

**O/589/21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3497042  
AND THE REQUEST BY ServiceX LTD  
TO REGISTER THE TRADE MARK**

**SmartSense**

**IN CLASSES 9 AND 11**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 421674  
BY DIGI INTERNATIONAL INC.**

## Background and pleadings

1. On 4 June 2020, ServiceX Ltd. (“**the Applicant**”) applied to register the plain text word “SmartSense” as a UK trade mark in respect of the following goods:

**Class 9:** *Parking sensors for vehicles; Resistors; Electric resistors; Electric resistors [for telecommunication apparatus]; Electric resistors for telecommunication apparatus; Electrical resistors; Force sensing resistors; Inductive resistors; Trimmer resistors; Variable resistors; Acceleration sensors; Active infra-red sensors; Air quality sensors; Air temperature sensors; Alarm sensors; Alarm sensors for laundry washing machines; Alarm sensors for refrigerators; Alarm sensors for washing machines; Automatic solar tracking sensors; Biochip sensors; Brake pad wear sensors; Coolant-temperature sensors; Digital sensors; Distance sensors; Door opening and closing detecting sensors; Electric current sensors; Electric sensors; Electric smoke sensors; Electrical sensors; Electro-optical sensors; Electrochemical gas sensors; Electronic control sensors for motors; Electronic measurement sensors; Electronic pressure sensors; Electronic sensors; Electronic sensors for measuring solar radiation; Electronical sensors for measuring solar radiation; Engine control sensors; Fire sensors; Flame sensors; Fluid level sensors; Gas sensors; Gyro sensors using GPS functions; Heat sensors; Impact sensors; Infrared sensors; Invader sensors; LED position sensors; Laser sensors; Level sensors; Light sensors; Liquid level sensors; Magnetic flux sensors; Magnetic resistance sensors; Magnetic sensors; Mass flow sensors; Measuring sensors; Microwave type intruder sensors; Motion recognizing sensors; Motion sensors; Motion sensors for security lights; Object detecting sensors; Occupancy sensors; Oil level sensors; Oil-water level sensors; On-off sensors; Optical fibre sensors; Optical position sensors; Optical sensors; Optical speed sensors; Oscillation sensor devices; Oxygen sensors, not for medical use; Parking sensors for vehicles; Passive infrared sensors; Photoelectric sensors; Piezoelectric sensors; Pollutant sensors; Position detection sensors; Position determining sensors; Position fixing sensors; Position sensors; Pressure sensors; Projected capacitive touch sensors; Proximity sensors; Pyroelectric infrared sensors; Range sensors; Remote temperature sensors; Rotation controlling sensors; Rotation measuring*

*sensors; Shock sensors; Shutter sensors; Sensor controllers; Sensor switches; Sensors; Sensors [measurement apparatus], other than for medical use; Sensors for determining acceleration; Sensors for determining position; Sensors for determining temperature; Sensors for determining velocity; Sensors for engines; Sensors for measuring depth; Sensors for measuring instruments; Sensors for measuring speed; Sensors for monitoring physical movements; Sensors for use in the control of engines; Sensors for use in the control of motors; Sensors for use with machine tools; Sensors used in meteorology; Sensors used in oceanography; Sensors used in plant control; Sensors, detectors and monitoring instruments; Smoke sensors; Synchro sensors; Temperature sensors; Thermal sensors [thermostats]; Timing sensors; Touchscreen sensors; Ultrasonic sensors; Ultrasonic wave type intruder sensors; Vibration sensors; Vibration sensors for installation in wind mill housings; Window opening and closing detecting sensors.*

**Class 11:** *HVAC systems (heating, ventilation and air conditioning); Vehicle HVAC systems (heating, ventilation and air conditioning).*

2. The application was published for opposition purposes in the Trade Marks Journal on 3 July 2020. It is opposed by Digi International Inc. (“**the Opponent**”) which relies on its international trade mark designating the UK, No. WO0000001501518, for the mark SMARTSENSE, registered for the following goods and services:

**Class 9:** *Computer hardware and downloadable computer software that allows users to continuously and wirelessly monitor temperature and humidity sensors, monitor external sensors and door switches, to provide oversight of food safety processes, to provide real-time fleet tracking, monitor task management activities for improved operational efficiencies, to provide voice, text and email alerts of triggering events, and to provide chain of custody verification; downloadable computer software application for logging data and generating reports; environmental monitoring systems comprised of temperature sensors, data recorders and cellular gateways, all for use in collecting, measuring, analyzing, and reporting on the performance of refrigeration and cold-chain distribution systems and providing alerts of triggering events, all via a computer network;*

*downloadable computer software application used to allow users to interface with environmental monitoring systems and to receive alerts; wireless remote temperature data collection and transmission instruments for an on-line remote monitoring service for monitoring food and ingredient temperatures during the food preparation process and monitoring the temperature of elongated and overnight low temperature cooking; computer hardware and computer software used to monitor and collect data on the temperature of products throughout refrigeration and cold chain distribution systems and to transmit the data to a host or a remote computer system used to provide alerts in the case of triggering events and to compile reports; downloadable computer software application used to allow users to interface with monitoring systems and to receive alerts.*

**Class 42:** *Providing a subscription-based website featuring technology that allows users to continuously and wirelessly monitors temperature and humidity sensors, external sensors and door switches, to provide oversight of food safety processes, to provide real-time fleet tracking, monitor task management activities for improved operational efficiencies, and provide voice, text and email alerts of triggering events, and to provide chain of custody verification; online, non-downloadable enterprise software for logging data and generating reports; providing a website featuring technology used to monitor and collect data on the temperature of products throughout refrigeration and cold chain distribution systems and to transmit the data to a host or a remote computer system used to provide alerts in the case of triggering events and to compile reports.*

3. The Opponent opposes the application partially on the basis of section 5(1) of the Trade Marks Act 1994 (“**the Act**”) which concerns identical trade marks and identical goods or services. The application is also opposed in full, on the basis of section 5(2)(a) of the Act, which concerns identical marks and similar goods or services.

4. An “earlier trade mark” is defined in section 6(1) of the Act as:

*“(a) a registered trade mark, international trade mark (UK), a European Union trade mark or international trade mark (EC) 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”*

5. The Opponent's international trade mark has a UK designation date of 20 March 2019 and a date of protection in the UK of 14 May 2020. The Opponent's mark is therefore an “earlier trade mark” within the definition in section 6(1). Under section 6A of the Act, a proprietor has a period of five years following registration in which to use its trade mark. As five years had not passed between the date of protection of the Opponent's mark and the application for the contested mark, the Opponent can rely on all of the goods in its earlier trade mark and is not required to show that its mark has been put to genuine use.

6. In its statement of grounds<sup>1</sup> the Opponent submits that:

- (i) The Applicant's mark is identical to its earlier trade mark.
- (ii) In respect of the Applicant's goods in Class 9 which are opposed under section 5(1) and the Opponent's goods relied upon under that ground, the goods in the respective marks are all types of sensors and are therefore identical.
- (iii) All of the Applicant's goods in Classes 9 and 11 are similar to the Opponent's goods and services in Classes 9 and 42, being complementary, and sharing the same channels of distribution, relevant public and being produced by the same companies.
- (iv) The identity of the marks and the identity, or similarity of the goods and services means there is a likelihood of confusion, including a likelihood of association, and any differences in the goods and services are offset by the identity of the marks.
- (v) The Opponent's mark has enhanced distinctiveness due to the use that has been made of it since 2018, meaning there is a higher likelihood of confusion.

7. In its Notice of defence and counterstatement, the Applicant submits that:

- (i) The Applicant's and Opponent's goods are substantially different, with the Opponent's goods referring mainly to computer hardware and software for

---

<sup>1</sup> Annex 1 of TM7, Notice of Opposition.

collection of data and monitoring of tasks and activities, whereas the Applicant's goods relate to specific hardware sensors that measure properties of physical objects.

(ii) The Opponent's mark does not cover the goods that the Applicant intends to use its mark on, and the Opponent should clarify and provide proof of how the use of its mark is identical to the use that the Applicant intends to make.

(iii) The Applicant has used its mark for several years prior to filing the application and no confusion has arisen between the Applicant's and Opponent's marks. The Applicant requests that the Opponent proves that confusion has arisen.

8. On 14 December 2020, the Registrar issued a preliminary indication under rule 19 of the Trade Mark Rules 2008. Here the Registrar indicated that the opposition was considered likely to succeed under section 5(1) but, due to the length of the specifications of goods and services, it was inappropriate to provide a preliminary indication on the section 5(2)(a) ground of opposition. On 31 December, the Applicant filed Form TM53, confirming its intention to proceed to the evidence rounds.

9. During the evidence rounds, only the Opponent filed evidence. The Opponent's evidence is in the form of a witness statement dated 16 March 2021, by Mr Steve Maurer, Senior Counsel for Intellectual Property & Commercial Transactions at Digi International Inc. The witness statement introduces 6 exhibits, SM01 to SM06 through which the Opponent seeks to explain the identity and/or similarity between the Applicant's goods and the Opponent's goods and services.

10. In these proceedings, the Applicant has not engaged professional representation; the Opponent is represented by Burgess Salmon LLP.

11. Neither party requested a hearing in this case. This decision is therefore taken following a careful perusal of the papers, which include submissions in lieu of a hearing, filed by the Opponent only.

12. Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act 1994 relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

## **DECISION**

### *Relevant legislation*

13. Section 5(1) and section 5(2)(a) of the Act state:

*“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.*

*(2) A trade mark shall not be registered if because –*

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

*(b) [...]*

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

### *Preliminary matter*

14. In its defence and counterstatement, the Applicant submits that it has used its mark for several years prior to filing the application and that no confusion has arisen. In respect of this, I note firstly that the Applicant has filed no evidence, so it is not possible to consider what use the Applicant may have made of its mark. Secondly, case law has established that, although evidence of actual confusion may assist an opponent

in showing that there is a likelihood of confusion between marks, the absence of such confusion is less significant:

*“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 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.”<sup>2</sup>*

15. Linked to this, in respect of the Applicant’s request that evidence of confusion be provided, it is confirmed that there is no requirement under section 5(1) or section 5(2)(a) for the Opponent to prove that confusion has arisen.

**Identity of the marks**

16. The respective trade marks are shown below:

<b>SMARTSENSE</b>	<b>SmartSense</b>
Earlier trade mark (Opponent’s trade mark)	Contested trade mark (Applicant’s trade mark)

---

<sup>2</sup> Roger Maier and Another v ASOS, [2015] EWCA Civ 220



17. It is a prerequisite of both section 5(1) and section 5(2)(a) of the Act that the trade marks are identical. The Opponent submits that the marks are identical, and this is not disputed by the Applicant.

18. The Applicant's and Opponent's marks are both word marks, consisting of the words "smart" and "sense" joined together. The marks are presented differently in that the Opponent's mark is all in capital letters, whereas the Applicant's mark is in lower-case letters, with a capital letter at the beginning of the words "Smart" and "Sense". In its submissions in lieu of a hearing, the Opponent refers to the main case law on the identity of trade marks in *LTJ Diffusion*<sup>3</sup> and to the Appointed Person's comments on word marks and how they may be presented in upper or lower-case letters.<sup>4</sup> With this case law in mind, and taking account of the Opponent's comments, and the lack of arguments from the Applicant on this point, I find the marks to be identical.

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

19. In considering the extent to which there may be similarity between the goods and services, I take account of the guidance from relevant case law. Thus, in *Canon* the Court of Justice of the European Union ("**the CJEU**") stated that:

*"In assessing the similarity of the goods... all the relevant factors relating to those goods... 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."*<sup>5</sup>

20. In *Boston Scientific*, the General Court described goods as "complementary" in circumstances where "... *there is a close connection between [the goods], 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*".<sup>6</sup> I also take note that in *Kurt Hesse v OHIM*, the CJEU stated that

---

<sup>3</sup> S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA, case C-291/00.

<sup>4</sup> *Groupement Des Cartes Bancaires v China Construction Bank Corporation* Case BL O/281/14, at paragraph 21.

<sup>5</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*, case C-39/97, at paragraph 23.

<sup>6</sup> *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, case T-325/06.

complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods.<sup>7</sup>

21. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case<sup>8</sup> for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive.

22. In *YouView TV Ltd v Total Ltd*,<sup>9</sup> Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

---

<sup>7</sup> Kurt Hesse v Office for Harmonisation in the Internal Market (OHIM), case C-50/15 P.

<sup>8</sup> British Sugar PLC v James Robertson & Sons Ltd [1996] R.P.C. 281

<sup>9</sup> Case [2012] EWHC 3158 (Ch), at paragraph 12 of that judgment.

23. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, the Court of Justice of the European Union (“the CJEU”) (the General Court) stated that goods can be considered as identical when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (and vice versa).<sup>10</sup>

**Section 5(1) claim**

24. The opposition under section 5(1) is directed at some of the Applicant’s goods in Class 9 and is based on some goods in the Opponent’s earlier mark. These are set out in the following table:

<p>Opponent’s goods in Class 9</p>	<ul style="list-style-type: none"> <li>• Environmental monitoring systems comprised of temperature sensors, data recorders and cellular gateways, all for use in collecting, measuring, analyzing, and reporting on the performance of refrigeration and cold-chain distribution systems and providing alerts of triggering events, all via a computer network.</li> </ul>
<p>Applicant’s goods in Class 9</p>	<ul style="list-style-type: none"> <li>• Air temperature sensors</li> <li>• Coolant-temperature sensors</li> <li>• Digital sensors</li> <li>• Electric sensors</li> <li>• Electrical sensors</li> <li>• Electronic sensors</li> <li>• Heat sensors</li> <li>• Infrared sensors</li> <li>• Laser sensors</li> <li>• Remote temperature sensors</li> <li>• Sensors</li> <li>• Sensors [measurement apparatus], other than for medical use</li> <li>• Sensors for determining temperature</li> </ul>

<sup>10</sup> Case T- 133/05 at paragraph 29 of that judgment.

	<ul style="list-style-type: none"> <li>• Sensors, detectors and monitoring instruments</li> <li>• Temperature sensors</li> <li>• Thermal sensors [thermostats]</li> </ul>
--	---

25. The Opponent refers to the relevant case law in *Treat*, *Canon* and *Meric*, that I have also referred to above. The Opponent refutes the Applicant’s claim in its counterstatement that the respective goods are “*substantially different*” and contends that the Applicant’s listed goods are “*sensors*,” which “*wholly encompass the Opponent’s protected goods*.” In support of this, the Opponent refers to Exhibit SM01, which shows the Opponent’s mark used on a wireless sensor. The Opponent also refers to the Registrar’s preliminary indication which found identity between these goods.

26. In respect of the preliminary indication, I remind the parties that, as set out in the Trade Mark Registry’s communication of 14 December 2020, this is not binding.

27. In assessing whether the above goods are identical, I take note of the Opponent’s submissions and the definitions of “sensor” provided in Exhibits SM02 and SM03. The goods relied on by the Opponent under section 5(1) are systems that monitor and feed back information on the conditions in temperature-controlled distribution systems. A part of these systems are temperature sensors, which are stated in the Opponent’s list of goods to be a part of the system.

28. I disagree with the Opponent that the Applicant’s sensors *wholly* encompass the Opponent’s goods. As referred above, the Opponent’s systems are described as comprising of various parts, with sensors being one such part. In addition to this, the Wikipedia definition of *sensor* at Exhibit SM03 includes the statement “*a sensor is always used with other electronics*.” On the basis of these factors, I do not accept that the ordinary and natural understanding of a temperature sensor would cover a whole system for monitoring and reporting on temperature conditions. I have also considered whether the converse of the Opponent’s argument is true, i.e. whether the Opponent’s environmental monitoring systems encompass the Applicant’s sensors and are therefore identical goods. It is clear that sensors are an important part of the

Opponent's systems, however, they are a discrete part and in my view, they are not identical to the wider system.

29. I find the Applicant's and Opponent's goods listed in the table above are not identical and therefore the opposition under section 5(1) fails. I do not rule out that there may be similarity between these goods, which I will consider below.

### **Section 5(2)(a) claim**

#### *Notional nature of the legal considerations*

30. The task of determining a likelihood of confusion under section 5(2)(a) requires an approach based on the perspective of the notional average consumer and on notional fair and ordinary use that either party may make of their respective trade marks. As the Opponent's earlier mark is not subject to the proof of use provisions under section 6A of the Act, the Opponent is entitled to rely on all of the goods and services protected under its mark. The task before me is to compare those goods and services in the Opponent's mark, to the goods included in the Applicant's mark. The Applicant states that the protection that the Opponent has under its mark "*does not cover the products that the Defendant intends to use its goods for*". On this point, it is not relevant as to the actual use to which the Applicant intends to use its mark. For instance, if the mark were registered, the Applicant would be free to change its mind on its use, or to sell its trade mark to another who may use it in line with the limits of the specification. The Applicant has not requested any limitation of its goods and therefore my decision is based upon the full list of goods submitted in its Form TM3 – Application to register a trade mark.

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

31. The Opposition under section 5(2)(a) is against all of the Applicant's goods and the Opponent relies on all of the goods and services in its earlier trade mark. In assessing whether there is similarity between the respective goods, I take note of the comments of the Appointed Person in *Separode Trade Mark* BL O-399-10 (AP) where it was confirmed that it is permissible to group goods together for the purpose of assessment:

*“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”*

32. In its submissions in lieu of a hearing, the Opponent groups the majority of the Applicant’s Class 9 goods under one of the headings of *fleet tracking; temperature sensors; refrigeration monitoring systems; door switches and external sensors; monitoring external sensors; and environmental monitoring systems*. The remaining goods in Class 9 are dealt with separately, as are the Applicant’s goods in Class 11. I will refer to the Opponent’s proposed groupings in my analysis, while also keeping in mind the Applicant’s argument from its counterstatement that the respective goods are “*substantially different*,” with the Opponent’s goods being mainly computer hardware and software for collecting data and monitoring tasks and activities and the Applicant’s goods being hardware sensors for measuring the properties of physical objects.

#### *Fleet tracking*

33. In paragraphs 37 to 40 of its submissions in lieu of a hearing, the Opponent describes the similarity between its goods and services and the following of the Applicant’s goods in Class 9:

*“Parking sensors for vehicles; Brake pad wear sensors; Distance sensors; Acceleration sensors; Engine control sensors; Parking sensors for vehicles; Sensors for determining acceleration; Sensors for determining velocity; Sensors for engines; Sensors for measuring speed; Range sensors; Impact sensors; Gyro sensors using GPS functions; Sensors for determining position; Sensors for use in the control of engines; Sensors for use in the control of motors; Electronic control sensors for motors; Position detection sensors; Proximity sensors; LED position sensors; Position sensors; Position determining sensors; Position fixing sensors.”*

34. The Opponent defines the Applicant's goods as monitoring the location, performance, and management of vehicles and finds the goods to be similar to the following of its goods and services:

*"Class 9: Computer hardware and downloadable computer software that allows users to continuously and wirelessly monitor temperature and humidity sensors, monitor external sensors and door switches, to provide oversight of food safety processes, to provide real-time fleet tracking, monitor task management activities for improved operational efficiencies, to provide voice, text and email alerts of triggering events, and to provide chain of custody verification;*

*downloadable computer software application used to allow users to interface with monitoring systems and to receive alerts;*

*Class 42: Providing a subscription-based website featuring technology that allows users to continuously and wirelessly monitors temperature and humidity sensors, external sensors and door switches, to provide oversight of food safety processes, to provide real-time fleet tracking, monitor task management activities for improved operational efficiencies, and provide voice, text and email alerts of triggering events, and to provide chain of custody verification."*

35. The Opponent's goods include computer hardware and software that allows users to monitor external sensors to provide real-time fleet tracking, and services related to this. I consider that the types of sensors that the Opponent's hardware and software would monitor when tracking a fleet would typically include sensors of the type listed in the Applicant's goods in paragraph 33, and to this list I add "*Electronic pressure sensors; Pressure sensors; Oil level sensors; Level sensors; Liquid level sensors; Fluid level sensors; Electronic measurement sensors; Sensors for measuring instruments; Shock sensors; Vibration sensors; and Timing sensors.*" These, and the sensors listed above could be applied to a vehicle, enabling its location to be tracked, as well as driver behaviour and servicing requirements, with these factors being relevant in the tracking and management of a fleet of vehicles. This being the case, the Applicant's and Opponent's goods share the same users, trade channels and intended purpose – to track a fleet. The goods are also complementary in that the

forms of sensors in the Applicant's mark are integral for the functioning of the Opponent's monitoring hardware and software for fleet tracking, with a consumer being likely to consider that responsibility for the goods lies with the same undertaking.

36. I find *Parking sensors for vehicles; Brake pad wear sensors; Distance sensors; Acceleration sensors; Engine control sensors; Parking sensors for vehicles; Sensors for determining acceleration; Sensors for determining velocity; Sensors for engines; Sensors for measuring speed; Range sensors; Impact sensors; Gyro sensors using GPS functions; Sensors for determining position; Sensors for use in the control of engines; Sensors for use in the control of motors; Electronic control sensors for motors; Position detection sensors; Proximity sensors; LED position sensors; Position sensors; Position determining sensors; Position fixing sensors; Electronic pressure sensors; Pressure sensors; Oil level sensors; Level sensors; Liquid level sensors; Fluid level sensors; Electronic measurement sensors; Sensors for measuring instruments; Shock sensors; Vibration sensors; and Timing sensors*" to be similar to the Opponent's "Computer hardware and downloadable computer software that allows users to continuously and wirelessly monitor temperature and humidity sensors, monitor external sensors and door switches, to provide oversight of food safety processes, to provide real-time fleet tracking, monitor task management activities for improved operational efficiencies, to provide voice, text and email alerts of triggering events, and to provide chain of custody verification" to a medium degree.

#### *Temperature sensors*

37. In paragraphs 41 to 44 of its submissions in lieu of a hearing, the Opponent sets out the similarity between its goods and services and the Applicant's temperature sensors which it indicates to cover:

*"Class 9: Digital sensors; Sensors; Sensors [measurement apparatus], other than for medical use; Sensors, detectors and monitoring instruments; Electric sensors; Electronic sensors; Electrical sensors; Laser sensors; Infrared sensors; Air temperature sensors; Heat sensors; Remote temperature sensors; Coolant-temperature sensors; Sensors for determining temperature; Temperature sensors; Thermal sensors [thermostats]."*



38. I note that this list mirrors the goods under the section 5(1) ground of opposition. I would include in this group the broad terms “*Measuring sensors; touchscreen sensors; and on-off sensors*”. While I have found there to be no identity between the Opponent’s *environmental monitoring systems* and the Applicant’s *temperature sensors*, I consider that such temperature sensors will clearly play an important role in the Opponent’s systems and I highlight the specific inclusion of “*temperature sensors*” in the description of the Opponent’s system.

39. On the basis of the important role that temperature sensors will play in the monitoring systems, I consider the average consumer would believe responsibility for the respective goods would lie with the same undertaking and therefore the goods are complementary. The goods also share the same users, channels of trade and intended purpose, of monitoring temperature conditions. I therefore find *Digital sensors; Sensors; Sensors [measurement apparatus], other than for medical use; Sensors, detectors and monitoring instruments; Electric sensors; Electronic sensors; Electrical sensors; Laser sensors; Infrared sensors; Air temperature sensors; Heat sensors; Remote temperature sensors; Coolant-temperature sensors; Sensors for determining temperature; Temperature sensors; Thermal sensors [thermostats]; Measuring sensors; Touchscreen sensors; and on-off sensors*” to be similar to the Opponent’s “*Environmental monitoring systems comprised of temperature sensors, data recorders and cellular gateways, all for use in collecting, measuring, analyzing, and reporting on the performance of refrigeration and cold-chain distribution systems and providing alerts of triggering events, all via a computer network*” to a degree that is somewhere between medium and high.

40. At this point I will also deal with the Applicant’s “*sensor controllers and sensor switches*” in Class 9. I consider that controllers and sensors such as these would feature in the Opponent’s environmental monitoring systems to enable its temperature sensors to be activated or controlled. Therefore, the respective goods would share the same intended purpose and possibly the same channels of trade.

41. I find “*sensor controllers and sensor switches*” to be similar to the Opponent’s “*Environmental monitoring systems comprised of temperature sensors, data recorders and cellular gateways, all for use in collecting, measuring, analyzing, and reporting on*

*the performance of refrigeration and cold-chain distribution systems and providing alerts of triggering events, all via a computer network” to a low degree.*

#### *Refrigeration monitoring systems*

42. The Opponent submits that the Applicant’s “*Alarm sensors for refrigerators*” are highly similar to its goods and services as such “*alarm sensors ensure product preservation is maximised by signalling if the temperature deviates from the set tolerance levels.*”

43. Comparing the Applicant’s “*Alarm sensors for refrigerators*” and the broader term “*Alarm sensors,*” to the Opponent’s “*computer hardware and computer software used to monitor and collect data on the temperature of products throughout refrigeration and cold chain distribution systems and to transmit the data to a host or a remote computer system used to provide alerts in the case of triggering events and to compile reports,*” I agree with the Opponent that the Applicant’s “*Alarm sensors for refrigerators*” and “*Alarm sensors*” would play an important role in the Opponent’s refrigerator monitoring hardware and software, with an alarm sensor being necessary in the reporting of a problem with the refrigerator. I consider that the average consumer, because of the importance of the alarm sensors to the Opponent’s systems, would believe the responsibility for the goods to lie with the same undertaking and so the goods are complementary. The goods also share the same users, channels of trade, and overall intended purpose, in respect of the preservation of food.

44. I find “*Alarm sensors* and *Alarm sensors for refrigerators*” to be similar to the Opponent’s *computer hardware and computer software used to monitor and collect data on the temperature of products throughout refrigeration and cold chain distribution systems and to transmit the data to a host or a remote computer system used to provide alerts in the case of triggering events and to compile reports* to a medium degree.

### *Door switches and external sensors*

45. In its submissions in lieu of a hearing, the Opponent submits that the Applicant's "*Door opening and closing detecting sensors; Motion sensors; and Sensors for monitoring physical movements*" are identical, or highly similar to the Opponent's "*Computer hardware and downloadable computer software that allows users to continuously and wirelessly monitor temperature and humidity sensors, monitor external sensors and door switches, to provide oversight of food safety processes, to provide real-time fleet tracking, monitor task management activities for improved operational efficiencies, to provide voice, text and email alerts of triggering events, and to provide chain of custody verification.*"

46. I disagree with the Opponent that these goods are identical, with my understanding of the Opponent's goods being that they are hardware and software that allow for the monitoring of external sensors and door switches, but they are not the sensors themselves. However, the Applicant's sensors that the Opponent has grouped under this heading are all related to doors and monitoring movement, the latter of which the Opponent indicates as in particular being the opening and closing of doors. The Applicant's sensors are therefore an important part of the Opponent's goods, which monitor external sensors and door switches and, due to this relationship, the average consumer would likely consider the goods to be the responsibility of the same undertaking.

47. To this grouping of the Applicant's goods, I add "*Motion recognizing sensors; Object detecting sensors; Occupancy sensors; Window opening and closing detecting sensors; Invader sensors; Microwave type intruder sensors; and Ultrasonic wave type intruder sensors*" which I consider to be forms of external and/or motion sensors that would be connected to the Opponent's monitoring hardware and software. The users of the respective goods and channels of trade would also be the same for the respective goods.

48. In summary, I find the applied for "*Door opening and closing detecting sensors; Motion sensors; Motion recognizing sensors; Sensors for monitoring physical movements; Object detecting sensors; Occupancy sensors; Window opening and*

*closing detecting sensors; Invader sensors; Microwave type intruder sensors; and Ultrasonic wave type intruder sensors” to be similar to the Opponent’s “Computer hardware and downloadable computer software that allows users to continuously and wirelessly monitor temperature and humidity sensors, monitor external sensors and door switches, to provide oversight of food safety processes, to provide real-time fleet tracking, monitor task management activities for improved operational efficiencies, to provide voice, text and email alerts of triggering events, and to provide chain of custody verification.” to a medium degree.*

#### *Environmental monitoring systems*

49. The Opponent groups the following of the Applicant’s goods under the heading *environmental monitoring systems*, stating that they “*broadly concern monitoring and measuring devices that assess air quality*”:

*“Air quality sensors; Pollutant sensors; Fire sensors; Electric smoke sensors; Smoke sensors”*

50. The Opponent submits that these goods are highly similar to the Opponent’s environmental monitoring systems and related software. Comparing the above goods to the Opponent’s “*Environmental monitoring systems comprised of temperature sensors, data recorders and cellular gateways, all for use in collecting, measuring, analyzing, and reporting on the performance of refrigeration and cold-chain distribution systems and providing alerts of triggering events, all via a computer network,*” I find that sensors of the type listed may form part of an environmental monitoring system in a cold-chain distribution system where monitoring for pollutants, smoke or fire could play a role in ensuring the safe transportation of products. Within the scope of this, I include the Applicant’s “*Gas sensors; and Electrochemical gas sensors,*” which could be a form of *pollutant* that the Opponent’s system would monitor for. As a result of this, I consider the goods to share the same intended purpose, users and channels of trade.

51. I therefore find the Applicant’s “*Air quality sensors; Pollutant sensors; Fire sensors; Electric smoke sensors; Smoke sensors; Gas sensors; and Electrochemical gas sensors;*” to be similar to the Opponent’s “*Environmental monitoring systems*

*comprised of temperature sensors, data recorders and cellular gateways, all for use in collecting, measuring, analyzing, and reporting on the performance of refrigeration and cold-chain distribution systems and providing alerts of triggering events, all via a computer network” to at least a low degree.*

#### *Monitoring external sensors*

52. Under this heading, the Opponent groups a long list of the Applicant’s Class 9 goods and submits that they are similar to its goods and services on the basis that the Applicant’s goods are the sensor products that the Opponent’s goods and services are used to monitor. The Opponent also submits that its computer software applications – which allow users to interface with environmental monitoring systems – are highly similar to the Applicant’s goods, as such software will often be integrated into sensors and monitoring devices.

53. I have already dealt with certain goods from the Opponent’s proposed grouping and will not assess these goods again under this heading. The list of goods that I will consider here is therefore:

*Class 9: Vibration sensors for installation in wind mill housings; Rotation controlling sensors; Rotation measuring sensors; Magnetic flux sensors; Magnetic resistance sensors; Magnetic sensors; Oxygen sensors, not for medical use; Passive infrared sensors; Active infra-red sensors; Piezoelectric sensors; Photoelectric sensors; Pyroelectric infrared sensors; Sensors for use with machine tools; Oil-water level sensors; Mass flow sensors; Alarm sensors for laundry washing machines; Alarm sensors for washing machines; Sensors for use with machine tools; Sensors for measuring depth; Ultrasonic sensors; Oscillation sensor devices; Shutter sensors; Synchro sensors; Resistors; Electric resistors; Electric resistors [for telecommunication apparatus]; Electric resistors for telecommunication apparatus; Electrical resistors; Force sensing resistors; Inductive resistors; Trimmer resistors; Variable resistors; Projected capacitive touch sensors; Electric current sensors; Flame sensors; Biochip sensors; Sensors for use with machine tools; Light sensors; Optical fibre sensors; Optical*

*position sensors; Optical sensors; Optical speed sensors; Electro-optical sensors; Motion sensors for security lights”*

54. In its submissions in lieu of a hearing, the Opponent submits that the Applicant's goods measure physical properties/stimuli, with data being shown on a display or transmitted for remote viewing or further processing. The Opponent then submits that its goods comprise sensors, hardware and software and related services, which allow users to monitor tasks, processes and performance via data collected from sensors.

55. I accept that the Applicant's listed goods monitor physical properties and stimuli. However, it appears to me that the physical properties and stimuli detected by the Applicant's goods are not related to the tasks, processes and performance that are monitored via the Opponent's goods and accessed through their services. Apart from the Opponent's "*downloadable computer software application for logging data and generating reports; downloadable computer software application used to allow users to interface with monitoring systems and to receive alerts and online; and non-downloadable enterprise software for logging data and generating reports,*" all of Opponent's goods and services relate specifically to food preparation and distribution. There is no explanation before me as to how the Applicant's above-listed sensors are similar to the Opponent's goods and services that are specifically for monitoring food production and distribution. Additionally, many of the Applicant's sensors appear very technical in nature and no explanation as to their nature has been provided,<sup>11</sup> meaning it is not possible to conduct a comparison between those goods and the Opponent's food preparation and transportation monitoring systems and related services.

56. I will now consider the list of the Applicant's goods (at paragraph 53) and whether they are similar to the Opponent's software goods and services that are not limited to food production and distribution – "*downloadable computer software application for logging data and generating reports; downloadable computer software application used to allow users to interface with monitoring systems and to receive alerts; and*

---

<sup>11</sup> *Magnetic flux sensors; sensors; Magnetic resistance sensors; Magnetic sensors; Passive infrared sensors; Active infra-red sensors; Piezoelectric sensors; Photoelectric sensors; Pyroelectric infrared sensors; Ultrasonic sensors; Shutter sensors; Synchro sensors; Projected capacitive touch sensors; Biochip sensors.*

online, non-downloadable enterprise software for logging data and generating reports.”

57. The Opponent submits that “*it is common for technology providers to also provide integrated or related software for sensors or monitoring devices.*” In *Les Éditions Albert René Sarl v Office for Harmonisation in the Internal Market*,<sup>12</sup> the Court of First instance (now the General Court) considered the similarity of software and electronic goods:

*“... the Court must reject the applicant’s argument that all the goods and services covered by the Community trade mark application are linked, in one way or another, to ‘computers’ and ‘computer programs’ (Class 9) covered by the earlier trade mark. As the defendant rightly points out, in today’s high-tech society, almost no electronic or digital equipment functions without the use of computers in one form or another. To acknowledge similarity in all cases in which the earlier right covers computers and where the goods or services covered by the mark applied for may use computers clearly exceeds the scope of the protection granted by the legislature to the proprietor of a trade mark. Such a position would lead to a situation in which the registration of computer hardware or software would in practice exclude subsequent registration of any type of electronic or digital process or service exploiting that hardware or software.”*<sup>13</sup>

58. The Opponent has argued that the Applicant’s goods and the Opponent’s goods and services share a “*functional complementarity*” on the basis that technology producers also provide integrated software for sensors and monitoring devices. In its evidence, the Opponent has shown that its systems utilise integrated computer software and related services.<sup>14</sup> However, what is not apparent from the evidence is the relevance of computer software to sensors of the types listed at paragraph 53. Taking this into account, and in light of *Les Éditions Albert René*, I disagree with the Opponent that the Applicant’s goods and the Opponent’s software goods and services share a “*functional complementarity*”. Even if the producer of, for example, a rotation measuring sensor, an ultrasonic sensor, or a resistor makes software to put in its

---

<sup>12</sup> Case T-336/03.

<sup>13</sup> At paragraph 69.

<sup>14</sup> See Exhibit SM01 and SM04.

goods, it is not offering software to the consumer and therefore I do not find similarity between the Applicant's sensors and resistors and the Opponent's downloadable computer software application for logging data and generating reports; downloadable computer software application used to allow users to interface with environmental monitoring systems and to receive alerts; downloadable computer software application used to allow users to interface with monitoring systems and to receive alerts; or online, non-downloadable enterprise software for logging data and generating reports.

59. I find the following of the Applicant's goods to be dissimilar to the Opponent's goods and services and therefore the opposition fails in respect of these goods:

*Class 9: Vibration sensors for installation in wind mill housings; Rotation controlling sensors; Rotation measuring sensors; Magnetic flux sensors; Magnetic resistance sensors; Magnetic sensors; Oxygen sensors, not for medical use; Passive infrared sensors; Active infra-red sensors; Piezoelectric sensors; Photoelectric sensors; Pyroelectric infrared sensors; Sensors for use with machine tools; Oil-water level sensors; Mass flow sensors; Alarm sensors for laundry washing machines; Alarm sensors for washing machines; Sensors for use with machine tools; Sensors for measuring depth; Ultrasonic sensors; Oscillation sensor devices; Shutter sensors; Synchro sensors; Resistors; Electric resistors; Electric resistors [for telecommunication apparatus]; Electric resistors for telecommunication apparatus; Electrical resistors; Force sensing resistors; Inductive resistors; Trimmer resistors; Variable resistors; Projected capacitive touch sensors; Electric current sensors; Flame sensors; Biochip sensors; Sensors for use with machine tools; Light sensors; Optical fibre sensors; Optical position sensors; Optical sensors; Optical speed sensors; Electro-optical sensors; Motion sensors for security lights."*

*The remaining goods in Class 9*

60. In respect of the Applicant's remaining goods in Class 9, the Opponent contends that these measure environmental stimuli and are therefore highly similar to the Opponent's "downloadable computer software application used to allow users to



*interface with environmental monitoring systems and to receive alerts.”* The Applicant’s goods are:

*“Sensors used in meteorology; Sensors used in oceanography; Sensors used in plant control; Electronic sensors for measuring solar radiation; Electronical sensors for measuring solar radiation; Automatic solar tracking sensors”*

61. Referring again to the judgment in *Les Éditions Albert René*, I reiterate that the mere inclusion of software within an electrical product does not mean that the product is similar to software. There is no evidence before me that the producers of Applicant’s sensors would also produce software or provide software services that would be made available to consumers, independently of the sensors themselves. On the basis of this conclusion, and because I find no similarity between the Applicant’s goods and the Opponent’s goods used in the production and transportation of food (or their related services), I find the Applicant’s *“Sensors used in meteorology; Sensors used in oceanography; Sensors used in plant control; Electronic sensors for measuring solar radiation; Electronical sensors for measuring solar radiation; and Automatic solar tracking sensors”* to be dissimilar to the Opponent’s goods and services and therefore the opposition fails in respect of these goods.

#### *Class 11*

62. The Applicant’s goods in Class 11 consist of:

*“HVAC systems (heating, ventilation and air conditioning); Vehicle HVAC systems (heating, ventilation and air conditioning).”*

63. In its submissions in lieu of a hearing, the Opponent submits that these goods are similar to its environmental monitoring systems as they share the same nature, purpose, relevant public, distribution channels and are complementary.

64. Comparing the Applicant’s heating, ventilation and air conditioning systems at large, and specifically for vehicles, to the Opponent’s *“environmental monitoring systems comprised of temperature sensors, data recorders and cellular gateways, all*

*for use in collecting, measuring, analyzing, and reporting on the performance of refrigeration and cold-chain distribution systems and providing alerts of triggering events, all via a computer network*", I consider the goods to be aligned in their intended purpose of controlling temperature, including in transportation and I therefore agree with the Opponent that the goods are similar in their nature, purpose, relevant public and channels of trade. In addition to this, the importance of temperature control and ventilation in food transport systems results in complementarity between the Applicant's and Opponent's goods as average consumers would likely think that the responsibility for the goods lies with the same undertaking.

65. I therefore find "*HVAC systems (heating, ventilation and air conditioning); Vehicle HVAC systems (heating, ventilation and air conditioning)*" to be similar to "*environmental monitoring systems comprised of temperature sensors, data recorders and cellular gateways, all for use in collecting, measuring, analyzing, and reporting on the performance of refrigeration and cold-chain distribution systems and providing alerts of triggering events, all via a computer network*" to a medium degree.

### **Average consumer and the purchasing act**

66. It is necessary to determine who is the average consumer for the goods at issue and how the goods are likely to be selected in the purchasing process. In *Hearst Holdings Inc.*,<sup>15</sup> Birss J. explained that:

*"... 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 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 word "average" denotes that the person is typical ..."*

67. The Opponent submits that (i) the average consumer of the goods will be both the public at large and the professional public; (ii) the goods will be selected visually, following research on websites, brochures and catalogues, or through official

---

<sup>15</sup> *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*, case [2014] EWHC 439 (Ch), at paragraph 60.

procurement; (iii) aural considerations will play a part through advice or recommendations; and (iv) the level of attention will be higher than average for the professional public and no more than average for the general public. The Applicant has not made any submissions on the average consumer and the purchasing act.

68. I agree with the Opponent's submissions, as expressed in points (i) to (iii)<sup>16</sup> above and would add to this analysis that the goods will vary in price from low cost items such as resistors, to high cost items such as HVAC systems, which may be bespoke for a user's requirements. In respect of point (iv), I agree that the professional public will pay a higher than average level of attention, however I disagree with the Opponent's "average" level of attention ascribed to the general public. There are few goods and services under consideration for which the average consumer will be the general public, with these being limited to "*smoke sensors; electric smoke sensors; and parking sensors for vehicles.*" Each of these goods relate to safety and protection of property and I therefore consider that the general public, when purchasing such products would pay a higher than average level of attention, taking into account the specific features and reliability of the products.

### **Distinctive character of the Applicant's earlier trade mark**

69. Distinctive character is the capacity of the mark to identify the goods or services for which it is registered as coming from a particular undertaking, and to distinguish those goods or services from those of other undertakings: see *Lloyd Schuhfabrik Meyer*, paragraph 22.

70. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The inherent distinctive character may be enhanced through the use that has been made of the mark.

71. In *Lloyd Schuhfabrik Meyer*, the CJEU set out how an assessment of a mark's distinctive character should be made:

---

<sup>16</sup> No similarity on the basis of the Opponent's services has been identified, so the average consumer and purchasing act for those services are not considered here.

*“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).”*

72. I shall begin my assessment by considering the inherent distinctiveness of the Opponent’s earlier mark. The Opponent sets out the above case law from *Lloyd Schuhfabrik Meyer* and submits that its mark is a “*singular fanciful name*” and is therefore inherently distinctive to at least a medium degree.

73. As indicated earlier in this decision, I consider that the Opponent’s mark consists of the joined English dictionary words “SMART” and “SENSE.” I take judicial notice that the word “smart” is used descriptively in trade, particularly in respect of electrical goods where it designates that the goods function in an intelligent way. The word “sense” refers to how something is understood, or detected, including through the five main senses (to see, hear, smell, taste and feel). The word “sense” alludes to the intended purpose of the Opponent’s goods and services which detect environmental conditions; however, I find the term to be allusive only, and not descriptive.

74. While the word “SMART” is low in distinctive character in respect of the Opponent’s goods and services, in combination with the word “SENSE,” which provides an element of alliteration, I consider the mark as a whole to be distinctive.

75. I find the Opponent’s mark to be inherently distinctive to at most an average degree.

76. In its notice of opposition, the Opponent claimed that its mark has enhanced distinctiveness due to the use that has been made of it since 2018. The Opponent has not made any further submissions on the claimed enhanced distinctiveness of its trade mark and I therefore assess this claim on the basis of the evidence contained in the witness statement of Mr Steve Maurer.

77. Only exhibits SM01 and SM04 contain extracts from the Opponent’s websites. In these extracts, I can see the Opponent’s mark used on a dashboard for monitoring conditions, a wireless sensor and a Bluetooth probe. Other than this, the only information that I have to guide me on the matter of enhanced distinctiveness of the Opponent’s mark is the statement in the notice of opposition that the mark has been used since 2018.

78. Applying the criteria from *Windsurfing Chiemsee* to the evidence before me, there has been a relatively short period of use prior to the application for the contested mark – approximately two years.<sup>17</sup> I have no information or figures on turnover or promotional expenditure, so I am unable to make an assessment of the market share held by the Opponent’s mark, how intensive and geographically widespread the use has been, the amount invested in promoting the mark, or the proportion of the public which identifies the mark as originating from a particular undertaking. On the basis of all these factors, I find that the distinctive character of the Opponent’s mark has not been enhanced through use.

---

<sup>17</sup> On the basis of the Opponent’s statement that its mark has been used since 2018 and the Applicant’s mark was filed on 4 June 2020.

## Likelihood of confusion

79. The principles of likelihood of confusion are set out in case law.<sup>18</sup> These principles include:

(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) 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;

(d) 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;

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

(f) 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;

(g) 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.

---

<sup>18</sup> *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

80. I have so far considered the factors that need to be taken into account when assessing the likelihood of confusion and I now come to make a global assessment of these factors. In making this global assessment, I take stock of my findings in the foregoing sections of this decision and the authorities and principles that I have set out above.

81. There are two types of confusion that I must consider. Firstly, direct confusion i.e. where one mark is mistaken for the other. The second is indirect confusion which is where the consumer appreciates that the marks are different, but the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or a related source.

82. In this decision I have found the Applicant's and Opponent's marks to be identical. In comparing the respective goods and services, I have found some goods to be dissimilar and the opposition has failed in respect of those goods. For the remaining goods, I have found similarity with the Opponent's goods to at least a low degree. I have found the Opponent's earlier mark to possess at most an average degree of distinctive character and that this has not been shown to have been enhanced through use. In terms of the average consumer, I have found this to be both the general public and the professional consumer, who, in both cases will pay an above average level of attention. Keeping all of these factors in mind, and the case law that I have cited, in particular the CJEU's comments in *Canon* that a lower degree of similarity between the goods may be offset by a greater degree of similarity between the marks,<sup>19</sup> I find there to be a likelihood of direct confusion between the Opponent's mark and the following goods from the Applicant's mark:

***Class 9: Parking sensors for vehicles; Brake pad wear sensors; Distance sensors; Acceleration sensors; Engine control sensors; Parking sensors for vehicles; Sensors for determining acceleration; Sensors for determining velocity; Sensors for engines; Sensors for measuring speed; Range sensors; Impact sensors; Gyro sensors using GPS functions; Sensors for determining position; Sensors for use in the control of engines; Sensors for use in the control of motors;***

---

<sup>19</sup> Case C-39/97, at paragraph 17.

*Electronic control sensors for motors; Position detection sensors; Proximity sensors; LED position sensors; Position sensors; Position determining sensors; Position fixing sensors; Electronic pressure sensors; Pressure sensors; Oil level sensors; Level sensors; Liquid level sensors; Fluid level sensors; Electronic measurement sensors; Sensors for measuring instruments; Shock sensors; Vibration sensors; Timing sensors; Digital sensors; Sensors; Sensors [measurement apparatus], other than for medical use; Sensors, detectors and monitoring instruments; Electric sensors; Electronic sensors; Electrical sensors; Laser sensors; Infrared sensors; Air temperature sensors; Heat sensors; Remote temperature sensors; Coolant-temperature sensors; Sensors for determining temperature; Temperature sensors; Thermal sensors [thermostats]; Measuring sensors; Touchscreen sensors; on-off sensors; sensor controllers; sensor switches Alarm sensors; Alarm sensors for refrigerators; Door opening and closing detecting sensors; Motion sensors; Motion recognizing sensors; Sensors for monitoring physical movements; Object detecting sensors; Occupancy sensors; Window opening and closing detecting sensors; Invader sensors; Microwave type intruder sensors; Ultrasonic wave type intruder sensors; Air quality sensors; Pollutant sensors; Fire sensors; Electric smoke sensors; Smoke sensors; Gas sensors; and Electrochemical gas sensors.*

**Class 11:** *HVAC systems (heating, ventilation and air conditioning); Vehicle HVAC systems (heating, ventilation and air conditioning)*

## **Conclusion**

83. The opposition under section 5(2)(a) succeeds in respect of the goods listed at paragraph 82.

84. The opposition under section 5(2)(a) fails in respect of:

**Class 9:** *Vibration sensors for installation in wind mill housings; Rotation controlling sensors; Rotation measuring sensors; Magnetic flux sensors; Magnetic resistance sensors; Magnetic sensors; Oxygen sensors, not for medical use; Passive infrared sensors; Active infra-red sensors; Piezoelectric sensors;*



*Photoelectric sensors; Pyroelectric infrared sensors; Sensors for use with machine tools; Oil-water level sensors; Mass flow sensors; Alarm sensors for laundry washing machines; Alarm sensors for washing machines; Sensors for measuring depth; Ultrasonic sensors; Oscillation sensor devices; Shutter sensors; Synchro sensors; Resistors; Electric resistors; Electric resistors [for telecommunication apparatus]; Electric resistors for telecommunication apparatus; Electrical resistors; Force sensing resistors; Inductive resistors; Trimmer resistors; Variable resistors; Projected capacitive touch sensors; Electric current sensors; Flame sensors; Biochip sensors; Light sensors; Optical fibre sensors; Optical position sensors; Optical sensors; Optical speed sensors; Electro-optical sensors; Sensors used in meteorology; Sensors used in oceanography; Sensors used in plant control; Electronic sensors for measuring solar radiation; Electronical sensors for measuring solar radiation; Automatic solar tracking sensors; and Motion sensors for security lights.*

85. The opposition under section 5(1) fails.

### **Costs**

86. The Opponent and the Applicant have both achieved success and so I order each party to bear its own costs in these proceedings.

**Dated this 6th day of August 2021**

**Charlotte Champion**

**For the Registrar**

**The Comptroller-General**