

O-441-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2631744
BY BASF SE TO REGISTER THE TRADE MARK**

TEXON

IN CLASSES 1 AND 5

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 104236
BY RITAM AGROCHEM INTERNATIONAL CO. LTD.**

BACKGROUND AND PLEADINGS

1) On 15 August 2012, BASF SE (“the applicant”) applied under the Trade Marks Act 1994 (“the Act”) for registration of the mark TEXON In respect of the following goods:

Class 1: *Chemicals used in agriculture, horticulture and forestry, especially plant fortifying preparations, chemical and/or biological preparations for stress management in plants, plant growth regulating preparations, chemical preparations for the treatment of seeds, surfactants, natural or artificial chemicals to be used as sexual baits or agents to confuse insects.*

Class 5: *Preparations for destroying and combating vermin, insecticides, fungicides, herbicides, pesticides.*

2) The application was published in the Trade Marks Journal on 14 September 2012. On 18 December 2012, Roram Agrochem International Co. Ltd. (“the opponent”) filed notice of opposition to the application. The single ground of opposition is that the application offends under Section 5(2)(b) of the Act because the mark is highly similar to an earlier Community Trade Mark (“CTM”) in the name of the opponent and in respect of identical or highly similar goods. It claims that as a result of this there is a likelihood of confusion. The relevant details of the opponent’s mark are:

Relevant details	List of goods
CTM 10570257 TUCSON Filing date: 18 January 2012 Date of entry in register: 30 May 2012	Class 5: <i>Insecticides; herbicides; fungicides; parasiticides; preparations for destroying vermin.</i>

3) The CTM relied upon by the opponent is registered and has a filing date earlier than that of the applicant’s mark. It is therefore an “earlier mark” for the purposes of Section 6(1) of the Act. Further, because it completed its registration procedure less than five years before the publication of the applicant’s mark it is not subject to the proof of use provisions set out in Section 6A of the Act. The relevance of this is that the opponent may rely upon the full list of goods listed in its registration.

4) The applicant subsequently filed a counterstatement denying the opponent's claims.

5) The applicant filed evidence and the opponent filed evidence in reply. Both sides also filed written submissions that I will refer to where appropriate in the decision. Both sides ask for an award of costs. Neither side requested to be heard and I give my decision after careful consideration of the papers.

Applicant's Evidence

6) This takes the form of a witness statement by Richard Mark Hiddleston, Trade Mark Attorney and Solicitor with Elkington and Fife LLP, the applicant's representative in these proceedings. At Exhibit RMH1, Mr Hiddleston provides what he considers is the most relevant selection of results obtained from the "Serion/Saegis" commercial searching database illustrating UK and Community applications and registrations and International Registrations designating the UK or the Community in Class 1 and Class 5 and containing the stems "T---ON", "TE—N" and "TU---N".

7) Mr Hiddleston then conducted an Internet search to determine if these marks were in use. The results of this search are also provided in Exhibit RMH1. Marks identified in use include TENON, TENSAN, TAKRON, TALON, TORDON and TRATON. These are all registered in respect of at least some identical goods to those of the opponent's registration.

8) At Exhibit RMH3, Mr Hiddleston provides extracts from various dictionaries all referring to the town of Tucson, Arizona. The first of these is from the New Oxford Dictionary of English and identifies it as a town in SE Arizona with an estimated population in 2003 of a little over half a million. It represents the pronunciation of the name as follows: 'tu:son. Both the Chambers World Gazetteer, fifth edition (1988) and the user-authored website Wikipedia represents its pronunciation as "too-son". The 1984 edition of Webster's New Geographical Dictionary represents its pronunciation as follows: 'tü-'sän.

9) Mr Hiddleston also conducted an Internet search using the search engine, Google, for the term "TUCSON" and "How do you pronounce Tucson Arizona?" Sample results of these searches are provided at Exhibit RHM4. A small selection of comments from users of various websites include:

"How is Tucson pronounced? (not American) I've always thought it was like Tuck-son."

"Too-son is kinda how you'd say it I guess, Im not good with phonetic spellings"

“Well having lived in its neighbour city for the last 6 years (Phoenix), I can attest with all accuracy that Tucson is pronounced without the hard “c” sound –basically, the “c” is silent... somit is Tu (long “U”) cson pronounced more like “sahn” rhyming with the word “dawn”...Hope that helps!!”

(one of 25 answers) “Tuk’ son”. The other 24 answers all suggest “tu son” are small variations of the same.

“... Just like Tucson is pronounced TOO-sahn in English, TOOK-sohn in Spanish and CHOOK-sohn (or thereabouts) in O’odham”

10) In the same exhibit, an extract from emol.org/Tucson/tuscon.html provides information on, what it claims, is the second largest city in Arizona and states “(e)ven though it is pronounced as *too-sahn*, most people outside the Old Pueblo call it *tuk-sun*. It sounds like it should be spelt as *tus-on*.”

11) At Exhibit RMH6, Mr Hiddleston provides a further extract from Wikipedia that indicates that Texon is the name of a “small unincorporated town” in Texas.

Opponent’s Evidence in reply

12) This takes the form of a witness statement by Nathalie Sarah John, Trade Mark Attorney with N. J. Akers & Co, the representative of the opponent in these proceedings. Much of Ms John’s evidence addresses the issue of similarity between the opponent’s Class 5 goods and the applicant’s Class 1 goods. For reasons that will become obvious, it is not necessary for me to provide detail of this evidence.

DECISION

Section 5(2)(b)

13) Section 5(2)(b) reads:

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

(a) ...

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

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

14) The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

15) In assessing the similarity of goods and services, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23:

‘In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.’

16) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281).

17) For ease of reference, the respective goods are:

Opponent’s goods	Applicant’s goods
<p>Class 5: <i>Insecticides; herbicides; fungicides; parasiticides; preparations for destroying vermin.</i></p>	<p>Class 1: <i>Chemicals used in agriculture, horticulture and forestry, especially plant fortifying preparations, chemical and/or biological preparations for stress management in plants, plant growth regulating preparations, chemical preparations for the treatment of seeds, surfactants, natural or artificial chemicals to be used as sexual baits or agents to confuse insects.</i></p> <p>Class 5: <i>Preparations for destroying and combating vermin, insecticides, fungicides, herbicides, pesticides.</i></p>

18) It is self evident that the opponent's *insecticides, herbicides, fungicides and preparations for destroying vermin* in Class 5 are identical to the applicant's corresponding terms in that class. In respect of the applicant's *preparations for ... combating vermin*, whilst in theory this term may include goods other than those for destroying vermin, it will also include goods that do. It is well established that goods of one party can be considered as identical when they are covered by a broader term in the other party's specification (see *Gérard Meric v OHIM*, T-133/05). Therefore, this term also includes identical goods to those on the opponent's specification.

19) There are submissions from both sides regarding the similarity, or otherwise, of the applicants Class 1 goods and the opponent's Class 5 goods but my finding in the previous paragraph, identify the opponent's best case. If the opponent cannot succeed in respect of these identical goods, neither will it succeed in respect of the applicant's Class 1 goods.

The average consumer and nature of purchasing act

20) Matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23), who is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, paragraph 27). The degree of care and attention the average consumer uses when selecting goods and services can, however, very depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems B.V. v. OHIM*, Case T-112/06).

21) I have found that the respective Class 5 goods are identical. It follows that the average consumer for both parties' goods will also be the same. It is clear from the evidence that there is a trade in such goods to commercial customers for treating crops etc. However, these goods may equally have a market as garden products and, as such, sold to the ordinary member of the public. Therefore, the average consumer may be both commercial customers and ordinary members of the public with an interest in gardening. The goods in question are carefully formulated for specific purposes and, consequently, some care will be taken to ensure that the correct goods are chosen for any given purpose. Therefore, there is likely to be a higher than normal level of care and attention during the purchasing process, but not necessarily the highest. The purchasing process is likely to be visual in nature, with the goods selected from a printed or online catalogue or from the shelf, but I do not ignore that aural considerations may play a part where, for example, the goods may be ordered by telephone.

Comparison of marks

22) For ease of reference, the respective marks are:

Opponent's mark	Applicant's mark
TUCSON	TEXON

23) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. 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; in relation to this the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97 stated:

“27. In order to assess the degree of similarity between the marks concerned, the national court must determine the degree of visual, aural or conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed.”

24) Neither the applicant's mark, nor the opponent's mark can be readily divided into separate components. Both will be perceived as single words were their distinctiveness lies in their entirety.

25) Visually, the respective marks share the same first letter “T” and the same last two letters “ON”. In other respects the marks differ. The applicant's mark consists of five letters, whereas the opponent's mark is longer, consisting of six letters. The second and third letters of the applicant's mark are EX, whereas the second, third and fourth letters of the opponent's mark are UCS. Taking all of this together, I conclude that the respective marks share a low to moderate level of visual similarity.

26) The opponent submits that the respective marks are phonetically similar because the opponent's mark will be expressed as TUC-SON. I do not agree. The word corresponds to the name as a place in the United States and the UK consumer is likely to recognise this. The applicant's evidence indicates that the correct pronunciation of that place is TOO-SON or TOO-SAHN or similar, but that occasionally, members of the public are unsure of the correct pronunciation. Whilst I accept that it may not always be pronounced correctly, the dictionary extracts are unanimous in identifying a pronunciation the same or very similar to TOO-SON. The evidence fails to illustrate that it is commonly mis-pronounced. In light of this, I will compare the opponent's mark, pronounced as TOO-SON with the applicant's mark pronounced as TEX-ON. In this respect, they both consist of two syllables and both begin with the “T” sound and end in an “ON” sound. They differ in other respects, with the respective first syllables being TOO and TEX and the last syllables being SON and ON respectively. Taking all of this together, I conclude that the respective marks share a moderately high level of aural similarity.

27) The opponent submits that the applicant's mark alludes to being of or from Texas because of its phonetic similarity to the word "Texan" and that the same will be the case with its own mark, namely that its mark will be expressed as TUC-SON, also being phonetically very similar to the word "Texan". I reject this argument. As I have already discussed in the above paragraph, and as the applicant has submitted, the opponent's mark is likely to be identified as a place in the United States. On the other hand, the applicant's mark appears to be a made up word. The applicant has provided evidence that it is the name of a small town in Texas, but it is unlikely that the average UK consumer will be aware of this. The opponent attempts to convince me that it has an allusion to Texas. In light of my findings regarding its own mark, how I consider it will be perceived becomes less important, but it is my view that this is unlikely to be the case. In the absence of evidence that TEXON is a common misspelling of "Texan", it is my view that the word will be perceived as invented and not having any meaning. Therefore, I conclude that the marks do not share any conceptual similarity.

Distinctive character of the earlier trade mark

28) I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). The distinctive character of the earlier trade mark must be assessed by reference to the goods for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91).

29) The opponent does not provide any evidence regarding the scale of use of its mark. Therefore, I only need consider the inherent qualities of its mark. In this respect, I have found that it consists of the name of a place in the United States. As a place name it is not endowed with the highest level of distinctive character, but when considered in respect of the goods covered by its registration, there is no obvious connection with the place that may reduce the level of distinctive character. Therefore, I conclude that that it is endowed with normal level of distinctive character.

Likelihood of confusion

30) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I must take into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the marks and that of the goods or services designated (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*)

31) Mr Hiddleston provides evidence of numerous similar marks on the register and in its written submissions, the applicant submits that the existence of so

many of these marks on the register points to a finding of no confusion. I note this but I keep in mind the following comments of the General Court (“the GC”) in *Zero Industry Srl v OHIM*, Case T-400/06:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71). “

32) I have found that some goods are identical, that the purchasing process is predominantly visual in nature and involves a higher than normal level of care and attention and that the earlier mark is endowed with a normal level of distinctive character. Further, I have found that the respective marks share a low to moderate level of visual similarity and a moderately high level of aural similarity.

33) I have also found that there is no conceptual similarity. Even if the applicant’s mark created an allusion to Texas/Texan, it will not assist the opponent in light of my finding that its own mark will not create any conceptual link to Texas or being Texan. In fact, it may count against it because a vague allusion to Texas/Texan will create a conceptual difference when compared to the opponent’s mark. However, this point is not determinative because even if the applicant’s mark creates no illusion to Texas/Texan, when considering all of the issues together, I conclude that there is no likelihood of confusion. The average UK consumer may not know much about the city of Tucson, but will recognise it as a place in the United States and further, is likely to know its correct pronunciation. This is sufficient to place enough difference between the marks for me to reach such a conclusion, even where the goods are identical.

34) Consequently, the opposition fails in its entirety.

COSTS

35) The applicant has been successful and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 4/2007. I take

account that both sides filed evidence and written submissions. I award costs on the following basis:

Considering statement and preparing counterstatement	£300
Evidence	£700
Written submissions	£300
Total:	£1300

36) I order Rotam Agrochem International Co. Ltd. to pay BASF SE the sum of £1300 which, in the absence of an appeal, should be paid within seven days of the expiry of the appeal period.

Dated this 14th day of October 2014

**Mark Bryant
For the Registrar,
the Comptroller-General**