take into account the interdependency principle which he went on to correctly summarise. The Hearing Officer made that statement in a context in which he made clear that he should take into account all the factors that he had already identified and made findings upon in his Decision.
37. In such circumstances, it is important to observe the distinction (as set out in paragraphs 20 and 21 above) between on the one hand making a decision at first instance and on the other hand determining on appeal whether it was open for the decision taker at first instance to arrive at the decision he did on a correct application of the law to the matter in dispute.
38. The Hearing Officer addressed himself to the assessment that he was required to make from the correct legal perspective. He did not, when forming his view, take immaterial factors into account or disregard any material factors. He concentrated on the impact of the dissimilarity of the goods, the degree of visual and aural similarity

of the marks and the dissimilarity in the conceptual meaning of the marks. I do not consider that on balancing the factors the Hearing Officer identified in the way he did, he came to a conclusion that was not open to him.

Conclusion

39. In the circumstances it does not seem to me that Syngenta has identified any material error of principle in the Hearing Officer's analysis or that the Hearing Officer was plainly wrong. In the result the appeal fails.

40. Neither side has asked for any special order as to costs. Since the appeal has been unsuccessful Sumitomo is entitled to its costs. I order that Syngenta pay a contribution towards Sumitomo's costs of £1000, to be paid within 14 days of the date of this decision, together with the £700 costs awarded by the Hearing Officer below.

Emma Himsworth Q.C.

16 July 2014

Mr. Stuart Baran (instructed by Murgitroyd & Company) appeared on behalf of Syngenta Limited

Mr. Thomas St Quintin (instructed by Marks & Clerk) appeared on behalf of Sumitomo Chemical Company Limited

The Registrar was not represented at the hearing and took no part in the Appeal