

O/746/21

TRADE MARKS ACT 1994

IN THE MATTER OF  
TRADE MARK APPLICATION NO. 3554433  
BY OPENQUERY LTD  
TO REGISTER AS A SERIES OF TRADE MARKS:

**Synth**  
**SYNTH**

IN CLASSES 9, 38, 41 & 42

AND

IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 600001688  
BY MERCK KGAA

## **Background and pleadings**

1. On 11 November 2020, OpenQuery Ltd. (“the applicant”) applied to register the trade marks **Synth** and **SYNTH** in the UK, under application number UK00003554433. As the only difference between the marks is the use of different letter cases, I will refer to them in the singular (i.e. “the contested mark”) unless it becomes necessary to distinguish between them. The contested mark was published in the Trade Marks Journal for opposition purposes on 15 January 2021. Registration is sought for the following goods and services:

Class 9: Software; not relating to music; none of the aforesaid goods relate to music.

Class 38: Data transfer services.

Class 41: Education services relating to computer software.

Class 42: Software as a service [SaaS]; none of the aforesaid services relate to music.

2. On 15 April 2021, Merck KGaA (“the opponent”) filed a notice of opposition. The partial opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against classes 9, 38 and 42. The opponent relies upon its European Union trade mark number 17472127, **SYNTHIA** (“the earlier mark”). The earlier mark was filed on 13 November 2017 and became registered on 3 May 2018 in respect of the following goods and services, all of which are relied upon for the purposes of the opposition:

Class 9: Computer hardware; computer software; databases; bioinformatics software; chemoinformatics software; software for use in biological and chemical modelling, analysis and information management; software for computer-aided molecular design, data processing and data analysis; chemical data analysis software; drug discovery information systems software; pre-programmed magnetic and/or optical media.

Class 37: Updating of computer hardware and systems.

Class 38: Providing access to databases; leasing access time to databases.

Class 42: Design, updating and rental of computer software and databases; design and rental of computer hardware and systems; analysis of databases and computer systems; computer consultancy; design and development of computer databases; biotechnology and pharmaceutical research; professional consultancy in relation to biotechnology and drug development; technical project studies; scientific research and development for others; analysis and preparation of data for scientific research; provision of information in relation to biology, genomics, proteomics, chemistry, biotechnology, pharmaceutical research, drug discovery and drug development.

Class 45: Licensing of software.

3. Given the respective filing dates, the opponent's mark is an earlier mark, in accordance with section 6 of the Act.<sup>1</sup> However, as it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within section 6A of the Act. As a consequence, the opponent may rely upon all of the goods and services for which the earlier mark is registered without having to establish genuine use.

4. The opponent essentially argues that the respective goods and services are identical or similar and that the marks are similar, giving rise to a likelihood of confusion.

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

6. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1 to 3 of rule 20 of the Trade Mark Rules 2008 but provides that rule 20(4) shall continue to apply. Rule 20(4) stipulates that "the Registrar may, at any time, give leave to either party to file evidence upon such terms as the Registrar thinks fit". The net effect of these changes is to require the parties to seek

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<sup>1</sup> Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. Tribunal Practice Notice 2/2020 refers.

leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

7. The opponent is professionally represented by A.A. Thornton & Co, whereas the applicant represents itself. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard only if (i) the Office requests it, or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary. Only the opponent filed written submissions in lieu of an oral hearing. Whilst I do not intend to summarise these, I have taken them into consideration and will refer to them as and where appropriate during this decision. This decision is taken following a careful perusal of the papers.

8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark case law.

### **Preliminary issue**

9. In its counterstatement, the applicant describes various differences between the actual goods and services provided by the parties, including the different fields and industries they currently operate in, asserting that this defeats any possibility of confusion.

10. Pausing here, it is important to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

11. Until a trade mark has been registered for five years, it is entitled to protection in relation to all the goods/services for which it is registered. As previously outlined, the opponent's earlier mark had not been registered for five years at the filing date of the contested application. Consequently, the opponent is not required to prove use of its mark for any of the goods or services for which it is registered. The opponent's earlier

mark is therefore entitled to protection against a likelihood of confusion with the applicant's mark based on the 'notional' use of that earlier mark for all the goods and services listed on the register.

12. The concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd*<sup>2</sup> like this:

"22. [...] It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

13. So far as the applicant's proposed or claimed use of its mark is concerned, in *O2 (UK) Limited v Hutchison 3G UK Limited*,<sup>3</sup> the Court of Justice of the European Union ("CJEU") stated at paragraph 66 that:

"[...] Once a mark has been registered its proprietor has the right to use it as he sees fit so that, for the purposes of assessing whether the application for registration falls within the ground for refusal laid down in that provision, it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier mark in all the circumstances in which the mark applied for might be used if it were to be registered."

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<sup>2</sup> [2004] RPC 41

<sup>3</sup> Case C-533/06

14. As a result, even though the applicant has suggested the ways in which the contested mark will be used, my assessment later in this decision must take into account only the applied-for mark – and its specification – and any *potential* conflict with the opponent's earlier mark. Any differences between the *actual* goods and services provided by the parties, or differences in their target industries, are irrelevant unless those differences are apparent from the respective marks.

## **Decision**

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

15. Sections 5(2)(b) and 5A of the Act read as follows:

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

[...]

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

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

“5A 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.”

### **Case law**

16. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v.*

*Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P:*

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

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

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

### **Comparison of goods and services**

17. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

18. In *Canon*, Case C-39/97, the CJEU stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, [...] 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”.

19. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity 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.

20. In *Gérard Meric v Office for Harmonisation in the Internal Market ('Merici')*,<sup>4</sup> the General Court (“the 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

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<sup>4</sup> Case T-133/05

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

21. For the purposes of considering the issue of similarity of goods or services, 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).

#### Class 9

22. Although the applicant has limited its specification, only software relating to music has been excluded. The applied-for goods still cover all other types of software and, therefore, encompass the opponent’s *‘bioinformatics software; chemoinformatics software; software for use in biological and chemical modelling, analysis and information management; software for computer-aided molecular design, data processing and data analysis; chemical data analysis software; drug discovery information systems software’*. As such, I find the respective goods identical under the principle outlined in *Meric*.

#### Class 38

23. *‘Data transfer services’* refers to the transfer of data from one location, or from one entity, to another, while the opponent’s *‘providing access to databases; leasing access time to databases’* describe the provision of access to sets of data. Although they are closely linked, the respective services differ in nature and method of use. However, in a broad sense, these services have an overlapping purpose in that they both relate to the accessing and viewing of data. The respective services may have the same users and may reach the market through shared channels of trade. They may also be provided by the same undertakings. Further, in my view, there is a degree of competition between them as the user could obtain information by way of data transfer or, instead, seek access to it via a database. Overall, I find that the respective services are similar to a medium degree.

## Class 42

24. Software as a service refers to a service whereby a consumer can use software that is hosted on a provider's server after paying a subscription or licence fee. I interpret the rental of software to be an arrangement whereby a consumer has temporary use of software (which could reasonably include cloud-based software) in exchange for a fee. Therefore, although the applicant's class 42 service is worded differently to the opponent's '[...] rental of computer software [...]', it is considered that they essentially describe the same service. As such, I find that the respective services are identical. This finding is not disturbed by the applicant's limitation, since the opponent's service covers the rental of all types of computer software, including software not relating to music. If I am wrong in this finding, it remains the case that the respective services are highly similar. There is an overlap in nature, intended purpose and method of use. Moreover, the respective services are likely to have the same users and reach the market through the same trade channels. There is also a competitive relationship between them, as a consumer could decide to access software via a subscription or, instead, pay a fee in order to rent it.

25. It should be noted that I have considered the other goods and services relied upon by the opponent. However, none put the opponent in a more favourable position.

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

26. 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 or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

27. 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.”

28. The applicant argues in its counterstatement that the average consumer will consist of highly educated professionals, and in practice the actual users of the software products offered by the parties are different. However, I note that the applicant has not adduced any evidence to that effect. Further, I am required to determine who the average consumer is in the context of notional use of the marks across the parties' specifications and in the terms outlined in the above case law.

29. Due to the nature of the goods and services at issue in these proceedings, it is necessary to identify two groups of relevant consumers, namely, business users and the general public.

30. In respect of business users, the price of the goods in class 9 is likely to vary, depending on their nature and type, but, overall, it is unlikely to be at the highest end of the scale. The frequency at which the goods are purchased is also likely to vary from a single purchase for a particular business purpose at one end of the spectrum, to repeat purchases as part of an ongoing business arrangement at the other. The selection of the goods would be relatively important for consumers from the business community as they will wish to ensure that the products meet their business needs and they would be alert to the potentially negative impact of choosing the wrong product. Business users are also likely to assess whether the goods are appropriate for use in a business capacity (such as, for example, on a large scale with high demands). Similarly, the cost of the services is likely to vary, though, overall, they are likely to require an average outlay. Again, the frequency at which the services are purchased is likely to vary; however, overall, they are likely to be purchased relatively frequently for the ongoing administrative or technological needs of the business. The selection of the services would be a relatively important choice for business users as

they will wish to ensure that they are provided to a professional standard and suitable for their needs. Business users may also consider factors such as the service provider's technical knowledge and previous outcomes when selecting the services. In light of the above, I find that the level of attention of members of the business community would be higher than normal. The goods are available from physical retail establishments, or their online equivalents, where they are likely to be purchased after viewing information on physical displays or on the internet. In these circumstances, visual considerations would dominate. However, I do not discount aural considerations entirely as it is possible that the purchasing of these kinds of goods would involve discussions with sales representatives or word of mouth recommendations. The services are also likely to be purchased after viewing information on the internet, in business prospectuses or brochures. Overall, I am of the view that the purchasing process would be predominantly visual in nature. However, I do not discount aural considerations as it is possible that the purchasing of the services would incorporate verbal consultations or word of mouth recommendations.

31. It is equally likely that some of the goods – such as, for example, '*computer hardware*' and '*computer software*' – will be purchased by the general public. In respect of these consumers, the goods are likely to be more occasional purchases. The cost of the goods will vary, though, overall, they are likely to require an average outlay. The purchasing of the goods is likely to follow a measured thought process and will not merely be casual; for instance, the general public will consider factors such as cost, the specifications of the product, reliability and ease of use during the selection process. In light of the above, I find that the level of attention of the general public would be medium. The goods are typically sold by brick-and-mortar retail establishments, or their online equivalents, where they will be purchased after viewing information on physical displays or the internet. In these circumstances, visual considerations would dominate. However, I do not discount aural considerations entirely as the general public may wish to discuss the products with salespersons prior to purchasing the goods.

## Comparison of the marks

32. It is clear from *Sabel BV v. Puma AG*<sup>5</sup> that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, Case C-591/12P, that:

“34. [...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

34. The respective trade marks are shown below:

Earlier mark	Contested mark
SYNTHIA	Synth SYNTH

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<sup>5</sup> Case C-251/95, paragraph 23

### Overall impressions

35. The earlier mark is in word-only format and comprises the word 'SYNTHIA'. The word is not stylised and there are no other components to the mark. The overall impression of the mark therefore lies in the word itself, in its totality.

36. The contested mark is also in word-only format and consists of the word 'Synth/SYNTH'. Similarly, the word is not stylised and there are no other components to the mark. As such the overall impression of the mark lies in the word itself, in its totality.

### Visual comparison

37. The competing marks are visually similar as they share five identical letters in the same order; the contested mark comprises the first 5 letters of the earlier mark. This similarity appears at the beginning of the respective marks, a position which is generally considered to have more impact due to consumers in the UK reading from left to right.<sup>6</sup> I do not consider the distinction in letter case between the earlier mark and the first mark in the applied-for series to be a point of significant difference between them. This is because the registration of word-only marks provides protection for the word itself, irrespective of whether it is presented in upper or lower case. The competing marks are visually different in that the earlier mark contains an additional two letters that are not replicated in the contested mark; this also renders the competing marks different in length. The differences between the marks are more noticeable given their relatively short length. Overall, the competing marks are visually similar to a medium degree.

### Aural comparison

38. The contested mark comprises one syllable, i.e. "SINTH", whereas the earlier mark consists of three syllables, i.e. "SINTH-EE-AH". The competing marks aurally coincide in the common syllable "SINTH", which is the entirety of the contested mark

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<sup>6</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

and the first syllable of the earlier mark. The competing marks are aurally different insofar as the earlier mark has an additional two syllables. These differences result in a medium degree of similarity overall.

### Conceptual comparison

39. The opponent has submitted that consumers would perceive its earlier mark as an informal name for a synthetic bacterium. I disagree. The opponent has not adduced any evidence to show that the average consumer would immediately understand its mark in the manner it has suggested. Moreover, for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>7</sup> In my view, the earlier mark would be recognised by some consumers as an alternative, albeit less common, spelling of the forename Cynthia. It is possible that other consumers would, instead, perceive the earlier mark as an invented word. For these consumers, the earlier mark will have no conceptual meaning. The contested mark would be understood by the average consumer as an abbreviation of the noun ‘synthesizer’, meaning an electronic musical instrument which produces sounds by generating and combining signals of different frequencies.<sup>8</sup> Irrespective of how the earlier mark is perceived by consumers, given that the contested mark conveys a clear meaning that is not replicated by the earlier mark, there is no conceptual overlap. Consequently, I find that the competing marks are conceptually dissimilar.

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

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

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<sup>7</sup> *Ruiz Picasso v OHIM* [2006] E.T.M.R 29.

<sup>8</sup> <https://www.lexico.com/definition/synth>; <https://www.lexico.com/definition/synthesizer>



overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

41. 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. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

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

43. As the earlier mark is comprised of one plain word with no other elements, its distinctiveness lies indivisibly in the word itself. In my view, the word ‘SYNTHIA’ will be recognised by a significant proportion of average consumers as an alternative, albeit less common, spelling of the female name Cynthia. For this section of

consumers, the earlier mark possesses a medium level of inherent distinctive character. I do not discount that another significant proportion of average consumers would perceive the earlier mark as an invented word, with no recognisable meaning. For this group of consumers, the earlier mark possesses a high level of inherent distinctive character.

### **Likelihood of confusion**

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

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

46. I have found that the respective goods and services are either identical or similar to at least a medium degree. I have found that relevant consumers of the goods and services would include the general public and business users. I have found that the general public would pay a medium degree of attention when selecting the goods, while business users would demonstrate a higher than normal level of attention. I have found that the purchasing process will be largely visual, however, I have not discounted aural considerations. I have found that the earlier mark and the contested mark are visually similar to a medium degree, aurally similar to a medium degree and conceptually dissimilar. I have found that the earlier mark has a medium level of inherent distinctive character for those consumers that would view the mark as a

female name, though, for others that view the mark as an invented word, the earlier mark has a high level of inherent distinctive character.

47. I acknowledge that the contested mark comprises the first five letters of the earlier mark. However, I do not consider that the differences between the competing marks will be overlooked by either the general public or business users in a visual or aural context. In my view, this is particularly the case given their length: the additional letters in the earlier mark are not negligible and, as the competing marks are both short words (being five and seven letters, respectively), the differences between the marks are more noticeable. Furthermore, in *Picasso*,<sup>9</sup> the CJEU found that conceptual differences between trade marks may counteract the visual and aural similarities between them. The contested mark has a clear meaning that is not conveyed by the earlier mark, irrespective of whether the latter is perceived as an alternative spelling of the female name Cynthia or an invented word; in my view, this conceptual difference would certainly be noticed by consumers. In my judgement, taking all the above factors into account, despite the earlier mark having at least a medium level of inherent distinctive character, the differences between the competing trade marks are likely to be sufficient to avoid consumers, paying at least a medium degree of attention, mistaking the contested mark for the earlier mark (or vice versa), even on goods and services which are identical. Consequently, notwithstanding the principle of imperfect recollection, I do not consider there to be a likelihood of direct confusion.

48. Having found no likelihood of direct confusion, I now go on to consider 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

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<sup>9</sup> *The Picasso Estate v OHIM*, Case C-361/04, paragraph 20

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 not exhaustive but provide helpful focus.

50. I bear in mind that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.<sup>10</sup> In my opinion, the earlier mark will be perceived as a single word. The average consumer will make no attempt to dissect the word ‘SYNTH’ from the whole. In any event, the shared string ‘SYNTH’ is not so strikingly distinctive that consumers

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<sup>10</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

will assume that only the opponent would be using it in a trade mark. Moreover, the difference created by the inclusion of the suffix 'IA' in the earlier mark (and lack thereof in the contested mark) is not simply adding or removing a non-distinctive element. Nor is this difference characteristic of any logical brand extension with which consumers would be familiar. I can see no reason why an undertaking would remove the 'IA' suffix from the forename, or invented word, 'SYNTHIA' to result in the dictionary word 'SYNTH'. Consequently, I do not believe that consumers will assume that the applicant and the opponent are economically linked undertakings on the basis of the competing trade marks; I am unconvinced that consumers would assume a commercial association or licensing arrangement between the parties, or sponsorship on the part of the opponent, merely because of the shared string 'SYNTH'. Taking all of the above factors into account, I do not consider there to be a likelihood of indirect confusion between the competing marks, even in relation to goods and services that are identical.

### **Conclusion**

51. The opposition under section 5(2)(b) of the Act has failed. Subject to any appeal against my decision, the application will proceed to registration in the UK.

## **Costs**

52. As the opposition has been unsuccessful, ordinarily the applicant would be entitled to an award of costs. However, as it has not instructed professional representatives, it was invited by the Tribunal to indicate whether it intended to make a request for an award of costs, including accurate estimates of the number of hours spent on a range of given activities relating to defending the proceedings. It was made clear by letter dated 23 July 2021 that, if the pro-forma was not completed, no costs would be awarded. The applicant did not return a completed pro-forma to the Tribunal and, on this basis, no costs are awarded.

**Dated this 8<sup>th</sup> day of October 2021**

**Sarah Wallace  
For the Registrar**