

**o/598/21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003484394**

**BY LILMACC LTD**

**TO REGISTER THE TRADE MARK:**

**Agagadgets**

**IN CLASSES 9 AND 11**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 421200**

**BY AGA RANGEMASTER GROUP LIMITED**

## BACKGROUND AND PLEADINGS

1. On 26 April 2020, Lilmacc Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on the 15 May 2020.

2. The applicant seeks registration for the following goods:

Class 9      Electrical and electronic apparatus for the transmission of data; Electrical and electronic connectors; Electrical and electronic instruments for the transmission of data; Electrical cable; Electrical cables; Electrical cables for use in connections; Electrical cabling; Electrical cords; Electrical distribution boxes; Electrical extension leads; Electrical junction boxes; Electrical outlets; Electrical plugs; Electrical power adaptors; Electrical power extension cords; Electrical power outlet boxes; Electrical sockets; Electrical surge and spike protection units; Electrical switch boards; Electrical switch boxes; Electrical switch timers; Electrical switches; Electrical switching apparatus; Electrical tape jigs [measuring instruments]; Electrical terminal blocks; Electrical terminal boxes; Electrical terminal connectors; Electrical terminals; Electrical travel adaptors; Electrical wires; Electrical wiring installations.

Class 11     Electrical appliances for cooking; Electrical coffee pots; Electrical heating elements; Electrical hot plates for food warming; Electrical lamps; Electrical lamps for indoor lighting; Electrical light bulbs; Electrical lighting fixtures; Electrical lighting fixtures for use in hazardous locations; Electrical rice cookers; Electrical serving pots.

3. The application was opposed by Aga Rangemaster Group Limited (“the opponent”) on 17 August 2020. The opposition is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under sections 5(2)(b) and 5(3) the opponent relies on the following trade marks:



UK registration no. UK00002425089

Filing date 21 June 2006; registration date 14 March 2008

**("the First Earlier Mark")**



UK registration no. UK00001137735

Filing date 25 July 1980; registration date 25 July 1980

**("the Second Earlier Mark")**

**AGA**

UK registration no. UK00002629515

Filing date 24 July 2012; registration date 15 February 2013

**("the Third Earlier Mark")**

**AGA**

UK registration no. UK00002425088

Filing date 21 July 2006; registration date 14 March 2008

**("the Fourth Earlier Mark")**

**AGA**

UK registration no. UK00001346740

Filing date 7 June 1988; registration date 26 October 1990

**("the Fifth Earlier Mark")**

# AGA


UK registration no. UK00000523495

Filing date 11 June 1931; registration date 11 June 1931

**("the Sixth Earlier Mark")**

4. Under section 5(2)(b), the opponent relies upon some of the goods and services for which its marks are registered, as underlined in the Annex to this decision. The opponent claims that there is a likelihood of confusion because of the similarity of the marks and the identity and similarity of the goods.

5. Under section 5(3), the opponent claims to have a reputation for all goods and services for which the marks are registered, as set out in the Annex to this decision. The opponent claims that the earlier marks have acquired a reputation in the UK, and use of the applicant's mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or reputation of the earlier mark.

6. Under section 5(4)(a), the opponent relies upon the sign **AGA** and  which it claims to have used throughout the UK since 1930 for the goods and services set out in the Annex to this decision.

7. The applicant filed a counterstatement denying the claims made.

8. The opponent is represented by HGF Limited and the applicant is unrepresented. Only the opponent filed evidence in chief. No hearing was requested and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

9. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

## **EVIDENCE AND SUBMISSIONS**

10. The opponent filed evidence in chief in the form of the witness statement of Mr David Carpenter, which is dated 18 February 2021. Mr Carpenter is Technical Director of the opponent. Mr Carpenter's statement was accompanied by 21 exhibits. I note that the opponent also filed written submissions.

11. Whilst I do not propose to summarise those here, I have taken them into consideration and will refer to them below where necessary.

## **DECISION**

### **Section 5(2)(b)**

12. Section 5(2)(b) reads as follows:

“5(2) A trade mark shall not be registered if because –

(a)...

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

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

13. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of IR

for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

14. The trade marks upon which the opponent relies qualify as earlier trade marks because they were applied for at an earlier date than the applicant's mark pursuant to section 6 of the Act. As the earlier trade marks have completed their registration process more than five years before the application date of the mark in issue, they are subject to proof of use pursuant to section 6A of the Act. However, as the applicant did not request that the opponent prove use of its marks, it is entitled to rely upon all of the goods and services for which the marks are registered.

### **Section 5(2)(b) case law**

15. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely

upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

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

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

16. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for 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.”

17. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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

18. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... 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.”

19. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

20. In *Kurt Hesse v OHIM*, Case C-50/15 P, the Court of Justice of the European Union (“CJEU”) stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“... there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think the responsibility for those goods lies with the same undertaking.”

21. 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 respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.” Whilst on the other hand: “... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

Whilst on the other hand:

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

### Class 9

22. “Scales”, “electronic measuring apparatus for monitoring conditions inside baking ovens”, “digital probe thermometers” and “thermometers and thermostats, all for use in cooking, warming heating, refrigerating apparatus, installations and appliances” in the opponent’s First and Fourth Earlier Marks’ specification fall within the broader category of “electrical and electronic apparatus for the transmission of data” and/or

“electrical and electronic instruments for the transmission of data” in the applicant’s specification. I consider them identical on the principle outlined in *Meric*.

23. I consider that the applicant’s remaining class 9 goods fall within the broader category of “parts and fittings for the aforesaid goods” in class 11 of the opponent’s First and Fourth Earlier Marks’ specifications. Even if I am wrong in this finding, the goods will overlap in trade channels, users, method of use, nature and purpose. I consider that they will be highly similar.

### Class 11

24. “Electrical appliances for cooking” in the applicant’s specification is self-evidently identical to “cooking, baking, warming, thawing and heating apparatus, installations and appliances” in the opponent’s First and Fourth Earlier Marks’ specifications.

25. “Electrical coffee pots” in the applicant’s specification is self-evidently identical to “electric coffee pots” in the opponent’s First and Fourth Earlier Marks’ specifications.

26. “Electrical hot plates for food warming”, “electrical serving pots” and “electrical rice cookers” in the applicant’s specification fall within the broader category of “cooking, baking, warming, thawing and heating apparatus, installations and appliances” in the opponent’s First and Fourth Earlier Marks’ specifications. I consider them identical on the principle outlined in *Meric*.

27. “Electrical lighting fixtures” and “electrical lighting fixtures for use in hazardous locations” in the applicant’s specification fall within the broader category of “lighting installations” in the opponent’s Sixth Earlier Mark’s specification. I consider them identical on the principle outlined in *Meric*.

28. “Electrical heating elements” in the applicant’s specification falls within the broader category of “parts and fittings for the aforesaid goods” in class 11 of the opponent’s First and Fourth Earlier Marks’ specifications. I consider them identical on the principle outlined in *Meric*.

29. “Electrical lamps” and “electrical lamps for indoor lighting” in the applicant’s specification overlaps with “lighting installations” in the opponent’s Sixth Earlier Mark’s specification. I consider there to be an overlap in trade channels, purpose, nature, method of use and user. I consider that they may be in competition, but they are not complementary. Taking the above into account, I consider the goods to be similar to a high degree.

30. “Electrical light bulbs” in the applicant’s specification overlaps with “lighting installations” in the opponent’s Sixth Earlier Mark’s specification. I consider there to be an overlap in trade channels, purpose, and user. I do not consider there to be an overlap in nature. I consider that they are not in competition, however, I do consider that they may be complementary because lighting installations will require electric light bulbs in order to function. I consider the goods to be similar to a medium degree.

#### A further consideration

31. Given the field in which the opponent operates, I also consider it necessary to make a finding in relation to the terms “cookers” and “ovens” which are covered by the specifications of the First, Second, Fourth and Sixth Earlier Marks’ specifications.

32. I consider that “cookers” and “ovens” fall within the broader category of “electrical appliances for cooking” in the applicant’s class 11 specification. I consider them identical on the principle outlined in *Meric*.

33. I consider that “electrical rice cookers” in the applicant’s specification falls within the broader category of “cookers” in the opponent’s specification. I consider them identical on the principle outlined in *Meric*.

34. “Electrical coffee pots” in the applicant’s class 11 specification may have some overlap with the opponent’s above goods. I consider there to be an overlap in trade channels and user. There could be a slight overlap in nature, but only to the extent that cookers and ovens can also be electric. There may be some overlap in purpose as they both are used to heat items which are consumed. However, they differ in

method of use. I do not consider them to be in competition nor complementary. Overall, I consider the goods to be similar to between a low and medium degree.

35. “Electrical serving pots” and “electrical hot plates for food warming” in the applicant’s class 11 specification may overlap with the opponent’s above goods. I consider there to be an overlap in trade channels and user. There could be a slight overlap in nature, but only to the extent that all the goods could be electrical. They differ in method of use, however, there may be some limited overlap in purpose to the extent that they all warm food, although the opponent’s goods are used to cook food, whereas the applicant’s goods are used to keep them warm once cooked. I do not consider them to be in competition nor complementary. Overall, I consider the goods to be similar to between a low and medium degree.

36. In my view, “cookers” and “ovens” are dissimilar with the applicant’s class 9 goods. Although the applicant’s goods may be a component of the opponent’s goods, they differ in nature, method of use, purpose and trade channels. Although there is an overlap in user, this is not enough on its own for a finding of similarity. I do not consider the goods to be in competition or complementary. Taking all of this into account, I consider the goods to be dissimilar.

37. I consider that “electrical heating elements” in the applicant’s class 11 specification is dissimilar to the opponent’s above goods. Although electrical heating elements may be a component of the opponent’s goods, they differ in nature, method of use, purpose and trade channels. An overlap in user is not enough to establish similarity. They are not in competition or complementary. Taking all of this into account, I consider the goods to be dissimilar.

38. I consider “electrical lamps”, “electrical lamps for indoor lighting”, “electrical light bulbs”, “electrical lighting fixtures” and “electrical lighting fixtures for use in hazardous locations” in the applicant’s class 11 specification are dissimilar to the opponent’s above goods. They differ in nature, method of use, purpose and trade channels. They may overlap in user; however, this is not enough on its own for a finding of similarity. They are not in competition or complementary. Taking all of this into account, I consider the goods to be dissimilar.

## **The average consumer and the nature of the purchasing act**

39. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

40. I consider that the average consumer of the goods will include both members of the general public and specialists such as electricians. The cost of the goods in question is likely to vary. The majority of the goods will be purchased relatively infrequently. The average consumer will take various factors into consideration such as the cost, warranty and the suitability of those goods to the consumer's needs. I also consider that the average consumer is likely to take into consideration if they are provided with an 'after-care' service such as advice and maintenance services for the goods. Taking the above into account, I consider that the level of attention paid during the purchasing process will be medium.

41. The goods are likely to be purchased from a specialist retailer or online equivalent. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through word-of-mouth recommendations.



## **Comparison of the trade marks**

42. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

44. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
 <p data-bbox="319 510 670 544">(The First Earlier Mark)</p>  <p data-bbox="295 819 694 853">(The Second Earlier Mark)</p> <p data-bbox="408 936 576 999"><b>AGA</b></p> <p data-bbox="236 1039 754 1128">(The Third, Fourth, Fifth and Sixth Earlier Marks)</p>	<p data-bbox="903 647 1321 719"><b>Agagadgets</b></p>

Overall Impression

45. The First and Second Earlier Marks consists of the word 'AGA' encased in a black rectangle, with rounded edges, with a black and white boarder. I consider the word AGA to play a greater role in the overall impression of the mark, with the background and stylisation playing a lesser role.

46. The Third, Fourth, Fifth and Sixth Earlier Marks consist of the word AGA. There are no other elements to contribute to the overall impression which lies in the word itself.

47. The applicant's mark consists of the word "Agagadgets". There are no other elements to contribute to the overall impression which lies in the word itself.



## Visual Comparison

### *The First and Second Earlier Marks and the Applicant's Mark*

48. Visually, the marks coincide in the fact that the First and Second Earlier Marks' word element, AGA, is entirely replicated at the beginning of the applicant's mark. The opponent submits that it is well noted that consumers pay more to the beginning of the marks. However, the applicant's mark has the additional letters G, A, D, G, E, T and S at the end which acts as a visual point of difference. I note that the First and Second Earlier Marks are also on a stylised black rectangular background. Taking the above into account, I consider the marks to be visually similar to between a low and medium degree.

### *The Third, Fourth, Fifth and Sixth Earlier Marks and the Applicant's Mark*

49. The same comparison applies as set out above, however, the Third, Fourth, Fifth and Sixth Earlier Marks are not on the stylised black rectangular background. I recognise that all of the marks are filed as word marks. Normal and fair use of word marks mean that they may be used in any standard typeface, as well as in upper and lower-case lettering. Taking the above into account, I consider the marks to be visually similar to a medium degree.

## Aural Comparison

### *The First and Second Earlier Marks and the Applicant's Mark*

50. Aurally, the opponent submits that because of the shared AGA beginning element, this creates a high aural similarity between all of the marks. However, I disagree. I consider that the First and Second Earlier Marks could be pronounced as either a word or an acronym. I consider the applicant's mark will be pronounced as AH-GAH-GAD-JETS. If the First and Second Earlier Marks are pronounced as a word, the marks will be similar to a medium degree, if the First and Second Earlier Marks are pronounced as an acronym, they will be similar to a low degree.

*The Third, Fourth, Fifth and Sixth Earlier Marks and the Applicant's Mark*

51. The same comparison applies as set out above.

Conceptual Comparison

*The First and Second Earlier Marks and the Applicant's Mark*

52. Conceptually, I consider that the First and Second Earlier Marks are likely to be viewed as an invented word or acronym which would be attributed no particular meaning.

53. I consider that the average consumer will identify the word 'gadgets' within the applicant's mark. The letters 'aga' will either be viewed as an invented word or acronym. In either case, they will be conceptually neutral in both marks. However, as the word 'gadgets' has no counterpart in the opponent's marks, it will act as a conceptual point of difference.

*The Third, Fourth, Fifth and Sixth Earlier Marks and the Applicant's Mark*

54. The same comparison applies as set out above.

**Distinctive character of the earlier trade marks**

55. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases

C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR 1-2779, 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 promotion of 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).”

56. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

57. I will begin by assessing the inherent distinctive character of all the earlier trade marks. AGA is an invented word or acronym which is neither allusive nor descriptive of the goods and services for which it is registered. I do not consider the rectangular background in the First and Second Earlier Marks adds significantly to the distinctiveness of the marks. Therefore, if the average consumer considers AGA to be an invented word, I consider all of the opponent’s marks to be inherently distinctive to a high degree. However, if they consider AGA to be an acronym, I consider all of the opponent’s marks to be inherently distinctive to a medium degree.

58. The opponent has also filed evidence to demonstrate that the marks have acquired enhanced distinctive character through use. The relevant market for assessing this is the UK market. The opponent has been operating in the UK and used their marks continuously since 1929. This would amount to 91 years of use at the relevant date.

59. The opponent provided **Exhibit DC8** to demonstrate that stores are located around the UK in locations such as Edinburgh, Exeter, Leicester, London, North Yorkshire, Sheffield, Stratford-upon-Avon, Perth, Somerset, and Truro. Clearly, therefore, use has been geographically widespread. Turnover figures have been provided under the trade marks in the UK for the period of 2010 to 2020. However, these figures are not broken down to record what proportion of this relates to the goods and services relied upon. The same is also true of the opponent's advertising figures for the period of 2016 to 2020. I also note that in Mr Carpenter's witness statement, both of the sets of figures provided are in relation to "that trade mark". The opponent is relying upon six earlier marks for the purposes of this opposition, the First and Second Earlier device marks, and the Third, Fourth, Fifth and Sixth word marks. Consequently, Mr Carpenter has not specified what earlier marks the above figures relate to. However, given that the distinctiveness of all the earlier marks lies in the word AGA, I consider that use of any one of them would be acceptable use of the others. Consequently, this will not impact my overall finding.

60. Although the opponent also submits that they are the UK's largest retailer for cooking, refrigeration, lighting and heating apparatus and related goods and services, overall, I note that the opponent's evidence overwhelmingly relates to cookers and ovens (as opposed to retailing of those goods). I note the following:

- a) **Exhibit DC6**, all 7 blogs written by Mary King, Marco Pierre, Dan Walker, Galton Blackiston, Marcus Bean and Paul Hollywood, which appear in agaliving.com, only mentions the celebrities using, owning, and recommending an AGA cooker. No other AGA products are mentioned.
- b) **Exhibit DC8**, the opponent submits three AGA guides:
  - a. In the AGA Official Guide, 14 out of 26 pages mention or depict the AGA cooker.
  - b. In the Buyer's Guide, 8 out of 11 pages mention or depict the AGA cooker.
  - c. In the "AGA home to great cooking, your guide to what makes the AGA so very special", 48 out of 56 pages mention or depict the AGA cooker and its baking, roasting, simmering, warming and slow cooking ovens.

- c) **Exhibit DC13**, is composed of 29 screenshots from the opponents websites. 19 of these all show the AGA cooker.
- d) **Exhibit DC14**, all 3 adverts are in relation to cookers:
  - a. the AGA 60 cooker.
  - b. A summer promotion with 10% off AGA cookers.
  - c. Saving 10% off an AGA Masterchef Deluxe cooker.
  - d. No other adverts have been provided for any other AGA product.
- e) **Exhibit DC15**, all the following articles only mention the AGA cooker and no other AGA products:
  - f) An extract from *HELLO!* dated 16 October 2020 called “Nigella Lawson’s incredible home kitchen revealed” which shows her mint green AGA.
  - g) An extract from *Which* dated 19 November 2020 called “Should you buy an Aga?” explores what they are, and which different AGA cookers you can choose from.
  - h) An extract from *Ideal Home* dated 22 May 2020 called “The history of AGA-track the timeline of Macca and Mary Berry’s favourite oven” includes the history and pictures of the AGA cooker.
  - i) An extract from *Country Life* dated 28 March 2017 called “Mary Berry: Why I love my Aga” explores how Mary Berry uses her own AGA cooker.
  - j) An extract from *Independent* dated 7 April 2017 called “Is an Aga cooker worth the investment” explores the history of the AGA.
- k) **Exhibit DC16**, press briefings only mention the AGA cooker. Under the “AGA’s Iron Age Woman enjoys life in the 21<sup>st</sup> century” it highlights that their latest advertising campaign “follows a long tradition showing women of the time at home with the *world’s most famous cooker*”. Another press release dated 3 April 2013 shows a City of London Police Officer running the London Marathon pulling an AGA cooker. The third press release shows AGA unveiling their new City60 cooker range.
- l) **Exhibit DC17**, demonstrates that 2 out of the 3 awards that AGA has won, the Silver Award in the Best of British Category at annual House Beautiful awards (2011) and the “Design Classic award” at the Designer Kitchen and Bathroom awards (2016), were for their cookers which were described in the articles as “innovative” and “iconic”.

- m) **Exhibit DC19**, shows the supporting graphics which appeared on their AGA show trailer in 2014. These graphics consists of 5 pictures of their cookers, including the front of the trailer. Again, no other AGA products are advertised on the trailers graphics.
- n) **Exhibit DC21**, shows images of AGA's show stands. The 100% Design Show (2012), the Royal Welsh Show (2010), the Show Trailer (2019) and the Homebuilding and Renovation Show NEC (2019) are all promoting their AGA cookers.

61. I note that these exhibits demonstrate use of all the Earlier Marks.

62. I also note that the opponent's marks also feature in its e-commerce domain names including its website agaliving.com which has over a million views in the years 2012 to 2017, and 2020. In **Exhibit DC13**, screenshots from these years depict the following:

- The screenshot dated 20 August 2012, shows the opponent's websites homepage, with a depiction of their AGA cooker in the centre.
- The screenshot dated 3 September 2013 advertises the AGA Dual Control cooker and the website itself has a specific "Classic AGA Cookers" section.
- The screenshot dated 14 August 2014 is advertising the AGA City60 range, with the text "introducing the brand new 60cm AGA cooker perfect for city dwellers and smaller homes". It also depicts 14 cookers all in different colours for that one range.
- The screenshot dated 1 August 2015 again is advertising the 60cm AGA cooker.
- The screenshot dated 31 May 2017 from also depicts two AGA cookers, with the following text above; "Receive £1000 of AGA cookware of your choice when you buy selected AGA cookers" and the following text below; "welcome to AGA, the home of cast iron cookers".
- The screenshot from 14 January 2020 also has the text "welcome to AGA, the home of cast iron cookers" on its front page.

63. The cooker has clearly been AGA's focus over the years. When the business was founded, it "sought to create a cooker which was clean, economical and easy to use and as such, the AGA cooker was created". AGA expanded their cooker ranges with the introduction of new colours in 1956, the creation of oil and gas-fired AGA cookers, the first AGA electric cooker being introduced in 1980 and more recently the introduction of the AGA City60 range. I consider that this focus, alongside the turnover figures ranging from £29 million, to the highest sales in the UK at £45 million in a year, would mean that such sales relating cookers/ovens alone would still amount to several million pounds.

64. Overall, it is clear to me that use of all the marks has been geographically widespread throughout the UK. The marks have been used for a number of years in the UK and the opponent's sales figures under the marks are high. Although these figures are not broken down and are said to relate to all of the products provided under both the AGA device and word marks, in Mr Carpenter's witness statement, it is clear that the core products in relation to which the opponent has developed its business are cookers and ovens. My finding is, therefore, that the distinctiveness of the AGA marks has been enhanced through use to a very high degree (where the inherent distinctiveness of the marks is high) or to a high degree (where the inherent distinctiveness of the marks is medium), but only in relation to cookers and ovens.

### **Likelihood of confusion**

65. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and the nature of the purchasing process.

In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

66. The following factors must be considered to determine if a likelihood of confusion can be established:

- The First and Second Earlier Marks are visually similar to the applicant's mark to between a low and medium degree.
- The Third, Fourth, Fifth and Sixth Earlier Marks are visually similar to the applicant's mark to a medium degree.
- All the earlier marks are aurally similar to the applicant's mark to a medium degree, or a low degree, depending on how they are pronounced.
- The word/acronym AGA in all of the marks is conceptually neutral, with the 'gadgets' element in the applicant's mark acting as a conceptual point of difference.
- I have found the earlier marks to be inherently distinctive to either a medium degree or a high degree, depending upon how they are perceived.
- I have found the distinctiveness of the First, Second, Fourth and Sixth Earlier Marks have been enhanced through use to either a high degree, or a very high degree, in relation to cookers and ovens.
- I have identified the average consumer for the goods to be both members of the general public and specialists such as electricians, who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- I have found the parties' goods to vary from being similar to a medium degree to identical.

67. Taking all of the factors listed in paragraph 66 into account, particularly the visual differences between the marks, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. I do not consider that the



'gadgets' element in the applicant's mark will be overlooked by the average consumer. I do not consider there to be a likelihood of direct confusion.

68. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

69. I consider that the common use of the word AGA will lead the average consumer to conclude that the marks originate from the same or economically linked undertakings. I consider that the average consumer will see the addition of the word 'gadgets' and perceive it as an alternate mark for a sub-brand of AGA, as the word gadgets could be seen as indicating a modern, high-tech range. Therefore, as the average consumer will see the marks as being used by the same or economically linked undertakings, I consider there to be a likelihood of indirect confusion. This will be even more likely where the opponent benefits from enhanced distinctiveness.

70. The opposition based upon s5(2)(b) has succeeded in its entirety.

### **Section 5(3)**

71. Section 5(3) of the Act states:

“5(3) A trade mark which –

(a) 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 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 repute of the earlier trade mark.”

72. As noted above, the marks relied upon qualify as earlier marks pursuant to section 6 of the Act. I note that all of the goods and services under the earlier marks are being relied upon for the opposition under section 5(3) of the Act.

73. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks

and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in

order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

74. The conditions of section 5(3) are cumulative. Firstly, the opponent's and applicant's marks must be identical or similar. Secondly, the opponent must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must have established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the later mark. Fourthly, assuming that the first, second and third conditions have been met, section 5(3) requires that one or more types of damage claimed will occur and/or that the contested mark will, without due cause, take unfair advantage of the reputation and/or distinctive character of the reputed marks. It is unnecessary for the purposes of section 5(3) that the goods and services 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.

75. The relevant date for the assessment under section 5(3) is the date of application i.e. 26 April 2020.

## **Reputation**

76. In *General Motors*, Case C-375/97, the CJEU held that:

“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."

77. In determining whether the opponent has demonstrated a reputation for the goods and services in issue, it is necessary for me to consider whether its marks will be known by a significant part of the public concerned with the goods and services. In reaching this decision, I must take all of the evidence into account including "the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertakings in promoting it."

78. The earlier marks are all UKTMs. Consequently, the opponent must establish a reputation in the UK. I have summarised the opponent's evidence in this regard above. Clearly, the use has been geographically widespread and long-standing. The sales figures are extensive. Furthermore, there is a significant amount of advertising expenditure, which is supported by promotional materials and press release examples. The opponent has also won awards and provided evidence of celebrity endorsements including publications in magazines such as *Hello!* and *Ideal Home* and the published "The AGA Book" by Mary Berry. However, as highlighted above, the majority of these materials relate to the opponent's AGA cookers and its different types of inbuilt ovens. Taking this all into account, I am satisfied that the opponent's First, Second, Fourth and Sixth Earlier Marks had, at the relevant date, a reasonably strong reputation in relation to cookers and ovens in the UK.

79. As the Third and Fifth Earlier Marks' specifications do not cover cookers and ovens, a reputation for these marks has not been established.

## **Link**

80. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

### The degree of similarity between the conflicting marks

For the reasons set out above, I consider the First and Second Earlier Marks to be visually similar to between a low and medium degree, and the Fourth and Sixth Earlier Marks to be visually similar to a medium degree, to the applicant's mark. I consider all the marks to be aurally similar to a medium degree, or low degree, depending on how they are pronounced. I have found all the marks to be conceptually neutral, with the 'gadgets' element in the applicant's mark acting as a conceptual point of difference.

### The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods and services, and the relevant section of the public

I have found the goods for which the opponent has demonstrated a reputation to vary from being dissimilar to identical to the applicant's goods.

### The strength of the earlier mark's reputation

The earlier marks have a reasonably strong reputation in the UK for cookers and ovens.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

I have found the distinctiveness of the First, Second, Fourth and Sixth earlier marks has been enhanced through use in relation to cookers and ovens to either to a high degree, or a very high degree, depending on how they are perceived.

Whether there is a likelihood of confusion

I have found there to be a likelihood of indirect confusion. I consider that this would apply to all goods which I have found to be similar to a medium degree or higher. Where there is dissimilarity of goods and services, there can be no likelihood of confusion. Where there is only a low or between a low and medium degree of similarity between the goods and services, I consider that this distance will be sufficient to offset the likelihood of confusion.

81. Taking into account the above factors, I consider that the similarity between the marks, combined with the strength of the opponent's reputation will be sufficient for a link to be made by a significant part of the relevant public, in relation to those goods that are similar to the opponent's cookers and ovens.

82. The opposition based upon section 5(3) must, therefore, fail in relation to the following goods in the applicant's specification for which I have found no link:

Class 9      Electrical and electronic apparatus for the transmission of data; Electrical and electronic connectors; Electrical and electronic instruments for the transmission of data; Electrical cable; Electrical cables; Electrical cables for use in connections; Electrical cabling; Electrical cords; Electrical distribution boxes; Electrical extension leads; Electrical junction boxes; Electrical outlets; Electrical plugs; Electrical power adaptors; Electrical power extension cords; Electrical power outlet boxes; Electrical sockets; Electrical surge and spike protection units; Electrical switch boards; Electrical switch boxes; Electrical switch timers;

Electrical switches; Electrical switching apparatus; Electrical tape jigs [measuring instruments]; Electrical terminal blocks; Electrical terminal boxes; Electrical terminal connectors; Electrical terminals; Electrical travel adaptors; Electrical wires; Electrical wiring installations.

Class 11 Electrical coffee pots; Electrical serving pots; Electrical hot plates for food warming; Electrical heating elements; Electrical lamps; Electrical lamps for indoor lighting; Electrical light bulbs; Electrical lighting fixtures; Electrical lighting fixtures for use in hazardous locations.

## **Damage**

83. The opponents submission in lieu read as follows:

“Given these identities and similarities, the Opponent therefore contends that the average consumer would make an unwarranted economic and commercial connection between the marks in question and the purchasing decision of the average consumer would be affected, as such the Applicants would obtain an unfair advantage by using their applied for trade mark without due cause.”

84. To the extent that the relevant public will believe that the applicant’s goods originate from the same or economically connected undertakings, damage will clearly arise.

85. In relation to damage, the opponent states:

“16. The use of the trade mark Agagadgets beyond the control of the Opponent would degrade the reputation the Opponent has established in the earlier trade marks and effectively piggyback off of the distinctive character and repute of the earlier trade marks and as clearly established in *L’Oreal v Bellure* [2010] EWCA Civ 535, any free riding advantage is unfair. It is our contention that the average consumer would assume that any purchase made bearing the brand name Agagadgets was connected with the Opponents AGA brand.



17. Given these identities and similarities, the average consumer would make an unwarranted economic commercial connection between the marks in question and the purchasing decision of the average consumer would be affected. The use of the trade mark Agagadgets beyond the control of the Opponent would damage the reputation the Opponent has established in the earlier trade marks and effectively piggy back off the distinctive character and repute of the earlier marks.”

86. I bear in mind that unfair advantage has no effect on the consumers of the earlier marks’ goods. Instead, the taking of unfair advantage of the distinctive character or reputation of the opponent’s earlier marks means that consumers are more likely to buy the goods of the later mark than they would otherwise have been if they had not been reminded of the earlier marks.

87. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant’s intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant’s conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

88. Taking into account the opponent’s reasonably strong reputation, the similarity of the marks, and the similarity of some of the goods, it is clear that there is potential for

this image to be transferred to the applicant. The applicant would consequently secure a commercial advantage, benefitting from the opponent's reputation without paying financial compensation and would, therefore, be likely to take unfair advantage of the earlier marks. This will only apply to the goods that I have found to share at least some similarity with the goods for which the opponent has demonstrated a reputation.

89. As I have found in favour of the opponent for all goods in relation to which I have found a link, I need not go on to consider the other heads of damage.

90. The opposition based upon section 5(3) succeeds in relation to the following goods only in the applicant's specification:

Class 11      Electrical appliances for cooking; electrical rice cookers.

**Section 5(4)(a)**

91. Section 5(4)(a) of the Act states as follows:

“5(4) 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 of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

aa)...

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”.

92. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

93. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. 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 all three limbs.

56. 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).”

### **Relevant date**

94. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows: ‘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.”

95. As the applicant has filed no evidence of use, I have only the prima facie relevant date to consider i.e. 26 April 2020.

## **Goodwill**

96. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in customers. It is the one thing which distinguishes an old-established business from a new business at its first start.”

97. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation;

54 evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

98. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

99. Goodwill arises as a result of trading activities. It is clear from the turnover figures provided by Mr Carpenter that the opponent's company has been trading under the AGA sign since 2010. However, Mr Carpenter has submitted that the opponent's company has operated since 1929 in Britain and provided evidence of trading dated as early as 2006.<sup>1</sup>

100. As previously established, although a breakdown of figures has not been provided, the overall turnover figures range from £29 million to £45 million a year. A significant proportion of the opponent's evidence relates to cookers and ovens and,

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<sup>1</sup> DC13

therefore, I consider that such sales relating cookers/ovens alone would still amount to several million pounds. Mr Carpenter also provided UK advertising figures from 2016 to 2020 which overall amounted to over £5 million.

101. I note that there is very little evidence which relates to the rest of the goods and services which are in the annex to this decision. This includes the Aga Cookshop Autumn/Winter 2015 catalogue which advertises the widest range of goods which the opponent is relying on. However, this catalogue is not supported by evidence of how many of these goods were actually sold, or any figures about how many catalogues were distributed to customers. Consequently, due to the lack of evidence, I do not consider that the opponent has demonstrated goodwill for the remaining goods and services at the prima facie relevant date.

102. Taking the evidence as a whole into account, I am satisfied that the opponent has demonstrated a reasonably strong degree of goodwill prior to the relevant date in relation to cookers and ovens. Examples have been provided of the mark being used in relation to sales catalogues, press releases, advertisements, the AGA trailer, the opponent's websites and social media, and celebrity endorsed articles. In light of this, I am also satisfied that the earlier signs were distinctive of the opponent's goodwill at the relevant date.

### **Misrepresentation and damage**

103. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“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] R.P.C. 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 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

And later in the same judgment:

"... for my part, I think that references, in this context, to "more than *de minimis*" and "above a trivial level" are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion."

104. I recognise that the test for misrepresentation is different from that for likelihood of confusion in that it entails "deception of a substantial number of members of the public" rather than "confusion of the average consumer". However, as recognised by Lewison L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that to be the case here.

105. The goods for which the opponent has shown goodwill are identical to electrical appliances for cooking and electrical rice cookers for the same reasons as set out above. Taking the closeness of the parties' fields of activity into account, and the fact that AGA is entirely replicated at the beginning of the applicant's mark, I consider that a substantial number of members of the relevant public would be misled into purchasing the applicant's goods in the mistaken belief that they are the goods of the opponent. Damage through diversion of sales is easily foreseeable.

106. However, for the goods and services that are similar to between a low and medium degree, or are dissimilar, I consider that the differences between the goods and services would be sufficient to avoid misrepresentation occurring. I consider that

these differences are sufficient to avoid a substantial number of members of the relevant public purchasing the applicant's goods in the mistaken belief that they are provided by the opponent's business. As there is no misrepresentation, there can be no damage.

107. The opposition under section 5(4)(a) succeeds in relation to the following goods:

Class 11 Electrical appliances for cooking; electrical rice cookers.

## **CONCLUSION**

108. The opposition has been successful and the application is refused.

## **COSTS**

109. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£1,600** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Filing a Notice of opposition and considering the applicant's counterstatement	£400
Preparing and filling witness statement and exhibits	£650
Filing written submissions	£350
Official Fee	£200
<b>Total</b>	<b>£1,600</b>



110. I therefore order Lilmacc Ltd to pay Aga Rangemaster Group Limited the sum of £1,600. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 11th day of August 2021**

**L FAYTER**

**For the Registrar**

## ANNEX

### **First Earlier Mark**

#### Class 3

Cleaning, degreasing, polishing, scouring and abrasive preparations and materials; scale removing preparations; rust removers; ceramic hob cleaners; enamel cleaners; chrome cleaners; enamel rubbers; detergents for cleaning use; soap; hand lotion and creams; cleaning preparations for hands; room fragrancing preparations and products; room perfume sprays.

#### Class 6

Metallic pan stands; aluminium foil baking cups and containers for food and beverages; foils of metal for cooking; metallic pan racks and shelves; prefabricated shelves of metal; metallic tiles; bins of metal; ornaments, all made of metal; parts and fittings for the aforesaid goods.

#### Class 7

Food and beverage blenders; food mixers; electric appliances for mincing foods; electric coffee grinders; electric coffee mills; ice cream makers; food liquidisers; electric food and vegetable juice extractors, presses and/or squeezers; food processors; food mixers; beverage preparation and making machines; electric bread knives; bread moulding machines; bread cutting machines; electric can openers; food slicing machines; food processing machines; food waste disposal machines; electric food whisks; machines for the food and beverage industry; presses for food stuffs; presses for moulding food stuffs; parts and fittings for the aforesaid goods.

#### Class 8

Cutlery; knives; meat forks; knife sharpeners; sharpening steels; pizza paddles; oven reachers; mezzalunas; table tops scrapers and replacement blades; bakers paddles; knife blocks; meat forks; fireplace bellows; fire irons; cutting wheels for cutting foods; implements for the serving of food; whisks; micro-planes; turners; spoons; ladles; spatulas; skimmers; scissors; hand-operated shredders or slicers; nut crackers; can and bottle openers; parts and fittings for the aforesaid goods.

### Class 9

Scales; electronic measuring apparatus for monitoring conditions inside baking ovens; electric timers; egg timers; magnets; meat thermometers; thermometers; digital probe thermometers; automatic temperature regulators, thermometers and thermostats, all for use in cooking, warming heating, refrigerating apparatus, installations and appliances; CDs, videos, DVDs, tapes, mini discs and discs; computer software for use in connection with cooking, warming, heating, thawing, refrigerating or freezing apparatus, installations and appliances; parts and fittings for the aforesaid goods.

### Class 11

Cooking, baking, warming, thawing and heating apparatus, installations and appliances; apparatus for refrigerating and freezing; ovens; hobs; cookers; cooking ranges; extractor hoods; cast iron wood burning stoves; cast iron solid fuel stoves; stoves; boilers; electric kettles; toasters; baking ovens; bread making machines; commercial ovens for baking foods; electric toasters; electric sandwich makers; electric coffee machines; electric coffee pots; espresso coffee machines; apparatus for lighting for use in kitchens; down lights; radial swivel down lights; machines for use in making ice cream (refrigerating); electric deep fat fryers; electric slow cookers; pasta making machines; electric cheese graters; wine coolers; ice makers; apparatus for use in the smoking or curing of food stuffs; apparatus for the grilling or toasting of food stuffs; heated or refrigerating food servery units; electric fans; apparatus for ventilating; water supply installations; sinks and sink units; taps; tap units; parts and fittings for the aforesaid goods.

### Class 14

Horological and chronometric instruments; clocks; watches; jewellery; badges and bars for use therewith; key rings and key chains; pins; tie pins; cuff links; parts and fittings for the aforesaid goods.

### Class 16

Books; magazines; periodical publications; instructional and teaching materials; manuals; all relating to the preparation, processing, cooking, preserving, refrigerating and freezing of food and beverages; photographs; post cards; greetings cards;

posters; calendars; gift bags; gift wrapping paper; prints; pictures; diaries; stickers; stationery.

#### Class 18

Coasters made of leather or imitation leather; place mats made of leather or imitation leather; travelling cases; bags; umbrellas; wallets; key fobs; purses; credit card holders; parts and fittings for the aforesaid goods.

#### Class 19

Tiles; tile groutings; fitted kitchen work tops; flooring materials; parts and fittings for the aforesaid goods.

#### Class 20

Pan racks; pan stands; food racks; kitchen furniture; non-heated and non-refrigerated cabinets; containers; kitchen cabinets, cupboards and display units; plaques; picture frames; mirrors; tables; chairs; stools; blinds; parts and fittings for the aforesaid goods.

#### Class 21

Utensils and containers for culinary or kitchen use; cast aluminium, stainless steel, hard anodised, earthen, glass, porcelain, ceramic, wooden or cast iron cookware, bake ware, kitchen ware and table ware; baking tins; baking trays; baking dishes; baking sheets; cooking moulds; saucepans; casseroles; frying pans; non-electric kettles; teapots; chopping boards; trivets; pan stands; cooling racks; articles for use in cleaning; brushes; hand operated coffee grinders; hand operated coffee mills; parts and fittings for the aforesaid goods.

#### Class 25

Articles of clothing, footwear and headgear; aprons; bibs; ties; scarves; gloves.

#### Class 35

The bringing together for the benefit of others of a variety of goods enabling customers to conveniently view and purchase the goods in a retail outlet or through a catalogue or via a website, all the aforesaid connected with catering, cooking, heating,

refrigerating, freezing, thawing, warming and serving products, apparatus and installations, culinary ware, cookware, kitchen ware and table ware items.

### Class 37

Custom construction, installation, repair, refurbishment and/or maintenance of catering apparatus, installations and appliances and of apparatus, installations and appliances for cooking, warming, thawing, heating, refrigerating, freezing or serving of food and beverages and of heating and water supply apparatus, installations and appliances; advisory, information services relating to all the aforesaid services.

### **Second Earlier Mark**

#### Class 11

Installations and apparatus included in Class 11, all for cooking and for heating; oil and gas stove burners; outer casings being parts included in Class 11 of heating cabinets.

### **Third Earlier Mark**

#### Class 11

Oven door shields; oven resistant pads and sheets; cooking range hob lid covers.

#### Class 21

Utensils and containers for culinary or kitchen use; cast aluminium, stainless steel, hard anodised, earthen, glass, enamelled, porcelain, ceramic, wooden or cast iron cookware, bake ware, kitchen ware and table ware; baking tins; baking trays; roasting trays; roasting tins, baking dishes; baking sheets; grill pans and griddles; cooking moulds; saucepans; casseroles; frying pans; hot plate brushes; non-electric kettles; teapots; chopping boards; carving boards ; glass work top protector; non-electric toaster; rolling pins ; cookbook stands; trivets; pan stands; cooling racks; articles for use in cleaning; cleaning cloths; brushes; wire brushes; hot plate brushes; hand operated coffee grinders; hand operated coffee mills; salt and pepper mills; jugs; mugs and cups; oven gloves; oven gauntlets ; pot holders; chefs pads; pan handle covers; pot grabs; oven mitts; bottle stops; top plate scrapers; pestle and mortars; pasta machines and accessories (not electric); mandolins; salad spinners; garlic presses and rollers; ice buckets; champagne buckets; napkin rings and holders; ornaments;

cake stands; trays; pie funnels; silicone bakeware; anodised bakeware; ceramic baking beans; jam pots; jam covers and seals; pegs for hanging clothes; icing cutter and presses; cake decorating tools; electric cork screws; turners; oven reachers being oven gloves; electric cork screws; flat irons, fish and like kettles; cooking moulds; salt and pepper mills; oven heat resistant pads and sheets, biscuit tins; cake tins; tea cosies; coffepot cosies; egg cosies; parts and fittings for the aforesaid goods.

#### Class 24

Textiles and textile goods; tea towels; towels; table covers; rugs; pillows and cushions; flags and bunting; furniture coverings of textile, textile place mats; table runners; table napkins not of paper; tablecloths; dish cloths; heat resistant fabrics.

#### Class 25

Articles of clothing, footwear and headgear; aprons; bibs; ties; scarves; gloves; headscarves.

### **Fourth Earlier Mark**

#### Class 3

Cleaning, degreasing, polishing, scouring and abrasive preparations and materials; scale removing preparations; rust removers; ceramic hob cleaners; enamel cleaners; chrome cleaners; enamel rubbers; detergents for cleaning use; soap; hand lotion and creams; cleaning preparations for hands; room fragrancing preparations and products; room perfume sprays.

#### Class 6

Metallic pan stands; aluminium foil baking cups and containers for food and beverages; foils of metal for cooking; metallic pan racks and shelves; prefabricated shelves of metal; metallic tiles; bins of metal; ornaments, all made of metal; parts and fittings for the aforesaid goods.

#### Class 7

Food and beverage blenders; food mixers; electric appliances for mincing foods; electric coffee grinders; electric coffee mills; ice cream makers; food liquidisers; electric food and vegetable juice extractors, presses and/or squeezers; food

processors; food mixers; beverage preparation and making machines; electric bread knives; bread moulding machines; bread cutting machines; electric can openers; food slicing machines; food processing machines; food waste disposal machines; electric food whisks; machines for the food and beverage industry; presses for food stuffs; presses for moulding food stuffs; parts and fittings for the aforesaid goods.

#### Class 8

Cutlery; knives; meat forks; knife sharpeners; sharpening steels; pizza paddles; oven reachers; mezzalunas; table tops scrapers and replacement blades; bakers paddles; knife blocks; meat forks; fireplace bellows; fire irons; cutting wheels for cutting foods; implements for the serving of food; whisks; micro-planes; turners; spoons; ladles; spatulas; skimmers; scissors; hand-operated shredders or slicers; nut crackers; can and bottle openers; parts and fittings for the aforesaid goods.

#### Class 9

Scales; electronic measuring apparatus for monitoring conditions inside baking ovens; electric timers; egg timers; magnets; meat thermometers; thermometers; digital probe thermometers; automatic temperature regulators, thermometers and thermostats, all for use in cooking, warming heating, refrigerating apparatus, installations and appliances; CDs, videos, DVDs, tapes, mini discs and discs; computer software for use in connection with cooking, warming, heating, thawing, refrigerating or freezing apparatus, installations and appliances; parts and fittings for the aforesaid goods.

#### Class 11

Cooking, baking, warming, thawing and heating apparatus, installations and appliances; apparatus for refrigerating and freezing; ovens; hobs; cookers; cooking ranges; extractor hoods; cast iron wood burning stoves; cast iron solid fuel stoves; stoves; boilers; electric kettles; toasters; baking ovens; bread making machines; commercial ovens for baking foods; electric toasters; electric sandwich makers; electric coffee machines; electric coffee pots; espresso coffee machines; apparatus for lighting for use in kitchens; down lights; radial swivel down lights; machines for use in making ice cream (refrigerating); electric deep fat fryers; electric slow cookers; pasta making machines; electric cheese graters; wine coolers; ice makers; apparatus for use in the smoking or curing of food stuffs; apparatus for the grilling or toasting of food

stuffs; heated or refrigerating food servery units; electric fans; apparatus for ventilating; water supply installations; sinks and sink units; taps; tap units; parts and fittings for the aforesaid goods.

Class 14

Horological and chronometric instruments; clocks; watches; jewellery; badges and bars for use therewith; key rings and key chains; pins; tie pins; cuff links; parts and fittings for the aforesaid goods.

Class 18

Coasters made of leather or imitation leather; place mats made of leather or imitation leather; travelling cases; bags; umbrellas; wallets; key fobs; purses; credit card holders; parts and fittings for the aforesaid goods.

Class 19

Tiles; tile groutings; fitted kitchen work tops; flooring materials; parts and fittings for the aforesaid goods.

Class 20

Pan racks; pan stands; food racks; kitchen furniture; non-heated and non-refrigerated cabinets; containers; kitchen cabinets, cupboards and display units; plaques; picture frames; mirrors; tables; chairs; stools; blinds; parts and fittings for the aforesaid goods.

Class 35

The bringing together for the benefit of others of a variety of goods enabling customers to conveniently view and purchase the goods in a retail outlet or through a catalogue or via a website, all the aforesaid connected with catering, cooking, heating, refrigerating, freezing, thawing, warming and serving products, apparatus and installations, culinary ware, cookware, kitchen ware and table ware items.

**Fifth Earlier Mark**

Class 37



Installation, maintenance and repair of cooking apparatus and instruments , space heating and domestic water heating apparatus and appliances, and of home laundering apparatus; all included in Class 37.

### **Sixth Earlier Mark**

#### Class 11

Lighting installations; heating apparatus; steam heating apparatus; cooking apparatus; refrigeration apparatus; drying apparatus; ventilating apparatus; water purifying apparatus; water closets and cisterns; filters and filtering apparatus, all for drinking water or for air conditioning all being parts of installations; blow lamps for burning off or brazing; dehydrators; furnaces.

### **Goods relied upon for section 5(4)(a)**

Scales; electronic measuring apparatus for monitoring conditions inside baking ovens; electric timers; egg timers; magnets; meat thermometers; thermometers; digital probe thermometers; automatic temperature regulators, thermometers and thermostats, all for use in cooking, warming heating, refrigerating apparatus, installations and appliances; CDs, videos, DVDs, tapes, mini discs and discs; computer software for use in connection with cooking, warming, heating, thawing, refrigerating or freezing apparatus, installations and appliances; parts and fittings for the aforesaid goods.

Cooking, baking, warming, thawing and heating apparatus, installations and appliances; apparatus for refrigerating and freezing; ovens; hobs; cookers; cooking ranges; extractor hoods; cast iron wood burning stoves; cast iron solid fuel stoves; stoves; boilers; electric kettles; toasters; baking ovens; bread making machines; commercial ovens for baking foods; electric toasters; electric sandwich makers; electric coffee machines; electric coffee pots; espresso coffee machines; apparatus for lighting for use in kitchens; down lights; radial swivel down lights; machines for use in making ice cream (refrigerating); electric deep fat fryers; electric slow cookers; pasta making machines; electric cheese graters; wine coolers; ice makers; apparatus for use in the smoking or curing of food stuffs; apparatus for the grilling or toasting of food stuffs; heated or refrigerating food serverly units; electric fans; apparatus for ventilating; water supply installations; sinks and sink units; taps; tap units; parts and fittings for the aforesaid goods; oil or gas stove burners, all being made of metal or predominantly of

metal; lighting installations; heating apparatus; steam heating apparatus; cooking apparatus; refrigeration apparatus; drying apparatus; ventilating apparatus; water purifying apparatus; water closets and cisterns; filters and filtering apparatus, all for drinking water or for air conditioning all being parts of installations; blow lamps for burning off or brazing; dehydrators; furnaces.

The bringing together for the benefit of others of a variety of goods enabling customers to conveniently view and purchase the goods in a retail outlet or through a catalogue or via a website, all the aforesaid connected with catering, cooking, heating, refrigerating, freezing, thawing, warming and serving products, apparatus and installations, culinary ware, cookware, kitchen ware and table ware items.

Installation, maintenance and repair of cooking apparatus and instruments , space heating and domestic water heating apparatus and appliances, and of home laundering apparatus.