O/1022/25

TRADE MARKS ACT 1994

IN THE MATTER OF THE DESIGNATION OF
INTERNATIONAL REGISTRATION NO. WO0000001776600
BY II-VI DELAWARE, INC.
FOR PROTECTION IN THE UNITED KINGDOM
OF THE FOLLOWING TRADE MARK:

SMARTSENSE+

IN CLASS 9

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 447860 BY SERVICEX LTD

BACKGROUND AND PLEADINGS

1. International trade mark 1776600 ("the IR") consists of the sign "SMARTSENSE+". The IR is registered with effect from 4 December 2023 and the holder is II-VI Delaware, Inc.. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement in respect of the following goods in class 9:

Laser measuring systems; laser equipment for nonmedical purposes; lasers not for medical use; all of the foregoing being an opto-mechanical accessory and none of the foregoing used in connection with parking sensors.[1]

2. The request to protect the IR was published on 17 May 2024. On 6 June 2024, ServiceX LTD ("the opponent") opposed the protection of the IR in the UK, in its entirety, under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). For the purpose of the opposition, the opponent relies upon the following trade mark and all goods for which it is registered, as laid out below:

United Kingdom Trade Mark ("UKTM") 3497042:

SmartSense

Filing date: 4 June 2020
Registration date: 24 September 2021

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

[1] The opponent was notified in an official letter dated 31 December 2024 that, further to a WIPO notification, the holder's specification had been limited as shown. The opponent was invited to notify the registry as to whether the limitation would allow withdrawal of the opposition. As the opponent did not respond, the opposition was considered to be maintained (as confirmed in official letter dated 28 January 2025).

infrared sensors; Sensors for use with machine tools; Oil-water level sensors; Mass flow sensors; Alarm sensors for laundry washing machines; Alarm sensors for washing machines; Sensors for measuring depth; Ultrasonic sensors; Oscillation sensor devices; Shutter sensors; Synchro sensors; Resistors; Electric resistors; Electric resistors [for telecommunication apparatus]; Electric resistors for telecommunication apparatus; Electrical resistors; Force sensing resistors; Inductive resistors; Trimmer resistors; Variable resistors; Projected capacitive touch sensors; Electric current sensors; Flame sensors; Biochip sensors; Light sensors; Optical fibre sensors; Optical position sensors; Optical sensors; Optical speed sensors; Electro-optical sensors; Sensors used in meteorology; Sensors used in oceanography; Sensors used in plant control; Electronic sensors for measuring solar radiation; Electronical sensors for measuring solar radiation; Automatic solar tracking sensors; and Motion sensors for security lights (class 9)

3. In its pleadings, the opponent contends that the parties' marks are "visually almost identical" and "would operate within the same category of goods", such that there exists a likelihood of confusion.

4. In its counterstatement, the holder denies that the parties' marks and the respective goods are sufficiently similar to give rise to a likelihood of confusion.

5. The holder is represented by Keltie LLP whilst the opponent is unrepresented. Only the opponent filed evidence during the course of the proceedings[2] and, whilst neither party requested a hearing, the holder elected to file written submissions in lieu. This decision is taken following a careful perusal of the papers.

DECISION

Relevance of EU law

[2] On 20 December 2024, the holder filed a request for an extension of time in which its file its evidence via official form TM9. On 31 December 2024, the registry issued a preliminary view refusing the request, with a of deadline 7 January 2025 set to challenge the view and ask for a case management conference. As no response was received, the preliminary view was upheld and no evidence was filed by the holder.

6. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Section 5(2)(b)

7. Section 5(2)(b) of the Act reads as follows:

> "5(2) A trade mark shall not be registered if because –
>
> (a)…
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

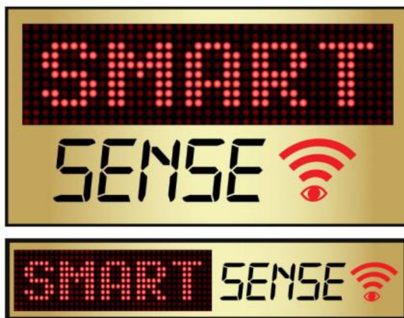
8. By virtue of the marks' respective filing dates, the opponent's trade mark clearly qualifies as an earlier mark pursuant to section 6 of the Act. As the opponent's mark had not completed its registration process more than 5 years before the filing date of the mark at issue, it is not subject to the proof of use provisions laid out in section 6A of the Act. Consequently, the opponent is able to rely upon its mark and all goods for which it is registered without providing evidence of use.

The opponent's evidence

9. The opponent's evidence comprises a witness statement dated 21 October 2024 from Mr Richard Reddyoff, an employee of the opponent since 2018. Mr Reddyoff sets out details of the trade mark relied upon, including the filing and registration dates. He submits that, prior to its registration, the mark was used since "at least March 2015".

The opponent currently offers 149 products under the earlier mark. It is used as a brand name for parking sensors and automotive resistors, and is displayed on the goods' respective packaging.

10. Mr Reddyoff's statement is supported by four exhibits (SS A – D). The first is a reproduction of what Mr Reddyoff refers to as the opponent's "design logo", shown below:



11. The second and third exhibits show examples of the above branding used on packaging and alongside an example of a product used for advertisement on an e-commerce website.[3] The final exhibit displays a table listing 17 March 2015 as the "creation date" for various SmartSense parking sensors.

12. That concludes my summary of the opponent's evidence, insofar as I consider it necessary.

Section 5(2)(b) – case law

13. 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:

[3] There is no additional context concerning the advertisement nor its significance.

(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 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

14. The competing goods are laid out at paragraphs 1 and 2 to this decision.

15. The relevant factors identified by Jacob J. (as he then was) in the *Treat*[4] case 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

[4] [1996] R.P.C. 281

whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

16. In *Kurt Hesse v OHIM*[5], the Court of Justice of the European Union ("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)*[6], 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."

17. The opponent's submissions on the matter of the goods' similarity extends to its statement in its Notice of Opposition, specifically "the opposed mark would operate within the same category as ours".

18. The holder addresses the issue fairly comprehensively. Within its submissions in lieu, for example, it presents the following table:

Similarity Factor	**Applicant's Goods**	**Opponent's Goods**	**Similar or Different?**
Nature of goods	Integrated accessory/component in sophisticated laser equipment	Stand-alone sensors and resistors	Clearly different
Intended purpose	Laser measuring for high-precision applications, such as laser cutting, laser welding, laser drilling	Recording movement; stopping electrical current (used in the automotive sector).	Clearly different
Method of use	As an integrated accessory/component in sophisticated laser equipment	Parking sensors and automotive resistors	Clearly different
End Users	Specialists engaged in commercial laser	General public	Clearly different

[5] Case C-50/15 P
[6] Case T-325/06

	cutting, welding and measuring.		
Manufacturer	Made by specialist optical materials companies	Automotive component manufacturers	Clearly different
Trade Channels	Business to business-only sold to specialist manufacturers via sales representatives	Typically sold direct to end consumer	Clearly different
Price Point	Extremely expensive (thousands of pounds per piece)	Inexpensive (£10-20 per piece)	Clearly different

19. I will briefly address a point raised by the holder in its submissions in lieu. It states that “the Opponent’s evidence makes it clear that the mark is only actually used in connection with parking sensors and automotive resistors”. Given that the opponent is not obliged to provide evidence of use in the present proceedings and I have not been tasked with, for example, framing a fair specification concerning the use made of its earlier mark, the opponent can rely upon all goods it has identified as they appear on the register. As the matter of confusion must be considered notionally, differences between parties’ current offerings are irrelevant to the assessment I am required to make, except to the extent that those differences are apparent from the lists of goods or services they have tendered for the purpose of registration.

20. The opponent has not made clear precisely which of its goods it considers similar to the applied-for terms. Rather, in its Notice of Opposition, it simply indicates that it wishes to rely upon “all goods and services”.[7] On this point, I keep in mind the below comments of Iain Purvis KC, sitting as the Appointed Person in *SMARTX*:[8]

> “[It] is for the Opponent to put forward the combinations of goods on which it relies for similarity (or identicality). If it fails to identify a particular combination, it cannot expect the Hearing Officer to do the job for it. [This] would place an intolerable burden on Hearing Officers in cases of this nature in which there will be thousands of potential combinations of goods which could be relied on, and for each combination a slightly different argument for similarity could be made.”

[7] See Question 5 of official Form TM7
[8] BL O/0911/24

21. In the absence of any specific indication as to which goods the opponent intends to rely upon, I will approach my assessment on the basis of the earlier goods which I consider to represent the most appropriate comparator.

22. For the purpose of an assessment, it is permissible to group goods and/or services together where they are sufficiently comparable to do so.[9]

Laser measuring systems; laser equipment for nonmedical purposes; lasers not for medical use; all of the foregoing being an opto-mechanical accessory and none of the foregoing used in connection with parking sensors.

23. Amongst the opponent's relied-upon terms are some fairly precise goods, such as *electro-optical sensors* and some which have a broader scope; *optical sensors* or *light sensors*, for example. The applied-for goods comprise lasers, laser measuring systems and laser equipment, all limited for use as an opto-mechanical accessory. The holder submits that these goods "combine optical and acoustic detectors with AI software to enhance quality and reduce scrap rates in laser cutting, welding, drilling, and marking applications." In more general terms, a laser is defined as "a narrow beam of concentrated light produced by a special machine. It is used for cutting very hard materials, and in many technical fields such as surgery and telecommunications."[10] A sensor is defined as "an instrument which reacts to certain physical conditions or impressions such as heat or light, and which is used to provide information."[11] These definitions marry with my own understanding, and that which I would expect the average consumer is familiar with. Whilst I accept that there may be a relationship between the opto-mechanical functionality in the applied-for goods and the opponent's *optical sensors* (for example), the technical nature of the goods, to my mind, likely means that the goods' respective core uses, and methods of use, will be distinct. For this reason, I do not consider the goods to be competitive. There may be some coincidence in the goods' users but this is at a fairly high level. The physical nature of the goods is likely to be distinct to fulfil their respective purposes, and there is nothing before me to suggest that the goods typically reach the market via the same trade channels. The opponent

[9] *Separode Trade Mark* BL O-399-10 (AP)
[10] *https://www.collinsdictionary.com/dictionary/english/laser*
[11] *https://www.collinsdictionary.com/dictionary/english/sensor*

contends that the goods "would operate in the same category". I acknowledge that there may be certain circumstances whereby the opponent's goods I have cited above may be compatible with, or used alongside, the holder's goods to meet a technological objective, for example. However, I have no submissions from the opponent on this point to explain or support a complementary dynamic whereby the goods are considered *indispensable* to one another, not least to an extent that the consumer would believe them to originate from a single undertaking. Weighing these findings, I cannot identify any clear or meaningful degree of similarity between the parties' goods.

24. For completeness, in the event that I am considered to be wrong to have found that the goods are not complementary and, instead, it would have been appropriate to find a degree of complementarity between the goods, I would nonetheless consider it not sufficiently pronounced to justify a finding of similarity for the purpose of the present assessment.[12]

25. Given that there can be no likelihood of confusion where there is no similarity between the parties' specifications,[13] the opposition fails at this juncture.

Conclusion

26. The opposition has failed. Subject to any successful appeal against this decision, the application will proceed to registration.

Costs

27. As the holder has succeeded, it is entitled to a contribution toward its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice ("TPN") 1/2023. In accordance with that TPN, I award the costs to the holder as follows:

Preparing a statement and considering the other side's statement:	£250

[12] *Energy Beverages LLC v Gogu Marin*, BL O/074/19
[13] See, for example, *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA

Considering the other side's evidence and preparing submissions in lieu of a hearing:	£400[14]
Total:	**£650**

28. I hereby order ServiceX LTD to pay II-VI Delaware, Inc. the sum of £650. 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 31st day of October 2025

Laura Stephens
For the Registrar

[14] I have taken into account the relevance and substantiveness of the opponent's evidence.