

**O-316-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
APPLICATION NO. 3302146  
BY DISONICS LTD  
TO REGISTER**



**AS A TRADE MARK IN CLASSES 9 & 42**

**AND**

**OPPOSITION NO. 413307 THERETO**

**BY**

**DI-SORIC GMBH & CO KG**

## BACKGROUND

1) On 06 April 2018, Disonics Ltd ('the applicant') applied to register the following, as a trade mark in respect of goods and services in classes 09 and 42:



The application was published in the Trade Marks Journal on 04 May 2018. Since the date of application, the specification of the application has been limited<sup>1</sup> and currently reads as follows:

Class 09: Flowmeters and parts thereof measuring flow acoustically; leak detectors and parts thereof identifying leaks by measuring flow acoustically.

Class 42: Engineering consultancy relating to design of pipelines and plumbing; Measuring water, oil and gas flows and testing for leaks acoustically; Engineering services relating to energy supply systems; Acoustic engineering surveying relating to water, oil or gas supply.

2) Di-soric GmbH & Co KG ('the opponent') claims that the trade mark application offends under section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). Relevant details of the marks relied upon are:

- EU registration No.13790704 ('mark 1')  
Filing Date: 04 March 2015  
Date of entry in the register: 04 September 2015

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<sup>1</sup> As per the Forms TM21B filed on 30 July 2018 and 23 January 2019.



Class 09: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life saving and teaching apparatus and instruments; Lighting devices, namely light-emitting diodes for signalling and warning purposes; Lighting ballasts; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carries; Calculating machines, data processing equipment and computers; Software; Control, measuring and regulating apparatus, in particular electronic controls; Contactless command generators, sensors and detectors, proximity switches, measuring light grids, light sensors, light barriers, light curtains, optoelectronic apparatus, power supply apparatus, amplifiers, including fibre optic cable amplifiers, level sensors, flow switches, timed relays, counters, monitoring apparatus, speed relays, lasers, not for medical purposes, optical fibres; Light diodes; Accessories and parts for the aforesaid goods, included in class 9.

Class 42: Scientific and technological services and research and design relating thereto; Industrial analysis and research services.<sup>2</sup>

- EU registration No. 8819211 ('mark 2')  
Filing Date: 19 January 2010  
Date of entry in the register: 13 July 2010

## di-soric

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<sup>2</sup> The registration also covers goods in class 11 but only those listed above are relied upon.

Class 09: Measuring, signalling, checking (supervision) apparatus and instruments.<sup>3</sup>

3) The opponent's registrations are earlier marks, in accordance with section 6 of the Act. As mark 2 completed its registration procedure more than five years prior to the publication date of the contested mark, it is, in principle, subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the goods relied upon under that mark. The opponent claims that the parties' respective goods and services are identical. It also argues that the respective marks are visually and aurally highly similar and conceptually indistinguishable since they are coined words with no obvious meaning. As a result, it claims that a likelihood of confusion exists.

4) The applicant filed a counterstatement. I note the following points made therein:

- Proof of use of mark 2 is not requested.<sup>4</sup>
- The applicant asserts that its mark is both visually and conceptually different to the opponent's marks.
- The applicant denies that the parties' goods and services are identical or similar, stating that its goods and services are aimed at a specialist market.
- The applicant points out that mark 1 was not brought to its attention before the opposition was filed.

5) The opponent is represented by Williams Powell; the applicant by Robert Beckham. No evidence has been filed in these proceedings with both parties opting to file written submissions only during the evidence rounds. Neither party has requested a hearing nor filed written submissions in lieu. I now make this decision after carefully considering the papers before me.

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<sup>3</sup> The registration also covers other goods and services in classes 09, 11 and 35 but only those listed above are relied upon.

<sup>4</sup> As per question 7 of Form TM8.

## DECISION

### The law

6) Section 5(2)(b) of the Act states:

“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.”

7) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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.

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

### **The correct approach**

8) Before going any further, it is appropriate to address the applicant's contention that there can be no likelihood of confusion because its goods and services are aimed at a specialist market which differs to that of the opponent. This contention does not assist the applicant. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C- 533/06, the CJEU stated at paragraph 66 of its judgment that when assessing the likelihood of confusion under section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. Further, in *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

9) It follows that the actual goods and services either party may currently be providing in the marketplace and their target market is irrelevant to the assessment of the likelihood of confusion. What matters is whether, notionally and objectively, the applicant's goods and services, as applied for, and the opponent's goods and services, as registered, are identical and/or similar.

### **The opponent's best case**

10) Of the two marks relied upon by the opponent, it seems to me that its strongest case lies with mark 1 bearing in mind the breadth of goods and services covered by that registration and the stylisation (including the colour) of that mark. If the opponent

is unsuccessful based on mark 1, it is in no better position in relation to mark 2. Accordingly, I will limit my assessment of the likelihood of confusion to that between the contested mark and mark 1.

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

11) In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) ('Meric'), the GC held:

“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).”

12) In the case before me, all of the applicant's goods in class 09 are encompassed by the opponent's 'measuring...apparatus and instruments'. The respective goods must therefore be considered identical. Further, all of the applicant's services in class 42 fall within the opponent's 'Scientific and technological services' and must also be considered identical.

### **Average consumer and the purchasing process**

13) It is necessary to determine who the average consumer is for the respective goods and services and the manner in which they are likely to be selected. 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.”

14) The average consumer for the goods and services at issue is likely to be commercial users (as the applicant submits). However, I do not rule out that they may be purchased by the general public. The marks are likely to be encountered primarily by visual means from packaging, websites, brochures and the like. I also bear in mind that there may be an aural aspect to the purchase since the goods and services may sometimes be the subject of discussions with sale representatives or engineers, either in person or on the telephone. The goods and services are of a technical nature and are likely to be more costly than everyday items. As a result, the average consumer is likely to pay an above average degree of attention during the purchase.

### **Comparison of marks**



15) 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.”

It would therefore be wrong to artificially dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

16) The marks to be compared are:

| Opponent's mark   | Applicant's mark   |
|---|--|
|  |  |

17) The applicant's mark consists of the word 'DiSonics' presented in an unremarkable font, where 'Di' is presented in dark navy blue and 'Sonics' in a lighter sky blue. This word is preceded by a stylised hexagonal shaped device presented in the same two colours. Both the device and the word are distinctive elements. Whilst the device enjoys a prominent position at the beginning of the mark, the word takes up a much larger proportion of the mark and is the element by which the mark will be referred to. I find that the word 'DiSonics' carries the greatest weight in the overall impression. The device, whilst far from insignificant, plays a lesser role.

18) Turning to the opponent's mark, this consists of three elements. The first is a stylised square shaped device in the colours grey and sky blue. The second is the hyphenated word 'di-soric' in an unremarkable font, also presented in sky blue. The third element is the words 'sensors and more'. Of the three elements in the mark, the latter is the smallest in size, subordinately positioned to the other two elements and will be perceived as entirely descriptive. The word 'di-soric' and the device element are both distinctive. However, the word takes up a larger proportion of the mark and

is the element by which the mark will be verbalised. I find that the 'di-soric' element carries the greatest weight in the overall impression, the device carries less weight and the words 'sensors and more' very little weight.

19) Visually, although both marks have a device element at the beginning, they are different to look at. The opponent's mark contains the phrase 'sensors and more' which is absent from the contested mark. In terms of the respective word elements, the opponent's mark contains hyphenation not present in the applicant's mark and the first two letters of the parties' marks are presented in different colours (sky blue and navy blue respectively). However, the word elements are a very similar length, with the applicant's mark being only one letter longer (ending with an additional 's'). Furthermore, the other letters within the marks are identical and presented in the same order, with the exception of the fifth letter, being 'r' and 'n' respectively. The fact that the first four letters are identical is of particular importance because, as the General Court ('GC') noted in *El Corte Inglés, SA v OHIM (El Corte Inglés)*<sup>5</sup>, the beginnings of words tend to have more visual (and aural impact) than the ends. The respective shades of sky blue also appear to me to be identical, or at least, highly similar. Overall, I find there to be a good degree of visual similarity between the marks.

20) In terms of how the marks will be spoken, the device elements in the parties' marks will not be articulated. It is also unlikely, given the descriptive nature of 'sensors and more', and the very little weight carried by that element in the overall impression, that those words will be verbalised. Accordingly, the aural comparison is between 'di-soric' and 'DiSonics'. Both words consist of three syllables. To my mind, the presence of the respective hyphen and contrasting sky blue/navy blue colouring naturally leads the consumer to pronounce the respective first syllables of both marks as 'dye' (as opposed to 'di' as in 'dinner'). The first syllables are therefore identical. The second and third syllables are highly similar, being 'sor-ic' and 'son-ics', which will be pronounced in an entirely predictable fashion. Overall, and bearing in mind the comments of the GC in *El Corte Inglés*, I find there to be a high degree of aural similarity.

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<sup>5</sup> Cases T-183/02 and T-184/02

21) Conceptually, neither the device nor the word 'di-soric' in the opponent's mark are likely to evoke any clear concept in the mind of the average consumer on account of the former being rather abstract and the latter having the appearance of an invented word with no descriptive or allusive qualities. I do not accept the applicant's contention that it will be perceived as alluding to the word 'historic'. The words 'sensors and more' will be readily understood and self-explanatory but it is not a distinctive concept in the context of the relevant goods and services. Insofar as the applicant's mark is concerned, the device here is, again, rather abstract and is unlikely to form part of the conceptual hook for the consumer. In terms of the word 'DiSonics', the opponent argues that it has no conceptual meaning. The applicant states that 'the overall mark would give the average person an allusion that the mark DISONICS related to the science of sound' (my emphasis). I accept that some consumers are likely to perceive 'DiSonics' as an invented word which alludes to sound. However, I also accept the opponent's contention that, as an invented word, there may be some consumers who perceive no concept at all from it. In the first scenario, the applicant's mark would send an allusive message which is not shared by the opponent's mark; in the second scenario, the marks would be conceptually neutral.

### **Distinctive character of the earlier mark**

22) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by 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)."

23) As there is no evidence of use before me, I have only the inherent distinctiveness of the opponent's mark to consider. The 'sensors and more' element of the mark is entirely descriptive. However, the other elements of the mark are neither descriptive nor allusive of the opponent's goods and services in any way. The device has a reasonable degree of distinctiveness and the 'di-soric' element, having the appearance of a meaningless invented word, has a high degree of distinctiveness. It is the latter element which gives the mark, as a whole, a high degree of inherent distinctiveness.

### **Likelihood of confusion**

24) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods and services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they

have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

25) I have found that the parties' goods and services are identical and the opponent's mark has a high degree of inherent distinctiveness; both of these are important factors weighing in the opponent's favour. In terms of the marks themselves, I have found that some consumers may perceive them as being conceptually neutral and others may perceive the applicant's mark as having an allusive concept which is not shared by the opponent's mark. Insofar as the latter consumers are concerned, I remind myself that it has been stated many times by the courts that conceptual differences may sometimes counteract visual and aural similarities<sup>6</sup> but they do not always do so<sup>7</sup>. I come to the view that, the fact that the applicant's mark alludes to sound whereas the opponent's mark does not, is not enough to outweigh the good degree of visual similarity and high degree of aural similarity between the marks, notwithstanding the above average degree of attention that is likely to be paid. Whilst that degree of attention may lessen, to some extent, the effects of imperfect recollection it does not mean those effects are entirely dispelled. As for consumers who perceive the marks to be conceptually neutral, the lack of any conceptual hook for them means that they are even more susceptible to the effects of imperfect recollection (again despite the degree of attention likely to be paid) and consequently, even more likely to misremember the marks. I find that there is a likelihood of both groups of consumers mistaking one mark for the other as a result of the imperfect picture they have kept in their mind. There is a likelihood of direct confusion.

26) If I am wrong about that and the average consumer, whilst still retaining an imperfect picture within their mind, nevertheless recognizes that the later mark is different, in some way, from the earlier mark, I find that, in those circumstances, the similarities between the marks, together with the identity of the goods and services, are still likely to lead the average consumer to believe that the applicant's mark is

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<sup>6</sup> *The Picasso Estate v OHIM*, Case C-361/04 P

<sup>7</sup> *Nokia Oyj v OHIM*, Case T-460/07

another brand or sub-brand of the opponent. There is a likelihood of indirect confusion.<sup>8</sup>

## OUTCOME

27) The opposition succeeds.

## COSTS

28) As the opponent has been successful, it is entitled to a contribution towards its costs. The applicant requests that I take into account that earlier mark 1 was not brought to its attention before the opposition was filed. As the opponent points out, it was not obliged to draw the applicant's attention to all of the possible earlier marks it may rely upon in the subsequent opposition. Furthermore, the applicant voluntarily joined the proceedings when it filed its defence and counterstatement despite lack of prior notice of mark 1. For these reasons, this factor will have no impact on the award of costs to the opponent<sup>9</sup>.

29) Using the guidance in Annex A of Tribunal Practice Notice 2/2016, I award the opponent costs on the following basis:

|  |             |
|--|-------------|
| Preparing the Notice of Opposition<br>and reviewing the counterstatement | £200        |
| Official fee (Form TM7)  | £100        |
| Written submissions  | £300        |
| <b>Total:</b>  | <b>£600</b> |

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<sup>8</sup> Having regard for the comments of Mr Iain Purvis Q.C., sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, [16]

<sup>9</sup> See also, Tribunal Practice Notice 6 of 2008: "Where an opposition is defended, the provision or otherwise of prior notice will not usually affect the award of costs at the conclusion of the proceedings, which will normally be based on the published scale of costs."

30) I order Disonics Ltd to pay Di-soric GmbH & Co KG the sum of **£600**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated 3 June 2019**

**Beverley Hedley  
For the Registrar,  
the Comptroller-General**