

O-109-20

**TRADE MARKS ACT 1994**  
**IN THE MATTER OF**  
**TRADE MARK APPLICATION NO. 3356503**  
**BY SEALED AIR CORPORATION (US)**  
**TO REGISTER**

**SEE**

**AS A TRADE MARK IN CLASSES 1,7,9,16,17,22,42**

**AND**

**OPPOSITION THERETO**  
**UNDER NO. 415867**  
**BY INFORMATIQUE GRAPHISME ENERGETIQUE - I.G.E.**

## Background and pleadings

1. On 27 November 2018, Sealed Air Corporation (US) (“the applicant”) applied to register the trade mark shown below under number 3356503:

SEE

2. The application was published for opposition purposes on 25 January 2019. Registration is sought for a range of goods and services in Classes 1, 7, 9, 16, 17, 22 and 42.

3. Informatique Graphisme Energetique - I.G.E. (“the opponent”) filed a notice of opposition on 25 March 2019 on the basis of sections 5(1), 5(2)(a), 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The section 5(4)(a) claim was later dropped. The opposition is directed against the goods and services in Classes 9 and 42. Those classes have been subject to amendment and now reads as follows:

*Class 9 Hardware for monitoring, reporting, controlling, and training systems, consisting of digital cameras, video monitors to store and transmit data and images to monitor and measure package manufacturing and packaging operational processes; automated process control system comprised of micro-processor based hardware used to monitor, analyze, and control packaging equipment.*

*Class 42 Developing hardware systems to monitor, measure, control, report, and train in connection with package manufacturing and packaging operational processes; consulting services in the field of automated process control and monitoring of package manufacturing and safety compliance, and packaging in connection with manufacturing, packaging, and other packaging operational processes.*

4. The opponent relies upon the following International Registration (“IR”), protected in the European Union, along with all of the goods and services for which it is protected:

**Mark:**

**SEE**

**IR registration no.** 1224093

**International registration and designation date:** 25 August 2014

**Date protection granted in EU:** 29 September 2015

**Goods and Services:**

<i>Class 9</i>	<i>Data processing apparatus, computers, recorded software.</i>
<i>Class 41</i>	<i>Training service; software release.</i>
<i>Class 42</i>	<i>Software design, installation and maintenance services, computer programming; computer programming services; services provided by a computer engineer; technical consultancy services provided to companies in the field of information technology, computer programming and implementation of information technology solutions.</i>

5. The applicant filed a counterstatement denying the grounds of opposition.

6. The opponent is represented by Mathys & Squire LLP and the applicant is represented by J A Kemp LLP. Both parties filed written submissions in lieu of a hearing. I make this decision after a careful reading of all the papers filed by the parties.

## **DECISION**

### **Sections 5(1), 5(2)(a) and 5(2)(b)**

7. The opposition is based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Act, which 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.

(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) 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 of the part of the public, which includes the likelihood of association with the earlier trade mark”.

8. An earlier trade mark is defined in s. 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered”.

9. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its protection process in the EU more than five years before the application date of the opposed application, it is not subject to the proof of use provisions under section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods and services it has identified.

## Section 5(2)(b) – case law

10. The following principles are gleaned from the judgments 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 C3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L.Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) The matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) The average consumer normally perceives the mark as a whole and does not proceed to analyse its various details;
- (d) The visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) Nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

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

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of marks**

11. The application is for the word “SEE” presented in capital letters. The opponent’s mark consists of the word “SEE” presented in slightly stylised capital letters. In its written submissions, the applicant argues that the marks are highly similar. However, in its counterstatement (paragraph 4), the applicant concedes that both marks are identical. Having made such a concession, the applicant cannot resile from its position. In any event, both marks consist of the word “SEE” and, as the contested mark is a word mark which may be used in any ordinary typeface, they are identical.

## Comparison of goods and services

12. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

13. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the Treat case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

14. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes

of the trade”.<sup>1</sup> I must also bear in mind the comments of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

15. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

16. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), 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”.

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<sup>1</sup> See *British Sugar*.

17. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“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”.

18. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C., sitting as the Appointed Person, noted in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes”,

whilst on the other hand:

“[...] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together”.

19. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

### **Class 9 of the contested application**

Hardware for monitoring, reporting, controlling, and training systems, consisting of digital cameras, video monitors to store and transmit data and images to monitor and measure package manufacturing and packaging operational processes.

20. In its written submissions, the applicant states:

“The goods of the Applicant are digital cameras, video monitors and monitoring hardware used in relation to package manufacturing and packaging operation processes. These goods are highly specialised goods directed at a professional public within a specific industry, i.e. packaging industry. These are different from the Opponent’s data processing apparatus, computers, recorded software.”<sup>2</sup>

21. The opponent submits:

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<sup>2</sup> See the applicant’s written submissions, page 2.

“This term falls within the scope of the Opponent’s registered goods “data processing apparatus” and “computers” and is therefore, identical or at least highly similar.”<sup>3</sup>

22. “Computer” is defined in the *Collins English Dictionary* as “an electronic machine that can store and deal with large amounts of information.”<sup>4</sup>

23. I struggle to see how the competing goods are identical. Whilst the opponent’s goods store or process data, a normal understanding of a digital camera/video monitor in the applicant’s specification is that it captures images or videos. As a result of which, the average consumer would not describe a digital camera/video monitor as a computer. Therefore, I do not consider that the opponent’s specification encompasses the applicant’s goods; the goods are not identical.

24. The applicant states:

“The Applicant’s goods have clearly a different nature, purpose and method of use from the Opponent’s. Furthermore, the Opponent’s goods target the general public. Since the relevant publics are different and the Applicant’s goods are so specific, they would not be sold through the same distribution channels. They also cannot be complementary (Judgement of 11 May 2011, T-74/10, Flaco, EU:T:2011:207, paragraph 40). Furthermore, they would not originate from the same undertakings. Therefore, they should be deemed dissimilar.

According to the case-law of the European Court of Justice, acknowledging similarity between the opponent’s broad terms such as “computers” and the applicant’s goods would exceed the scope of protection granted by the law. It would not be legitimate to refuse the application where the applicant’s goods are highly specialised goods of use by a professional public within a specific

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<sup>3</sup> See the opponent’s written submissions, page 3.

<sup>4</sup> <https://www.collinsdictionary.com/dictionary/english/computer> [accessed 17 February 2020].

sector i.e. the packaging industry and the earlier registration makes no reference to any activity in that sector.”<sup>5</sup>

25. I find that the competing goods are different in purpose as the applicant’s goods capture images and videos while the opponent’s goods store or process data. Their nature and method of use will also differ from that of the opponent’s goods. I concur with the applicant that the users may overlap so far as the professional public is concerned. Further, while the competing goods are not competitive, there does appear to be a complementary relationship in play. In this regard, I note the applicant’s argument that a certain link between the competing goods can be found as computers in different forms may be necessary for the opponent’s goods. I also bear in mind the applicant’s submission that the reasoning of the General Court (“GC”) in *Les Editions Albert René v Office for Harmonization in the Internal Market (“Mobilix”) (Trade Marks and Designs) (OHIM)* should apply in the present instance by analogy. The court at paragraph 61 of the judgment stated:

“The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

26. As I understand it, digital cameras and video monitors in the applicant’s specification may be connected to a computer to monitor or measure the images or data. Therefore, in my view, this is not a comparison between component parts and finished products but concerns separate goods which may be used together. The link between the competing goods therefore creates a complementary relationship in the sense that one is important for the use of the other and the average consumers may expect that the goods originate from the same undertaking. Considering these factors, I find that the competing goods are similar to a low degree.

Automated process control system comprised of micro-processor based hardware used to monitor, analyze, and control packaging equipment.

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<sup>5</sup> See the applicant’s written submissions, pages 3 and 5.

27. The opponent in its submissions contends that the applicant's specification is covered by the opponent's goods "data processing apparatus" and "computers" and the goods are therefore identical. The opponent further argues that the applicant's specification will, by definition, comprise hardware and software and therefore is identical to "recorded software" covered by the earlier registration and similar and/or complementary to the opponent's "software design, installation and maintenance services, computer programming; computer programming services" in Class 42.

28. For its part, the applicant states that its goods are very specific and that it would not be legitimate to refuse its application on the basis of a similarity (or identity) with broad terms such as data processing apparatus, computers or recorded software.

29. The *Collins English Dictionary* defines "*automation*" as "*the use of methods for controlling industrial processes automatically, esp by electronically controlled systems, often reducing manpower*".<sup>6</sup> As I understand it, in automation, various control systems are used to operate equipment automatically and an automated process control system can range from thermostats to aircraft applications. The applicant's product is an automated microprocessor-based control system used in the packaging process. In the ordinary and natural meaning, it is unlikely that the average consumer would refer to a computer as an automated process control system. Accordingly, to my mind, there is no self-evident reason why the competing goods should be considered identical. Given that a computer may be used to monitor or control equipment, it may very well be used with the applicant's goods to monitor, analyze, and control packaging equipment. Certainly, there is no evidence before me that this would not be the case. In those circumstances, I find that the competing goods are complementary in the sense indicated in the case law and I conclude that the respective goods share a low level of similarity.

30. I do not consider it necessary to compare the opponent's "*data processing equipment*" and "*recorded software*" in Class 9 or the services in Class 42 with the

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<sup>6</sup><https://www.collinsdictionary.com/dictionary/english/automation> [accessed 17 February 2020].

contested goods, as it will not place the opponent in a better position in these proceedings.

### **Class 42 of the contested application**

Developing hardware systems to monitor, measure, control, report, and train in connection with package manufacturing and packaging operational processes

31. The opponent submits:

“The term developing hardware systems to monitor, measure, control, report, and train in connection with package manufacturing and packaging operational processes falls within the remit of the services provided by a computer engineer protected by the opponent’s earlier registration in class 42; indeed, the two major specialities of a computer engineer are computer software engineering and computer hardware engineering, the latter including services such as development of hardware systems, which covers the said contested term and is therefore identical thereto.”<sup>7</sup>

32. The applicant states:

“The Applicant submits that whilst computer engineers may develop hardware systems, they would only do so in relation to computer systems. The applicant’s services are provided in connection with hardware that would most likely require the services of a mechanical or electronics engineer who would be working with circuits, switchboards and other electronic configurations with a specific knowledge of the packaging industry. The services provided would be different insofar as they relate to goods of different nature, purpose, method of use and would target a different public. Therefore, the services cannot be held similar, still less identical.”<sup>8</sup>

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<sup>7</sup> See the opponent’s written submissions, page 4.

<sup>8</sup> See the applicant’s written submission, page 7.

33. It is not obvious to me, nor is there any evidence that, the applicant's services are solely offered by an electronics/mechanical engineer. As I understand it, the term "hardware" also refers to the physical components of a computer and I see no reason why the term "hardware" in the applicant's specification would not include computer hardware systems used for the purposes described in the applicant's specification. As developing computer hardware systems is, as agreed by the applicant, a service offered by a computer engineer, I find that the competing services are identical by the application of the *Meric* principle.

Consulting services in the field of automated process control and monitoring of package manufacturing and safety compliance, and packaging in connection with manufacturing, packaging, and other packaging operational processes.

34. The opponent submits:

"The term "consulting services in the field of automated process control and monitoring of package manufacturing and safety compliance, and packaging in connection with manufacturing, packaging, and other packaging operational processes" is covered by the terms "technical consultancy services provided to companies in the field of information technology, computer programming and implementation of information technology solutions" and "services provided by a computer engineer", protected by the earlier registration in class 42".<sup>9</sup>

35. The applicant argues:

"The opponent's services are provided in the field of information technology i.e. computer-based information systems and consist of ensuring that computers and computer networks of a business are optimised and functioning properly. The applicant's services are for industrial use and provided in connection with package manufacturing and operational process. The nature and purpose of these services are different. They are not complementary nor in competition.

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<sup>9</sup> See the opponent's written submissions, page 2.

They also do not target the same public and are not provided by the same undertakings. Therefore, they cannot be held similar, still less identical.”<sup>10</sup>

36. The applicant’s services are concerned with providing advice and information in the particular field of automation and monitoring systems used in the packaging process. These do not strike me as computer services per se, but services concerned with industrial processes. However, even though their nature, purpose and method of use are different, the users may overlap so far as the professional users are concerned. Further, it seems to me likely that a consultancy service such as that offered by the applicant will be dependent to a degree on the services of a computer engineer in order to build the resulting automated process control and monitoring systems. The advice strikes me as being of a particular technical nature and, with this in mind, I consider that there is a degree of complementarity which will result in a low degree of similarity overall.

#### **The average consumer and the nature of the purchasing act**

37. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services. I must then determine the manner in which these goods and services are likely to be selected by the average consumer.

38. 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

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<sup>10</sup> See the applicant’s written submissions, page 7.

“average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.

39. I will focus on the goods and services I have found to be similar. Even though the average consumer of the opponent’s goods and services includes both the general public and business users, the goods and services in the applied-for mark’s specification are related to industrial processes and the average consumer for these services is a business user. The goods and services will be selected primarily by visual means, after research conducted on websites, from brochures, catalogues, or through an official procurement process involving tender. There may also be an aural aspect to the purchase if advice is sought from sales representatives or other businesses. Although the public buying the opponent’s goods and services may pay only a medium degree of attention, the professional user of the goods and services at issue is likely to pay attention to details such as the business needs, the technological interface, the functionalities, or costs which, in my view, are likely to be important business decisions. Therefore, the level of attention paid will be fairly high by business users.

#### **Distinctiveness of the earlier mark**

40. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

41. As the opponent filed no evidence, I have only the inherent position to consider. The earlier mark is made up of the word “SEE” presented in capital letters. Although the mark is slightly stylised, the typeface appears ordinary and does not add to the distinctive character of the mark. The mark has no suggestive or evocative qualities in relation to the opponent's goods and services. I conclude that, as a whole, the earlier mark has a medium degree of distinctive character.

### **Conclusions in relation to Section 5(1)**

42. In order to succeed under section 5(1) of the Act, the trade marks, and goods and services must be identical. The applicant accepts that the competing trade marks are identical. Having concluded that services for *developing hardware systems to monitor, measure, control, report, and train in connection with package manufacturing and packaging operation processes* in Class 42 in the application are identical to *services provided by a computer engineer*, in the earlier mark, the opposition under section 5(1) of the Act succeeds in relation to those services.

### **Likelihood of confusion**

43. In relation to the goods and services which I found are not identical, section 5(2)(a) of the Act applies and I am required to assess the likelihood of confusion. In determining whether there is a likelihood of confusion, I need to bear in mind several factors. The first is the interdependency principle, i.e. a lesser degree of similarity

between the respective goods and services may be offset by a greater degree of similarity between the trade marks (*Canon* at [17]). It is also necessary for me to bear in mind the distinctive character of the opponent's trade marks, as the more distinctive those trade marks are, the greater the likelihood of confusion (*Sabel* at [24]). I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks, relying instead upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

44. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/services down to the responsible undertaking being the same or related).

45. Earlier in the decision, I concluded:

- That the marks are identical;
- The goods and services are similar to a low degree;
- The opponent's mark has a medium degree of distinctive character;
- That the average consumer comprised of business users who is likely to use the goods and services covered by the applicant's and the opponent's mark will pay a fairly high degree of attention during that process.

46. Applying these conclusions, I find that there is a likelihood of direct confusion. Whilst I acknowledge that there is only a low degree of similarity between the goods and services, which points away from confusion, the earlier mark is distinctive to a medium degree and the identity between the marks affords the consumer no means of distinguishing between the marks. The distance between the goods and services is not sufficient, despite a fairly high degree of attention paid during the selection process to avoid the consumer thinking that the respective marks are being used by the same or a connected undertaking. There is a likelihood of confusion.

## Conclusion

47. The opposition has succeeded in full. The application will be refused in relation to:

Class 9: Hardware for monitoring, reporting, controlling, and training systems, consisting of digital cameras, video monitors to store and transmit data and images to monitor and measure package manufacturing and packaging operational processes; automated process control system comprised of micro-processor based hardware used to monitor, analyze, and control packaging equipment.

Class 42: Developing hardware systems to monitor, measure, control, report, and train in connection with package manufacturing and packaging operational processes; consulting services in the field of automated process control and monitoring of package manufacturing and safety compliance, and packaging in connection with manufacturing, packaging, and other packaging operational processes.

48. The application will proceed to registration for the remaining goods and services in Classes 1, 7, 16, 17 and 22.

## Costs

49. The opponent has been successful and is entitled to an award of costs. Awards of costs are governed by Tribunal Practice Notice (“TPN”) 2/2016. In making my assessment, I bear in mind that the opponent dropped the claim made under section 5(4)(a). Therefore, I consider it appropriate to award costs covering the official fee for an opposition based on sections 5(1) and 5(2) only. I award costs to the opponent on the following basis:

Official fee: £100

Preparing the notice of opposition and  
considering the counterstatement: £200

Filing written submissions: £300

Total: £600

50. I order Sealed Air Corporation (US) to pay Informatique Graphisme Energetique - I.G.E.the sum of **£600**. 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 this case if any appeal against this decision is unsuccessful.

**Dated this 20<sup>th</sup> February 2020**

**Karol Thomas**

**For the Registrar**

**The Comptroller-General**