

O-264-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2617345
BY SYNERGY PHARMACEUTICALS
TO REGISTER THE TRADE MARK**

SynerVit-D₃

IN CLASS 5

AND:

**OPPOSITION THERETO UNDER NO. 103645
BY FIRST CHOICE PHARMA LTD**

BACKGROUND

1. On 11 April 2012, Synergy Pharmaceuticals (“the applicant”) applied to register the trade mark shown on the cover page of this decision. The application was accepted and published for opposition purposes on 11 May 2012 for: “vitamin supplements” in class 5.

2. On 31 July 2012, First Choice Pharma Ltd (“the opponent”) filed a notice of opposition. The opposition is based upon a single ground under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) for which the opponent relies upon the goods shown below in bold in the following trade mark registration:

UK TM no. 2593342 for the trade marks: **SYNER D3** and **Syner D3** (series of 2) applied for on 2 September 2011 and registered on 16 December 2011 for:

**Pharmaceutical products and/or preparations and/or substances;
pharmaceutical drugs; products and preparations for pharmaceutical use;
pharmaceutical preparations obtainable on prescription; medicine.**

In its notice of opposition the opponent says:

“3. The beginning and ending of the two trade marks are identical. Furthermore Syner which is the distinctive element of the earlier mark, appears at the beginning of the later trade mark. Syner is also a separate element within the later trade mark... D3 is a vitamin and is therefore a descriptive element of the marks. It nevertheless needs to be taken into account when comparing the respective trade marks.

5. Furthermore, the class 5 goods covered by the respective marks are similar.”

3. On 9 October 2012, the applicant filed a counterstatement in which it denies the opponent’s claims. The applicant says:

“2. The name SynerVit D3 is derived from the name of the applicant “Synergy” and the fact that the product is a vitamin.

3. The applicant denies the claim that there is a likelihood of confusion...on the basis that there is an extra syllable in their mark. It is clear that this product is a vitamin and people would notice the difference in the name. When spoken the two marks are very different due to the hard sounding VIT element. Visually and conceptually the marks are also different.

4. The applicant’s trade mark application is very specific. They have only requested protection for vitamin supplements in class 5 rather than a broad range of products or class heading.

5. The applicant submits that a vitamin supplement is not the same as a pharmaceutical product or other products covered by the opponent's trade mark registration for the [following reasons]:

6. The applicant does not refer to their product as a pharmaceutical product simply because it isn't. The definition of a pharmaceutical product is as follows: "A drug, broadly speaking, is any substance that, when absorbed into the body of a living organism, alters bodily function" (source Wikipedia after a Google search for the term "definition of a pharmaceutical product"). Vitamin D is already present in the human body, the applicant's product is simply used to enhance it when the patient has not obtained enough through normal day to day living and therefore it does not ALTER bodily function which is the essential element of a pharmaceutical product. By definition a vitamin is not a pharmaceutical product.

7. The product is used to treat vitamin D deficiency only, it has no other uses, it is not harmful in any levels and has no known side effects.

8. The end user has no choice in the product they receive, it is chosen for them by a highly qualified GP who is used to seeing chemical and pharmaceutical names. A GP will know for what ailment he is prescribing the supplement and hence there will be no confusion in the marketplace.

9. The product itself is already registered in the Chemist and Druggist and is available only on prescription from a GP. This product is available via GP's and the applicant is not aware of any confusion to date."

4. Both parties filed evidence. Whilst neither requested to be heard the opponent filed submissions in lieu of attendance at a hearing; I will refer to these submissions as necessary below.

EVIDENCE

5. I do not propose to summarise the evidence which has been filed in these proceedings but will refer to it as necessary below. For the record, the evidence consists of: two witness statements from Neil Patel (the opponent's managing director) and exhibits NP1 to NP6 thereto, Zain Khan and Jatish Mistry (both pharmacists) on behalf of the opponent and Ali Reza Master (the applicant's managing director) and Gulamraza Ahmad Dattoo (also a pharmacist) on behalf of the applicant.

DECISION

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

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

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

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

7. 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 the 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.”

8. In these proceedings the opponent is relying upon the trade marks shown in paragraph 2 above, which constitute earlier trade marks under the above provisions. Given the interplay between the date on which the application was published and the date on which the opponent’s registration completed its registration procedure, the earlier trade marks are not subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004.

Section 5(2)(b) – case law

9. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* -BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117; Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v

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 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, in certain circumstances, be dominated by one or more of its components;
- (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The average consumer and the nature of the purchasing process

10. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and then to determine the manner in which these goods will be selected by the average consumer in the course of trade. The goods at issue in these proceedings are, broadly speaking, pharmaceutical products, preparations, substances and drugs, medicine (the opponent’s goods) and vitamin supplements (the applicant’s goods); neither parties’ specifications are limited in any way. As such goods may be made available over the counter or on prescription, the average consumer will comprise medical professionals and members of the general public. As the goods may be selected by the eye or in writing, visual considerations will play an important role in the selection process. However, as, for example, pharmacies often keep certain products behind the counter, even though they are not prescription only products, aural considerations will also come into play. As to the degree of care that will be exercised when selecting such goods, in *Laboratorios Del Dr Esteve, SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-230/07 the General Court said:

“36 In the present case, the Board of Appeal rightly stated that, considering the nature of the goods concerned, being food supplements, the consumer’s level of attention would be rather sustained. It is apparent from case-law that the relevant public’s degree of attentiveness with regard to vitamins, food supplements, herbal, medical and pharmaceutical preparations is higher than average because consumers who are interested in that type of product take particular care of their health so that they are less likely to confuse different versions of such products (Case T-202/04 *Madaus v OHIM– Optima Healthcare (ECHINAID)* [2006] ECR II-1115, paragraph 33).”

Comparison of goods

The opponent’s goods	The applicant’s goods
Pharmaceutical products and/or preparations and/or substances; pharmaceutical drugs; products and preparations for pharmaceutical use; medicine.	Vitamin supplements

11. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the CJEU accepted that all relevant factors should be taken into

account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (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.

12. In reaching a conclusion, I will also keep in mind the decision of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 i.e.

“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 the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

13. In its counterstatement the applicant’s argues that its goods are: “not the same as a pharmaceutical product or other products covered by the opponent’s trade mark”, and in its evidence it draws a distinction between pharmaceutical products and vitamins, the latter of which it describes as a food supplement. As a consequence, a good deal of the opponent’s evidence deals with how these terms should be interpreted and whether or not a product can be classed as a pharmaceutical product only if it is licensed. In his statement Mr Patel of the opponent said:

“13. Vitamins can be supplements or medicines or pharmaceuticals. In most cases these words are used synonymously and interchangeably. A vitamin supplement is not dissimilar to a medicine or pharmaceutical. They are most certainly similar products...”

In their statements Messrs. Master and Dato for the applicant say:

“It is my opinion that a pharmaceutical product...and a vitamin supplement...are two distinct and separate product types. I would not expect a vitamin/food supplement to be confused with a licensed pharmaceutical product...”

In their statements Messrs. Khan and Mistry for the opponent say:

“I further confirm that pharmaceuticals and vitamin supplements are not mutually exclusive. A pharmaceutical product can be a vitamin supplement and a vitamin supplement can be pharmaceutical. They can function as both simultaneously. They are most definitely similar products.”

14. The opponent’s specification includes a range of pharmaceutical goods and medicine. Collins English Dictionary defines medicine as:

“any drug or remedy for use in treating, preventing, or alleviating the symptoms of disease”.

The same dictionary defines drug as:

“any synthetic, semisynthetic, or natural chemical substance used in the treatment, prevention, or diagnosis of disease, or for other medical reasons related adjective pharmaceutical.”

And vitamin as:

“any of a group of substances that are essential, in small quantities, for the normal functioning of metabolism in the body. They cannot usually be synthesized in the body but they occur naturally in certain foods: insufficient supply of any particular vitamin results in a deficiency disease.”

15. A vitamin supplement will be used to treat a deficiency of a particular vitamin in the body. As the term medicine is, in my view, broad enough to include the applicant’s vitamin supplements, the applicant’s goods are, on the principles outlined in *Gérard Meric*, identical to medicine in the opponent’s specification. However, even if that is considered too broad an interpretation of the word medicine, given what are likely to be the similarities in the physical nature and method of use of the competing goods (they may all be supplied in tablet, capsule or liquid form and swallowed), together with the similarities in the intended purpose (i.e. to treat a deficiency in the body), the users and trade channels through which the competing goods will reach the market, even if the

applicant's goods are not identical to the opponent's pharmaceutical preparations, medicines etc. they are, in my view, similar to a high degree.

Comparison of trade marks

16. The competing trade marks are as follows:

The opponent's trade marks	The applicant's trade mark
SYNER D3	SynerVit-D₃
Syner D3	

17. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. In reaching a conclusion on similarity I must compare the respective trade marks from the visual, aural and conceptual perspectives identifying, where appropriate, what I consider to be the distinctive and dominant elements of the respective trade marks. Although the opponent's registration consists of a series of two trade marks, the trade marks vary only to the extent that the word SYNER is presented in both upper and title case. As both the second trade mark in the series and the first part of the applicant's trade mark is presented in title case, it is, in my view, the second trade mark in the series which offers the opponent the best prospect of success in these proceedings and it is this trade mark upon which I will base the comparison.

18. The word Syner and the letter and numeral combination D3 are separate identifiable elements of both trade marks. As far as I am aware, the word Syner has no meaning for the goods at issue, and is, given its positioning as the first element, both a dominant and distinctive element of both parties' trade marks. In its submissions the opponent said:

“2. The applicant's argument that the respective marks are not similar due to the extra syllable Vit that is contained within their mark cannot carry much (sic) particularly since Vit is an abbreviation for vitamin and will be understood by the average consumer as being a vitamin D3 product. Vit D3 therefore has a descriptive function within their trade mark and not a distinctive one.”

19. Neither parties' specifications are limited to vitamin D3. However, as the applicant indicates that its trade mark will be used on vitamin supplements to treat vitamin D deficiency (as does the opponent) and as the evidence indicates that the letter and numeral combination D3 will be understood by the average consumer of the goods at issue as a reference to vitamin D3, it is neither a dominant (by virtue of its positioning) or distinctive element of either trade mark. Although the applicant's trade mark differs stylistically from the opponent's trade mark (i.e. the bold slightly stylised font, the

presence of the hyphen, the positioning and relative proportions of the size of the numeral 3 to the letter D and the presentation of this combination in blue), the only difference of any significance is, in my view, the presence in the applicant's trade mark of the letters Vit which appears as a separate identifiable element after the word Syner. However, as this element would, as the opponent argues, be seen by the average consumer in the context of the goods for which the applicant seeks registration as a reference to vitamins, it is neither a dominant or distinctive element of the applicant's trade mark. Considered as totalities, I think the competing trade marks are visually, aurally and conceptually highly similar.

Distinctive character of the opponent's earlier trade marks

20. I must now assess the distinctive character of the opponent's earlier trade marks. The distinctive character of a trade mark can be appraised only, first, by reference to the goods for which it is registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. The combination D3 is unlikely to be given any trade mark significance by the average consumer. However, as the word Syner is, as far as I am aware, neither descriptive of nor non-distinctive for the goods for which the opponent's trade marks stand registered, considered overall, the opponent's trade marks are, in my view, possessed of a high degree of inherent distinctive character.

Likelihood of confusion

21. In determining whether there is a likelihood of confusion, 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 vice versa. As I mentioned above, it is also necessary for me to factor in the distinctive character of the opponent's earlier trade mark as the more distinctive this trade mark is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind. Earlier in this decision I concluded that; (i) the average consumer was a medical professional or a member of the general public, (ii) the goods would be selected by both visual and aural means, although visual considerations were likely to be to the fore, (iii) the competing goods were either identical or similar to a high degree, (iv) the average consumer would, given the nature of the goods at issue, pay a higher than normal level of attention when selecting such goods, (v) the competing trade marks were visually, aurally and conceptually highly

similar, and (vi) the opponent's earlier trade marks were possessed of a high degree of inherent distinctive character.

22. Having reached those conclusions, I have, notwithstanding the heightened degree of care the average consumer will take when selecting the goods at issue (even if that is a medical professional prescribing the goods for use by others), no hesitation concluding that the high degree of similarity in both the goods and the competing trade marks will lead to a likelihood of direct confusion i.e. the applicant's trade mark will be mistaken for the trade mark of the opponent. In reaching that conclusion, I have not overlooked the applicant's statement to the effect that its trade mark is already in the marketplace and there have been no instances of confusion. However, this does not assist the applicant because, as Mr Patel explains, the opponent's trade mark is not yet in use.

Overall conclusion

23. The opposition to the application succeeds.

Costs

24. As the opponent has been successful it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant's statement:	£200
Opposition fee:	£200
Preparing evidence and considering and commenting on the applicant's evidence:	£500
Written submissions:	£200
Total:	£1100

25. I order Synergy Pharmaceuticals to pay First Choice Pharma Ltd the sum of **£1100**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27th day of June 2013

C J BOWEN
For the Registrar
The Comptroller-General