

O/551/18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003154863 BY
DEVENISH NUTRITION LIMITED
TO REGISTER:**

AminoSave

AS A TRADE MARK IN CLASSES 1, 5 AND 31

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 406898 BY
EVONIK DEGUSSA GmbH**

BACKGROUND AND PLEADINGS

1. On 14 March 2016, Devenish Nutrition Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 1 April 2016.

2. The application was opposed, in respect of the goods shown in paragraph 11 below, by Evonik Degussa GmbH (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is based on the earlier International Trade Mark no. 1041517 for the trade mark AMINORED which has a priority date of 8 December 2009 and was granted European Union protection on 11 May 2011.

3. The following goods and services are relied upon in this opposition:

Class 1 Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing agents; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives in industry.

Class 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; electric installations for the remote control of industrial operations; batteries; apparatus for recording, transmission or reproduction of data, sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; computer software, computer programs, especially as database for amino acid analysis in

feedstuffs for animal nutrition; testing apparatus (not for medical purposes), food analysis apparatus (not for veterinary purposes).

Class 31 Agricultural, horticultural and forestry products and grains (not included in other classes); foodstuffs for animals; additives to fodder, not for medical purposes, malt.

Class 41 Education and instruction; entertainment; teaching and further education for experts in the field of feedstuff; arranging and conducting of conferences, congresses, symposiums and colloquiums, organization of exhibitions for cultural and/or educational purposes, publication of books, newspapers and periodicals; organization of exhibitions for cultural and/or educational purposes, arranging and conducting of seminars and workshops, especially for experts in field of animal nutrition.

Class 42 Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software, in particular computer programs, especially as database for amino acid analysis in feedstuffs for animal nutrition, computer software consultancy, technical consulting services for the animal feed industry about the use of animal feed ingredients, chemistry services; engineering services; bacteriological and/or chemical laboratory services; physics research.

4. The opponent argues that the respective goods and services are identical or similar and that the marks are similar.

5. The applicant filed a counterstatement denying the claims made.

6. Both parties have filed two sets of written submissions. The opponent's submissions are dated 22 March 2018 and 29 June 2018. The applicant's submissions are dated

22 May 2018 and 29 June 2018. No hearing was requested and so this decision is taken following a careful perusal of the papers.

DECISION

7. Section 5(2)(b) of the Act reads as follows:

“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. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6(1) In this Act an “earlier trade mark” means –

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

9. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than 5 years before the publication date of the application in issue in these proceedings, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods and services it has identified.

Section 5(2)(b) – case law

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

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 impression 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 to mind the earlier mark, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

11. The opponent has confirmed that it wishes to rely upon all goods and services for which the earlier mark is registered. However, its submissions focus on classes 1 and 31 which, in my view, contain the strongest comparisons with the applicant's

specification. I have, therefore, only reproduced these goods in the table below as the other classes relied upon do not assist the opponent any further.

Opponent's goods	Applicant's goods
<p><u>Class 1</u> Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins; unprocessed plastics; manures; fire extinguishing agents; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.</p> <p><u>Class 31</u> Agricultural, horticultural and forestry products and grains (not included in other classes); foodstuffs for animals, additives to fodder, not for medical purposes, malt.</p>	<p><u>Class 1</u> Amino acids; mixtures of amino acids; amino acid preparations for use in animal and poultry feed.</p> <p><u>Class 5</u> Amino acid for animal foodstuffs; mineral supplements and vitamin supplements for animals.</p> <p><u>Class 31</u> Foodstuffs for animals; animal feed supplements; protein for animals.</p>

12. In its submissions dated 22 March 2018, the opponent argues as follows regarding the similarity of the goods:

“3. The respective goods in classes 1 and 31 are identical because the goods in classes 1 and 31 which the application covers are contained within the general terms of the specifications in classes 1 and 31 of the opponent's mark.

4. The class 5 goods which the application covers, “Amino acids for animal foodstuffs; mineral supplements and vitamin supplements for animals”, are highly similar to the goods in classes 1 and 31 which the earlier mark covers because they are essentially the class 5 equivalent of the goods which the

application covers in classes 1 and 31. In this regard, the classes are clearly less relevant than the goods themselves.”

13. The applicant argues as follows in its submissions dated 22 May 2018:

“5. It is now well established that in assessing the similarity of goods, all relevant factors relating to those goods themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.

The nature, purpose, method of use and trade channels of the goods covered by the respective marks can be distinguished and are dissimilar.”

14. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment:

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

15. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

16. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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.”

17. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), 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 observation 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."

18. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations" anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

19. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs [30] to [38]).

20. "Foodstuffs for animals" in the applicant's specification is the same as "foodstuffs for animals, additives to fodder, not for medical purposes" in the opponent's specification. These goods are plainly identical. "Additives to fodder" in the opponent's specification falls within the broader category of "animal feed supplements" in the applicant's specification. "Protein for animals" in the applicant's specification will have a variety of uses included those which are not for medical purposes and so this will fall within the broader category of "additives to fodder, not for medical purposes" in the opponent's specification. Such goods can, therefore, be considered identical on the principle outlined in *Meric*.

21. "Amino acid preparations for use in animal and poultry feed", "amino acid for animal foodstuffs" and "mineral supplements and vitamin supplements for animals" in the

applicant's specification are likely to have the same users as "additives to fodder, not for medical purposes" in the opponent's specification, specifically farmers or other individuals involved in industrial livestock production activities. They are likely to have the same uses i.e. nutritional or dietary benefits for the animals. They will all be available for purchase through the same channels such as specialist animal feed suppliers. I therefore consider that these goods will be similar to a high degree. "Amino acids" and "mixtures of amino acids" in the applicant's specification are not limited in their uses for animal feed and may have any number of uses. However, these broad terms will include amino acids used as additives to animal feed. They will, in these circumstances, have the same uses and users as "additives to fodder, not for medical purposes" in the opponent's specification. In those instances, the goods will be available through the same channels (such as specialist retail outlets or their online equivalents). I therefore find that these goods are highly similar.

The average consumer and the nature of the purchasing act

22. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' 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 (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."

23. The applicant argues as follows in its submissions dated 29 June 2018:

“17. The goods at issue are, in our submission, reasonably specialist goods that would be used by experts in the relevant field who would pay a more than average degree of attention to the Trade Marks and, in particular, would pay more attention to the visual elements of the marks in the purchasing process.”

24. The opponent has made no submissions on the identity of the average consumer or the purchasing process for the goods in issue.

25. The goods in issue vary from specialist products such as amino acid products to generic animal feed products. The average consumer in these proceedings will therefore either be a specialist user (such as those in the field of industrial livestock production activities or biological sciences) or a member of the general public. The frequency of purchases of this nature are likely to vary depending on the volume and nature of the goods being purchased. For example, standard food products for animals will be frequent purchases whereas mineral and vitamin supplements for animals may be less frequent purchases. The cost is also likely to vary depending on the specific type of goods being purchased (from standard animal feed which will be of low cost to specialist nutritional supplements which may be of higher cost). Both specialists and members of the general public are likely to give some consideration to the goods being purchased to ensure that they meet their specific requirements, for example, ensuring that feed contains the required nutritional supplements for their animals. I consider that the average consumer will pay an average degree of attention during the selection process for the goods in issue.

26. The average consumer is likely to purchase the goods by self-selection from a specialist retail outlet or from their website or catalogue equivalent. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may be an aural component to the purchase of the goods, given that advice as to animals' dietary or nutritional requirements may be sought from a specialist (such as a veterinary professional) or advice may be sought at the point of purchase from a sales assistant.

Comparison of trade marks

27. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) 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 the trade 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.”

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

29. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
AMINORED	AminoSave

30. The parties have made various submissions on the similarities of the marks and I have considered them all in reaching my decision. I will refer to some of the arguments raised below (although I do not propose to reproduce the submissions in full).

31. The opponent argues that the marks are “similar in length and share the first five letters in the same positions”. The opponent argues that this is of particular importance because “consumers read from left to right” and sharing the same first five letters makes the marks visually and phonetically similar.

32. The applicant argues that because the first five letters of both marks make up the word “amino” the public will pay less attention to this than the suffixes “RED” and “Save” because it refers to the nature of the goods and is consequently of “low distinctiveness”. The applicant argues that the addition of the suffixes “RED” and “Save” mean that the marks are visually and aurally different.

33. Conceptually, the applicant argues that the presence of the word “amino” in both marks “conveys the message that the products contain or are related to amino acids”, but that the use of the words “RED” and “Save” in the marks distinguishes between them conceptually.

34. The applicant’s mark consists of nine letters “AminoSave”. Although conjoined, I think it clear that the mark will be perceived as the two dictionary words “Amino” and “Save”. The opponent’s mark consists of eight letters “AMINORED”. Again, although conjoined I think it clear that the mark would be perceived as the two dictionary words “AMINO” and “RED”. It is clear from their submissions that the parties differ in their view of the importance of the word “amino” in the marks, with the applicant arguing that it is of lesser importance because it relates to the goods in issue and the opponent arguing that it is of greater importance because consumers read from left to right and therefore the start of the word is more important.

35. The GC case *CureVac GmbH v OHIM* Case T-80/08 is of particular assistance on this point. In that case, the court considered the similarity between two marks where the common element at the start of each mark was related to the goods and services in issue. The common element was the first three letters “RNA”. The earlier mark was “RNActive” and the mark applied for was “RNAiFect”. The court stated as follows:

“As regards the first, visual comparison, 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 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'.

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...

As regards, second, the phonetic comparison, it should be noted that, whilst the two signs begin with the three letters 'r', 'n' and 'a', their endings create a fairly clear distinction between them. The two signs are thus pronounced differently, so that if there is a similarity, it must be regarded as, at the very least, extremely weak...

As regards, third, the conceptual comparison, it is true that, in relation to the goods in question, the relevant public will either, particularly concerning the specialist public, perceive the first three letters as referring to the English abbreviation for ribonucleic acid or, concerning the general public, assume that those initials refer, at the very least, to a component of a chemical or medical nature, even if they do not know the exact meaning of it...

However, the respective endings of the signs ('ctive' for one and 'ifect' for the other), which have different meanings, offset the similarity resulting from the common component 'rna'."

36. The Court went on to conclude:

"Thus, although the common component of the two signs, namely 'rna', appears first, the fact that it is identical does not lead to a likelihood of confusion because that component has limited distinctive character, so that the public's attention will be drawn to the endings of the two signs which are, in the context of an

overall assessment, visually, phonetically and conceptually distinct. The two signs thus give different impressions.”

37. Both parties agree that consumers who would purchase the goods in issue would recognise the relevance of the word “amino” in relation to the goods. I consider that this is the case whether the goods were being purchased by a specialist or a member of the general public. Even if a member of the general public did not appreciate the full meaning of the word “amino” they would recognise it as a biological substance. In my view, it is the suffixes “Save” and “RED” respectively that play a greater role in the overall impression of the marks. The word “Amino/AMINO” will play a lesser role in the overall impression of the marks.

38. The first and sixth letters of the applicant’s mark are presented in upper case, with the rest of the mark being presented in lower case. The opponent’s mark is presented entirely in upper case. However, notional and fair use means that either mark could be used in upper or lower case and so the difference created by the cases as presented alone is not relevant. Visually, as noted above, each mark can be broken down into two ordinary dictionary words. The first word in each mark is identical which creates a degree of visual similarity between the marks. However, the similarities between the marks is offset by the presence of the entirely different second word. Overall, I consider that there is a medium degree of visual similarity between the marks.

39. Aurally, each mark is likely to be broken down into two separate words – “amino” and “save” or “amino” and “red”. Whilst there is, of course, a degree of aural similarity between the marks due to the common first word the entirely different second words in each mark means that there is a low degree of aural similarity between the marks.

40. Conceptually, the word “amino” is a common dictionary word that will be recognised by the average consumer as relating to the goods in question. The similarity created by this shared concept will be offset by the presence of the words “red” and “save” respectively which the average consumer is likely to understand as their ordinary dictionary meanings with no specific connection to the goods. Overall, I consider that there is a medium degree of conceptual similarity between the marks.

Distinctive character of the earlier trade mark

41. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the 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-2779, 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).”

42. 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 or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

43. As the opponent has not filed any evidence to show that its mark has enhanced its distinctiveness through use, I have only the inherent position to consider. The

opponent stated as follows in its submissions dated 22 March 2018 with regard to the distinctiveness of its mark:

“6. Likewise, the applicant’s argument that the marks are not similar because the element AMINO/Amino is descriptive or non-distinctive is not correct. The earlier mark was registered without any limitations or official objections, and it is therefore necessary to compare the marks side by side. The opponent accepts that AMINO alludes to amino acids, but denies that it is more than allusive or that it is directly descriptive or otherwise non-distinctive.

7. As <http://www.dictionary.com/browse/amino?s=t> confirms, the term “amino” is an adjective meaning “containing the amino group”. This supports the opponent’s position that the term is allusive and therefore distinctive within the earlier mark.”

44. In its submissions dated 22 May 2018, the applicant stated as follows:

“10. It should be borne in mind that, contrary to the submission made by the Opponent, the element Amino is not allusive but is descriptive of any goods containing or relating to Amino Acids and less weight should be given to this element as it appears in the respective Trade Marks.”

45. The applicant goes on to state, in its submissions dated 29 June 2018:

“14. It is our submission that the inclusion of the element Amino in the earlier right results in the mark being inherently of low distinctive character as it gives the mark an allusive meaning. Indeed, this is acknowledged and admitted in the submissions made on behalf of the Opponent in paragraph 6 and 7 of those submissions.

46. I must make an assessment of the inherent distinctiveness of the earlier mark as a whole. Both words are common dictionary words with a recognisable meaning. The opponent accepts that the use of the word “AMINO” is allusive. I agree that at the very

least “AMINO” is allusive but, in some cases, it is actually descriptive of the goods in issue. Consequently, I find that the mark has a low degree of inherent distinctiveness.

Likelihood of confusion

47. 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 and services down to the responsible undertakings being the same or related. 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 of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is 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 alive to 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 he has retained in his mind.

48. I have found the parties’ marks to be visually and conceptually similar to a medium degree and aurally similar to a low degree. I have found the earlier mark to have a low degree of inherent distinctive character. I have identified the average consumer to be a specialist (such as in the field of industrial livestock production activities or biological sciences) or a member of the general public who will select the goods primarily by visual means (although I do not discount an aural component), and I have concluded that the degree of attention paid will be average. I have found the parties’ goods to be identical or highly similar.

49. I consider that the visual, aural and conceptual differences between the marks are sufficient to ensure that the marks will not be misremembered or mistakenly recalled as each other. I do not, therefore, consider that there will be direct confusion.

50. I must now decide whether there will be indirect confusion. Indirect confusion was described in the following terms by Iain Purvis QC, sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case 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. 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”, “WORDLWIDE”, “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).”

51. It is clear that the categories identified by Mr Purvis are illustrative not exhaustive (see *Thomson Hotels LLC v TUI Travel Amber E&W LLP*, BL-O-440/14 at [29]).

52. There is some similarity between the marks due to the presence of the common word “amino”. However, I have found that the marks are visually and conceptually similar to a medium degree and aurally similar to a low degree. The average consumer will recognise the word “amino” as being allusive or descriptive of the goods in issue and it is therefore the second word in each mark which will act as a hook prompting the consumers’ recall of the competing trade marks. Even though the goods are either identical or similar to a high degree, the conceptual hook will prevent the average consumer from assuming that the undertakings are the same or economically linked. I do not, therefore, find that there is a likelihood of indirect confusion.

CONCLUSION

53. The opposition has been unsuccessful and the application will proceed to registration.

COSTS

54. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Note 2/2016. In the circumstances, I award the applicant the sum of £500 as a contribution towards the costs of the proceedings. Although the applicant filed two sets of submissions in these proceedings, the second was an expansion upon the first and so I have made a single award in respect of both sets of submissions. The sum is calculated as follows:

Preparing a statement and considering the other side’s statement	£200
Preparing written submissions	£300
Total	£500

55. I therefore order Evonik Degussa GmbH to pay Devenish Nutrition Limited the sum of £500. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 5th day of September 2018

S WILSON

For the Registrar