

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2050765
IN THE NAME OF BEIERSDORF-LILLY GmbH
TO REGISTER THE MARK SYNT IN CLASS 5**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO 45062 BY SYNTHELABO**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application No 2050765**
in the name of Beiersdorf-Lilly GmbH
to register the mark SYNT in Class 5

and

10 **IN THE MATTER OF Opposition thereto**
under No 45062 by Synthelabo

15 **DECISION**

20 On 11 January 1996 Beiersdorf-Lilly GmbH of Hamburg, Germany applied to register the
mark SYNT in Class 5 for a specification of goods which reads “pharmaceutical preparations
and substances”.

The application is numbered 2050765.

25 On 7 August 1996 Synthelabo of France filed notice of opposition to this application. The
grounds of opposition are in summary:

- 30
- i under Section 3 in that the mark is devoid of distinctive character having regard
to the large number of trade marks including the prefix SYNT (or its phonetic
equivalent SINT)
 - ii under Section 5 in that the mark applied for is similar to a number of other
marks on the register and covers the same or similar goods. I take this to be a
ground based on Section 5(2)(b)

35 A reference to Section 5(3) in the statement of grounds appears to have been made in error
and I need say no more about it.

40 The opponents also ask the Registrar to refuse the application in the exercise of his discretion.
However as no such discretion is available to me in the case of an application which meets
the requirements of the Act I do not propose to consider this matter further. The opponents
also seek an award of costs in their favour.

45 The opponents refer in their statement of grounds and evidence to registrations standing in
their own name and the name of a number of other proprietors commencing with the element
SYNT or SINT. For ease of reference details of these registrations appear at Annex A. (I

have omitted one of the registrations which is for an unrelated mark and must, I think, be a wrong reference. Nothing turns on this).

5 The applicants did not file a counterstatement or evidence. The opponents filed evidence and the matter came to be heard on 12 August 1998 when they were represented by Mr W Allen of J A Kemp & Co, their Trade Mark Attorneys. The applicants were not represented at the hearing.

10 Opponents' evidence

The opponents filed a statutory declaration dated 26 March 1997 by Maryse Tonnin Philbert, the Head of the Trade Mark Department of Synthelabo, a position she has held since 1986. She is fully conversant with the English language and says she has been in the pharmaceutical industry for a considerable period of time.

15 She expresses surprise that the application for the word SYNT had been allowed to proceed because it consists of the first four letters of a very large number of trade marks owned by different firms. She refers to the examples which appear as Annex A and says that she considers the mark applied for to be similar to these earlier marks.

20 In relation to the issue of distinctiveness she says:

25 “I believe that the trade mark SYNT is incapable of being distinctive. It consists simply of the well established prefix SYN- together with the single letter T. SYN is the anglicized version of the Greek word meaning “with” or “together” and has internationally become used to describe any form of fusion (see Collins English Dictionary, Third Edition (updated 1994), Page 1562). If reference is also made to Page 1564, it will be seen that the word SYNTH is short form “synthesizer” and hence I believe that the word SYNT clearly has a meaning of “synthetic” and is hence
30 incapable of distinguishing the proprietors goods from those of their competitors.”

That concludes my review of the evidence.

35 I will deal firstly with the Section 3 ground. Mr Allen confirmed at the hearing that the objection was based on Section 3(1)(b) in that the mark applied for was devoid of any distinctive character. There are two aspects to the opponents' objection. The first is that the mark consists of the prefix SYN (meaning “with” or “together” and used to signify fusion) combined with the single letter T. I find this to be an unconvincing and unnatural analysis of the mark. I do not see why the mark should be broken down in this way or, even if this had
40 been explained, how it would be objectionable in relation to the goods at issue. The second objection is that SYNTH is short for “synthesizer” and, Ms Philbert adds, “hence ... the word SYNT clearly has a meaning of synthetic”. I do not follow the logic of this argument. It is true that the Collins dictionary reference records “synth” as being short for synthesizer but the mark applied for is SYNT and not SYNTH. Moreover the basis of the objection is not clear
45 in the context of the dictionary meanings of synthesizer. The further claim that SYNT means synthetic is quite a different claim and is not supported by the dictionary references.

However, despite the problem I have in accepting the case put forward by the opponents I do not dismiss their claim out of hand. It is not essential for a word to appear in a dictionary as a recognised abbreviation for it to be open to objection and dictionaries cannot in any case always keep pace with developments in the use of language. I am conscious also of the fact that, in relation to areas such as pharmaceutical terminology it is not as easy to reach a view as might be the case with, for instance, consumer products. I note, in this context, that most of the registrations referred to by the opponents have specifications referring in very broad terms to pharmaceutical preparations and substances but one (No 960669) refers specifically to “synthetic thyroxine...”. This suggests that there may indeed be some force to the opponents’ argument that the prefix SYNTH or SYNT alludes to the nature of the goods. In the event, however, I do not consider that I have a sufficiently strong basis on the material before me to decide the point in the opponents’ favour despite Mr Allen’s perfectly reasonable comment that the applicants have neither denied nor countered the objection. The objection based on Section 3 of the Act therefore fails.

I now turn to the ground based on Section 5(2)(b) of the Act. So far as is relevant this 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.”

The term “earlier trade mark” is itself defined in Section 6 of the Act in the following terms:

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

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

(b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority

claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.”

5 The opponents refer to two marks in their own name and a large number of marks in the
ownership of different companies and individuals (see Annex A) commencing with the
prefixes SYNT (and SYNTH or SINT). It is evident from the information supplied that the
10 prefixes are very popular in relation to Class 5 goods (there is direct overlap in almost every
case with the goods of the mark applied for). There is no evidence before me as to the
circumstances in which the marks came to be placed on the register but it is undeniably the
15 case that they have achieved registration despite having a shared first element (or phonetic
equivalent thereof). Given the importance that is usually attached to the first syllable of
words (see TRIPCASTROID 1925 RPC 264) this appears on the surface to be a somewhat
unusual state of affairs. Furthermore it suggests to me that there is at least a tacit acceptance
20 that no individual trader can claim a monopoly in the initial element concerned. I offer this
view with some caution as there is no evidence before me as to whether the registrations
referred to are in use in the marketplace and recognising also that I have been unable to come
to a clear conclusion as to the potential descriptive significance of the word SYNT when
25 considering the Section 3 objection (but it is a factor which might help to explain the state of
the register). To put the matter another way it appears to me that it is the differences in the
registered marks as totalities that distinguishes them one from another. The consequential
conclusion must be that the initial element is of less significance in distinguishing between
the respective marks. In these circumstances I find it difficult to accept that any one trader
30 should be able to claim a monopoly right in SYNT alone. I do not, therefore, propose or need
to carry out individual comparisons between the mark applied for and each of the registered
marks in turn. It seems to me though that the problem is likely to be at its most acute in
relation to short words such as SYNTEX and SYNTEL and words such as SYNTEPAC
which could mistakenly be construed in oral use as referring to a pack of SYNT (brand)
goods and thus be confused with the mark applied for bearing in mind also that I have already
found that identical goods are involved. I have, therefore, come to the conclusion that the
opposition succeeds under Section 5(2)(b).

As the opponents have been successful in these proceedings they are entitled to a contribution
towards their costs. Mr Allen commented at the hearing that the applicants had neither
35 contributed to the proceedings by means of a counterstatement or evidence nor on the other
hand had they abandoned their application. I order the applicants to pay the opponents the
sum of £800.

Dated this 20th day of August 1998

40

45 M REYNOLDS
For the Registrar
the Comptroller General

IN THE NAME OF THE OPPONENTS

	NUMBER	MARK	CLASS	JOURNAL/ PAGE	SPECIFICATION
5					
10	1061813	SINHELABO	5	5211/1406	Pharmaceutical, veterinary and sanitary substances; infants' and invalids' foods; medical and surgical plasters, materials prepared for bandaging; materials for stopping teeth and for making dental impressions; and disinfectants (other than for laying and absorbing dust).
15					
20					
25	1565852	SYNHELABO	5	6048/6687	Pharmaceutical, veterinary and sanitary products; dietetic substances for medical use; plasters, material for bandaging; material for stopping teeth, dental wax; disinfectants; all included in Class 5.
30					
	<u>IN THE NAME OF SYNTEX CORPORATION</u>				
35	678094	SYNTREX	5	3782/0940	Materials and substances included in Class 5 for use in dentistry; materials prepared for bandaging; and medical and surgical plasters; and disinfectants.
40	807672	Syntepac	5	4314/0593	Pharmaceutical preparations and substances for human use and for veterinary use.
45	860285	Syntaris	5	4469/0634	Pharmaceutical preparations and substances for human use and for veterinary use.

	NUMBER	MARK	CLASS	JOURNAL/ PAGE	SPECIFICATION
5	882925	SYNTEXAN	5	4549/1452	Pharmaceutical preparations and substances for human use and for veterinary use.
10	895245	SYNTEX REGOLAR	5	4614/0122	Steroid hormone preparations for gynaecological use.
15	983093	SYNTEX MENOPHASE	5	4913/2120	Pharmaceutical preparations based on steroid hormones and for use in connection with menopausal conditions.
20	1072739	SYNTEX and device	5	5249/0562	Pharmaceutical, veterinary and sanitary preparations and substances; infants' and invalids' foods; and medicated nutritional supplements for such foods; diabetic foods; and deodorants; but not including any such goods for use in dentistry.
25					
30	1151999	SYNTEX SUPPRESS	5	5437/2689	Pharmaceutical preparations for use as suppressants.
35	1207611	SYNTEX	5	5563/0946	Pharmaceutical, veterinary and sanitary preparations and substances; infants' and invalids' foods; surgical and medical plasters; material prepared for bandaging; dental preparations and materials, all included in Class 5; disinfectants (other than for laying or absorbing dust); herbicides; pesticides; fungicides; insecticides; deodorants (not for personal use); supplements included in Class 5 for infants' and invalids' foods.
40					
45					

	NUMBER	MARK	CLASS	JOURNAL/ PAGE	SPECIFICATION
5	1207856	SYNTEX SYN-AID	5	5566/1132	Veterinary pharmaceutical preparations.
10	1239183	SYNTEL	5	5608/0522	Pharmaceutical preparations and substances; dental substances included in Class 5.
15	1239184	SYNTERIC	5	5608/0523	Pharmaceutical preparations and substances; dental substances included in Class 5.
20	1457232	SYNTEX SYNTEX and device	5	5945/7427	Pharmaceutical, dental and veterinary preparations and substances; all included in Class 5.

IN THE NAME OF CIBA-GEIGY AG

25	734681	SINTHROME	5	4008/0310	Pharmaceutical preparations for human use and for veterinary use, sanitary substances, medical and surgical plasters, material prepared for bandaging, disinfectants and antiseptics.
----	--------	-----------	---	-----------	---

IN THE NAME OF NOVARTIS AG (previously Sandoz Ltd)

35	742105	SYNTOCINON	5	4032/0880	Pharmaceutical preparations and substances.
	816991	SYNTOMETRINE	5	4324/0913	Pharmaceutical products.
40	848179	SYNTOPRESSIN	5	4442/1465	Pharmaceutical products.

IN THE NAME OF THE BOOTS COMPANY PLC

45	818791	SYNTOLIN	5	4339/1476	Pharmaceutical preparations and substances.
----	--------	----------	---	-----------	---

	NUMBER	MARK	CLASS	JOURNAL/ PAGE	SPECIFICATION
5	960669	SYNTHROID	5	4852/1698	Synthetic thyroxine, being pharmaceutical preparations for use in the treatment of myxedema, cretinism and the like hypometabolic states.
10	<u>IN THE NAME OF CARLO ERBA SOCIETA PER AZIONI</u>				
15	871423	SINTISONE	5	4528/0768	Pharmaceutical and veterinary preparations and substances.
20	<u>IN THE NAME OF CLINTEC BENELUX SA</u>				
25	1063086	SYNTHAMIN	5	5240/0173	Pharmaceutical substances consisting of, or containing, amino acids.
30	1359613	SYNTHAMIX	5	5832/4228	Pharmaceutical preparations and substances; parenteral nutrition solutions for medical use; all included in Class 5.
35	<u>IN THE NAME OF LOCK LABORATORIES LTD</u>				
40	1112984	SYNTHADERM	5	5343/0216	Materials for dressing wounds; medical and surgical plasters; materials prepared for bandaging.
45	<u>IN THE NAME OF DEGUSSA AK</u>				
	1381919	SINTAPRET	5	5833/4376	Noble metal alloys and materials included in Class 5, all for use in dentistry.

IN THE NAME OF PROF. DR. MED. KLAUS DRAENERT

	NUMBER	MARK	CLASS	JOURNAL/ PAGE	SPECIFICATION
5	2014686	SYNTHACER	5	6106/1356	Chemicals for use in the surgical, medical, dental, and veterinary fields; ceramics for surgical, medical, dental and veterinary purposes; ceramics in the form of sintered compacts and granules for surgical, medical, dental and veterinary purposes;
10					pharmaceutical, veterinary and sanitary preparations; plasters, dressing materials; materials for stopping teeth, dental wax.
15					
20			10		Surgical, medical and dental apparatus and instruments; applicators and sterilizing containers; artificial limbs and teeth; orthopedic articles; suture materials.
25					