

**O/0931/24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3686117**

**BY UPL CORPORATION LIMITED**

**TO REGISTER THE TRADE MARK:**

**Nimaxxa**

**IN CLASS 5**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 429325**

**BY SYNGENTA CROP PROTECTION AG**

## BACKGROUND AND PLEADINGS

1. On 25<sup>th</sup> August 2021, UPL Corporation Limited (“the applicant”) applied to register the trade mark shown on the cover of this decision in the United Kingdom. The application was accepted and published in the Trade Marks Journal on 24<sup>th</sup> September 2021, in respect of the following goods:

**Class 5:** *Herbicides, pesticides, insecticides, fungicides, vermicides, rodenticides, weedicides, preparations for killing weeds and destroying vermin.*

2. On 17<sup>th</sup> December 2021, Syngenta Crop Protection AG (“the opponent”) opposed the application based on Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods in the application. The opponent relies upon the earlier mark, an International Registration, (“IR”) shown below:

**WO0000001525095**

**NIMACTRA**

Registered on 25<sup>th</sup> February 2020 and protected in the UK on 25<sup>th</sup> June 2020, with a Swiss priority date of 24<sup>th</sup> December 2019.

Relying upon the following goods:

**Class 1:** *Active chemical ingredients for manufacture of fungicides, herbicides, insecticides, nematocides; chemical products used in agriculture, horticulture and forestry; bio-stimulant products; preparations for improving crops; preparations for fortifying plants; chemical and/or biological preparations for stress management in plants; plant growth regulating preparations; chemical preparations for seed treatment; additives.*

**Class 5:** *Products for destroying vermin; fungicides, herbicides, insecticides, nematocides.*

3. The opponent's IR qualifies as an "earlier trade mark" in accordance with Section 6 of the Act, as its filing date is earlier than the filing date of the applicant's mark. Since the opponent's earlier mark had been protected for less than five years at the filing date of the applicant's mark, it is not subject to the use provisions specified in Section 6A of the Act.
4. Under Section 5(2)(b), the opponent claims that the marks have a high degree of visual and aural similarity and cover identical, highly similar and complementary goods, resulting in the likelihood of confusion or association. It submits that the aural similarity is strong, in particular quoting the identical "NIMA-" element, as well as both marks sharing the same number of syllables and ending in the letter "A". The opponent submits that, due to the similarities between the marks, "it is without doubt that the Application will be taken to refer to goods which originate from or are endorsed by the Opponent".<sup>1</sup>
5. The applicant filed a counterstatement denying that its mark is highly similar to the earlier mark. This also included that:
  - The applied for mark contains a "highly unusual and noticeable "XX" element" which would be "highly memorable to the average consumer".<sup>2</sup>
  - That the marks are aurally distinct from one another.
6. In these proceedings, the opponent is represented by CMS Cameron McKenna Nabarro Olswang LLP and the applicant by Groom Wilkes & Wright LLP.

## **EVIDENCE AND SUBMISSIONS**

7. The opponent filed written submissions but only the applicant filed evidence. This is in the form of a witness statement, dated 29<sup>th</sup> November 2023 from Dr Vishal A. Sodha, an authorised representative and signatory of UPL Corporation Limited, a position he has held since 16<sup>th</sup> May 2019. This is accompanied by 5 exhibits. It denies the allegation that the two marks are confusingly similar. The

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<sup>1</sup> Paragraph 8 of statement of grounds.

<sup>2</sup> See paragraph 3.

evidence covers the nature and origins of the applicant via screenshots of the applicant's website and details of industry awards it has received. It also highlights and provides information on previous opposition actions in other jurisdictions. Finally, the remainder relates to the applicant's assertions that the term 'NIMA' is used by numerous marks for class 5 goods on the UK trade mark register and that 'NIMA/NEMA' (which it submits is a reference to the goods being a nematicide) is commonly used by multiple companies for class 5 products in the marketplace. The applicant claims that this demonstrates how the prefix 'NIMA' is not exclusive to any single company and that products may co-exist within the marketplace.

8. Both parties filed submissions during the evidence rounds. No hearing was requested though the applicant also submitted written submissions in lieu of a hearing. This decision is taken following careful consideration of all the papers before me. I have not summarised the evidence and the submissions in full, but they will be referenced within this decision to the extent that is necessary.

## **DECISION**

### **Section 5(2)(b)**

9. Section 5(2)(b) of the Act is as follows:

“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.”

Section 5A states:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade

mark is applied for, the application is to be refused in relation to those goods and services only.”

10. In considering the opposition under this section, I am guided by the following principles which are taken from the decisions of the Court of Justice of the European Union (“CJEU”) 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 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-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:<sup>3</sup>

### **The principles**

(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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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;

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<sup>3</sup> 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.

(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 greater 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; and

(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

11. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court of the European Union (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

12. The goods to be compared are as follows:

The applicant’s goods	The opponent’s goods
<p><b>Class 5:</b> <i>Herbicides, pesticides, insecticides, fungicides, vermicides, rodenticides, weedicides, preparations for killing weeds and destroying vermin.</i></p>	<p><b>Class 1:</b> <i>Active chemical ingredients for manufacture of fungicides, herbicides, insecticides, nematocides; chemical products used in agriculture, horticulture and forestry; bio-stimulant products; preparations for improving crops; preparations for fortifying plants; chemical and/or biological preparations for stress management in plants; plant growth regulating preparations; chemical preparations for seed treatment; additives.</i></p> <p><b>Class 5:</b> <i>Products for destroying vermin; fungicides, herbicides, insecticides, nematocides.</i></p>

13. The applicant admits that “*herbicides*”, “*insecticides*”, “*fungicides*”, and “*preparations for destroying vermin*” are identical to the opponent’s “*herbicides*”, “*insecticides*”, “*fungicides*” and “*products for destroying vermin*”.<sup>4</sup>

14. The applicant argues that the remaining terms within its specification have only similarity with the opponent’s class 5 goods, whereas the opponent argues that all these are identical to corresponding class 5 terms for which its earlier mark is registered, through the principles outlined in *Meric*. I will cover each of the contested terms in turn below. In conducting this assessment, I have considered *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), in which Floyd J. (as he then was) stated that:

“... 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 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.”

15. Additionally, I bear in mind *Sky v Skykick* [2020] EWHC 990 (Ch), in which 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:

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<sup>4</sup> Paragraph 8 of counterstatement.

- (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.”

### Pesticides

16. The opponent submits that these are “meant to control pests” and would therefore include its registered terms “*herbicides*”, “*insecticides*” and “*nematicides*”.<sup>5</sup> The applicant refutes this.<sup>6</sup> My understanding of the word “pest”, in a gardening, agricultural or household management context, is a reference to an undesirable insect or small animal which has a damaging effect on plants, crops or the home. I am content that the term “*insecticides*” would be encompassed within the natural and core meaning of the opponent’s “*pesticides*”, and therefore that this is a sufficient basis on which to find them identical under the principles in *Meric*.
17. I note my assessment here runs contrary to the views provided within the applicant’s submissions, in particular that:

“...“*insecticides*” are chemical preparations used to control insects and are only used for this function. As this product is very specific and has a single purpose, we maintain that although it is similar to “*pesticides*” it is not strictly identical as the average consumer will readily understand its specific function and will not consider it a general “*pesticide*” product”.<sup>7</sup>

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<sup>5</sup> See paragraph 29 of written submissions submitted 30<sup>th</sup> August 2023.

<sup>6</sup> See paragraph 23 of its observations in reply dated 27<sup>th</sup> October 2023.

<sup>7</sup> Paragraph 24 of the applicant’s observations in reply.

18. It appears that the crux of the applicant's argument is that the average consumer will be well aware that the purpose of an insecticide is to control insects and therefore will perceive it specifically as an "*insecticide*", rather than under the more general term of "*pesticide*". Even if this is the case, i.e. the average consumer is more likely to understand that (or refer to) the product as an insecticide than a pesticide, I cannot see how this impacts the finding that a pesticide is a general term used to refer to chemicals intended control undesirable insects/small animals. Therefore, that an insecticide is an example of a type of pesticide. With this being the case, it is clear that, under the principles defined within *Meric* (highlighted above at paragraph 11), the terms should be considered identical for the purposes of this comparison. However, if the applicant's view is instead that an insecticide cannot (or should not) be considered a pesticide, then it should have submitted submissions and evidence specifically to address this.

19. Having found identity between "*pesticides*" and the term "*insecticides*" within the opponent's specification, it is not necessary for me to consider the similarity between "*pesticides*" and the opponent's "*herbicides*" or "*nematicides*".

### *Vermicides*

20. The opponent submits at paragraph 30 of its written submissions that the term "*vermicides*" is used interchangeably with "*nematicides*" in that both refer to substances used for killing worms in animals or plants. I have received no evidence to support this claim, though note the applicant has not specifically addressed this point beyond its submission that the terms are merely similar. In the absence of evidence, but basing my assessment on dictionary definitions to ascertain their natural and core meaning, I am content that the terms are directly identical or, at the very least, that "*nematicide*" is encompassed within "*vermicide*" and thus identical according to *Meric*.<sup>8</sup>

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<sup>8</sup> All definitions from the Collins Dictionary accessed 12/09/24: Vermicide: "any substance used to kill worms" (<https://www.collinsdictionary.com/dictionary/english/vermicide>) Nematicide: "a pesticide substance or preparation used to kill nematodes" (<https://www.collinsdictionary.com/dictionary/english/nematicide>) Nematode: "any unsegmented worm of the phylum (or class) Nematoda, having a tough outer cuticle." (<https://www.collinsdictionary.com/dictionary/english/nematode>)

### Rodenticides

21. My understanding of the word “rodent” is reference to small animal, usually a rat or mouse and that “vermin” relates to the same type of animal but in the context of them being unwelcome in a particular scenario, e.g. due to a hygiene risk or risk they will cause damage to a premises, building or its contents. Therefore, it is my view that “rodenticides” (as a substance intended to kill rodents) is identical to the opponent’s “products for destroying vermin.” I note the applicant disagrees on this, for similar reasons as those provided for “insecticides” and “pesticides” – i.e. that one is a general term whereas the other is a specific term. My response to this is the same as to that provided at paragraph 18 above, that instances where a specific term is encompassed within a more general term is addressed within *Meric* and is a valid basis upon which to find the two terms identical.

### Weedicides, preparations for killing weeds

22. The opponent asserts that these terms fall under the general category of “herbicides.” I agree and this is consistent with the definition of herbicides as: “a chemical that is used to destroy plants, especially weeds.”<sup>9</sup>

23. As I have already found identity across the class 5 goods, it is not necessary to consider the applicant’s class 5 goods with respect to the opponent’s class 1 terms.

### **The average consumer and the nature of the purchasing act**

24. As the case law indicates, it is necessary for me to determine who the average consumer is for the goods. I must then determine the manner in which these goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership*

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<sup>9</sup> From the Collins Dictionary accessed online 12/09/24:  
<https://www.collinsdictionary.com/dictionary/english/herbicide>

*(Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. 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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.

25. The opponent submits in its written observations that the average consumer is a member of the general public with an interest in gardening or an agricultural business. Regarding the former group, it proposes that these general consumers will buy the goods frequently, at low cost. Furthermore, that the purchasing process will be less considered (compared to a business consumer), based not on cost but efficacy and that, since the goods only perform one function, the level of attention is likely to be low or, at best, average. For the second group (the agricultural business), the opponent submits that cost and suitability for business needs will be key and that, given the potential impact on the business, they may pay a slightly higher than average degree of attention to the purchasing process.

26. The applicant highlights that the goods are toxic and therefore require handling with great care, its argument here being that the average consumer will demonstrate a higher level of attention during the purchasing process, especially consumers with pets or children to consider.<sup>10</sup> The applicant also disagrees with the opponent’s suggestion that the average consumer will be limited to members of the public with an interest in gardening.

27. In terms of my own assessment, I broadly agree with the two consumer groups identified by the opponent, though with the clarification that I would consider users such as farmers in the “agricultural business” group and taking on board

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<sup>10</sup> Paragraph 34 of observations in reply.

that the applicant's argument that the "general public" group may include those with an interest in gardening or more general pest management. I disagree in relation to the level of attention applied by the opponent to each group. It is my view that even a recreational gardener (or general homeowner), whilst being unburdened by business considerations, will be invested in ensuring that the product they select has the desired effect and doesn't negatively impact the plants and crops (or premises) they are looking to safeguard. I think the purchase of the goods will be reasonably infrequent and that both cost and efficacy will play a part in the selection of the goods, plus factors such as environmental impact. I also take on board the applicant's comment regarding the potential toxicity of the goods and that this consideration will have a role in the selection of goods. Overall, I consider that the level of attention is likely to be slightly higher than average. In relation to the second group, comprising agricultural businesses, I consider that the cost, efficacy and environmental impact will also be key considerations but that the direct relationship between the goods and the business' commercial success (e.g. the impact the goods will have on yield) will lead to a high attention to detail being paid.

28. I note the opponent asserts that purchasing process will be largely visual but that there is likely to be an aural impact where the average consumer discusses goods with salespersons or through word-of-mouth recommendations.<sup>11</sup> I agree. For both groups, consumers are likely to select the goods visually, for example where they are displayed and self-selected from shelves in garden centres, supermarkets or 'DIY' and hardware stores or, in the case of the business consumer group, more specialist agricultural retail premises. Goods may also be purchased online or from the pages of a catalogue, where consumers will select the goods relying on the information and images displayed on webpages or within printed publications. Word-of-mouth recommendations or conversations with salespeople may also play a part, so aural considerations will play a role. Whilst being applicable to both consumer groups, this is more relevant for the business consumers, who may seek advice from, or engage in discussions with, agronomists or experts/representatives from agricultural companies prior to

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<sup>11</sup> Paragraph 43 of written submissions.

purchase.

### Comparison of the marks

29. 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.”

30. It would be wrong, therefore, to dissect the marks artificially, 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.

31. The respective marks are shown below:

Applicant's contested mark	Opponent's earlier mark
Nimaxxa	NIMACTRA

## **Overall Impression**

32. Both marks are word only marks of a single word, in which the overall impression resides. The opponent's mark comprises the invented word "NIMACTRA" in upper case. The applicant's mark comprises the invented word "Nimaxxa" in title case. The fact that the earlier mark is registered in upper case and the contested mark is sought to be registered in title case is immaterial. In paragraph 39 of *LA Superquimica v European Union Intellectual Property Office*, Case T-24/17, the GC held that such plain word marks protected the word or words contained in the mark in whatever form, colour or typeface.

## **Visual similarity**

33. Both marks begin with the same four letters and in the same order, "NIMA". The points of difference resides in the total number of letters and the ends of the marks – ending with the three letter "XXA" or four letter "CTRA" for the applicant and opponent, respectively. The opponent submits that there is a high degree of visual similarity whereas the applicant considers them visually dissimilar. On balance, I find that the applicant's mark is visually similar to the opponent's mark to a low to medium degree.

## **Aural similarity**

34. The opponent deems the marks are highly similar from an aural perspective. It highlights that the first two syllables would be pronounced the same across both marks but admits there would be "subtle difference" in how the last syllable is articulated in each mark.<sup>12</sup> In terms of pronunciation, the opponent suggests this would be 'NI-MAC-TRA' for its mark, versus 'NI-MAC-SA' for the applicant's mark.

35. The applicant admits that both marks have the same number of syllables but submits the marks are phonetically dissimilar when considered in their entirety. Its arguments are focussed on the "XXA" element of its mark having a "soft

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<sup>12</sup> See paragraph 20 of opponent's written submissions.

pronunciation”, whereas the opponent’s “CTRA” ending is pronounced “much more harshly and very differently”.<sup>13</sup> It submits that the marks will be pronounced “NIM-AXX-A” and “NIM-AC-TRA”.<sup>14</sup>

36. In terms of my own assessment, I agree in that the phonetic differences between the marks lie in the endings of the words. I believe that the applicant’s mark would be pronounced “NIM-MAX-SA” and the opponent’s mark as “NIM-MACK-TRA”, which appear to correspond with the applicant’s suggestions, albeit with different spellings.<sup>15</sup> Overall, I consider that these leads to a medium to high degree of aural similarity.

### **Conceptual similarity**

37. Both marks are invented words and the applicant and opponent agree that neither is likely to convey any specific meaning to the average consumer.<sup>16</sup> Therefore the marks are conceptually neutral and there is no conceptual similarity.

### **Distinctive character of the earlier mark**

38. Distinctive character is a measure of how strongly the earlier mark identifies the goods for which it is registered (and on which it may rely), determined, according to *Lloyd Schuhfabrik Meyer & Co.*, partly by assessing the proportion of the relevant public which, because of the mark, identifies the goods as originating from a particular undertaking. At paragraph 23, of its judgment, the CJEU stated:

“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

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<sup>13</sup> See paragraph 19 of applicant’s written submissions in reply.

<sup>14</sup> See paragraph 3 of applicant’s counterstatement.

<sup>15</sup> To add, even if the first syllable is pronounced differently, i.e. more in line with the opponent’s suggestion of “NI” (which I think could be articulated as “NIGH” or “NEE”) then this would be the same across both marks so would not have a bearing on the degree of similarity.

<sup>16</sup> Paragraph 21 of opponent’s written submissions and paragraph 20 of applicant’s observations in reply.

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).

39. The assessment as to whether there is a likelihood of confusion includes considering whether the distinctive character of the earlier mark has been enhanced (i.e. more distinctiveness has been acquired) through the use made of it. The opponent has not filed evidence about the use it has made of its mark. Consequently, I have only the inherent position to consider. It claims its mark is inherently distinctive for the goods as it is not descriptive or allusive of its goods, or any of their characteristics and the applicant appears to agree on this point.<sup>17</sup> I note the opponent has not provided a view on the degree to which it considers its mark is inherently distinctive. As the earlier mark is an invented word with no obvious meaning, I consider it to have high inherent distinctiveness.

#### **40. GLOBAL ASSESSMENT – conclusions on likelihood of confusion**

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

42. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree

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<sup>17</sup> Paragraph 39 of opponent's written submissions and paragraph 17 of applicant's submissions in lieu of a hearing.

of similarity between the goods may be offset by a greater degree of similarity between the trade marks, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing act. In doing so, I must take into account the fact that the average consumer rarely has an opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

43. The applicant focuses on what it deems are substantial visual and aural differences between the marks. It highlights that the different endings of the words are key, giving a “completely different visual emphasis” and that its mark contains a “highly unusual and noticeable ‘XX’ element” which is “not a common letter pattern in the English language”.<sup>18</sup> It submits that these differences counteract any overlap between the goods. I note that the applicant also asserts that the marks “clearly only share a low degree of visual similarity when compared side by side”, though in response to this I reiterate that the assessment must be made on the basis that the average consumer rarely has an opportunity to make direct comparisons between the marks.<sup>19</sup>

44. The opponent’s arguments focus on the fact that the marks coincide at the beginning and at a position which is “generally regarded to have visual significance to consumers” and submits that the likelihood of confusion is therefore greater, referencing *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02”.<sup>20</sup> Whilst I recognise this general rule, I also note that this is not necessarily decisive, as per *CureVac GmbH v OHIM*, T-80/08. In that case, the court considered the similarity between two marks where the common element was the first three letters “RNA”. The marks being compared were “RNAActive” and “RNAiFect”. With regards to the visual similarity, the court stated as follows:

“38. ...the signs at issue both consist of a single word each containing eight letters, the first three of which, written in upper case are identical. The five

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<sup>18</sup> Paragraph 18 of observations in reply and paragraph 3 of counterstatement.

<sup>19</sup> Paragraph 18 of observations in reply.

<sup>20</sup> Paragraph 19 of written submissions.

subsequent letters of the earlier mark are written in lower case, as are those of the mark applied for, except for the fifth letter 'f'.

39. The similarities resulting from the identical nature of the first three letters is, however, strongly mitigated by the presence of the last five letters of the signs at issue, which, although four of them appear in both signs, do not occur in the same order, which gives rise to a very different visual perception for the two signs at issue. Thus, the overall impression created by the signs at issue shows visual differences.”

45. The opponent also highlights the aural similarities between the marks and submits that “consumers may be prone to the effects of confusion when inquiring over such products over the phone or making purchases in the relevant stores”.<sup>21</sup> I have already acknowledged at paragraph 28 that aural considerations should not be discounted due to word-of-mouth recommendations and conversations with salespersons. In response to the specific ‘over the phone’ scenario suggested by the opponent, I see no inherent reason why these goods would be particularly difficult to discuss over the phone compared to any other goods. Further, regarding the example presented regarding purchases made in store, I would expect the average consumer, once having spoken to a salesperson, would still also have opportunity to visually inspect the goods before making their purchase.

46. To summarise my global assessment so far, I have found the parties’ goods to be identical, identified the average consumer to be a member of the general public (with an interest in gardening or general pest control) or an agricultural business. They will select the goods primarily by visual means, although I do not discount the aural component. I have concluded that the degree of attention paid will be slightly higher than average for the general public group or high for agricultural businesses. I have found the parties’ marks to be visually similar to a low to medium degree and to be aurally similar to a medium to high degree. The marks are conceptually neutral and therefore share no similarity. Finally, I have found

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<sup>21</sup> Paragraph 44 of written submissions.

the earlier mark to have a high degree of inherent distinctive character.

47. The identity between the goods and high degree of inherent distinctive character in the earlier mark are obvious factors in the opponent's favour. I also acknowledge that the marks are similar in length (seven letters versus eight letters long) and that the first four of letters of the marks are identical. Nevertheless, there are visual and aural differences between the marks which are not negligible. The endings of each mark are markedly different, and I consider these are unlikely to be overlooked by the average consumer, in particular, the 'XX' letter pattern as referenced at paragraph 43 above. I agree that this is an uncommon letter combination in the English language and therefore more likely to be noticed and recalled by the average consumer. In terms of aural similarities, again, I consider the difference is sufficient for the average consumer to discern between the two marks. Therefore, I consider it unlikely that the marks will be mistakenly recalled or misremembered as each other. This is especially so taking into account the slightly higher than average or high level of attention being paid to the goods. Consequently, notwithstanding the principles of imperfect recollection and interdependency, I find that there is no likelihood of direct confusion, even in relation to identical goods.

48. In relation to indirect confusion, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.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”).

49. These examples are, clearly, not intended to be an exhaustive list but illustrate some of the circumstances in which indirect confusion may arise. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor KC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (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. I am also mindful that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark.<sup>22</sup>

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<sup>22</sup> As per *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17.

50. Applying these principles and taking into account all the above factors, I cannot see any reasons why, once the average consumer has recalled the various differences between the marks, they would conclude that the goods come from the same or an economically-related undertaking. Although the opponent's mark has a high level of inherent distinctiveness, this lies in the word as a whole and there is no shared independent distinctive element which could give rise to indirect confusion. The only common element is the first four letters ("NIMA") and I do not consider that the average consumer would dissect or separate these out. Further, there is no crossover between the marks suggestive of a brand extension. Consequently, I find that there is no likelihood of indirect confusion.

51. As I have found no likelihood of confusion between the marks, it has not been necessary for me to consider the applicant's evidence and the subsequent submissions (from both sides) regarding the "state of the register", use of 'NIMA/NEMA' marks in the marketplace and previous oppositions in other jurisdictions.

## **CONCLUSION**

52. The opposition is unsuccessful, and the application may proceed to registration.

## **COSTS**

53. The applicant has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of £1200.00, calculated as follows:

Preparing a statement and considering the other side's statement	£300
Preparing evidence	£500
Preparing written submissions in lieu of a hearing	£400
<b>Total</b>	<b>£1200</b>

54. I therefore order Syngenta Crop Protection AG to pay UPL Corporation Limited the sum of **£1200.00**. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 24<sup>th</sup> day of September 2024**

**C IRELAND**

**For the Registrar**