O/0849/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3669310
IN THE NAME OF KOHLER MIRA LIMITED
TO REGISTER THE FOLLOWING TRADE MARK:

SENSE

IN CLASSES 9 & 11

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 429005
BY GROHE AG

Background and pleadings

1. On 8 November 2016,[1] Kohler Mira Limited ("the applicant") applied to register the trade mark **SENSE** in the UK, under number 3669310 ("the contested mark"). Details of the application were published for opposition purposes on 10 September 2021. Registration is sought for the following goods:

> Class 9: Apparatus and instruments for controlling and detecting liquids and gases; remote control mechanisms and devices; thermostats; thermometers; apparatus for thermostatically controlling the mixture of fluids; electric and electronic flow control systems; apparatus for indicating and recording the flow of fluids; temperature sensors and scanners; water temperature regulators; temperature display units; valve position indicators; liquid level indicators; electric and electronic timing devices; timed flow controls; infra-red detection units; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; solenoids; batteries; electric cable and wire; protection devices for electric circuits; all relating directly or indirectly to water supply and sanitary installations; parts and fittings for the aforesaid goods; none of the aforementioned goods being filters.
>
> Class 11: Apparatus and installations for water supply and sanitary purposes; showers, spray fittings, shower heads, shower handsets, shower hoses; water mixing appliances and water taps for use in showers; shower baths; booths, cabins, enclosures, cabinets, cubicles, screens and trays for showers; thermostatic mixing valves; parts and fittings for the aforesaid goods; none of the aforementioned goods being filters or for use in central heating apparatus.

2. On 10 December 2021, Grohe AG ("the opponent") opposed the application in full under sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 ("the Act").

[1] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 59 of the Withdrawal Agreement between the UK and EU, applications for EUTMs made before the end of the transition period that had received a filing date can form the basis of a UK application with the same filing date as the corresponding EUTM, provided they were filed within 9 months of the end of the transition period. The applicant's EUTM number 16012461 was filed at the EUIPO on 8 November 2016, whereas its UK application was filed on 15 July 2021. Accordingly, the UK application was given the same filing date as its EUTM.

3. For the purposes of its claims under sections 5(1) and 5(2)(a), the opponent relies upon its comparable UK trade mark number 915678048,[2] **Sense** ("the first earlier mark"). The first earlier mark was filed on 20 July 2016 and became registered on 26 August 2020 in respect of the following goods, all of which are relied upon by the opponent:

> Class 9: Electrotechnical, electronic, optoelectronic and acoustic equipment, apparatus and installations composed thereof for monitoring, controlling and regulating water supply and drainage, treatment, availability, distribution, removal and heating of drinking and commercial water; equipment and apparatus for monitoring, measuring, controlling and regulating pressure, temperature and flow rate quantities of water in water conduit installations, containers and sanitary installations; temperature controlling apparatus, thermostat components and kits for cold and hot water mixing valves, thermostat fittings and batteries, parts and accessories for the aforesaid goods (included in class 9); mobile apps for operating toilets, water taps; electronic devices for monitoring and transmitting health data; mobile apps for health monitoring, sensors for moisture, flooding, leak monitoring, water control and water quality; sprinklers; component parts for all the aforesaid goods.

4. In its notice of opposition, the opponent argues that the goods of the first earlier mark are identical or similar to those in class 9 of the contested mark and similar to those in class 11 of the contested mark. Further, it contends that the first earlier mark is identical to the contested mark. On this basis, the opponent submits that registration of the contested mark ought to be refused under section 5(1) of the Act and/or there is a likelihood of confusion such that the contested mark should be refused under section 5(2)(a) of the Act.

[2] Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing EUTM. As a result of the opponent's EUTM number 15678048 being registered as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original EUTM filing date.

5. As for its claim under section 5(2)(b), the opponent relies upon its comparable UK trade mark number 904319034,[3] **Essence** ("the second earlier mark"). The second earlier mark was filed on 25 February 2005 and became registered on 22 January 2007 for the following goods, all of which are relied upon for the purposes of the opposition:

> Class 11: Water conduits for kitchen and sanitary use; pipe fittings mixing cold and warm water, in particular those operated by one hand for washbasins and utility sinks, washstands, bidets, tubs and showers; showers and shower fittings; parts for all the aforesaid goods.

6. The opponent contends that the goods of the second earlier mark are identical to those in class 11 of the contested mark and similar to those in class 9 of the contested mark. It also argues that the second earlier mark is similar to the contested mark. Based upon these factors, the opponent submits that there is a likelihood of confusion such that the contested mark ought to be refused under section 5(2)(b) of the Act.

7. The applicant filed a counterstatement, denying the grounds of opposition. It contends that the applied-for goods are not identical or similar to the goods of the earlier marks. Moreover, the applicant denies that the contested mark is similar to the second earlier mark. On this basis, it denies that there is a likelihood of confusion between the competing marks and that the contested mark should be refused under section 5(1), 5(2)(a) or 5(2)(b) of the Act.

8. Given the respective filing dates, the opponent's marks are earlier marks in accordance with section 6 of the Act. As the first earlier mark had not completed its registration process more than five years before the filing date of the contested mark, it is not subject to the proof of use provisions specified in section 6A of the Act. Consequently, the opponent is entitled to rely upon all the goods identified, without having to demonstrate genuine use. The second earlier mark had completed its

[3] Comparable UK trade mark automatically created by virtue of Article 54 of the Withdrawal Agreement, based upon the opponent's EUTM number 4319034 being registered as at the end of the Implementation Period. As above, the comparable mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original EUTM filing date.

registration process more than five years before the filing date of the contested mark and is, therefore, subject to proof of use. In its notice of opposition, the opponent made a statement of use for all the goods of the second earlier mark. Within its counterstatement, the applicant indicated that it would require the opponent to provide proof of use of the same.

9. Both parties are professionally represented; the opponent by Fladgate LLP and the applicant by Barker Brettell LLP. Both parties filed evidence. Neither party requested a hearing, nor did they elect to file written submissions in lieu of attendance. This decision is taken following careful consideration of all the papers before me.

10. Although the UK has left the EU, section 6(3)(a) of the European Union (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 Act relied upon in these proceedings are derived from an EU Directive and, therefore, this decision continues to refer to the trade mark case law of the EU courts.

Evidence

11. The opponent's evidence is given in the witness statement of Philip Speck, dated 21 November 2022, and four accompanying exhibits (PS1 to PS4). Dr Speck is Leader of Intellectual Property (Europe, Middle East and North Africa region) at LIXIL, the opponent's parent company, a position he has held since 2019. The purpose of Dr Speck's statement is to provide evidence of use of the second earlier mark.

12. The applicant's evidence came in the form of a witness statement from Steven Gamble, dated 3 March 2023, and five accompanying exhibits (SG1 to SG4 and SG6). Mr Gamble is Senior Product Manager (Commercial) of the applicant, a position he has held since around 2008. Mr Gamble's evidence goes to the applicant's use of another registered mark.

13. I have read all the evidence and will return to it to the extent I consider necessary in the course of this decision.

Preliminary remarks

14. From its evidence, I note that the applicant is the proprietor of UK registration number 2351085, under which the mark 'RADA SENSE' is protected for goods in classes 9 and 11.[4] Mr Gamble outlines that it was filed on 10 December 2003 and, therefore, predates the registrations relied upon by the opponent in these proceedings.[5]

15. Although the applicant's use of this other mark could be relevant to a defence of honest concurrent use (which I note has not been pleaded), I must clarify that its mere existence will have no bearing on the outcome of these proceedings, notwithstanding that it has an earlier filing date than the opponent's registrations. Section 72 of the Act stipulates that registration shall be taken as *prima facie* evidence of the validity of a registered mark. Sections 5(1) and 5(2) of the Act turn upon whether the 'attacker' has an earlier trade mark compared to the mark under 'attack', as defined by section 6 of the Act. Whether the applicant has another registration that predates those upon which the 'attacker' relies cannot affect the outcome of the case in relation to these grounds. The position was explained in *PepsiCo, Inc v OHIM,* Case T-269/02:

> "24. Nor did the applicant claim, and even less prove, that it had used its earlier German mark to obtain cancellation of the intervener's mark before the competent national authorities, or even that it had commenced proceedings for that purpose.
>
> 25. In those circumstances, the Court notes that, quite irrespective of the question whether the applicant had adduced evidence of the existence of its earlier German mark before OHIM, the existence of that mark alone would not in any event have been sufficient reason for rejecting the opposition. The applicant would still have had to prove that it had been successful in having the intervener's mark cancelled by the competent national authorities.

[4] Witness statement of Steven Gamble, §5; Exhibit SG1
[5] Gamble, §5

> 26. The validity of a national trade mark, in this case the intervener's, may not be called in question in proceedings for registration of a Community trade mark, but only in cancellation proceedings brought in the Member State concerned (Case T 6/01 Matratzen Concord v OHIM - Hukla Germany (MATRATZEN) [2002] ECR II 4335, paragraph 55). Moreover, although it is for OHIM to ascertain, on the basis of evidence which it is up to the opponent to produce, the existence of the national mark relied on in support of the opposition, it is not for it to rule on a conflict between that mark and another mark at national level, such a conflict falling within the competence of the national authorities."

16. The viability of a defence including claims that the applicant for registration has a registered trade mark that predates the trade mark upon which the 'attacker' relies was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, Case BL O/211/09. Ms Carboni rejected the defence as being wrong in law. Therefore, if the applicant of the mark under 'attack' has an earlier mark which could be used to invalidate the trade marks relied upon by the 'attacker', and the applicant wishes to invoke that earlier mark, the proper course is to apply to invalidate the 'attacker's' marks.[6]

17. As I understand it, the applicant has not sought to invalidate the opponent's registrations on the basis of its claim to an even earlier trade mark. Consequently, the opponent's trade marks must be regarded as validly registered marks. In this situation, the law requires priority to be determined according to the filing dates of the applications for registration. This means that, for the purposes of this opposition, the opponent's marks have priority. A likelihood of confusion between the marks in suit only, based on their notional use throughout the UK, or identity between the marks and their goods, will be enough to justify the refusal of the contested mark.

[6] Tribunal Practice Notice 4/2009 refers.

Section 5(1)

The law

18. Sections 5(1) and 5A of the Act read as follows:

> "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."
>
> "5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

Identity of the marks

19. In order for a claim under section 5(1) of the Act to succeed, the competing marks are required to be identical. The question of when a mark may be considered identical to another was addressed in *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA,* Case C-291/00, where the Court of Justice of the European Union ("CJEU") held that:

> "54. […] a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."

20. The first earlier mark consists of the word 'Sense' with no other elements. The registration of word-only marks provides protection for the words themselves, irrespective of whether they are presented in upper, lower or title case.[7] As such, I find

[7] *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16, paragraph 56; *LA Superquimica v EUIPO*, Case T-24/17, paragraph 39; *Bentley Motors Limited v Bentley 1962 Limited*, Case BL O/158/17, paragraph 16

that the contested mark, comprising the word 'SENSE' with no other elements, reproduces, without any modification or addition, all of the elements of the first earlier mark. Accordingly, the marks are identical.

Identity of the goods

21. In *Gérard Meric v OHIM,* Case T- 133/05, the General Court ("GC") stated that:

> "29. […] 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 fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

22. The goods to be compared under this ground are as follows:

Opponent's goods	Applicant's goods
Class 9: Electrotechnical, electronic, optoelectronic and acoustic equipment, apparatus and installations composed thereof for monitoring, controlling and regulating water supply and drainage, treatment, availability, distribution, removal and heating of drinking and commercial water; equipment and apparatus for monitoring, measuring, controlling and regulating pressure, temperature and flow rate quantities of water in water conduit installations, containers and sanitary installations; temperature controlling apparatus, thermostat components and kits for cold	Class 9: Apparatus and instruments for controlling and detecting liquids and gases; remote control mechanisms and devices; thermostats; thermometers; apparatus for thermostatically controlling the mixture of fluids; electric and electronic flow control systems; apparatus for indicating and recording the flow of fluids; temperature sensors and scanners; water temperature regulators; temperature display units; valve position indicators; liquid level indicators; electric and electronic timing devices; timed flow controls; infra-red detection units; apparatus and

and hot water mixing valves, thermostat fittings and batteries, parts and accessories for the aforesaid goods (included in class 9); mobile apps for operating toilets, water taps; electronic devices for monitoring and transmitting health data; mobile apps for health monitoring, sensors for moisture, flooding, leak monitoring, water control and water quality; sprinklers; component parts for all the aforesaid goods.	instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; solenoids; batteries; electric cable and wire; protection devices for electric circuits; all relating directly or indirectly to water supply and sanitary installations; parts and fittings for the aforesaid goods; none of the aforementioned goods being filters.

'Apparatus and instruments for controlling […] liquids […]; all relating directly or indirectly to water supply and sanitary installations; none of the aforementioned goods being filters'

23. The applicant's goods relate to any apparatus and instruments (save for filters) used in the context of water supply and sanitary installations. In my view, they incorporate the opponent's *'electrotechnical, electronic, optoelectronic and acoustic equipment, apparatus and installations composed thereof for […] controlling […] water supply and drainage, treatment, availability, distribution, removal and heating of drinking and commercial water'*. As such, the goods are to be regarded identical in accordance with *Meric*.

'Apparatus and instruments for […] detecting liquids […]; all relating directly or indirectly to water supply and sanitary installations; none of the aforementioned goods being filters'

24. To my mind, the opponent's *'sensors for moisture, flooding, leak monitoring […]'* refers to a particular example of apparatus/instruments for detecting liquids and could be used in the context of water supply/sanitary installations. For these reasons, I find that the respective goods are identical under the principle outlined in *Meric*.

'Remote control mechanisms and devices; all relating directly or indirectly to water supply and sanitary installations; none of the aforementioned goods being filters'

25. There is nothing preventing the opponent's *'electrotechnical, electronic, optoelectronic and acoustic equipment, apparatus and installations composed thereof for monitoring, controlling and regulating water supply and drainage, treatment, availability, distribution, removal and heating of drinking and commercial water'* and *'equipment and apparatus for monitoring, measuring, controlling and regulating pressure, temperature and flow rate quantities of water in water conduit installations, containers and sanitary installations'* being controlled remotely. As the opponent's goods also relate to the supply or water and/or sanitary installations, I find that the applicant's goods encompass those of the opponent, rendering them identical under the *Meric* principle.

'Thermometers; all relating directly or indirectly to water supply and sanitary installations; none of the aforementioned goods being filters'

26. A thermometer relating to water supply and/or sanitary installations is a particular example of the opponent's *'equipment and apparatus for monitoring, measuring […] temperature […] of water in water conduit installations, containers and sanitary installations'*. I find that the respective goods are identical in accordance with *Meric*.

'Apparatus for thermostatically controlling the mixture of fluids; all relating directly or indirectly to water supply and sanitary installations; none of the aforementioned goods being filters'

27. I interpret the opponent's *'thermostat components and kits for cold and hot water mixing valves'* to be apparatus for thermostatically controlling the mixture of fluids (i.e. hot and cold water). As such, these goods are encompassed by the applicant's term. The respective goods are identical under *Meric*.

'Temperature sensors and scanners; all relating directly or indirectly to water supply and sanitary installations; none of the aforementioned goods being filters'

28. To my mind, the opponent's *'equipment and apparatus for monitoring, measuring, […] temperature […] of water in water conduit installations, containers and sanitary installations'* would include sensors and scanners. Moreover, the opponent's term could reasonably relate to the supply of water and sanitary installations. Given that the opponent's term encompasses the applicant's, I find that the respective goods are identical under the *Meric* principle.

'Water temperature regulators; all relating directly or indirectly to water supply and sanitary installations; none of the aforementioned goods being filters'

29. Similarly, the opponent's *'equipment and apparatus for […] regulating […] temperature […] of water in water conduit installations, containers and sanitary installations'* clearly includes water temperature regulators and, given their application, could reasonably relate to the supply of water and sanitary installations. The respective goods are identical in accordance with *Meric*.

'Timed flow controls; electric and electronic flow control systems; all relating directly or indirectly to water supply and sanitary installations; none of the aforementioned goods being filters'

30. The goods above consist of equipment/apparatus for controlling flow. Particularly given the specific application of the goods, they are included within the opponent's *'equipment and apparatus for […] controlling […] flow rate quantities of water in water conduit installations, containers and sanitary installations'*. Although they are described as being timed and electric/electronic control systems, the opponent's term is sufficiently broad to cover timed and electric/electronic control systems. Therefore, I find that the respective goods are identical under *Meric*.

'Thermostats; all relating directly or indirectly to water supply and sanitary installations; none of the aforementioned goods being filters'

31. The opponent's *'temperature controlling apparatus'* covers all such apparatus, including thermostats. Although the applicant's goods are limited to a particular field of application, the opponent's goods are not limited in any way and could also cover goods relating to water supply and sanitary installations. On this basis, the goods are identical under the principle in *Meric*.

'Temperature display units; all relating directly or indirectly to water supply and sanitary installations; none of the aforementioned goods being filters'

32. I understand the above term to be describing, for instance, a screen which displays the temperature. It is not uncommon for digital thermostats to incorporate a screen whereby the user can view the temperature of the room. For these reasons, I consider the applicant's goods to fall within the opponent's *'thermostat components […], thermostat fittings […], parts and accessories for the aforesaid goods'*. The respective goods are identical under *Meric*.

'Infra-red detection units; all relating directly or indirectly to water supply and sanitary installations; none of the aforementioned goods being filters'

33. Although I acknowledge that there is equipment that can be used to detect infrared radiation, in the context of the positive limitation I interpret the above term to refer to a type of sensor which uses infra-red light to detect something, likely to be leaks, water levels and the like. It is my view that they would be encompassed by the opponent's *'sensors for […] leak monitoring […]*', which would include all sensors for this purpose. I find that the respective goods are identical under *Meric*.

'Batteries; all relating directly or indirectly to water supply and sanitary installations; none of the aforementioned goods being filters'

34. Thermostats can be said to (at least indirectly) relate to water supply and sanitary installations, since they control the flow of hot or cold water. The applicant's term

covers all batteries in the specified field, including, to my mind, those for thermostats. As such, I find that the opponent's *'thermostat […] batteries'* are encompassed within this applied-for term, rendering the respective goods identical under *Meric*.

'Liquid level indicators; all relating directly or indirectly to water supply and sanitary installations; none of the aforementioned goods being filters'

35. A liquid level indicator can be fairly described as equipment/apparatus for monitoring and measuring quantities of a liquid. In the context of the positive limitation, that liquid is likely to be water. On this basis, these goods would be encompassed by the opponent's *'equipment and apparatus for […] monitoring, measuring […] flow rate quantities of water in water conduit installations, containers and sanitary installations'* and *'electrotechnical, electronic, optoelectronic and acoustic equipment, apparatus and installations composed thereof for monitoring […] water supply […]'*. The respective goods are identical under *Meric*.

'Apparatus for indicating […] the flow of fluids; all relating directly or indirectly to water supply and sanitary installations; none of the aforementioned goods being filters'

36. Although the above term is worded slightly differently to the opponent's *'equipment and apparatus for monitoring, measuring […] flow rate quantities of water in water conduit installations, containers and sanitary installations',* they describe the same goods. I find that the respective goods are identical.

'Electric and electronic timing devices; all relating directly or indirectly to water supply and sanitary installations; none of the aforementioned goods being filters'

37. Timing devices used in the context of water supply and sanitary installations could reasonably be used as a way of measuring the flow rate of water. In my view, the applied-for goods are encompassed by the opponent's *'equipment and apparatus for […] measuring […] flow rate quantities of water in water conduit installations, containers and sanitary installations'*. They are, therefore, identical under *Meric*.

'Valve position indicators; all relating directly or indirectly to water supply and sanitary installations; none of the aforementioned goods being filters'

38. It is my understanding that valve position indicators, particularly in the context of water supply, are used to measure the flow of water. These goods, therefore, fall within the scope of the opponent's *'equipment and apparatus for […] measuring […] flow rate quantities of water in water conduit installations, containers and sanitary installations'*. They are identical under *Meric*.

'Apparatus and instruments for […] detecting […] gases; all relating directly or indirectly to water supply and sanitary installations; none of the aforementioned goods being filters'

39. The goods above include sensors, whereas the opponent's *'sensors for […] leak monitoring'* would be for, *inter alia*, gas leaks. As such, it is my view that these goods are encompassed by one another, rendering them identical in accordance with *Meric*.

'Solenoids; all relating directly or indirectly to water supply and sanitary installations; none of the aforementioned goods being filters'

40. In the context of the positive limitation, it is my impression that this term is likely to be referring to valves which enable a water supply to be turned on or off in response to a signal. To my mind, they would be encompassed within the opponent's *'equipment and apparatus for […] controlling and regulating pressure […] and flow rate quantities of water in water conduit installations, containers and sanitary installations'*. As such, the respective goods are identical in accordance with *Meric*.

'Electric cable and wire; protection devices for electric circuits; all relating directly or indirectly to water supply and sanitary installations; none of the aforementioned goods being filters'

41. The opponent has protection for component parts for all the goods in class 9 of the first earlier mark by virtue of its term *'component parts for all the aforesaid goods'*. To my mind, these goods of the application could reasonably comprise component

parts for many of the opponent's goods, such as, for example, *'[…] electronic […] equipment, apparatus and installations composed thereof for monitoring, controlling and regulating water supply and drainage, treatment, availability, distribution, removal and heating of drinking and commercial water'*. Accordingly, they are identical under the principle outlined in *Meric*.

'Parts and fittings for the aforesaid goods'

42. Given that I have found all the parties' goods hitherto considered to be identical, it follows that the parts and fittings for those goods of the application are identical to the opponent's *'component parts for […]'* those goods of the first earlier mark on the same basis.

'Apparatus and instruments for controlling […] gases; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; all relating directly or indirectly to water supply and sanitary installations; parts and fittings for the aforesaid goods; none of the aforementioned goods being filters'

43. In my view, although these goods relate to water supply and sanitary installations, they are not identical to any of the goods of the first earlier mark. I note that the opponent has not filed any evidence to demonstrate which goods of the first earlier mark it considers them to be identical to. Neither has it filed any explanation in this regard. In the absence of any such evidence or submissions, I am not satisfied that they are identical to any of the opponent's goods.

Conclusion

44. As a result of my findings above, the opponent's claim under 5(1) of the Act succeeds in relation to the following goods:

> Class 9: Apparatus and instruments for controlling and detecting liquids; apparatus and instruments for detecting gases; remote control mechanisms and devices; thermostats; thermometers; apparatus for thermostatically controlling the mixture of fluids; electric and electronic flow control systems;

apparatus for indicating and recording the flow of fluids; temperature sensors and scanners; water temperature regulators; temperature display units; valve position indicators; liquid level indicators; electric and electronic timing devices; timed flow controls; infra-red detection units; solenoids; batteries; electric cable and wire; protection devices for electric circuits; all relating directly or indirectly to water supply and sanitary installations; parts and fittings for the aforesaid goods; none of the aforementioned goods being filters.

45. The opponent's claim under this ground fails in respect of the following goods, which are not identical to those of the first earlier mark:

Class 9: Apparatus and instruments for controlling gases; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; all relating directly or indirectly to water supply and sanitary installations; parts and fittings for the aforesaid goods; none of the aforementioned goods being filters.

Section 5(2)(a)

The law

46. Sections 5(2)(a) and 5A of the Act read as follows:

"5(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, […]

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

"5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the

trade mark is applied for, the application is to be refused in relation to those goods and services only."

47. 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:

(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.

Identity of the marks

48. I have already found that the competing marks are identical.

Comparison of goods

49. In *Canon,* the CJEU stated at paragraph 23 of its judgment that:

"In assessing the similarity of the goods or services concerned, […] all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended

purpose and their method of use and whether they are in competition with each other or are complementary".

50. The relevant factors identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 for assessing similarity were:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

51. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM,* Case T-325/06, the GC stated that "complementary" means:

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

52. In light of my finding at paragraphs 44 and 45, the goods to be compared under this ground are as follows:

Opponent's goods	Applicant's goods
Class 9: Electrotechnical, electronic, optoelectronic and acoustic equipment, apparatus and installations composed thereof for monitoring, controlling and regulating water supply and drainage, treatment, availability, distribution, removal and heating of drinking and commercial water; equipment and apparatus for monitoring, measuring, controlling and regulating pressure, temperature and flow rate quantities of water in water conduit installations, containers and sanitary installations; temperature controlling apparatus, thermostat components and kits for cold and hot water mixing valves, thermostat fittings and batteries, parts and accessories for the aforesaid goods (included in class 9); mobile apps for operating toilets, water taps; electronic devices for monitoring and transmitting health data; mobile apps for health monitoring, sensors for moisture, flooding, leak monitoring, water control and water quality; sprinklers; component parts for all the aforesaid goods.	Class 9: Apparatus and instruments for controlling gases; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; all relating directly or indirectly to water supply and sanitary installations; parts and fittings for the aforesaid goods; none of the aforementioned goods being filters. Class 11: Apparatus and installations for water supply and sanitary purposes; showers, spray fittings, shower heads, shower handsets, shower hoses; water mixing appliances and water taps for use in showers; shower baths; booths, cabins, enclosures, cabinets, cubicles, screens and trays for showers; thermostatic mixing valves; parts and fittings for the aforesaid goods; none of the aforementioned goods being filters or for use in central heating apparatus.

Class 9

'Apparatus and instruments for controlling gases; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; all relating directly or indirectly to water supply and sanitary installations; parts and fittings for the aforesaid goods; none of the aforementioned goods being filters'

53. The above goods and the opponent's *'electrotechnical, electronic, optoelectronic and acoustic equipment, apparatus and installations composed thereof for monitoring, controlling and regulating water supply and drainage, treatment, availability, distribution, removal and heating of drinking and commercial water'* have a different nature, intended purpose and method of use. However, the respective goods are specialist in nature and all relate to the supply of water and sanitary installations. On this basis, it is likely that they will reach the market through shared trade channels. Moreover, the respective goods may share users. There is no competition between them. Nevertheless, the applicant's goods could be used to control, for example, the electricity and gas which powers the opponent's water-heating goods. In my view, given that consumers are likely to assume that responsibility for the goods lies with the same undertaking, I consider this relationship to be sufficiently proximate to give rise to a degree of complementarity. Overall, I find that there is a low degree of similarity between the respective goods.

Class 11

'Apparatus and installations for water supply and sanitary purposes; none of the aforementioned goods being filters or for use in central heating apparatus'

54. Whilst the above term and *'equipment and apparatus for monitoring, measuring, controlling and regulating pressure, temperature and flow rate quantities of water in water conduit installations, containers and sanitary installations'* in class 9 of the first earlier mark may have a different nature and method of use, they overlap in that they are both likely to be used in the supply of water or for sanitary purposes. The respective goods are likely to reach the market through shared trade channels and may be provided by the same undertakings. Users are also likely to overlap. I do not

consider the respective goods to be indispensable or important to one another in such a way that customers may think that responsibility for them lies with the same undertaking. As such, they are not complementary. Since they are not interchangeable, neither is there any meaningful competition between them. Taking all of this into account, I find that the respective goods are similar to a medium degree.

'Thermostatic mixing valves; none of the aforementioned goods being filters or for use in central heating apparatus'

55. Whilst the nature and method of use of the above goods may differ from that of *'temperature controlling apparatus, thermostat components and kits for cold and hot water mixing valves'* in class 9 of the earlier mark, it is my view that they have an overlapping purpose; the respective goods can both be used for controlling the temperature of water. The respective goods are likely to reach the market through the same trade channels and may be provided by the same undertakings. They may also share users. Although the respective goods may be used together, I do not consider that sufficient for a finding of complementarity in accordance with the case law. Whilst there is an overlapping purpose, the respective goods are not interchangeable and, therefore, there is no competition between them. Overall, I find that there is a medium degree of similarity between the respective goods.

'Showers; water mixing appliances and water taps for use in showers; spray fittings, shower heads, shower handsets, shower hoses; shower baths; booths, cabins, enclosures, cabinets, cubicles, screens and trays for showers; none of the aforementioned goods being filters or for use in central heating apparatus'

56. In my view, the applied-for goods above have a different nature, method of use and intended purpose when compared with the opponent's *'temperature controlling apparatus, thermostat components and kits for cold and hot water mixing valves'*. However, there is nothing which indicates that the opponent's goods cannot be used for the same installations or in the same domestic settings. Moreover, the respective goods are specialised and target the same users. They are also likely to share trade channels and may be provided by the same undertakings. There is no competition between the respective goods. In addition, they are not important or indispensable to

one another in such a way that consumers may assume that responsibility for them lies with the same undertaking. In light of all this, I find that there is a low degree of similarity between the respective goods.

'Parts and fittings for the aforesaid goods'

57. I have found the parties' goods to be similar to at least a low degree. For the same reasons, it is considered that the parts and fittings for those goods of the application will share the same degree of similarity with the opponent's *'component parts for […]'* those goods of the first earlier mark.

The average consumer and the nature of the purchasing act

58. The average consumer is deemed to be reasonably well informed, observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.[8]

59. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

[8] *Lloyd Schuhfabrik Meyer,* Case C-342/97

60. In line with my approach to the comparison of the parties' goods, my assessment below will focus upon the average consumer of those for which I have found some level of similarity.

61. Although the goods at issue are available to the general public, it is my view that relevant consumers will also include professionals, such as members of the plumbing trade.

62. The goods are likely to be occasional purchases for the general public, whereas they will be purchased more regularly by professionals for ongoing use in the course of their trade. The cost of the goods is likely to vary considerably. The purchasing of the goods is unlikely to be merely casual for either group of relevant consumers. The general public will consider factors such as functionality, price, aesthetics and compatibility with other items when selecting the goods. Professionals will also have regard to these factors; in addition, such consumers will be alive to the potentially negative impact of selecting the wrong product on their business and the consequences it may have for their customers. In light of all this, although the attentiveness exhibited may vary depending on the particular product being purchased, overall, I find that both groups of relevant consumers will demonstrate between a medium and high (but not the highest) level of attention during the purchasing process. The goods are likely to be purchased from retailers and trade outlets, or their online equivalents, after viewing information on shelves, in brochures or on webpages. In these circumstances, visual considerations are likely to dominate. However, I do not discount aural considerations entirely; in this regard, it is possible that consumers will receive word of mouth recommendations or wish to discuss products of this nature prior to making their selection.

Distinctive character of the earlier mark

63. In *Lloyd Schuhfabrik Meyer*, 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 *WindsurfingChiemsee* 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 *WindsurfingChiemsee*, paragraph 51)."

64. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods will be somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

65. Although the distinctiveness of a mark may be enhanced as a result of it having been used in the market, the opponent has filed no evidence of use of the first earlier mark; accordingly, I have only the inherent position to consider.

66. The first earlier mark is in word-only format and consists of the word 'Sense'. As it is the only element in the mark, the distinctive character lies in the word itself. The word has a number of dictionary meanings, such as a faculty by which the body perceives external stimuli, to have a feeling that something is the case, or to detect or

measure. Regardless of which meaning is attributed to the word, I find that the first earlier mark possesses a medium level of inherent distinctive character.

Likelihood of confusion

67. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

68. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related.

69. Earlier in this decision, I concluded that:

- The competing trade marks are identical;

- The parties' goods are similar to at least a low degree;

- Relevant consumers of the goods at issue are likely to include members of the general public and trade professionals, both displaying between a medium and high level of attention during the purchasing process;

- The purchasing process will be predominantly visual in nature, though aural considerations have not been excluded;

- The first earlier mark enjoys a medium level of inherent distinctive character.

70. In consideration of all the above factors, I find that there is a likelihood of direct confusion. I acknowledge that both groups of relevant consumers will demonstrate an above average level of attentiveness when selecting the goods. However, taking into account the principles of interdependency and imperfect recollection, it is my view that the identity of the competing marks and the distinctive character of the first earlier mark will result in consumers mistaking one mark for the other, even in relation to goods which are only similar to a low degree.

Conclusion

71. The opponent's claim under section 5(2)(a) of the Act succeeds in relation to the following goods:

> Class 9: Apparatus and instruments for controlling gases; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; all relating directly or indirectly to water supply and sanitary installations; parts and fittings for the aforesaid goods; none of the aforementioned goods being filters.
>
> Class 11: Apparatus and installations for water supply and sanitary purposes; showers, spray fittings, shower heads, shower handsets, shower hoses; water mixing appliances and water taps for use in showers; shower baths; booths, cabins, enclosures, cabinets, cubicles, screens and trays for showers; thermostatic mixing valves; parts and fittings for the aforesaid goods; none of the aforementioned goods being filters or for use in central heating apparatus.

Section 5(2)(b)

The law

72. Sections 5(2)(b) and 5A of the Act read 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."
>
> "5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

73. The case law principles outlined at paragraph 47 are also equally applicable under this ground.

My approach

74. As noted above, to support its claim under this ground of opposition the opponent relies upon the second earlier mark, which is subject to the proof of use provisions. I also note that Dr Speck's evidence goes to this issue. However, for reasons that will become apparent, I will proceed on the basis that the opponent has satisfied the genuine use requirement for all the goods relied upon, only returning to consider it if it becomes necessary to do so.

75. Furthermore, some of the applied-for goods, such as, for example, *'showers'*, are clearly identical to the goods of the second earlier mark. Therefore, I will proceed on the basis that all the parties' goods at issue under this ground are identical. If the opposition fails, even where the goods are identical, it follows that the opposition will also fail where the goods are only similar.

76. Finally, whilst I recognise that the goods to be considered under this ground are different to those considered under section 5(2)(a), I do not consider that the differing goods will have any material effect on my assessment of the average consumer. For this reason, I also adopt my findings at paragraphs 61 and 62 under this ground.

Distinctive character of the earlier mark

77. The second earlier mark is in word-only format and comprises the word 'Essence'. As there are no other elements in the mark, its distinctive character rests in the word itself. The word 'Essence' is a dictionary defined word, meaning the basic or most important idea or quality of something, or an extract or concentrate used for flavouring or scent. It has no descriptive or allusive qualities in relation to the goods relied upon, but it is not an unusual or uncommon word. Overall, I find that the second earlier mark possesses a medium level of inherent distinctive character.

78. Evidence has been filed by the opponent and I am now required to assess whether it has demonstrated that, at the relevant date of 8 November 2016, the second earlier mark had an enhanced level of distinctive character.

79. Dr Speck says that the second earlier mark was used throughout the five-year period preceding the relevant date in relation to the opponent's kitchen and bathroom taps.[9] He provides examples of such products' packaging and product labels.[10] Both feature images of taps and the word 'Essence'/'ESSENCE' in normal font. The

[9] Witness statement of Philip Speck, §2
[10] Exhibit PS1

packaging artwork also features the words 'GROHE ESSENCE' on a blue background, which I consider to be use of the second earlier mark as registered.[11]

80. Example price lists for the opponent's products, distributed between 2011 and 2016 in Germany, Austria, Italy, Spain and the UK, are also in evidence.[12] The word 'Essence' in normal font is used in relation to a range of taps throughout the price lists.

81. Dr Speck provides the following turnover figures for 'Essence' branded products sold within the EU:[13]

Year	Turnover (€)
2012	897,877
2013	693,918
2014	617,107
2015	728,268
2016	979,352
Total	3,916,522

82. Invoices from between 2012 and 2017 have been exhibited.[14] Whilst those from 2017 do not assist the opponent, the remaining invoices demonstrate the sale of 'Essence' branded taps to customers prior to the relevant date. Most of the invoices were sent to customers in Germany, though there are (very limited) examples of customers in Luxembourg and the UK.

83. Finally, Dr Speck provides printouts of the opponent's website and a promotional brochure as examples of marketing materials.[15] The website and brochure both feature word 'Essence'/'ESSENCE' in normal font, used in relation to the opponent's

[11] This is because use of a mark encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark: *Colloseum Holdings AG v Levi Strauss & Co.,* Case C-12/12
[12] Exhibit PS2
[13] Speck, §7
[14] Exhibit PS3
[15] Exhibit PS4

range of taps. Dr Speck says the printouts of the website are from 2016, whilst the brochure is from August 2015.[16]

84. Clearly, the opponent used the second earlier mark before the relevant date. This is evident from the product packaging and artwork, price lists, unchallenged turnover figures, invoices, printouts of the opponent's website, and brochure. However, the turnover figures provided relate to the whole of the EU, and no indication is given as to what proportion of the same accrued from business in the UK. The other evidence relating to the UK is extremely limited. Whilst price lists are said to have been distributed in the UK prior to the relevant date, there is no detail as to how many price lists were sent in this territory, or to whom. Moreover, there is a single invoice relating to the sale of 'Essence' branded products to customers in the UK. This shows one product being sold for a total value of £71.76. Although I accept that the invoices in evidence may not be exhaustive, the invoice (together with the fact that the vast majority of the others relate to Germany) suggests that the opponent's business in the UK likely accounted for an extremely small proportion of its overall EU turnover. Furthermore, whilst I accept that a website featuring the second earlier mark was in operation, as well as Dr Speck's narrative evidence that this was the case in 2016, it is not entirely clear whether the website targeted UK consumers. In any event, there is a distinct lack of detail as to how many internet users in the UK accessed the website prior to the relevant date, or, indeed, whether any business was generated in this territory through the same. The brochure has the same limitations as the price lists, i.e. there is no evidence of how many of the brochures were circulated for marketing purposes or where in the UK (if at all) they were distributed. Taking all of this into account, the evidence falls a long way short of sufficiently demonstrating that the average UK consumer has been exposed to the second earlier mark. It is my view that it does not support a finding that the distinctiveness of the second earlier mark has been enhanced above its inherent characteristics through use in the UK (the use in the EU not counting towards enhanced distinctiveness acquired through use of the mark in the UK).

[16] Speck, §6

Comparison of trade marks

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

> "[…] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

86. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

87. The competing trade marks are as follows:

The second earlier mark	The contested mark
Essence	SENSE

Overall impressions

88. The competing marks are in word-only format and consist of the words ‘Essence’ and ‘SENSE’. As these words are the only elements of the marks, they dominate their respective overall impressions.

Visual comparison

89. The competing marks are visually similar in that they share four letters in the same order, i.e. ‘SEN’ and ‘E’. For reasons outlined previously, the difference created by the varying letter case is not significant. The competing marks are visually different as the second earlier mark begins with two letters, i.e. ‘Es’, which have no counterparts in the contested mark. This difference appears at the beginning of the marks, a position which is generally considered to have more impact.[17] These additional letters also render the competing marks different in length. Finally, the competing marks differ in that an ‘S’ appears in the contested mark in place of the ‘C’ in the second earlier mark. Bearing in mind my assessment of the overall impressions, I find that there is a medium degree of visual similarity between the competing marks.

Aural comparison

90. The competing marks are both dictionary words which will be pronounced in the ordinary way. They differ in that the second earlier mark has an additional “E” sound at its beginning. Moreover, the letter ‘E’ within the string ‘SEN’ will be articulated as a short vowel in the second earlier mark, but longer in the contested mark. However, overall, the competing marks are aurally similar to between a medium and high degree.

Conceptual comparison

91. The second earlier mark comprises a dictionary defined word, which will convey the concept of the basic or most important idea or quality of something, or an extract

[17] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

or concentrate used for flavouring or scent. The contested mark also consists of a dictionary word, which has a number of meanings. For instance, it may convey the concept of a faculty by which the body perceives external stimuli, to have a feeling that something is the case, or detecting or measuring. Irrespective of which specific meaning(s) the average consumer attributes to the competing marks, they convey different concepts which do not overlap; the competing marks are conceptually dissimilar.

Likelihood of confusion

92. The principles set out at paragraphs 67 and 68 are equally applicable under this ground.

93. Earlier in this decision, having proceeded on the basis that the parties' goods are identical, I further concluded that:

- Relevant consumers of the goods at issue are likely to include members of the general public and trade professionals, both displaying between a medium and high level of attention during the purchasing process;

- The purchasing process will be predominantly visual in nature, though aural considerations have not been discounted;

- The second earlier mark possesses a medium level of inherent distinctive character, which has not been enhanced through use;

- The overall impressions of the competing marks are dominated by the words 'Essence' and 'SENSE', respectively;

- The competing marks are visually similar to medium degree, aurally similar to between a medium and high degree, and conceptually dissimilar.

94. I acknowledge that the competing marks share four letters, and that they appear in the same order. Nevertheless, there are differences between the marks which are not negligible. The second earlier mark contains two additional letters at its beginning. As I have already outlined, this position tends to have most impact. As such, I consider it highly unlikely that consumers will overlook the difference the additional letters create. Moreover, where the meaning of at least one of the two marks at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those marks may counteract the visual and phonetic similarities between them.[18] Although I accept that conceptual differences do not always overcome visual and aural similarities, I certainly consider that to be the case here. Whilst the competing marks share visual and aural similarities, they are conceptually dissimilar. Each mark is an ordinary dictionary word which conveys meanings not replicated by the other. To my mind, given the distinct meanings, it is extremely unlikely that the average consumer will mistake one mark for the other. Rather, taking all the above factors into account, it is my view that the aforementioned differences are likely to be sufficient for the average consumer – even when paying no more than a medium level of attention – to distinguish between them. Accordingly, notwithstanding the principles of imperfect recollection and interdependency, it follows that there will be no direct confusion, even in relation to identical goods.

95. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms,

[18] *The Picasso Estate v OHIM*, Case C-361/04 P, paragraph 20

is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

96. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.[19] I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.[20] The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a “proper basis” for finding indirect confusion.[21]

[19] *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207
[20] *Duebros Limited v Heirler Cenovis GmbH,* Case BL O/547/17
[21] *Liverpool Gin Distillery*

97. Having regard to all the above principles, I do not believe that the average consumer, having noticed the differences between the competing marks, will assume that the opponent and the applicant are economically linked undertakings on the basis of the competing trade marks. I am unconvinced that the average consumer would assume a commercial association or licencing arrangement between the parties, or sponsorship on the part of the opponent, merely because of the shared letters 'SEN' and 'E'. This part of the second earlier mark is not so strikingly distinctive that consumers would assume that only the opponent would be using it in a trade mark. In any event, consumers would not dissect the second earlier mark and separate this string from the mark as a whole. This would involve a level of analysis not typically conducted by consumers upon immediate perception of trade marks. Moreover, the differences between the competing marks are not simply adding or removing non-distinctive elements. Nor are the differences consistent with any logical brand extensions with which consumers would be familiar. I can see no reason why an undertaking would dissect the dictionary word 'Essence' (which forms a singular word with clear, recognisable meanings) by removing two letters and altering another, resulting in an entirely different dictionary word (which also forms a singular word with clear, recognisable meanings). Whilst indirect confusion is not limited to the categories outlined in *L.A. Sugar*, to my mind, there is no other basis for concluding that the average consumer would assume an economic connection between the parties, even when consumers are paying no more than a medium level of attention. I should add that, whilst I do not ignore the fact that the opponent has a registration for the words 'Sense' and 'Essence', this is not a factor which I can take into account or something that relevant consumers would know. Taking all of the above factors into account, I do not consider there to be a likelihood of indirect confusion between the competing marks, even in relation to goods that are identical.

Conclusion

98. The opponent's claim under section 5(2)(b) fails.

Honest concurrent use

99. Although honest concurrent use has not been specifically pleaded as a defence by the applicant, I will deal with it for the sake of completeness. I may do so briefly.

100. It is settled law that a long period of honest concurrent use may defeat a claim of confusion.[22] However, circumstances that give rise to this defence must be exceptional.[23] For a defence of honest concurrent use to succeed, I would need to be satisfied that the parties have traded in circumstances where the relevant public has been exposed to both marks and has been able to differentiate between them without confusion as to the trade origin of the goods. Whilst I note that the applicant has filed evidence of the contested mark being used (in conjunction with its 'RADA' mark), the opponent has filed no evidence of use of the first earlier mark, the basis of its successful claims. As such, there is no evidence that the relevant public has been exposed to the first earlier mark and the contested mark, or that the marks have ever come into conflict. Whilst evidence of use of the second earlier mark has been filed by the opponent, I have concluded that there is no likelihood of confusion between it and the contested mark. Consequently, the defence of honest concurrent use would not have assisted the applicant had it been pleaded.

Overall outcome

101. Whilst the opposition under section 5(2)(b) of the Act has failed, the opposition under sections 5(1) and 5(2)(a) has been successful. Subject to any appeal against my decision, the contested mark will be refused.

Costs

102. As the opponent has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the

[22] *Budejovicky Budvar NP v Anheuser-Busch Inc*, Case C-482/09, and *Victoria Plum Ltd v Victorian Plumbing Ltd* [2016] EWHC 2911 (Ch)
[23] *Budejovicky Budvar*

circumstances, I award the opponent the sum of **£800**, which has been calculated as follows:

Preparing a statement and considering the applicant's counterstatement	£200
Preparing evidence and considering the applicant's evidence	£500
Official fee	£100
Total	**£800**

103. I order Kohler Mira Limited to pay Grohe AG the sum of **£800**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 8th day of September 2023

James Hopkins
For the Registrar