

O-057-16

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3060219

BY

THE 1810 COMPANY LIMITED

TO REGISTER THE TRADE MARK

Senso

IN CLASS 11

AND

OPPOSITION 403453 THERETO

BY

GROUPE ADEO

Background and pleadings

1. The 1810 Company Limited (the applicant) applied to register the trade mark 'Senso' in the UK on 17/06/2014. It was accepted and published in the Trade Marks Journal on 19/09/2014 in respect of the following goods:
2. Class 11: Kitchen taps
3. Groupe ADEO (the opponent) oppose 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 Community mark 'SENSEA' (EU011055878). The following goods in Class 11 are relied upon in this opposition:

Lighting apparatus and lamps, all the aforesaid being integrated into bathroom mirrors or bathroom furniture; Apparatus for heating, steam generating, refrigerating, ventilating, drying, water supply and sanitary purposes; Bathtubs, in particular health spa bathtubs; Showers; Sauna installations; Toilets (water closets); Toilet seats and lids; Fittings for sanitary purposes; Air conditioning apparatus and installations.

4. The opponent argues that the respective goods are identical and that the marks are similar.
5. The applicant filed a counterstatement denying the claims made. Given its date of filing (19 July 2012) the opponent's mark is an earlier mark for the purposes of the Act and as it had not been registered for more than five years prior to the date of publication of the applicant's mark, it is not subject to proof of use.
6. Both parties filed submissions, which will not be summarised but will be referred to as and where appropriate during this decision. The applicant filed a witness statement by Laura West, a Trade Mark Attorney instructed by the applicant. It is also referred to at the appropriate point below. No hearing was requested and so this decision is taken following a careful perusal of the papers.

DECISION

Section 5(2)(b)

7. Section 5(2)(b) of the Act is 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.

8. 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.

Average consumer and the purchasing act

9. The average consumer of the goods in Class 11 will fall into two categories: members of the general public, and tradespeople. For both categories, selection of goods will be primarily via trade catalogues, websites and also in hardware stores, plumbers' merchants and the like. This suggests that the visual impact of the mark is important. However, there may also be an aural consideration where orders are placed over the telephone or over the counter.
10. These goods will be bought fairly infrequently by the general public, but may be purchased more regularly by e.g. a kitchen and bathroom fitter. The goods are somewhat technical in nature, though not to the highest degree, and the selection may be also be based on particular aesthetics. In consideration of the foregoing I consider the average consumer (both types) will exercise a medium degree of care and attention.

Distinctive character of the earlier trade mark

11. 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).

12. The opponent submits that the earlier mark is inherently highly distinctive and as such enjoys a broad scope of protection. As a made up word, this would normally be true.

13. However, the applicant contends that the shared element 'SENS' is in fact descriptive, and as such the earlier mark should be regarded as having a weak distinctive character.
14. To support this submission the applicant exhibits LTW1 to the Witness Statement of Laura West, a Trade Mark Attorney instructed by the applicant. The exhibit comprises a number of screenshots of Google searches for 'sensor' related plumbing articles, and purports to show that 'products in the market increasingly use parts and apparatus that comprise of sensing/sensor technology', the implication being that 'SENS' as a prefix is descriptive of the sensor-operated goods. I find that this evidence does not advance the applicant's case any further than its submissions. The prefix 'SENS' is at most slightly allusive, and in my view too oblique to carry much weight. Taking all the factors into account I find that the mark is possessed of a high degree of inherent distinctive character.

Comparison of goods

15. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court 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 where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.
16. The opponent submits that "*fittings for sanitary purposes' and 'apparatus for water supply and sanitary purposes' covered by the prior right are identical to the goods 'kitchen taps; covered by the Trade Mark'*". This is by virtue of kitchen taps falling within the wider categories denoted by the other two terms.
17. In reply the applicant says that the majority of the opponent's specification relates to products for the bathroom, not the kitchen, and that they have not expressly included kitchen taps within their specification.
18. Even though some of the opponent's products may be more bathroom orientated, the wide terms covered by the opponent's trade mark and on which identity is claimed are not limited to just bathrooms. I do not agree that 'fittings for sanitary purposes' are identical to kitchen taps, one is for the supply of water whilst the other relates more to the removal of waste, but there is a degree of complementarity between them and they are at least similar. However, whilst taps are not specified by name in the opponent's specification, they fall clearly within the meaning of 'apparatus for water supply', and on that basis I find that the goods are identical.

Comparison of marks

19. 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 Court of Justice of the European Union 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.

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

The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
SENSEA	SENSO

21. The overall impression of the marks will be based upon the single invented words of which they consist.
22. The opponent submits that the marks are visually and phonetically highly similar by virtue of the shared four initial letters, and that neither mark has any conceptual meaning from an English speaker's perspective.
23. In its submission of 7 May 2015 the opponent further submits that 'in the event that the Hearing Officer is of the view that it is possible to compare the marks conceptually, the Opponent submits that, given the identity of the 'SENS' element, the marks are likely to be considered as being conceptually similar'.
24. The applicant submits that owing to the short nature of the marks, the differences between them will take on greater significance in the mind of the consumer notwithstanding the general principle that the beginning of a mark has the greater impact.
25. The applicant further submits that I should view the 'SENS' element of the marks as allusive of a characteristic of the goods, or 'somewhat descriptive' of a tap operated via sensors (as opposed to manually), and that therefore this element should play a lesser role in the comparison of marks.
26. Visually the marks are five and six letter words respectively, sharing the initial four letters 'SENS' and differing in that the applicant's mark ends 'O' whilst the opponent's mark ends 'EA'. As short words the difference is more marked than would be the case in longer words whose only difference was the terminal one or two letters, however I still assess the visual similarity as reasonably high. The

opponent's mark will be pronounced 'SEN-SEE' or possibly 'SEN-SEE-AH', whilst the applicant's mark will be pronounced 'SEN-SOH'. I assess the aural similarity as reasonably high. Conceptually the opponent's mark includes the word 'SEA' which may suggest the ocean and water to some consumers. Despite this, in my view the overwhelming majority of consumers will simply view both as invented words, rendering the conceptual considerations neutral.

Conclusions on Likelihood of Confusion

27. In assessing the likelihood of confusion, I must adopt the global approach set out in case-law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to 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.

28. At this juncture I note the applicant's submission that there are 142 other co-existing registrations beginning with "SENS" in class 11, and that "this highlights the narrow monopoly afforded to the opponent's earlier registration".

29. In the TREAT case (*British Sugar PLC v. James Robertson & Sons Ltd.*, 1996 R.P.C. 281) Jacob J said as follows:

Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word "Treat". I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see eg MADAME Trade Mark ([1996] RPC 541) and the same must be true under the 1994 Act. I disregard the state of the register evidence.

30. The mere fact of the existence of other marks is not evidence of their use in the marketplace, much less the impact of any such use. Indeed, having identified these marks it was open to the applicant to submit evidence of use of those marks and their share of the market, but they did not do so. The only evidence approaching this is a search result for 'Senselec®' returned in the search for 'sensor shower' in exhibit LTW1, but this alone is insufficient. Accordingly I disregard the applicant's state of the register argument.

31. Earlier in this decision I have found that:

- the goods are identical;
- the marks are visually and aurally similar to a reasonably high degree, and conceptually neutral;

- the average consumer is the public or tradespeople both selecting with a medium degree of care and attention; and
- the earlier mark is possessed of a high degree of inherent distinctive character.

32. Bearing in mind the average consumer's imperfect recollection and the fact that they do not directly compare marks, the factors identified above will lead consumers to mistake one mark for another, i.e. there will be direct confusion.

CONCLUSION

33. The opponent has succeeded under Section 5(2)(b) of the Act and the application is refused.

COSTS

34. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £600. The sum is calculated in accordance with Tribunal Practice Notice (TPN) 4/2007 as follows:

Preparing a statement and considering that of the other side:	£200
Preparing submissions and considering those of the other side:	£300
Official fee:	£100
Total:	£600

35. I therefore order The 1810 Company to pay to Groupe ADEO the sum of **£600**, payable 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 2nd day of February 2016

**Andrew Wall
For the Registrar**