

**TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 1578831 BY
SOLDAN HOLDING & BONBONSPEZIALITATEN GMBH
TO REGISTER A TRADE MARK IN CLASS 5**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 47935
BY FERRERO S.P.A & SOREMARTEC S.A.**

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BACKGROUND

1. On 28 June 1994, Soldan Holding & Bonbonspezialitäten GmbH of Nurnberg, Germany, applied to register the trade mark shown below in Class 5:



2. The application was examined and was subsequently accepted in Part A of the Register. On 17 September 1997, the application was advertised for the following range of goods:

“Pharmaceutical preparations, all for the treatment of diseases of the respiratory organs and tracts; nose sprays, chemical products for medical treatments and sanitary use, pharmaceutical drugs and preparations, cough syrups, balsams, all for adults and children; all included in Class 5; but not including any such goods being medicated confectionery or infants and invalids foods”.

I note that the advertisement of the trade mark included the following clause:

“Registration of this mark shall give no right to the exclusive use of the word “Kinder”.”

3. Since advertisement the specification of the application has been amended to read:

“Pharmaceutical preparations, all for the treatment of diseases of the respiratory organs and tracts; nose sprays, chemical products for medical treatments and sanitary use, pharmaceutical drugs and preparations, cough syrups, balsams, all for children; all included in Class 5; but not including any such goods being medicated confectionery or infants and invalids foods”.

4. The application is opposed by Ferrero S.p.A of Cuneo, Italy and Soremartec S.A. of Schoppach-Arlon, Belgium. In their Statement of Grounds the opponents say that they have made substantial use of the trade mark KINDER and have acquired a considerable reputation in the goods sold under the trade mark. They identify fifty one registered trade marks owned by the respective opponents in the United Kingdom in which the word KINDER appears either alone or together with others elements - details of these registrations can be found in Annex A to this decision. The opponents base their objections on the following sections of the Act:

- Section 9 because the trade mark the subject of the application is not adapted to distinguish;
- Section 10 because the trade mark the subject of the application is not capable of distinguishing;
- Section 11 because of the substantial goodwill and reputation acquired by the opponents in the trade mark KINDER, use of the mark the subject of the application is likely to deceive or cause confusion and so would be disentitled to protection in a court of justice;
- Section 12 because the trade mark the subject of the application so nearly resembles the trade marks of the opponents which are already on the register or are pending registration in respect of the same goods or description of goods as those covered by the application as to be likely to deceive or cause confusion;
- Section 17(2) generally for the reasons dealt with below.

5. The applicants filed a Counter-Statement which, in essence, consists of a denial of the various grounds of opposition. In so far as the opponents have identified a range of trade marks owned by them which feature the word KINDER either alone or together with other elements, the applicants observe: that none of the trade marks identified are registered or applied for in Class 5; that the majority of the trade marks identified are stylised or device marks; that a number of the trade marks contain disclaimers to the exclusive use of the word KINDER; that a number of the trade marks contain limitations which have been entered on the register to the effect that KINDER is the German word for children; that a number of the trade marks contain colour limitations which have been entered on the register; that a number of the trade marks post-date the application in suit and finally that a number of the trade marks have been attacked by the applicants. The applicants comments in paragraphs 10 to 11 of their Counter-Statement are reproduced verbatim below:

“10. The applicant is a German company and the word KINDER is the German word

for children or children's. KINDER is a purely descriptive word in German and the applicant has disclaimed any right to its exclusive use. Its German meaning would also be understood in the United Kingdom. In particular the word KINDERGARTEN to describe a children's nursery is a familiar expression in the United Kingdom and appears in English dictionaries. The trade mark which is the subject of the application is intended to be used for goods which are particularly suitable for children and this is reinforced by the device of a child which is included in the applicants' trade mark. The applicant should not be prevented from using its own German language in its mark to indicate the particular suitability for children of its goods and to use such mark in the European Union whether in Germany or the United Kingdom. Further KINDER has been included in at least two United Kingdom trade mark registrations in Class 5 in respect of which neither of the opponents is the registered proprietor, namely:

1358486	KINDER-VITES	22.9.88	Tischon Corporation
1240460	KINDERGEN	24.4.85	Scientific Hospital Supplies International Ltd

The former was registered for "*Medicinal preparations and substances; dietetic substances adapted for medical use; preparations and substances containing or consisting of vitamins*" with a disclaimer of KINDER and a limitation that KINDER is the German word for children. This registration has expired. The second mark is registered for "*Infants and invalids foods*". In both cases the marks appear to have been registered in respect of goods which are particularly suitable for children.

11. In the premises, if, which is denied, the applicants' trade mark is found to resemble the opponents' trade marks so nearly in respect of goods of the same description as to be likely to deceive or cause confusion within the meaning of Section 12(1) Trade Marks Act 1938, registration of the application should be permitted on the basis of special circumstances under section 12(2) Trade Marks Act 1938 or otherwise in the exercise of the Registrar's discretion."

6. Both sides filed evidence and both seek an award of costs. Both sides also ask for the Registrar to exercise her discretion in their favour. The matter came to be heard on 30 May 2002. At the Hearing the applicants were represented by Mr Richard Arnold of Her Majesty's Counsel instructed by Carpmaels & Ransford, Trade Marks Attorneys and Boulton Wade Tennant, Trade Mark Attorneys; the opponents were represented by Mr Michael Edenborough of Counsel instructed by Taylor Joynson Garrett, Solicitors.

7. By the time the matter came to be heard the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later part of this decision are references to the provisions of the old law.

EVIDENCE

8. The evidence filed in these proceedings is substantially the same as that filed in Opposition No 47934 in relation to Application No 1578833. For convenience, my summary of the evidence in those proceedings is reproduced in Annex B.

Sections 9 and 10

9. In his skeleton argument Mr Edenborough helpfully indicated that the objections based on any inherent defects in the marks would not be pursued at the hearing. However he did not have instructions to abandon the grounds with the result that they could not be formally withdrawn. Mr Arnold submitted that the grounds were hopeless and indicated that as a consequence, he would not be making submission in relation thereto.

10. As a result, I do not need to say a great deal about these objections to the mark applied for. It consists, self evidently, of a stylised, cartoon-like, device of a child holding a card with the words Kinder-eukal on it. The applicants have entered a disclaimer of the word Kinder. I will consider the significance of this word separately in the context of the objections under Sections 11 and 12 of the Act. For present purposes suffice to say that I have no doubt that the mark as a whole is adapted to distinguish in relation to the goods applied for within the meaning of Section 9 of the Act. Accordingly the objections under both that Section and Section 10 must fail.

Section 11

11. The Section reads as follows:-

“11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.”

12. The established test for an objection under this provision is set down in Smith Hayden and Company Ltd’s application ([1946] 63 RPC 101) as adapted by Lord Upjohn in the BALI trade mark case [1969] RPC 496. The test may be expressed as follows:

Having regard to the user of the opponents’ marks, is the tribunal satisfied that the mark applied for, if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

13. Mr Edenborough rightly reminded me that, in order to be successful under Section 11, it is not necessary to be able to show that the opponents would have succeeded in a passing-off action. My attention was also drawn to the following judicial guidance set out in *De Cordova and Others v Vick Chemical Coy* [1951] 68 RPC 103:

“The likelihood of confusion or deception in such cases is not disproved by placing

the two marks side by side and demonstrating how small is the chance of error in any customer who places his order for goods with both the marks clearly before him, for orders are not placed or are often not placed, under such conditions. It is more useful to observe that in most persons the eye is not an accurate recorder of visual detail and that marks are remembered by general impressions or by some significant detail than by any photographic recollection of the whole.”

14. Reference was also made to guidance from the European Court of Justice in the context of Council Directive 89/104 as regards the underlying principles bearing on the issue of confusion of the public in as much as that issue is common to both the 1938 and 1994 Acts. Whilst I understand the limited context in which the point is raised, there are differences in approach between the respective Acts (and the Directive provisions that underpin the 1994 Act) that seem to me to make it unsafe or inadvisable to rely on authorities based on Directive provisions.

15. The filing date of the application in suit is 28 June 1994. The opponents must establish priority of user in order to get their case off the ground. Of the six marks referred to in Ms Wooll’s declaration as being in use, five are relevant at the material date (KINDER JOY was only brought into use from September 1995 onwards). The five relevant marks are:

KINDER SURPRISE	- a chocolate egg product containing a toy
KINDER CHOCOLATE	- a chocolate bar
KINDER MILK SLICE	- a sponge bar with milky filling
KINDER BUENO	- a chocolate bar with a milk and hazelnut filling
KINDER MAXI	- no product packaging supplied but the evidence (VW2) suggests it is a bar of some kind

16. Each of the above marks has been used from a date that precedes the filing date of the application by a number of years. There is an important qualification to my above references to the marks. This being Section 11, it is the marks as used that must be considered (as distinct from the form in which they may be registered). In use the word Kinder is usually presented with the K in black and the remaining letters in red. The second element is usually presented in a different typeface. Two examples are attached to this decision (Annex C).

17. In terms of the BALI test I must consider each of the marks relied on by the opponents and the goods in respect of which they are used and decide whether there is a likelihood of confusion if the applicants’ use their composite mark in a normal and fair manner in respect of the full range of goods encompassed by their specification. I differ, therefore, from Mr Arnold to the extent that his skeleton suggests that “the only product which has achieved any reputation is the chocolate egg containing a toy sold under the name KINDER SURPRISE. If Ferrero cannot succeed in a Section 11 objection on the basis of KINDER SURPRISE, then it cannot be in any better position on the basis of eg KINDER BUENO”. The basis of the Section 11 action is strictly the opponents’ use rather than reputation though I agree that the extent of use will determine the nature and extent of resulting reputation (and in turn influence the likelihood of confusion). I bear in mind particularly the opponents’ use of KINDER CHOCOLATE which, because the second element is the product itself (a chocolate bar), relies largely on the word KINDER for its distinctive character.

18. That brings me to the core issue of the significance of the word KINDER which has been the subject of a large amount of evidence and submissions at the hearing. Put briefly, the opponents say that their KINDER mark has a reputation in the UK and, if a member of the public saw the same word upon another product, confusion is likely. The applicants take the contrary position that it is an ordinary word of the German language which has also become part of the English language; that it should be available to them for descriptive use; and that it would be understood in its descriptive sense if used in relation to products aimed at children.

19. Guidance on the correct approach to the registrability of words in foreign languages (for the purpose of Section 9 and 10 of the Act) can be found in EL CANAL DE LAS ESTRELLAS Trade Mark [2000] RPC 291. I am not concerned here with the registrability of the applicants' mark for Section 9 and 10 purposes (they have, in any case, disclaimed rights in the word KINDER) but I find the reported case of some assistance in terms of the general approach to words in foreign languages where, as here, a foreign language word is relied on by the opponents to prevent registration of the application in suit. The headnotes for EL CANAL DE LAS ESTRELLAS record that:

- “(1) There was no rule that foreign words had to be examined for registrability by reference to their meaning in translation. The purpose of translation was to ensure that foreign words were not registered without knowing their meaning.
- (2) For registration, foreign words needed only to be capable of functioning satisfactorily as trade marks in relation to the goods or services supplied in or from the United Kingdom, whether or not they would also qualify for protection elsewhere.
- (3) The less obscure a foreign word was, the greater the weight which had to be given to its meaning in translation.
- (4) Traders engaged in intra-Community trade were not, unjustifiably, to be prevented from using words in the language of other member states of the European Union.
- (5) Spanish was a modern language widely understood and spoken in the United Kingdom. Spain was a trading partner of the United Kingdom and a fellow member of the European Union. The services specified in the application were supplied nationally and internationally.
- (6) EL CANAL DE LAS ESTRELLAS was easily recognisable as Spanish which when used in respect of the services specified would be understood as laudatory and not a reference to stellar bodies.
- (7) The disclaimers offered did not cure the defects of the mark.”

20. Whilst the above guidance provides a useful pointer to assessing the character of a word in a foreign language there are additional factors in the case before me dealing with the significance of the word KINDER and the nature and extent of the reputation attaching to the

opponents' mark(s). On the opponents' side there is evidence of use and survey material dealing with public awareness and understanding of KINDER. On the applicants' side there is dictionary and other material intended to demonstrate that KINDER means 'children' and that it has entered the English language and would be understood as meaning 'children' in this country. There are also the results of various searches undertaken and purporting to show that KINDER is used in a meaningful way in a business context to denote products or services for, or relating to, children. Finally there are decisions of other trade mark offices suggesting that KINDER has a descriptive meaning. I go on to consider this material before drawing my own conclusions.

21. The opponents' evidence of use of their various KINDER marks is summarised above. At the material date in these proceedings sale of KINDER SURPRISE chocolate eggs had reached, and been maintained at, significant levels. KINDER chocolate and the KINDER MILK SLICE sponge bar products had also been available since 1986/7 with more modest levels of sales. KINDER MAXI and KINDER BUENO are more recent introductions to the range from about 1990/91 onwards though sales of the former appear to have been negligible in 1993/94 and to have ceased completely thereafter. There is no evidence before me to place the sales figures in a context which allows me to judge the success of individual products within the industry as a whole. It seems that each of the marks is used in relation to a single product only. With the probable exception of KINDER MILK SLICE all are chocolate products. Given the volume of sales, reinforced by the evidence from the survey (albeit that some caution is needed in interpreting the results - see below), I accept that the KINDER SURPRISE chocolate egg product enjoyed a significant reputation at the material date. I am less persuaded that the other KINDER products had made an impact at that time.

22. In support of their position the opponents have filed the results of two surveys. The first (Benson/Miller) invited responses to questions concerning certain of the applicants' marks. The second (Kotzur/Rodrigues) was intended to establish the level of public awareness of KINDER. Both surveys were the subject of significant criticisms in Mr Arnold's skeleton argument and submissions at the hearing having regard to the leading authorities on the subject, *Imperial Group Plc v Philip Morris Ltd*, [1984] RPC 293 and *Scott Ltd v Nice-Pak Products Ltd*, [1989] FSR 100. The latter is relied on particularly in relation to circumstances where an applicants'/defendants' goods are not on the market.

23. The main general criticisms of the surveys seems to me to be as follows:

- they were conducted some four years after the relevant date. That may to an extent have been inevitable but it rendered the results unreliable to the extent that they would have been influenced by continuing and increased use by the opponents during the intervening period.
- the numbers interviewed were relatively small (45 and 40 respectively) and concentrated at a single location.
- there is insufficient information on the basis on which the agents charged with recruiting interviewees went about the selection process.

- certain questions were of a leading nature and others invited speculation.

24. More particularly the Benson/Miller survey was conducted using a card with four of the applicants' marks on it, three of them being variant marks that are the subject of the three oppositions before me and the fourth a mark unrelated to the actions before me. It would seem that interviewees were also shown packaging for a mark that is not the subject of these opposition proceedings. Some of the marks shown to the interviewees had KINDER as a more dominant element than others. It is not possible to say to which mark or marks interviewees were reacting. The first question is of a leading nature referring as it does to the words in question being 'names of products' (products which are not it seems on the market in the UK). Question 4 reads:

"The names KINDER EM-EUKAL and EUKAL FÜR KINDER are to be used on various confectionery products, bakery products and medicines. You can see that the word "KINDER" is used on the packaging. What does the word KINDER mean to you?"

25. The first mark does not feature in any of the opposition proceedings before me and the words in the second strictly only in relation to the mark the subject of Opposition No 47934. More important still the question directs the interviewee to the word on which the interviewer wishes attention to be focussed.

26. The response to Question 2 ("Have you seen these products before?") of questionnaire No 14 in the interviews conducted by Mr Miller is recorded as being "Is it Kinder eggs? (Saw one on the table)". If the latter is representative of the circumstances in which the survey took place (ie with an example of the opponents' main product visible) that in itself must fatally undermine the value of the survey.

27. There are defects too in the Kotzur/Rodrigues survey. The first question was an ostensibly open one "What does the word KINDER mean to you?" The interviewees were at the same time shown a card with KINDER on it. Mr Edenborough was inclined to rely on the results as demonstrating unprompted awareness of the significance of KINDER in relation to his clients' products - of the 40 people questioned 27 said either chocolate, egg, chocolate egg or Kinder egg. One person said both children and Kinder egg. The difficulty with this is that in articulating the question the interviewer had to adopt a particular pronunciation and it seems likely that a short 'i' sound was adopted rather than the long 'i' of the English comparative adjective kinder. If that is so the question was, despite appearances, a leading one or likely to invite speculation.

28. The combined effect of the deficiencies is, in my view, to severely diminish, if not destroy, the value of the surveys. The opponents might feel able to draw some limited support from the surveys in terms of public awareness of, particularly, the KINDER SURPRISE egg product. But the applicants too can point with some legitimacy to the fact that a number of interviewees were also aware that KINDER meant children (indeed a few referred to both the trade mark significance and the fact that it was a word meaning children).

29. Turning to the applicants' evidence, I have not found the dictionary material to be persuasive particularly the foreign language ones intended to demonstrate that kind/kinder are words in other languages meaning child or children. As Mr Edenborough pointed out, dictionaries do not tell you how familiar the general public are with particular words. That is, a fortiori, the case where a foreign language word is involved. Where 'kinder' appears in an English dictionary (Exhibit DJR3 to Ms Harris' Exhibit BPBH3) it is only as part of an expression (kinder, kirche, küche - children, church, kitchen).

30. Perhaps the most telling point in support of recognition and understanding of the word KINDER in this country is the fact that it will be familiar to many people through the word Kindergarten. That is a word with which, I would think, most people would be familiar and would have an appreciation of its meaning. The word KINDER is also without question a common word of the German language and one that is likely to be understood by anyone with a smattering of that language. The company name information contained in Ms Harris' evidence and followed up in Mr Moore's evidence also provides some support for the view that the word is used in this country in circumstances where it is intended to carry a reference to children.

31. I am, however, unable to go as far as Mr Arnold when he suggests that the word has become part of the English language. Foreign words and expression are sometimes so completely absorbed into the language that they will be used rather than an English language paraphrase (eg entrepreneur, élan, déjà vu, alfresco). I do not think an English speaker would normally use the word Kinder in place of children. Nor is there likely to be universal understanding of the word. Nevertheless it is in my view likely to command a reasonable level of recognition in this country.

32. That is not to say that it is incapable of assuming or acquiring a trade mark character. The way in which the word is used, the goods in relation to which it is used, the context and surrounding circumstances will determine whether it has done so.

33. I have not felt able to place particular reliance on decisions of overseas Registries in relation to the German word Kinder or its English equivalent appearing in, or as part of, marks. Those decisions are not binding on me and cannot be taken as reliable indicators of public perception of, and reaction to, the word in this country.

34. As part of their case the applicants have also referred to a number of 'KINDER' marks in use in this country in relation to products for children. Those specifically relied on are KINDERGEN which is used as a food substitute for feeding children with renal failure (Mr Morris' evidence), KINDERVITAL which is a children's dietary supplement (Mr Moore's evidence) and KINDERBOX, a box for storing children's books and nursery furniture (Mr Moore's evidence). The suggestion is that this shows the word KINDER in use in relation to products relating to children; that the opponents have no monopoly on the word; and that these marks have been used without any suggestion of confusion with the opponents' goods.

35. From the material supplied in support of this it would appear that KINDERGEN is a prescription only product. Mr Morris records that his contact at the suppliers of the product indicated it was not a big seller. No information is given on how long the KINDERVITAL

products has been available in the UK or the volumes sold. KINDERBOX is used in a product area some way removed from the opponents' mainstream business. I am not inclined to accept that this evidence tells me anything about the issue of confusion with the opponents' goods. To the extent that it reinforces other parts of the evidence which point to the word Kinder being used for its descriptive connotations across a broad range of goods and services it is a not altogether surprising state of affairs.

36. It will be useful at this point to summarise my main findings from the voluminous evidence before me. These are that:

- the opponents have significant use of, and reputation in, the mark KINDER SURPRISE in relation to a chocolate egg product;
- the case for consumer awareness of the opponents' other KINDER products has not been established on the evidence given the modest levels of use;
- the marks are used on single products only;
- the range of goods is narrow being largely restricted to chocolate products (KINDER MILK SLICE being the only exception);
- there is no evidence of other traders using KINDER in the confectionery field but it is used in other areas in relation to products or services for, or directed at, children;
- Kinder is a common word of the German language;
- it cannot be said to have passed into the English language but is nevertheless a word that is likely to command a reasonable degree of recognition in this country even amongst people who would not claim to speak or generally understand much German;
- the inherent merits of the word are likely to be relatively low particularly if used in relation to goods suitable for, or directed at, children and the degree of protection to be accorded to it should be judged accordingly;
- the manner and prominence of presentation of the word and the context in which it is used are likely to have a bearing on consumer perception of the word (that is to say whether it is being used as a trade mark or in a descriptive sense).

37. With these findings in relation to the opponents' use and reputation and the significance of the word KINDER in mind I go on to consider the likelihood of deception and confusion. The opponents have a number of marks in use and are entitled to have their position tested on the basis of each of them. In practice it is, I think, unnecessary to consider all their marks. KINDER SURPRISE has been much more heavily promoted, enjoyed significantly higher sales and is, as a consequence, likely to have a more extensive reputation than the other used

marks. I propose also to bear in mind the KINDER chocolate mark because it carries the word KINDER on its own (or simply with the name of the goods) and also because in use the packaging carries a picture of the face of a young boy (see Annex C for the actual marks used). Mr Edenborough invited me to take particular note of this in the light of the child device that features prominently in the applicants' mark. If the opponents do not succeed on the basis of these marks they are unlikely to be in any better position on the basis of their other marks either individually or collectively.

38. The applied for mark consists of the device of a child holding a card with the words KINDER EUKAL on it. Visually the largest single component of the mark is the child device. It is a stylised, cartoon-like, representation of a child which is, in my view, far removed from the photographic representation of a boy's face on the packaging of the opponents' KINDER chocolate mark. The words KINDER and EUKAL are presented in different typefaces with KINDER first, in somewhat larger script and slightly more prominent. Given the composite nature of the applied for mark there seems to me to be little likelihood of consumers directly mistaking that mark for either of the opponents' marks. But, accepting the maxim that words talk in trade marks and bearing in mind the prominence of the word KINDER, consumers might well be given cause to wonder whether the mark in issue was another of the opponents' KINDER marks, a variant perhaps which they had not previously come across.

39. Turning to the goods I must have regard to the full range of goods applied for and the goods on which the opponents have used their marks, that is to say chocolate or chocolate eggs. I note that the applicants' specification has been limited so as to exclude medicated confectionery, a term which would, for instance, cover medicated chocolate.

40. The test under Section 11, unlike that under Section 12, is not restricted to goods of the same description and an opponent may succeed under Section 11 in circumstances where the respective goods or services would not be found to be of the same description within the established (JELLINEK) test. Nonetheless there seem to me to be important and clear differences between the parties' goods in this case. The applicants' goods serve medical or quasi-medical purposes (hence their inclusion in Class 5) and their specification excludes both medicated confectionery and a wider range of infants' and invalids' foods. The opponents' chocolate products, on the other hand, are purchased and consumed purely for pleasure. There is no suggestion that the opponents' trade has extended to Class 5 goods. Rather the evidence is that they concentrate on a narrow product range and apply particular marks to a single product only. There is a suggestion that the respective products might meet at the retail level as a result of confectionery being in close proximity to shelves of pharmaceuticals in, say, supermarkets. I am not persuaded that this is the case. Pharmaceutical products are in my experience generally in discrete areas. Nor has any evidence been adduced to suggest that there is any other trade connection or association in the minds of consumers between the applicants' goods and chocolate or chocolate eggs. The position here is markedly different, for instance, from the circumstances in Hack's Application [1941] RPC 91 where, in the context of identical marks, it was held that the public might think that a laxative sold under the mark BLACK MAGIC contained chocolate having regard to the opponents' extensive reputation and the fact that chocolate was used as a flavouring for laxatives.

41. Taking all the above factors into account I do not consider that there can be said to be a reasonable likelihood of confusion amongst a substantial number of persons if the applicants' mark is used for any of the goods applied for.

42. Before leaving Section 11 there is a further issue that I need to touch on but I can do so fairly briefly. There was a subsidiary strand to the opponents' case based on the potential deceptive nature of the mark applied for if it was not limited to goods for children (the original specification having referred to "all for adults and children"). In fact, since advertisement the specification has been amended to restrict the goods concerned to being "all for children". Unfortunately the amendment requested by the applicants on the official form (TM21) dated 10 September 1999 has not been properly reflected in the amendment made to the Registry's database. The comma that currently appears after the word 'balsams' should in fact be a semi-colon. It is a small but significant change in terms of the scope of the restriction. The point will be dealt with by means of an erratum in due course.

43. Section 12 reads:

"12.-(1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

- a. the same goods
- b. the same description of goods, or
- c. services or a description of services which are associated with those goods or goods of that description."

The reference in Section 12(1) to a near resemblance is clarified by Section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

44. The test here can be expressed as follows:

"Assuming user by the opponents of their marks in a normal and fair manner for any of the goods covered by the registrations of those marks, is the tribunal satisfied that there will be no reasonable likelihood of deception amongst a substantial number of persons if the applicants use their mark normally and fairly in respect of any goods covered by their proposed registration."

45. The opponents have a number of registrations but I do not understand them to dissent from the position adopted for the purposes of Mr Arnold's skeleton argument that their best case rests on registrations for the mark KINDER solus. This mark is registered with the following specification of goods:

Chocolate and chocolate products (for food) - Class 30 (No 1170775)

Milk, milk shakes, yoghurt, ice cream, whipped cream; all being chocolate flavoured -
Class 29 (No 1393756)

46. The correct test in relation to comparison of marks is the well known one set out in Piantotist Co's Application [1966] 23 RPC 774. I have already set out my views in relation to the parties' marks in the context of Section 11 where KINDER chocolate was one of the marks used. The opponents' position for Section 12 purposes is marginally stronger given that the marks are plain block capital words and not presented in the colour/stylistic manner of the marks as used.

47. The question, therefore, arises as to whether the opponents' goods are of the same description as the applicants' goods. The test is again a well known one - that in Ladislav Jellinek's Application [1946] RPC 59 (Panda). I am required to consider the matter under the headings of the nature, purpose and channels of trade of the goods in question.

48. In his oral submissions Mr Edenborough suggested that the applicants' goods closest to his clients' goods were cough syrups and balsams. Balsams are, to the best of my knowledge, medicinal ointments for application to the skin. I cannot see that they are particularly relevant to the enquiry. Cough syrups were, in Mr Edenborough's submission, often formulated with a sweet ingredient to make them more palatable and acceptable to children and hence closer to sweets.

49. In terms of the Panda test a cough syrup seems to me to be quite different in nature to all or any of the opponents' goods in Class 29 and 30. In its basic form a syrup is simply sugar dissolved in water. In the context of a cough syrup it is usually a flavoured and somewhat more viscous preparation. The opponents' goods would, I think, be formulated rather differently and none would naturally be described as a syrup.

50. The purpose of a cough syrup is, self evidently, medicinal unlike the opponents' chocolate and chocolate flavoured milk and dairy products. The latter are usually consumed for pleasure rather than with the intention of curing or alleviating an ailment.

51. As to channels of trade I have commented briefly on this in the context of Section 11 and particularly the suggestion that pharmaceutical/medicinal products may be found in close proximity to one another in supermarkets. My own experience leads me to doubt whether this is generally the case but I concede that trade evidence might persuade me otherwise. But, even if I am wrong in my view of this aspect of the trade in such goods, it does not seem to me to necessarily establish a common channel of trade given that pharmaceutical/medicinal products are usually sold in relatively discrete areas and customers are less prone to casually browse in such areas. Channels of trade must not, however, be viewed narrowly from the retail perspective. The position of manufacturers and wholesalers must also be considered. I do not have any evidence directed towards whether cough syrups or any of the other goods in the applicants' specification are produced by, or traded through, the same businesses. It is not self evident that this should be the case, certainly at the manufacturing level, given the different nature and purpose of the goods. It is conceivable that wholesalers supplying supermarkets or chemists, say, may handle a wide variety of goods but again I have no specific information to guide me. I conclude that channels of trade too are different.

52. I have reached the view that the applied for goods are not of the same description as any of the opponents' goods. It follows, therefore, that the opposition must fail under Section 12.

53. There are two further points I need to deal with for the sake of completeness. I will do so very briefly. The first is Mr Arnold's submission that, in the event that I was against him under Section 12(1), the application should be allowed to proceed to registration on the basis of 'other special circumstances' pursuant to Section 12(2). The circumstances he relied on were that the only reason for the objection is the presence in the mark applied for of a word which "(a) is a very common word in the language of another EC Member State, (b) has also entered the English language and (c) is being used descriptively by a company domiciled in the Member State in question: cf. *Kerly* (12th ed) paragraph 10-21."

54. I have already considered the nature and character of the word KINDER in terms of its likely signification to the relevant UK public. I have also considered the opponents' use of the word as, or as an element in, their mark(s), along with the penumbra of protection arising therefrom. Whether a stand-alone defence is available to the applicants under Section 12(2) in the terms argued for by Mr Arnold is a matter on which I see no need to express a concluded view. In the light of the above findings I do not need to do so.

55. There is, separately, a request by the opponents for the exercise of the Registrar's discretion in their favour. In their statement of grounds the opponents ask that the application be refused either because it would be likely to prejudice the legitimate conduct of the opponents' business or because of 'the conduct of the applicants and the nature of the trade mark'. I do not understand the basis for any of these claims save to the extent that they have been considered under the grounds dealt with above. Mr Edenborough's skeleton took a somewhat different tack in referring to the need to ensure that the integrity of the register is maintained and that the protection of the public is guaranteed pursuant to Section 32 of the 1938 Act. I have already considered the registrability of the mark applied for against the relevant provision of the Act and I do not understand the relevance of Section 32 in the context of opposition proceedings. In short I see no basis for an exercise of discretion adverse to the applicants.

56. The applicants have succeeded and are entitled to an award of costs in their favour. I order the opponents to pay them the sum of £1300. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 19 day of July 2002

M REYNOLDS
For the Registrar
The Comptroller General

United Kingdom Trade Mark Registrations owned by Ferrero S.p.A. & Soremartec S.A.

<u>No</u>	<u>Trade Mark</u>	<u>Class</u>	<u>Application Date</u>
1170775	KINDER	30	03/03/1982
1393756	KINDER	29	02/08/1989
1117389	KINDER JOY (Expired)	28	11/07/1979
1117390	KINDER JOY	30	11/07/1979
1190606	KINDER SURPRISE	30	16/02/1983
1203542	KINDER FRESCO	30	16/09/1983
1357980	KINDER MILK SLICE	30	23/09/1988
1393751	KINDER SURPRISE	30	02/08/1989
1471898	KINDER SCHOKO-BONS	30	29/07/1991
1474992	KINDER DELICE	30	29/08/1991
1489981	KINDER SNAPPY	30	05/02/1992
1492502	KINDER SOFTY (+ device)	30	28/02/1992
1508672	KINDER CIRCUS	30	05/08/1992
1525450	KINDER CHOCOLATE (+ device)	30	01/02/1993
905725	KINDER SCHOKOLADE	30	21/02/1967
	FERRERO (+ device) (Expired)		
928392	KINDER CHOCOLATE (+ device)	30	22/07/1968
958455	FERRERO KINDER	30	20/04/1970
1296561	KINDER SUN DRINK (stylised)	29	24/12/1986
1296562	KINDER SUN DRINK (stylised)	32	24/12/1986
1280876	KINDER JUMBO SURPRISE (+ device)	30	02/10/1986
1269665	KINDER COUNTRY (stylised)	30	16/04/1986
1267242	KINDER BUENO (stylised)	30	16/05/1986
1260493	KINDER MILK-SANDWICH (stylised)	30	16/12/1985
<u>No</u>	<u>Trade Mark</u>	<u>Class</u>	<u>Application Date</u>
1245781	KINDER MILK-BREAK (stylised)	30	10/07/1985
2124572	KINDER MAXI (+ device)	30	24/02/1997
1226610	KINDER SOFTY (stylised)	30	03/07/1984
1373988	KINDER TIME (+ device)	29	22/02/1989
1440569	KINDER CUORDIFRUTTA (stylised)	30	07/07/1990
1440579	KINDER PINGO (stylised)	30	07/09/1990
1507498	KINDER CHOCO BLANC (+ device)	29	22/07/1992
1507499	KINDER CHOCO BLANC (+ device)	30	22/07/1992
1524541	KINDER PINGUI	30	22/01/1993
1529869	KINDER PINGUINO (Archived)	-	-
1529878	KINDER PINGUI (Archived)	-	-

1298128	KINDER SOFTY (stylised)	30	19/01/1987
1326031	KINDER DAYLICIOUS	30	18/05/1987
1541165	KINDER TIME	30	08/07/1993
1541166	KINDER TIME	32	08/07/1993
1560119	KINDER HAPPY HIPPOS SNACK	30	25/01/1994
1561631	KINDER HAPPY EGGS (+ device) - (Expired)	30	08/02/1994
1569173	KINDER HAPPY HIPPO SNACK (+ device)	30	19/04/1994
1569175	KINDER HAPPY EGGS (Expired)	30	19/04/1994
1569226	KINDER TONUS	30	19/04/1994
1569247	KINDER SCHOKO-BONS (+ device)	30	19/04/1994
1573811	KINDER CROKO-KISS (Expired)	30	01/06/1994
1579263	KINDER PINGUI (+ device)	30	22/07/1994

<u>No</u>	<u>Trade Mark</u>	<u>Class</u>	<u>Application Date</u>
2011082	KINDER OVETTO (stylised)	30	14/02/1995
2030347	KINDER KING	30	14/08/1995
2125682	KINDER PROF. RINO	30	06/03/1997
2122787	KINDER MILK SLICE (+ device)	30	05/02/1997
2147366	KINDER PROF. RINO (+ device)	30	08/10/1997

Copy of Evidence Summary from Opposition No 47934. (Paragraph numbers are as per the original.)

Opponents' Evidence-in-Chief

8. *This consists of eight declarations. The first declaration dated 2 September 1998 is by Martin Krause who is a trade mark agent and a partner in the firm of Haseltine Lake Trademarks who are the opponents' professional representative in these proceedings. The purpose of his declaration is to have admitted into the proceedings the declaration of Vivienne Wooll dated 14 August 1998 and exhibits VW1 to VW5 thereto. In his declaration Mr Krause notes that the declaration and exhibits of Ms Wooll are all headed for proceedings under the 1994 Trade Marks Act whereas these opposition proceedings are under the Trade Marks Act 1938; he adds that the error in the headings is inadvertent and does not affect the substantive matter contained in the declaration and exhibits. I note that the declaration of Vivienne Wooll was subsequently re-filed correctly headed for the proceedings in suit.*

9. *The second statutory declaration dated 3 December 1998 is by James Setchell. Mr Setchell is a Trainee Trade Mark Attorney also at Haseltine Lake Trademarks. Exhibit JCS1 to his declaration consists of copies of the registrations identified by the opponents in their Statement of Grounds, such copies having been obtained from the Trade Marks Registry's database on 2 December 1998.*

10. *The third declaration dated 5 February 1999 is by Vivienne Wooll. Ms Wooll states that she is the Manager External Affairs of Ferrero UK Limited, a member company of Ferrero Group (the Group) of which Ferrero SpA of Cuneo, Italy and Soremartec S.A. of Schoppach-Arlon, Belgium are also members (the Companies). Ms Wooll has held her current position since 1985; she confirms that she is authorised to make her declaration on behalf of the companies and that the information in her declaration comes from either her own knowledge or from the records of the companies to which she has full access. The following points emerge from Ms Wooll's declaration:*

- *that Ferrero UK Limited is the sole importer of Ferrero products in the United Kingdom;*
- *that the KINDER trade mark was first used by the Group in the United Kingdom in 1967 and that the Group have sold the following KINDER products in the United Kingdom: KINDER MILK SLICE, KINDER SURPRISE, KINDER CHOCOLATE, KINDER MAXI, KINDER BUENO and KINDER JOY. These are collectively referred to as the products. Photocopies of the packaging of the products (except KINDER MAXI sold by the Group under the KINDER trade mark are provided in exhibit VW1;*
- *that products have been sold by the Group under the KINDER trade mark in the United Kingdom and that products have been available in branches of at least the following retail outlets: Sainsburys, Tesco, Safeway, Gateway, Kwik Save and the Co-Op. Exhibit VM2 consists of sample invoices of products sold under the KINDER*

- trade mark;
- exhibit VM3 consists of a table showing sales in tonnes, consumer units and net revenue of products in the United Kingdom since 1967. I note that the net revenue under the respective trade marks in the periods indicated is as follows: KINDER MILK SLICE (1986/87-1994/95) - £3.2m; KINDER SURPRISE (eggs) (1980/81 - 1994/95) - £91.3m; KINDER CHOCOLATE (packs) (1986/87-1994/95)- £2.7m; KINDER MAXI (1990/91-1993/94) - £313K and KINDER BUENO (1990/91-1994/95) - £ 2.8m. Figures are also provided for invoices sales in the United Kingdom of goods under the KINDER JOY trade mark in the period September 1995 to July 1998 but these relate to sales after the material date in these proceedings;
 - approximate annual amounts spent on advertising the various trade marks is provided as is said to be as follows: KINDER SURPRISE - between 1983 and 1994/1995 approximately £12m; KINDER BUENO - between 1992 and 1994/95 approximately £197k; KINDER CHOCOLATE - between 1987 and 1994/95 approximately £300k and KINDER MILK SLICE - between 1989 and 1994/95 approximately £900k. Exhibits VW4 and VW5 consist respectively of: copies of advertising material for certain of the products together with catalogues and other literature produced by the Group and a video containing television advertisements for the trade marks KINDER MILK SLICE (1989-1990), KINDER SURPRISE (shown since 1995) and KINDER BUENO (shown in 1994 and 1995).

11. The fourth declaration dated 17 December 1998 is by Michael Robert Morris. Mr Morris states that he is a Corporate Investigator employed by Keypoint Services Limited of Hampton, Middlesex a position he has held since 1994. He explains that in July 1998 acting under instructions from Taylor Joynson Garrett he carried out enquiries to determine if trade mark Nos 1240460 KINDERGEN and 1358486 KINDER-VITES were being used in the United Kingdom. I do not think it is necessary to summarise the remainder of Mr Morris's declaration or exhibits MRM1 and MRM2 thereto here, but note his investigations which suggest that (i) the product sold under the KINDERGEN mark is a tube or sip feed designed to provide complete nutritional support or supplementary feeding for infants and children with chronic renal failure and that it is only available on prescription and (ii) that the KINDER-VITE product which is a chewable children's vitamin is not available in the United Kingdom and is only available in Russia under a Russian label.

12. The remaining declarations are from employees of the firm of Taylor Joynson Garrett who are the opponents' solicitors in these proceedings. They are as follows:

Christopher James Benson (solicitor) dated 3 March 1999 and exhibits CJB1-CJB3 thereto;

Wolfgang Kotzur (trainee solicitor) dated 1 March 1999 and exhibits WK1-WK3 thereto;

Christopher David Miller (solicitor) dated 19 February 1999 and exhibits CDM1-CDM3 thereto;

Michelle Sylvia Rodrigues (solicitor) dated 23 February 1999 and exhibits MSR1-MSR3 thereto.

13. The content of the declarations of Mr Benson and Mr Kotzur are reproduced verbatim

below:

Mr Benson

“1. I am a solicitor in the firm of Taylor Joynson Garrett, solicitors for Ferrero SpA and Soremartec (the opponents) in this matter. Save where otherwise appears, the facts of the matters to which I depose are within my personal knowledge through my involvement in this matter. Insofar as I rely on information communicated to me by third parties, I believe this information to be true.

2. On 3 September 1998, I travelled with colleagues to Dartford in Kent in order to conduct surveys involving members of the public.

3. There is now produced and shown to me marked CJB 1 a copy of the questionnaire used for the survey which I and my colleague Christopher David Miller carried out.

4. The survey took place at the Royal Victoria and Bull public house in Dartford. Members of the public were approached on the street outside by representatives of Field Management Limited and recruited for a face to face interview.

5. I interviewed members of the public brought to me by agents of Field Management and recorded their responses on a questionnaire.

6. There is now shown to me and marked CJB2 copies of the photocopies referred to at question one. I showed the interviewee the KINDER SURPRISE egg when asking question eight.

7. I confirm that the interviewees were not at any stage led or encouraged to give answers that would assist the opponents or which were detrimental to the case of Soldan Holding & Bonbonspezialitäten GmbH. All the interviews I carried out during the survey I conducted openly and honestly and interviewees responses were recorded in their entirety.

8. I interviewed and completed questionnaires for 29 people in total. There is now produced and shown to me marked CJB3 copies of all the original completed questionnaires showing the results of all the interviews which were conducted by me in respect of this survey in Dartford.

9. I have read Christopher David Miller’s affidavit and the replies of the 16 members of the public he questioned.

10. The following result emerges from the survey:-

In response to question 12, 28 out of the 45 people questioned (62.22%) said they would be surprised that there was no connection between KINDER EUKAL, KINDER EM EUKAL and KINDER FUR KINDER (sic) on the one hand and “the people who make KINDER SURPRISE” on the other.

11. I have read the declarations of Michelle Sylvia Rodrigues and Wolfgang Kotzur

and the replies of the 40 members of the public they questioned.

12. The following results emerge from the survey:-

12.1 In response to question 1, what does the word KINDER mean to you, 27 people out of the 40 questioned (67.5%) said only either chocolate, egg, chocolate egg or Kinder egg. 1 person said both children and Kinder egg.

12.2 Of the six people who only said child or children in response to question one, four of them said chocolate egg when asked what the word KINDER means to them in respect of food in response to question 2."

Mr Kotzur

"1. I am trainee solicitor in the firm of Taylor Joynson Garrett, solicitors for Ferrero SpA and Soremartec (the opponents) in this matter. Save where otherwise appears, the facts of the matters to which I depose are within my personal knowledge through my involvement in this matter. Insofar as I rely on information communicated to me by third parties, I believe this information to be true.

2. On 3 September 1998, I travelled with colleagues to Dartford in Kent in order to conduct surveys involving members of the public.

3. There is now produced and shown to me marked WK1 a copy of the questionnaire used for the survey which I and my colleague Michelle Sylvia Rodrigues carried out.

4. The survey took place at the Royal Victoria and Bull public house in Dartford. Members of the public were approached on the street outside by representatives of Field Management Limited and recruited for a face to face interview.

5. I interviewed members of the public brought to me by agents of Field Management and recorded their responses on a questionnaire.

6. There is now shown to me and marked WK2 the KINDER word card referred to at question one. I showed the interviewee the KINDER SURPRISE egg when asking question four, the packaging of the KINDER CHOCOLATE product asking question nine, the packaging of the KINDER BUENO product when asking question fourteen and the KINDER JOY product when asking question nineteen.

7. I confirm that the interviewees were not at any stage led or encouraged to give answers that would assist the opponents or which were detrimental to the case of Soldan Holding & Bonbonspezialitäten GmbH. All the interviews I carried out during the survey I conducted openly and honestly and interviewees responses were recorded in their entirety.

8. I interviewed and completed questionnaires for two people in total. There is now produced and shown to me marked WK3 copies of all the original completed questionnaires showing the results of all the interviews which were conducted by me in respect of this survey in Dartford."

14. I note that the declarations of Mr Miller and Ms Rodrigues are in virtually identical terms to those of their colleagues completing the respective surveys (Mr Benson in the case of Mr Miller and Mr Kotzur in the case of Ms Rodrigues) varying only to the extent necessary to identify the number of members of the public they interviewed (16 in the case of Mr Miller and 38 in Ms Rodrigues's case). The conclusions to be drawn from the results of these two surveys from the opponents' standpoint is contained in Mr Benson's declaration above; I shall return to this survey evidence later in my decision.

Applicants' Evidence-in-Chief

15. This consists of four declarations. The first dated 10 September 1999 is by Berenice Patricia Bella Harris. Ms Harris is a registered trade mark agent and a solicitor in the employ of Carpmaels & Ransford, who are the applicants' professional representatives in these proceedings. In paragraph 1 of her declaration Ms Harris says:

"I receive instructions on behalf of the applicant from its German attorney, Dr. Jochen M. Schäfer of Beiten Burkhardt Mittl & Wegener. Unless otherwise stated, this declaration is based on my own knowledge or is derived from my firm's records or other documents to which I refer specifically."

16. The first part of Ms Harris's declaration deals with the circumstances which lead to the amendment of the application in suit. I do not propose to summarise her observations here but will bear them in mind when reaching my decision. In paragraph 3 of her declaration Ms Harris comments as follows:

"3. My understanding from Dr Schäfer is that the mark is intended by the applicants (a German company) for use in respect of products for children, as denoted by the German words "für kinder" in the mark. Accordingly the applicant will apply to amend the application so as to make this clear. The applicant will also apply to amend the specification so as to delete "diet bars, diet chocolates, diet bakery products" and exclude chocolate and bakery products generally. The proposed amended specification is as follows:

Sugar products, dragees, tablets, dextrose tablets and compressed sugar tablets, eucalyptus lozenges, diet candy, vitamin candy, sugar gums, chewing gums, diet sugar products, diet dragees, diet toffees, diet chewing gums, diet sugar gum products; all for children; all included in Class 30; but not including chocolate products or bakery products."

17. Ms Harris explains that David Rickard of Boulton Wade Tennant who has the day-to-day responsibility for handling other trade mark matters on the applicants' behalf has filed a declaration in other related proceedings between the parties dealing with knowledge of the German language and of the meaning of the word KINDER in the United Kingdom. A copy of Mr Rickard's declaration dated 15 October 1998 originally filed in Revocation proceedings No 9548 is provided as exhibit BPBH3.

18. In his declaration Mr Rickard confirms his position as a trade mark agent, solicitor and a partner in the firm of Boulton Wade Tennant. He confirms that his declaration is based on his own knowledge and on documents to which he refers. The remainder of his declaration is

reproduced verbatim below:

“2. Now produced and shown to me marked exhibit DJR1 are copy extracts from the 1997 edition of *Statistisches Jahrbuch* produced by *Statistisches Bundesamt*. The extracted page 273 relates to tourism in Germany. On page 273 numbers of tourists visiting Germany from various countries are shown for 1996. 1,350,400 tourists from the UK, including Northern Ireland, visited Germany. 2,946,700 nights were spent by UK tourists in Germany. Extracted page 82 shows the number of Germans emigrating to various countries. In 1996 in excess of 20,000 Germans migrated to the United Kingdom (including Northern Ireland). Also included in exhibit DJR-1 is a copy extract from the 1997 edition of the *Austrian Tourist Office Annual Report*. In 1997 531,926 tourists from the UK visited Austria. 2,478,040 nights were spent by UK tourists in Austria in 1997.

3. Now produced and shown to me marked exhibit DJR-2 are copy extracts from two books available in the United Kingdom namely “*German In Three Months*” published by Hugo’s Language Books Limited and “*Ealing Course in German*” published by Longman. These books teach German language to English speakers. I note from the “*German-English vocabulary*” section of the Hugo book that the word “*kinder*” means “*child*”. Lesson 1 of the Hugo book deals with the general principles of speaking German and in particular, “*the alphabet, spelling and pronunciation, vowels and vowel combinations, consonants, punctuation and stressed syllables*”. Lesson 2 deals with “*greetings, every day phrases*”, “*gender*” and other basics. In lesson 2, the reader is introduced to certain German words. On page 23 the word “*kind*” is taught and is said to mean “*child*”. On page 24 the reader is taught the plural of the noun is “*kinder*”. This lesson includes various exercises which make reference to the words “*kind*” and “*kinder*”. In the Longman book, the reader is introduced to the word “*kinder*” in lesson 3. In both books, the word “*kinder*” is introduced at an early stage in the lessons programs.

4. When studying for European Patent Examinations, I learnt some German language. One of the earliest words which I learnt was “*kinder*” meaning “*child*”. I believe that this word is taught to students learning the German language at an early stage in most cases in the UK. The word “*kinder*” is one of the German words which I still recall from my lessons including its meaning of “*child*”. This word has made its way into the English language in words such as “*kindergarten*”.

5. Also included in exhibit DJR-2 is a copy extract from the *Times Educational Supplement* of 28 August 1998 listing the numbers of students who sat various GCSE exams in 1997 and 1998. German was the second most popular foreign language subject and apparently the tenth most popular course overall. I note that the total number of students who sat the exam for German in 1998 was 133,683. The number of 1997 was 132,615.

6. Now produced and shown to me marked exhibit DJR-3 is a copy extract from the *Shorter Oxford Dictionary*. The word “*kind*” is a well known English word and the word “*kinder*” is a variation of the word “*kind*”. It means more “*acceptable, gentle, agreeable, soft*”. I also note that the German word is listed with its English meaning of “*children*” thereby establishing that it is recognised generally in the UK. Also

included in Exhibit DJR-3 are copy extracts from Dutch-English, Afrikaans-English,

German-English and Spanish-English dictionaries. Each of these shows that the word “kind” and “hence “kinder” are words in these languages.”

19. Ms Harris comments that the fact that the word KINDER is understood by a large number of people in the United Kingdom as meaning or relating to children is borne out by the opponents own evidence. Ms Harris observes that of the 85 people questioned in the two surveys, 23 people recognised the word as meaning child or children and a further 5 people referred to “kindergarten” (ie a nursery school) or just garden. If the opponents surveys are considered to be representative says Ms Harris, this would indicate that approximately one third of the population of the United Kingdom understands the word KINDER to indicate or relate to children.

20. Ms Harris makes the following observations on the declaration of Ms Wooll which is summarised above:

- that the opponents only list six products as having been sold under the KINDER trade mark, of which five appear to be chocolate products with the other (KINDER MILK SLICE) appearing to be a dairy bakery product. In Ms Harris’s view none of these goods appear to be similar in any way to the revised specification indicated above;*
- that sales of goods under the trade mark KINDER JOY did not begin until September 1995 ie. after the filing date of the application in suit;*
- that apart from the presence of the word KINDER, none of the packaging used on the opponents’ products bears a mark which is similar to the application in suit;*
- that in so far as the opponents’ television advertisements are concerned, the advertisement for the trade mark KINDER SURPRISE is after the material date in these proceedings and that it is uncertain from when in 1994 the KINDER BUENO advertisement dates. Once again Ms Harris concludes that the advertised products are not similar to the goods in the applicants’ revised specification. Ms Harris comments as follows:*

“It would therefore appear from the declaration of Ms Wooll that any reputation acquired by the opponents in the UK before the filing date of the application in relation to products bearing marks which incorporated the word KINDER could not have extended beyond chocolate products and a dairy sponge snack. However their own survey evidence suggests that such reputation may not extend beyond the KINDER SURPRISE eggs”;

- exhibit BPBH5 consists of extracts from the Trade Marks Registry database and where device marks are involved, copies of the extracts from the relevant Trade Marks Journal for all the trade marks relied upon by the opponents in their Statement of Grounds. Ms Harris comments that from the evidence of Ms Wooll it is clear that the majority of these have not been used and that in her view the only common feature is the presence of the descriptive word “kinder”.*

21. Ms Harris concludes her declaration in the following terms:

“As is apparent from the application, the applicant is a German company. I understand from Dr Schäfer that the applicant uses the word kinder on its products to indicate their particular suitability for children. The mark also incorporates the device of a child, which I would expect to reinforce the concept of a product suitable for children.”

22. *The second declaration dated 1 March 2000 is by the same Berenice Harris mentioned above. Ms Harris explains that she has undertaken or arranged for various searches to be carried out to show the use made of KINDER in the United Kingdom. The nature of these searches were as follows:*

(1) An on-line search of Yellow Pages on the Internet for businesses which included the word KINDER. A copy of the search report is provided as exhibit JDM1 to the declaration of James Dominic Moore to which I shall refer later in this decision. Having used the “?” symbol to reveal the nature of the business, Ms Harris explains that the report was annotated accordingly. Having explained the limitations of the search system used (to the effect that the search only revealed businesses where KINDER forms part of the first word or entry or where the first word is an initial or preposition), Ms Harris concludes that the search shows widespread use throughout the United Kingdom of KINDER in the context of businesses related to children.

(2) On-line searches on the Companies House web site for companies using the word KINDER in their names. Ms Harris explains that she searched in the “Companies Name & Address Index with Basic Company Information” entering KINDER against “Company/Branch name” in the search engine and selected searches in respect of (1) Current/Recently Dissolved names, (2) Previous names and (3) Dissolved names. Copies of the list of “Current/Recently Dissolved names” and the list of “Previous names” together with attached company particulars are provided as exhibits JDM2 and JDM3 to the declaration of Mr Moore. Exhibit BPBH8 consists of a copy of the list of “Dissolved names”. Ms Harris explains that as these were all dissolved companies which could not be contacted for further information individual company searches were not performed. However she notes from the list of “Dissolved names” that in many cases KINDER was used in the context of a business related to children.

(3) Search International were instructed to carry out a United Kingdom “Common Law” search for KINDER to include use as a business name, trade mark or descriptively in respect of any goods or services related to children. A copy of the search report is provided as exhibit JDM4 to the declaration of Mr Moore.

23. *Ms Harris explains that the reports mentioned above were passed to Mr Moore with instructions to telephone as many of the businesses as he could with a view to establishing whether the businesses or products were child-related, how long KINDER had been used in the name and why it was chosen. While not summarised here, Ms Harris explains in detail the manner in which the various reports were annotated by her prior to them being given to Mr Moore. She adds that she also asked Mr Moore to inspect the 1994 telephone directories maintained by British Telecom Archives and to obtain copies of any entries for businesses which included KINDER in their name; Mr Moore was asked to cover as many regions as possible. Copies of Mr Moore’s investigations in this regard are provided in exhibit JDM6 to his declaration.*

24. Exhibits BPBH9 and BPBH10 consist of copies of declarations dated 16 and 17 February 2000 filed in parallel opposition proceedings No 48318 to the trade mark *EUKAL FUR KINDER* and device by the same David Rickard mentioned above. Ms Harris explains that the applicant in these proceedings relies on the matters contained in these declarations and the associated exhibits.

25. I have already reproduced verbatim paragraphs 2 to 6 of the declaration dated 16 February 2000 above. The relevant points emerging from the remainder of Mr Rickard's first declaration are, in my view, as follows:

- *that in view of the comments in Ms Wooll's declaration to the effect that only six products have been sold under the KINDER mark in the United Kingdom, Mr Rickard concludes that Ferrero and/or Soremartec have not used in excess of 50 of the trade marks listed in their Statement of Grounds;*
- *exhibit DJR-5 consists of copies of letters dated 28 November 1997 and 2 June 1999 received by his firm from the Office for Harmonisation in the Internal Market (OHIM) in response to an application to register the trade mark KINDERCARE. Mr Rickard notes that the Examiner in rejecting the application stated that "kinder is a German word known throughout the Community to mean "child" or "children", that the trade mark "conveys a simple and obvious descriptive meaning" and that the combination is desirable for other traders to use in the course of trade as a descriptive indication. The mark nonetheless would be readily understood in English, German and Dutch as being primarily descriptive. The mark merely indicates goods and services for children which involve care or caring";*
- *exhibit DJR-7 is said to consist of copies of Decisions of the German Patent Office together with English translations. However only copies of the documents relating to the trade mark "kinder eukal" are provided. The Decision dated 25 July 1997 relates to an opposition by Ferrero to registration of the trade mark KINDER EUKAL. Mr Rickard refers to the following passages from the Decision:*

"In the present case, the first element "kinder" of the multiple word mark points out to the addressed consumers i.e. children, the particular suitability of the goods marked this way in a descriptive manner and is not suitable to shape the attacked mark by itself. The addressed consumers will not be enabled to make reference from the word "kinder" the place of origin on the goods labelled with the trade mark in dispute and, therefore, such consumers will base their distinction of this trade mark.....predominantly upon the element "eukal". For this reason, the risk may be neglected that the addressees will compare the element "kinder" separated from the rest with the prior trade mark. Thus a direct risk of confusion can be denied. In addition, there is no risk that the attacked mark may be associated with the opposing mark."

"In view of the insufficient distinctiveness of the word "kinder" it lacks the suitability to serve as a reference necessary to infer to the identical place of origin of the goods";

- *although copies are not provided, Mr Rickard also refers to Decisions of the German Patent Office in cases S112/97 and S175/96. He explains that in S112/97 the German Patent Office held that registration No 39610402 for a stylised representation of the words FUR-KINDER was invalid. Mr Rickard says that it was held that “the trade mark (FUR-KINDER) is devoid of the necessary minimum degree of distinctiveness” stating that “the word elements have a mere factual character” and the registration was cancelled. The Patent Office held “on its own the words FUR-KINDER obviously represent a statement of determination, as children form the preferred target for the products in question ie. confectionery, and as such goods with respect to their composition, taste and presentation are frequently in particular designed to the needs and desires of children”. He adds that the Patent Office went on to hold that “it is also conventional to refer to such kind of determination within the product group “confectionery” by way of a determination like “FUR-KINDER”. Consequently, it can be held that competitors have a great interest in having these words reserved for free use of all.”*
- *in so far as the Decision in S175/96 is concerned, the German Patent Office held that trade mark No 39610406 CHILDREN’S CHOCOLATE should be cancelled. The Office held that “on its own the words CHILDREN’S CHOCOLATE originating from the English language represent a typical description of goods with the meaning “chocolate for children”. It held that “children form a preferred target group for the goods of the type claimed” “hence, for the concerned goods, which may all be made of chocolate or at least may contain chocolate, the attacked mark merely contains a reference to chocolate products, which are in particular intended for or suitable for children. This is easily comprehensible for the major part of the domestic consumers”;*
- *exhibit DJR-8 consists of copies of various web sites which include KINDER in connection with children together with a list of companies in the United Kingdom which include KINDER in their name;*
- *exhibit DJR-9 consists of copy extracts printed from a search of a CD provided by BT containing telephone listings for the UK, the results of a search of Yellow pages on the Internet and copy extracts of various BT telephone directories published in 1997 for areas of the United Kingdom all in relation to the word KINDER. Mr Rickard estimates that the directories searched constitute approximately 60% of the BT directories covering the United Kingdom. Mr Rickard notes that the names of some of the entries describe the nature of the business and adds that on 16 February 2000 his assistant Julius Stobbs telephoned a number of entries from the list to establish the nature of their business. Of the ten companies Mr Stobbs contacted, I note that all were involved with goods and services relating to children.*

26. *Exhibit BPBH10 consist of a copy of Mr Rickard’s declaration of 17 February 2000. Exhibit DJR-10 to that declaration consists of details of United Kingdom and Community trade mark registrations which include KINDER which are not owned by the opponents in these proceedings.*

27. *Finally Ms Harris explains that Search International were instructed to carry out a United Kingdom “Similarity Search” in respect of EUKAL in Classes 5 and 30 to establish to*

what extent third parties might have pending or registered trade marks in or covering the United Kingdom similar to the EUKAL part of the applicants' mark. A copy of the report is provided as exhibit BPBH11 with Ms Harris concluding from it that EUKAL is highly distinctive for the goods covered by the application.

28. *In so far as the searches mentioned above are concerned, Ms Harris comments:*

"I believe that it is apparent from the searches carried out on behalf of the applicant that KINDER is widely understood and used throughout the United Kingdom as referring to children and that this was also the case at the date of the application in suit."

29. *The third declaration dated 1 March 2000 is by James Dominic Moore. Mr Moore is a trainee trade mark agent in the employ of Carpmaels & Ransford. Mr Moore states that he has been assisting Ms Harris who has the conduct of these proceedings on behalf of the applicants for registration. He explains that on 18 February 2000, Ms Harris gave him copies of the documents mentioned in her second declaration above. Mr Moore explains that Ms Harris suggested the businesses which he might contact by annotating the pages accordingly; he confirms the instructions given to him by Ms Harris which included not contacting the list of Kindergartens from the Search International Report or any business where it was clear that the name of the business clearly derived from the name of an individual or where the business clearly would not be related to children. Having obtained in so far as was possible the telephone numbers of the companies on the respective lists, Mr Morris explains that he contacted the companies concerned identifying himself as a trade mark agent who was conducting a survey of companies that included KINDER in their name. Not surprisingly, Mr Morris was not able to obtain information from all the companies he contacted. Of those who were willing to assist, he asked the following questions; (1) what is your company's business? (2) how long has your company used a name that contained KINDER? (3) why was the company name that included the word KINDER chosen? (4) the name of the person to whom Mr Moore spoke. The results of his investigations are provided in exhibit JDM5. I note that in response to question (3), the majority of the responses suggest that the name was chosen because it means or relates to children.*

30. *Mr Morris explains that in so far as the Search International Report was concerned, that he tried on 25 February 2000 to contact the businesses responsible for the following products: KINDERVITAL, KINDERVITAL P.R.O.D., KINDERGUARD, KINDERBOX, KINDER WORLD and KINDERCRYL. Mr Moore provides the results of these investigations and comments:*

"On the various occasions when the persons to whom I spoke answered to the effect that KINDER means children in German, I formed the impression, from the way they said this, that they thought that this was obvious and well-known."

31. *In so far as Mr Moore was asked to obtain copies from the BT Archive of extracts from BT telephone books for 1994 which showed entries for businesses which included KINDER in their name, Mr Moore explained that he visited the BT Archive in High Holborn, London on 22 February 2000. During his visit explains Mr Moore he reviewed the 1994 London Business Pages and regional 1994 BT telephone books, although because of time constraints he was unable to review all of the documents and selectively ignored some of the rural*

Scottish and Welsh directories. Exhibit JDM6 consist of copies of pages from the various 1994 telephone directories showing business names beginning with KINDER.

32. The final declaration dated 1 March 2000 is by the same David Rickard mentioned above. The purpose of his declaration is simply to confirm the truth and accuracy of the evidence filed by Ms Harris in so far as it included references to evidence provided by him and filed in related proceedings.

Opponents' evidence-in-reply

33. This consists of a witness statement dated 2 August 2000 by the same Martin Krause mentioned above. Mr Krause comments:

“Unless otherwise stated, the Declaration is based on my own knowledge or is derived from other documents to which I refer specifically. I am also a German speaker with a good knowledge of the German language.”

*34. Mr Krause divides his response to the applicants' evidence into a number of sub-headings drawing conclusions where appropriate. He begins by reviewing the **meaning of the word KINDER**. Exhibit MHK1 and MHK2 are respectively, copies of page 854 of the Collins English Dictionary (third edition) 1994 which says Mr Krause lists all words in the dictionary commencing with the letters KIND and pages 472 and 473 of the Oxford Pocket Dictionary (sixth edition) dated 1978 showing, he says, the same results as the Collins dictionary. Mr Krause accepts that the word “kind” is widely known as the comparative form of the adjective “kind”. In so far as Ms Harris relies in exhibit BPBH3 on the declaration of Mr Rickard who in turns relies on an extract from New Shorter Oxford Dictionary, Mr Krause notes that two entries incorporating the word kinder are identified, these are: KINDER, KIRCHE, KUCHE and KINDERSPIEL. Of these entries Mr Krause says:*

“I am unaware of any use of either the above phrase or the above word in common parlance. I am aware that the New Shorter Oxford English Dictionary includes a number of references to obsolete, archaic and dialectal words, as well as many words and phrases which, though still in occasional use, are used only by a very small minority of the population. I believe, therefore that the phrase KINDER, KIRCHE, KUCHE and the word KINDERSPIEL are now either obsolete in the English language or are used only by a very small minority of the population of this country”

and he concludes that there is no indication that the word “kinder” had “made its way into the English language” at the relevant date, other than as the comparative form of the English word “kind”.

*35. In relation to the **use of the word KINDER**, Mr Krause notes that only the search of the 1994 telephone directories referred to in Mr Moore's declaration (exhibit JDM6) reflect the position at the material date in these proceedings. Mr Krause comments that it is apparent from the searches that the word “kinder” is a surname adding that the search reveals only four businesses in the London area and nineteen elsewhere whose names commence with the word “kinder” whereas the search shows more than fifty entries for individuals with the surname “kinder”.*

36. In so far as **the word EUKAL** is concerned, Mr Krause notes the comments of Ms Harris when she said:

“I believe that it is clear from this report that EUKAL is highly distinctive for the goods covered by the application.....”

37. Exhibit MHK3 consists of an extract taken from the Oxford Duden German Dictionary showing the entry for the German word “Eukalyptus”, which means in English “eucalyptus”. Mr Krause comments that the word EUKAL appears, therefore, to be derived from the first two syllables of the German word “Eukalyptus” and in his view is phonetically identical with and visually almost the same as the first part of the English word “eucalyptus”.

38. Finally in relation to the **amendment of the mark**, Mr Krause says:

“I concede that the term “eukal für kinder” would be interpreted by a German speaker as essentially the same, in meaning, as “Kinder eukal”; the terms can be translated into English as “eukal for children” and “children’s eukal” respectively”,

he goes on to say that in his opinion more than a rudimentary grasp of the German language would be necessary in order to appreciate this point. He adds that:

“While it is also conceded that the use of the capital letter K in the amended mark is, technically, correct in that it is usual in German for the first letter of a noun to be a capital letter, this point is unlikely to be appreciated by those in this country without a knowledge of German, as there is no such practice in contemporary English (other than in relation to proper nouns). I believe that the use of a capital letter K in the amended mark, would simply be seen as a way of giving prominence to the word, and, perhaps, signifying that it is a trade mark.”