



Benelux Office for
**Intellectual
Property**

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2018389
of 29 September 2023

Opponent: **Grohe AG**
Industriepark Edelburg
D-58675 Hemer
Germany

Representative: **& DE BANDT cv**
IJzerlaan 19
1040 Etterbeek
Belgium

Trademark invoked 1: **European Union trademark 15678048**
SENSE

Trademark invoked 2: **European Union trademark 4319034**
Essence

against

Defendant: **KOHLER MIRA LIMITED**
Whaddon Works Cromwell Road
Cheltenham, Gloucestershire GL52 5EP
United Kingdom

Representative: **De Merkplaats B.V.**
Herengracht 227
1016 BG Amsterdam
Netherlands

Contested sign: **Benelux application 1469581**
SENSE

I. FACTS AND PROCEEDINGS**A. Facts**

1. On 8 November 2016 the defendant filed a Benelux trademark application for the word trademark SENSE for goods in classes 9 and 11. This application was processed under number 1469581 and was published on 6 September 2022.
2. On 27 October 2022 the opponent filed an opposition against this application. The opposition is based on the following earlier trademarks:
 - European Union trademark 15678048 for the word trademark SENSE, filed on 20 July 2016 and registered on 26 August 2020 for goods in class 9;
 - European Union trademark 4319034 for the word trademark Essence, filed on 25 February 2005 and registered on 22 January 2007 for goods in class 11.
3. According to the register the opponent is the actual holder of the trademarks invoked.
4. The opposition is directed against all the goods of the contested application and is based on all the goods of the trademarks invoked.
5. The language of the proceedings is English.

B. Proceedings

6. The opposition is admissible and the Benelux Office for Intellectual Property (hereinafter referred to as: "the Office") notified the parties on 31 October 2022. During the administrative phase of the proceedings both parties filed arguments, at the request of the defendant, the opponent submitted proof of use. All the documents submitted meet the requirements as stated in the BCIP and the Implementing Regulations (hereinafter referred to as: "IR"). The administrative phase of the procedure was completed on 26 May 2023.

II. ARGUMENTS OF THE PARTIES

7. The opponent filed an opposition at the Office under article 2.14 (2)(a) BCIP, in accordance with the provisions of article 2.2ter (1)(a) and (b) BCIP: the likelihood of confusion based on the identity or similarity of the relevant trademarks and of the goods or services concerned.

A. Opponent's arguments

8. When comparing the signs at issue, the opponent states that the contested sign is identical to the first trademark invoked, SENSE.
9. With regard to the second trademark invoked, Essence, the opponent explains that the signs in question are aurally highly similar as the second syllable "SENCE" of the earlier trademark and "SENSE" of the contested sign are pronounced in the same way. According to him, the first syllable "ES-" of the trademark invoked will not attract the attention of customers as the emphasis is clearly on the second syllable of the trademark "ES-SENCE". Visually, the opponent considers that the signs in question are at least similar to an average degree as they coincide in the sequence of the letters "SEN*E" and only differ in the letters "C" and "S" and the first syllable of the earlier trademark "ES". To illustrate these assertions,

the opponent relies on a decision of the EUIPO in opposition proceedings based on EU trademark 4319034 "ESSENCE" and lodged against the defendant's EU trademark "SENSE".

10. According to the opponent, the contested goods in class 9 are identical to the goods covered in class 9 by the first trademark invoked because they are all apparatus (including electronic equipment) for controlling and detecting liquids and monitoring and controlling heat. Furthermore, the opponent finds that the goods covered in class 11 by the second trademark invoked relate to apparatus and installations for water supply and are complementary to the contested goods in class 9, which concern the support and/or control of water supply, so they are produced by the same manufacturers, distributed through the same channels and are offered at the same places. According to the opponent these goods are highly similar.

11. The opponent considers that the goods covered in class 11 by the second trademark invoked concern apparatus and installations for water supply. Both these goods and the contested goods in class 11 are covered by the broader category "apparatus and installation for water supply and sanitary purpose", therefore, the opponent finds them identical. Moreover, as the goods in class 9 covered by the first trademark invoked relate to the support and/or control of water supply, the opponent considers these goods to be complementary to the contested goods in class 11 because the latter are apparatus and installations for water supply or fittings thereto.

12. For the above-mentioned reasons, the opponent requests the Office to uphold the opposition, not to register the contested sign and that the costs be awarded to the defendant.

13. Upon request of the defendant, the opponent has provided proof of use of the first trademark invoked, the only one he believes to be subject to an obligation to use.

B. Defendant's arguments

14. The defendant has requested proof of use of the trademarks invoked.

15. When comparing the second trademark invoked with the contested sign, the defendant considers the signs in question to be dissimilar. Visually, the defendant points out that the trademark invoked contains a word of seven letters whereas the contested sign consists of only five letters. Although both signs contain the element "SEN", they have different beginnings. It should be noted that the first part of a mark is generally the one that catches the consumer's attention and is remembered more clearly than the rest of the sign. The defendant is of the opinion that the different beginnings strengthen the different visual impression. Phonetically, the defendant explains that the signs differ in length, rhythm and composition resulting from the different numbers of syllables. The emphasis in pronunciation in the trademark invoked would be on the first syllable. According to the defendant, the public usually attributes the greatest weight to the beginnings of signs, therefore, the different sound of the first syllables is sufficient to counteract the phonetic similarity of the second parts of the signs. Conceptually, the defendant states that the word SENSE is "a faculty by which the body perceives an external stimulus (sight, smell, hearing, taste and touch)" whereas ESSENCE is the basic or most important idea or quality of something or a strong liquid, usually from a plant or flower.

16. As there is no similarity between the signs in question, the defendant finds the comparison of the goods hardly necessary. However, as the opponent claims there is similarity between the goods in question, the defendant addresses the dissimilarity of these goods. The opponent quotes the same EUIPO decision (in the context of the opposition proceedings based on EU trademark 4319034 "ESSENCE" and lodged against the defendant's EU trademark "SENSE") to reach the conclusion that use of the second trademark invoked is proven only in respect of "pipe fittings mixing cold and warm water, in particular those operated by one

hand for washbasins and utility sinks, washstands, bidets, tubs and showers” in class 11. Therefore, the defendant indicates that they must be taken in account when comparing the goods in question.

17. Relying on previous decisions of the EUIPO and the Office, involving comparisons between goods in class 9 and goods in class 11, the defendant establishes that the goods (cited above) covered by the second trademark invoked in class 11 are dissimilar to the contested goods in class 9 as they fall into different classes, have different uses, different nature and would not be in competition with each other.

18. When comparing the second trademark invoked with the contested sign, the defendant confirms that these signs are identical. Regarding the comparison of the goods, the defendant refers to its arguments concerning the lack of similarity between the goods to conclude that they have different uses, nature and would not be in competition with each other.

19. For the above-mentioned reasons, the defendant concludes that the opposition cannot be upheld for the contested goods in class 11 and requests that the Office partially rejects the opposition.

III. DECISION

A.1 Likelihood of confusion

20. In accordance with Article 2.14 BCIP, the holder of a prior trademark may submit a written opposition to the Office, within a period of two months to be calculated from the publication date of the application, against a trademark which in the order of priority, ranks after its own in accordance with Article 2.2ter BCIP.

21. Article 2.2ter (1) BCIP stipulates insofar as relevant that “*a trademark shall, in case an opposition is filed, not be registered (...) where: b. because of its identity with, or similarity to, the earlier trademark and the identity or similarity of the goods or services covered by the trademarks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trademark*”.¹

22. A likelihood of confusion within the meaning of this provision exists if the public may believe that the goods or services designated by that trademark and those covered by the trademark applied for come from the same undertaking or, where appropriate, from undertakings which are economically linked.²

23. According to settled case-law of the CJEU, the existence of a likelihood of confusion in the mind of the public must be assessed globally, considering all the relevant circumstances of the individual case, including the degree of similarity between the signs at issue and the goods or services concerned, the degree of recognition of the earlier trademark and the degree of distinctiveness – inherent or acquired through use – of the earlier trademark.³

Comparison of the signs

24. To assess the degree of similarity between the conflicting signs, their visual, phonetic, and conceptual similarity should be determined. The comparison must be based on the overall impression given

¹ Art. 2.2ter (1)(b) BTIP implements art. 5 (1)(b) Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks. A similar provision can be found in art. 8 (1)(b) Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark.

² CJEU 11 June 2020, C-115/19 P, ECLI:EU:C:2020:469, point 54 (China Construction Bank).

³ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 57 and the case-law mentioned there (Equivalenza).

by those signs. In the assessment, the perception of the signs by the average consumer plays a decisive role. The average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details.⁴

25. Although the comparison must be based on the overall impression made by those signs on the relevant public, account must nevertheless be taken of the intrinsic qualities of the signs at issue.⁵ The overall impression created in the mind of the relevant public by a complex trademark may, in certain circumstances, be dominated by one or more of its components. Regarding the assessment whether this is the case, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the complex mark.⁶

26. The assessment of the similarity between the signs, regarding the visual, aural and conceptual similarity of the signs, must be based on the overall impression created by them, taking into account, *inter alia*, their distinctive and dominant components.

27. The Office will first compare the first trademark invoked with the contested sign.

28. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
SENSE	SENSE

29. The Office establishes that the signs are identical.

Comparison of the goods

30. In assessing the similarity of the goods and services concerned, account must be taken of all the relevant factors which characterise the relationship between them. These factors include, *inter alia*, their nature, their end-users, and their method of use and whether they are in competition with each other or are complementary.⁷

31. In comparing the goods, the goods shall be considered in the terms set out in the register and not the actual or intended use.⁸

32. The goods to be compared are the following:

Opposition based on:	Opposition directed against:
Class 9 Electrotechnical, electronic, optoelectronic and acoustic equipment, apparatus and installations composed thereof for monitoring, controlling and regulating water supply and	Class 9 Apparatus and instruments for controlling and detecting liquids and gases; remote control mechanisms and devices; thermostats; thermometers; apparatus for thermostatically

⁴ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 58 and the case-law mentioned there (Equivalenza).

⁵ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 71 and the case-law mentioned there (Equivalenza).

⁶ General Court (EU) 23 October 2002, T-6/01, ECLI:EU:T:2002:261, points 34 and 35 (Matratzen) en 13 December 2007, T-242/06, ECLI:EU:T:2007:391, point 47 (El Charcutero Artesano).

⁷ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 23 (Canon).

⁸ General Court (EU) 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).

<p>drainage, treatment, availability, distribution, removal and heating of drinking and commercial water; Equipment and apparatus for monitoring, measuring, controlling and regulating pressure, temperature and flow rate quantities of water in water conduit installations, containers and sanitary installations; Temperature controlling apparatus, Thermostat components and kits for cold and hot water mixing valves, thermostat fittings and batteries, parts and accessories for the aforesaid goods (included in class 9); Mobile apps for operating toilets, water taps; Electronic devices for monitoring and transmitting health data; Mobile apps for health monitoring, sensors for moisture, flooding, leak monitoring, water control and water quality; sprinklers; Component parts for all the aforesaid goods.</p>	<p>controlling the mixture of fluids; electric and electronic flow control systems; apparatus for indicating and recording the flow of fluids; temperature sensors and scanners; water temperature regulators; temperature display units; valve position indicators; liquid level indicators; electric and electronic timing devices; timed flow controls; infra-red detection units; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; solenoids; batteries; electric cable and wire; protection devices for electric circuits; all relating directly or indirectly to water supply and sanitary installations; parts and fittings for the aforesaid goods; none of the aforementioned goods being filters.</p>
	<p>Class 11 Apparatus and installations for water supply and sanitary purposes; showers, spray fittings, shower heads, shower handsets, shower hoses; water mixing appliances and water taps for use in showers; shower baths; booths, cabins, enclosures, cabinets, cubicles, screens and trays for showers; thermostatic mixing valves; parts and fittings for the aforesaid goods; none of the aforementioned goods being filters or for use in central heating apparatus.</p>

Class 9

33. The opponent argues that all the contested goods in class 9 are identical to the goods covered by the first trademark invoked (see paragraph 10), which is not contested by the defendant (see paragraph 19). The identity of the goods in class 9 is therefore clearly *in confesso*, so that the Office does not need to examine it further.

Class 11

34. The *thermostatic mixing valves* designated by the contested sign are similar, at least to a certain degree, to the *temperature controlling apparatus, thermostat components and kits for cold and hot water mixing valves, thermostat fittings and batteries, parts and accessories for the aforesaid goods* covered by the trademark invoked because they coincide in distribution channels, relevant public and producer.

35. The contested *apparatus and installations for water supply and sanitary purposes; showers, spray fittings, shower heads, shower handsets, shower hoses; water mixing appliances and water taps for use in showers; shower baths; booths, cabins, enclosures, cabinets, cubicles, screens and trays for showers; parts and fittings for the aforesaid goods; none of the aforementioned goods being filters or for use in central heating apparatus* are complementary and similar to a certain degree to the opponent's goods. The

opponent's goods are controlling, monitoring and regulating apparatus and instruments for water supply/distribution. The goods in question are aimed at the same public. They will be sold in the same shops so the distribution channels are identical.

Conclusion

36. The goods covered by the contested sign are partly identical and partly similar to a certain degree, to the goods covered by the first trademark invoked.

A.2 Global assessment

37. When assessing the likelihood of confusion, in particular the level of attention of the relevant public, the similarity of the goods and services in question and the similarity of the trademarks are important factors.

38. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. It should also be considered that the average consumer's level of attention is likely to vary in accordance with the category of goods or services in question.⁹ In the case at hand, the Office establishes that the end user of the products in question is the general public, but these products are generally purchased and installed by professionals with specific professional knowledge or expertise. Consequently, the level of attention should be considered as ranging from average to above average.

39. The more distinctive the earlier trademark, the greater the likelihood of confusion. Marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character.¹⁰ In the present case, the first trademark invoked has a normal distinctive character, given that it does not describe a characteristic of the goods in question.

40. The global assessment of the likelihood of confusion assumes that there is a certain degree of interdependence between the factors that have to be taken into account, particularly between the level of similarity of the signs and of the goods or services which they cover. A lesser degree of similarity between the relevant goods or services can be offset by a greater degree of similarity between the trademarks, and vice versa.¹¹

41. The trademarks are identical. The goods in class 9 are identical *in confesso*, and the contested goods in class 11 are similar, at least to a certain degree, to the goods covered in class 9 by the first trademark invoked. Based on the aforesaid, the Office concludes that the relevant public might believe that the goods in question come from the same undertaking or from economically linked undertakings.

B. Conclusion

42. Based on the foregoing the Office concludes that there exists a likelihood of confusion.

43. As the opposition is fully upheld on the basis of the first trademark invoked, it is not necessary to examine the second trademark invoked in accordance with Article 1.14 (1)(i) IR.

⁹ CJEU 22 June 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

¹⁰ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

¹¹ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 59 and the case-law mentioned there (Equivalenza).

IV. CONSEQUENCE

44. The opposition with number 2018389 is justified.

45. Benelux application with number 1469581 will not be registered.

46. The defendant shall pay the opponent 1,045 euros in accordance with article 2.16 (5) BCIP in conjunction with rule 1.28 (3) IR, as the opposition is justified in its entirety. This decision constitutes an enforceable order pursuant to article 2.16 (5) BCIP.

The Hague, 29 September 2023



Flavie Rougier
rapporteur

Tineke Van Hoey

Pieter Veeze

Administrative officer:

Monique Vrolijk