

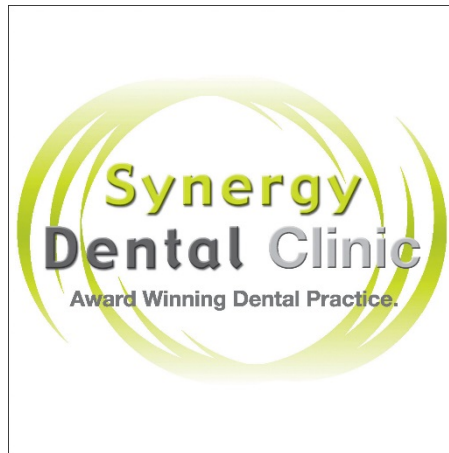
O-251-16

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3108095

BY ANDREW JOHNSTON

TO REGISTER THE TRADE MARK



IN CLASS 44

AND OPPOSITION THERETO

**UNDER NO 404747 BY
SYNERGY HEALTH LIMITED
(FORMERELY SYNERGY HEALTH PLC)**

Background and pleadings

1) On 11 May 2015, Zuber Bagasi (“the applicant”) applied to register the trade mark (“the application) on the front cover in the UK. It was accepted and published in the Trade Marks Journal on 5 June 2015 in respect of “Dentist services” in class 44.

2) On 23 July 2015, Synergy Health Plc opposed the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its earlier UK Trade Mark (“the earlier mark”). Pertinent details of the earlier mark are below:

Mark:	SYNERGYHEALTH
Number:	2490881
Filing date:	23 June 2008
Date of entry in register:	8 July 2011
Publication date:	19 September 2008
Earlier relied upon services:	Class 44 “dentistry services”

3) In the statement of case it was argued that the respective services are identical and that the marks are similar.

4) The applicant filed a counterstatement denying the claims made, setting out why it does not consider the marks to be confusingly similar. The submissions made within the counterstatement shall be referred to where necessary in this decision. The applicant states that it has an earlier trade mark registration (no. 2554881) and in view of this the respective marks, plus other marks containing SYNERGY, co-exist on the UK Register. The applicant also argues that there is no evidence of confusion. Each of these arguments shall be addressed later in this decision.

5) Neither side filed evidence, nor did they file written submissions. A hearing took place via video-link on 7 April 2016, with the opponent professionally represented by

Mr John Reddington of Williams Powell and the applicant by Ms Ann Wong of MW Trade Marks.

Preliminary issues

Substitution of parties

6) The day before the hearing, Ms Wong, on behalf of the applicant, sought clarification on the identity of the opponent. She stated that her understanding was that the opponent, during the course of the proceedings, had changed ownership but the applicant had not been notified. This was addressed as a preliminary issue at the hearing whereby Mr Reddington confirmed that the opponent changed corporate status from being a public company to a private limited company and that the trade marks register had been amended accordingly. When an opponent changes midway through opposition proceedings, the new opponent is required to provide certain assurances and, once agreed, they are substituted. During the hearing Mr Reddington provided these assurances, namely that Synergy Health Limited has 1) had sight of all the forms and evidence filed in the opposition, 2) stands by the opposition claims, and 3) are aware and accept its liability for costs (if applicable). In view of the assurances provided by Mr Reddington, Synergy Health Plc is “the opponent”.

Defences

7) The applicant relies upon a number of arguments which it claims will avoid any likelihood of confusion. These were dismissed at the hearing, though I shall nevertheless address each:

- a) *The word Synergy is diluted on the UK Register for identical and similar services*

8) The comparison I must make is between the application and the earlier mark for the services which it is registered for. The existence of other trade marks on the register is not relevant to the judgment I must make. See the judgments of the Court of Justice of the European Union (“CJEU”) in *Henkel KGaA v Deutsches Patent- und Markenamt*,

Case C-218/01 and the General Court (“GC”) in *Zero Industry Srl v OHIM*, Case T-400/06.

b) The opponent has not challenged the applicant’s earlier registration¹

9) This argument is wrong in law. In *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09, Ms Anna Carboni sitting as the appointed person rejected this defence. If an applicant is under attack and has an earlier mark or right which could be used to oppose or invalidate the mark relied upon by the opponent, then it is for the applicant to invoke that earlier mark.

c) It is unlikely that the opponent is using its mark in all classes, especially for the relied upon services. Further, they are unlikely to have any intention to use its registration for all of the applied for goods and services.

10) In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the CJEU stated at paragraph 66 of its judgment that when assessing the likelihood of confusion under Section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. Therefore, I reject the applicant’s argument.

d) The opponent has not shown any evidence of confusion between the marks

11) In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated at paragraph 80 that:

“.....the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has

¹ UK trade mark registration no. 2554881 for the mark SYNERGY DENTAL PRACTICES (plus device)

been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

12) In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff’s registered trade mark.”

13) In view of the above, I reject the applicant’s claim that a lack of marketplace confusion means that there is not a likelihood of confusion.

DECISION

Legislation and case law

14) Sections 5(2)(b) of the Act is as follows:

“A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Case law

15) 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 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

16) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

17) 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 users of the respective goods or services;

b) The physical nature of the goods or acts of services

- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

18) The respective services are as follows:

Application	Earlier mark
Class 44: Dentist services	Class 44: Dentistry services

19) It is clear that the respective services are identical.

Comparison of marks


20) It is clear from *Sabel BV v. Puma AG*, (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall

impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

21) The average consumer normally perceives a mark as a whole and does not analyse its details. Therefore, in making the comparison I must decide which, if any, of the components I consider to be distinctive and dominant. I do this without engaging in an artificial dissection of the marks.

22) The respective trade marks are shown below:

Application	Earlier mark
	SYNERGYHEALTH

23) In this instance, the application consists of a number of words and a device. The word “Synergy” is above the words “Dental Clinic” in a similar size font but different colour. Below this, and in smaller font, are the words “Award Winning Dental Practice”. Apart from the word “Synergy”, all of the words in the application are descriptive. Ms Wong (for the applicant) described the application as being “busy”, “complex” with “a lot going on with it”. Ms Wong also argued that the combination of elements produces a total effect that is greater than the sum of the individual elements. Mr Reddington (for the opponent) argued that the device is “rather weak, decorative and non-distinctive” and therefore the combination of elements does not make a material difference to there being similarity.

24) With regard to the earlier mark, this consists of SYNERGYHEALTH, a conjunction of two well-known words which the average consumer would recognise and understand, with the latter word being broadly descriptive of the services provided.

25) In my view the word “Synergy” is the most prominent element of each mark. Whilst the device in the application does add a modicum of distinctive character, I agree with the applicant that it would be viewed as decorative and I consider it to be less prominent than the word SYNERGY. I find the word “Synergy” to be more dominant than the device in the application and more dominant in the earlier mark than the descriptor HEALTH. It is also the first element in the earlier mark, a contributory factor in its dominance.

26) Visually, the application does include a device and more words than the earlier mark which consists solely of SYNERGYHEALTH. As previously stated the word SYNERGY would immediately be separated from the word HEALTH. Therefore, since the respective marks both include the word SYNERGY, which is the dominant element within the mark, I consider there to be a medium degree of visual similarity.

27) Aurally, the device in the application would not be verbalised. Therefore, the first word of the respective marks would be spoken in the same way, i.e. SYNERGY. The words DENTAL CLINIC and HEALTH are unlikely to be verbalised. Therefore, I consider the overall degree of aural similarity as being high.

28) Conceptually, the word SYNERGY would be recognised as being a dictionary defined word but consumers may not know what it means. Therefore the word SYNERGY would be remembered. Whilst the other words in the respective marks would also be understood, since they are descriptive they do not lessen the overall conceptual similarity between the marks. Therefore, I consider there to be a high degree of conceptual similarity.

Average consumer and the purchasing act

29) 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.

30) 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 at paragraph 60 in these terms:

“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.”

31) The services in question are dentist services. These are services which would be acquired by the public at large. They are likely to be sought following a visual perusal of websites, directories or signage in close proximity to the consumer's home or workplace. Therefore they would be sought following a visual perusal, though I do not discount aural recommendations.

32) Generally, consumers are likely to base their decision on which dentist to visit on its location and convenience. On this basis, I consider the level of care and attention paid when choosing which dentists to visit as being medium.

Distinctive character of the earlier trade mark

33) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23 that:

“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-0000, paragraph 49).

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).”

34) The opponent has not filed any evidence, nor has it made any claim to an enhanced degree of distinctive character. Therefore, I only have the inherent distinctive character to consider.

35) The mark consists of two well-known words which have been conjoined. As previously stated it has not been argued that the earlier mark is an invented word so it is not at higher end of the distinctiveness scale. The opponent claims that the earlier mark has an average degree of distinctive character, and the applicant states that it is “not the highest level of distinctiveness”. In my view, the combination of the distinctive word SYNGERY with the descriptor HEALTH renders the overall distinctiveness of the earlier mark as medium.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

36) 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 keep in mind the distinctive character of the opponent's 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 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 he has retained in his mind.

37) I have already found that:

- The word SYNERGY is more prominent element in the respective marks.
- The marks are visually similar to an above medium degree but not high. They are conceptually and aurally similar to a high degree.
- The respective services are identical.
- The average consumer of the services are the general public, who will pay a medium degree of care and attention following a visual inspection.
- I consider the inherent distinctive character of the earlier mark to be medium.

38) Taking all of the above into account, I conclude that there is a likelihood of direct confusion. During the hearing Ms Wong emphasised the impact of the device within the application and that the interaction between the varying elements when considered as a whole produce a total effect that is greater than the individual parts. I have already concluded that the device would be viewed as decorative and SYNERGY more prominent. Since consumers rely upon an imperfect recollection, the word SYNERGY is what would be noticed by consumers and the other matter does not result in the marks being distinguishable from one another. Moreover, any lesser degree of similarity between the marks, has certainly been offset by the services being identical. Confusion is likely to arise.

OUTCOME

39) The opposition under section 5(2)(b) of the Act succeeds. Subject to appeal, the application shall be refused in its entirety.

COSTS

40) The opponent has been successful and is entitled to a contribution towards its costs. During the hearing Mr Reddington asked for costs at the higher end of the published scale. He argues that in view of the applicant's "lack of chances of success" and due to the number of "non-points" raised, the opposition should not have got to the hearing stage. Further, Mr Reddington argued that the applicant states in its skeleton that it is cost conscious yet it is happy to "waste" his client's money by arguing "non-points" and pursuing the application. Ms Wong stated that many of the submissions made in relation to the comparison of the marks are valid. It is clear many of the arguments put forward were unsuccessful, however I do not believe that it would have been particularly time consuming for Mr Reddington to consider (and dismiss) these arguments. In the circumstances I award the opponent the sum of £700, which is calculated as follows:

Official fee	£100
Preparing a statement and considering the applicant's counterstatement	£200
Preparing for and attending a hearing	£400
Total	£700

41) I therefore order Zuber Bagasi to pay Synergy Health Limited the sum of £700. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 19TH day of May 2016

MARK KING

For the Registrar,

The Comptroller-General