

O/0562/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. WO1611681

BY MIDEA GROUP CO., LTD.

TO REGISTER THE TRADE MARK:



IN CLASSES 7 & 11

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 433034

BY ARDUTCH B.V.

Background and pleadings

1. International trade mark no.1611681 ('the contested mark') shown on the cover page of this decision was registered by Midea Group Co., Ltd ('the holder') with effect from 19 April 2021. From the same date, the holder designated the UK as a territory in which it seeks to protect the contested mark under the terms of the Protocol to the Madrid Agreement. The holder seeks protection in relation to the following goods and services:

Class 7: Beaters, electric; food preparation machines, electromechanical; kneading machines; electric juicers; dishwashers; kitchen machines, electric; food processors, electric; coffee grinders, other than hand-operated; washing machines [laundry]; dry-cleaning machines; wringing machines for laundry; stacking machines; conveyors [machines]; industrial robots; handling machines, automatic [manipulators]; dynamos; compressors [machines]; vacuum cleaners; machines and apparatus for cleaning, electric; rechargeable sweepers; steam mops; cleaning appliances utilizing steam; dust removing installations for cleaning purposes; garbage disposal units.

Class 11: Refrigerating appliances and installations; refrigerators; air conditioners; air-conditioning installations; bath fittings; lamps; cooking utensils, electric; fireplaces; disinfectant apparatus; fans [air-conditioning]; air purifying apparatus and machines; dehumidifiers for household purposes; humidifiers; hair dryers; fabric steamers; laundry dryers, electric; drying apparatus and installations; extractor hoods for kitchens; heat pumps; heating installations; lighting apparatus and installations; kettles, electric; microwave ovens [cooking apparatus]; pressure cookers, electric; coffee machines, electric; bread-making machines; multicookers; cooking apparatus and installations; heating and cooling apparatus for dispensing hot and cold beverages; electric rice cookers; induction cookers; electric ovens for household purposes; electric ranges; gas ranges; cooling appliances and installations; wine cellars, electric; bath installations; heaters for baths; sanitary apparatus and installations; water dispensers; water purifying apparatus and machines; water filtering apparatus; disinfectant apparatus in the form of cupboards; radiators, electric.

2. On 28 April 2022 Ardutch B.V. (the opponent) opposed the protection of the contested mark in the UK based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies upon the following trade mark:

UK902921211

ARCTIC

Filing date: 17 September 2019

Registration date: 6 December 2019

Class 7: Machines and machine tools; washing machines and compressors for washing machines; machines for drying and airing clothes; tumble dryers; dishwashers; machines for the preparation of food and beverages; electric kitchen machines; electric can openers; electric knives and sharpeners; machines for cleaning and washing carpets and upholstery; electric polishing machines for household purposes; vacuum cleaners; sewing, embroidering and knitting machines; ironing machines; waste disposal machines; parts and fittings for all the aforesaid goods; electrical hair trimmers/clippers.

Class 11: Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, water supply and sanitary purposes; gas and/or electric cookers; cookers; electric kettles; cooling and freezing appliances and containers; refrigerators; freezers; electric apparatus for making beverages; installations, apparatus, appliances and utensils all for cooking; stoves, ovens, microwave ovens, toasters and griddles; barbecues and grills; hair dryers; electric hair dryers; water heating installations and apparatus; lamps; apparatus for drying and airing clothes; tumble dryers; parts and fittings for all the aforesaid goods; portable steamers for fabrics; but not including pipe freezing apparatus or electronic apparatus for use in freezing pipes; cooker hoods; freezers and refrigerators.

3. The opponent claims that the marks are identical or highly similar to each other and that the goods and services in question are identical or similar.

4. The holder filed a counterstatement denying the claims made and put the opponent to proof of use of the earlier mark.

5. The holder is represented by HGF Limited and the opponent is represented by Beck Greener LLP.

6. The opponent filed evidence. Neither party requested a hearing but the holder provided submissions in lieu. This decision is therefore taken following careful consideration of the papers.

7. 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

8. The opponent's evidence consists of a witness statement by Gabriel Adrian Eremia, who is the Marketing Director of Arctic S.A. which he states within his witness statement is part of the Arcelik A.S group of companies which uses the trade mark 'Arctic' by authorisation of Ardutch B.V. The main purpose of the evidence is to demonstrate that the earlier mark has been genuinely used for the relevant period.

9. I have read and considered all of the evidence and will refer to the relevant parts at the appropriate points in the decision.

Decision

Section 5(2)(b)

10. 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.”

11. 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 or international trade mark (UK) which has a date of application 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.

...”

12. The opponent’s mark qualifies as an earlier mark, in accordance with the above provision. The earlier mark is subject to proof of use requirements as it has been registered for five years or more before the designation date of the holder’s mark, as per section 6A of the Act. The holder has requested that the opponent provides proof of use for its mark.

Proof of use

13. I will begin by assessing whether there has been genuine use of the earlier marks.

14. Section 6A:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a),
(aa) or (ba) in relation to which the conditions set out in section 5(1),
(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed
before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending
with the date of the application for registration mentioned in subsection (1)(a)
or (where applicable) the date of the priority claimed for that application.

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

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

(5)-(5A) [Repealed]

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

15. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the “five-year period”) has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

16. Section 100 of the Act states that:

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

17. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier marks is the five-year period ending with the designation date of the contested mark i.e. 20 April 2017 to 19 April 2022. This is a comparable mark and so, in accordance with paragraph 7(3) of Part 1 of Schedule 2A of the Act, the assessment of use shall take into account any use of the corresponding EUTM prior to IP Completion Day, being 31 December 2020. ¹

18. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C 416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I 4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV*

[EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

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

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to

encourage the sale of the latter: Silberquelle at [20]-[21]. But use by a non-profit making association can constitute genuine use: Verein at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: Ansul at [37]-[38]; Verein at [14]; Silberquelle at [18]; Centrotherm at [71]; Reber at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: Ansul at [38] and [39]; La Mer at [22]-[23]; Sunrider at [70]-[71], [76]; Leno at [29]-[30], [56]; Centrotherm at [72]-[76]; Reber at [29], [32]-[34].

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

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: Reber at [32].”

Evidence

19. The witness statement of Mr Eremia includes the following table of unit sales from 2015 to 2021 broken down by the various appliances:

	2015	2016	2017	2018	2019	2020	2021
Domestic ARCTIC							
Chest Freezer	57.465	89.695	71.696	79.198	75.835	102.254	86.311
Refrigerator	249.495	323.194	313.374	320.468	360.956	332.815	335.981
Minibar					0	0	0
Washing Machine	163.463	221.367	262.042	250.454	277.634	255.343	247.906
Dryer	1.224	4.773	8.468	11.431	12.631	17.310	26.184
Dishwasher	8.721	15.867	22.527	24.207	35.829	34.261	45.412
Oven	95.429	140.476	158.405	148.666	170.994	174.997	187.177
Cooking Appl.	82.561	136.760	179.547	175.807	175.012	169.720	171.937
Air Conditioner	3.623	5.768	35.046	47.736	21.491	32.447	48.106
Television - LED+LCD	297	10	5	0	7	0	4
Heaters					9.729	28	6.308
Humidifier					328	1.947	-41
Vantilators					2.547	-1	8.434
Air Care						2.436	-1
Audio - Video	475	376	588	0	3	0	
Small Domestic Appl.	24.586	32.566	140.764	123.901	143.382	166.806	187.815
Other Sales	30	1.091	1.692	1.798	1.403	1.342	1.753
GRAND TOTAL	687.369	971.943	1.194.154	1.183.666	1.287.781	1.291.705	1.353.286

20. This is followed by a table of the sales turnover in ‘000 Euros for the same time period. Mr Eremia confirms that these sales figures (and the unit figures below) are only for sales within Romania and does not include export sales to the UK or other parts of the European Union. This means that I cannot take into account the 2021 figures for the purposes of showing use:

Domestic ARCTIC	2015	2016	2017	2018	2019	2020	2021
Chest Freezer	9.076	13.123	10.473	12.342	11.475	15.939	14.438
Refrigerator	42.870	56.609	55.716	60.660	68.080	63.169	70.001
Minibar					0	0	0
Washing Machine	23.665	31.816	39.179	41.275	45.607	43.229	42.705
Dryer	237	1.048	2.060	3.066	3.379	4.695	7.306
Dishwasher	1.589	2.763	4.064	4.723	6.852	6.611	8.901
Oven	12.762	18.027	20.807	21.328	25.036	26.193	28.564
Cooking Appl.	3.836	6.843	10.149	10.969	11.359	11.438	11.866
Air Conditioner	1.096	1.456	7.413	9.055	4.344	6.393	9.620
Television - LED+LCD	74	4	2		2	0	1
Heaters					243	1	226
Humidifier					14	82	-1

Vantilators					58	0	197
Air Care						241	0
Audio - Video	17	7	16	0	0		
Small Domestic Appl.	717	861	3.666	3.242	4.512	5.225	6.337
Other Sales	1.563	2.062	1.669	1.479	1.278	1.568	1.791
GRAND TOTAL	97.502	134.619	155.214	168.139	182.239	184.784	201.952

21. I note within the holder's submissions that they state the above figures have not been corroborated and should be disregarded however, these figures have been supplied as part of a witness statement which contains a statement of truth and I have been provided with no reason as to why the statement cannot be relied upon.

22. Exhibit GAE1 sets out a timeline of the Arctic Brand history starting in 1968 when the company was founded and going up to 2021. I note it claims 45 years of activity in in Romania in 2015 and references its acquisition by a Turkish company.

23. In Exhibit GAE2, Mr Eremia has provided example invoices between 2017 and 2022 which all appear to be to customers in Romania. Some of the invoices fall outside the relevant period however, most of the invoices are from within the period. Each of the invoices are headed with the following logo:



The logo for Arctic, featuring the word "arctic" in a bold, lowercase, sans-serif font. The letter 'a' is stylized with a thick, rounded shape, and the 'i' has a dot. The overall appearance is modern and clean.

24. There are also other references to 'ARCTIC' on the invoices including in the column containing the items being sold. The invoices are in Romanian and have not been officially translated; however, I note that within the witness statement, Mr Eremia has provided information relating to the items that are sold within the invoices, a product list to cross reference the invoices with and the above-mentioned tables of sales which also refer to the goods that have been sold. I have prepared the below table showing goods found within the invoices that I have been able to cross reference with the product list provided. I cannot assign a value to the sales as the invoices have not been translated and it is not immediately clear which value column is which. As the invoices appear to all be to Romanian customers, I can only take into consideration the invoices prior to the IP Completion Day:

Product type	Invoice number/date	Product number
Cooker	4400219713/26.01.2018	7787182118
		7738482132
Cooker hood	4400265950/11.01.2019	8906640910
	4400274180/13.03.2019	
Hob	4400320777/07.01.2020	7712282106
Freezer*	4400377637/26.02.2021	7515010004
	4400376862/22.02.2022	7515110002
Fridge*	4400376862/22.02.2021	7519810004
Washing machine*	4400390544/17.06.2021	7129241700
	4400386484/20.05.2021	
Dishwasher*	4400387630/27.05.2021	7615602277

*All of these invoices fall after IP completion day.

25. I note that Mr Eremia states there are invoices with air conditioning units, vacuum cleaners and televisions; however, none of these goods feature on the product list for me to cross reference them. The table of sales does however make mention of sales of air conditioners and a small number of televisions.

26. Also provided within the witness statement is the following statement which shows domestic advertising and promotional expenditure in Romania between 2015 and 2021:

ths eur	2015	2016	2017	2018	2019	2020	2021
Advertising	2.035	1.589	997	1.054	1.195	1.125	2.547
Promotion	728						

27. Exhibit GA4 features pictures of products sold by Arctic which purportedly all have the mark affixed to the goods. However, these pictures are very unclear, extremely pixelated and undated. There is only one photo which I am actually able to see the mark 'Arctic' on, as follows:



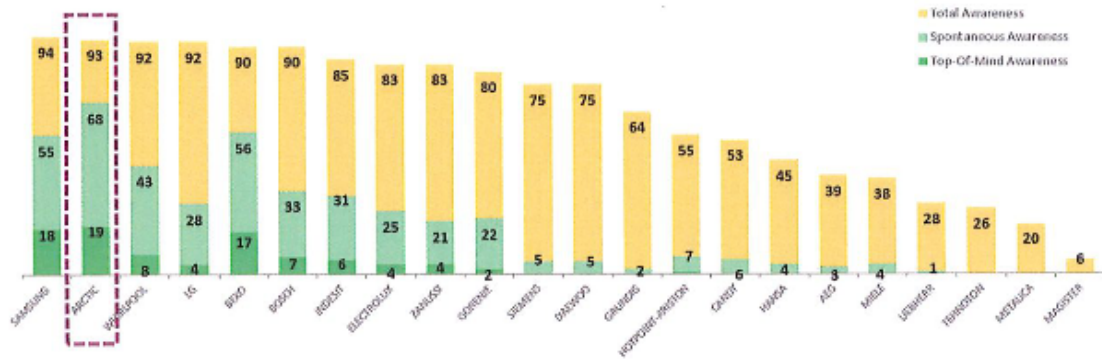
28. Exhibit GAE5 is a brand awareness study relating to domestic appliances. From the study itself I can see that the fieldwork for this was carried out in 40 countries but only the following are listed: Romania, Poland, UK, France, Italy, Russia, Germany, Spain and Thailand. This fieldwork was carried out between 4 April 2022 and 31 June 2022 and therefore, for the most part, falls outside of the relevant period. Within his witness statement, Mr Eremia has provided parts of previous awareness studies between 2017 and 2021 such as the following from 2019 and 2020:



- Top brands have no awareness problems. Good news, Arctic and Beko shine out with their high mind share. They are the top brands in terms of spontaneous awareness
- Grundig seems to have a heritage in this market when prompted It is recalled by 64%; however it has no mind share.



Brand Awareness

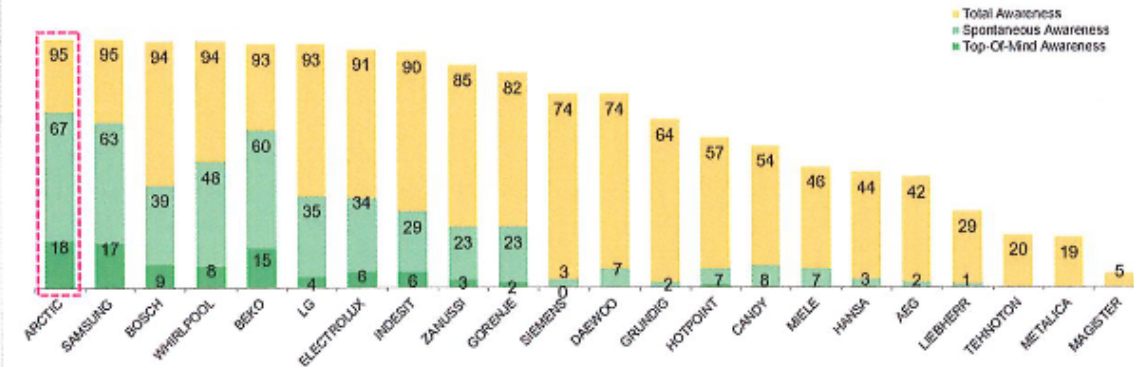


2020

- Arctic, Samsung and Beko have the strongest mindshare with similar shares. More than half of Romanian consumers recall these brands spontaneously.
- When prompted, top 10 brands are known by almost all of the consumers.
- However Grundig lags far behind these brands.



Brand Awareness



Q1a. Can you please tell me the first white goods brand (Refrigerator, Washing Machine, Dishwasher, Cooker/Oven/Range Cooker, Clothes Dryer/Tumble Dryer, Freezer) that comes to your mind?
 Q1b. Please tell me the other brands of white goods (Refrigerator, Washing Machine, Dishwasher, Cooker/Oven/Range Cooker, Clothes Dryer, Freezer) that come to your mind?
 Q2. And which of these white goods brands (Refrigerator, Washing Machine, Dishwasher, Cooker/Oven/Range Cooker, Clothes Dryer, Freezer) are you aware of?
 Base (n): 603 all respondents
 Ipsos

29. Once again, Mr Eremia states this is related to consumers in Romania only but purportedly shows that the brand 'Arctic' is consistently a brand which is most remembered by consumers. I note that I do not know the background and reason for conducting these studies and therefore limited emphasis can be placed on them.

30. Mr Eremia has also provided examples of advertisements within his witness statement such as the following:

Bucharest outdoor 2017



31. Some of these adverts are outside of the relevant period or it is unclear where they were reproduced to the public. The above examples represent the best evidence of some goods and where and when the adverts were shown.

Analysis

Form of the mark/how the marks are used

32. I note that the opponent's marks are word marks. The version used throughout the opponent's evidence (shown again below for ease of reference) is in a relatively simple typeface and there is nothing to alter the distinctive character of the mark. I therefore find this use to be acceptable:

arctic

Conclusions from the evidence on genuine use

33. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the comparable mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the relevant territory during the relevant five-year period. This is the EU for the part of the period up to 31 December 2020 and the UK thereafter. In making this assessment, I am required to consider all relevant factors, including:

- The scale and frequency of the use shown;
- The nature of the use shown;
- The goods and services for which has been shown;
- The nature of those goods/services and the market(s) for them; and
- The geographical extent of the use shown.

34. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.²

35. The opponent's brand started in 1968 and from there has shown growth through the sales figures totalling 168,139,000 Euros in 2018, 182,239,000 Euros in 2019 and so on. I cannot see any details of any of their own stores or where the goods are sold however, the brand awareness report does hint at significant recognisance of the brand within Romania. There is no evidence provided regarding sales within just the UK or elsewhere in the EU.

36. I consider that the kitchen appliance market is extremely large and these figures represent a reasonable level of sales, particularly as these sales are focused within one country. I note there is no de minimis level of sales. I also note that advertising and promotion expenditure figures have been provided although I am not entirely clear whether these refer to 997 Euros in 2017 or whether it should be 997,000 Euros. Within

² *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

the witness statement and Exhibit GAE6 there are example advertisements and promotional activities in Romania including:

- Outdoor adverts
- TV and digital advertising
- Digital outdoor advertising

37. Taking into account all of the above, I am satisfied that the opponent has demonstrated genuine use of its earlier mark during the relevant period. Furthermore, the case law above is clear that use of a mark in an area of the European Union constituting one-member state may be sufficient to demonstrate genuine use in the European union as a whole. When factoring in that the opponent has made significant sales figures over a sustained period of time, in a country which would be viewed as one of the larger member countries of the EU, for goods that are not likely to be purchased on a regular basis by consumers (not even on a yearly basis) then I am satisfied that the opponent has demonstrate use of its mark in the EU for that part of the relevant period. I consider that such use has been shown for cookers, cooker hoods, hobs, washing machines, refrigerators, dishwashers, dryers and freezers due to the consistently high sales figures in the above tables over a number of years, some of those sales backed up with invoice evidence and the product list and also products being visible in the advertisements.

Fair Specification

38. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

39. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation

to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

40. As a reminder, the opponent’s mark is relying on the following goods:

Class 7: Machines and machine tools; washing machines and compressors for washing machines; machines for drying and airing clothes; tumble dryers; dishwashers; machines for the preparation of food and beverages; electric kitchen machines; electric can openers; electric knives and sharpeners; machines for cleaning and washing carpets and upholstery; electric polishing machines for household purposes; vacuum cleaners; sewing, embroidering and knitting machines; ironing machines; waste disposal machines; parts and fittings for all the aforesaid goods; electrical hair trimmers/clippers.

Class 11: Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, water supply and sanitary purposes; gas and/or electric cookers; cookers; electric kettles; cooling and freezing appliances and containers; refrigerators; freezers; electric apparatus for making beverages; installations, apparatus, appliances and utensils all for cooking; stoves, ovens, microwave ovens, toasters and griddles; barbecues and grills; hair dryers; electric hair dryers; water heating installations and apparatus; lamps; apparatus for drying and airing clothes; tumble dryers; parts and fittings for all the aforesaid goods; portable steamers for fabrics; but not including pipe freezing apparatus or electronic apparatus for use in freezing pipes; cooker hoods; freezers and refrigerators.

41. Regarding the class 7 goods, from the evidence, particularly the sales, invoices and advertisements, there is a clear trend for items which would be termed more generally as kitchen appliances, as I have listed above. I do not consider that the evidence shows that there is use of the mark for ‘machines and machine tools’ more generally. Nor do they appear to sell separate parts for any goods. No use is shown

for anything related to washing carpets or upholstery, polishing machines, ironing, sewing, embroidering and knitting machines, waste disposal machines; and electrical hair trimmers/clippers. I note that there is some evidence showing sustained sales of dryers and I believe this is sufficiently covered by the term 'tumble dryers' and there is no evidence which supports the need for the fair specification to extend further and continue to cover 'machines for drying and airing clothes'

42. For 'machines for the preparation of food and beverages; electric kitchen machines', these are more general terms and I have not seen any evidence in relation to items that are involved in food or drink preparation other than ovens/cookers/hobs which are more suitably covered in class 11. I therefore do not believe it is necessary to include this term further. I also find electric kitchen machines to cover such a broad range of items and that the evidence does not support an overly broad range so it would not be proportionate for me to find usage for that term.

43. Turning to the Class 11 goods, the opponent has the general term 'apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, water supply and sanitary purposes' and I cannot find use for any items relating to lighting, heating, steam generating, water supply and sanitary purposes. Regarding the terms 'apparatus for cooking, refrigerating and drying' and 'installations, apparatus, appliances and utensils all for cooking', once again this is a very general term and I believe given the evidence that the opponent's goods can be dealt with more specifically- the use of 'ovens' and 'cookers' covers all different types of those goods. The same can also be said for 'refrigerators' and 'freezers' and that those terms will cover the use shown as opposed to the wider term 'cooling and freezing appliances and containers'.

44. I can see no evidence supporting use of any of the following goods 'electric kettles; electric apparatus for making beverages; microwave ovens, toasters and griddles; barbecues and grills; hair dryers; electric hair dryers; water heating installations and apparatus; lamps; portable steamers for fabrics'

45. As mentioned above, I note that there is some evidence showing sustained sales of dryers and I believe this is sufficiently covered by the term 'tumble dryers' and there

is no evidence which supports the need for the fair specification to extend further and continue to cover 'apparatus for drying and airing clothes'.

46. I therefore consider a fair specification to be:

Class 7: Washing machines; tumble dryers; dishwashers

Class 11: Gas and/or electric cookers; cookers; refrigerators; freezers; stoves; ovens; tumble dryers; cooker hoods; freezers and refrigerators.

Section 5(2)(b)

47. In making this decision, I bear in mind the following principles 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

48. I note that within the holder's counterstatement that they admit the goods are similar however, they have put the opponent to proof over the use of the marks for the goods as registered. As not all of the opponent's goods have carried through to the fair specification, I must carry out a full comparison.

49. In the judgment of the 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".

50. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

51. In *Gérard Meric v Office for Harmonisation in the Internal Market* (OHIM) ('Meric'), Case T-133/05, the General Court ("the 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 für Lernsysteme v OHIM - Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

52. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

53. The Parties' respective specifications are:

Holder's goods	Opponent's goods
Class 7: Beaters, electric; food preparation machines, electromechanical; kneading machines; electric juicers; dishwashers; kitchen machines, electric; food processors, electric; coffee grinders, other than hand-operated; washing machines [laundry]; dry-cleaning machines; wringing machines for laundry; stacking	Class 7: Washing machines; tumble dryers; dishwashers

<p>machines; conveyors [machines]; industrial robots; handling machines, automatic [manipulators]; dynamos; compressors [machines]; vacuum cleaners; machines and apparatus for cleaning, electric; rechargeable sweepers; steam mops; cleaning appliances utilizing steam; dust removing installations for cleaning purposes; garbage disposal units.</p>	
<p>Class 11: Refrigerating appliances and installations; refrigerators; air conditioners; air-conditioning installations; bath fittings; lamps; cooking utensils, electric; fireplaces; disinfectant apparatus; fans [air-conditioning]; air purifying apparatus and machines; dehumidifiers for household purposes; humidifiers; hair dryers; fabric steamers; laundry dryers, electric; drying apparatus and installations; extractor hoods for kitchens; heat pumps; heating installations; lighting apparatus and installations; kettles, electric; microwave ovens [cooking apparatus]; pressure cookers, electric; coffee machines, electric; bread-making machines; multicookers; cooking apparatus and installations; heating and cooling apparatus for dispensing hot and cold beverages; electric rice cookers; induction cookers; electric ovens for</p>	<p>Class 11: Gas and/or electric cookers; cookers; refrigerators; freezers; stoves; ovens; tumble dryers; cooker hoods; freezers and refrigerators.</p>

household purposes; electric ranges; gas ranges; cooling appliances and installations; wine cellars, electric; bath installations; heaters for baths; sanitary apparatus and installations; water dispensers; water purifying apparatus and machines; water filtering apparatus; disinfectant apparatus in the form of cupboards; radiators, electric.	
--	--

Dishwashers; washing machines [laundry];

54. The above goods are found identically within both specifications.

Beaters, electric; food preparation machines, electromechanical; kneading machines; electric juicers; food processors, electric; Coffee grinders, other than hand-operated;

55. I find there is an overlap of user for the above goods from the holder's specification with the opponent's 'cookers' as both will be used by someone who is making food and drink. Therefore, there is also an overlap in purpose as they will be used to prepare food or within the cooking process in order for it to be consumed however, the holder's goods are preparing the ingredients without the use of heat. They may well share trade channels and be found within similar areas of shops. I believe the nature will differ as the holder's goods are likely to be smaller items that are used on the kitchen worktop and do not produce heat in order to work. They are not complementary nor are they in competition. I therefore find them to be similar to a medium degree.

Dry-cleaning machines;

56. I consider the above goods from the holder's specification would share a purpose with the opponent's 'washing machines' as they are both related to laundry and cleaning clothes, there would also therefore be a slight overlap in user although I note it would not be the general public buying dry cleaning machines. The nature and method of use would differ as dry cleaning machines use chemicals to clean opposed

to water. There might be a slight overlap in trade channels. I therefore find the goods to be similar to a low degree.

Wringing machines for laundry;

57. I believe that 'wringing machines for laundry' from the holder's specification will share a purpose with 'tumble dryers' found in the opponent's specification as both will be used to help dry clothes after washing. They will also therefore share an overlap of user and they could both be sold in similar trade channels. Their nature will differ. It is possible that the goods will be in some competition with one another but they are not complementary. I therefore find them to be similar to a medium degree.

Stacking machines; conveyors [machines]; industrial robots; handling machines, automatic [manipulators]; dynamos; compressors [machines]; dust removing installations for cleaning purposes; garbage disposal units.

58. On application of the *Canon* and *Treat* case law, I cannot see any overlap with the above goods with the opponent's goods and therefore find them to be dissimilar.

Vacuum cleaners; machines and apparatus for cleaning, electric; rechargeable sweepers; steam mops; cleaning appliances utilizing steam;

59. I believe that the above goods would be considered as household appliances for cleaning. I consider there might be a slight overlap in general users with the opponent's 'washing machines' as these goods will all be used for general household jobs however, they differ in nature and purpose as washing machines are for cleaning clothes and the above goods are used more generally for surfaces and floors. There may be an overlap in trade channels as they might be found in the same electrical appliance stores. They are not in competition nor are they complementary. I therefore find them to be similar to no more than a medium degree.

Refrigerators;

60. The above goods are found identically within both specifications.

Refrigerating appliances and installations;

61. I consider that the above goods from the holder's specification includes the opponent's 'refrigerators' from the opponent's specification and therefore find them to be identical under the *Meric* principles.

Air conditioners; air-conditioning installations; fans [air-conditioning]; bath fittings; bath installations; heaters for baths; lamps; lighting apparatus and installations; fireplaces; disinfectant apparatus; air purifying apparatus and machines; dehumidifiers for household purposes; humidifiers; sanitary apparatus and installations; disinfectant apparatus in the form of cupboards; radiators, electric.

62. On application of the *Treat* guidance, I cannot see any overlap with the above goods with the opponent's goods and services and therefore I find them to be dissimilar.

Kettles, electric; heating and cooling apparatus for dispensing hot and cold beverages; coffee machines, electric;

63. I consider that the above goods would be considered as kitchen appliances. I believe there might be a slight overlap in general users with the opponent's 'cookers', as these goods will all be used in the kitchen however, they differ in nature and purpose as cookers are for heating food and the above goods are used for preparing drinks. There may be an overlap in trade channels as they might be found in the same electrical appliance stores. They are not in competition nor are they complementary. I therefore find them to be similar to a low degree.

Hair dryers;

64. On application of the *Canon* and *Treat* case law, I cannot see any overlap with the above goods with the opponent's goods and therefore find them to be dissimilar.

Fabric steamers;

65. For the holder's 'fabric steamers' I consider there to be an overlap in user and general purpose with the opponent's 'tumble dryers' as both sets of products are used to help prepare clothes to be ready to be worn however, they differ in nature as one applies steam/moisture to smooth clothes and the other is used to dry clothes after they have been washed. There may be an overlap in trade channels as they may be sold in similar stores such as homeware and electronic stores. They are not complimentary nor are they in competition with each other. I therefore find these goods to be similar to no more than a medium degree.

Laundry dryers, electric;

66. I find that the above goods from the holder's specification is an alternative name for 'tumble dryers' as found within the opponent's specification and therefore I find them to be identical.

Drying apparatus and installations;

67. I consider that the above goods from the holder's specification will include 'tumble dryers' from the opponent's specification and therefore find them to be identical under the *Merck* principles.

Extractor hoods for kitchens;

68. As far as I am aware, extractor hoods and cooker hoods (found in the opponent's specification) are interchangeable terms for the same good and I therefore find the above goods from the holder's specification to be identical.

Heat pumps; heating installations;

69. On application of the *Treat* guidance, I cannot see any overlap with the above goods with the opponent's goods and services and therefore I find them to be dissimilar.

Cooking utensils, electric; Microwave ovens [cooking apparatus]; pressure cookers, electric; bread-making machines; multicookers; electric rice cookers; cooking apparatus and installations;

70. I believe that the above goods from the holder's specification will share users and purpose with the opponent's 'cookers' as they are all used in the cooking of food. They will overlap in nature insofar as they will contain heating elements although their shapes and sizes will vary due to the need of the item to be cooked. They will also like share trade channels and be found in the same appliance stores. I do not believe they are in competition nor are they complementary. I therefore find the goods to be similar to at least a medium degree.

Induction cookers;

71. I find that the above goods from the holder's specification fall within the wider category of 'cookers' from the opponent's specification and therefore find them to be identical under the *Meric* principles.

Electric ovens for household purposes; electric ranges; gas ranges;

72. I consider that the above goods from the holder's specification fall within the wider category of 'ovens' from the opponent's specification and therefore find them to be identical under the *Meric* principles.

Cooling appliances and installations;

73. The opponent's 'freezers and refrigerators' are goods which fall within the wider category of the above goods from the holder's specification and therefore, I find them to be identical under the *Merck* principles.

Wine cellars, electric;

74. I believe that electric wine cellars as found in the holder's specification are used to keep wine at a constant temperature for storage purposes. I consider that the general purpose for both the above goods and the opponent's 'refrigerators' would be maintaining temperature in order to keep food and drink in its best condition. They might both contain shelving and cooling elements but that is as far as they will share nature. There might be a slight overlap in user also. They are not in competition and nor are they complementary. I find them to be similar to a low degree.

Water dispensers; water purifying apparatus and machines; water filtering apparatus;

75. On application of the *Treat* guidance, I cannot see any overlap with the above goods with the opponent's goods and services and I therefore find them to be dissimilar.

76. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

77. I have found no similarity for the holder's following goods and therefore the opposition fails in relation to them:

Class 7: Stacking machines; conveyors [machines]; industrial robots; handling machines, automatic [manipulators]; dynamos; compressors [machines]; dust removing installations for cleaning purposes; garbage disposal units.

Class 11: Air conditioners; air-conditioning installations; bath fittings; lamps; fireplaces; disinfectant apparatus; fans [air-conditioning]; air purifying apparatus and machines; dehumidifiers for household purposes; humidifiers; hair dryers; heat pumps; heating installations; lighting apparatus and installations; bath installations; heaters for baths; sanitary apparatus and installations; water dispensers; water purifying apparatus and machines; water filtering apparatus; disinfectant apparatus in the form of cupboards; radiators, electric.

78. The opposition will continue in respect of the holder's:

Class 7: Beaters, electric; food preparation machines, electromechanical; kneading machines; electric juicers; dishwashers; kitchen machines, electric; food processors, electric; coffee grinders, other than hand-operated; washing machines [laundry]; dry-cleaning machines; wringing machines for laundry; vacuum cleaners; machines and apparatus for cleaning, electric; rechargeable sweepers; steam mops; cleaning appliances utilizing steam.

Class 11: Refrigerating appliances and installations; refrigerators; cooking utensils, electric; fabric steamers; laundry dryers, electric; drying apparatus and installations; extractor hoods for kitchens; kettles, electric; microwave ovens [cooking apparatus]; pressure cookers, electric; coffee machines, electric; bread-making machines; multicookers; cooking apparatus and installations; heating and cooling apparatus for dispensing hot and cold beverages; electric rice cookers; induction cookers; electric ovens for household purposes; electric ranges; gas ranges; cooling appliances and installations; wine cellars, electric.

Average consumer and the purchasing act

79. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

80. 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. (as he then was) 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

81. For the most part, the goods at issue are household appliances, including washing machines, tumble dryers, freezers and refrigerators and therefore the consumer is likely to be the general public. However, I cannot discount that there might be professional or corporate purchasers, particularly in relation to goods such as dry-cleaning machines. In either event, the majority of these goods are likely to be purchased fairly infrequently and would not be insignificant in terms of their cost. Some of the goods such as bread machines and microwaves might be of a slightly lower base value but can still range to fairly high value. The average consumer may consider factors such as size, ease of use and practicality. Keeping all this in mind, I consider that the average consumer would likely pay at least a medium (but not the highest) degree of attention when purchasing these products.

82. The selection of the goods is likely to be a more visual process whereby they are viewed on retail displays or photographs on websites. There is, however, the

possibility of the marks being spoken by sales representatives so I cannot discount the aural use of the marks.


Comparison of the marks

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

84. 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.

85. The respective trade marks are shown below:

Earlier mark	Contested mark
<p>ARCTIC</p>	

86. The earlier mark is a word mark containing one word and therefore the overall impression lies within the word itself.

87. The contested mark contains two words 'Arctic' and 'King' with the word 'Arctic' being positioned above 'King'. Both are presented as the same size in a bold simple typeface. There is a device which looks to be a simplistic stylised mountain range/peaks. I believe that the device reinforces the idea of cold and arctic as the peaks of mountains often have snow on or it gets colder as you reach the summit. I note that the holder has submitted that this could also be viewed as a crown; however, I do not believe that the average consumer will see it as such. In my opinion, the overall impression lies in the combination of the two-word elements, with them being co-dominant. The device mark is not insignificant but it's simplistic style and link to the idea of coldness with the Arctic means that I find it to play a smaller role than the words.

88. Visually, the earlier mark comprises of one word made up of six letters. This word is found identically within the contested mark. However, there is a further word, 'King' which is four letters and sits beneath the word 'Arctic'. To the left-hand side of the mark and also somewhat behind the words there is the inclusion of a black and white device which, as I have said, appears to be a stylised depiction of mountain peaks. Given the extra matter within the contested mark which has no replication in the earlier mark, I find them to be visually similar to no more than a medium degree.

89. Next, I will look at the aural comparison of the marks. The earlier mark is one word which will be given its ordinary everyday pronunciation which is two syllables long. The contested mark is two words, the first being identical to the earlier mark and therefore having the same pronunciation followed then by the further word 'King' which is one syllable and also given its everyday pronunciation and will follow immediately after 'Arctic'. I therefore find the marks to be aurally similar to a medium degree.

90. The holder provided some submissions in relation to the conceptual meaning behind the marks. I agree that the concept of the earlier mark would be the geographical place at the very top of the Earth, which is known to be very cold. For their own mark they claim that the addition of 'King' brings the conceptual focus to that of a male ruler. I find that the concept of the contested mark will be that of the ruler of the Arctic as the words are seen together and not dissected by the average consumer. Therefore, the concepts at issue are a place versus a person or ruler of that place. I do note that there may be a portion of consumers who see 'King' as a reference to the quality of the goods – being the top- but I do not believe this to be a significant proportion of consumers. There is not much conceptual content added by the device in the contested mark, it would perhaps reinforce the idea of the Arctic being a cold place. I therefore find these marks to be conceptually similar to a between a low and medium degree.

Distinctive Character of the Earlier Marks

91. 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-0000, paragraph 49).

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

92. The opponent has submitted evidence regarding use of its mark and I will review this to see whether this evidence shows that use of the mark can be said to have enhanced the distinctiveness of the earlier mark.

93. In order to do this, first I must consider the level of inherent distinctiveness the earlier mark has. For the most part, words that are descriptive or allusive of the character of the goods and services provided are on the lower end of the scale of distinctiveness whereas invented terms are likely to attract the highest level of distinctiveness.

94. I consider that the term ‘Arctic’ will conceptually make the average consumer think of the place which, as mentioned above, is known to be extremely cold. I therefore consider that the term might be allusive to some of the goods that are within the opponent’s specification – particularly those items the main purpose of which is to make or keep items cold, such as refrigerators and freezers. For those goods I would find the level of inherent distinctiveness to be between a low and medium degree. For the other goods within the opponent’s specification, I find that the mark is inherently distinctive to a medium degree as it is an ordinary dictionary word (not an invented term) and is not related to the goods within the specification.

95. The opponent did provide sales figures and example invoices as detailed above; however, all the invoices are for Romania and not within the UK and I can see no

evidence of any sales within the UK itself. Given this, I do not believe that they have shown enhanced distinctiveness in the UK market and therefore the distinctive character of the earlier mark remains at its inherent level.

Likelihood of Confusion

96. There are two types of confusion that I must consider. Firstly, direct confusion i.e., where one mark is mistaken for the other. The second is indirect confusion which is where the consumer appreciates that the marks are different, but the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or a related source.

97. In *L.A. Sugar Limited v Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C. (as he then was), as the Appointed Person, explained that:

“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.

98. I have come to the conclusions above that the marks at issue are visually similar to no more than a medium degree; aurally similar to a medium degree; conceptually similar to between a low and medium degree and the average consumer would pay at least a medium degree of attention. The remaining goods at issue have been found to be between identical and similar to a low degree. The earlier mark is inherently distinctive to either a low to medium degree or a medium degree. I found the overall

impression of the earlier mark was in the word itself and for the contested mark I found that the two words 'Arctic' and 'King' would be co-dominant.

99. I note the beginning word of the marks are identical however in *CureVac GmbH v OHIM*, T-80/08 it was determined that this was not always a decisive matter in the finding of a likelihood of confusion. I actually consider that the differences in the concepts of the mark (together with the additional word and device visually) to be the most important element here. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

100. I find that the marks at issue have differing conceptual meanings together with different endings and the inclusion of a device in the contested mark that is not replicated at all in the earlier mark. Even where the goods are identical, I believe that the average consumer will recall the differences, in particular noting the conceptual and visual differences and therefore I find there to be no direct confusion.

101. I will now go on to consider the possibility of indirect confusion. Again, I take guidance from Mr Purvis in *L.A. Sugar Limited* where he stated:

“17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite

distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example”).

102. These examples are not exhaustive but provide helpful focus as was confirmed by Arnold LJ in *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207:

“This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.”³

103. Turning to the above categories; firstly, the shared elements between the marks is the word ‘ARCTIC’ which is an ordinary dictionary word and cannot be said to be strikingly distinctive, especially as it could be seen as allusive to some of the goods in question.

104. Secondly, the addition of ‘King’ and the device element are not non-distinctive elements which could form part of a sub-brand. Indeed, the addition of the word ‘King’ means that the meaning/concept of the mark has noticeable differences from that of the earlier mark.

³ Paragraph 12

105. The differing elements would not be an obvious or logical brand extension, in my opinion. I do not consider this to be a step that the average consumer of the goods at issue would reasonably expect a business to take.

106. Whilst the categories set out above by Mr Purvis are not exhaustive, I can find no other reason why the average consumer would, when exposed to the contested marks, assume that the goods and services at issue came from the same or an economically linked undertaking, or vice-versa, especially when those marks convey differing meanings. For items like refrigerators and freezers, with the main purpose of making or keeping items cold, the low to medium degree of distinctive character means that a consumer is less likely to assume a connection and will likely believe it to be a coincidence. For the goods where the mark will have a medium degree of distinctive character, the differences between the concepts of the two marks as discussed above will prevent consumers from assuming that there is a connection between the two, they may recall the other mark to mind but that is mere association and not indirect confusion⁴.

107. I therefore find that there would be no indirect confusion between the marks.

Conclusion

108. The opposition fails in its entirety.

Costs

109. The holder has been successful and is entitled to a contribution towards its costs. Award of costs are based upon the scale as set out in Tribunal Practice Notice 2 of 2016. The award of costs in this matter has been calculated as follows:

Considering the Notice of Opposition	£350
and preparing Counter Statement	

⁴ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

Considering and commenting on the other side's evidence	£650
Preparation of submissions	£400
Total	£1400

110. I therefore order Ardutch B.V. to pay Midea Group Co., Ltd. the sum of £1400. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 16 day of June 2023

L Nicholas
For the Registrar