

O-262-05

TRADE MARKS ACT 1994

**IN THE MATTER OF AN APPLICATION
BY SENSORNET LIMITED
TO REGISTER A TRADE MARK No 2375067
IN CLASSES 9, 37, 38 AND 43**

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BACKGROUND

1. On 6 October 2004 Sensornet Limited of 198 Providence Square, Jacob Street, London, SE1 2DZ applied under the Trade Marks Act 1994 for registration of the trade mark SENSORNET in classes 9, 37, 38 and 43.

2. The goods and services for which registration is sought are:

Class 09

Scientific, optical, weighing, measuring, signalling, checking (supervision) apparatus and instruments; instruments for use in surveys or monitoring and controlling environmental conditions in the oil, gas, security, telecommunication or construction industries; cables; fibre optic cables, sheaths for fibre optic cables, sensors in the form of and for use with fibre optic cables, detectors in the form of and for use with fibre optic cables, optical multiplexers for use with fibre optic cables, electrical or optical components for use with fibre optic cables, instruments and apparatus for detecting, measuring, recording, regulating, or controlling pressure, strain temperature, stress, optical wavelength and optical linewidth, environmental conditions, distance or length; instruments capable of measuring temperature using fibre optics; instruments capable of measuring strain using fibre optics; instruments capable of measuring pressure using fibre optics; fibre optic cables which measure, detect, record or control temperature and other environmental conditions; connectors and connections for fibre optic cables; pressure gauges; pressure indicators; pressure valves; pressure seals; apparatus and instruments for installing optical fibre sensors into conduits, and seals for sealing optical fibres; remote control apparatus; computer software; computer peripheral devices; computer hardware; magnetic data carriers; computer programmes and apparatus for display, recordal, monitoring and interpretation of data obtained from instruments used to detect temperature and other environmental conditions.

Class 37

Installation, testing and repair of instruments and apparatus for use in surveys in the oil, gas, security, telecommunications and construction industries; installation, testing and repair services for fibre optic cables and instruments and apparatus for detecting, measuring, recording, regulating or controlling pressure, strain, stress, temperature, acoustics, environmental conditions, distance and length; installation and repair of computer hardware and apparatus for display, recordal and interpretation of data obtained from instruments used to detect temperature and other environmental conditions.

Class 38

Telecommunications services; telecommunication of information including web pages; provision of telecommunication access and links to computer databases and to the Internet, including provision of telecommunication access and links to computer databases for information obtained from instruments and apparatus for monitoring environmental conditions in oil, gas, security, telecommunications or construction installations; electronic mail message services.

Class 42

Services of monitoring environmental conditions, including temperature, pressure, strain and stress, in oil and gas wells and other installations; design, testing, and maintenance services for fibre optic cables and apparatus and instruments for monitoring, measuring, controlling, or regulating environmental conditions, including temperature, strain, pressure and stress; designing computer programmes; installation, maintenance, testing and repair of computer software; design, testing, and maintenance of computer software for access to and use of the Internet and world-wide web; maintenance of computer databases and storage and retrieval of data, including data regarding environmental conditions in oil and gas installations; rental of computer software, computer peripherals, computer hardware and apparatus for displaying, recordal, monitoring and interpretation of data obtained from instruments used to detect temperature and other environmental conditions; surveying services; oil field surveys; oil field exploration services; geological research; hosting computer sites; design, research, development, and testing, of telecommunication apparatus and instruments; information, advisory and consultancy services relating to all the aforesaid and all other aspects of information technology included in this class.

3. Objection was taken under Section 5(2) of the Act in respect of two registered marks which were 1443153 and a Community Trade Mark 1975549. This objection relates to Class 9 only. There is no objection relating to Classes 37, 38 and 42. The objection based on 1443153 was subsequently waived and I need make no further mention of it in this decision. The remaining citation, E1975549, is registered in respect of the following earlier trade mark:



4. This earlier trade mark is registered in Class 9 in respect of the following goods:

Class 9

Physical and chemical measuring, signal and checking (supervision) apparatus and instruments on an electronic base.

5. A hearing was held on 18 May 2005 at which the applicant was represented by Ms Claire Lazenby, their trade mark attorney. At the hearing the objection under Section 5(2) of the Act was maintained and Notice of Refusal was subsequently issued.

6. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

7. No evidence has been put before me, therefore no claim under Section 7 of the Act has been made.

The case for registration

At the hearing Ms Lazenby made the following submissions in support of this application:

1. That the word elements of the earlier trade mark would be perceived as IQSENSORNET i.e. as a single combination of letters and words.
2. That the words SENSOR NET are somewhat descriptive of the relevant goods and therefore less distinctive than "I.Q."
3. Ms Lazenby provided me with sight of documents detailing goods provided by the applicant and the proprietors of the earlier trade mark and suggested that I should judge the likelihood of confusion in respect of these goods only.
4. During the hearing Ms Lazenby provided me with a revised specification in respect of the goods applied for in Class 9. However, I formed the view that this revised specification was a complex and technical list of goods and, in the circumstances, I declined to consider it at the hearing but advised Ms Lazenby that I would consider it on return to the office. However, this revised specification has not been submitted for consideration and the list of goods remains as filed.

DECISION

The Law

8. Section 5(2) of the Act reads 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, 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 on the part of the public, which includes the likelihood of association with the earlier trade mark.”

9. An earlier trade mark is defined in Section 6(1) which states:

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

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

10. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

11. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*; 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*;

(h) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*.

Distinctive character of the earlier trade mark

12. It is clear from the ECJ's judgment in the case of *Sabel BV v Puma AG* that the likelihood of confusion may be increased where the earlier trade marks have a highly distinctive character.

13. The earlier trade mark is a registered trade mark and is therefore deemed to be valid (Section 72 of the Act refers). The earlier trade mark does not consist solely of invented words so it cannot be accorded the very highest level of distinctive character. The earlier trade mark is a composite mark consisting of letters, words and devices. The device is of a number of interlinked squares which, although contained in the top right portion of the mark give the appearance of a background to the letters and words which, in my view, tend to dominate the mark. The letters IQ are larger than the words SENSOR NET and are separated from them both by their position and the underlining which forms a line between the two components.

14. The letters IQ is defined in Collins English Dictionary as an abbreviation for "intelligence quotient". As far as I am aware the letters IQ are not meaningful in relation to the goods in question unless it is meant to be an indication that the goods are in some way intelligent in the way that they function. If the combination of the letters IQ have no meaning then they are a simple combination of two letters of the alphabet, a combination which is certainly not at the top end of the scale of distinctive character. The words SENSOR NET are likely to be regarded by consumers of the relevant kinds as a shortened form of SENSOR NETWORK. However, whilst this term is partly descriptive of electronic apparatus involving sensors and a communications network it does not appear to be a natural term to use to describe any of the goods at issue, and would require further words to be added in order to convey a coherent descriptive message. The earlier trade mark is registered in respect of physical and chemical measuring, signal and checking (supervision) apparatus and instruments. The fact that these are limited to those on an electronic base does not, in

my view, reduce the scope of this specification significantly. This specification is in Class 9 and many of the goods covered by this specification would be on an electronic base. The specification remains quite wide and covers a wide range of physical and chemical measuring, signal and checking apparatus and instruments. I find it difficult, if not impossible, to determine each of the goods covered by the specification for which the earlier trade mark is registered but it is clear that the level of distinctive character which may be attributed to the earlier trade mark may vary according each of the goods covered by this specification. Having considered the earlier trade mark in its entirety I have concluded that it possesses a relatively high level of distinctive character for some of the goods in the earlier registration, but even for the goods for which it is allusive of characteristics, it has a modest but not negligible level of distinctive character.

Similarity of the goods

15. It is clear from the applicant's specification in Class 9 that there is a direct conflict with the goods contained within the specification of the earlier trade mark. The applicant's application is for a very wide range of goods which include measuring, signalling, checking (supervision) apparatus and instruments. It is clear that these terms within the applicant's specification directly conflict with the goods for which the earlier trade mark is registered. There are other terms such as instruments for use in surveys or monitoring and controlling environmental conditions in the oil, gas, security, telecommunication or construction industries which also directly conflict with the goods for which the earlier trade mark is registered. These conflicting goods are identical. The applicant's specification is wider than the specification of the earlier trade mark and although it is difficult, if not impossible, to determine all of the goods covered by them it is clear that in addition to identical conflicting goods, there are also similar goods to be considered. By way of example I note that the applicant's specification in Class 9 includes scientific apparatus and instruments together with instruments for use in surveys or monitoring and controlling environmental conditions in the oil, gas, security, telecommunication or construction industries. Such terms will include both identical and similar goods to those for which the earlier trade mark is registered.

Similarity of the marks

16. Since the trade mark of this application is not identical to the earlier trade mark the matter falls to be decided under sub-section (b) of Section 5(2) of the Act. The question, therefore, is whether the mark of this application is so similar to the earlier trade mark that there exists a likelihood of confusion which includes the likelihood of association on the part of the public.

17. The similarity of the marks must be assessed by reference to the visual, aural and conceptual similarities of the trade marks. It is clear from the judgment of the ECJ in the case of *Sabel BV v Puma AG* that I must assess the overall impressions created by the marks bearing in mind their distinctive and dominant components.

18. At the hearing Ms Lazenby suggested that the earlier trade mark would be perceived as being essentially an IQSENSORNET mark i.e. a single combination of letters and words. I cannot agree with this interpretation of the earlier trade mark. The

letters and word elements of the earlier trade mark are separated in two ways. Firstly, they are different in size and position which results in a separation which renders them unlikely to be seen as a single combination of letters and words. Secondly, they are further separated by the broken line which separates the words SENSOR NET from both the letters IQ and the device of interlinked squares. The letters IQ are larger in size than the letters which form the word SENSOR NET. In my view the letters IQ and the words SENSOR NET will be perceived as two separate components within this composite mark. There is, of course, the device of the interlinked squares. This device is much lighter in tone than the words and letters and would, in my view, be perceived as background within the mark with the letters IQ and the words SENSOR NET being perceived as being the distinctive and dominant components within it.

19. The applicant's trade mark consists of the word SENSORNET. I consider this mark to be a representation of the words SENSOR and NET conjoined. I do not see that there is any other way in which the relevant consumer would perceive this mark. I consider it to be aurally identical to the SENSOR NET element of the earlier trade mark. Visually, while it is not identical it is so close as to be perceived as being virtually identical to the SENSOR NET element of the earlier trade mark. I also find the word SENSORNET and the SENSOR NET element of the earlier trade mark to be conceptually identical. I have acknowledged that the IQ element is physically larger than the words SENSOR NET. However, I consider SENSOR NET to be at least as distinctive as IQ and words tend to dominate over matter in a consumer's recollection of a composite mark. It is therefore possible to conclude that SENSOR NET is one of the distinctive features of the earlier mark, and dominates the earlier mark to a greater extent than the IQ element.

Likelihood of confusion

20. I must, of course, bear in mind that a mere possibility of confusion is not sufficient. (See e.g. *React Trade Mark* [2000] RPC 285 at page 290) The Act requires that there must be a likelihood of confusion. I have already found that the goods for which the earlier trade mark is registered contains goods which are either identical or similar to the goods applied for. It is clear that where there is a lesser degree of similarity between the trade marks this may be offset by a greater degree of similarity between the services (and vice versa) - see *Lloyd Schuhfabrik Meyer & CO GmbH v Klijsen Handel BV*.

21. Furthermore, it is now well established that the matter must be determined by reference to the likely reaction of an average consumer of the goods in question, who is deemed to be reasonably well informed, reasonably observant and circumspect. At the hearing Ms Lazenby provided me with sight of documents indicating goods provided by both the applicant and the proprietor of the earlier trade mark. However, I consider this to be of little assistance as I must consider the specification of goods applied for against the specification of goods for which the earlier trade mark is registered. In relation to these goods I consider the average consumer of such goods to be the general public and organisations of varying sizes as well as those who would provide trade supplies for use in relation to the provision of such goods and I accept that the goods in question are relatively sophisticated goods which will be purchased with a degree of care. The average consumer generally relies upon the imperfect picture of the earlier trade mark that he or she has kept in his or her mind and must

therefore rely upon the overall impression created by the trade marks in order to avoid confusion.

22. I must, of course, consider the likelihood of confusion by reference to the visual, aural and conceptual points of similarity. In my view the weight to be attached to all aspects of confusion is significant. The similarities between the marks and the identical and similar goods which are in conflict are likely to lead to both visual and aural confusion. I have found that both of the conflicting marks possess a relatively high degree of distinctive character for some of the goods in question and this is a factor that I have born in mind in concluding that there are also conceptual similarities between the marks. In my view there appears to be two ways in which confusion could occur between these marks. Firstly, consumers could mis-recollect the earlier mark as a SENSOR NET mark because that is the dominant impression it creates. Secondly, consumers will notice the difference between the marks, but because of the prominence of SENSOR NET in the earlier mark, and the identity of the respective goods, mistakenly believe that the applicant's mark is indicative of an economic connection between the applicant and the proprietor of the earlier mark.

24. I have concluded that the identical and similar goods that I have identified coupled with the relatively high degree of distinctive character for some of the goods in question of the marks and the similarity between them, is sufficient to give rise to a likelihood of confusion within the meaning of Section 5(2)(b) of the Act.

CONCLUSION

25. In this decision I have considered all of the documents filed by the applicant and all of the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 5(2) of the Act.

Dated this 20th day of September 2005

**A J PIKE
For the Registrar
The Comptroller-General**