

O/785/19

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3302748 BY
FOSHAN SHUNDE QINGZHOU ELECTRIC APPLIANCES CO. LTD
TO REGISTER:**



AS A TRADE MARK IN CLASSES 7 & 11

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 413255
BY DE LONGHI BENELUX SA**

Background and pleadings

1. Foshan Shunde QINGZHOU Electric Appliances Co., Ltd (“the applicant”) applied to register the following trade mark in the United Kingdom on 10 April 2018:



It was accepted and published in the Trade Marks Journal on 27 April 2018 in respect of the following goods and services:

Class 7

Mixing machines; Crushers for kitchen use, electric; Mixers [machines]; Mills for household purposes, other than hand-operated; Pepper mills other than hand-operated; Coffee grinders, other than hand-operated; Kitchen machines, electric; Whisks, electric, for household purposes; Fruit presses, electric, for household purposes; Food processors, electric; Kitchen grinders, electric; Butter machines; Flour mill machines; Bread cutting machines; Food preparation machines, electromechanical; Milking machines; Brewing machines; Beverage preparation machines, electromechanical.

Class 11

Lamps; Lighting apparatus and installations; Lights for vehicles; Cooking apparatus and installations; Fruit roasters; Kitchen ranges [ovens]; Pressure cookers [autoclaves], electric; Coffee machines, electric; Barbecues; Kettles, electric; Microwave ovens [cooking apparatus]; Multicookers; Electric fans for personal use; Laundry dryers, electric; Air purifying apparatus and machines; Solar thermal collectors [heating]; Water purification installations; Pocket warmers; Electric appliances for making yogurt.

2. The application was partially opposed by De Longhi Benelux S.A. (“the opponent”) on 27 July 2018. The opposition is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) and concerns the following goods:

Class 7

Mixing machines; Crushers for kitchen use, electric; Mixers [machines]; Mills for household purposes, other than hand-operated; Pepper mills other than hand-operated; Coffee grinders, other than hand-operated; Kitchen machines, electric; Whisks, electric, for household purposes; Fruit presses, electric, for household purposes; Food processors, electric; Kitchen grinders, electric; Butter machines; Flour mill machines; Bread cutting machines; Food preparation machines, electromechanical.

Class 11

Cooking apparatus and installations; Fruit roasters; Kitchen ranges [ovens]; Pressure cookers [autoclaves], electric; Coffee machines, electric; Barbecues; Kettles, electric; Microwave ovens [cooking apparatus]; Multicookers; Electric appliances for making yogurt.

3. With regards to its claim based upon sections 5(2)(b) and 5(3) of the Act, the opponent is relying upon EU Trade Mark (EUTM) 1284199: **CHEF**. The mark was applied for on 20 August 1999 and registered on 24 April 2003 in respect of the following goods:

Class 7

Food mixers.

4. The opponent claims that its mark is incorporated in its entirety in the applied-for mark and that the opposed goods are identical or similar/complementary. It claims that the applied-for mark could be misconstrued as a sub-brand of the opponent’s trade mark such that there exists a likelihood of confusion on the part of the public and consequently the application offends against the provisions of section 5(2)(b) of the Act.

5. Additionally, or alternatively, the opponent claims that use of the applicant's mark without due cause for all the opposed goods would take unfair advantage of the reputation of the earlier mark and cause detriment to the reputation of that mark. Therefore, registration of the contested mark should be refused under section 5(3) of the Act.

6. Under section 5(4)(a) of the Act, the opponent claims that use of the applicant's mark for the opposed goods is liable to be prevented under the law of passing off, owing to its goodwill attached to the sign **CHEF**, which it claims to have used throughout the UK since "some time in the 1950s", in respect of the following goods, some of which are covered by the earlier mark:

Food mixers and food preparation equipment and machines and attachments and accessories for the aforesaid goods.

7. The applicant filed a defence and counterstatement, denying all the grounds. It also requested that the opponent provide evidence of proof of use of the earlier mark.

8. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that I consider necessary.

9. The opponent also filed written submissions on 29 January 2019. These will not be summarised but will be referred to as and were appropriate during this decision.

10. A Hearing took place before me on 11 December 2019, with the opponent represented by Andrew Lomas of Counsel, instructed by Mathys & Squire LLP. The applicant did not attend the hearing or make written submissions in lieu of attendance. In these proceedings, it is represented by Haseltine Lake Kempner LLP.

Evidence

11. The opponent's evidence comes from Mr Claude Geiben, Director with special powers of De Longhi Benelux S.A. (DLBSA) since 26 November 2014. It is dated 29 January 2019.

12. In November 2013, DLBSA became the owner of the earlier mark, following the merger of De'Longhi Benelux SA and De Longhi Household SA, and the change of name to DLBSA. Exhibits CG01-CG04 contain documents that confirm ownership.

13. Mr Geiben states that the **CHEF**-branded food mixer was first launched in 1950 under the name "the Kenwood Electric Food Chef".¹ It has been on sale continuously since, and the evidence contains examples of advertisements through the decades:²

"shsh... we're giving Mummy a Kenwood Chef!"

A Kenwood Chef in your kitchen—and you say goodbye to all the hard, wrist-aching part of making exciting meals. Just plan the menus and then hand over the work to your Chef—your Kenwood Chef. Here's the power to do the jobs that are—let's face it—the real chores of the kitchen.

This is what your Kenwood Chef does for you : swiftly, thoroughly, it minces, mixes, beats, slices and shreds. It peels potatoes—opens cans. Give your Chef the work to do. It's to-day's "kitchen staff". Better still, it's ready and willing every minute of the year. You deserve to have—you need to have—you can have a Kenwood Chef!

Note to husbands
You can buy her a Kenwood Chef
for an initial payment of only
£3 - 15 - 0
and eight monthly payments of £3.15s.
THE PRESENT WITH A FUTURE

Cash Pr
£31.8s.4d

The Standard Pack is complete with Mixing Bowl, Beat Whisk, Dough Hook, Spat and Dust-cover. AC/DC 115, 120/175, 200/250 Volts.

See the Kenwood Chef **IN ACTION** at your local electrical shop, in department stores and Electricity Board showrooms.

All Kenwood appliances can be bought on advantageous credit-sale and Hire Purchase Terms. Write for **FREE** Illustrated literature about all the **KENWOOD** team.

You have endless possibilities for novel and exciting recipes with the Kenmix. It juices, mixes, blends, pulverises and grinds; does the work of hours—anywhere in the kitchen. Price £10.5s.

The efficient Minor portable food mixer. Mix, beat or whip quickly and thoroughly anywhere in the kitchen. Price £10.5s.

Here's the perfect steam and dry iron—the Kenwood Sizzam-o-matic. It uses ordinary tap-water; it made in "Stay-brite" stainless steel, thermostatically controlled light and easy to use. Price £6.11s.

Warming in Summer, cooling in Winter, NEW Kenwood Air is the air-conditioner's **UNIQUE** "AirFresher". Safe, silent, economical. Price 13 gns.

KENWOOD MANUFACTURING CO. LTD • DEPT. HS • WOKING • SURREY • ENGLAND
200

¹ Paragraph 8.

² The adverts reproduced here come from Exhibit CG11, pages 200 and 206.



The Chef
does everything
but cook
- that's what
wives are for!

"Cooking's fun" says my wife "... food preparation is a bore! Think of the meals I'd cook you if I had a Kenwood Chef!" For the Chef beats, whisks and blends. With its attachments it liquidises, minces, chops, cuts. Slices, grinds, pulps. It shells peas and slices beans. Peels potatoes and root vegetables. Opens cans, grinds coffee. Extracts fruit and vegetable juices. It helps with every meal—from a welsh rarebit to a four-course dinner. I can take a hint—I'm giving my wife a Kenwood Chef right away!

Other products in the range of Kenwood Kitchen Equipment Freezers, Refrigerators, Dishmaster Dishwashers, Waste-master waste disposal unit, Rotisserie Rotary Spit and Electric Knife Sharpener.

▲ The Kenwood Chef complete with two beaters, bowl and a big recipe and instruction book is yours for only 29.99. Tax paid. (Easy terms are available.)

JUST FOUR OF THE CHEF'S WONDERFUL ATTACHMENTS



MINCER LIQUIDISER POTATO PEELER CAN OPENER

The Kenwood Chef has more attachments — does more jobs — and costs less than any other food preparing machine.

Send off this coupon for a handsome personalty magnet about the Kenwood Chef

NAME _____
ADDRESS _____

Kenwood Manufacturing (Woking) Ltd., New Lane, Haslemere, Surrey, GU27 0JH.
WPK 124 ONE OF THE KENWOOD GROUP

I'm giving my wife a
KENWOOD Chef

14. The following sales figures are taken from Exhibit CG14:

North & East Europe:³

	Kenwood brand kitchen machines sales value (€)	Kenwood brand sales volume (units)	CHEF brand sales value (€)	CHEF brand sales volume (units)
2008	27,379,272	179,090	9,597,213	62,274
2009	30,858,371	185,799	10,743,411	64,296
2010	42,759,161	241,859	16,989,727	90,730
2011	52,056,579	287,465	20,380,576	100,441
2012	56,736,254	285,806	20,114,643	92,508
2013	62,213,661	317,940	20,462,369	97,094
2014	73,151,682	350,263	24,300,080	103,689
2015	69,014,623	322,944	22,679,078	93,132

South & West Europe:⁴

	Kenwood brand kitchen machines sales value (€)	Kenwood brand sales volume (units)	CHEF brand sales value (€)	CHEF brand sales volume (units)
2008	45,742,451	225,099	17,789,003	72,135
2009	53,116,609	259,879	20,964,247	76,743
2010	67,190,471	291,603	31,542,045	93,355
2011	72,860,953	295,613	37,035,296	103,557
2012	82,312,774	317,553	39,353,255	101,928

³ According to Exhibit CG15, this includes the following EU Member States: Belgium, Bulgaria, Croatia, Czech Republic, Denmark, Estonia, Finland, Hungary, Ireland, Latvia, Malta, Lithuania, Netherlands, Poland, Romania, Slovakia, Slovenia, Sweden and the UK. It also includes the following non-EU countries: Kyrgyzstan, Russia, Turkmenistan, Uzbekistan, Albania, Azerbaijan, Belarus, Bosnia-Herzegovina, Georgia, Iceland, Liechtenstein, Montenegro, Norway, Serbia, Ukraine.

⁴ According to Exhibit CG15, this includes the following EU Member States: Austria, Cyprus, Germany, Italy, Portugal and Spain. It also includes the following non-EU countries: Turkey, Israel, Andorra, Armenia, Monaco, San Marino and Switzerland.

	Kenwood brand kitchen machines sales value (€)	Kenwood brand sales volume (units)	CHEF brand sales value (€)	CHEF brand sales volume (units)
2013	102,821,305	390,027	51,184,746	140,670
2014	124,460,133	472,087	62,771,821	158,159
2015	119,472,487	446,648	63,374,315	162,983

15. Earlier sales figures can be found in Exhibit CG06, the prospectus from the placing and public offer by Schroders of shares in Kenwood Appliances plc (“Kenwood”), which took place in 1992. Mr Geiben states that Kenwood is now part of the De Longhi group. The prospectus also provides details of the history of the brand. On page 100, it says:

“The Kenwood business was founded in 1947 and developed during the 1950’s and 1960’s, based largely on the Kenwood Chef.”

Later, on page 102, the following paragraph is found:

“Kenwood’s principal product is the Chef. The Chef is used for whisking, beating and mixing and can be supplied with a wide range of attachments for other uses such as mincing and blending. It is a robust, high quality and well designed product. Over seven million units have been sold since the Chef was first introduced in the 1950’s.”

16. The variety of attachments sold are shown in Exhibits CG08, CG09 and CG13. These include a frozen dessert maker, potato peeler, purée maker, citrus juicer, blender, chopper/grinder, slicer/grater, creaming beater, dicing attachment, food mincer, food processor, fruit press, grinding mill, pasta maker and pasta roller.

17. Exhibit CG18 contains information on the marketing budget in the UK and Ireland. This relates to the period 2005-2013.

18. Market research company reports in Exhibit CG17 show that Kenwood was the market leader globally for kitchen machines in both 2012 and 2016, although they do not provide information at the level of individual brands. In 2016, it was the top brand in the UK, France, Italy, Austria, Belgium, Spain, Portugal, Poland, Denmark, Finland, Sweden and Greece. The Chef was the second biggest global seller in 2012. In the UK, there is evidence of it being offered for sale through Kenwood's website and high-street retailers.

19. Exhibits CG19-CG22 contain reviews of goods marketed under the **CHEF** name from national publications, such as *Good Housekeeping* and *Observer Food Monthly*, and *Which?* reports. Advertisements and articles from a range of publications can be found in CG23. However, almost all of these appeared in publications from the period May 2006 – 1 November 2012.

20. Between 2007 and 2017, models bearing the **CHEF** name won various design awards.⁵

Proof of Use

21. Section 6A of the Act states that:

“(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

⁵ Exhibit CG24.

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

22. The opponent's earlier mark had been registered for more than five years on the date on which the contested application was published. It is, therefore, subject to these provisions, and the applicant has requested such proof for all the goods relied on. The opponent has made a statement that it has made genuine use of the mark in the EU, including the UK, in the relevant period for the goods upon which it is relying. The relevant period for these purposes is the five years prior to and ending on the date of publication of the contested application: 28 April 2013 to 27 April 2018.

23. The case law on genuine use was summarised by Arnold J (as he then was) in *Walton International Limited & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch):

“114. *The law with respect to genuine use.* The CJEU has considered what amounts to ‘genuine use’ of a trade mark in a series of cases: Case

C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundersvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816] [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W. F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].
- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a

single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

- (4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].
- (5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].
- (6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [132].”

24. As the earlier mark is an EUTM, I bear in mind the decision of the Court of Justice of the European Union (CJEU) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, in particular the following paragraphs:

“36. It should, however, be observed that ... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

and

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for that use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which the Community trade mark has

been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

25. The onus is on the opponent, as the proprietor of the earlier mark, to show use. Section 100 of the Act states that:

“If in any civil proceedings under this Act a question arises as to the use to which a registered mark has been put, it is for the proprietor to show what use has been made of it.”

26. The first issue I will consider is whether any use has been made by the opponent, or with its consent. Mr Geiben explains that:

“Historically, De’Longhi Benelux SA (‘D’LBSA’), under its previous name ‘Kenwood Appliances Luxembourg SA’ (‘KALSA’), licensed use of the IP to De’Longhi Finance S.A. (‘DLFSA’). DLFSA was given the right to sub-license the IP and under that authority, issued a sub-licence to Kenwood Limited (‘KLTD’). Since DLFSA changed its name to DLBSA, the Opponent became the licensee of the IP and the issuer of a sub-licence to KLTD.”⁶

26. Exhibit CG04 contains copies of the licence agreement dated 23 March 2006 between KALSA and DLFSA and the sub-licence agreement dated 24 March 2006 between DLFSA and Kenwood Limited, which is the undertaking that has used the mark. The first criterion – that the mark should be used by the proprietor or with its consent – has been met.

27. The image below shows how the mark appears on one of the products sold. The picture was taken from an article in *The Independent*, dated 28 March 2016:⁷

⁶ Paragraph 5.

⁷ Page 323.



The word “CHEF” can be made out more clearly on the machine shown in the undated picture (taken in a well-known department store), below:⁸



⁸ Exhibit CG25, page 390.

28. The registered mark frequently appears together with another mark “KENWOOD”. However, for the purposes of assessing whether there has been genuine use, this does not in itself create difficulties. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, the Court of Justice of the European Union (CJEU) found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in connection with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No. 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1).”

29. The sales figures quoted in paragraph 14, even bearing in mind that the EU will account for only a proportion of them, are, in my view, sufficient to show genuine use. I recall that there is no set market share which the opponent must reach. I note, however, that Kenwood was the best-selling brand for kitchen machines in 2016 in a selection of EU Member States. The tables in the aforementioned paragraph indicate that **CHEF**-branded goods accounted for approximately one-third of Kenwood sales in the north and east European region, and a slightly higher proportion in south and west European region. Based on the evidence, which I note has not been challenged, I infer that genuine use has been made of the mark for food mixers.

DECISION

Section 5(2)(b)

30. Section 5(2)(b) of the Act states that:

“A trade mark shall not be registered if because –

...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

31. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the courts of the European Union in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs (OHIM))* (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

b) the matter must be judged through the eyes of the average consumer of the goods or services in question. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks and vice versa;

h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

32. When comparing the goods, all relevant factors should be taken into account, per *Canon Kabushiki Kaisha*:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or complementary.”⁹

⁹ Paragraph 23

33. Guidance was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] RPC 281. At [296], he identified the following relevant factors:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

34. The goods to be compared are shown in the table below:

Opponent’s goods	Applicant’s goods
<p><u>Class 7</u> Food mixers</p>	<p><u>Class 7</u> Mixing machines; Crushers for kitchen use; Mixers [machines]; Mills for household purposes, other than hand-operated; Pepper mills other than hand-operated; Coffee grinders, other than hand-operated; Kitchen machines, electric; Whisks, electric, for</p>

Opponent's goods	Applicant's goods
	<i>household purposes; Fruit presses, electric, for household purposes; Food processors, electric; Kitchen grinders, electric; Butter machines; Flour mill machines; Bread cutting machines; Food preparation machines, electromechanical.</i>
	<u>Class 11</u> <i>Cooking apparatus and installations; Fruit roasters; Kitchen ranges [ovens]; Pressure cookers [autoclaves], electric; Coffee machines, electric; Barbecues; Kettles, electric; Microwave ovens [cooking apparatus]; Multicookers; Electric appliances for making yogurt.</i>

35. In construing the terms used in the parties' specifications, I bear in mind the comments of Floyd J (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language

unnaturally so as to produce a narrow meaning which does not cover the goods in question."

36. I also take account of the principle set out by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

"In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."¹⁰

37. The opponent submits that the applicant's goods are identical, highly similar and/or complementary to its *food mixers*. The *Oxford Dictionary of English* defines a mixer as "a machine for mixing things, especially an electrical appliance for mixing foods: *a food mixer*". I consider that this is how the average consumer would understand the term.

Class 7 goods

38. In my view, the opponent's *food mixers* would be included in the following terms from the applicant's specification: *mixing machines, mixers [machines], Kitchen machines, electric, Food processors, electric and Food preparation machines*. I find them to be identical in line with the *Meric* principle. The average consumer would expect a food processor also to serve as a mixer.

39. *Whisks, electric, for household purposes* may be hand-held or attachments for free-standing machines. They are used for beating air into ingredients, such as egg whites, or for mixing ingredients together. I also find them to be identical to the opponent's goods per *Meric*.

¹⁰ Paragraph 29.

40. *Crushers for kitchen use and kitchen grinders, electric* are used to reduce large pieces of food to smaller ones. They have the same users as food mixers and share the same trade channels. They are not in competition, but there is some complementarity, as they may be available as attachments for food mixers¹¹ and the average consumer would expect them to be produced by the same business. I find these goods to be similar to no more than a medium degree. The same applies for *mills for household purposes, other than hand-operated; pepper mills, other than hand-operated* and *coffee grinders, other than hand-operated*. *Fruit presses, electric*, are used to extract the juice from fruit, but in all other respects the analysis is the same. They are also similar to food mixers to no more than a medium degree.

41. *Flour mill machines* have the same uses as the crushers and grinders I have just considered. However, it seems to me that the users will be different. It is unlikely that the average user of a food mixer, who is a member of the general public, would be milling their own flour. Flour mills are more specialist pieces of equipment. They may share some trade channels – specialist food and kitchen shops, for example – but would not be found in many of the general retailers that sell food mixers. They are not in competition with food mixers and if there is any complementarity it is fairly low. I find these goods to be similar to a low degree. The same analysis applies in the case of *butter machines*.

42. *Bread cutting machines* are also more specialist equipment. These are more likely to be used in business establishments, where there is a need to slice multiple loaves. However, I note that *food mixers* also have professional users. Therefore, some of the users will be the same. Some trade channels will be the same – mainly specialist retailers serving trade customers. The goods are not in competition, and not complementary. I find these goods to have only a low degree of similarity.

Class 11

43. The contested *Cooking apparatus and installations; Fruit roasters; Kitchen ranges [ovens]; Pressure cookers [autoclaves], electric; Barbecues; Microwave ovens*

¹¹ A grinding mill attachment is shown in Exhibit CG09, page 133.

[cooking apparatus]; Multicookers; Electric appliances for making yogurt are all appliances that are used to produce food that is ready to be eaten. They have the same users as *food mixers*, and similar uses, all being involved in the preparation of food. They share the same trade channels and are likely to be found in similar areas of a general retail outlet. In response to my query at the hearing, Mr Lomas submitted that the goods are complementary to *food mixers*.

44. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as “complementary” and therefore similar to a degree in circumstances where the nature and purpose of the prospective goods and services are different:

“... the complementarity between the goods and services in the context of a likelihood of confusion does not rely on the existence of a connection between the goods and services at issue in the mind of the relevant public from the point of view of their nature, their method of use and their distribution channels but on the close connection between those goods and services, in the sense that one is indispensable or important for the use of the other in such a way that the public might think that the responsibility for the production of those goods or provision of those services lies with the same undertaking.”¹²

45. In my view, there is some similarity between *food mixers* and *Pressure cookers [autoclaves], Microwave ovens [cooking apparatus], Multicookers and Electric appliances for making yogurt*. The average consumer is likely to think they are produced by the same undertaking. They are all electrical appliances that are used in the preparation of food and can be accommodated on the worktops in an average domestic kitchen, and will have the same users and same trade channels. They are also likely to be sold in the same area of a shop. The average consumer will expect a producer of food mixers to manufacture other goods for use in cooking. Consequently, I find these goods to be similar to at least a medium degree.

¹² Paragraph 36.

46. Mr Lomas submitted that *coffee machines* and *kettles, electric* were also complementary to *food mixers*. The users are the same, as are the trade channels. They are not in competition. However, I find that there is a degree of complementarity. The average consumer would expect all these goods to be among those produced by a manufacturer of domestic kitchen appliances. I find there to be similarity between these goods, but at no more than a medium level.

47. The remaining goods – *Cooking apparatus and installations; Fruit roasters; Kitchen ranges [ovens]* and *Barbecues* – are all larger pieces of equipment. They will have largely the same users, similar uses and overlapping trade channels. However, based on their knowledge of the practices of the trade, the average consumer, in my view, would not expect them to be produced by the same undertaking that produces *food mixers*. I find there to be some similarity, but at a low level.

Average consumer and the purchasing act

48. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, I must bear in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question, see *Lloyd Schuhfabrik Meyer*.

49. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited* [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person.

The word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”¹³

50. The average consumer of the goods at issue will be a member of the general public or a professional, such as a restaurant or hotel owner. In his skeleton argument, Mr Lomas submits that the average consumer will be paying an average level of attention. I agree with this submission. The goods are not every-day purchases and some are relatively expensive, and the consumer will be considering the features, appearance and expected reliability of the goods.

51. The goods will normally be self-selected, either from the shelves in a shop or from a website or catalogue. The visual element will therefore be most significant, although I do not discount the possibility of word-of-mouth recommendations or assistance from sales staff. The aural element cannot be ignored.

Comparison of marks

52. It is clear from *SABEL BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo*, C-591/12 P, that:


“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”¹⁴

¹³ Paragraph 60.

¹⁴ Paragraph 34.

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

54. The respective marks are shown below:

Opponent's mark	Applicant's mark
CHEF	

55. The opponent's mark consists of the word "CHEF" in capital letters in a standard typeface. It alludes to some of the users of the goods. The overall impression of the mark lies in the word itself.

56. The applicant's mark consists of the letters "amzchef" in a standard, sans-serif typeface, all in lower case. They are presented in a light colour against the background of a dark rectangle. To the left of the letters is a line drawing that resembles a chef's hat. This makes a contribution to the overall impression of the mark, although it is a lesser one than the letters, and reinforces the "chef" element of the word. The average consumer is likely to split the word into two units: "amz" and "chef". As I have already noted, the word "chef" alludes to the users of the goods. The "amz" element is unlikely to have a meaning for the average consumer, who may see it as representing initials, without it being readily apparent what those initials stand for. I find that the overall impression of the mark lies in the word as a whole, with the device also making a contribution.

Visual comparison

57. The four letters of the opponent's mark are completely contained within the applicant's mark. The additional letters and device are a point of difference, although the letters are presented in a standard typeface. I find that there is a medium degree of visual similarity between the marks.

Aural comparison

58. The opponent's mark will be pronounced "SHEF", while the applicant's will be articulated as "AY-EM-ZED-SHEF" or "AMZ-SHEF". The applicant's mark is therefore noticeably longer, although it does contain the opponent's mark at the end. I find there to be a medium degree of aural similarity between the marks

Conceptual comparison

59. The common element, "CHEF", will be understood by the average consumer as a reference to a cook in a restaurant. In the case of the applicant's mark, this message is reinforced by the device, which will be seen as a chef's hat. The letters "AMZ" will be assumed to be an abbreviation, although it is unlikely that the average consumer will recognise what it stands for. I find the marks to have a high degree of conceptual similarity.

Distinctiveness of the earlier mark

60. There is, as has already been noted, a greater likelihood of confusion if the earlier mark is highly distinctive. The CJEU provided guidance on assessing a mark's distinctive character in *Lloyd Schuhfabrik Meyer*:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from

those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases 108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49.

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

61. Mr Lomas submitted that the distinctiveness of the earlier mark had been enhanced through the volumes of sales that had been achieved over a long period of time. He accepted that its inherent distinctiveness was fairly low. I agree: “CHEF” is, as I have already found, a word that alludes to a person who is likely to use the opponent’s goods. I must now consider whether the evidence shows that the level of distinctiveness has been enhanced through use.

62. The evidence shows that the mark has been used for a long time (since the 1950s) and over a wide geographical area. From what is before me, I am able to infer that the mark enjoys a significant share of the market for the opponent’s goods. Exhibit CG18 contains figures for the marketing budget for UK and Ireland for the years 2005 to 2013. This is, of course, before the relevant period for the purpose of use, but it goes to show that the mark was being promoted for some time. The selection of advertisements and media articles in Exhibit CG23 shows coverage in publications such as *The Sun*, *The Daily Mail*, *BBC Good Food* and *Good Housekeeping*. Again, many of these date from before the relevant period, but they indicate that a significant number of people are likely to have come across the mark.

63. What I must also consider, though, is whether it is because of this mark that the public would identify the goods as originating from the opponent or, in this case, its subsidiary. There are very few examples in the evidence of “CHEF” being used on its own, without reference to “KENWOOD”. Where it is used on its own, the public will already have been informed that Kenwood is the responsible undertaking, as they are looking at Kenwood brochures or the Kenwood website.

64. In *Enterprise Holdings Inc v Europcar Group UK Ltd & Anor* [2015] EWHC 17 (Ch), Arnold J (as he then was) surveyed the law on the acquisition of distinctive character through use. This summary included the following statement:

“... a trade mark may acquire a distinctive character in consequence of the use of that mark as part of, or in conjunction with, another trade mark (which may itself be a registered trade mark).”¹⁵

65. Mr Lomas submitted that “Kenwood” was the house brand, and “CHEF” a sub-brand. A similar argument was used in a recent appeal against the decision of the Hearing Officer in *CONTENT GURU TRADE MARK* and was rejected by Phillip Johnson, sitting as the Appointed Person, who said that:

“... just because GURU *could* develop distinctiveness when it is used in conjunction with O2 in the mark O2 GURU (see C-353/03 *Nestlé v Mars* [2005] ECR I-6135) it does not mean that it has done so. It requires evidence of some sort that the consumer sees GURU as a sub-brand of O2 when it is used alone. No such evidence existed in this case.”¹⁶

66. In my view, there is no evidence that the consumer sees “CHEF” as a sub-brand of “KENWOOD” when it is used alone. Consequently, I am unable to find that the mark has enhanced distinctiveness.

¹⁵ BL O/394/19, paragraph 149.

¹⁶ BL O/394/19, paragraph 11.

Conclusions on Likelihood of Confusion

67. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred in paragraph 31. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods and/or services may be offset by a greater degree of similarity between the marks, and vice versa.¹⁷ The distinctiveness of the earlier mark must also be taken into account.

68. Such a global assessment does not imply an arithmetical exercise, where the factors are given a score and a calculation reveals whether or not there is a likelihood of confusion. I must keep in mind the average consumer of the goods and/or services and the nature of the purchasing process. I note that it is generally accepted that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture they have kept in their mind.¹⁸

69. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor QC, sitting as the Appointed Person, gave helpful guidance on making a global assessment:

81.2 ... in my view it is important to keep in mind the purpose of the whole exercise of a global assessment of a likelihood of confusion, whether direct or indirect. The CJEU has provided a structured approach which can be applied by tribunals across the EU, in order to promote a consistent and uniform approach. Yet the reason why the CJEU has stressed the importance of the ultimate global assessment is, in my view, because it is supposed to emulate what happens in the mind of the average consumer on encountering, for example, the later mark applied for with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.

¹⁷ *Canon*, paragraph 17.

¹⁸ *Lloyd Schuhfabrik Meyer*, paragraph 27.

81.3 Third, when a tribunal is considering whether a likelihood of confusion exists, it should recognise that there are four options:

81.3.1 The average consumer mistakes one mark for the other (direct confusion);

81.3.2 The average consumer makes a connection between the marks and assumes that the goods or services in question are from the same or economically linked undertakings (indirect confusion);

81.3.3 The various factors considered in the global assessment lead to the conclusion that, in the mind of the average consumer, the later mark merely calls to mind the earlier mark (mere association);

81.3.4 For completeness, the conclusion that the various factors result in the average consumer making no link at all between the marks, but this will only be the case where either there is no or very low similarity between the marks and/or significant distance between the respective goods or services;

81.3.5 Accordingly, in most cases, it is not necessary to explicitly set out this fourth option, but I would regard it as a good discipline to set out the first three options, particularly in a case where a likelihood of indirect confusion is under consideration.”

70. I found that the distinctiveness of the mark was fairly weak. This does not preclude a likelihood of confusion: see *L'Oréal SA v OHIM*, Case C-235/05 P, paragraph 45. However, it does mean that the penumbra of protection of the earlier mark is relatively small. When comparing the marks, I found that there was a medium degree of visual and aural similarity, and a high degree of conceptual similarity, between them. The average consumer is prone to imperfect recollection, and earlier I found that they would be paying no more than an average level of attention. Where the goods are

identical, it seems to me that there is a likelihood of direct confusion. The average consumer will more readily identify the “CHEF” element of the applicant’s mark. Given the weak distinctiveness of this common element, it is my view that direct confusion would not be likely where the goods are merely similar. “CHEF” is a word that the average consumer is likely to expect different producers of kitchen equipment to want to use in their marks.

71. I turn now to indirect confusion. It is, in my view, unlikely that the average consumer will be indirectly confused. As Mr Mellor noted, this would involve an assumption that the applicant’s mark is a sub-brand, or a rebrand, of the opponent’s, or connected in some other way. I see no reason to consider that an automatic connection of the kind I have just described is likely, given the allusiveness of the word “chef” and the lack of readily understandable meaning of “amz”. The average consumer may wonder whether there is a connection, but this falls within Mr Mellor’s third category of “mere association”.

Outcome of section 5(2)(b) ground

72. The opposition succeeds under section 5(2)(b) in respect of the following goods:

Class 7

Mixing machines; Mixers [machines]; Whisks, electric, for household purposes; Kitchen machines, electric; Food processors, electric; Food preparation machines, electromechanical.

73. The opposition fails under section 5(2)(b) in respect of the following goods:

Class 7

Crushers for kitchen use; Mills for household purposes, other than hand-operated; Pepper mills other than hand-operated; Coffee grinders, other than hand-operated; Fruit presses, electric, for household purposes; Kitchen grinders, electric; Butter machines; Flour mill machines; Bread cutting machines.

Class 11

Cooking apparatus and installations; Fruit roasters; Kitchen ranges [ovens]; Pressure cookers [autoclaves], electric; Coffee machines, electric; Barbecues; Kettles, electric; Microwave ovens [cooking apparatus]; Multicookers; Electric appliances for making yogurt.

Section 5(3)

74. Section 5(3) of the Act states that a trade mark which is identical with or similar to an earlier trade mark

“shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community/European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

75. The conditions of section 5(3) are cumulative:

- The opponent must show that the earlier mark has a reputation;
- The level of reputation and the similarities between the marks must be such as to cause the public to make a link between the marks;
- One or more of three types of damage (unfair advantage, detriment to distinctive character or repute) will occur.

76. It is not necessary for the goods to be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

77. In *General Motors Corp v Yplon SA*, Case C-375/97, the CJEU gave guidance on assessing whether a mark has a reputation:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark,

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation in the Member State. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

78. Earlier in my decision, I considered the same criteria when assessing whether the earlier mark had enhanced distinctiveness. I found that it had not, as there was no evidence before me that the relevant public would see “CHEF” as a sub-brand of “KENWOOD” when the mark was used on its own. Given this lack of evidence, I am unable to find that the earlier mark has a reputation.

79. However, even if I am wrong and the mark has a reputation, I consider that there would not be a link, except in those cases where I found there to be a likelihood of confusion under section 5(2)(b), namely the identical goods. I have already noted the

allusiveness of the word “CHEF”, and it appears to me unlikely that the average consumer would make the link with the opponent in the case of the remaining goods.

80. The section 5(3) ground fails.

Section 5(4)(a)

81. Section 5(4)(a) of the Act states that:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule or law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of ‘an earlier right in relation to the trade mark’.”

82. It is settled law that, for a finding of passing off, three factors must be present: goodwill, misrepresentation and damage. Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law in *Jadebay Limited, Noa and Nani Limited trading as the Discount Outlet v Clarke-Coles Limited trading as Feel Good UK* [2017] EWHC 1400 IPEC:

“56. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL) namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of those limbs.

57. In relation to deception, the court must assess whether ‘a *substantial number*’ of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

83. *Halsbury’s Laws of England* Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309, it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors;

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

84. The relevant date for assessing a section 5(4)(a) claim has been discussed by Mr Daniel Alexander QC, sitting as the Appointed Person, in *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11. In this decision, he quoted with approval the following summary of the position provided by the Hearing Officer, Mr Allan James, in *SWORDERS TM*, BL O-212-06:

“... Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.”¹⁹

85. The applicant has not given any indication that it has been using the mark. Therefore the relevant date is the date the application was made: 10 April 2018.

¹⁹ Paragraph 148.

Goodwill

86. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co.'s Margarine Ltd* [1901] AC 217:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction to bring customers home to the source from which it emanates”.

87. As stated in *Wadlow's Law of Passing-Off: Unfair Competition by Misrepresentation*, 5th edition,

“Though the existence of sufficient goodwill to form the basis of the passing-off action is a separate issue to that of the reputation or distinctiveness of the name or mark relied on, the two are factually related, and are sometimes confused. In *Phones 4U v Phone4U.co.uk Internet* the confusion was further compounded at first instance by the trial judge failing to distinguish between the legal criteria appropriate to liability for passing off, as opposed to those applicable to registration as a trade mark. That a business might have had no goodwill in the proper sense despite having traded with the public for five years, at the end of which it had 60 retail shops and an annual turnover of £40 million, was never remotely credible.”²⁰

88. Given the long-standing use of the name “CHEF” and the volumes of sales of products bearing that name that are indicated by the evidence, it would be difficult to find that the opponent does not have actionable goodwill in connection with the sale of *Food mixers and food preparation equipment and machines and attachments and*

²⁰ Section 3-11.

accessories for the aforesaid goods. In paragraph 16 of this decision, I listed the variety of attachments that are shown for sale in the evidence.

Misrepresentation

89. The relevant test was set out by Morritt LJ in *Neutrogena Corporation and another v Golden Limited and another* [1996] RPC 473:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 at page 407 the question on the issue of deception or confusion is:

‘is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants’ [product] in the belief that it is the respondents’ [product].’

The same proposition is stated in Halsbury’s Laws of England 4th Edition Vol. 48, para. 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd v June Perfect Ltd* (1941) 58 RPC 147 at page 175; and *Re Smith Hayden’s Application* (1945) 63 RPC 697 at page 101.”

90. The factors that I must consider are set out in the passage I quoted from *Halsbury’s Laws of England* in paragraph 83 above. In the light of the Court of Appeal’s judgment in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, it seems doubtful whether the difference between the test for misrepresentation for passing off purposes and the test for a likelihood of confusion under trade mark law will (all other factors being equal) produce difference outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments. Bearing this in mind, I would find misrepresentation where I considered the applicant’s goods to be identical to the opponent’s goods.

91. However, I also found that the opponent had actionable goodwill associated with the sale of accessories for food mixers. Some of the applicant's Class 7 goods may be sold as attachments for food mixers (namely, fruit presses and mills). I recall that misrepresentation does not require the parties to be operating in a common field of activity, as Millet LJ stated in *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA). However, confusion or deception is more likely if the goods in question are identical or similar.

92. Earlier in this decision I have mentioned the weak distinctiveness of "CHEF" from the perspective of trade mark law. I see no reason why a significant number of members of the public would believe that a kettle, electric fruit press, butter machine or oven, for example, bearing the applicant's mark, was the responsibility of, or connected with, the opponent. For these goods, I find there to be no misrepresentation.

Damage

93. As I have found misrepresentation only for those goods where the opposition succeeded under section 5(2)(b), there is no need to consider in depth whether damage is likely. As I found there to be direct confusion, it follows that there is likely to be substitution.

Outcome of the section 5(4)(a) ground

94. The opposition under section 5(4)(a) succeeds in respect of the following goods:

Class 7

Mixing machines; Mixers [machines]; Kitchen machines, electric; Whisks, electric, for household purposes; Food processors, electric; Food preparation machines, electromechanical.

95. The opposition under section 5(4)(a) fails in respect of the following goods:

Class 7

Crushers for kitchen use, electric; Mills for household purposes, other than hand-operated; Pepper mills other than hand-operated; Coffee grinders, other than hand-operated; Fruit presses, electric, for household purposes; Kitchen grinders, electric; Butter machines; Flour mill machines; Bread cutting machines.

Class 11

Cooking apparatus and installations; Fruit roasters; Kitchen ranges [ovens]; Pressure cookers [autoclaves], electric; Coffee machines, electric; Barbecues; Kettles, electric; Microwave ovens [cooking apparatus]; Multicookers; Electric appliances for making yogurt.

Conclusion

96. The partial opposition partially succeeds. The application by Foshan Shunde QINGZHOU Electric Appliances Co., Ltd may proceed to registration in respect of the following goods:

Class 7

Crushers for kitchen use, electric; Mills for household purposes, other than hand-operated; Pepper mills other than hand-operated; Coffee grinders, other than hand-operated; Fruit presses, electric, for household purposes; Kitchen grinders, electric; Butter machines; Flour mill machines; Bread cutting machines; Milking machines; Brewing machines; Beverage preparation machines, electromechanical.

Class 11

Lamps; lighting apparatus and installations; Lights for vehicles; coking apparatus and installations; Fruit roasters; Kitchen ranges [ovens]; Pressure cookers [autoclaves], electric; Coffee machines, electric; Barbecues; Kettles, electric; Microwave ovens [cooking apparatus]; Multicookers; Electric fans for personal use; Laundry dryers, electric; Air purifying apparatus and machines; Solar thermal collectors [heating]; Water purification installations; Pocket warmers; Electric appliances for making yogurt.

Costs

97. Both parties have had some success in these proceedings, with the greater proportion of success being won by the applicant. In awarding costs, I take account of the fact that the applicant filed no evidence, made no submissions and did not attend the hearing. In the circumstances, I award the applicant the sum of £275 as a contribution towards its costs. The sum is calculated as follows:

Preparing a statement and considering the other side's statement: £175

Considering the other side's evidence: £100

Total: £275

98. I therefore order De Longhi Benelux SA to pay Foshan Shunde QINGZHOU Electric Appliances Co., Ltd the sum of £275. The above sum should be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 23rd day of December 2019

Clare Boucher

For the Registrar,

Comptroller-General