

**O/0977/24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NUMBER 3800124  
BY FMC CORPORATION AND FMC AGRICULTURAL SOLUTIONS A/S  
FOR THE TRADE MARK**

**ZIMERI**

**IN CLASS 5**

**AND**

**THE OPPOSITION THERETO  
UNDER NUMBER 436704  
BY SYNGENTA CROP PROTECTION AG**

## Background and pleadings

1. On 17 June 2022, FMC Corporation and FMC Agricultural Solutions A/S (“the applicants”) applied for the mark ZIMERI (number 3800124) for the following goods in class 5: *Pesticides; insecticides; herbicides; fungicides; nematicides.*

2. Syngenta Crop Protection AG (“the opponent”) opposes the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying upon the following earlier international trade mark registration:

1526072

ZIMETADO

Swiss priority date: 24 December 2019; international registration date: 25 February 2020; protection granted in the UK: 30 July 2020

Class 1: *Chemical products for use in agriculture, horticulture and forestry; preparations for the treatment of seeds; soil fertilizers.*

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

3. The opponent claims that the parties’ goods are identical and that the marks are visually and aurally highly similar leading to a likelihood of confusion.

4. The applicants filed a defence and counterstatement. Although a likelihood of confusion is denied, the applicants admit the identity or similarity of the contested goods compared to the opponent’s class 5 goods.

5. The opponent is represented by Bromhead Johnson LLP and the applicants by Appleyard Lees IP LLP. Only the applicants filed evidence. The opponent filed written submissions during the evidence rounds (in chief and in reply to the applicants’ evidence). The applicants requested a hearing which took place by video conference on 20 March 2024, at which they were represented by Mr Daniel Bailey from Appleyard

Lees LLP. The opponent did not attend or file written submissions in lieu of attendance. I make this decision after a careful consideration of all the papers on file and the submissions made at the hearing, referring to them as and when relevant and necessary.

## **Evidence**

6. Roberte Makowski, who has been the first applicant's Chief Intellectual Property Counsel and Assistant Secretary since 2 January 2019, gives evidence for both applicants about their business and regulatory requirements; and also the state of the UK trade mark register in respect of *ZIM*- marks in classes 1 and 5.<sup>1</sup>

## **Section 5(2)(b) of the Act**

7. Section 5(2)(b) states:

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

(a) ...

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

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

8. 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

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<sup>1</sup> Witness statement dated 17 May 2023 and exhibits.

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

9. The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act 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 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>2</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, 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

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<sup>2</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.

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

10. The parties' respective goods to be compared are:

Earlier mark	Contested mark
<p data-bbox="193 255 796 450">Class 1: <i>Chemical products for use in agriculture, horticulture and forestry; preparations for the treatment of seeds; soil fertilizers.</i></p> <p data-bbox="193 528 796 674">Class 5: <i>Products for destroying vermin; fungicides, herbicides, insecticides, nematocides.</i></p>	<p data-bbox="798 255 1398 338">Class 5: <i>Pesticides; insecticides; herbicides; fungicides; nematocides.</i></p>

11. The applicants admit that the parties' class 5 goods are identical or similar. *Insecticides; herbicides; fungicides; nematocides* appear in both parties' specifications and are clearly identical. *Pesticides* would also appear to be identical to *insecticides* since insects in the 'wrong' context are viewed as pests. Insecticides are a type of pesticide.<sup>3</sup> I find all the parties' class 5 goods to be identical.

#### The average consumer and the purchasing process

12. As the caselaw cited above indicates, 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."<sup>4</sup> The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose 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*. The opponent submits that the goods can be directed to professionals, farmers and to individuals who have gardens. The opponent submits that the degree of attention paid to the purchase will be low to average. The applicants' evidence and their submissions are aimed at showing that the goods are subject to a high level of attention during the purchasing process because they are heavily regulated. The applicants' own business is

<sup>3</sup> *Gérard Meric v OHIM*, General Court of the European Union, Case T-33/05.

<sup>4</sup> *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).

agricultural; however, that is not reflected in the specification of the contested mark which also covers goods for use by householders in homes and gardens. Given there are professional (agribusiness or horticulturalist) consumers, and homeowners and amateur gardeners who are also consumers, there is more than one group of average consumer. The professional group will pay a high degree of attention, taking into consideration bulk-buy costs, efficacy, reputation (e.g. if an organic business) and environmental impact. The domestic average consumer will also have a mind to efficacy and cost, impact on the environment and the home/garden, but will be less concerned with effects on crop yield and will not have business considerations. Toxicity is likely to be a consideration. For this group of consumers, who are likely to buy the goods less frequently than the business consumer, there will be an above average, but not high, degree of attention.

13. The purchasing process is likely to be predominantly visual, selected from shelves in retail premises, whether they be garden centres or agricultural retailers, and from catalogues or online stores. Word-of-mouth recommendations and discussions with sale professionals may also play a part, which means there may be an aural dimension to the purchasing process.

#### Comparison of marks

14. The marks to be compared are:

<b>Earlier mark</b>	<b>Contested mark</b>
ZIMETADO	ZIMERI

15. *Sabel BV v. Puma AG* 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.”

16. It is necessary to take into account the distinctive and dominant components of 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. In this case, the marks both consist of a single component in which their overall impression resides.

17. The earlier mark comprises eight letters and the contested mark six letters. The point of visual similarity is that the first four letters of each mark are the same. However, the other letters in each mark are entirely different to each other. The marks are visually similar to a low to medium degree.

18. There are several possibilities as to how the earlier mark would be pronounced. It could be said as three syllables: ZYME-TAR-DO or ZYME-TAY-DO. This is the opponent's position: that the first syllable is composed of ZIME. It might be said as four syllables: ZIMM-E-TAR-DO or ZIMM-E-TAY-DO. The contested mark will be said as three syllables: ZIMM-E-REE, ZIMM-EER-EE or ZIMM-AIR-EE. It is too cumbersome to try to say it as ZIME-REE and I do not think this is how the average English speaker in the UK would naturally pronounce it. The third and fourth syllables of the earlier mark sound completely different to any of the syllables in the contested mark. If the earlier mark is pronounced as three syllables, there is next to no aural similarity. If the earlier mark is pronounced as four syllables, bringing the first two syllables into alignment, there is no more than a low to medium degree of aural similarity because the third and fourth syllables are different to any of the sounds in the contested mark.

19. Both marks are invented words which makes concept a neutral factor in the assessment of a likelihood of confusion.

### Distinctive character of the earlier marks

20. If a mark has an inherently high level of distinctiveness, or distinctiveness which has been enhanced through use, the likelihood of confusion is increased.<sup>5</sup> As the opponent has not filed any evidence that it has used its mark, I have only the inherent distinctive character of the earlier mark to consider. ZIMETADO is an invented word which does not allude to or evoke any characteristic of the goods. The earlier mark has a high degree of inherent distinctiveness.

### Likelihood of confusion

21. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa. In this case, the goods are identical. This is a factor in the opponent's favour, as is the high degree of distinctive character of its mark.

22. However, the opposition fails. This is because, despite these factors, the balance of the other factors in the global assessment which I have considered throughout this decision means that there is no likelihood of confusion. There are two types of confusion: direct and indirect. Neither will occur.

23. Direct confusion occurs where marks are mistaken for one another, flowing from the principle 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 which has been retained in the mind. The opponent submits that the average consumer is likely to remember the first part of the mark, ZIME, but not the end part.<sup>6</sup> The applicants submit that this entails ignoring 50% of the earlier mark and 30% of the

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<sup>5</sup> *Sabel BV v Puma AG*, Case C-251/95.

<sup>6</sup> Written submissions dated 3 March 2023.

contested mark, which they say indicates that the opponent seeks a monopoly in the prefix ZIME.

24. The authorities caution against dissecting marks.<sup>7</sup> They must be considered as wholes. It is highly unlikely that the average consumer, even if paying the lowest degree of attention, will mistake ZIMETADO for ZIMERI. The fact that ZIMETADO enjoys a high degree of distinctive character for identical goods cannot compensate for the differences between the marks. There is no likelihood of direct confusion.

25. The other potential type of confusion is indirect confusion, which was explained by Mr Iain Purvis QC, sitting as the Appointed Person, in *Back Beat Inc v L.A. Sugar (UK) Limited*, BL O/375/10:

“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.

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<sup>7</sup> *Sabel BV v Puma AG*, Case C-251/95.

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).”

26. 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. ZIMERI is not a logical brand extension of ZIMETADO (or vice versa). That the three categories in that case are non-exhaustive was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others*.<sup>8</sup> I do not find any of the *L.A. Sugar* categories or any other types of indirect confusion fit the present case. Indirect confusion is not a consolation prize for an opponent which has not succeeded in a finding of direct confusion. Differences between marks which are the reason why there is no likelihood of direct confusion might also be the reason why there is no indirect confusion. That is the case here.<sup>9</sup>

27. Given my findings, there is no need to take into account the applicant’s evidence about the nature of the market, how products are labelled, or the evidence about the ‘state of the register’.

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<sup>8</sup> [2021] EWCA Civ 1207.

<sup>9</sup> See the comments of Mr James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Limited v Ashish Sutaria*, BL O/219/16.

## **Outcome**

28. The opposition fails. The application may proceed to registration.

## **Costs**

29. The applicants have been successful and are entitled to a contribution towards their costs, based on the scale in Tribunal Practice Notice 2/2016, which is applicable to these proceedings. The costs breakdown is as follows:

Considering the opposition and filing the counterstatement	£300
Preparing evidence	£600
Attending the hearing	£700
Total	£1600

30. I order Syngenta Crop Protection AG to pay to FMC Corporation and FMC Agricultural Solutions A/S the sum of £1600. 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 14<sup>th</sup> day of October 2024**

**Judi Pike**  
**For the Registrar**