

TRADE MARKS ACT 1994

TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996

IN THE MATTER OF:

A REQUEST BY NOVARTIS SEEDS BV

FOR PROTECTION IN THE UNITED KINGDOM

OF INTERNATIONAL TRADE MARK No. 726627

IN CLASS 31

DECISION

1. In the present case the Registrar of Trade Marks has refused a request initially made in the name of Novartis Seeds and now proceeding in the name of Syngentic Participations AG (**'the Applicant'**) for protection in the United Kingdom under the provisions of the Madrid Protocol and the Trade Marks (International Registration) Order 1996 of the word mark:

CANTO

for use in relation to the following goods within the specification of International Registration number 726,627: *'Flower seeds, but not including seeds for human consumption'* in Class 31.

2. The request for protection was refused on the ground that use of the mark **CANTO** in relation to goods of that kind would infringe the rights of the proprietor of the earlier trade mark:

ERIC CANTONA CANTO

registered as a Community trade mark under number 997411 in respect of a plethora of goods and services including: ‘*Agricultural, horticultural and forestry products and grains not included in other classes; seeds, natural plants and flowers;`* in Class 31.

3. Infringement was anticipated under section 5(2)(b) of the Trade Marks Act 1994 on the basis that there would be ‘*a likelihood of confusion*’ within the meaning of that expression as interpreted by the European Court of Justice in Case C-39/97 Canon KK v. Metro Goldwyn Mayer Inc [1998] ECR I-5507 at paragraphs 26 to 30 if the earlier trade mark and the later trade mark were used concurrently in the United Kingdom in relation to goods of the kind for which they were respectively registered and proposed to be registered.

4. The objection to registration was raised and maintained by the Registrar without evidence or intervention from the proprietor of the earlier trade mark. It necessarily depended on the finding of a likelihood of confusion inherent in the similarities between the marks and goods in issue c.f. Case T-57/03 SPAG SA v. OHIM (HOOLIGAN) (1st February 2005) at paragraphs 31 to 33.

5. The finding of a likelihood of confusion was made for the reasons given by Mr Edward Smith on behalf of the Registrar in a decision in writing issued on 16th June 2004 (BL O-176-04). His reasons were as follows:

19. The earlier trade mark ERIC CANTONA CANTO contains the word CANTO but this of itself is not necessarily decisive. The question is: would the average consumer for the relevant goods be likely to confuse the origin of goods sold under the mark CANTO with those sold under the mark ERIC CANTONA CANTO ?

20. In correspondence, the examiner cited the case of *Bulova Accutron* [1969] RPC 102 (BULOVA) and it is worthwhile considering the application of that case to the case before me – accepting as I do that the case has application. I should also say that I know of no authority whereby the principle set out in BULOVA has been varied or abandoned altogether.

21. In that case, it was held that there was a likelihood of confusion between the marks BULOVA ACCUTRON and ACCURIST. The opponents owned ACCURIST, an invented word which had, in an earlier decision, been held to lead to a likelihood of confusion with the mark ACCUTRON. Taking account of imperfect recollection, it was held that the average consumer was apt to regard the word BULOVA, when combined with ACCUTRON, as either a house mark or another trade mark.

22. Applying the BULOVA principle to this case, I believe that the sign ERIC CANTONA (being the name of the well known footballer) would be seen by the average consumer as the house mark element of the trade mark. The secondary sign CANTO would operate as a secondary indicator of origin. Given that the average consumer would see ERIC CANTONA CANTO as *two separately identifiable trade mark elements*, I can come to no other conclusion than the one arrived at in the BULOVA case. In fact in this case, the likelihood of confusion is even more pronounced: the secondary element CANTO in ERIC CANTONA CANTO is identical to CANTO solus.

23. I would simply add that just as it cannot be right that by adding a house mark to an already registered trade mark the likelihood of confusion is avoided, likewise it must be the case that seeking registration of a secondary trade mark without a house mark avoids a likelihood of confusion. Of course, this is not to say that such an act was done wilfully, merely that due protection should be given by the registrar to all the dominant and distinctive elements of an earlier mark.

24. No submission to the contrary has been put to me. I am left therefore to apply, as the examiner did, the **BULOVA** view, which in my view is wholly consistent with the principles subsequently set out in the various ECJ cases referred to in paragraph 15 above.

The Applicant now appeals against the refusal of its request for protection.

6. The ‘house mark plus invented word’ analysis undoubtedly explains why the Bulova case was decided the way it was. In that case an application to register **ACCUTRON** for clocks and watches had been refused by the Court of Appeal in view of the likelihood of confusion with the opponent’s registered trade mark **ACCURIST**: [1996] RPC 152. The applicants then sought to register the combination **BULOVA ACCUTRON**. The application was refused on the ground that **BULOVA ACCUTRON** so nearly resembled the opponent’s mark **ACCURIST** as to be likely to cause the very deception and confusion that the Court of Appeal had regarded as likely when the applicants applied to register the word **ACCUTRON** simpliciter: [1969] RPC 102. At p.109 Stamp J. said:

Particularly having regard to the fact that **BULOVA** is the house name of the applicants and has a significance other than as a trade mark, its addition before the word **ACCUTRON** does not in my judgment serve to prevent the deception or confusion which would in the view of the Court of Appeal have been caused but for that adoption. As the Assistant Registrar remarks in his decision: ‘As **BULOVA** and **ACCUTRON** do not hold together as a phrase or present a wholly different meaning to the separate components, I think that their combination will be taken by many persons on first impression as an indication that the manufacturer of the watches is using two separate trade marks in connection with his products’. I would add that the combination of the two words is likely to be taken by other persons on first impression as an indication that the part of the trade mark which consists of **BULOVA** is a house name of the

marketers of the watches, that the trade mark is ACCUTRON and that they will confuse them with watches marketed under the trade mark ACCURIST simpliciter.

This was not the enunciation of a principle. It was an assessment of the net effect of the differences and similarities between the marks in issue in that case.

7. The basic proposition as now confirmed by the ECJ in paragraph 29 of its Judgment in Case C-120/04 Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH (6th October 2005) is that:

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 *Matratzen Concord*, paragraph 32).

The marks in issue must therefore be evaluated and compared without dismemberment or excision. When that is done, they might be found to have elements in common that the relevant average consumer may take to be performing an '*independent distinctive role*'. They might then be regarded as distinctively similar marks, the concurrent use of which would be liable to give rise to the existence of a likelihood of confusion. This was recognised in paragraphs 30 and 31 of the Judgment of the Court:

30. However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible

that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31. In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

With particular reference to the case before it, the Court accordingly ruled (in paragraph 37) that:

Article 5(1)(b) of the directive is to be interpreted as meaning that where the goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name or another party and a registered mark which has normal distinctiveness and which without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein.

8. In the present case it appears to me that the earlier trade mark **ERIC CANTONA CANTO** might be perceived and remembered in one or other of a number of ways, which I shall now try to represent graphically with the aid of accentuating punctuation:

ERIC – CANTONA – CANTO

ERIC ‘CANTONA’ CANTO

ERIC . CANTONA . CANTO

ERIC CANTONA – CANTO

ERIC CANTONA . CANTO

ERIC CANTONA : CANTO

The Hearing Officer adopted the fifth possibility on the basis that the average consumer in the market for seeds would recognise and remember **ERIC CANTONA** as the name of a famous footballer and mentally sub-divide the mark into two parts, with **ERIC CANTONA** possessing the significance of a house mark and **CANTO** possessing the significance of a secondary indicator of origin. He thus ascribed visual, aural and conceptual autonomy to the word **CANTO**.

9. I agree with the Hearing Officer in thinking that the relevant average consumer will have been predisposed by past publicity relating to the activities of the footballer Eric Cantona to perceive and remember **ERIC CANTONA CANTO** as a mark based on the personal name **ERIC CANTONA**. I am not entirely convinced that the mark would be taken to be referring specifically to the footballer in the context of trading in seedstuffs. But whether or not the mark was taken to be referring specifically to him, I think the average consumer in the market for seedstuffs will have been likely to appreciate that the word **CANTO** echoed the first five letters of the name **CANTONA** and did so in the idiom of a nickname. Thus the word **CANTO** would, in my view, derive meaning and significance from the name **ERIC CANTONA** when used in the context of the mark **ERIC CANTONA CANTO** as applied to seedstuffs.

10. I think it follows that the distinctive character of the earlier trade mark resided visually, aurally and conceptually in the doubling up of 'a name and its nickname' (**ERIC**

CANTONA : CANTO). In argument on behalf of the Registrar the mark was analogised to the expression **TOTTENHAM HOTSPUR : SPURS**. I accept the analogy so far as it relates to the doubling up of ‘a name and its nickname’ in a footballing context. However it does not carry the corollary that use of the single word **SPURS** in relation to seedstuffs would be understood as a reference to **TOTTENHAM HOTSPUR** or the further corollary that use of the single word **CANTO** in relation to seedstuffs would be understood as a reference to **ERIC CANTONA**. The present case does not appear to me to involve an asynchronous combination of ‘a house mark plus invented word’ (**ERIC CANTONA . CANTO**) as exemplified by the Bulova case. I therefore do not accept that the element **CANTO** performs what the ECJ has referred to as an ‘*independent distinctive role*’ in the context of the composite mark **ERIC CANTONA CANTO**.

11. The Applicant’s mark is the single word **CANTO**. I do not think it can be assumed (and there is no evidence on file to suggest) that in the United Kingdom at the date of the request for protection the average consumer would have perceived and remembered the unaccompanied word **CANTO** as applied to seedstuffs as being the first five letters of the surname **CANTONA** presented in the idiom of a nickname. I think it would have been perceived and remembered entirely as an invented word in that connection.

12. As I have noted above, the question raised by the objection under section 5(2)(b) was whether there were similarities (in terms of marks and goods) that would combine to give rise to a likelihood of confusion if the marks in issue were used concurrently in the United Kingdom in relation to goods of the kind for which they were respectively

registered and proposed to be registered. In order to answer that question it was necessary to give as much or as little significance to the visual, aural and conceptual differences and similarities between the marks as the average consumer of seedstuffs would have attached to them at the date of the Applicant's request for protection.

13. Having rejected the central premise of the hearing officer's decision (i.e. that there are '*two separately identifiable trade mark elements*' in the earlier trade mark) and determined that there is an appreciable degree of conceptual dissonance between the marks in issues, I find it difficult to say with confidence that use of the Applicant's mark would infringe the rights conferred by registration of the earlier trade mark. I believe that the blend of meaning and significance possessed by the combination of words **ERIC CANTONA CANTO** and the apparent absence of any meaning and significance in the single word **CANTO** as applied to seedstuffs might well enable the marks to co-exist in the marketplace without giving rise to a likelihood of confusion of the approach affirmed in paragraphs 20 to 23 of the Judgment of the ECJ in Case C-361/04P Ruiz-Picasso v. OHIM (12th January 2006). That is a view which would, of course, need to be reconsidered in the light of any evidence that might be put forward in support of the contrary proposition. However, the role of the Registrar in the absence of evidence or intervention from the proprietor of the earlier trade mark was to act as a watchdog not as a bloodhound. Looking at the matter from that point of view, I think there was enough room for doubt as to the sustainability of the objection under section 5(2)(b) to point to the conclusion that the request for protection should at this stage of the examination process be advertised for the purposes of opposition in the ordinary way. I consider that the hearing officer's decision should be set aside on that basis.

14. The appeal is therefore allowed. The refusal of the request for protection is set aside and the request for protection is remitted to the Registrar for further processing in accordance with the Act and the Rules. In accordance with the usual practice, I make no order for costs in respect of the appeal.

Geoffrey Hobbs QC
16th January 2006

Mr. Mark Hickey of Messrs Castles appeared on behalf of the Applicant

Mr. Allan James appeared on behalf of the Registrar

**TRADE MARKS ACT 1994
TRADE MARKS (INTERNATIONAL
REGISTRATION) ORDER 1996
IN THE MATTER OF:
A REQUEST BY NOVARTIS SEEDS BV
FOR PROTECTION IN THE UNITED
KINGDOM OF INTERNATIONAL
TRADE MARK No. 726627
IN CLASS 31**

DECISION
