

O/0207/23

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001582184

DESIGNATING THE UK

BY DIRS D.O.O.:

CHEFdeluxe 

IN CLASSES 7, 11 AND 21

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 429075

BY DE LONGHI BENELUX S.A.

BACKGROUND AND PLEADINGS

1. International trade mark 1582184 (“the IR”) consists of the sign shown on the cover page of this decision. The holder is DIRS d.o.o.. The IR is registered with effect from 3 December 2020. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The holder seeks protection for the IR in relation to the goods set out in paragraph 17 below.

2. The request to protect the IR was published on 10 September 2021. On the same date, De Longhi Benelux S.A. (“the opponent”) opposed the protection of the IR in the UK 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 upon the following trade mark:

CHEF

UKTM no. 3438050

Filing date 21 October 2019; registration date 20 March 2020

Relying on all goods for which the mark is registered, namely:

Class 7 Food mixers; attachments and accessories for food mixers.

3. Under section 5(2)(b), the opponent claims that there is a likelihood of confusion because the marks are similar and the goods are identical or similar.

4. Under section 5(3), the opponent claims a reputation for all the goods for which the earlier mark is registered and claims that use of the IR would, without due cause, take unfair advantage of that reputation or would be detrimental to the distinctive character of the earlier mark.

5. Under section 5(4)(a), the opponent relies upon the sign **CHEF** which it claims to have been using throughout the UK since the 1950s in relation to “food mixers; attachments and accessories for food mixers”.

6. The holder filed a counterstatement denying the claims made.

7. The opponent is represented by Mathys & Squire LLP and the holder is represented by Brandsmiths S.L. Limited.

8. Only the opponent filed evidence. Neither party requested a hearing and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

9. The opponent filed evidence in the form of the witness statement of Gary William Anthony Johnston, dated 5 July 2022. Mr Johnston is a Chartered Trade Mark Attorney acting on behalf of the opponent. His statement is accompanied by 30 exhibits. Exhibit GWAJ13 is subject to a confidentiality order.

10. The opponent filed written submissions during the evidence rounds dated 5 July 2022. It also filed written submissions in lieu of a hearing dated 6 December 2022.

11. I have taken all of the submissions and evidence into consideration in reaching my decision.

RELEVANCE OF EU LAW

12. 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 upon 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.

DECISION

Section 5(2)(b)

13. Section 5(2)(b) of the Act 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.”

14. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

15. By virtue of its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had not completed its registration process more than 5 years before the application date of the IR in issue, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods identified.

16. 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 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 to mind the earlier mark, 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

17. The parties' respective goods are as follows:

Opponent's goods	Holder's goods
<p><u>Class 7</u> Food mixers; attachments and accessories for food mixers.</p>	<p><u>Class 7</u> Electric arc cutting apparatus; whisks, electric, for household purposes; fruit presses, electric, for household purposes; scissors, electric; food processors, electric; knives, electric; beaters, electric; beverage preparation machines, electromechanical; food preparation machines, electromechanical; water heaters being parts of machines; machines and apparatus for wax-polishing, electric; parquet wax-polishers, electric; dust exhausting installations for cleaning purposes; air suction machines; spin dryers [not heated] / spin driers [not heated].</p>

Class 11

Beverage cooling apparatus; bread-making machines; heating apparatus, electric; cooking utensils, electric; electric lamps; coffee percolators, electric; coffee machines, electric; waffle irons, electric; deep fryers, electric; heating plates; water heaters; cooking rings; cooking stoves / cookers; kitchen ranges [ovens]; microwave ovens [cooking apparatus]; cooking apparatus and installations; bread baking machines; bread toasters / toasters; hearths; stoves [heating apparatus]; kilns; hot air ovens; roasting apparatus / griddles [cooking appliances] / grills [cooking appliances]; bakers' ovens; hot plates; fittings, shaped, for furnaces / fittings, shaped, for ovens / shaped fittings for furnaces / shaped fittings for ovens; rotisseries; roasting apparatus / griddles [cooking appliances] / grills [cooking appliances]; incandescent burners.

Class 21

Tea strainers; strainers for household purposes; teapots; autoclaves, non-electric, for cooking / pressure cookers, non-electric; deep fryers, non-electric; ceramics for household purposes; cooking skewers of metal / cooking pins of metal; vessels of metal for making ices

	<p>and iced drinks; cooking utensils, non-electric; cooking pot sets; kitchen containers; kitchen utensils; basting spoons [cooking utensils]; pots; spatulas for kitchen use; scoops for household purposes; pie servers / tart scoops; kitchen grinders, non-electric; blenders, non-electric, for household purposes; whisks, non-electric, for household purposes; kitchen grinders, non-electric; moulds [kitchen utensils] / molds [kitchen utensils]; cookery moulds / cookery molds; cake moulds / cake molds; tableware, other than knives, forks and spoons; cookie [biscuit] cutters; pastry cutters; napkin rings; bottle openers, electric and non-electric; pot lids; dish covers / covers for dishes; stew-pans; frying pans; containers for household or kitchen use; bread bins; heat-insulated containers; mills for household purposes, hand-operated; sieves [household utensils]; dishes; salad bowls; vegetable dishes; garlic presses [kitchen utensils].</p>
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18. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“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 are complementary.”

19. Guidance on this issue has also 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.

20. 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.”

Class 7

Whisks, electric, for household purposes; Food processors, electric; beaters, electric; food preparation machines, electromechanical;

21. The opponent claims that these goods are all identical to “food mixers”. I agree, they are clearly identical on the principle outlined in *Meric*.

Beverage preparation machines, electromechanical;

22. The opponent makes the same submissions in relation to these goods. However, I do not agree that these are identical to the opponent’s “food mixers”. The holder’s goods relate to beverage preparation, not food. I recognise that these could include goods such as smoothie makers, which would overlap in nature with the opponent’s goods. There could be an overlap in method of use. I consider it unlikely that it will be common for the same businesses to produce both goods, although I recognise that there may be some large undertakings that do. In any event, there may be an overlap in trade channels to the extent that both could be sold through the same retailers. The user will clearly overlap. The purpose of the goods will differ, as one is used to mix food whereas the other is used to prepare beverages. There may be an element of competition where, for example, smoothie makers are concerned, as consumers may either buy a specific machine for the purposes of beverage preparation or may buy a general household food processor, which could be used for the same purpose. There is no complementarity. Taking all of this into account, I consider the goods to be similar to between a medium and high degree.

Fruit presses, electric, for household purposes;

23. The opponent has made no specific submissions in relation to these goods. However, I note the opponent’s general submission as follows:

“With regards the remaining terms not touched upon above, these are similar and/or complementary to the Opponent’s Goods, as they would share one or more of the following:

- i. The same average consumer (for example, home keepers, home cooks etc);
- ii. The same purpose (for example, for food and beverage preparation);
- iii. The same (or at least highly similar) method of use); and
- iv. The same trade channels, as they would be found sold and advertised together in the same retail outlets dedicated for home, or in the ‘home’ sections of wider stores (and/or websites thereof).”

24. To my understanding, these are goods that are typically used to crush fruit for the purposes of making juices or other beverages (such as cider). Whilst these are used in beverage preparation, they do not share the same overlap in nature or method of use with the opponent’s goods as identified in relation to other types of beverage preparation machines above. There will also not be the same competition. The user will clearly overlap as both can be used by members of the general public. The purpose will differ and there will be no complementarity. I note that the opponent’s evidence shows that it offers a fruit juice attachment for its food mixers i.e. an attachment that extracts the juice from fruit. However, I have no reason to believe that it is common practice for businesses to offer both and no evidence that it is. I recognise that there may be some overlap in retailers. Taking all of this into account, I consider the goods to be similar to a low degree.

Scissors, electric; knives, electric;

24. I have no specific submissions from the opponent in relation to these goods. I accept that there will be overlap in user, as both parties’ goods could be used by members of the general public. However, the purpose of the holder’s goods is to cut food or other items, whereas the opponent’s goods are for mixing. The nature of the goods will be different, as will the method of use. In the absence of any evidence, I see no reason why the same businesses would produce both, although I recognise that both could be sold through the same retailers and in similar aisles. I do not

consider the goods to be in competition or complementary. Consequently, I consider the goods to be similar to a low degree.

Electric arc cutting apparatus; water heaters being parts of machines; machines and apparatus for wax-polishing, electric; parquet wax-polishers, electric; dust exhausting installations for cleaning purposes; air suction machines; spin dryers [not heated] / spin driers [not heated].

25. As far as I can see, the opponent's submissions in relation to "the remaining terms" do not apply to these goods. They do not share the same purpose; none of these goods relate to food or beverage preparation. I can see no reason why there would be any overlap in method of use, nor trade channels. To my mind, the fact that some of these goods may, as the opponent submits, be sold in "home" sections of stores (if, in fact, they would be), is not enough to justify a finding of similarity. I accept that some of these may be purchased by members of the general public, as would the opponent's goods. Taking all of this into account, I consider the goods to be dissimilar.

Class 11

Beverage cooling apparatus; bread-making machines; heating apparatus, electric; cooking utensils, electric; coffee percolators, electric; coffee machines, electric; waffle irons, electric; deep fryers, electric; heating plates; cooking rings; cooking stoves / cookers; kitchen ranges [ovens]; microwave ovens [cooking apparatus]; cooking apparatus and installations; bread baking machines; bread toasters / toasters; stoves [heating apparatus]; hot air ovens; roasting apparatus / griddles [cooking appliances] / grills [cooking appliances]; bakers' ovens; hot plates; fittings, shaped, for furnaces / fittings, shaped, for ovens / shaped fittings for furnaces / shaped fittings for ovens; rotisseries; roasting apparatus / griddles [cooking appliances] / grills [cooking appliances];

26. As far as I can see, the only point of overlap between these goods in the holder's specification and the opponent's goods is that both could be used by members of the general public and that both could be purchased from retailers specialising in cooking apparatus and kitchenware. I consider it unlikely that it is common for these goods to

be produced by the same businesses. There is no overlap in purpose, nature or method of use and they are neither in competition nor complementary. In my view, this is not sufficient on its own for a finding of similarity. However, even if I am wrong in this finding, any similarity would be at a low level.

Electric lamps; water heaters; hearths; kilns; incandescent burners.

27. In my view, the same applies as above in relation to these goods, with the additional difference that these are not goods I would expect to be sold by retailers specialising in cooking apparatus and kitchenware. Consequently, I consider these goods to be dissimilar.

Class 21

Cooking utensils, non-electric; kitchen utensils; blenders, non-electric, for household purposes; whisks, non-electric, for household purposes;

28. These are all types of goods that can be used (or include goods that are used) to mix food. Consequently, there is an overlap in purpose with the opponent's "food mixers". The user will clearly overlap. The nature and method of use of the goods will clearly differ. I consider it unlikely that businesses producing the opponent's power-operated food mixers would also produce non-electric equivalents. However, there is potential for them to be sold through the same retailers. Clearly, they will be in competition. I do not consider there to be complementarity. Taking this into account, I consider the goods to be similar to a medium degree.

Tea strainers; strainers for household purposes; teapots; autoclaves, non-electric, for cooking / pressure cookers, non-electric; deep fryers, non-electric; ceramics for household purposes; cooking skewers of metal / cooking pins of metal; vessels of metal for making ices and iced drinks; cooking pot sets; kitchen containers; basting spoons [cooking utensils]; pots; spatulas for kitchen use; scoops for household purposes; pie servers / tart scoops; kitchen grinders, non-electric; kitchen grinders, non-electric; moulds [kitchen utensils] / molds [kitchen utensils]; cookery moulds / cookery molds; cake moulds / cake molds; tableware, other than knives, forks and

spoons; cookie [biscuit] cutters; pastry cutters; napkin rings; bottle openers, electric and non-electric; pot lids; dish covers / covers for dishes; stew-pans; frying pans; containers for household or kitchen use; bread bins; heat-insulated containers; mills for household purposes, hand-operated; sieves [household utensils]; dishes; salad bowls; vegetable dishes; garlic presses [kitchen utensils].

29. As far as I can see, none of these remaining goods in class 21 of the holder's specification overlap in purpose in the same way as the above goods. Consequently, there is no competition. Whilst there will clearly still be an overlap in user, and possibly some superficial overlap in trade channels, I do not consider this sufficient to give rise to similarity. I note that the opponent has filed evidence that it sells attachments for its food mixers which provide additional functionality such as milling and grinding.¹ However, by virtue of being included in class 7, the opponent's "attachments for food mixers" are powered rather than hand-held, whereas the holder's goods are handheld (by virtue of being in class 21). Further, I do not think that the ordinary meaning of "attachment for food mixers" would include attachments which provide entirely different functions to mixing foods. Taking this into account, I consider these goods to be dissimilar.

30. As a finding of similarity of goods is essential for there to be a likelihood of confusion under section 5(2)(b), the opposition will fail in relation to all of those goods that I have found to be dissimilar.

The average consumer and the nature of the purchasing act

30. As the above case law 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:

¹ Exhibit GWAJ09

“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.”

31. The average consumer for the goods will be a member of the general public or a professional user, such as a chef or restaurant owner. The cost of the goods is likely to vary, but they are likely to be relatively infrequent purchases. Given that the goods will be used in food preparation, the level of attention paid is likely to be at least medium (or average).

32. The goods are likely to be selected from the shelves of a retail outlet or their online equivalents. Consequently, I consider it likely that visual considerations will dominate the purchasing process. However, given that advice may be sought from sales assistants, I do not discount an aural component.

Comparison of trade marks


33. 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.”

34. 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.

35. The respective trade marks are shown below:

Opponent's trade mark	The IR
CHEF	

36. The opponent's mark consists of the word CHEF. There are no other elements to contribute to the overall impression which lies in the word itself. The IR consists of the word CHEF in upper case font, conjoined with the word 'deluxe' in lower case font. There is a figurative device placed above the letter 'x'. All of these elements contribute to the overall impression. However, in my view, the word CHEF plays the greater role due to it appearing at the start of the mark and being in bold upper case font.

37. Visually, the marks overlap to the extent that the opponent's trade mark is replicated at the beginning of the IR. The addition of the word deluxe acts as a point of difference, as does the device. Taking all of this into account, I consider the marks to be visually similar to a medium degree.

38. Aurally, the marks overlap in that the word CHEF will be pronounced identically in both marks. The word 'deluxe' in the holder's mark will clearly act as a point of aural difference. Consequently, I consider the marks to be aurally similar to between a medium and high degree.

39. Conceptually, the word CHEF (being a well known English word) will be given the same meaning in both marks. The word 'deluxe' in the holder's mark will also be given

its ordinary English meaning i.e. a laudatory term meaning high quality.² I do not consider that the device in the IR will convey any conceptual meaning to the average consumer. Taking this into account, I consider the marks to be conceptually similar to between a medium and high degree.

Distinctive character of the earlier trade mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-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 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).”

41. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic

² <https://www.collinsdictionary.com/dictionary/english/deluxe>

of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

42. A lot of the information provided in the opponent's evidence relates to the EU market. As it is the UK market which is relevant for enhanced distinctiveness, this will not assist the opponent. With that in mind, I note the following from the opponent's evidence:

- a) A Placing and Public offer of shares dated 17 June 1992 confirms that over seven million units of "the Chef" mixer had been sold since its introduction in the 1950s.³ The same document confirms that by 1988 Chef mixers and attachments had sold over £21,000,000.
- b) An extract from the Wayback Machine dated 22 April 2020 shows Chef mixers available to purchase from the Kenwood website.⁴
- c) In 2010, the opponent celebrated 60 years of the CHEF kitchen machine.

d) [REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]⁵

e) [REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]

³ Exhibit GWAJ06
⁴ Exhibit GWAJ08
⁵ Confidential Exhibit GWAJ13

[REDACTED]

[REDACTED]⁶

f) [REDACTED]⁷

[IMAGE REDACTED]

[IMAGE REDACTED]

⁶ Confidential Exhibit GWAJ13

⁷ Confidential Exhibit GWAJ13

- [REDACTED]
- [REDACTED]
- [REDACTED]
- g) Invoices addressed to customers located around the UK (including Hertfordshire, Glasgow, Somerset and London) and dated between 2009 and 2013 show sales of over 2,700 units bearing the CHEF mark.⁸
- h) The “Cooking Chef” was described as the no. 2 Global Top Seller in 2012.⁹ However, no reference is made to its position within the UK market specifically. I also note that various information is given about the status of the KENWOOD brand, but as that is not the mark relied upon, I do not consider that assists the opponent.
- i) General figures have been given for UK market share for Kenwood’s machines, but this is not broken down into either products sold under the CHEF mark or food mixers specifically.¹⁰
- j) The CHEF food mixer has been covered in publications including *Good Housekeeping* (2002 and 2007, for example), *The Telegraph* (2006), *Ideal Home* (2007), *Delicious* (2009), *BBC Good Food* (2009 and 2012), *The Sun* (2010), *Mail Online* (2017) and *The Times* (2020).¹¹
- k) The opponent’s goods have won awards for their design.¹²
- l) The opponent’s CHEF mixers and attachments are sold through retailers including John Lewis and Lakeland.
- m) The opponent’s CHEF mixers have been reviewed by Which?.¹³

⁸ Exhibit GWAJ15

⁹ Exhibit GWAJ16

¹⁰ Exhibit GWAJ17

¹¹ Exhibits GWAJ18 and GWAJ26

¹² Exhibit GWAJ19

¹³ Exhibit GWAJ24

43. There are aspects of the opponent's evidence which go in its favour. For example, its longevity. Further, there has clearly been national use when taking into account the national retailers that stock CHEF products and the range of locations to which invoices have been addressed. However, there are also clearly issues with the evidence provided; the extent of the use (in terms of sales) is difficult for me to assess with the way in which the evidence has been presented. The information provided is not specific enough (or clearly presented) to enable me to determine the extent of sales made in the UK in relation to food mixers sold under the CHEF mark. I have no information about advertising and promotional expenditure. Taking all of this into account, I am not satisfied that the opponent's evidence establishes any enhanced distinctive character through use.

44. Consequently, I have only the inherent position to consider. The opponent submits as follows:

“38. The Opponent's Mark has no descriptive meaning in respect of the Opponent's Goods. It follows, therefore, that the Opponent's Mark enjoys at least an average degree of inherent distinctive character.”

The word CHEF is an ordinary dictionary word meaning a cook. For goods in the field of food and beverage preparation, I do not consider it to be particularly distinctive. In my view, the earlier mark has a low degree of inherent distinctive character.

Likelihood of confusion

45. 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 them 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 vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of 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.

46. I have found as follows:

- a) The marks are visually similar to a medium degree and aurally and conceptually similar to between a medium and high degree;
- b) The earlier mark is inherently distinctive to a low degree;
- c) The goods vary from being identical to similar to a low degree (except where I have found them to be dissimilar);
- d) The average consumer is a member of the general public or a professional user, who will pay a medium (or average) degree of attention;
- e) The purchasing process will be predominantly visual, although I do not discount an aural component.

47. I do not consider that the additional word – DELUXE – in the IR will be forgotten by the average consumer, notwithstanding the principle of imperfect recollection. Consequently, I do not consider that there is a likelihood of direct confusion. I recognise that a finding of indirect confusion should not be made merely because two marks share a common element.¹⁴ However, the fact that the earlier mark has a weak distinctive character does not preclude a likelihood of confusion.¹⁵ The addition of the word DELUXE to the applicant's mark will, in my view, be seen as indicating a high quality subcategory of CHEF products sold by the same business. I consider that this

¹⁴ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

¹⁵ *L'Oréal SA v OHIM*, Case C-235/05 P

addition, as well as the device and stylistic changes, will be viewed by the average consumer as an alternative mark being used by the same or economically linked undertakings. Consequently, I consider there to be a likelihood of indirect confusion. This will apply where the goods are similar to at least a medium degree. Where there is less similarity between the goods, this will offset the similarity of the marks.

48. The opposition based upon section 5(2)(b) succeeds in relation to the following goods:

Class 7 Whisks, electric, for household purposes; food processors, electric; beaters, electric; beverage preparation machines, electromechanical; food preparation machines, electromechanical.

Class 21 Cooking utensils, non-electric; kitchen utensils; blenders, non-electric, for household purposes; whisks, non-electric, for household purposes.

49. For the avoidance of doubt, even if I am wrong in my finding regarding enhanced distinctiveness, I do not consider that the distinctiveness of the earlier mark would have been enhanced to such a degree that it could have bridged the gap between the remaining goods. Consequently, I do not consider that it would have changed the outcome of my decision.

Section 5(3)

50. 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 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.”

51. Section 5(3A) of the Act states:

“Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

52. 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*).

53. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier mark and the holder's mark are similar. Secondly, the opponent must show

that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be 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. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods 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.

54. I can deal with this ground relatively swiftly. For similar reasons as set out above, I do not consider the opponent's evidence to be sufficiently clear to justify a finding of reputation in the UK market. Consequently, the opposition based upon section 5(3) falls at the first hurdle. However, even if there were a reputation, I do not consider that this ground would put the opponent in any stronger position than it is under section 5(2)(b). This is because the distance between the remaining goods in the holder's specification (i.e. those that would not give rise to confusion under 5(2)(b)) and the goods for which the opponent would have a reputation, would be sufficient to offset the opponent's reputation and the similarity between the marks. I do not consider that there would be a link or damage for the remaining goods.

55. The opposition based upon section 5(3) fails.

Section 5(4)(a)

56. 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”.

57. 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.”

58. Again, I can deal with this ground relatively swiftly. Whilst the opponent’s evidence is not particularly clear, I consider it sufficient to establish a protectable goodwill (albeit a modest one). However, I do not consider that this ground would extend the opponent’s success any further than its 5(2)(b) ground. This is because the distance between the remaining goods in the holder’s specification and the goods for which the opponent has goodwill would be sufficient to offset the similarity of the marks and to avoid a misrepresentation and damage arising.

59. Consequently, the 5(4)(a) ground succeeds to the same extent as the 5(2)(b) ground.

CONCLUSION

60. The opposition is successful in relation to the following goods, for which the IR is refused:

Class 7 Whisks, electric, for household purposes; food processors, electric; beaters, electric; beverage preparation machines, electromechanical; food preparation machines, electromechanical.

Class 21 Cooking utensils, non-electric; kitchen utensils; blenders, non-electric, for household purposes; whisks, non-electric, for household purposes.

61. The opposition is unsuccessful in relation to the following goods, for which the IR may proceed to registration:

Class 7 Electric arc cutting apparatus; fruit presses, electric, for household purposes; scissors, electric; knives, electric; water heaters being parts of machines; machines and apparatus for wax-polishing, electric; parquet wax-polishers, electric; dust exhausting installations for cleaning purposes; air suction machines; spin dryers [not heated] / spin driers [not heated].

Class 11 Beverage cooling apparatus; bread-making machines; heating apparatus, electric; cooking utensils, electric; electric lamps; coffee percolators, electric; coffee machines, electric; waffle irons, electric; deep fryers, electric; heating plates; water heaters; cooking rings; cooking stoves / cookers; kitchen ranges [ovens]; microwave ovens [cooking apparatus]; cooking apparatus and installations; bread baking machines; bread toasters / toasters; hearths; stoves [heating apparatus]; kilns; hot air ovens; roasting apparatus / griddles [cooking appliances] / grills [cooking appliances]; bakers' ovens; hot plates; fittings, shaped, for furnaces / fittings, shaped, for ovens / shaped fittings for furnaces / shaped fittings for ovens; rotisseries; roasting apparatus / griddles [cooking appliances] / grills [cooking appliances]; incandescent burners.

Class 21 Tea strainers; strainers for household purposes; teapots; autoclaves, non-electric, for cooking / pressure cookers, non-electric; deep fryers, non-electric; ceramics for household purposes; cooking skewers of metal / cooking pins of metal; vessels of metal for making ices and iced drinks; cooking pot sets; kitchen containers; basting spoons [cooking utensils]; pots; spatulas for kitchen use; scoops for household purposes; pie servers / tart scoops; kitchen grinders, non-electric; kitchen grinders, non-electric; moulds [kitchen utensils] / molds [kitchen utensils]; cookery

moulds / cookery molds; cake moulds / cake molds; tableware, other than knives, forks and spoons; cookie [biscuit] cutters; pastry cutters; napkin rings; bottle openers, electric and non-electric; pot lids; dish covers / covers for dishes; stew-pans; frying pans; containers for household or kitchen use; bread bins; heat-insulated containers; mills for household purposes, hand-operated; sieves [household utensils]; dishes; salad bowls; vegetable dishes; garlic presses [kitchen utensils].

COSTS

62. The holder has enjoyed the greater degree of success and, consequently, is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. I have taken the holder's only partial success into account in making this award. Consequently, I award the holder the sum of £1,050, calculated as follows:

Preparing counterstatement and considering the Notice of opposition	£250
Considering the opponent's evidence	£500
Preparing written submissions	£300
Total	£1,050

63. I therefore order De Longhi Benelux S.A. to pay DIRS d.o.o. the sum of £1,050. This sum should 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 28th day of February 2023

S WILSON
For the Registrar

