

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2360358 BY PHILIP MAITLAND-KRAFT
TO REGISTER A TRADE MARK IN CLASS 21**

**AND IN THE MATTER OF OPPOSITION No. 92917
BY MAYTAG INTERNATIONAL INC**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY THE APPLICANT AGAINST THE DECISION OF MR M. REYNOLDS
DATED 20 AUGUST 2007**

DECISION

Background

1. On 6 April 2004, Philip Maitland-Kraft ("the Applicant") applied under number 2360358 to register the designation MAGIC HOME CHEF for use as trade mark in respect of the following goods:

Class 21

Kitchen utensils for pressing and moulding food into rectangular blocks.

2. In accordance with section 37(1) of the Trade Marks Act 1994, the Registry examined the application for compliance with the requirements of the Act (including the Trade Marks Rules 2000). At the time, that examination included the relative grounds for refusal of registration in section 5 of the Act for which purpose section 37(2) provided that the Registrar should carry out a search, to such extent as he considers necessary, of earlier trade marks¹.
3. As a result of that search, the Registry objected to the application under section 5 of the Act on the basis of one citation. That citation was UK Trade Mark number 2043115² for the earlier trade mark HOME CHEF and device registered in Class 21 for kitchen utensils and equipment.
4. In the event the Applicant overcame the citation. In a letter dated 1 July 2004, the Registry informed the Applicant *inter alia* that the section 5 objection had been waived and that the application was accepted and would proceed to publication in the Trade Marks Journal after which the application would be open to opposition by third parties for a period of three months.
5. Following publication, on 1 November 2004, Maytag International Inc. ("the Opponent") filed notice of opposition against the application. The opposition was brought under section 5(2)(b) of the Act that because the mark applied for was similar to an earlier trade mark belonging to the Opponent and registration was sought in respect of identical or similar goods there existed a likelihood of confusion, which included a likelihood of association with the earlier trade mark.

¹ As from 1 October 2007 the Registrar no longer examines an application for compliance with section 5 of the Act and section 37(2) was repealed on that date (articles 2 and 3, Trade Marks (Relative Grounds) Order 2007).

² Apparently UK TM 2043115 is no longer on the Register.

6. The earlier trade mark on which the opposition was based was UK Trade Mark number 2286942 MAGIC CHEF and device:



The specified goods insofar as relevant to this appeal were:

Class 7

Domestic, kitchen and household electrical apparatus, instruments and machines; electric kitchen machines; food processors and preparation machines; electric mixers; electric crushers, grinders and cutting machines; juicers and electric fruit presses for household purposes

Class 9

Domestic, kitchen and household electrical apparatus, instruments and machines

Class 11

Domestic, kitchen and household electrical apparatus, instruments and machines; electric cooking utensils; bread makers.

7. Only the Applicant filed evidence. Both sides filed written submissions but neither party requested an oral hearing.
8. In a written decision issued on 20 August 2007 under number BL O/235/07, the Hearing Officer acting for the Registrar found in favour of the Opponent and refused the application. In summary he found that: (a) the Applicant's goods were highly similar to those of the Opponent; (b) the distinctiveness of the competing marks resided in their respective totalities rather than their constituent parts; (c) there was a high level of similarity between MAGIC HOME CHEF and MAGIC CHEF and device; (d) the average consumer would pay a moderately high level of attention to the purchase of the goods in questions; (e) when all the relevant circumstances were taken into account there was a likelihood that the average consumer would fall prey to either direct or indirect confusion as a result of falsely attributing a common or economically linked trade source to goods sold under the respective marks; (f) accordingly the opposition under section 5(2)(b) succeeded.
9. On 28 August 2007, the Applicant filed notice of appeal to an Appointed Person under section 76 of the Act. An oral hearing of the appeal was appointed through the Treasury Solicitor on one month's notice for 10 December 2007. The Applicant informed the Treasury Solicitor by email dated 14 November 2007 that he would not be represented and would not appear. He filed his skeleton argument with the Treasury Solicitor on 21 November 2007 confirming his reasons for not appearing in person.
10. Under cover of a letter from the Treasury Solicitor, I was sent a copy of a letter from Marks & Clerk, the Opponent's representatives, to the Registry dated 30 November 2007, which I understood to be a request under rule 61(1) for the Registrar to require security for costs from the Applicant in relation to the opposition proceedings and the appeal. Marks & Clerk asked for an adjournment of the appeal pending the Registrar's obtaining of security for costs. I indicated through the Treasury Solicitor to all concerned that I would consider any application that the Opponent might wish to make as a preliminary to the appeal.

11. In the event, at very late notice³, Marks & Clerk communicated to the Treasury Solicitor the Opponent's intention not to be represented or to appear at the appeal hearing. Nor did the Opponent make any written submissions. I have therefore proceeded to decide the appeal on the basis of the papers before me.

Nature of the appeal

12. An appeal to the Appointed Person is by way of review and not rehearing and this tribunal should be reluctant to interfere with the Hearing Officer's decision in the absence of a distinct and material error of principle (*REEF Trade Mark* [2003] 101, Robert Walker L.J. at 109 –110).

Arguments on appeal

13. The Applicant challenges the Hearing Officer's findings in relation to the respective goods. He says that it is wrong to describe his product as a machine. It is a non-mechanical, non-electrical device for making sushi and there would be no confusion with goods in Classes 7, 9 or 11. He gives the analogy of a fork or spoon on the one hand and a cake-mixing machine on the other hand.
14. Although the product of present commercial interest to the Applicant is a sushi-making device, the specification covers kitchen utensils for pressing and moulding food into rectangular blocks in Class 21. The Hearing Officer's assessment of the degree of similarity between the goods applied for and the Opponent's goods as identified at paragraph 6 above was as follows (decision paras. 25 and 29 – 35):

"25. In assessing the similarity of the goods concerned, all the relevant factors relating to these goods should be taken into account. Such factors include *inter alia* their nature, intended purpose, and also whether or not they are in competition with each other or are complementary (see the judgment of the European Court of Justice, Case C-36/97, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). Further factors include their pertinent distribution channels and sales outlets.

[...]

29. In its submissions the applicant has identified differences between the goods at issue almost solely on the basis that the kitchen utensils covered by his own mark are non-electrical. It is the case that, by falling in Class 21 (as opposed to, for example, Class 07), the applicant's kitchen utensils must be non-electrical by nature. It follows that the opponent's kitchen machines, food processors and food preparation machines etc. (which are proper to Classes 07, 09 and 11) cannot be considered *identical* to the applicant's goods. However, the fact that some of the goods may or may not be electrically powered is not, by itself, a sufficient basis for determining the degree (or absence) of similarity between the contested goods.

30. From submissions made by the applicant, it appears that the specification of "kitchen utensils for pressing and moulding food into rectangular blocks" refers to a hand-operated device used for the preparation of specific foodstuffs, wherein the device's function is to mould or shape food into a desired form. Although the applicant has chosen to use the term "utensils" within its specification, I see no reason to doubt that any hand-operated utensil for pressing and moulding food into rectangular blocks is as equally likely to be described as a "device", an "instrument", a "piece of apparatus" or, in fact, a "machine".

³ The day of the hearing, allowing no time for the arrangements for the hearing to be cancelled.

31. By strictly applying the aforementioned *Canon* criteria, it is clear that the applicant's products are mechanical or semi-mechanical devices, used in a kitchen environment for the preparation of food. Being designed for such a purpose, these devices are likely to be sold in a specialist cookware/kitchenware retail outlet or, when provided through a larger department-type store, in the relevant "cookware/kitchen" department or section of that store.

32. Applying the same criteria to the opponent's goods, I reach very similar conclusions. Terms such as "kitchen electrical apparatus, instruments and machines", "electrical kitchen machines" and "electric mixers" all describe mechanical devices also used for the purposes of food preparation. These are products which are likely to be used in a professional or home kitchen, and are likely to be provided through specialist cookware retailers and/or cookware sections of department stores.

33. In my opinion (and in relation to the opponent's goods identified at paragraph 28 above), the non-electrical nature of the applicant's products constitutes the main (and possibly only) dissimilar characteristic to the goods of the opponent. The extent to which this dissimilar characteristic is likely to affect an overall assessment of similarity then has to be considered in the context of the goods concerned. In respect of kitchen apparatus, it is commonplace to find both electrical and non-electrical versions of the same product. One can purchase an electrical food grating machine *or* a hand-operated grating machine; an electrical food handling machine *or* a non-electrical food handling machine; and so on. Furthermore, both electrical and non-electrical versions of the same food preparation product may be displayed and sold in close proximity to each other, within the same retail outlet. They represent alternative choices for the average consumer.

34. The references to "food grating machines" and food handling machines" in the previous paragraph are given as examples only, intended to demonstrate the extent to which one can purchase both electrical and hand-powered versions of kitchen apparatus with identical applications. Although the opponent lists similar types of products in its specification (e.g. electric mixers, cutters and grinders etc.), I am also aware that much of the earlier mark's specification covers products with broader purposes and applications i.e. "kitchen apparatus", "kitchen machines" and "food processors" applied across Classes 07, 09 and 11. Knowing that the applicant's mark covers a piece of apparatus with a very limited and specific function, I find no reason to believe that the opponent's more general kitchen apparatus such as "food processors" and "kitchen machines" are any less similar to the applicant's products. It is wholly feasible that electric-powered versions of the applicant's products could be within the scope of coverage offered by broad terms such as "kitchen apparatus" and "kitchen machines". It is also possible that electrically-powered multi-purpose products such as "food processors" and "food preparation machines" may incorporate some form of food shaping and/or moulding feature.

35. The World Intellectual Property Organisation's own interpretation of the Class 21 class heading confirms that this class covers hand-operated household utensils that have their electrically-powered counterparts in Class 07. The explanatory notes indicate, for instance, that Class 21 includes small hand-operated apparatus for mincing, grinding, pressing etc whilst their electrical counterparts are in Class 7. Taking all these considerations into account I find that the applicant's goods are highly similar to those goods of the opponent identified at paragraph 28 above [para. 6 of this decision]".

15. I agree with the Applicant that manual kitchen utensils are more likely to be referred to as tools or implements rather than machines. Given the nature of Applicant's actual product the Hearing Officer might have been using the latter in the sense of two or more parts working together to produce a predetermined result. However, whether or not the Applicant's product is a machine was not material to the Hearing Officer's determination that the goods applied for and the Opponent's goods were highly similar.
16. The Hearing Officer's findings in that regard were (in no particular order):
- (a) Both sets of goods were for use in a kitchen for the preparation of food.
 - (b) Such goods often had electric and non-electric counterparts.
 - (c) The Opponent's specifications in Classes 7, 9 and 11 contained broad terms like "kitchen apparatus", "kitchen machines" and "food processors". It was possible that an electrical device for pressing and moulding food into rectangular blocks might be included within those broad terms or that an electrical multi-purpose product covered by those terms, e.g., a food processor, would have a food shaping and, or moulding tool.
 - (d) The Applicant's and the Opponent's goods were likely to be sold through specialist cookware/kitchenware retailers or cookware/kitchenware sections of department stores.
 - (e) Electric and non-electric versions of food preparation products might be stocked concurrently in those retail outlets.
 - (f) The Explanatory Notes to the International Classification System supported the Hearing Officer's analysis at least in relation to Classes 21 and 7.
17. In my judgment, the Hearing Officer did not err in his determination of the degree of similarity between the respective goods. The Applicant makes two further points. First, that the Hearing Officer did not take into account TV shopping channels. However, the Hearing Officer's reference to retail outlets was not necessarily confined to retailers in the traditional sense and in any event his findings were equally applicable to TV shopping channels. Second, the Applicant says that in fact his product operates in a completely different way to any other kitchen product. That may well be the case but the correct comparison under section 5(2)(b), as the Hearing Officer rightly indicated, is between the goods as stated in the application on the one hand and the goods as listed in the Opponent's earlier mark on the other hand and account must be taken of any notional and future uses in both cases.
18. The Applicant further argues that the Opponent has not used the earlier mark in the UK. The UK system contemplates that a trade mark may be protected through registration even though it has not been used. The obligation is that a proprietor must put his mark to genuine use in the UK in relation to the goods or services for which it is registered within five years of the date when registration takes place. The Opponent's earlier trade mark was entered on the Register on 12 July 2002. Thus, at the time the application was published on 30 July 2004, the sanctions for non-use did not apply. In particular, as the Hearing Officer explained at paragraph 21 of the decision, the Opponent could not be called upon in the opposition to prove use in accordance with section 6A of the Act (inserted by The Trade Marks (Proof of Use, etc) Regulations 2004). Nor at that time could the Applicant have applied under section 46(1)(a) of the Act for revocation of the Opponent's earlier mark for non-use. Additionally, as I have sought to explain above, the fact that there was (or could have been) no actual confusion in the market between the Applicant's and the Opponent's products at the date of filing the Applicant's mark is not decisive because regard must be had to notional and future use.

19. The Applicant has been granted a patent for his product. The patent protects the technical advance he has contributed to the particular field, i.e., his invention, but it does not give him the right to secure trade mark registration for the name under which he markets that invention. In order to obtain trade mark registration in the UK, the conditions of registrability set out in the Act and the Rules must be satisfied. Those conditions include the absence of an earlier trade mark where the criteria of section 5(2)(b) are successfully asserted in opposition proceedings. The Hearing Officer differentiates patent and trade mark protection at paragraphs 19 – 20 of the decision.
20. The Applicant feels aggrieved that the Registry examination did not uncover the Opponent's earlier trade mark. The Registry examination and search that I have described at paragraphs 2 and 3 above did not guarantee that an opposition would not be brought under section 5 either by the owner of the mark cited or by third parties whose earlier rights were not revealed during the examination. Why the Opponent's mark was not cited against the application is not a matter for this appeal.

Conclusion

21. The Applicant has not established that the Hearing Officer materially erred in arriving at his decision that there was a likelihood of confusion under section 5(2)(b) and that the opposition was made out. The appeal is therefore dismissed. I have no reason to believe that the Opponent incurred any costs in relation to this appeal and I will make no order as to costs.

Professor Ruth Annand, 4 January 2008