

O-013-10

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2488809

BY

APM

TO REGISTER THE TRADE MARK:

AGRIFORCE

IN CLASSES 1, 2, 3, 4, 6, 8, 9, 11, 16, 21 AND 25

AND

THE OPPOSITION THERETO

UNDER NO 98000

BY

THE PREMIERE POLISH COMPANY LIMITED

Trade Marks Act 1994

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by APM
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under no 98000
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BACKGROUND

1) On 29 May 2008 APM applied to register the trade mark AGRIFORCE in classes 1, 2, 3, 4, 6, 8, 9, 11, 16, 21 and 25. The application was published for opposition purposes on 4 July 2008. On 1 October 2008 The Premiere Polish Company Limited (Premiere) filed a notice of opposition against some of the goods of the application, namely:

cleaning, polishing, scouring and abrasive preparations; solvent cleaners for removing grease; abrasives; automotive care products;

penetrating oils;

paper wipes; paper for cleaning purposes;

dispensers for detergents.

The above goods are in classes 3, 4, 16 and 21 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) Premiere bases its opposition on sections 5(2)b) and 5(4)(a) of the Trade Marks Act 1994 (the Act). Section 5(2)(b) of the Act states:

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

Section 5(4)(a) of the Trade Marks Act 1994 (the Act):

“4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented——

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade”.

The principles of the law of passing-off were summarised by Lord Oliver in *Reckitt & Colman Products Ltd v. Borden Inc* [1990] RPC 341 at page 406:

“The law of passing off can be summarised in one short, general proposition: no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. ... Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

3) The opposition under section 5(2)(b) of the Act is based on Community registration no 2920965 for the trade mark FORCE. The trade mark is registered for:

preparations and substances all for laundry use; cleaning, polishing, scouring, descaling, and abrasive preparations; soaps; turpentine substitute; paint or polish stripping preparations and substances; water closet colouring materials; antistatic preparations and substances; and rinse additives.

The above goods are in class 3 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. The application for the registration of the trade mark was filed on 7 November 2002 and the registration process was completed on 6 October 2004. Consequently, the trade mark is an earlier trade mark and is not subject to the proof of use

requirements. Premiere states that the opposed class 3 goods of the application all fall within the parameters of the specification of its registration. It states that the other opposed goods have a cleaning function and are, therefore, similar. Premiere states that APM's trade mark consists of the descriptive combining form AGRI, meaning related to agriculture, and its distinctive trade mark FORCE. It states that the dominant part of the trade mark must be FORCE. Premiere states that the likelihood of confusion is emphasised by the use shown on an extract from the website wildcatpestcontrol.com. This use shows, inter alia, the AGRI element of the trade mark in green and the force element of the trade mark in white. Premiere states that the address given for Agriforce is the same as APM and that APM is the owner of the trade mark WILDCAT, which is the specific product promoted in the extract. Premiere states that the usage shown of AGRIFORCE is within the ambit of the trade mark the subject of the application. It states that the use shown emphasizes the FORCE part of the trade mark. Premiere states that the likelihood of confusion is increased by its use of the registered trade marks OVENFORCE and DRIVING FORCE, it claims that AGRIFORCE is likely to be seen as a member of the same family of trade marks.

4) The opposition under section 5(4)(a) is based on the earlier sign FORCE. Premiere claims that the sign has been used since 1997 in the United Kingdom in relation to cleaning and de-greasing products. Premiere states:

“There is a likelihood of confusion as set in paragraph 4 on page 4 which is damaging to the opponents reputation and will cause dilution. Further the use of the mark AGRIFORCE (see web extract) on pesticides raises damaging public health issues as pesticides and cleaning products are frequently both used by janitors and the like.”

5) APM filed a counterstatement. APM states that Premiere has suggested that APM's trade mark is a combination of a descriptive element AGRI – and a distinctive element FORCE, it does not accept this. APM submits that neither element of the trade mark AGRIFORCE is wholly descriptive nor totally distinctive but that it is the whole of the trade mark that is distinctive. APM states that AGRI has several meanings, the most common being to indicate agriculture. APM states FORCE is a well-known word indicating strength. APM states AGRIFORCE as a whole has a very distinctive overall impression that is likely to bring to mind connections with agriculture and the outdoors and something strong or powerful but which has no overall meaning. APM states that this is in contrast to the trade mark FORCE which is a well-known word and as such has limited distinctiveness. APM states that the element FORCE is very common in trade marks. APM encloses the first page from a search conducted on the Trade Marks Registry website which indicates that there are over 500 entries on registers of trade marks including the element FORCE. APM states that this indicates that this element has limited distinctiveness. Included with the counterstatement is a further search from the Trade Marks Registry website,

which indicates that there are 118 entries on the register in class 3 that include the element FORCE. APM states that this indicates that the trade mark AGRIFORCE is unlikely to be confused with the trade mark FORCE. APM states that Premiere has stated that AGRIFORCE will be seen as a member of its family of trade marks; Premiere states that owing to the large number of registrations that include the element FORCE it is not understood why AGRIFORCE would be connected with the registrations OVENFORCE and DRIVING FORCE. APM also states that the reference to these registrations is not understood as Premiere has not used them as the basis for its opposition. APM states that AGRIFORCE is not similar to FORCE and that there is not a likelihood of confusion. It states that the respective trade marks are different visually, phonetically and conceptually and that the overall impressions made by them are different.

6) Both parties filed evidence. Neither party requested a hearing. Premiere filed written submissions.

EVIDENCE

Primary evidence of Premiere

Witness statement of Roger Geoffrey Lawson-Lee

7) Mr Lawson-Lee is the company secretary of Premiere.

8) Premiere has been trading in the United Kingdom since 1924 and sells a wide range of cleaning and janitorial products as well as products for use in the catering trade. Premiere has always manufactured cleaning products and latterly cleaning machines. Premiere's products are principally designed and intended for industrial and business use, including use in offices.

9) At the beginning of 1997 Premiere developed a new cleaning formulation which was particularly effective at removing grease. It was decided to market the product under the trade mark FORCE and a United Kingdom trade mark application was made for the registration of this trade mark on 13 February 1997, the trade mark was registered on 18 December 1998. Premiere decided to produce a version of the product particularly targeted at the vehicle market under the trade mark DRIVING FORCE, an application for the registration of this trade mark in the United Kingdom was filed on 15 February 1997, the trade mark was registered on 24 October 1997. On 22 April 1997 an application for the registration of the trade marks OVEN FORCE and OVENFORCE in the United Kingdom was filed, the trade marks were registered on 4 September 1998. On 18 March 2000 an application for the registration of the trade mark FORCE CITRUS in the United Kingdom was filed, the trade mark was registered on 16 March 2001. Sales of FORCE branded products (to the nearest £1,000) have been as follows:

Late April 1997 to December 1997	£122,000
1998	£223,000
1999	£257,000
2000	£285,000
2001	£260,000
2002	£305,000
2003	£293,000
2004	£233,000
2005	£248,000
2006	£263,000
2007	£286,000
2008	£501,000

10) Mr Lawson-Lee states that Premiere has “extensively and clearly advertised or caused to be referred to, amongst its other products its FORCE branded goods in well known trade journals and magazines such as CHT – Cleaning and Hygiene Today (since at least August 1997); C&M – Cleaning and Maintenance (since at least October 1997); International Cleaning Review; and The European Cleaning Journal.” Exhibited at RLL.2 are examples of advertisements (page numbers refer to the pagination of the exhibit):

CHT – undated (pages 1-2). Advertisement for cleaning products and machines from Premiere. Canisters marked FORCE and FORCE CITRUS can be seen (advertisement 1).

European Cleaning Journal for central and eastern Europe for February 2002 (page 3). The journal does not appear to be in English. A picture of various Premiere products can be seen, a canister marked FORCE amongst them.

CHT for February 2003 (pages 4-5). Advertisement 1.

CHT – undated (page 6) (there is a reference to a 2003 catalogue launch and so it would appear likely that the publication emanates from 2002 or 2003). An advertisement for Premiere products, owing to the quality of the reproduction it is not possible to discern which specific products are being advertised.

CHT for March 2003 (pages 7 - 8). Advertisement 1.

CHT for August 1997(pages 9-10). A picture of canisters of FORCE and DRIVING FORCE can be seen.

CHT for January 2000 (pages 11-12). An advertorial for Premiere products. The writing in the body of the advertorial is illegible. A picture of a canister of FORCE can be seen.

CHT for August 1997 (pages 13-14). An advertorial for Premiere products. The writing in the body of the advertorial is illegible. A picture of a canister of FORCE can be seen.

CHT for October 1997(pages 15 -16). An advertorial for Premiere products. A picture of a canister of DRIVING FORCE is shown. The copy refers to the launch of DRIVING FORCE which is described as a “concentrated vehicle cleaner and degreaser for the commercial cleaning of lorries, vans and heavy plant equipment.”

C & M for January 1998 (pages 17 -18). An advertorial for Premiere products. A picture of a canister of FORCE is shown. FORCE is described as having “superior cleaning power on oil and grease”. FORCE is described as being “particularly suitable for use in workshops and manufacturing units, where it is second-to-none in removing accumulations of ingrained oil and grease on heavily soiled concrete floors. It also achieves excellent results in removing soot and grime following fire damage.”

Circular No 78 (page 19) – advertising activity for January and February 1998, this circular relates to advertising activity in the trade press. At page 20 a copy of an advertisement for FORCE from *CHT* for February 1998 is reproduced. FORCE is promoted as a Premiere product. It is advertised as instantly removing oil, grease and bacteria. At page 21 a copy of an advertisement for DRIVING FORCE, published in *CHT* and *C & M* in January 1998, is reproduced. DRIVING FORCE is identified as a Premier product.

CHT for July of an unidentifiable year (pages 22 and 23). The advertisement reproduced does not relate to a product that includes the word FORCE.

International Cleaning Review for May 1998 (page 24). The cover of this publication shows various Premier products, amongst which a canister of DRIVING FORCE can be seen.

C & M for February 1999 (pages 25 and 26). An advertisement shows various Premier products, amongst which a canister of DRIVING FORCE can be seen.

C & M for April 1999 for April 1999 (pages 27, 28 and 29). Two advertisements show various Premier products, amongst which a canister of DRIVING FORCE can be seen.

C & M for July/August 1999 (pages 30 and 31). An advertisement shows various Premier products, amongst which a canister of DRIVING FORCE can be seen.

An advertisement from an unknown publication which bears the handwritten number 2000 (page 32). This advertisement shows various Premiere products including a canister of FORCE.

CHT for an unknown date (pages 33 and 34). An advertorial for FORCE CITRUS appears, it is identified as a Premiere product. The copy of the advertisement reads as follows:

“New to the market, Force Citrus is Premiere’s latest introduction to compliment their successful multi-purpose cleaner, Force. Fragranced with a fresh citrus perfume, Force Citrus is an excellent heavy duty cleaner for all heavily soiled floors, including Altro and modern safety flooring.....”

CHT for July 2000 (pages 35 and 36). The advertorial for FORCE CITRUS referred to immediately above appears.

CHT for September 2000 (pages 37 and 38). An advertisement for various Premiere products shows a canister of FORCE.

CHT for November 2000 (pages 39 and 40). An advertisement for various Premiere products shows a canister of FORCE.

European Cleaning Journal for central and eastern Europe for February 2001 (page 41). An advertisement for various Premiere products shows a canister of FORCE.

CHT for September in 200? (the final year does not appear in the copy) (pages 42 and 43). An advertisement shows various Premier products, amongst which a canister of FORCE can be seen.

CHT for January 2002 (pages 44 and 45). An advertisement shows various Premier products, amongst which a canister of FORCE can be seen.

At pages 46 – 49 copies of 4 advertisements appear. There is no indication as to the publication(s) in which they appeared. Pages 47, 48 and 49 bear the handwritten dates April 2002, September 2001 and November 1997. Page 46 shows a number of Premiere products including FORCE and FORCE CITRUS. Pages 47 and 48 show a number of Premiere products including FORCE. Page 49 is an advertisement for DRIVING FORCE.

11) Mr Lawson-Lee states that Premiere distributes annual catalogues to a large part of the market. Exhibited at RLL.3 are copies of pages from the 2003 catalogue. At page 3 of the exhibit multi-purpose cleaners are shown, these include DRIVING FORCE, FORCE CITRUS and FORCE. The products are described as being designed for general cleaning of floors and hard surfaces. At page 4 further details of these three products are given. FORCE and FORCE CITRUS are both described as being heavy duty cleaners and degreasers. DRIVING FORCE is described as a concentrated vehicle cleaner and degreaser. Mr Lawson-Lee states that Premiere routinely exhibits its products. At page 1 of

exhibit RLL.4 are details of exhibitions attended by Premiere in 2002 and 2003; some 7 in 2002 and 15 in 2003.

12) Mr Lawson-Lee states that Premiere takes care to police its FORCE trade mark. He states that it has “consistently and successfully objected to many applications in Class 3 incorporating the word FORCE and has lead to either the withdrawal of such applications or their limitation to personal products, which fall outside the market of my Company’s products. By way of example in Exhibit RLL5 are pictures of a product produced by Henkel Eco Lab Limited. This was withdrawn from the market after objection by my Company.” The product referred to bears the name Force 1.

Witness statement of Victor Caddy

13) Mr Caddy is a trade mark attorney. He exhibits a copy of pages from *Chambers English Dictionary*. The reference to agri-, agribusiness etc directs the reader to look under agriculture. Agri and agro are defined as pertaining to fields, land use of agriculture. The words agribusiness and agriproduct both relating to farming appear.

Evidence of APM

Witness statement of William James Browning

14) Mr Browning is the marketing manager of APM.

15) APM has been trading since 1982, primarily supplying the agricultural sector across the south of England. Its customer base also includes those involved in ground care, steelwork, fencing, gamekeeping, recycling and leisure.

16) The trade mark AGRIFORCE was chosen by APM as “this primarily kept the desired effect of being clearly a brand with predominantly agricultural associations, but additionally the ‘force’ section galvanised the name, giving it strength and dynamism”. As of 30 June 2009 APM has spent in excess of £6,000 marketing the “Agriforce/Wildcat (pest control) brands”. This expenditure includes money spent on creating the logos, a Wildcat website, container and label designs, brochure design and printing, key rings and display banners. Since first marketing the AGRIFORCE brand in September 2008 sales of Agriforce/Wildcat branded goods have amounted to £85,692.75p. Mr Browning states that during this period APM has not been aware of any public confusion or possible association between the AGRIFORCE brand and any other product bearing the name FORCE. Mr Browning states that the policy of using the AGRIFORCE name as “the background brand” will continue across a range of products. Exhibited at WJB1 are pictures of products bearing the name AGRIFORCE; these pictures show that AGRI and FORCE are presented in different colours. Included amongst the products shown are antifreeze, engine

coolant (under the brand CoolShield), rotating lights, a diesel pump, high foaming cleaner (under the brand superclean, the APM name appears on the label), traffic film remover (under the brand autowash , the APM name appears on the label), waterless hand towels (under the brand superwipes, the APM name appears on the packaging), scrub wipes (under the brand tuffwipes) and rodent killer (under the brand wildcat st.

17) Mr Browning states that the word force is used in a wide spectrum of products in industry, including products that APM currently market in a range from a company supplying automotive cleaning products. Exhibited at WJB2 are pictures of two aerosol products. The first one is sold under the trade mark Natural Force which is described as a multi-purpose cleaner, degreaser and deodoriser. The copy relating to the product includes the following:

“Natural Force is particularly effective in all areas of industry. In food factories its foaming action makes it an excellent product for emulsifying vegetable oils and animal fats whilst its powerful degreasing action makes it ideal for using as a general degreaser on any surface in all types of industry.”

The second product is sold under the trade mark FORCE. The aerosol tin shows that the product is a cleaner for brake parts.

Further evidence of Premiere

Witness statement of Kenneth Barnes

18) Mr Barnes is the managing director of Premiere.

19) Mr Barnes states that, from his experience, the sales figures given by APM, given the wide range of areas in which it claims to be active, are at a very low level. He states that taking into account the degree of spread, the level of activity is likely to be almost invisible.

20) The rest of Mr Barnes' witness statement does not contain any evidence of fact but simply comments upon the evidence of Mr Browning.

DECISION

Decisions of the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)

21) With its submissions Premiere prayed in aid two decisions of OHIM. These relate to a cancellation action and an opposition lodged by Premiere based on its trade mark FORCE. APM was not involved in either case, the trade marks which Premiere was attacking were not the same as that of the current application.

There is no estoppel arising out of the cases before OHIM. I have to consider the case before me on the basis of the facts before me. I have read the cases but do not consider that they assist me.

Family of trade marks

22) Premiere prays in aid that it has a family of trade marks that include the word FORCE, thus increasing the likelihood of confusion and/or misrepresentation in relation to another trade mark that includes the word force. The European Court of Justice (ECJ) in *Il Ponte Finanziaria SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-234/06 P accepted that having a family of trade marks may be relevant in considering whether there is a likelihood of confusion:

“62 While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a ‘family’ or ‘series’ of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a ‘family’ or ‘series’ of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a ‘family’ or ‘series’, the earlier trade marks which are part of that ‘family’ or ‘series’ must be present on the market.”

23) There has to be a “sufficient number” of trade marks that have a common element and the trade marks must be present on the market. APM argues that

the word force is used on a wide spectrum of products and by a wide range of companies and so there is no reason that force trade marks would be associated with Premiere. However, it has furnished no evidence to show such use at the date of the application for registration of its application (the material date). In relation to the two examples it gives, the subject of exhibit WJB2, there is no indication as to when the goods were put on the market, or their market penetration or whether they would have crossed into the market of Premiere's goods, so dissolving the family of trade marks. In its counterstatement APM prayed in aid the number of trade mark registrations and applications that contained the word force. It is what is happening in the market place that is of importance not what is sitting on trade mark registers, as per the judgments of Jacob J in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 and the Court of First Instance (CFI) in *Zero Industry Srl v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-400/06* and *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-135/04*. Even if the state of the register details had been formalised into evidence, it would not have had an effect on my decision. As far as the evidence goes, there is no evidence of use of trade marks containing the word force in the United Kingdom by the material date other than those of Premiere. Mr Browning states that APM did not start using its trade mark until September 2008, after the material date.

24) For a family of trade marks to have any effect the use must be in such a fashion that the relevant public will need to perceive that the goods sold under the trade mark come from the same or an economically linked undertaking; otherwise the family of trade marks can have no effect. As this case concerns a United Kingdom application it is the perception of the relevant public, at the material date, in this jurisdiction that is relevant. Use in eastern Europe is not going to affect that perception. No use of the trade marks OVEN FORCE/OVENFORCE has been shown. Before the material date use has been shown, in the United Kingdom, of the trade marks FORCE, DRIVING FORCE and FORCE CITRUS for cleaning products for industrial and/or commercial use. The figures that Mr Lawson-Lee gives give no breakdown as to turnover in relation to goods sold under the specific trade marks. Use has been shown, through the copies of advertisements exhibited, of FORCE and DRIVING FORCE since 1997 and use of FORCE CITRUS since 2000. The exhibited material does not go beyond 2003 so it is not clear what goods have been sold under which trade mark since 2003. The advertisements for the products and the labelling of the products clearly identify them as being the goods of Premiere. The products are often advertised with other products. The target public are those involved in trade and these people will certainly take cognisance of the company behind the product, especially as they are quite likely to be purchasing the product directly from the company; the contact details given in advertisements are those of Premiere. It is a deficiency that there is no specificity as to turnover in relation to specific trade marks and that there is no indicative promotional material from after 2003. DRIVING FORCE has an obvious meaning as a phrase, in FORCE

CITRUS adjective and noun are transposed, however, owing to the connection through Premiere in the promotion the relevant public had been educated into making a connection between FORCE trade marks for commercial and industrial cleaning products and Premiere *prior to the material date*. Taking into account the clear identification of the products with Premiere, the clear and obvious FORCE elements of the trade marks, the nature of the relevant public, who being commercial buyers reading specialist magazines are likely to retain a knowledge of products, Premiere has established that *prior to the material date* it had a family of trade marks, namely: FORCE, DRIVING FORCE and FORCE CITRUS. However, the absence of clarity in relation to the evidence after 2003 leaves no clear indication of the position as of 29 May 2008. A period of five years have elapsed between the evidence of use of the three trade marks and the date of application. It is not possible to ascertain what trade mark or trade marks were used at the material date, it is not possible to ascertain the pattern of use between 2003 and 2008. It could be that the use of one particular trade mark has wiped from the memory and the perception of the relevant public the use of the other trade marks for the products sold by Premiere. It could be that the absence of use of one or more of the trade marks has led to the same result. It would have been easy enough for Premiere to identify the pattern of use between 2003 and 2008, it has signally failed to do this. The burden is upon Premiere to prove its case. **Premiere has not established that *at the material date* that it had a family of trade marks.**

25) In its counterstatement APM states that the reference to the registrations of OVENFORCE and DRIVING FORCE is not understood as Premiere has not used them as the basis for its opposition. In its statement of grounds Premiere establishes that it is relying upon a family of trade marks that share the FORCE element. It would have been helpful if it had identified in its statement of case that it was relying also upon FORCE CITRUS; there is so evidence of use of OVEN FORCE/OVENFORCE. However, the evidence of Mr Lawson-Lee clearly identifies the use of the three trade marks which I have decided formed a family in 2003 but not at the material date. In relation to the likelihood of confusion, one trade mark must be compared to another, one does not make a comparison with a conglomeration of trade marks. In this case the claim of a likelihood of confusion is based upon the trade mark FORCE, it is against this trade mark that the comparison will be made in terms of similarity of trade marks and similarity of goods. However, as per the judgment of the ECJ in *Il Ponte Finanziaria SpA*, as part of the global appreciation of a likelihood of confusion the use of other trade marks containing a common element can be taken into account. There is not a requirement to rely upon these trade marks separately under section 5(2)(b) of the Act. It is difficult to see what purpose the addition of other registered trade marks would have. If an opponent has several trade marks there is likely to be one trade mark which gives it the best chance of success and in such circumstances a hearing officer is unlikely to consider other trade marks. Whether Premiere's DRIVING FORCE, OVENFORCE and FORCE CITRUS trade marks are similar to AGRIFORCE or the degree of any similarity will not be

determinative of whether FORCE is similar to AGRIFORCE and if so the degree of similarity.

26) In relation to passing-off all of the context of the use of the sign upon which Premiere relies must be taken into account; this includes the use of other signs which include the FORCE element. The question is whether, taking into account any goodwill in Premiere's business which is associated with the sign FORCE, and all the facts established by the evidence of the parties, there will be a misrepresentation and damage and use of the trade mark of APM is liable to be prevented. The context of this enquiry must take into account the use of FORCE and the use by Premiere of other signs including FORCE which have been identified with it. This enquiry must be based on the position as of the material date, as with likelihood of confusion.

Goodwill of Premiere

27) The sole earlier sign upon which Premiere relies is FORCE. A similar provision to section 5(4)(a) of the Act is to be found in Article 8(4) of Council Regulation 40/94 of December 20, 1993. This was the subject of consideration by the Court of First Instance in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07. In that judgment the CFI stated:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.”

I apply the reasoning of the CFI, *mutatis mutandis*, in relation to the Act. So the material date is the date of the application for registration, 29 May 2008. However, if there had been use of the trade marks by APM prior to the date of application this would have to be taken into account. It could establish that APM was the senior user, that there had been common law acquiescence or that the existing position should not be disturbed and so use would not be liable to be prevented by the law of passing-off¹. In this case the evidence of APM establishes that there was no use prior to the date of the filing of the application and so the aforesaid considerations are not relevant.

28) How goodwill is to be established has been dealt with in several judgmentsⁱⁱ. *Phones 4u Ltd v Phone4u.co.uk. Internet Ltd* [2007] RPC 5 establishes that one cannot just follow a formula or demand certain predetermined requirements to be met. Premiere's evidence establishes a goodwill by reference to the sign FORCE as of 2003 in relation to commercial and industrial cleaning products.

29) In his witness statement Mr Lawson-Lee refers to sales of FORCE branded goods. In the following paragraph in reference to FORCE branded goods he exhibits material that relates to goods sold under the trade marks FORCE, DRIVING FORCE and FORCE CITRUS. Consequently, the turnover figures in relation to FORCE branded goods must include goods sold under the signs DRIVING FORCE and FORCE CITRUS. There is evidence of use of FORCE in *CHT* for March 2003 (pages 7 - 8). However, there is no evidence of use of FORCE after this date and as Premiere's case is based upon the sign FORCE on its own, it must establish that at the material date it had a protectable goodwill by reference to this sign. In the absence of evidence of use of FORCE after March 2003 and in the absence of specificity in relation to the turnover figures and the signs to which they relate I cannot make an assumption that FORCE has been used after March 2003. Consequently, on the basis of the evidence, I must decide whether a residual goodwill in relation to the sign FORCE would exist as of the material date if use of FORCE on its own had ceased after March 2003.

30) The considerations relating to residual goodwill were dealt with by Pennycuik VC in *Ad-Lib Club Limited v Granville* [1971] FSR:

"In support of that statement there is cited the case of *Norman Kark Publications Ltd. v. Odhams Press Ltd.*, [1962] 1 All E.R. 636; [1962] R.P.C. 163 in which the first paragraph of the headnote reads:

"In an action to restrain the use of a magazine or newspaper title on the ground of passing off the plaintiff must establish that, at the date of the user by the defendant of which the plaintiff complains, he has a proprietary right in the goodwill of the name, viz., that the name remains distinctive of some product of his, so that the use of the name by the defendant is calculated to deceive; but a mere intention on the part of the plaintiff not to abandon a name is not enough".

Wilberforce, J. went at length into the principles underlying proprietary right in goodwill and annexation of a name to goodwill and the laws of the right to protection of a name and on the facts of that particular case he held that the plaintiff company had lost its right in respect of the name TODAY as part of the title of a magazine.

It seems to me clear on principle and on authority that where a trader ceases to carry on his business he may nonetheless retain for at any rate some period of time the goodwill attached to that business. Indeed it is

obvious. He may wish to reopen the business or he may wish to sell it. It further seems to me clear in principle and on authority that so long as he does retain the goodwill in connection with his business he must also be able to enforce his rights in respect of any name which is attached to that goodwill. It must be a question of fact and degree at what point in time a trader who has either temporarily or permanently closed down his business should be treated as no longer having any goodwill in that business or in any name attached to it which he is entitled to have protected by law.

In the present case, it is quite true that the plaintiff company has no longer carried on the business of a club, so far as I know, for five years. On the other hand, it is said that the plaintiff company on the evidence continues to be regarded as still possessing goodwill to which this name AD-LIB CLUB is attached. It does, indeed, appear firstly that the defendant must have chosen the name AD-LIB CLUB by reason of the reputation which the plaintiff company's AD-LIB acquired. He has not filed any evidence giving any other reason for the selection of that name and the inference is overwhelming that he has only selected that name because it has a reputation. In the second place, it appears from the newspaper cuttings which have been exhibited that members of the public are likely to regard the new club as a continuation of the plaintiff company's club. The two things are linked up. That is no doubt the reason why the defendant has selected this name."

In *The Law of Passing-Off* (third edition) Christopher Wadlow at 3-178 states:

"The better view is that if a business is deliberately abandoned in circumstances which are inconsistent with its ever being recommenced then the goodwill in it is destroyed unless contemporaneously assigned to a new owner. Otherwise, the goodwill in a discontinued business may continue to exist and be capable of being protected, provided the claimant intended and still intends that his former business should resume active trading. It is not necessary that the prospect should be imminent, but the mere possibility of resumption if circumstances should ever change in the claimant's favour is not enough. The claimant's intention to resume business may the more readily be believed where the original cessation was forced on him by external circumstances, but this factor is not conclusive either way."

In this case there is no issue as to the goodwill of the business of Premiere having been abandoned. The question relates to whether at the material date that goodwill is associated with the sign FORCE, without that association there can be neither misrepresentation nor damage. It is essentially a question of the reputation of FORCE rather than goodwill in its strict meaning.

31) The turnover figures in relation to goods which bear the word FORCE in some context are not enormous at an absolute level. However, the goods are specialist goods with a limited market. Promotion of goods sold under the sign FORCE on its own were made from 1997 to 2003 and so for a reasonably long period of time. Sales of goods sold under a sign that includes the word FORCE were made up to the material date. After 2003 there is no evidence to show the nature and extent of any promotion; the evidence comes to a grinding halt. In the absence of clarity in the evidence it is impossible to ascertain which FORCE trade mark(s) have been used from 2003 onwards. In the absence of such evidence it is not possible to draw a conclusion as to whether at the material date the trade mark FORCE on its own, which is the sole sign upon which Premiere relies, had a reputation. It could be, for instance, that one of the other trade marks had been used only and had totally supplanted memory of use of FORCE on its own. It is simply impossible to know. As with the issue of a family of trade marks, Premiere has to prove its case at the material date; it could have furnished evidence to make clear what the position between 2003 and 2008 was, it did not.

32) Premiere has not established that at the material date it enjoyed a goodwill by reference to the sign FORCE and so the case under section 5(4)(a) of the Act must be dismissed.

Lack of confusion

33) APM prays in aid that there have no instances of confusion in the market place and it has used its trade mark in relation to certain of the cleaning products. Lack of confusion in the market place is seldom telling in relation to likelihood of confusion as the use will seldom be for the full of gamut of goods and/or services and the trade marks will often be used with other matter or in different markets. The registrar's view of the claim of lack of confusion in the marketplace was, inter alia, the subject of Tribunal Practice Notice TPN 4/2009ⁱⁱⁱ. In this case there is no indication that the respective products have appeared in the same market place. APM identifies its market as being primarily in the agricultural sector in the south of England. There is no indication of Premier's use in a similar market. Premiere's use of various FORCE trade marks has always been clear identified to it through use of the Premiere name. There is no indication of the extent of the sale of cleaning products made by APM, these cleaning products also sell with sub-brands. The specification of Premier's registration is wider than any use demonstrated. It is also not clear when the trade mark, FORCE, was last used by Premiere. The absence of confusion in the marketplace does not tell me anything.

Actual use of APM's trade mark

34) Premiere considers that the actual use by APM of the AGRIFORCE trade mark should be taken into account, where the AGRI element is in a different

colour to the FORCE element. In *Open County Trade Mark* [2000] RPC 477 Aldous LJ stated:

“The test laid down in *Smith Hayden*, adapted in accordance with the speech of Lord Upjohn in *Bali*, is the test applicable whether the applicant has or has not used his trade mark. However, no court would be astute to believe that the way that an applicant has used his trade mark was not a normal and fair way to use it, unless the applicant submitted that it was not. It does not follow that the way that the applicant has used his trade mark is the only normal and fair manner. However in many cases actual use by an applicant can be used to make the comparison. I believe that this is such a case.”

This was a case under section 11 of the 1938 Act and so I am loath to automatically apply the reasoning to the 1994 Act.

35) The CFI has considered whether the consideration of similarity of trade marks should take into account the form a trade mark may be used in when the earlier trade mark has been registered in a standard font or the trade mark the subject of an application has been applied for in a standard font. There does not appear to be a consistent position in relation to this matter. In *Volvo Trademark Holding AB v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-434/07 the CFI stated:

“37 The applicant cannot, moreover, assert that the earlier word sign might exist in a script type comparable to that of the mark applied for. It is important to point out that the examination of the similarity of the marks at issue takes into consideration those marks in their entirety, as they have been registered or as they have been applied for. A word mark is a mark consisting entirely of letters, of words or of groups of words, written in printed characters in normal font, without any specific figurative element. The protection which results from registration of a word mark relates to the word mentioned in the application for registration and not the specific figurative or stylistic aspects which that mark might have. The graphic form which the earlier word sign might have in the future must not, therefore, be taken into account for the purposes of the examination of similarity (see to that effect, *Faber*, paragraphs 36 and 37; judgment of 13 February 2007 in Case T-353/04 *Ontex v OHIM – Curon Medical (CURON)*, not published in the ECR, paragraph 74; and judgment of 22 May 2008 in Case T-254/06 *Radio Regenbogen Hörfunk in Baden v OHIM (RadioCom)*, not published in the ECR, paragraph 43).”

In *Peek & Cloppenburg v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-386/07 the CFI held:

“27 Furthermore, the Board of Appeal was wrong to take into account the particular font used by the mark applied for in its comparison of the signs at issue. As the applicant is correct to note, since the earlier mark is a word mark, its proprietor has the right to use it in different scripts, such as, for example, a form comparable to that used by the mark applied for (see, to that effect, Case T-346/04 Sadas v OHIM – LTJ Diffusion (ARTHUR ET FELICIE) [2005] ECR II-4891, paragraph 47).”

In *Sadas SA v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-346/04 the CFI stated:

“47. Moreover, since registration of the trade mark ARTHUR ET FELICIE was sought as a word mark, nothing prevents its use in different scripts, such as, for example, a form comparable to that used by the earlier mark. As a result, the signs at issue must be considered visually similar.”

One is left with two questions:

- i. Is the use shown of APM’s trade mark an example of notional and fair use of the trade mark for which it has applied?
- ii. If so, should the notional and fair use be taken into account in comparing the trade marks?

36) The first question could be a hostage to fortune in some future revocation for non-use case. However, in the absence of any argument to the contrary, I consider that the use shown is use in a form that does not alter the distinctive character of the trade mark the subject of the application.

37) To answer in the affirmative to the second question would be not to compare the trade mark for which the application has been made but to compare the trade mark in a different form. In *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 147/03 the CFI stated:

“65 Before examining the visual, phonetic and conceptual comparison of the signs carried out by the Board of Appeal, it is necessary to reject the applicant’s argument that the Board of Appeal ought to have examined the earlier national mark not as it was registered but as it was used, by the sign reproduced in paragraph 10 above.

66 It is important to note that, under the provisions of Regulation No 40/94 governing examination of opposition to registration of a Community trade mark, the purpose of demonstrating genuine use of an earlier national mark is to provide a means for its proprietor, at the express request of the Community trade mark applicant, to furnish proof that during the period of

five years preceding the date of publication of the Community trade mark application its mark has been put to actual and genuine use on the market. In accordance with Article 15(2)(a) and Article 43(2) and (3) of Regulation No 40/94, that proof also applies where the sign used differs from the earlier mark as it was registered in elements which do not alter the distinctive character of the mark. In the absence of such demonstration, in particular if the elements used alter the distinctive character of the earlier mark, or in the absence of demonstration of justifiable grounds for lack of use, the opposition must be dismissed. Accordingly, demonstration of genuine use of an earlier mark in connection with opposition proceedings has neither the aim nor the effect of granting its proprietor protection for a sign or elements of a sign which have not been registered. Accepting the opposite argument would lead to unlawful extension of the protection enjoyed by the proprietor of an earlier mark which is the basis of an opposition to registration of a Community trade mark.

67 In this case, since the applicant registered only the earlier mark as reproduced in paragraph 5 above, which is the basis of the opposition on which the Board of Appeal was asked to rule in the contested decision, only that mark enjoys the protection accorded to earlier registered trade marks. It is therefore also that mark which, for the purposes of examination of the opposition, had to be compared with the mark applied for, as the Opposition Division and the Board of Appeal legitimately did, in respect of the goods for which the proof of genuine use had been furnished by the applicant, in this case ‘watches and watch bands or straps’ in Class 14.”

It is difficult to tally this consideration of the comparison of the earlier trade mark with the position of the CFI in *Peek & Cloppenburg* and equally that of the Court of Appeal in *Open Country*.

38) If one adopts the *Peek & Cloppenburg* approach one is no longer comparing a trade mark as registered but a plethora of potential trade marks, it is difficult to tally this with the wording of the Act and practical application. Such a position would also effectively lead, in non-use cases, not to comparing the earlier trade mark with the later trade mark but comparing it to the actual use of that earlier trade mark (in clear contradiction of *Devinlec Développement Innovation Leclerc SA*). If one adopted such a position one could end up comparing a trade mark not as registered with a trade mark, not as applied for. I prefer the *Volvo Trademark Holding AB* approach to the *Peek & Cloppenburg* approach and will compare the trade mark for which there has been an application rather than the trade mark which has been used.

Likelihood of confusion – section 5(2)(b) of the Act

Average consumer and purchasing process

39) It is necessary to consider the gamut of goods for which the earlier trade mark is registered and the gamut of goods the subject of the application. The consideration cannot be limited to the nature of the goods for which use has been demonstrated (Premiere's registration is not subject to the proof of use requirement). Premiere's products are everyday goods which are bought by the public at large as well as by specialists. They are goods that can be of low value and not bought as the result of a careful and educated decision. Such a purchase process will increase the effects of imperfect recollection. Where the goods are bought by specialists, eg for industrial cleaning, there will be a more careful and educated purchasing decision, limiting the effects of imperfect recollection.

Comparison of goods

40) The goods of the earlier registration are:

preparations and substances all for laundry use; cleaning, polishing, scouring, descaling, and abrasive preparations; soaps; turpentine substitute; paint or polish stripping preparations and substances; water closet colouring materials; antistatic preparations and substances; and rinse additives.

The goods the subject of the opposition are:

cleaning, polishing, scouring and abrasive preparations; solvent cleaners for removing grease; abrasives; automotive care products;

penetrating oils;

paper wipes; paper for cleaning purposes;

dispensers for detergents.

41) ***Cleaning, polishing, scouring and abrasive preparations; solvent cleaners for removing grease; abrasives of the application are included in the goods of the earlier registration and so are identical. Automotive care products will include such goods as cleaning and polishing preparations. 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^{iv}, consequently, automotive care products must be considered to be identical to the goods of the earlier registration.***

42) In “construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade^v”. Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaning^{vi}. Consideration should be given as to how the average consumer would view the goods or services^{vii}. The class of the goods and services in which they are placed may be relevant in determining the nature of the goods^{viii}. In assessing the similarity of goods and services it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary^{ix}. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 the CFI explained when goods were complementary:

“82 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).”

In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed^x.

43) In its submissions Premiere claims that *penetrating oils* are used not merely for lubrication but to clean and free products which have become bound together by grime and rust. Premiere argues that the goods are, therefore, by their nature cleaning products. I accept that penetrating oils, the most famous of which is probably WD40®, are used to free products that have become locked together and that they can also be used to clean eg removing the residue of adhesive labels from goods. Consequently, they have a cleaning function and so have the same purpose as many of the *cleaning preparations* of the earlier registration. The respective goods could all be in aerosol form and so have a similar nature and also be used in the same manner. If wishing to clean an item the respective goods are fungible and so in competition. Taking into account these similarities the respective users will be the same. ***Penetrating oils are similar to a high degree to cleaning preparations of the earlier registration.***

44) *Paper wipes* and *paper for cleaning purposes* all have a cleaning purpose and so serve the same purpose as *cleaning preparations*. This common purpose means that the respective goods are fungible and so in competition and also will have the same end users. *Cleaning preparations* of the earlier registration will encompass paper products that have been impregnated with a cleaning solution,

consequently, the respective goods can have the same nature and be used in the same manner. The respective goods could be found in the same area of a supermarket. ***Paper wipes and paper for cleaning purposes are similar to a high degree to cleaning preparations.***

45) Premiere has made no specific submissions as to why *dispensers for detergents* are similar to the goods of its registration. They do not have the same nature as the goods of the earlier registration. They are not fungible in any shape or form. There is no evidence to indicate if they are sold in the same areas of shops as the goods of the earlier registration or if they have the same channels of trade. This is certainly not something of which I have any knowledge. In *Canon* the ECJ stated:

“22. It is, however, important to stress that, for the purposes of applying 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. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar.”

The court required evidence of similarity to be adduced. This finding has been reiterated by the ECJ and the CFI eg in *Commercy AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-316/07*:

“43 Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan v OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27).”

The above part of the *Canon* judgment has been more recognised in the breach than in the observance in this jurisdiction. It may not always be practical to adduce evidence of similarity; it may be that the nature of the goods is so well-known that it would be a waste of effort and resources to do so; as is the case with the majority of the goods in question in this case, being everyday, household goods. I can assume that *dispensers for detergents* dispense detergent but other than this I have no knowledge of the product. Premiere's *cleaning preparations* will include *detergents* so the former goods are dependent on the latter goods, although there is no mutual dependency. In the absence of evidence I am unable to find that customers may think that the responsibility for the respective goods lies with the same undertaking. In *Assembled Investments*

(Proprietary) Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-105/05 the CFI stated:

“34 Lastly, it should be stated that there is a degree of complementarity between some articles of glassware, in particular wine glasses, carafes and decanters, on the one hand, and wine, on the other, in so far as the first group of products is intended to be used for drinking wine. However, in so far as wine may be drunk from other vessels and the articles of glassware mentioned above can be used for other purposes, that complementarity is not sufficiently pronounced for it to be accepted that, from the consumer’s point of view, the goods in question are similar within the terms of Article 8(1)(b) of Regulation No 40/94.

35 Having regard to all of the foregoing, it must be held that articles of glassware and wine are not similar goods. Consequently, there can be no likelihood of confusion between the conflicting marks and the applicant’s second plea must therefore be accepted.”

In the absence of evidence in relation to this matter the position in this case is very much on the same standing as wine glasses against wine. One set of goods is used for the other but that does not establish a degree of complementarity that gives rise to a finding of similarity. ***Dispensers for detergents are not similar to the goods of the earlier registration.***

Comparison of trade marks

46) The trade marks to be compared are:

Earlier trade mark:

Trade mark of application:

FORCE

AGRIFORCE

47) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details^{xi}. The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components^{xii}. Consequently, I must not indulge in an artificial dissection of the trade marks, although I need to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant^{xiii}. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public^{xiv}.

48) Premiere's trade mark does not lead itself to division into distinctive and dominant components, its distinctiveness and dominance lies in the trade mark as a whole. APM's trade mark naturally falls into two parts: AGRI and FORCE. AGRI will strike the average consumer as relating to agricultural and as a descriptor of FORCE. Owing to the inherent and clear descriptive nature of AGRI the distinctive and dominant component of APM's trade mark is FORCE. The distinctive and dominant component of APM's trade mark is identical phonetically, visually and conceptually as Premiere's trade mark. However, it is necessary to consider APM's trade mark in its entirety and the AGRI element is totally alien phonetically, visually and conceptually. It is a rule of the thumb that the beginning of word trade marks are more important in terms of similarity than the ends. However, this is dependent on the nature of the beginning. In this case owing to the clearly descriptive nature of AGRI I consider that it is FORCE element that is more important in terms of similarity. **The respective trade marks are similar to a high degree.**

Conclusion in relation to likelihood of confusion

49) Where I have found that the respective goods and services are not similar there cannot be a likelihood of confusion.

50) In considering whether there is a likelihood of confusion in relation to the goods that are identical or similar various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa^{xv}. In this case the respective goods are identical or where they are similar they are similar to a high degree.

51) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion^{xvi}. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public^{xvii}. 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^{xviii}. FORCE is an ordinary word of the English language. It is not descriptive or directly allusive of the characteristic of the goods for which it is registered. It might give an impression of strength but this gives rise to a nebulous conception and perception. Premiere's trade mark can clearly distinguish the products for which it is registered from those of other undertakings, it enjoys a reasonable degree of distinctiveness.

52) The ECJ in *Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) v Shaker di L Laudato & C Sas* Case C-334/05 P stated:

“41 It is important to note that, according to the case-law of the Court, in the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see order in *Matratzen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29).

42 As the Advocate General pointed out in point 21 of her Opinion, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element.”

The AGRI element has to be considered. The AGRI element will be indicative of FORCE products that are for agricultural use. Those buying products for agricultural use are not the public at large and are likely to purchase goods as a result of a careful, reasoned decision. However, owing to the common FORCE element the care and attention of the purchaser will not obviate the likelihood of confusion. This purchaser will think that the goods come from the same undertaking. The specification of the application is not limited to goods for agricultural use. The public at large knowing of the FORCE trade mark and the AGRIFORCE trade mark will still, owing to the common presence of the FORCE element, consider that the respective goods, whether for agriculture or not, will consider that the goods that are identical or similar come from the same or an economically linked undertaking. This public would just see AGRI as allusive to goods that might have been originally for agricultural use or could be of agricultural use. There is a likelihood of confusion in respect of all of the goods that are identical or similar.

53) Registration of the application is refused in respect of:

cleaning, polishing, scouring and abrasive preparations; solvent cleaners for removing grease; abrasives; automotive care products;

penetrating oils;

paper wipes; paper for cleaning purposes.

COSTS

54) Premiere having for the most part been successful is entitled towards a contribution towards its costs. I award costs upon the following basis:

Opposition fee	£200
Preparing a statement of grounds and considering the counterstatement of the applicant	£400
Preparing evidence and considering the evidence of the applicant	£400
Written submissions	£200
Total	£1,200

I order APM to pay The Premiere Polish Company Limited the sum of £1,200. 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 15 day of January 2010

**David Landau
For the Registrar
the Comptroller-General**

ⁱ See, for instance: *Croom's Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42.

ⁱⁱ *South Cone Inc v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19, *Loaded BL O/191/02, Phones 4u Ltd v Phone4u.co.uk. Internet Ltd* [2007] RPC 5 and *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat).

ⁱⁱⁱ **Trade Mark Opposition and Invalidation Proceedings - Defences**

Defences including a claim that the applicant for registration/registered proprietor has a registered trade mark that predates the trade mark upon which the attacker relies for grounds under sections 5(1) and 5(2) of the Act.

1. A number of counterstatements in opposition and invalidation actions have prayed in aid that the applicant for registration/registered proprietor has a registered trade mark (or trade mark application) for the same or a highly similar trade mark to that which is the subject of the proceedings that predates the earlier mark upon which the attacker relies.

2. Sections 5(1) and 5(2) of the Act turn upon whether the attacker has an earlier trade mark compared to the mark under attack, as defined by section 6 of the Act. Whether the applicant for registration/registered proprietor has another registered trade mark (or trade mark application) that predates the earlier mark upon which the attacker relies cannot affect the outcome of the case in relation to these grounds.

3. The position was explained by the Court of First Instance in *PepsiCo, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) T-269/02*:

“24 Nor did the applicant claim, and even less prove, that it had used its earlier German mark to obtain cancellation of the intervener’s mark before the competent national authorities, or even that it had commenced proceedings for that purpose.

25 In those circumstances, the Court notes that, quite irrespective of the question whether the applicant had adduced evidence of the existence of its earlier German mark before OHIM, the existence of that mark alone would not in any event have been sufficient reason for rejecting the opposition. The applicant would still have had to prove that it had been successful in having the intervener’s mark cancelled by the competent national authorities.

26 The validity of a national trade mark, in this case the intervener’s, may not be called in question in proceedings for registration of a Community trade mark, but only in cancellation proceedings brought in the Member State concerned (Case T-6/01 *Matratzen Concord v OHIM – Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 55). Moreover, although it is for OHIM to ascertain, on the basis of evidence which it is up to the opponent to produce, the existence of the national mark relied on in support of the opposition, it is not for it to rule on a conflict between that mark and another mark at national level, such a conflict falling within the competence of the national authorities.”

The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker’s mark

4. The viability of such a defence was considered by the Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the IPO are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker’s mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker’s mark.

Reliance on the Absence of Confusion in the Marketplace

6. Parties are also reminded that claims as to a lack of confusion in the market place will seldom have an effect on the outcome of a case under section 5(2) of the Act.

7. In *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 Laddie J held:

“22. It is frequently said by trade mark lawyers that when the proprietor’s mark and the defendant’s sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 (“the 1994 Act”), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer’s use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place.”

8. (In *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch) Warren J commented:

“99. There is a dispute between Mr Arnold and Mr Vanhegan whether the question of a likelihood of confusion is an abstract question rather than whether anyone has been confused in practice. Mr Vanhegan relies on what was said by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at paragraphs 22 to 26, especially paragraph 23. Mr Arnold says that that cannot any longer be regarded as a correct statement of the law in the light of *O2 Holdings Ltd v Hutchison 3G Ltd* [2007] RPC 16. For my part, I do not see any reason to doubt what Laddie J says....”

9. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett LJ stated:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff’s registered trade mark.”

^{iv} See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05 paragraph 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).”

The above is a translation from the French. There is no variation in the judgment in French:

“29 En outre, des produits peuvent être considérés comme identiques lorsque les produits que désigne la marque antérieure sont inclus dans une catégorie plus générale visée par la demande de marque [arrêt du Tribunal du 23 octobre 2002, Institut für Lernsysteme/OHMI – Educational Services (ELS), T 388/00, Rec. p. II 4301, point 53], ou lorsque les produits visés par la demande de marque sont inclus dans une catégorie plus générale visée par la marque antérieure [arrêts du Tribunal du 23 octobre 2002, Oberhauser/OHMI - Petit Liberto (Fifties), T 104/01, Rec. p. II 4359, points 32 et 33 ; du 12 décembre 2002, Vedia/OHMI - France Distribution (HUBERT), T 110/01, Rec. p. II 5275, points 43 et 44, et du 18 février 2004, Koubi/OHMI - Flabesa (CONFORFLEX), T 10/03, Rec. p. II 719, points 41 et 42].”

This is also the position of Professor Annand, sitting as the appointed person in *Galileo International Technology LLC v Galileo Brand Architecture Limited* BL 0/269/04:

“13. I agree with Mr. Onslow that the issue raised by this appeal is whether, when considering the test of identity for section 5(1), it is sufficient that goods or services overlap or must they be co-extensive. Like Mr. Onslow, I am unaware of any authority supporting a co-extensive test. Kerly’s Law of Trade Marks and Trade Names, 13th Edition, states at para. 8-10:

“... the goods or services must be the same as those the subject of the earlier trade mark. Although not explicit, it would seem that this provision can only sensibly be interpreted as prohibiting registration where there is an overlap of goods or services.”

A footnote indicates that such interpretation is in accordance with Article 13 of Council Directive 89/104/EEC. Although not expressly included, it is well established that the TMA must be read subject to Article 13, which provides:

“Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only.”

14. The equivalent to section 5(1) in Council Regulation (EC) No. 40/94 on the Community trade mark (“CTMR”) is Article 8(1)(a). Mr. Onslow referred me to two decisions of the Opposition Division of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (“OHIM”) concerning Article 8(1)(a) of the CTMR where identity of goods and services was found to subsist through overlaps in specifications. In WALLIS, Decision No. 1978/2004, identity was found inter alia between Class 14 specifications even though the contested CTM application covered additional goods in that class. The Opposition Division said:

“There is identity between the goods or services that are subject to comparison if they either have the same wording or can be considered synonyms. The identity is also found if the specification of the earlier mark includes a generic term that covers the specific goods of the contested application. Similarly if the goods specifically designated in the earlier mark are covered by a generic term used in the contested application, such goods are identical, to the degree that they are included in the broad category. Finally, in case that the goods in question overlap in part they are also to be considered as identical.”

A similar decision was arrived at in PACE, Decision No. 1033/2003. Again, the Class 41 services in the CTM application were wider than those in the earlier CTM registration. In addition, there was held to be identity between some of the applicant’s Class 42 services namely, “computer programming; providing of expert opinion”. The opponent’s registration was in respect of “consulting services related to improving and expediting product development, industrial research services, computer programming services” in Class 42. The Opposition Division observed:

“In particular, the applicant’s expression providing of expert opinion in class 42, is broad enough to encompass any consulting services registered by the opponent in class 42, which makes them equivalent to the extent that the one includes the other.”

15. The overlap test for identity of goods and services is also applied by the OHIM in connection with priority and seniority claiming under Articles 29, and 34 and 35 of the CTMR respectively. Indeed, it is recognised that partial priority claiming (i.e. where the subsequent application is for a narrower or wider specification than in the application(s) from which priority is claimed) is a possibility under section 33 of the TMA, which speaks of a right of priority “for some or all of the same goods or services” in a Convention application.

16. I believe that overlapping specifications satisfy the test for identical goods or services in section 5(1) of the TMA. There is no necessity for such specifications to co-extend.”

I do not consider that the judgment of Norris J is in *Budejovický Budvar, národní Podnik v Anheuser-Busch Inc* [2008] EWHC 263 (Ch) is in conflict with the above. In that case he stated: “41. There is however one respect in which this appeal succeeds. AB’s application for a declaration of invalidity extended to the whole of BB’s registration in respect of “beer ale and porter; malt beverages;” (although its own registration related only to “beer ale and porter”). In his decision the Hearing Officer regarded it as obvious that in respect of “beer, ale and porter” the respective specifications encompassed the same goods (and the contrary has not been argued before me). He said:-

“The only possible area of contention is the description “malt beverages” in the mark in suit. The term covers all beverages made with malt, including “malt beers” and the like. Accordingly the specification of the registration that is the subject of these proceedings is covered in its entirety by the specifications of [AB’s] earlier mark”

This is a determination of a mixed question of fact and law which I must approach with caution. But in my judgement this passage discloses an error of principle. AB’s earlier mark covered only “beer, ale and porter”. BB’s included “malt beverages”. The specification of AB’s earlier mark simply did not cover entirely the specification of the mark in suit. It is necessary to decide whether “malt beverages” can only be “beer ale and porter”, or whether “malt beverages” can include goods which are not identical with or similar to “beer ale and porter”.

42. I do not consider that “malt beverages” can only be (and are therefore identical with) “beer ale and porter”. The form of the specification would indicate that “beer, ale and porter;” is one category and “malt beverages” another, with possibly an overlap between the two. One is not simply an alternative description for the other.”

In the above judgment Norris J was considering whether the respective goods could be described as being identical, not whether they should be considered to be identical. There is a deal of difference between stating that goods **are** identical and stating that they are considered to be identical.

If one did not follow the principles laid down by the CFI and Professor Annand considering similarity of goods in certain cases would become virtually impossible. If, for example, an earlier registration was for wedding dresses and an application for clothing one would have to consider the degree of similarity between the former goods and every potential product covered by the term clothing as there would be varying degrees of similarity and the global appreciation of the likelihood of confusion requires consideration of the degree of similarity between goods and/or services.

An applicant has plenty of time to amend a specification which includes a portmanteau term so that the term lists goods which are of specific interest. If the applicant does not do so then it must expect to bear the consequences.

^v *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

^{vi} *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

^{vii} *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use”

^{viii} *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

^{ix} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

^x He considered that the following should be taken into account when assessing the similarity of goods and/or services:

- “(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.”

^{xi} *Sabel BV v Puma AG* [1998] RPC 199.

^{xii} *Sabel BV v Puma AG* [1998] RPC 199.

^{xiii} *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

^{xiv} *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

^{xv} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

^{xvi} *Sabel BV v Puma AG* [1998] RPC 199.

^{xvii} *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

^{xviii} *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.