

O-1038-24

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION UK00003835350 BY CLOSED LOOP MEDICINE LTD
TO REGISTER:**

SOMSYNC

AS A TRADE MARK IN CLASSES 5, 10 AND 44

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 438647
BY IPSEN PHARMA S.A.S.**

Background and pleadings

1. On 3 October 2022, CLOSED LOOP MEDICINE LTD (“the applicant”) applied to register “SOMSYNC” as a trade mark in the United Kingdom in respect of the following goods and services:

Class 5: Drugs for medical use; Drugs for medical purposes; Drugs for treatment of insomnia; Melatonin drugs; Pharmaceuticals; Pharmaceutical drugs; Pharmaceutical drugs for treatment of insomnia; Therapeutic drugs and agents; Pharmaceuticals and natural remedies; Medical preparations for humans; Medicines; Medicines for the treatment of sleep disturbance; Parts and fittings for all of the aforesaid goods.

Class 10: Medical apparatus; Medical apparatus for treatment of insomnia; Medical devices; Medical devices for treatment of insomnia; Electro medical instruments; Medical testing instruments; Medical instruments for recording physiological data; Electronic monitoring instruments for medical use; Parts and fittings for all of the aforesaid goods.

Class 44: Healthcare; Health consultancy; Healthcare services; Healthcare information services; Healthcare advisory services; Health clinical services; Health screening services; Medical health assessment services; Therapy services; Monitoring of patients; Individual medical counseling services provided to patients; Medical care and analysis services relating to patient treatment; Health counselling; Health screening; Preparation of reports relating to health care matters, Providing news and information in the field of healthcare; Providing medical information; Information and advisory related to all of the aforesaid services.

2. On 17 January 2023, a notice of opposition was filed by Ipsen Pharma S.A.S. (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition concerns the application in its entirety and, for the purpose of the

opposition, the opponent relies upon the following trade marks and all goods for which they are registered, as laid out below:

United Kingdom Trade Mark ("UKTM") 3836990

SOMYNA

Class 5: *Pharmaceutical preparations.*

Class 10: *Medical apparatus and instruments; Surgical apparatus and instruments; Injectors for medical purposes; Autoinjectors for the administration of pharmaceutical preparations.*

Filing date: 7 October 2022

Registration date: 30 December 2022

UKTM 3774102:

SOMSET

Class 5: *Pharmaceutical preparations.*

Class 10: *Medical apparatus and instruments; Surgical apparatus and instruments; Injectors for medical purposes; Autoinjectors for the administration of pharmaceutical preparations.*

Filing date: 5 April 2022

Registration date: 1 July 2022

3. The opponent contends that the similarities between the parties' trade marks and the identity and/or similarity between the respective goods and services give rise to a likelihood of confusion, on the part of the relevant public, including a likelihood of association.

4. In its counterstatement, the applicant denies that there exists a likelihood of confusion, maintaining that the respective goods and services differ and that the parties' marks are visually, aurally and conceptually different.

5. The applicant is represented by Basck Limited whilst the opponent is represented by Reddie & Grose LLP. Only the applicant filed evidence during the course of the proceedings. Neither party requested a hearing, though the opponent elected to file written submissions in lieu. This decision is taken following a careful perusal of the papers.

Relevance of EU law

6. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

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. Section 5A of the Act reads as follows:

“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.”

9. The trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As neither mark had completed its registration process more than 5 years prior to the application date of the mark at issue, neither is subject to the proof of use provisions set out in section 6A of the Act. Consequently, the opponent may rely upon both of its earlier marks and all goods it has identified without providing evidence of use.

The applicant’s evidence

10. The applicant filed evidence in the form of a witness statement from Dr Paul Goldsmith, the applicant’s director, dated 27 November 2023. Dr Goldsmith has held a directorial position since the company’s incorporation on 26 January 2017. His statement is supported by three exhibits (PL1 to PL3).

11. I take the following from Dr Goldsmith’s evidence:

- The applicant dedicates the use of its SOMSYNC mark to the treatment of insomnia and sleep disturbances.
- Dr Goldsmith is not aware of any consumers who would “associate or confuse” the applicant’s mark with either of the opponent’s.
- At Exhibits PL1 and PL2 Mr Goldsmith encloses screenshots of the parties’ respective websites¹. At PL3, he encloses an extract from *TM View* which shows that there are “almost 400 active marks beginning with the phrase “SOM” and filed in classes 5, 10 or 44 in the UK.”

That concludes my summary of the applicant’s evidence insofar as I consider it necessary.

¹ <https://www.closedloopmedicine.com> and <https://www.ipsen.com/stories/>

Preliminary matters

State of the register

12. On the basis of his findings enclosed at PL3 (above) concerning marks beginning S-O-M, Mr Goldsmith submits that “it can be clearly concluded that such trade marks are able to coexist in the UK mark [sic] and do not constitute a likelihood of confusion among relevant consumers”. Whilst Mr Goldsmith’s findings are noted, I should make clear that the existence of such marks on the register will not have any bearing on the outcome of these proceedings. In *Zero Industry Srl v OHIM*², the General Court (“GC”) stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘...there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II 4865, paragraph 68, and Case T 29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II 5309, paragraph 71). “

13. In light of the above, and given that I have no evidence showing the use of such trade marks in the marketplace, that line of reasoning will play no part in my considerations as to whether there exists a likelihood of confusion.

² Case T-400/06

Absence of confusion

14. In response to Mr Goldsmith's submission insofar as he has "never heard of or possessed knowledge" concerning consumers who would confuse the parties' respective marks, I can deal with the point relatively briefly. Tribunal Practice Notice ("TPN") 4/2009 states:

'6. Parties are also reminded that claims as to a lack of confusion in the market place will seldom have an effect on the outcome of a case under section 5(2) of the Act.

7. In *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 Laddie J held:

"22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. 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."

15. In *Rousselon Freres et Cie v Horwood Homewares Limited*³, Warren J commented:

"99. There is a dispute between Mr Arnold and Mr Vanhegan whether the question of a likelihood of confusion is an abstract question rather than whether anyone has been confused in practice. Mr Vanhegan relies on what was said by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at paragraphs 22 to 26, especially paragraph 23. Mr Arnold says that that cannot any longer be regarded as a correct statement of the law in the light of *O2 Holdings Ltd v Hutchison 3G Ltd* [2007] RPC 16. For my part, I do not see any reason to doubt what Laddie J says...)"

16. Further, in *The European Limited v The Economist Newspaper Ltd*⁴ 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."

On that basis, it seems clear that the applicant's submission does not assist it. I am required to consider the likelihood of confusion notionally i.e. I must consider what the future position would be, taking into account the full breadth of the parties' specifications and marks as they appear on the register, regardless of whether or not there have been any identified instances of confusion previously.

Section 5(2)(b) - Case law

17. The following principles are gleaned from the decisions of the courts of the European Union 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 Office for Harmonization in the*

³ [2008] EWHC 881 (Ch)

⁴ [1998] FSR 283

Internal Market (Trade Marks and Designs) (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 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 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 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 and services

18. The goods and services to be compared are set out at paragraphs 1 and 2 to this decision.

19. In Mr Goldsmith's witness statement, in regard to the parties' respective fields, he asserts that:

“...even if both companies run businesses in the medical field, they do not provide the same goods and services to the relevant public, therefore their business core is entirely different.”

He also states that:

“Whilst I acknowledge that there might be perceived to be an overlap between classes 5 and 10 at first glance, there is no similarity in practice, especially since My Company's terms have been narrowed to focus on drugs for the treatment of sleep disturbances... It shall be pointed out that the Opponent's goods are pharmaceutical preparations which is a very broad term. Based on its website, it is highly possible that its trade mark will be connected with Opponent's specialisation which are Oncology, Neuroscience...and rare disease....

However, the registered scope of Opponent's goods is not specified and does not reveal their specific nature."

20. Whilst I understand the point Mr Goldsmith is making here, particularly as the opponent is not required to provide evidence of use, I must consider the respective specifications objectively. The opponent may rely upon the broad terms for which its earlier marks are protected and these are not subject to any degree of limitation on the basis of the webpages Mr Goldsmith has enclosed or the assertions made in his witness statement.

21. When approaching my comparison, I am guided by the provision set out in *Gérard Meric v OHIM*⁵, which reads as follows:

"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".

22. 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;

⁵ Case T-133/05

(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.

23. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*,⁶ 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.”

24. In *Kurt Hesse v OHIM*⁷, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*,⁸ the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

25. For the purpose of a comparison it is permissible to group goods or services together, as appropriate.⁹

⁶ Case C-39/97

⁷ Case C-50/15 P

⁸ Case T-325/06

⁹ *Separode Trade Mark* BL O-399-10 (AP)

Drugs for medical use; Drugs for medical purposes; Drugs for treatment of insomnia; Melatonin drugs; Pharmaceuticals; Pharmaceutical drugs; Pharmaceutical drugs for treatment of insomnia; Therapeutic drugs and agents; Pharmaceuticals and natural remedies; Medical preparations for humans; Medicines; Medicines for the treatment of sleep disturbance (class 5)

26. On the basis of the principle laid out in *Meric*, I find the applied-for terms in class 5 are encompassed by the opponent's *pharmaceutical preparations* and should therefore be treated as identical. Should this be considered too broad a finding, in respect of those terms which are not deemed identical, I find a high degree of similarity nonetheless. The goods are likely to overlap, at least, in use (insofar as both sets of goods could be used to treat the same ailment or deficiency), in their respective users and trade channels and, in certain circumstances, they could be competitive and/or complementary.

...Parts and fittings for all of the aforesaid goods. (class 5)

27. If the applied for *...parts and fittings for all of the aforesaid goods* in class 5 are not encompassed by the opponent's *pharmaceutical preparations*, I find at least a medium degree of similarity. In the case of the *parts and fittings*, whilst it is not entirely clear what exactly the term refers to, I note that the opponent has submitted that these goods are identical to its *pharmaceutical preparations*, explaining that "a pharmaceutical preparation can be a finished drug or it can be a compound used in the formulation of that drug." To my mind the term could, as the opponent suggests, represent certain compounds (in a finished medicinal product comprising multiple ingredients, for example) or it could represent certain vessels or casings within which the finished drugs, for example, are stored ahead of consumption (such as a soluble capsule, perhaps). There may be a distinction in the goods' users and in their immediate use (though ultimately they will serve the same purpose), the trade channels are not necessarily the same and they are unlikely to be competitive though there may, in some circumstances, be some similarity in physical nature and, to the extent that the *parts and fittings* are, on the basis of the above, essential to the creation

of, for example, pharmaceutical drugs or medicines, I find there is an element of complementarity.

Medical apparatus; Medical apparatus for treatment of insomnia; Medical devices; Medical devices for treatment of insomnia; Electro medical instruments; Medical testing instruments; Medical instruments for recording physiological data; Electronic monitoring instruments for medical use (class 10)

28. The applicant's terms fall within the wider remit of *medical apparatus and instruments*, for which the opponent has protection. The goods are, consequently, to be considered identical.

... Parts and fittings for all of the aforesaid goods. (class 10)

29. As for the *parts and fittings* of the preceding goods in class 10, if those are not encompassed by the opponent's *medical apparatus and instruments*, I, again, find at least a medium degree of similarity. Their immediate use may not be the same but the goods' ultimate use is highly similar, though the users may not necessarily be shared. There will be some degree of coincidence in the goods' physical nature and, in some circumstances, their respective trade channels. The goods are not competitive but I do consider them complementary, both to the extent that one is indispensable for the other and in the sense that it would seem reasonable for the average consumer to expect a single undertaking to be responsible for both.

Healthcare; Health consultancy; Healthcare services; Healthcare information services; Healthcare advisory services; Health clinical services; Health screening services; Medical health assessment services; Therapy services; Monitoring of patients; Individual medical counseling services provided to patients; Medical care and analysis services relating to patient treatment; Health counselling; Health screening; Preparation of reports relating to health care matters, Providing news and information in the field of healthcare; Providing medical information; Information and advisory related to all of the aforesaid services. (class 44)

30. I consider the above applied-for services against the opponent's fairly broad terms *pharmaceutical preparations* and *medical apparatus and instruments*. The respective terms share a purpose, broadly speaking, insofar as each targets, or seeks to improve, the health or wellbeing of the end consumer. Whilst I accept that individual conditions are likely to be variable, the nature of both parties' terms is such that, absent of any particularisation or limitation, they could be used to treat the same conditions or ailments. Both the goods and the services are likely to be accessed both by the general public and individuals within the medical or healthcare profession. There is a clear distinction in the nature of the goods and services and there may, in certain circumstances, be an opportunity for competitiveness. A medical professional, for example, may choose between a particular apparatus or a pharmaceutical product when considering how to treat a particular ailment. The consumer may see a relationship between goods which are used to address various ailments and a wider healthcare service which seeks to address the same or similar ailments or direct the consumer toward an appropriate remedy, for example. Weighing all considerations, and taking into account what could be a fairly wide fluctuation in the immediate purpose of the goods and services and their nature, I nonetheless find at least a low degree of similarity.

The average consumer and the nature of the purchasing act

31. 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. 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. (as he then was) 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.”

32. In *Mundipharma AG v OHIM*¹⁰, the GC accepted that there were two groups of relevant consumers for a pharmaceutical product, professional users and the general public.

33. In *Olimp Laboratories sp. z o.o. v EUIPO*¹¹, the GC considered the average consumer for, and level of attention which would be paid in, the selection of pharmaceutical and medical products in class 5. It said:

“39 Where the goods in question are medicinal or pharmaceutical products, the relevant public is composed of medical professionals, on the one hand, and patients, as end users of those goods, on the other (see judgment of 15 December 2010, *Novartis v OHIM – Sanochemia Pharmazeutika (TOLPOSAN)*, T 331/09, EU:T:2010:520, paragraph 21 and the case-law cited; judgment of 5 October 2017, *Forest Pharma v EUIPO – Ipsen Pharma (COLINEB)*, T 36/17, not published, EU:T:2017:690, paragraph 49).

40 Moreover, it is apparent from case-law that, first, medical professionals display a high degree of attentiveness when prescribing medicinal products and, second, with regard to end consumers, in cases where pharmaceutical products are sold without prescription, it must be assumed that those goods will be of concern to consumers, who are deemed to be reasonably well informed and reasonably observant and circumspect where those goods affect their state of health, and that these consumers are less likely to confuse different versions of such goods. Furthermore, even assuming that a medical prescription is mandatory, consumers are likely to demonstrate a high level of attentiveness upon prescription of the goods at issue in the light of the fact that those goods are pharmaceutical products. Thus, medicinal products, whether or not issued on prescription, can be regarded as receiving a heightened level of attentiveness

¹⁰ Case T-256/04

¹¹ Case T-817/19, EU:T:2021:41

on the part of consumers who are normally well informed and reasonably observant and circumspect (see judgment of 15 December 2010, *TOLPOSAN*, T 331/09, EU:T:2010:520, paragraph 26 and the case-law cited).

41 [...]

42 In the present case, having regard to the nature of the goods concerned, namely medical or pharmaceutical products in Class 5, the Board of Appeal acted correctly in finding in paragraphs 18 to 21 of the contested decision – which, moreover, is not disputed by the applicant – that, in essence, the relevant public was made up of medical professionals and pharmacists and consumers belonging to the general public with a higher than average degree of attentiveness.”

34. As the above case law indicates, the average consumer of the goods and services at issue will comprise both members of the general public and professional users. To my knowledge, the goods are generally selected from the pages of a medical catalogue or publication or in the cases of some of the goods, *pharmaceuticals*, for example, selection may be made from the shelves of a relevant retail establishment such as a pharmacy. The services are also likely to be selected from the pages of a relevant catalogue or online site. The visual impression of the goods and services is therefore likely to play the greatest part in the selection process. That being said, I do not discount the significance of the marks’ aural impact as guidance may be offered in conversations amongst professionals or peers, for example. Generally speaking, the goods and services are not purchased on a particularly frequently basis though I acknowledge there will be exceptions. Still, given that the goods and services concern the health and wellbeing of the end consumer, it seems likely that at least a medium degree of attention will be engaged during the selection process, ranging to a high degree in some circumstances.

Comparison of trade marks

35. 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 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.”

36. It would be wrong, therefore, 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.

37. The trade marks to be compared are displayed in the table below:

Opponent's marks	Applicant's mark
<p data-bbox="368 1312 604 1346"><u>UKTM 3836990:</u></p> <p data-bbox="368 1368 604 1420">SOMYNA</p> <p data-bbox="368 1514 604 1547"><u>UKTM 3774102:</u></p> <p data-bbox="368 1570 604 1621">SOMSET</p>	<p data-bbox="954 1424 1222 1476">SOMSYNC</p>

38. Both the opponent's mark ending '990 and its mark ending '102 comprise a single word of six letters. In both cases, in the absence of any additional components, each mark's overall impression resides solely in the word it comprises.

39. The applicant's mark is made up of a single seven-letter word. Its overall impression rests solely in the word itself.

The opponent's mark ending '990

40. Visually, the parties' marks coincide in their first three letters (S-O-M). They also incorporate, sequentially, 'Y-N', signifying the fourth and fifth letters in the opponent's mark and the fifth and sixth letters in the application. The marks' remaining letters share no meaningful degree of similarity. Weighing those considerations, and keeping in mind that the beginnings of marks generally have a greater impact on the consumer, I find the marks are visually similar to at least a medium degree.

41. I find the applicant's mark likely to be articulated in three syllables; loosely SOM-EE-NAH or SOM-IH-NAH. The opponent's mark will likely be expressed in two syllables; SOM-SINC. The marks differ, in length, by one syllable, though the first syllable is identical. I find a medium degree of aural similarity between the marks.

42. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer¹². In my view, SOMYNA will be viewed as an invented word with no retrievable concept. Turning to the applicant's mark, I make a similar finding. The word SOMSYNC, to my knowledge, will convey no specific meaning to the average consumer, though I do find it likely that the average consumer will identify that the word incorporates a SYNC element, which is a fairly ordinary dictionary word which will be readily understood (meaning, vaguely speaking, to work together or merge together in some respect). Whilst, on the whole, neither mark will evoke a specific concept, the identification of SYNC in the applicant's mark creates somewhat of a conceptual distinction between the parties' marks.

The opponent's mark ending '102

43. Visually, the respective marks each begin identically with the letters S-O-M-S. The marks' remaining letters are distinct, and there is one less letter in the opponent's mark than in the applicant's. Weighing those factors, and keeping in mind where the similarities are positioned, I find at least a medium degree of visual similarity.

¹² See, for example, *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29

44. Aurally, the applicant's mark will likely be articulated as I have expressed above. The opponent's mark will likely be articulated in two syllables; SOM-SET. I find the aural similarity fairly high.

45. Conceptually, I have found that the applicant's mark will be viewed as an invented word absent of any tangible meaning, though the SYNC element within the word is likely to be readily identified. To my knowledge, the opponent's mark will also fail to convey a specific concept and will instead be viewed as an invented word. Neither mark provides the average consumer with a clear concept, though the acknowledgement of the word SYNC in the applicant's mark allows for a degree of conceptual distinction.

Distinctive character of the earlier trade mark

46. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, 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 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).”

47. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services for which they are registered, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will typically fall somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; generally, the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced as a result of it having been used in the market.

48. In the absence of evidence showing the use made of the earlier marks, I have only their inherent position to consider. I have found that both of the opponent’s marks will be viewed as invented words which fail to evoke any specific meaning. In the absence of any conceptual indication, I find neither mark capable of being descriptive nor allusive when considered in respect of the relied upon goods and services. With those considerations in mind, I reach the view that both earlier marks enjoy a fairly high degree of inherent distinctiveness.

Likelihood of confusion

49. 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 services 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 it is, the greater the likelihood of confusion.

50. To make the assessment, I must adopt the global approach advocated by the case law whilst taking account of my earlier conclusions. I also bear in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and, instead, must rely upon the imperfect picture of them retained in its mind.

51. In *Kurt Geiger v A-List Corporate Limited*¹³, Mr Iain Purvis Q.C., as the Appointed Person, pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

52. Confusion can be direct or indirect. Direct confusion is simply a matter of mistaking one mark for another, whereas indirect confusion arises where the consumer recognises that one mark is different from the other but nonetheless attributes what the marks have in common to a shared or related origin¹⁴.

¹³ BL O-075-13

¹⁴ *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10

53. I have found the parties' marks visually similar to at least a medium degree and aurally similar to either a medium or fairly high degree. I have found that neither of the opponent's marks nor the applicant's mark will convey a tangible meaning (in their entirety, at least) and that both earlier marks enjoy a fairly high degree of inherent distinctiveness. The average consumer will apply between a medium and high degree of attention to its selection of the goods or services. The marks' visual impression is likely play the greatest role in the selection process, though I do not overlook the relevance of their aural impression. To my mind, notwithstanding the identity in the beginnings of the marks, there is sufficient difference between them, particularly in light of the consumer's attention level, for the average consumer to readily acknowledge that they are not the same. Though I have found each mark will be seen as an invented word, I have also found that the consumer will identify the presence of the word SYNC in the applied-for mark (or absence thereof). This recognition will prompt a level of understanding in the mind of the average consumer which is absent in the other marks. Even where considered in regard to identical goods and where only a medium degree of attention is applied, this conceptual insight, or lack thereof, will be recalled by the average consumer when attempting a repeat purchase of the goods, for example. I dismiss a likelihood of direct confusion.

54. I turn my attention now to a likelihood of indirect confusion. A finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion; it requires a proper basis.¹⁵ What the respective trade marks have in common are their initial letters (S-O-M or S-O-M-S). This is not, to my mind, a particularly distinctive sequence of letters, at least not to a degree whereby the average consumer would be minded to conclude that the marks must originate from shared or related undertakings. I of course keep in mind that the earlier marks enjoy a fairly high inherent distinctiveness, however, the differences between the marks', namely the remaining letters, are not consistent, in my experience, with what is likely to be interpreted as a brand extension or sub-brand. Rather, differences of this nature, even when considered in respect of goods which are identical, are likely to be attributed to the marks simply originating from distinct undertakings. An identical sequence of letters positioned at the beginning of the marks is likely to be considered

¹⁵ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

as simply coincidence. The parties' respective marks may call the others' mark to mind, but this is as far as it is likely to go and falls short of a finding of confusion.

55. For completeness, if my interpretation of the term is considered incorrect and I was wrong to find a degree of similarity in respect of the applicant's ...*parts and fittings for all of the aforesaid goods* in class 5, it would clearly not have any bearing on the outcome of the decision given that I have found no likelihood of confusion.

Conclusion

56. The opposition has failed in its entirety. Subject to any successful appeal, the application will proceed to registration.

Costs

57. The applicant has been successful and is entitled to a contribution toward its costs. Awards of costs in opposition proceedings are based upon the scale published in TPN 2/2016. Using that scale as a guide, I award the applicant the sum of £500, calculated as follows:

Considering the Notice of Opposition and preparing a counterstatement:	£200
Preparing evidence:	£300 ¹⁶
Total:	£500

58. I hereby order Ipsen Pharma S.A.S. to pay CLOSED LOOP MEDICINE LTD the sum of £500. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

¹⁶ I have reduced the amount in regard to the applicant's evidence to reflect its limited relevance to the merits of the proceedings.

Dated this 1st day of November 2024

**Laura Stephens
For the Registrar**