O/0848/24

TRADE MARKS ACT 1994

IN THE MATTER OF
INTERNATIONAL REGISTRATION NO. WO0000001693685
BY AGROTOP GMBH

TO REGISTER THE TRADE MARK:

easyMatic connect

IN CLASSES 7 AND 8

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 438840
BY BASF SE

Background and pleadings

1. On 20 September 2022, agrotop GmbH ("the holder") registered the International trade mark displayed on the front cover of this decision, under number WO0000001693685 ("the IR"). With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The IR claims a priority date of 2 May 2022 from the German Patent and Trademark Office.[1]

2. The IR was accepted for protection in the UK and published in the Trade Mark Journal on 25 November 2022 in respect of the following goods:

    Class 7: Machines and non-hand-operated implements for decanting liquids, in particular plant protection product concentrates; machines for agriculture, forestry and gardening; non-hand-operated implements for agriculture, forestry and horticulture.

    Class 8: Hand-operated tools and implements for agriculture, forestry and horticulture.

2. On 25 January 2023, BASF SE ("the opponent") filed a notice of opposition. The opposition is brought under Section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is directed against all the goods of the application.

3. The opponent relies upon its International Registration Designating the UK, under number WO0000001670758**,**

EASY CONNECT

("the opponent's mark").

[1] Priority claimed from Trademark No. 30 2022 106 972

4. The opponent's mark was registered on 27 May 2022. With effect from the same date, the opponent designated the UK as a territory in which it sought to protect the International Registration under the terms of the Protocol to the Madrid Agreement. The opponent's mark claims a priority date of 5 January 2022 from the European Union Intellectual Property Office.[2] Protection in the UK was granted on 24 February 2023 in respect of goods in classes 5, 6, 7, 20 and 21. However, for the purposes of this opposition only the following goods are relied upon:

    Class 6: Metal hardware; couplings and connectors of metal; metal plugs; closures of metal; metallic cap closures; caps of metal; screw caps of metal; screw tops of metal for containers and bottles; valves of metal; nozzles of metal; parts and fittings for all the aforesaid goods.

    Class 7: Agricultural, gardening and forestry machines and apparatus; sprayers [machines] for agricultural use in spraying fungicides, herbicides, insecticides and parts thereof.

5. Given the respective priority filing dates, the opponent's mark is an earlier mark, in accordance with section 6 of the Act. However, as it had not been registered for five or more years at the filing date of the holder's application, it is not subject to the proof of use requirements specified within section 6A of the Act. Consequently, the opponent may rely upon all of the goods identified without having to demonstrate genuine use.

6. In its notice of opposition, the opponent claims that the competing trade marks are similar as a result of the holder's IR containing within it the words "easy" and "connect", and that the respective goods are either identical (in relation to the opposed class 7 goods) or similar (with respect to the opposed class 8 goods), leading to a likelihood of confusion.

[2] Priority claimed from Trademark No. 18633026

7. The holder filed a counterstatement denying the ground of opposition. The holder concedes that the goods are similar,[3] however, it denies that the marks are similar or that there would be a likelihood of confusion.

8. Only the holder filed evidence in these proceedings. The opponent chose not to file evidence but instead filed written submissions during the evidence rounds. A hearing was requested and held before me, by video conference on 30 January 2024. At the hearing the opponent was professionally represented by Mr McLeod of Elkington & Fife LLP; the holder has been represented throughout these proceedings by Withers & Rogers LLP, however, neither the holder nor its representative attended the hearing.

Relevance of EU law.

9. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence and submissions

10. The opponent filed submissions in chief dated 19 June 2023. The holder's evidence comprises the witness statement of Mr Mark Caddle, a Trade Mark Attorney and Partner at Withers and Rogers LLP, dated 18 August 2023, together with exhibits MC01 to MC05. The purpose of the evidence is to assist with the meanings and distinctiveness of elements within the competing marks. The opponent chose not to file evidence or submissions in reply.

11. Before the hearing the opponent filed a skeleton argument in advance of the hearing. The holder chose not to attend but instead filed written submissions in lieu of its attendance.

[3] Amended Form TM8 filed 30 March 2023, Q8

12. Whilst the parties' evidence and submissions will not be summarised here, I have taken them all into consideration in reaching my decision and will refer to them below, as and where necessary.

DECISION

Legislation

13. Sections 5(2)(b) of the Act read as follows:

> "5(2) A trade mark shall not be registered if because-
>
> […]
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

Case law

14. I am guided by the following principles which 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 might 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. 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."

16. All relevant factors relating to the goods should be taken into account, which include, inter alia:[4]

• the physical nature of the goods;

• their intended purpose;

• their method of use / uses;

• who the users of the goods are;

• the trade channels through which the goods reach the market;

• in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and

• whether they are in competition with each other (taking into account how those in trade classify goods, for instance whether market research companies put them in the same or different sectors)

or

• whether they are complementary to each other. Complementary signifying that "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".[5] Noting that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.[6]

17. When interpreting the terms in a specification, I bear in mind that it is necessary to focus on the core of what is being described and that trade mark registrations

[4] See Canon, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.,* [1996] R.P.C. 281 – the "Treat" case.
[5] *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82, see also *Sandra Amalia Mary Elliot v LRC Holdings Limited,* BL O/255/13
[6] *Kurt Hesse v OHIM*, Case C-50/15 P, se also *Sanco SA v OHIM*, Case T-249/11

should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. Nevertheless, the principle should not be taken too far and 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.[7]

18. Furthermore, I bear in mind the approach in *Sky v Skykick,*[8] where Lord Justice Arnold set out 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 *Gérard Meric v Office for Harmonisation in the Internal Market ('Meric'),*[9] the General Court held that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa.

20. The competing goods to be compared are as follows:

[7] *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12
[8] [2020] EWHC 990, (Ch),
[9] Case T-133/05, paragraph 29

Opponent's goods	Holder's goods
Class 6 Metal hardware; couplings and connectors of metal; metal plugs; closures of metal; metallic cap closures; caps of metal; screw caps of metal; screw tops of metal for containers and bottles; valves of metal; nozzles of metal; parts and fittings for all the aforesaid goods. Class 7 Agricultural, gardening and forestry machines and apparatus; sprayers [machines] for agricultural use in spraying fungicides, herbicides, insecticides and parts thereof.	Class 7 Machines and non-hand-operated implements for decanting liquids, in particular plant protection product concentrates; machines for agriculture, forestry and gardening; non-hand-operated implements for agriculture, forestry and horticulture. Class 8 Hand-operated tools and implements for agriculture, forestry and horticulture.

21. Within the holder's notice of defence it appears to accept that the competing goods are similar.[10] However, it fails to identify the exact applied for goods that it believes are similar to the registered goods relied upon and the level to which it believes that they are similar. I acknowledge that later within its written submissions the holder asserts, "*The Opponent's Goods in Class 6 are dissimilar to the Holder's Goods as they differ in nature, method of use, purpose and end users. They are neither in competition, nor complementary*."[11]

22. I pause here. At the hearing Mr McLeod raised as a preliminary point the lateness with which the holder had raised that the class 6 goods under the opponent's mark were dissimilar to its goods. Further, Mr McLeod interpreted the later statement as a change in position. Whilst I accept that this has occurred at a rather late stage

[10] Amended Form TM8 filed 30 March 2023, Q8
[11] Holder's written submissions, paragraph 22.

within these proceedings, it does appear to be a clarification rather than a change in position or submission that is necessarily contrary to the pleadings. As discussed above, whilst the holder accepts within its notice of defence that the competing goods are similar it has not identified precisely which ones, nor the degree to which they are similar. In my view, all the later remark appears to do is clarify that the applied for goods are not similar to the class 6 goods relied upon. If the holder was now asserting that some of the applied for goods were not similar to any of the earlier goods, then I accept that would be a contradiction, but it is not, it is simply saying that although the applied for goods are similar to the earlier goods (the degree of similarity not specified) that they are not similar to the class 6 goods relied upon. In relation to the lateness in which this clarification was made, I do not consider that to be detrimental to the opponent, as the opponent had received the holder's written submissions and moreover had the opportunity at the hearing to respond to the submission.

23. In any event, given my findings below, I do not consider that Mr McLeod's submissions takes the opponent's case any further.

Class 7

Machines for agriculture, forestry and gardening; non-hand-operated implements for agriculture, forestry and horticulture

24. The above applied for goods are self-evidently identical to the opponent's term "*agricultural, gardening and forestry machines and apparatus*" which simply describe the same goods in an alternative way.

Machines and non-hand operated implements for decanting liquids, in particular plant protection product concentrates

25. The above goods are machines that are typically used in, and for the purpose of, agriculture. Therefore, it follows that the applied for goods would be encompassed within the opponent's broad term "*agricultural, gardening and forestry machines and apparatus*", consequently, the competing terms are *Meric* identical.

Class 8

Hand-operated tools and implements for agriculture, forestry and horticulture.

26. The holder's goods in class 8, clearly differ in method of use (and, to some extent, nature) to the opponent's goods "*agricultural, gardening and forestry machines and apparatus"* in class 7, as they are operated in different ways. The holder's goods being operated by manpower whereas the opponent's goods are obviously machine operated given that they are found in class 7. Without evidence to the contrary, the goods do not appear to be complementary as they are not important or indispensable to the use of the other, for example, a shovel is not required in order to use an electric or diesel cultivator. Furthermore, consumers are not likely to believe that the same undertaking is responsible for the competing goods. However, the purpose would overlap as the competing goods are both used in agriculture, forestry, and gardening/horticulture. As a result, the goods would most likely be in competition with each other, as the user could choose to purchase agricultural machines that may be quicker to use or cover a larger surface area or the equivalent hand tools that would allow for more precision and efficiency. Users would be the same, and in some cases distribution channels may overlap, for example, where goods are sold by retailers targeting users within the agriculture and forestry industry. Overall, in my view there is, at least, a medium degree of similarity between the competing goods.

The average consumer and the nature of the purchasing act

27. As indicated in the caselaw cited above, it is necessary to decide who the average consumer is for the parties' goods and how they purchase them. "Average consumer" in the context of trade mark law means the "typical consumer."[12] The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of

[12] *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch).

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.[13]

28. Due to the nature of the goods at issue, I find that the average consumer would be either a member of the general public who is interested in gardening and horticulture, or farmers and business users within the agricultural and forestry industry.

29. With respect to members of the general public who have an interest in gardening or horticulture, the goods are likely to be purchased occasionally and range in price, but overall, they are unlikely to be prohibitively expensive. Members of the general public are likely to consider factors such as, cost, ease of use, compatibility, and quality. Overall, the average consumer will exercise a medium level of attention during the selection process. The goods are typically available from physical retail outlets specialising in gardening and horticultural equipment and their online equivalents. The purchasing process will predominately be visual in nature, although I do not discount there may be an aural element where retail assistants or word-of-mouth recommendations are involved.

30. As for farmers and business users within the agricultural and forestry industry the goods are likely to be relatively expensive given that they will be needed for use on an industrial scale, although I appreciate that some handheld tools such as a spade or an axe for example are likely to be less expensive. The goods will be purchased on a semi regular basis to meet business demands. Farmers and business users are likely to have similar considerations to members of the general public, but with added business considerations, such as, reliability (as the equipment is likely to be used with greater frequency in a more demanding environment), and efficiency given that farmers and business users will have to tackle larger areas at speed to be most profitable. Overall, they will exercise a higher than medium level of attention throughout the purchasing process. The goods are typically available from agricultural trade shows and specialist agricultural retailers and their online equivalents. The purchasing process will

[13] *Lloyd Schuhfabrik Meyer*, Case C-342/97.

predominately be visual in nature, although I do not discount an aural component entirely.

Distinctive character of the opponent's mark

31. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the Court of Justice of the European Union ("CJEU") stated that:

> "22. 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).
>
> 23. 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; 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)."

32. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a

characteristic of the goods to those with high inherent distinctive character, such as invented words which have no allusive qualities. Dictionary words which do not allude to the goods will be somewhere in between. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion: the more distinctive the earlier mark, the greater the likelihood of confusion.

33. Further, although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use (nor was it required to do so). Consequently, I have only the inherent position to consider.

34. The opponent's mark is a figurative mark that consists of the word "EASY" sat above the word "CONNECT", both words in bold, upper-case font. Within the mark is a device element consisting of a horizontal line with two dots at each end, which could give the perception of linking together the first two letters of the word "CONNECT". The mark is presented in the colour black.

35. On the issue of distinctiveness of the opponent's mark, the holder argues:

> "[…] as submitted by the Holder in their defence, the Opponent's Mark has a low level of distinctiveness and is descriptive of the goods relied upon in the opposition proceedings in Class 6 and 7, namely it will be considered to have the meaning of an easy way to connect goods and/or their accessories."

36. The holder also points to the *Easy Group Limited V Easy Life Limited* case,[14] where it was held that the word easy is not distinctive, instead finding it to be a descriptive word.[15]

37. In contrast, for the opponent, Mr McLeod contended at the hearing that the opponent's mark was not directly descriptive in relation to the goods at issue as the specification of the opponent's mark is broader than connectors or connecting

[14] [2021] EWHC 2150 (Ch)
[15] Ibid, paragraph 266

products. Further, Mr McLeod relied on the F1 case,[16] to support his point that as the mark had been registered it must possess some level of distinctiveness.

38. It is clear from the case law referred to above that the word "EASY" itself will be viewed as descriptive. As for the word "CONNECT" the typical nature or method of use of the goods in the context of agricultural and horticultural machinery and/or hand-held equipment would not result in the word "CONNECT" being viewed as purely descriptive. However, where the goods themselves are apparatus for connecting equipment together, such as "couplings and connectors of metal" the word "CONNECT" will be purely descriptive of the goods. When used in conjunction with one another, the words "EASY CONNECT" may be perceived for those goods where the word "CONNECT" is not purely descriptive as allusive or laudatory, i.e. that the goods are easy to connect together. With regards to the figurative device element (described above at paragraph 34), whilst it provides a contribution to the overall distinctive character it is not particularly distinctive as it will be perceived as merely reiterating the 'connect' meaning. As for the bold font and stylisation, these are unremarkable and have little trade mark significance in the mark as a whole hence these elements do not elevate the distinctive character of the mark. Consequently, overall, I find that the opponent's mark enjoys a low level of inherent distinctiveness.

Comparison of the marks

39. It is clear from *Sabel* (cited above) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, Case C-591/12P, that:

[16] *Formula One Licensing BV v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-196/11P

"34. […] 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."

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

41. The respective trade marks are shown below:

Opponent's mark	Holder's mark
	easyMatic connect

Overall impressions

42. The opponent's mark is described above, within the distinctive character section. The overall impression of the mark lies in the combination of the words "EASY" and "CONNECT", albeit individually they are not particularly distinctive. The device connecting the letters "C" and "O" also contributes to the overall impression of the mark as a whole, but to a lesser degree in comparison to the words. However, the emboldening of the letters and the typeface used will have little impact on the overall impression.

43. The IR is a word only mark comprising the words "easyMatic connect". I have taken into account the arguments made by the parties regarding how the element "Matic" will be viewed by the average consumer. The opponent states that:

> *"In its counterstatement the Holder argues that the existence of the -matic element in the opposed mark is adequate to render the respective marks dissimilar. The opponent disputes this position and submits that it is inadequate and not sustainable. The -matic element is commonly used in the English language as a suffix derived from the Latin word which means something that operates or acts on itself or the prefix so in the context of the opposed mark, the -Matic element does not differentiate from the Earlier Mark as asserted by the Holder."*[17]

44. In contrast to the opponent's submissions, Mr Caddle states for the holder the following within his witness statement:

> *"4. The Opponent submits that '-MATIC' as a suffix has a meaning derived from Latin meaning that something operates or acts on itself, Enclosed at **Exhibit MC01** are the results of an internet search for 'matic suffix meaning'. As can be seen from the first page of results, no clear and consistent meaning is provided for '-matic' as a suffix.*
>
> *5. Further, enclosed at **Exhibit MC02** are examples of other words with '-matic' as a suffix. As can be seen from the selection of meanings included at this Exhibit, no consistent meaning has been given to those words which include '-matic' as a suffix. It cannot be said to have the meaning presented by the Opponent.*
>
> *6. Enclosed at **Exhibit MC03** are the results from searches completed on the Cambridge online dictionary and Merriam-Webster online dictionary which demonstrate that 'MATIC' has no meaning."*

[17] The opponent's written submissions, paragraph 9.

45. Having viewed the evidence referred above, in so far as the dictionary definitions are concerned, the Merriam-Webster online dictionary is attributed to the US, and, as such is not reflective of the position in the UK. I shall only, therefore, consider those definitions that are relevant to the average UK consumer, and which are commonly known. The Oxford online dictionary defines Matic as "*-matic comb. form. Forming words (typically proprietary or brand names) denoting devices which work automatically or mechanically".*[18] Consequently, I accept that the element "Matic" alludes to a device that operates on its own or is mechanical. As such, I consider the word "easyMatic" to be an inventive blended word that consumers will identify as consisting of "easy" and "Matic".[19] Whilst I do not consider this portmanteau word to be descriptive of the goods at issue, I do acknowledge that it is allusive of automatic or mechanical goods that are easy to use, perhaps being perceived as a play on the word automatic. Taking all the above into account, in my view, the overall impression of the IR rests within the words "easyMatic" and "connect" in roughly equal measure, but with "easyMatic" playing a slightly greater role as an invented word, albeit from the combination of words found commonly within the English language.

Visual comparison

46. The competing marks are visually similar in that they both contain the identifiable words "easy" and "connect", although in the applied for mark, the word "easy" appears within the invented word "easyMatic". The marks differ in the addition of the element "Matic" which is present within the IR but not in the opponent's mark. Equally, the opponent's mark contains a figurative device element (described above) which is not replicated within the IR. I also note that within the opponent's mark the words are presented with the first word sat above the second word and in bold font. Further, the opponent's mark appears in upper case font, however, I acknowledge that any distinction in letter case between the opponent's mark and the IR will not be considered as a point of significant difference between them.

[18] I refer to BL O/0293/24 paragraph 31, where Emma Himsworth KC acting as the Appointed Person confirmed that it was open to the hearing officer to consult dictionaries as part of the decision making process.
[19] *Usinor SA v OHIM*, Case T-189/05, consumers tend to naturally break down trade marks into elements which they can identify and understand

This is because the registration of word-only marks, such as the applied for mark, provides protection for the words themselves, irrespective of whether they are presented in upper or lower case.[20] The marks also differ in length as a result of the added element "Matic" in the applied for mark. Weighing up the similarities as against the differences and taking into account the overall impressions of each, I find that the competing marks are visually similar overall to no more than a medium degree.

Aural comparison

47. The holder argues:

> "Whilst the Opponent submits that Matic has a soft pronunciation, this is incorrect owing to the capitalisation of the letter M. The capitalisation will lead consumers to stress and add emphasis to that letter and Matic.
>
> Furthermore, the Opponent's Mark is four syllables in length, whereas the Application is six syllables in length. The additional syllables in the Opponent's Mark will have an impact on the average consumer and will create a different phonetic impression."[21]

48. In contrast, although the aural similarities were not a focal point at the hearing, I observe that the opponent claims within its statement of grounds that:

> "Phonetically, UK consumers would pronounce the 'easy' and 'connect' elements of the marks in the same way. The 'matic' element of the IR has a soft pronunciation so can be lost to the listener when combined with the 'easy' and 'connect' word. The marks are therefore phonetically similar to a high degree.[22]

49. The opponent's mark would be verbalised as "EE/ZEE/CON/NECT" therefore containing four syllables. Whilst the IR will be articulated as "EE/ZEE/MAT/IC/CON/NECT" consisting of six syllables. The competing marks

[20] *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16
[21] Holder's written submissions in lieu of the hearing, paragraphs 13 and 14.
[22] Opponent's statement of grounds, paragraph 7

differ in the number of syllables they possess, and whilst the first two and the last two syllables are identical, they differ in the additional two syllables found in the IR that are absent from the opponent's mark. Although I accept that some syllables are the same, the additional letters in the IR create an aural difference. I do not accept that the "Matic" element has a soft pronunciation that will be lost to the listener despite being positioned in the middle of identical syllables. This is because the two additional syllables resulting from the element "Matic" break up the articulated rhythm of the opponent's mark. Producing not only a noticeable difference in length, but importantly a noticeable difference to the overall pronunciation. Consequently, I find the marks to be aurally similar to a medium degree.

Conceptual comparison

50. I observe that the parties have differing opinions on the meaning of 'Matic' or 'easyMatic', as discussed above. I remind myself that for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.[23]

51. Considering first the opponent's mark, this will be understood in line with the ordinary meanings of the words. "Easy", meaning something that is simple to achieve and effortless, whilst "connect" means to link or join together. As a result, overall, the mark will be understood as meaning easy to connect. As for the figurative element, this is likely to be perceived as reinforcing the connect message as it joins together the letters "C" and "O" within the word "CONNECT".

52. With regards to the IR, as discussed above, I consider the word "easyMatic" to be an inventive blended word consisting of the word "easy" and the element "Matic", which will be understood as alluding to something that is easy to use and operates on its own or is mechanical, perhaps being perceived as a play on the word automatic. The word "connect", which is found within both the competing marks, will be perceived in the same way, i.e. joining or linking together. Whilst I acknowledge that both marks evoke the concept of ease and have the shared

[23] *Ruiz Picasso v OHIM* [2006] E.T.M.R 29.

meaning in the word “connect”, it does not follow that the later mark conveys the concept of being easy to connect in the same way that the opponent’s mark does. Indeed, it creates the idea of something that is easy to use because it is automatic or mechanical in nature. Bearing in mind my assessment of the overall impressions, to the extent that the marks convey a meaning, they are conceptually similar to a medium degree.

Likelihood of confusion

53. Whether there is a likelihood of confusion must be assessed globally, taking into account a number of factors. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods, and vice versa. It is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be aware of the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

54. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

55. In relation to assessing the likelihood of confusion where the common element has no or low distinctiveness, I keep in mind that in *Face2FaceHR Partners Limited v Peninsula Business Services Limited*,[24] Emma Himsworth K.C. as the Appointed Person, reviewed the case law in *Whyte and Mackay v Origin*[25] and *Nicoventures Holdings Limited v The London Vape Co Ltd,*[26] as well as guidance in the Common

[24] O/0368/23
[25] [2015] EWHC 1271 (Ch)
[26] [2017] EHWC 3303 (Ch),

Communication on the Common Practice of Relative Grounds of Refusal - Likelihood of Confusion (impact of non-distinctive/weak components) dated 2 October 2014, which is referred to in the case law. Ms Himsworth summarised the correct approach as follows, at paragraph 44:

> "(1) The distinctiveness of the mark as a whole must be assessed, taking into account that a minimum degree of distinctiveness must be acknowledged.
>
> (2) The distinctiveness of each of the components of both marks must be assessed with priority being given to the coinciding elements.
>
> (3) The focus of the assessment of the likelihood of confusion should be on the impact of the non-coinciding components on the overall impression of the mark.
>
> (4) Account must be taken of the similarities/differences in the non-coinciding elements of the marks.
>
> (5) A coincidence of an element with a low level of distinctiveness will not usually lead to a likelihood of confusion.
>
> (6) There may be a finding of a likelihood of confusion if (a) the non-coinciding elements of the mark are of lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression is similar; or (b) the overall impression of the marks is highly similar or identical."

56. Further, I note that in *General Ecology, Inc. v Wan Jou Lin & Great Ins Company Ltd*,[27] Professor Phillip Johnson, as the Appointed Person, found that marks **NATURE PURE**, and 

were confusingly similar, despite the common

[27] O/0331/23

elements only having low distinctiveness. Furthermore, I remind myself that a low level of distinctiveness does not preclude a likelihood of confusion.[28]

57. I have found identity for some of the respective goods and a medium level of similarity of others. The average consumer of the goods will be either a member of the general public who is interested in gardening and horticulture and will pay a medium level of attention, or farmers and business users within the agricultural and forestry industry who will pay a higher than medium level of attention. I have found that the purchasing process will be largely visual, however, I have not discounted aural considerations. I have found that the opponent's mark and the IR are visually similar to no more than a medium degree, and aurally and conceptually similar to a medium degree. I have also found that the opponent's mark possesses a low level of inherent distinctive character overall.

58. I acknowledge that both marks contain the identical words/elements "easy/EASY" at the beginnings of the respective marks, a position where the attention of consumers is usually directed, and "connect/CONNECT" at their ends. However, the marks differ in the use of the element "Matic" attached to the word "easy" within the IR. In my view, given how descriptive/allusive the words "easy" and "connect" are, the addition of the element "Matic" (to produce an inventive portmanteau word) will not be overlooked; indeed, its inclusion creates a visual, aural and conceptual difference between the competing marks. Further, in the opponent's mark the figurative element also creates a visual difference. Consequently, it is unlikely that the competing marks will be mistaken or misremembered for one another. Rather, the aforementioned differences are likely to be sufficient to enable consumers to differentiate between them. In my judgement, taking all the above factors into account, the differences between the competing trade marks are likely to enable consumers, even those paying a medium level of attention, to avoid mistaking the marks for one another. Notwithstanding, the principles of imperfect recollection and interdependency. As a result, I find that there is no likelihood of direct confusion, even in relation to goods that are identical.

[28] *L'Oréal SA v OHIM*, Case C-235/05 P

59. That leaves indirect confusion to be considered. In L.A. Sugar Limited v By Back Beat Inc, Case BL O/375/10, Mr Iain Purvis K.C., 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.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).
>
> (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.)
>
> (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

60. These examples are not exhaustive but provide helpful focus.

61. I bear in mind that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion. Furthermore, in *Liverpool Gin*,[29] Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (Case BL O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

62. Whilst consumers will recognise the common words/elements, "easy/EASY", and "connect/CONNECT, these are words that are, at best, low in distinctive character, and, as such, consumers will not consider that only the opponent would use these words within its mark. Therefore, despite the identity of the goods, any connection based on commonality of the shared words "easy" and "connect" will only result in a bringing to mind of another mark. Keeping in mind the words of *Arnold J* in *Whyte and Mackay v Origin*,[30] *"…what can be said with confidence is that, if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion",* in my view, the mere shared presence of these frequently used words is insufficient for a finding that there is a likelihood of confusion. In my judgement, consumers will identify the conjoined word "easyMatic" as originating from a different undertaking to the opponent's mark, rather than identifying it as a logical brand extension. The common elements/words "easy/Easy" and "connect/CONNECT" will be seen as merely coincidental.

[29] *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207
[30] [2015] EWHC 1271 (Ch) para 44

Conclusion

63. The opposition under Section 5(2)(b) of the Act has failed. Therefore, subject to any successful appeal against my decision, the application will proceed to registration.

Costs

64. As the holder has been entirely successful, it is therefore entitled to a contribution for its costs based upon the scale published in Annex A of the Tribunal Practice Notice 2 of 2016. Applying this guidance, I award the holder the sum of **£1000**, which has been calculated as follows:

Considering a notice of opposition and preparing a counterstatement:	£200
Preparing evidence and considering and commenting on the other sides submissions:	£500
Preparing written submissions in lieu of hearing:	£300
Total:	**£1000**

65. Accordingly, I hereby order BASF SE to pay agrotop GmbH the sum of **£1000**. This sum is to be paid within twenty-one days of the expiry of the appeal period, or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 3rd day of September 2024

Sarah Wallace
For the Registrar