

O-179-13

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2597646  
BY SUMITOMO CHEMICAL COMPANY LIMITED  
TO REGISTER THE TRADE MARK  
FORGE  
IN CLASS 5  
AND**

**IN THE MATTER OF OPPOSITION  
THERE TO UNDER No. 102821 BY  
SYNGENTA LIMITED**

**BACKGROUND**

1) On 12 October 2011, Sumitomo Chemical Company Limited (hereinafter the applicant) applied to register the trade mark FORCE in respect of the following goods in Class 5: Herbicides, fungicides, insecticides, and preparations for killing weeds and destroying vermin.

2) The application was examined and accepted, and subsequently published for opposition purposes on 4 November 2011 in Trade Marks Journal No.6912. On 16 January 2013 the applicant filed a TM21 restricting its application to just “Herbicides”.

3) On 30 December 2011 Syngenta Limited (hereinafter the opponent) filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade mark:

| Mark  | Number         | Date of application / date of registration | Class | Specification  |
|-------|----------------|--|-------|--|
| FORCE | CTM<br>2972040 | 12 December 2002<br>21 December 2004       | 1     | Chemicals used in agriculture, horticulture and forestry; seed treatment preparations. |
|       |                |  | 5     | Insecticides, fungicides, herbicides.  |

b) The opponent contends that the mark in suit is similar to its mark differing only in one letter. They note that the letters which are different (“C” and “G”) look very similar. They claim that the goods of the two parties are similar or identical. The mark in suit therefore offends against Section 5(2)(b) of the Act.

4) On 6 March 2012, the applicant filed a counterstatement denying that the marks are similar. They also put the opponent to proof of use of its mark.

5) Only the opponent filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard, nor did they provide written submissions.

**OPPONENT’S EVIDENCE**

6) The opponent filed two witness statements. The first, dated 24 September 2012, is by Alice Davies their Trade Mark Attorney. She states that the evidence she provides is based on her knowledge gained from dealing with this case and also from the records to which she has access. She states that the opponent has sold its insecticide in a number of European countries. In attached exhibits AD1 she provides examples of labelling used for packaging in France and sales literature from Hungary. As neither of the documents has been translated I cannot be certain of the goods but the mark FORCE is apparent and it appears after a device element. She states that sales are made to

farmers and corporate land owners via a variety of channels including trade fairs, the internet or via sales personnel. She states that quantities can start from as little as 10kg.

7) The second witness statement, dated 22 November 2012, is by Joachim Hofmann a senior trade mark attorney for the Syngenta group of companies. Although employed by Syngenta International AG he has authority to act in relation to trade mark issues for the opponent. He states that the facts he presents are from his own knowledge or from the records of the opponent to which he has full access. He states that the opponent has used its mark on insecticides since 2003 in the European Community. He states that a number of insecticides are sold under the FORCE mark, and that they are sold in thirteen EU member states. He provides the following turnover and advertising figures for the EU. For reasons best known to the opponent the advertising figures are shown in Euros for some EU countries and US\$ for other EU countries.

| Year | Turnover<br>US\$ million | Advertising |        |
|------|--------------------------|-------------|--------|
|      |                          | Euros       | US \$  |
| 2006 | 8.6                      | 10,000      | 45,000 |
| 2007 | 16.4                     | 124,000     | 50,000 |
| 2008 | 29.6                     | 346,000     | 55,000 |
| 2009 | 45.3                     | 1,117,000   | 55,000 |
| 2010 | 37.1                     | 395,000     | 55,000 |
| 2011 | 29.6                     | 66,000      | 60,000 |

8) Mr Hofmann also provides the following exhibits:

- JH1: A copy of literature distributed in Italy in 2009 which shows use of the FORCE mark in respect of insecticide.
- JH2: Examples of technical leaflets which show use of the mark FORCE in respect of insecticides.
- JH3: Examples of invoices for the period 2006 -2011 in relation to Hungary and France. The mark FORCE is used clearly on these documents when describing the goods.
- JH4: Copies of advertising literature used in the EU. These all show use of the mark FORCE in relation to insecticides.

9) That concludes my summary of the evidence filed, insofar as I consider it necessary.

## **DECISION**

10) The only ground of opposition is based on section 5(2)(b) which reads:

5.-(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.”

11) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

12) The opponent is relying upon its trade mark listed in paragraph 3 above which is clearly an earlier trade mark. The applicant requested that the opponent provide proof of use. Given the interplay between the date that the opponent’s mark was registered and the date that the applicant’s mark was published it is entitled to request such proof as per The Trade Marks (Proof of Use, etc) Regulations 2004, paragraph six of which states:

“6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the

United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

13) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of its mark has been made. In the instant case the publication date of the application was 4 November 2011, therefore the relevant period for the proof of use is 5 November 2006 – 4 November 2011. The requirements for “genuine use” have been set out by the Court of Justice of the European Union (CJEU) in its judgments in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28 and by the Court of Appeal in the UK in *LABORATOIRE DE LA MER Trade Mark* [2006] FSR 5. The principles established in these judgments have been conveniently summarised by Ms Anna Carboni, sitting as the Appointed person O-371-09 *SANT AMBROEUS*:

“(a) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(b) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(c) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(d) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(i) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(ii) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(e) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(f) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

14) I must now consider the evidence filed and determine a fair specification for use in the comparison test. In determining a fair specification I take into account the approach set out by Mr Richard Arnold QC (as he was then) acting as the Appointed Person in O/262/06 (*NIRVANA*) where he said:

“58. I derive the following propositions from the case law reviewed above:

(1) The tribunal’s first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [30].

(2) Next the tribunal must arrive at a fair specification having regard to the use made: *Decon v Fred Baker* at [23]; *Thomson v Norwegian* at [31].

(3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording: *MINERVA* at 738; *Decon v Fred Baker* at [21]; *Thomson v Norwegian* at [29].

(4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [29]; *ANIMAL* at [20].

(5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used: *Thomson v Norwegian* at [31]; *West v Fuller* at [53].

(6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: *ANIMAL* at [20].

(7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: *West v Fuller* at [58]; *ANIMAL* at [20].

(8) The exercise of framing a fair specification is a value judgment: *ANIMAL* at [20].”

15) 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 its mark is registered. To my mind, the only specification possible is: Insecticides.

16) When considering the issues under Section 5(2) and the likelihood of confusion, I take into account the guidance from the settled case law provided by the CJEU in *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 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade*

*Marks and Designs*) (OHIM) C-334/05 P (LIMONCELLO). In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

(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/ 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; 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;

(e) 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 in that mark;

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

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

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

(i) 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;



(j) 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.

### **Distinctive character of the opponent's earlier trade mark**

17) The opponent has provided evidence of use of its mark in the EU. However, whilst it has provided turnover figures and advertising figures for the EU it has not put either into context. There is no information regarding market share, no evidence from the trade or from farming representatives. It cannot therefore benefit from an enhanced reputation. However, I consider it to have a reasonable degree of inherent distinctiveness for the goods for which it is registered.

### **The average consumer and the nature of the purchasing process**

18) I must now determine the average consumer for the goods of the parties. Whilst the opponent has stated that it sells to farmers and corporate land owners, there is no restriction in either sides' specification which would prevent them selling their goods to individuals for use in their garden. Therefore the average consumer must be regarded as being both the general public and also businesses (farmers/corporate land owners and horticultural businesses). Clearly the types of chemical products covered by the specifications of both parties are heavily regulated and care must be taken in using them and also in the residue they can leave in food items. Such products inevitably carry warnings on use, and are also often highly specific in their roles. They tend to have relatively narrow effects on specific groups of insects or plants to avoid the past disasters when using very wide ranging chemicals such as DDT. Therefore, even though they could be sold in small relatively cheap quantities their selection will be made very carefully. Overall the average consumer is likely to pay a high degree of attention to the selection a chemical agent.

### **Comparison of goods**

19) The opponent's specification has been reduced due to the requirements for proof of use to insecticides, whilst the applicant has reduced its specification to herbicides. The accepted test for comparing goods is that set out by Jacob J. in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28 TREAT, which was effectively endorsed by the Advocate General in *Canon*; ETMR 1. The factors to be taken into account are:

- a) The respective uses of the respective goods;
- b) The respective users of the respective goods;
- c) The physical nature of the goods;
- d) The respective trade channels through which the goods reach the market;
- e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be found on the same or different shelves;

f) The extent to which the respective goods are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods in the same or different sectors.

20) The question of complementary goods has been considered by the CFI in *Boston Scientific Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM) Case T- 325/06 the CFI stated:

“It is true that goods are complementary if there is a close connection between them, 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 (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685 , paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057 ; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757 , paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000 , paragraph 48).”

21) 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”

**Comparison of trade marks**

22) The trade marks to be compared are as follows:

|                  |                 |
|------------------|-----------------|
| Applicant’s mark | Opponent’s mark |
| <b>FORGE</b>     | <b>FORCE</b>    |

23) It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes 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 go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

### **Distinctive and dominant components**

24) Neither mark has a dominant feature, the distinctiveness lies within the totality of the mark. I will approach the comparison of the trade marks with this in mind.

### **Visual similarity**

25) Clearly both marks consist of five letters. They both begin with the letters "FOR" and end in the letter "E". The only difference is in their fourth letter with the applicant's mark having a letter "G" and the opponent's mark a letter "C". The opponent contends that the letters "G" and "C" are visually similar and I accept this contention. To my mind, the respective marks share a reasonable level of visual similarity.

### **Aural similarity**

26) Again there is a degree of similarity as they only differ at the fourth letter. This does make a difference to the sound of the end of each word.

### **Conceptual similarity**

27) Both marks are well known English words which will be instantly recognised by any consumer. They have very different meanings. FORCE =strength, power, might energy, whereas FORGE=a place; a furnace; shaping or making; imitation/fraudulent. They have very different meanings.

28) I take into account Case T-185/02 *Claude Ruiz-Picasso v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2005] E.T.M.R. 22 where the Court stated:

"56 Such conceptual differences can in certain circumstances counteract the visual and phonetic similarities between the signs concerned. For there to be such a counteraction, at least one of the signs at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately ( BASS , [2003] E.C.R. II-0000 , [47])."

### **Likelihood of confusion**

29) 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 trade marks may be offset by a greater degree of similarity between goods and services and vice versa. 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 the 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.**

**CONCLUSION**

30) The opponent has failed under Sections 5(2)(b).

**COSTS**

31) As the applicant has been successful it is entitled to a contribution towards its costs.

|  |             |
|--|-------------|
| Preparing a statement and considering the other side's statement | £200        |
| Considering the evidence of the other side                       | £500        |
| <b>TOTAL</b>   | <b>£700</b> |

32) I order Syngenta Limited to pay Sumitomo Chemical Company Limited the sum of £700. This sum 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 1<sup>st</sup> day of May 2013**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**