

O-294-04

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2325142 BY  
SYNGENTA PARTICIPATIONS AG TO REGISTER A TRADE MARK  
IN CLASSES 1 AND 5**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NUMBER 91871 BY  
HOMCARE SERVICE AB**

## TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2325142  
by Syngenta Participations AG  
to register a trade mark in Classes 1 and 5**

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**IN THE MATTER OF Opposition  
thereto under No. 91871  
by Homcare Service AB**

### BACKGROUND

1. On 28 February 2003 Syngenta Participations AG applied to register the trade mark SWIPE GOLD in Classes 1 and 5 of the register for the following specifications of goods in Classes 1 and 5:-

**Class 1:**

Chemicals used in agriculture, horticulture and forestry, manures.

**Class 5:**

Preparations for destroying vermin; fungicides, herbicides.

2. The application was accepted by the Registrar and published in the Trade Marks Journal.

3. On 1 August 2003 Homcare Service AB filed a Notice of Opposition on the basis of Section 5(2)(b) of the Act in that the mark applied for is similar to the following earlier trade mark owned by the opponent and covers the same and similar goods so that there exists a likelihood of confusion on the part of the public:

<b>REGISTRATION NUMBER</b>	<b>MARK</b>	<b>DATE REGISTRATION EFFECTIVE</b>	<b>SPECIFICATION OF GOODS</b>
910653	SWIPE	13 June 1967	<b>Class 01:</b> Preparations for application to glass, to the surfaces of transparent materials and to polished surfaces to prevent misting and to break the surface tension of water falling on such surfaces.  <b>Class 03:</b> Soaps and liquid cleaning

			preparations, all for household use.  <b>Class 21:</b> Cleaning cloths.
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4. In its Statement of Grounds the opponent submits that the word GOLD appearing in the applicant’s mark is a laudatory word which would be perceived by the relevant public as being an indication that the goods being referred to are of premium quality. It does not add any distinctive character to the mark of the application. Turning to the goods applied for, the opponent contends that the respective goods in Class 1 are either similar or identical. In relation to Class 5, the opponent submits that it is known that soaps and cleaning preparations may be effectively employed as a preparation or as an ingredient in a preparation for the destruction of vermin, or as a fungicide or herbicide. Accordingly, the respective goods are either completely the same or similar to the goods in Class 3 of the opponent’s earlier registration.

5. The applicant filed a Counterstatement denying the grounds of opposition. In the Counterstatement the applicant points out that its registered trade mark number 1169814 for the word SWIPE in Class 5 for “Herbicides”, has co-existed with the opponent’s registered trade mark 910653 for twenty years. The applicant submits that the marks cover distinctively different goods (agrochemicals vs soaps) and state that this has been acknowledged by representatives of the opponent in a letter dated 13 June 1995 to the applicant’s “legacy company” Ciba Geigy.

6. The applicant goes on to submit that the respective goods have different functional purposes and that moreover, firms in the agrochemical business do not in general produce household cleaners. Accordingly, the goods would be distributed through different trade channels to different customers and the risk of confusion does not exist. Furthermore, the applicant contends that the connection between soap and pesticides is false and confusion would not exist due to the different functionality of the goods, the different trade channels and different customers.

7. The opponent has filed evidence. Both parties were content for a decision to be reached without recourse to a hearing and neither party forwarded written submissions for the Hearing Officer’s attention.

**Opponent’s Evidence**

8. The opponent’s evidence consists of a written statement by Antony Xavier Gallafent of Urquhart-Dykes & Lord, the opponent’s professional advisors in these proceedings.

9. Mr Gallafent notes that the applicant’s earlier registration number 1169814 is in respect of “Herbicides” only and the letter of 13 June 1995 from the opponent’s representatives does not suggest that any other goods would be regarded as distinct from the goods covered by registration number 910653. He adds that it would be wrong to characterise “herbicides” as the equivalent of agrochemicals.

10. Mr Gallafent states that the Class 1 goods covered by the prior registration are not in any way limited as to the field in which they are to be used. He adds that in agriculture and horticulture the use of greenhouses, glasshouses, or similar transparent or semi-transparent structures is widespread in connection with some crops such as, for example tomatoes. Attached as Exhibit AXG1 to Mr Gallafent's statement is an extract from the website of the British Tomato Growers Association ([www.britishtomatoes.co.uk](http://www.britishtomatoes.co.uk)) which states that "In Britain almost all tomatoes are grown under glass". Mr Gallafent goes on to say that in greenhouses or glass houses there may be many reasons why it is undesirable for misting to occur on the inside surface of that structure. To prevent such misting the Class 01 goods of registration 910653 may be employed which would clearly be use of such goods as an agricultural or horticultural chemical. Thus Mr Gallafent submits that the Class 01 goods of registration 910653 are the same as, or very similar to, at least some of the goods covered by the Class 01 of the specification of goods for application 2325142.

11. On the applicant's submissions in relation to the differences between the respective goods, Mr Gallafent states that at a Garden Centre many goods falling within the scope of those covered by the opposed application may be purchased. He draws attention to Exhibit AXG2 to his statement which in an extract taken from the website of Wyevale Garden Centres ([www.wyevale.co.uk](http://www.wyevale.co.uk)) and he refers to the following in particular – "From ready-to-use chemicals, compost, gardening books, starter kits and easy-to-grow plants to state of the art tools and specialist equipment, you will find it all at Wyevale" and "Our home and gift departments are full of inspiring ideas for all occasions. So, if you are looking for a gift for a wedding, birthday, anniversary, or even a treat for yourself, you'll find something suitable at Wyevale". Mr Gallafent adds that it is known that Garden Centres sell a wide range of "home" type products as may be seen in the Wyevale Garden Centre website where a "home and gift department" is specifically mentioned. He submits that it is well known for such departments to include, for example, scented soaps and the like and on that basis it will be seen in that the channels of trade, through which the goods covered by opposed application 2325142 may be distributed and the goods of registration 910653 may be distributed, can be the same.

12. Mr Gallafent states that it is well known for soap to be used as an ingredient in a pesticide and in support he attaches at Exhibit AXG3 to his statement extracts from two Google searches and also at AXG4, a fact sheet produced by Colorado State University obtained via the internet. Furthermore, Exhibit AXG5 contains information obtained from the internet showing how domestic or household soap is used by members of the public in the preparation of pesticides. On this basis, Mr Gallafent submits that a member of the public would be aware without specialist agrochemical knowledge, that use of soap in agricultural or horticultural practices as a pesticide is one of a range of agrochemicals available to the agriculturalist, horticulturalist or amateur gardener. Accordingly, he believes, the respective Class 5 and Class 3 goods to be similar.

13. This completes my summary of the evidence filed in this case. I turn now to the decision.

## DECISION

14. Section 5(2) of the Act reads as follows:

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or;
- (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.”

15. An earlier right is defined in Section 6, the relevant parts of which state:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

16. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors; *Sabel BV v Puma AG*;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, page 224, who is deemed to be reasonably well informed and reasonably circumspect and observant – but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sable BV v. Puma AG*;

- (d) 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; *Sabel BV v. Puma AG*;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a slightly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*;
- (g) account should be taken of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it was registered; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V*;
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*.

17. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my considerations on whether there are similarities sufficient to show a likelihood of confusion I am guided by the recent judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. As I have no evidence to demonstrate use of the respective marks in the UK in relation to the relevant goods, I must compare the mark applied for and the opponent's registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on the goods covered within the respective specifications.

18. I turn first to a comparison of the respective goods and have to decide whether the goods covered by the application are the same or similar to the goods covered by the opponent's registrations. In relation to the determination of similarity of goods I have considered the guidelines formulated by Jacob J in *British Sugar v James Robertson & Sons Ltd* [1996] RPC 281 (pages 296, 297) as set out below-

“The following factors must be relevant in considering whether there is or is not similarity:-

- (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 services;
- (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 particular they are respectively 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 the industry, put the goods or services in the same or different sectors.”

19. Whilst I acknowledge that in view of the CANON-MGM judgement by the European Court of Justice (3-39/97) the Treat case may no longer be wholly relied upon, the ECJ said the factors identified by the UK government in its submissions (which are listed in Treat) are still relevant in respect of comparison of goods.

20. The goods covered within Class 1 of the specification of the applicant’s mark are “Chemicals used in agriculture, horticulture and forestry, manures.” It is the opponent’s contention that these goods are either identical or similar to its goods within Class 1 of its earlier registration i.e. “Preparations for application to glass, to the surfaces of transparent materials and to polished surfaces to prevent misting and to break the surface tension of water falling on such surfaces.” In particular the opponent submits that the opponent’s goods could be used in relation to greenhouses or similar transparent or semi-transparent structures which are used to grow crops, to prevent misting etc.

21. I have no doubt that the opponent is correct in that its Class 1 specification encompasses goods which could be used in agriculture or horticulture to prevent misting etc in/on on glasshouses and similar structures, thus maximising crop potential. Furthermore, the goods could well be in the form of chemical preparations formulated and sold for such a purpose. The applicant’s Class 1 specification is widely drafted in that it includes chemicals used in agriculture and horticulture at large. It seems to me that these goods would include not only the more obvious products such as chemical fertilisers (not similar), but also chemicals or chemical compositions used to prevent misting and to break the surface tension of water, in/on greenhouses and similar structures. In my view the applicant’s chemicals used in agriculture and horticulture encompasses a sufficiently wide range of goods so as to include identical and closely similar goods to that covered by the opponent’s goods in Class 1 of the earlier registration.

22. The applicant’s Class 1 specification also includes chemicals for use in forestry and manures. In relation to chemicals used in forestry, while I have no evidence before me on the point, it is not my understanding that forestry normally involves the

nurturing of trees under glass and I do not believe that similarity of goods exists on this part of the application. Furthermore, it seems to me that there is no similarity of goods in relation to the applicant's "manures".

23. I go now to the goods within Class 5 of the mark applied for, which are "Preparations for destroying vermin; fungicides; herbicides." The opponent submits that as soaps and cleaning preparations may be effectively employed as a preparation or an ingredient in a preparation for destroying vermin or as a fungicide or herbicide, they are the same or similar to the opponent's Class specification, which is for "Soaps and liquid cleaning preparations, all for household use".

24. I am aware, and the evidence confirms that, soap may be used as a pesticide or as a major ingredient within pesticides. However, the opponent's soaps by virtue of falling within Class 3 and it seems to me within the context of its specification, are for cleaning, de-odorising or disinfecting purposes. Furthermore, the opponent's specification refers to "all for household use" which confirms that its goods are for normal domestic uses such as cleaning.

25. I have no doubt that the uses and users of the respective goods are different and while the goods may be sold through the same outlets, the opponent's example being garden centres (paragraph 11 of this decision refers), within such outlets the goods would be sold from separate shelves or in separate locations/departments within the store.

26. Although it is possible for household soap for cleaning purposes to be used as a pesticide, it is not sold or normally purchased for such a purpose and such use would, in my view, fall outside the normal circumstances and channels of trade. I conclude that the applicant's Class 5 goods are not identical or similar to the goods included within the specification(s) of the opponent's earlier registration.

27. I now go on to a comparison of the mark in suit with the opponent's earlier registrations. In the evidence the applicant has drawn my attention to the co-existence of its registered mark No. 1169814, with the opponent's prior registrations – paragraph 5 of this decision refers. However, the applicant has provided me with no evidence as to whether the above mark, or the mark in suit, has been used in the UK. Accordingly, this amounts to no more than "state of the register" information. I am not assisted by this evidence and I am guided on this point by the following comments of Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281:

"Both sides invite me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word "Treat". I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular

mark tendered for registration, see e.g. *MADAM Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

28. My decision involves a comparison of the applicant’s and opponent’s particular marks and must be made on its own merits, taking into account notional and fair use of the respective marks.

29. I go on to compare the mark in suit with the opponent’s earlier mark.

30. The applicant’s mark comprises the two dictionary words SWIPE GOLD, where the opponent’s marks consists of the dictionary word SWIPE.

31. The dictionary word SWIPE possesses a number of obvious meanings, one of which is to hit with a sweeping blow. Whilst this may indirectly allude to a characteristic of goods, in that they hit at vermin etc, it seems to me that the word is distinctive in relation to the goods at issue and deserves a good penumbra of protection. The word GOLD is another obvious dictionary word but the words SWIPE GOLD have no obvious meaning in their totality. The opponent contends that the word GOLD would indicate premium quality and there is some merit to this point. It seems to me that GOLD would be perceived as a laudatory epithet in relation to the goods.

32. The respective marks must be compared as a whole and by reference to overall impression but, as recognised in *Sabel BV v Puma AG* (mentioned earlier in the decision) in any comparison reference will inevitably be made to the distinctiveness and prominence of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course and circumstances of trade. I must bear this in mind when making the comparisons.

33. Turning to a visual and aural comparison of the marks, while both marks contain the word SWIPE, a difference is apparent in that the mark applied for also contains the word GOLD. The word SWIPE appears as the first word within the applicant’s mark and given its prominence must be regarded as a distinctive, dominant, visually and aurally striking component within the applicant’s mark. In totality, it seems to me that there is considerable visual and aural similarity between the two marks.

34. Going to a conceptual comparison, I have little doubt that the word SWIPE will share the same connotation to the relevant customer and it is likely that the customer would perceive the word GOLD as indicating a premium or superior product. In my view the respective marks share a close conceptual similarity.

35. In my considerations relating to the global appreciation of a likelihood of confusion I must consider the goods at issue and the average customer for the goods. It seems to me that the customer for the applicant’s goods would include those engaged professionally in agriculture, horticulture etc. and also ordinary members of the public looking to care for their gardens. Those customers seeking to purchase the opponent’s goods would also include the public at large . The respective goods would be purchased with some degree of care and this is not a “bag of sweets” case.

## CONCLUSIONS

36. On a global appreciation taking into account the relevant factors, I have reached the following conclusions:

- (i) in relation to Class 1 of the application, while the applicant's "chemicals used in agriculture, horticulture" would include identical and similar goods to those of the opponent which fall within Class 1 of its earlier registration, chemicals used in forestry and manures do not constitute identical or similar goods to those of the opponent;
- (ii) the goods covered by Class 5 of the application are not similar to any of those goods covered by the opponent's earlier registration;
- (iii) the respective marks are closely similar;
- (iv) in all the circumstances the relevant customer is likely to be confused in relation to the origin of goods falling within "Chemicals used in agriculture and horticulture", but not confused regarding chemicals used in forestry and manures in Class 1 and the applicant's Class 5 goods.

37. In reaching a decision in relation to the likelihood of confusion I have particularly borne in mind the following comments of the European Court of Justice in Canon:

"Accordingly, 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 4(1)(b) of the Directive (see SABEL, paragraphs 16 to 18)"

38. The opposition is successful in relation to chemicals used in "agriculture, horticulture" in Class 1 of the application in suit but fails in respect of the remaining goods in Class 1 and the Class 5 goods. If within twenty eight days of the expiry of the appeal period the applicant files a Form TM21 deleting "Chemicals used in agriculture and horticulture, the applicant will be allowed to proceed for the goods which remain in Classes 1 and 5. If the applicant fails to file the necessary TM21, the application will be refused.

## COSTS

39. Both sides have achieved a measure of success. The opposition has partly succeeded in relation to Class 1 but has failed in respect of manures and chemicals

used in forestry in Class 1 and also in respect of the goods falling within Class 5 of the application. Accordingly, it seems to me appropriate that I make no order as to costs in respect of these proceedings.

Dated this 24<sup>th</sup> day of September 2004

**JOHN MACGILLIVRAY**  
**For the Registrar**  
**The Comptroller-General**