

O/551/20

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION  
NO. 3437385 BY  
BIONT INTERNATIONAL LTD  
TO REGISTER:



AS A TRADE MARK IN CLASS 1

AND

OPPOSITION THERETO  
UNDER NO. 419125  
BY  
BASF AGROCHEMICAL PRODUCTS B.V.

## Background and Pleadings

1. Biont International Ltd (“the applicant”), applied to register the (figurative) trade mark shown on the front page of this decision in the United Kingdom on 17 October 2019. It was accepted and published in the Trade Marks Journal on 25 October 2019 in respect of the following goods:

<b>Class 1</b>
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<i>Fertiliser for soil and potting soil; Fertilisers; Fertilisers, and chemicals for use in agriculture, horticulture and forestry; Fertilisers consisting of compounds of nitrogen; Fertilisers for soil and potting soil; Fertilising preparations; Fertilized bases made of mineral wool for growing plants; Fertilized preparations of mineral wool for growing plants; Fertilizer compositions; Fertilizers; Fertilizers and manures; Fertilizers containing nitrogen and magnesium; Fertilizers for agricultural use; Fertilizers for agriculture made of seaweed; Fertilizers for domestic use; Fertilizers for household plants; Fertilizers for soil; Fertilizers for the land; Fertilizers, lawn fertilizers, grass fertilizers; Fertilizing preparations.</i>
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2. BASF Agrochemical Products B.V. (“the opponent”) partially opposes the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition concerns some of the applicant’s goods in Class 1, namely “*chemicals for use in agriculture, horticulture and forestry*”.
3. The opponent is the proprietor of the European Union Trade Mark (EUTM) registration 3317617 for the word:

BEYOND

The mark was filed on 21 August 2003 and registered on 11 May 2005 for various goods in Class 5. However, for the purpose of this opposition, the opponent only relies on “herbicides” as covered by its Class 5 registration.

4. The opponent in its TM7 claims that the word “BIONT” is the dominant element of the applicant's mark, which is phonetically similar to the earlier mark “BEYOND”. It also contends that the contested goods covered by the applicant’s specification are similar or at least complementary to herbicides because “the chemicals in question could be ingredients or compounds in herbicides”. Therefore, registration of the contested mark should be refused under section 5(2)(b) of the Act.
5. The applicant filed a defence and counterstatement, denying the claims on two grounds. First, the applicant states that there is no “commonality” between the two marks regarding “text, image, and pronunciation”. Second, the applicant claims that there is no direct conflict with the goods covered by the earlier mark as they are registered under a different Class from that of the applicant. The applicant also claims that the contested goods were taken from the IPO Classification Guide “as a whole clause” and it is not possible to partially exclude terms from it.
6. Both parties filed written submissions, but neither of the parties filed evidence in these proceedings.
7. Neither side requested a hearing. However, the opponent filed written submissions on 2 September 2020 in lieu of a hearing. These submissions (nor those mentioned earlier) will not be summarised here but will be referred to as and where appropriate below. Thus, this decision has been taken following a careful consideration of the papers.
8. In these proceedings, the opponent is represented by Elkington and Fife LLP, and the applicant is a litigant in person.

### **Proof of Use**

9. The EUTM registration 3317617 had completed the registration process more than five years before the application date of the application in suit,

and is, in theory, subject to the proof of use provisions in accordance with Section 6A of the Act. The applicant, however, indicated in its counterstatement that it did not require evidence of use. Consequently, the opponent may rely upon the goods it has identified without being subject to the proof of use provisions.

## Decision

10. The relevant statutory provisions are as follows:

Section 5(2)(b) of the Act states:

“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”.

11. An “earlier trade mark” is defined in section 6(1) of the Act:

“In this Act an ‘earlier trade mark’ means –

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

references in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and

which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

12. Under the provisions outlined above, the opponent’s trade mark clearly qualifies as an earlier mark.

13. The principles, considered in this opposition, stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- 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;
- 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 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;
- nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- 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;
- 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;
- 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;
- mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- 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;
- 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**

14. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

15. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“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 complementary.”<sup>1</sup>

16. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

“(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.”

17. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The General Court clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06:

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<sup>1</sup> Paragraph 23.

“...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.”<sup>2</sup>

18. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“[...] the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

19. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute*

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<sup>2</sup> Paragraph 82.

*of Patent Attorneys (Trademarks) (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”<sup>3</sup>*

20. The competing goods to be compared are shown in the following table:

<b>Opponent’s Goods</b>	<b>Applicant’s Goods</b>
<i>Class 5 Herbicides</i>	<i>Class 1 Chemicals for use in agriculture, horticulture and forestry</i>

21. In the Notice of Opposition, the opponent states that the goods:

“are similar or at least complementary to herbicides because the chemicals in question could be ingredients or compounds in herbicides.”

22. In the Notice of Defence and Counterstatement, the applicant states that:

“[...] the goods and services that we applied for are registered under Class 1, for which “Fertilisers, and chemicals for use in agriculture, horticulture, and forestry” are classified under. This is a whole clause provided by IPO classification guide, which would be impossible to

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<sup>3</sup> Paragraph 12.

partially exclude from the description of our trademark, as per requested by the opponent. Furthermore, the goods at that the opponent registered are on Class 5, and since our trademark belongs to a different Class, there is no direct conflict.”

23. In its submissions, the opponent claims that “[c]hemicals for use in agriculture, horticulture and forestry” are likely to be key elements of herbicides, so the nature of the respective goods is highly similar, if not identical.” On the other hand, the applicant reiterates in its submissions that: “[...] registering a trade mark under a specific class prevents someone from registering the same or similar trade mark within the same class, but it does not, however, prevent someone potentially registering a similar trade mark in a different class(es), despite sufficient distinctive elements of Application.”

24. As per Section 60A(1)(b), goods are not to be regarded as dissimilar simply because they fall in different classes. This, therefore, deals with one of the points raised by the applicant.

25. Both parties have referred to the ability or otherwise to limit the opponent’s goods from conflict with the goods of the applicant. However, no limitation has been presented, and I must simply compare the terms before me.

26. In relation to the opponent’s goods, the opponent provided in its submissions, dated 20 April 2020, the following definition of the term “*herbicides*”: “the term “herbicides” is commonly understood to denote agents, usually chemical, for killing or inhibiting the growth of unwanted plants, such as residential or agricultural weeds and invasive species.” Based on the Oxford English Dictionary definition, herbicides may consist of “any chemical agent that is toxic to some or all plants and is used to destroy unwanted vegetation”. Therefore, “*herbicides*” are goods usually of chemical origin to control, inhibit, or kill weed (etc.).

27. As to the applicant's contested goods in Class 1, namely "*chemicals for use in agriculture, horticulture and forestry*", they would include raw materials used as ingredients in finished (chemical) products, including "*herbicides*", found in Class 5. Similarity, on the basis of being a key element or ingredient, is one of the grounds on which the opponent claims. In paragraph 15 of its submissions of 20 April 2020 the opponent also states that "the chemicals would feasibly be used in an herbicidal context". This appears to be an argument that goods in Class 1 could be used as herbicides. Whilst I accept, having regard to the case-law I quoted earlier, that the chemical products in Class 1 could be used for agricultural (and other relevant) purposes, such as fertilizers, or other soil conditioning functions, the term cannot be taken to cover herbicides *per se*, because such goods fall in Class 5.

28. The General Court considered the relationship between finished articles and component parts in *Les Éditions Albert René v OHIM, Case T-336/03*, at paragraph 61:

"[...] The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular their nature, intended purpose and the customers for those goods may be completely different."

Therefore, I bear in mind that components of goods are not necessarily similar to the goods themselves. There is no evidence showing how herbicides are manufactured. On the face of it, whilst there may be some similarity in nature given the chemical composition of both, the intended purpose is different, and the goods do not compete. The chemical product will be sold to manufacturers, including those who manufacture horticultural/agricultural products, whereas the herbicide will be sold to different users such as gardeners and farmers. It could be argued that there is complementarity because the chemical product is needed to

produce chemical based herbicides, but there is no evidence to show that such a connection is “in such a way that customers may think that the responsibility for those goods lies with the same undertaking.” I consider that there is no similarity between these goods, or else any similarity is low.

29. In relation to the opponent’s goods covering other chemical products for agricultural use of the type I exemplified earlier, they are certainly not identical. However, they are both goods that are used in the agricultural industry for healthy plant/crop growth and production. Therefore, both goods share the same high-level general purpose. Such goods could both be made of chemicals, so there could be an overlap in nature, and it is not uncommon for the goods to be produced by the same undertakings, and to be sold close together in stores or online, creating a potential overlap in trade channels and targeting the same consumers, including farmers agricultural experts or even the general public. The goods, however, are not complementary in the sense that one is indispensable for the use of the other, nor can they be used interchangeably. That said, particularly with regard to the precise purpose and nature of the goods, the similarity is a quite general level such that I would regard any similarity to be of only a low to medium level.

### **Average Consumer and the Purchasing Act**

30. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is

reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word 'average' denotes that the person is typical. The term 'average' does not denote some form of numerical mean, mode or median."<sup>4</sup>

31. The goods at issue will be purchased by either members of the general public for use in gardening or by agricultural professionals, particularly farmers and gardeners. Given that the goods contain chemical compounds, I will proceed on the basis that the general public as well as professionals will, when purchasing such goods, pay at least a reasonable degree of attention to ensure that the goods are fit for purpose and to potentially identify their environmental impact.

32. For both groups, the selection process for the goods is primarily visual, yet I do not discount the fact that there may be an aural element given that word of mouth recommendation may play a part. The goods may be purchased in stores, such as garden centres, supermarkets, Do It Yourself ('DIY') stores, online or by mail order. In retail premises, the goods at issue will be displayed on shelves, where they will be viewed and self-selected by both groups. Similarly, for the online stores, the consumers will select the goods relying on the images displayed on the relevant web pages. In addition, professionals may consult either digital or hard copy specialist publications or experts, such as agronomists. The selection process, thus, may involve aural considerations with advice being sought prior to purchase or discussion with, for example, experts or representatives from agricultural companies. The selection of the goods at issue will, therefore,

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<sup>4</sup> Paragraph 60.

be primarily visual, although aural considerations will not be ignored in the assessment.

### **Comparison of Trade Marks**

33. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“[...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

34. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

35. The marks to be compared are:

Earlier mark	Contested mark
BEYOND	

36. The earlier mark consists of the ordinary dictionary word “BEYOND” in capital letters and a standard font. Registration of a word mark protects the word itself presented in any normal font and irrespective of capitalisation.<sup>5</sup> The overall impression of the earlier mark lies in the word itself.

37. The applicant’s mark consists of a number of elements. In terms of the overall impression of the applicant’s figurative mark, the stylised and coloured word element “BIONT” has by far the greatest relative weight, given its size and position within the mark. There is a device above the letter “I” which is made of a green leaf shape, replacing the superscript dot, the stylisation of the letter “O”, which is divided vertically between red and green colours, and a thin red stripe on the left of the capitalised letter “B”; these figurative components are not negligible, but their impact in the overall impression of the mark is more limited. Due to their size and that they do not strike me as greatly distinctive, the capitalised and italicised words “GROWING SUCCESS”, displayed in green colour and above the word “BIONT”, also play a more limited role in the overall impression.

38. Visually, there is some degree of visual similarity based on the letters that the word “BEYOND” and the word element “BIONT” (the element of that mark which has by far the greatest relative weight) have in common. The former and the latter words are six and five letters long, respectively. Whilst just rules of thumb, I also bear in mind that both words are short, and the

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<sup>5</sup> See *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

first part of a mark usually has more impact. Notably, both begin with the letter “B” and share the letters “O” and “N”. However, they differ in the rest of the letters. In particular, the opponent’s mark contains the letter “Y” in the third place and the second and last letters are “E” and “D”, while the second and last letters of the applicant’s mark are “I” and “T”. There are further differences due to the figurative aspects and the presence/absence of the words “GROWING SUCCESS”, although, as I have already noted, the impact of these in the overall impression of the mark is less.

39. I do not consider the difference created by the use of uppercase/lowercase and capitalisation in the respective marks to be significant, since normal and fair use allows word-only marks to be presented in any standard font or case.<sup>6</sup> Moreover, it is not appropriate to notionally apply complex colour arrangements to a mark registered in black and white, as this goes beyond normal and fair use of the word mark.<sup>7</sup> I find, therefore, that the combination of colours used by the applicant (for example the differently coloured halves of the letter O) creates a visual difference, although I bear in mind two points: i) that such a difference resides in aspects of the mark which play less relative weight, and ii) the word mark could notionally be used in a similar red colour to the applied for mark. Thus, weighing the various points of similarity and difference, I consider that overall the marks are visually similar to only a low degree.

40. Aurally, I agree with the opponent’s submission that the word “BEYOND” will be pronounced either as BEE-OND or BEE-YOND. The applicant in its submissions stated that the dominant word element, “BIONT”, will be pronounced as BIO-NEW-T. According to the applicant’s submissions, this pronunciation stems from the abbreviated form of the term “biochemical

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<sup>6</sup> *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19.

<sup>7</sup> See paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47.

nutrition". It is, however, very unlikely for the average consumer to naturally and intuitively pronounce the word "BIONT" as BIO-NEW-T. This presupposes prior knowledge of the applicant's intentions behind the mark (and the reason for it being coined) in order for the consumers to pronounce a rather uncommon word in such a specific way. Therefore, it seems to me that consumers who, when saying the applicant's mark aloud, would say BAI-ONT or BUY-ONT. In addition to the latter pronunciation, the opponent states that consumers may also pronounce the applicant's mark as BEE-ONT. However, in my view, this is less likely.

41. With the pronunciations detailed in the preceding paragraph, both marks (or at least the dominant element in the applicant's mark) are each two syllables long. There is some similarity in relation to the first syllable of the respective words lying between the articulation BAI/BUY in the applicant's mark and BEE in the opponent's mark. The last syllable of the applicant's mark, ending with the articulation ONT, may sound highly similar but not the same as OND/YOND of the earlier mark. The device, of course, will not be articulated, nor are the words "GROWING SUCCESS", likely to be spoken. Overall, there is a medium degree of aural similarity between the marks.

42. Conceptually, the opponent admits "that the marks are distinguishable". Indeed, there is no conceptual link between the two marks. The dictionary word "BEYOND" possesses various meanings, one of which is further along in space, time or degree. Turning to the application's dominant word element "BIONT". Based on the Oxford English dictionary, the word '-biont' occurs only as part of a compound word "forming nouns denoting kinds of living organism, esp. with reference to particular modes of life, as haplobiont, photobiont, protobiont." However, it is very unlikely that the consumers will be aware of such a definition and may perceive it as an invented word. The applicant states that the word "BIONT" "[...] is not like the earlier mark, that is an existing English word, instead it is formed from

Applicant's product concept "biochemical nutrition [...]"<sup>8</sup>. Since there is no evidence to support that consumers are aware of such a concept, I do not consider that the average consumer will attribute any concept to the dominant word element of the contested mark. The leaf device is likely to be seen as decorative. In relation to the words "GROWING SUCCESS", the average consumer may interpret the message either literally or metaphorically as indicating successful growth in relation to plant growth. Whether based on the dominant element, and the mark as a whole, and whatever way the applicant's mark is conceptualised, the meaning of the opponent's "BEYOND" mark, results in the marks being conceptually different.<sup>8</sup>

### **Distinctive Character of the Earlier Trade Mark**

43. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

"In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

In making that assessment, account should be taken, in particular, 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 has been registered; the market share held by the mark;

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<sup>8</sup> See *The Picasso Estate v OHIM*, Case C361/04 P.

how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

44. The opponent has not shown use of its mark and, thus, it cannot benefit from any enhanced distinctiveness; so I have only the inherent distinctiveness of the earlier mark to consider. As noted above, the earlier mark is the well-known and ordinary English word “BEYOND”, which has no real suggestive or allusive significance in relation to the goods for which it is registered. However, I do not consider that the word is highly distinctive or fanciful in the same way an invented word might be. I consider the distinctive character to be medium.

### **Likelihood of Confusion**

45. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred in paragraph 13 of this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa.<sup>9</sup> It is essential to keep in mind the distinctive character of the opponent’s trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to

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<sup>9</sup> See *Canon Kabushiki Kaisha*, paragraph 17.

make direct comparisons between trade marks and must instead rely upon imperfect recollection.<sup>10</sup>

46. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis Q.C., sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

47. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient

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<sup>10</sup> See *Lloyd Schuhfabrik Meyer*, paragraph 27.

that a mark merely calls to mind another mark. This is mere association not indirect confusion.

48. Earlier in this decision, I concluded that:

- The average consumer for the goods and services is a member of the general public, including professionals, who will select the goods and services by predominantly visual means, but without dismissing the aural means, and will likely pay a reasonable degree of attention to the selection of such goods;
- The opponent's mark is inherently distinctive to a medium degree. The opponent has not shown use of its mark and so it cannot benefit from any enhanced distinctiveness;
- The specification of the mark applied for is similar to the opponent's specification for its registered mark to only a low to medium degree;
- The competing marks have only a low degree of visual similarity, a medium degree of aural similarity, and there is conceptual difference between them.

49. Taking all of the above into consideration, the factors persuade me that there is no likelihood of confusion. Looking first at direct confusion, I note that the goods are of only a low to medium degree of similarity. Further, I have found that the purchasing process will be primarily a visual one. In that respect, I have found only a low degree of visual similarity, and in my view the average consumer will be able to distinguish the differences between the earlier mark "BEYOND" and the contested mark. As to the aural similarity, whilst there is a higher degree of aural similarity than the visual one, it is still not acute enough to result in confusion. Last and

importantly, there is a key conceptual difference<sup>11</sup> between the marks. Although not every conceptual difference would be capable of counteracting the visual and aural similarities,<sup>12</sup> in the present case, when weighing the degree of aural and visual similarity, together with the other factors relevant to the global assessment, there will be no likelihood of direct confusion.

50. In relation to indirect confusion, the average consumer having identified that the marks are different, will not make an assumption that the respective undertakings are economically linked. They will recall that the one mark is the word BEYOND, and that the other mark contains a different word as its dominant component. I can see no mental process which would result in the average consumer indirectly confusing the marks. For the sake of completeness, I add that even if I had found that the goods had a higher degree of similarity, I would have reached the same outcome.

## **Outcome**

51. The opposition under sections 5(2)(b) of the Act has failed. Subject to any successful appeal against my decision, the application will become registered in the UK for the full range of goods applied for.

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<sup>11</sup> In *The Picasso Estate v OHIM*, Case C-361/04 P, paragraph 20, the CJEU found that: “By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.” See also *Wearwell Inc v. Work Well Mats Limited*, BL O/055/19.

<sup>12</sup> See *Nokia Oyj v OHIM*, Case T 460/07.

## Costs

52. As the opposition has been unsuccessful, the applicant is, therefore, entitled to a contribution towards its costs. The applicant was not professionally represented and submitted a completed cost proforma to the Tribunal on 2 September 2020, outlining the number of hours spent on these proceedings. I set out below my assessment on the claim made. However, it should be noted that a costs award is intended to be a contribution towards costs rather than full compensation. I will make the award of costs on the basis of £19.00 per hour, which is the minimum rate of compensation allowed under The Litigants in Person (Costs and Expenses) Act 1975 (as amended).

- The applicant claimed 4 hours for considering the forms of opposition, and 8 hours for filing its defence. Whilst I consider the former is a reasonable claim, 8 hours for the notice of defence would, in my view, be an excessive amount to award. I will allow 4 hours for considering the notice of opposition and 4 hours for the defence.
- The applicant has claimed a total of 32 hours for filing submissions and considering those of the other party. Again, I consider it would be excessive to award for all the hours claimed to have been expended. Further, I also note that some of the submissions were not particularly helpful, including those as to the meaning of the mark. I will award 15 hours in total.
- **The total award is £437** (23 hours at £19 per hour).

53. I therefore order BASF Agrochemical Products B.V to pay Biont International Ltd the sum of £437. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an unsuccessful appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 5th day of November 2020**

**Dr Stylianos Alexandridis  
For the Registrar,  
The Comptroller General**