

O-087-14

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2594052  
BY CARRS AGRICULTURE LIMITED  
TO REGISTER THE TRADE MARK:**

**AMINOMAX GREEN**

**IN CLASSES 5 & 31**

**AND:**

**OPPOSITION THERETO UNDER NO. 102972  
BY EVONIK DEGUSSA GMBH**

## BACKGROUND

1. On 8 September 2011, Afgritech Limited applied to register the mark shown on the cover page of this decision. Following assignment, the application now stands in the name of Carrs Agriculture Limited (“the applicant”). The application was published for opposition purposes on 4 November 2011 for the following goods:

**Class 5** - Veterinary preparations; antibiotic food supplements for animals; non-medicated food supplements for animals being minerals, trace elements and/or vitamins; preparations for use as nutritional supplements for animal foodstuffs being minerals, trace elements and/or vitamins; protein preparations for use as additives to animal foodstuffs for veterinary purposes.

**Class 31** - Animal foodstuffs; food supplements (non-medicated) for animals; non-medicated preparations for use as nutritional additives or supplements for animal foodstuffs; protein preparations for use as additives to animal foodstuffs (other than for veterinary or medical purposes).

2. The application is opposed by Evonik Degussa GmbH (“the opponent”). The opposition, which is directed against all of the goods in the application, is based upon a single ground under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon all of the goods and services in the following International Registration designating the European Union:

No. 1041517 for the mark: **AMINORED** which was applied for on 10 April 2010 (claiming an international priority date of 8 December 2009 from Germany) and for which protection was granted in the EU on 11 May 2011. The mark is registered for the following goods and services:

**Class 1** - Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing agents; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.

**Class 9** - Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; electric installations for the remote control of industrial operations; batteries; apparatus for recording, transmission or reproduction of data, sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; computer software, computer programs, especially as database for amino acid analysis in feedstuffs for animal nutrition; testing

apparatus (not for medical purposes), food analysis apparatus (not for veterinary purposes).

**Class 31** - Agricultural, horticultural and forestry products and grains (not included in other classes); foodstuffs for animals, additives to fodder, not for medical purposes, malt.

**Class 41** - Education and instruction; entertainment; teaching and further education for experts in the field of feedstuff; arranging and conducting of conferences, congresses, symposiums and colloquiums, organization of exhibitions for cultural and/or educational purposes, publication of books, newspapers and periodicals; organization of exhibitions for cultural and/or educational purposes, arranging and conducting of seminars and workshops, especially for experts in field of animal nutrition.

**Class 42** - Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software, in particular computer programs, especially as database for amino acid analysis in feedstuffs for animal nutrition, computer software consultancy, technical consulting services for the animal feed industry about the use of animal feed ingredients, chemistry services; engineering services; bacteriological and/or chemical laboratory services; physics research.

In its Notice of Opposition, the opponent stated:

“The class 5 and 31 goods of the later mark are identical or similar to at least the class 31 goods of the earlier mark. The dominant parts of the later mark are the first element AMINO plus the separate element GREEN (a colour). The earlier mark consists of the element AMINO and a colour (RED). The marks are highly similar and a likelihood of confusion exists.”

3. The applicant filed a counterstatement (subsequently amended) in which the basis of the opposition is denied. In its counterstatement, the applicant states:

“2...The applicant admits that the goods in classes 5 and 31 of the application are identical or similar to the goods in class 31 of the earlier mark. However, it is denied that there is any similar (sic) between the goods and services in classes 1, 9, 41 and 42 of the earlier mark and the goods of the application.

3...The earlier trade mark consists of the single word AMINORED whereas the mark of the application consists of the two words AMINOMAX GREEN. Visually, both marks share the prefix “AMINO” but differ as to their respective endings “RED” and “MAX GREEN”. The applicant submits that there is only a small degree of visual similarity between the marks.

Aurally, the mark of the application is pronounced as “A-MI-NO-RED” whereas the mark of the application is pronounced “A-MI-NO-MAX GREEN”. Both share the same first syllables but differ as to their endings. The mark of the application is longer because of the second word “GREEN”. The applicant submits that there is only a small degree of phonetic similarity between the marks.

Conceptually, both marks begin with the prefix “AMINO” which, it is submitted, would be understood as a reference to “amino acids”. The suffix “RED” of the earlier trade mark would be commonly understood to be a colour. It is submitted that the earlier trade mark would be understood to mean “red coloured amino acids.” The suffix “MAX” of the mark of the application is a reference to a maximum amount. Further, the word GREEN is commonly used in relation to products that are environmentally or ecologically sound or beneficial. It is submitted that the mark of the application would be understood to mean “larger amounts of amino acids with ecological or environmental benefits.”

Consequently, it is submitted that the marks are only conceptually similar to the extent that they contain the prefix “AMINO”. There, is therefore, only a small degree of conceptual similarity.

4. The similarities between the marks arise from the shared prefix “AMINO”. However, as this would be understood to be a reference to amino acids, which are the building blocks of protein important for cell function and, therefore, a preferable foodstuff. As the application has been filed in relation to animal foodstuffs and supplements for which amino acids would be an important ingredient, it is submitted that the prefix “AMINO” would be considered to be a weak element for the goods against which the opposition is directed. The average consumer would pay greater attention to the distinctive elements of the mark. Consequently, the impact on the average consumer of the “AMINO” element of the marks would be limited when assessing the likelihood of confusion.

5. It is submitted that taking this into account that the average consumer would pay greater attention to the distinctive elements of the mark. As the distinctive element of the mark are very different, the applicant submits that there would be no likelihood of confusion on the part of the average consumer...”

4. No evidence or submissions were filed during the evidence rounds. Whilst neither party asked to be heard, both filed submissions in lieu of attendance at a hearing; I will bear these submissions in mind and refer to them as necessary below.

## **DECISION**

5. Section 5(2)(b) of the Act reads:

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

(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, or

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

6. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

7. In these proceedings, the opponent is relying upon the mark shown in paragraph 2 above, which constitutes an earlier trade mark under the above provisions. Given the interplay between the date on which the application was published and the date on which protection of the earlier mark in the EU was granted, the earlier trade mark is not subject to proof of use as per section 6A of the Act.

### **Section 5(2)(b) – case law**

8. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* -BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

### **The CJEU cases**

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; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v

## The principles

“(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.”

### **Relevance of decisions at the OHIM**

9. Attached to the applicant’s submissions, is a copy of an OHIM decision (dated 22 May 2013) in which the mark upon which the opponent relies in these proceedings was the subject of a cancellation action by Afgri Operations Limited. That action, which was based upon registration of the earlier mark AMINOMAX in class 31, failed. In addition, in its submissions, the opponent states:

“4.5 We note that in parallel proceedings [in a decision dated 12 September 2013] OHIM rejected the opponent’s opposition against [an application for the mark AMINOMAX GREEN] based on the same earlier mark [in these proceedings i.e. AMINORED].

However, the opponent has lodged an appeal...and so this opposition decision is suspended. The Trade Marks Registry is certainly not bound by this appealed opposition decision from OHIM.”

10. I have reviewed these decisions, and will approach them on the basis outlined by the Appointed Person, Mr Geoffrey Hobbs QC, in *Zurich Private Banking* (BL 0/201/04) i.e.

“Finally, it must be appreciated that all assertions of inconsistency between acceptances and refusals within a national Registry and all assertions of inconsistency between acceptances and refusals in different registries are, by their very nature, question-begging as to the correctness of each of the various acceptances and refusals that are brought into contention.

However, the position as between different national registries and the Community Trade Marks Office is that they are not competent to adjudicate on the correctness of each other’s determinations and, as a corollary of that, not required to treat each other’s determinations as binding upon them in the independent exercise of their own powers. That is not to say that each of them should or will simply ignore determinations of the others. The general principle is that each of them should give determinations of the others such weight (if any) as they might fairly and properly be said to bear in the decision-taking processes they are required to under undertake independently of one another.”

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

11. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and then to determine the manner in which these goods will be selected by the average consumer in the course of

trade. In its submissions, the opponent indicates that it is now only relying upon its goods in class 31, therefore, the goods at issue in these proceedings are: veterinary preparations, animal foodstuffs, food supplements and food additives for animals. In its submissions, the opponent states:

“4.3 – The class 5 and 31 goods of the later mark include products offered to the general public, as well as a more specialised public...It is clear that the relevant public does include the general public, and that the goods are not expensive, and so a normal level of attentiveness to the marks should be assumed.”

In its submissions the applicant states:

“20...As a general rule, the goods of the application are directed to veterinarians, farmers and the general public, namely consumers who have animals, whether in domestic or commercial situations, and those who treat animals. The goods of the application would be available from supermarkets, retail outlets specialised in animals and animal related products, agricultural retailers and veterinary suppliers...

“22. In the present case, the goods for which the application has been filed fall into a number of different categories for which the average consumer is likely to be different. As identified above, the consumers of the goods of the application would consist of veterinarians, farmers and the general public. The “veterinary preparations, antibiotic food supplements for animals, protein preparations for use as additives to animal food stuffs for veterinary purposes” in class 5 of the application will be aimed at veterinarians. Such consumers are likely to pay a high degree of attention to the treatments that they are purchasing or administering as a consequence of using the incorrect treatment could have adverse effects on the animal being treated or, ultimately, lead to the death of the animal. As such, the consumer of such goods is likely to pay a higher than average degree of attention to the trade marks for these products.

In relation to the remaining goods in classes 5 and 31 of the application, these would generally be purchased by farmers or the general public. However, this does not mean that the average consumer would not pay, at least an average degree of attention to the goods being purchased. Animal feeds and supplements, particularly those for commercial agriculture, are important purchases for farmers as the incorrect feed or supplement can affect dramatically the yield of a herd. Farmers also tend to be acutely aware of the commercial considerations that their businesses face when making decisions regarding the purchasing of products such as animal feeds and supplements. Consequently, a farmer is likely to pay close attention to the feed products that are being purchased. Further, in domestic settings, the average consumer will want to purchase animal feeds and supplements that their animals (usually pets) enjoy eating and which do not disagree with the animal. Consequently, the general



public is still likely to pay a reasonable degree of attention to the animal feeds and supplements that they are purchasing for their pets.”

12. From the respective submissions, it is clear that the parties agree that the goods at issue in these proceedings will be aimed at either a member of the general public or a more specialised consumer. I agree that the average consumer of the goods at issue will, most likely, fall into the categories the applicant has identified i.e. veterinarians, famers and the general public. I also agree with the applicant that the goods will be available from “supermarkets, retail outlets specialised in animals and animal related products, agricultural retailers and veterinary suppliers”. As the average consumer is, I think, most likely to select the goods at issue from either a shelf (in the real world) or from the pages of a catalogue or website, visual considerations are most likely to dominate the selection process. That said, as the average consumer may (where circumstances allow) seek guidance before selecting a particular product, aural considerations are also likely to play their part. As to the degree of care taken during the selection process, insofar as a member of the general public is concerned, the parties appear to have reached much the same conclusion i.e. the opponent thinks that a member of the general public will pay “a normal level of attentiveness”, whereas the applicant pitches the level at a “reasonable degree of attention”. I agree with that assessment, as I do with the applicant’s submissions in relation to the differing degrees of attention that will be paid by veterinarians and those such as farmers buying for commercial purposes i.e. a “higher than average” level of attention.

**Comparison of goods**

13. The goods to be compared are as follows:

<b>The opponent’s goods</b>	<b>The applicant’s goods</b>
<p><b>Class 31</b> - Agricultural, horticultural and forestry products and grains (not included in other classes); foodstuffs for animals, additives to fodder, not for medical purposes, malt.</p>	<p><b>Class 5</b> - Veterinary preparations; antibiotic food supplements for animals; non-medicated food supplements for animals being minerals, trace elements and/or vitamins; preparations for use as nutritional supplements for animal foodstuffs being minerals, trace elements and/or vitamins; protein preparations for use as additives to animal foodstuffs for veterinary purposes.</p> <p><b>Class 31</b> - Animal foodstuffs; food supplements (non-medicated) for animals; non-medicated preparations for use as nutritional additives or supplements for animal foodstuffs; protein preparations for use as additives to animal foodstuffs (other</p>

than for veterinary or medical purposes).
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14. In its submissions, the applicant restates its position in relation to the competing goods in the following terms:

“13. The applicant admitted in its defence and counterstatement that the goods in class 5 and 31 of the application are identical or similar to the goods in class 31 of the earlier trade mark.”

15. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services 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 or services 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 or services in the same or different sectors.

16. In reaching a conclusion, I will also keep in mind the decision of the GC in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) case T-133/05 i.e.

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-

110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

17. Whilst the applicant admits that its goods are identical or similar to the goods in class 31 of the earlier mark, as it does not identify which goods it considers to be identical, nor in relation to the goods it considers to be similar the degree of similarity, it remains necessary for me to make an assessment in this regard. “Animal foodstuffs” in class 31 of the application are identical to “foodstuffs for animals” in the earlier mark. As “food supplements (non-medicated) for animals; non-medicated preparations for use as nutritional additives or supplements for animal foodstuffs; protein preparations for use as additives to animal foodstuffs (other than for veterinary or medical purposes)” in class 31 of the application would, in my view, all be encompassed by either or both of the phrases: “foodstuffs for animals”, “additives to fodder, not for medical purposes” in class 31 of the earlier mark, these goods are identical on the principle outlined in *Meric*. Insofar as the goods in class 5 of the application are concerned, as these are all (or could be) food supplements or additives for animal foodstuffs, the similarity in their nature, intended purpose, method of use, users and the trade channels through which they are likely to reach the market, leads me to conclude that they are highly similar to “foodstuffs for animals” and “additives to fodder, not for medical purposes” in class 31 of the earlier mark.

### **Comparison of marks**

18. The competing marks are as follows:

Opponent’s mark: **AMINORED** Applicant’s mark: **AMINOMAX GREEN**

19. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives marks as a whole and does not pause to analyse their various details. In addition, he 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. In reaching a conclusion on similarity I must compare the respective marks from the visual, aural and conceptual perspectives identifying, where appropriate, what I consider to be the distinctive and dominant elements of the respective marks.

In its submissions, the opponent states:

“4.1 Although a scientist might question whether the element AMINO in the marks alluded to “amino acids” and might wonder if the element is in any way descriptive of the goods (which include animal foodstuffs), it is clear that ordinary members of the public (e.g. farm labourers) would see no connection between the [marks at issue] and amino acids. It is certainly not common knowledge that foodstuffs or food supplements have anything to do with amino acids and the average consumer could not answer the question “what is an amino acid? It is

fanciful to suppose that the element AMINO in both marks is descriptive in the mind of the average consumer...”

In its submissions, the applicant states:

“29... As mentioned above, the word AMINO will be perceived by the average consumer as referring to amino acids. It is widely recognised that amino acids are the building blocks of protein and that protein is important for cell function and is, therefore a preferable food. Bearing in mind the goods of the application consists of veterinary preparations, food stuffs for animals and food supplements, it is submitted that the word AMINO has a low level of distinctiveness in relation to these goods...”

20. The opponent’s mark consists of the word AMINORED presented in upper case. The applicant’s mark consists of two separate words also presented in upper case. The positioning of the word AMINOMAX as the first word in the applicant’s mark makes it a more dominant element than the word GREEN which follows it. I have no evidence to assist me on how the various average consumers identified above will approach the competing marks. Whilst I accept that veterinarians and specialist users such as farmers etc. are likely to be familiar with the term amino acid and its significance in relation to foodstuffs and diet, as none of the goods in either parties’ specifications are limited by reference to a specialist end user, it is from the perspective of a member of the general public that I must consider the matter (I will return to this point later in this decision when I consider the likelihood of confusion).

21. In my view, it is possible that a member of the general public will have heard of the term “amino acid”. As a consequence, it is possible that they will identify that the opponent’s mark and the first element of the applicant’s mark break down into two elements i.e. AMINO and RED and AMINO and MAX. The fact that the average consumer will be very familiar with the words RED and MAX point to the same conclusion. While the word RED in the opponent’s mark will be well known to the average consumer as a colour, there is no evidence to suggest that it is a descriptive or non-distinctive element. Given the manner in which the opponent’s mark is presented (i.e. as a unified whole), there are, in my view, no dominant or distinctive elements; the distinctiveness of the opponent’s mark lies in the mark as a whole. The words MAX and GREEN in the applicant’s mark will be well known to the average consumer as a reference to maximum and to both a colour and to goods which are environmentally friendly or beneficial. However, given the integrated nature of its presentation, the first element of the applicant’s mark does not, in my view, contain any distinctive or dominant elements, the distinctiveness, once again, lying in the first element as a totality. Given its positioning as the second element of the applicant’s mark and its descriptive credentials mentioned above, the word GREEN is neither a dominant nor distinctive element of its mark.

22. Returning to the word AMINO, even if a member of the general public identifies the word AMINO as an element of the competing marks, I very much doubt that they would

be able to answer the opponent's question posed above i.e. "what is an amino acid? I certainly would not. Consequently, whilst the word AMINO in the competing marks may be recognised by the average consumer, as they are, in my view, unlikely to attribute any concrete meaning to this word, is it likely, to convey to them origin rather than descriptive connotations. In its submissions, the applicant states:

"28. In summary, the applicant accepts that the earlier trade mark and the mark the subject of the application are similar to the extent that they coincide with the prefix AMINO. They do, however, differ by their respective endings which makes the marks visually, phonetically and conceptually quite different."

23. Whilst the opponent's mark contains the additional word RED and the applicant's mark the additional word MAX and the additional and separate word GREEN, the presence in both parties' marks of the word AMINO as the first part of each mark results, in my view, in a reasonable degree of visual similarity between them. Although the opponent's mark consists of four syllables i.e. A-MI-NO-RED and the applicant's mark five syllables i.e. A-MI-NO-MAX GREEN, the fact that the first three syllables of each mark is the same, results, once again, in my view, in a reasonable degree of aural similarity between them. Considered from the perspective of the average consumer I have identified above who will not, in my view, have a concrete understanding of the word AMINO, the competing marks are, I think, unlikely to convey any concrete meaning; in those circumstances, the conceptual position is neutral.

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

24. I must now assess the distinctive character of the earlier mark. The distinctive character of a mark can be appraised only, first, by reference to the goods for which it is registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

25. As the opponent has not filed any evidence in these proceedings I have only the inherent characteristics of its mark to consider. In its submissions, the opponent states:

"The earlier mark has a high degree of inherent distinctiveness because AMINORED is an invented word.

In its submissions, the applicant states:

"31...The applicant submits that the earlier trade mark has only a low level of distinctiveness in relation to the goods in class 31 for which it is registered as it

would be understood to mean either red-coloured amino acids or a reduced level of amino acids. As both meanings describe possible characteristics of goods in class 31, the earlier trade mark can only have a low level of distinctiveness for these goods...”

26. I have already concluded that even if the average consumer identifies that the earlier mark contains the word AMINO, as they are unlikely to be familiar with the meaning of this word, it is more likely than not to send to them an origin message. However, even if the average consumer has heard of the term amino acids and is familiar with the word AMINO and its meaning, there is no evidence to indicate that when this word is combined with the word RED, the resultant whole is either descriptive of or non-distinctive for the goods in class 31 upon which the opponent relies (there is, for example, no evidence that there is such a thing as a red or reduced amino acid). As a consequence, the earlier mark is, in my view, possessed of (at least) a normal degree of inherent distinctive character.

### **Likelihood of confusion**

27. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to factor in the distinctive character of the earlier mark as the more distinctive this mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

28. I note that in *Adelphoi Limited v DC Comics* (a general partnership) BL O/440/13, Professor Annand, sitting as the appointed person stated:

“21. As for the services, e.g., broadcasting, whilst I agree with Mr. Malynicz that the average consumer would include business consumers or professionals as well as the general public, the likelihood of confusion must be assessed in relation to the part of the public whose attention is lower (see e.g., Case T-448/11, *Golden Balls Ltd v. OHIM*, 16 September 2013, para. 26), although in any event, the Hearing Officer relied on an average consumer (reasonably well informed and reasonably circumspect and observant) paying an average level of attention (para. 41).”

29. Earlier in this decision I concluded that: (i) whilst the average consumer of the goods at issue fell into a number of categories, as neither parties’ specifications are limited in any way, the position must be determined from the perspective of a member of the general public, (ii) the competing goods are identical or highly similar, (iii) even if the average consumer has heard of the term “amino acid”, as they are, in my view, unlikely

to known its meaning, the word AMINO in the competing marks is likely to convey to them an origin message, (iv) the competing marks are visually and aurally similar to a reasonable degree and conceptually neutral, and (v) the earlier mark is possessed of (at least) a normal degree of inherent distinctive character.

30. Given the differences in the competing marks, I think it most unlikely that a member of the general public paying a normal/reasonable level of attention during the selection process will mistake one trade mark for the other i.e. there will be no direct confusion. However, I have already concluded that the average consumer is more likely than not to attribute to the word AMINO an origin significance. That being the case, notwithstanding the presence of the word MAX in the first element of the applicant's mark, as the word AMINO in the opponent's mark is accompanied by a colour i.e. RED and as it is also accompanied in the applicant's mark by a colour i.e. GREEN (notwithstanding that the word GREEN is descriptive/lacks distinctive character), the totalities each mark creates, is likely, in, my view, to lead the average consumer to assume that the identical and highly similar goods at issue in these proceedings originate from undertakings which are economically linked i.e. there will be indirect confusion.

## **Conclusion**

**31. The opposition based upon section 5(2)(b) of the Act succeeds.**

## **Costs**

32. As the opponent has been successful it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. In its submissions, the applicant states:

“34...In making its award of costs, the applicant requests that the office take into account the additional costs to which the applicant has been put due to the opponent's decision to challenge the amendment of the applicant's defence and counterstatement and the opponent's reliance upon the goods in classes 1, 9, 41 and 42 of the earlier trade mark that are clearly very different from the goods of the application.”

33. Insofar as the applicant's first point is concerned, I note that in a letter dated 23 July 2013, the applicant sought leave to amend its counterstatement to reflect the fact that its request before OHIM to cancel the earlier mark upon which the opponent relies in these proceedings had failed. In an official letter dated 2 August 2013, the Tribunal expressed a preliminary view that this amendment should be allowed. In a letter dated 15 August 2013, the opponent challenged that view and asked to be heard. At an interlocutory hearing held on 12 September 2013, the hearing officer maintained the Tribunal's preliminary view. In relation to costs, she said:

“11. On the matter of costs, the opponent submitted that there should not be a cost award. The applicant submitted that costs should be awarded on the official

scale. Costs in respect of the hearing today will be carried over to form part of the considerations of costs by the hearing officer dealing with the substantive decision.”

34. When the applicant filed its original counterstatement, it ought, in the event that its request for cancellation failed, to have included the fall-back position which it subsequently sought to rely upon in its amended defence. However, in line with the Tribunal’s published guidance on amendments to pleadings, it can have come as no surprise to the opponent that the preliminary view was to allow the amendment. For the opponent to then request a hearing in those circumstances was, in my view, unrealistic. As indicated above, while I think the applicant was at fault, the opponent’s objection was, in the face of the Tribunal’s published position on amendments, unrealistic. As a consequence, I make no award of costs in respect of the interlocutory hearing.

35. Turning to the second point, in its Notice of Opposition the opponent indicated that it was relying upon all of the goods and services in its registration. However, later in the Notice when asked if it wished to provide “further information”, the opponent comments that the applicant’s goods are identical or similar to “at least” its goods in class 31. In its amended counterstatement, the applicant admitted that its goods in classes 5 and 31 were identical or similar to the opponent’s goods in class 31. Although the opponent did not at that point limit its opposition to rely only upon its goods in class 31, in its submissions, it noted the applicant’s concession and made no further submissions on the point. Although the applicant made detailed submissions on the additional classes initially relied upon by the opponent, given the manner in which the opponent pleaded its case and as the additional classes (even if identical or similar) could not have put the opponent in any better position, it appears to me that this additional effort on the applicant’s part was unnecessary. As a consequence, I do not intend to make any reduction to the award I would otherwise have made to the opponent. Using the TPN mentioned above as a guide, I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant’s statement:	£200
Written submissions:	£300
Opposition fee:	£200
<b>Total:</b>	<b>£700</b>



36. I order Carrs Agriculture Limited to pay to Evonik Degussa GmbH the sum of **£700**. 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 26th February 2014**

**C J BOWEN  
For the Registrar  
The Comptroller-General**