

O/0633/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS. UK00003702428 AND UK00003702422

BY ONTEL PRODUCTS CORPORATION

TO REGISTER THE TRADE MARKS:

**ARCTIC AIR PURE CHILL**

IN CLASS 11

AND

**ARCTIC AIR FREEDOM**

IN CLASS 11

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NOS. 433635 AND 433639

BY ARDUTCH B.V.

## BACKGROUND AND PLEADINGS

1. On 28 September 2021, Ontel Products Corporation (“the applicant”) applied to register the **ARCTIC AIR PURE CHILL** mark (“**428 Mark**”) shown on the cover page of this decision in the UK. The application was filed pursuant to Article 59 of the Withdrawal Agreement.<sup>1</sup> As a consequence, it is deemed to have the same filing date as the corresponding trade mark application filed in the EU. Since the EU trade mark application was an international registration designating the EU, which claimed priority from the applicant’s earlier US registration (90248846), the application in turn also claims the same priority being 12 October 2020. The applicant seeks registration for the following goods:

Class 11      Personal portable humidifier and air purifier in the nature of a cooling device; fans and personal cooling fans.

2. On 28 September 2021, the applicant also applied to register the **ARCTIC AIR FREEDOM** mark (“**422 Mark**”) shown on the cover page of this decision in the UK. The application was also filed pursuant to Article 59 of the Withdrawal Agreement. Since the EU trade mark application was an international registration designating the EU, which claimed priority from the applicant’s earlier US registration (90235789), the application in turn also claims the same priority being 5 October 2020. The applicant seeks registration for the following goods:

Class 11      Portable personal cooling devices; wearable cooling apparatus.

3. The applications were both opposed by Ardutch B.V. (“the opponent”) on 18 May 2022. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following trade mark:

# ARCTIC

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<sup>1</sup> ‘Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community (2019/C 384 I/01)’, also known as the ‘Withdrawal Agreement’.

Comparable UK trade mark (EU) registration no. UK00902921211

Filing date 31 October 2002; Registration date 13 October 2005.

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

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.

4. As shown above, the opposition is based upon the opponent's comparable UK trade mark (EU),<sup>2</sup> claiming that there is a likelihood of confusion because the goods are identical or highly similar, and due to the "presence of the opponent's mark as the prefix word in the mark[s] applied for".

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<sup>2</sup> Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

5. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use.

6. The opponent is represented by Beck Greener LLP, and the applicant is represented by Kilburn & Strode LLP. A hearing was neither requested nor considered necessary. Both parties filed evidence in chief, and the applicant filed written submissions in lieu of a hearing. I make this decision having taken full account of all the papers, referring to them as necessary.

## **RELEVANCE OF EU LAW**

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 the witness statement of Gabriel Adrian Eremia dated 2 November 2022. Mr Eremia is the Marketing Director of Arctic S.A. which he states within his witness statement, is part of the Arcelik group of companies which uses the trade mark 'ARCTIC' by authorisation of the opponent. Mr Eremia's statement was accompanied by 7 exhibits (GAE1-GAE7).

9. The applicant's evidence consists of the witness statement of Ryan Edward Pixton dated 9 January 2023. Mr Pixton is a Chartered Trade Mark Attorney at Kilburn & Strode who is the applicant's representative in this matter. Mr Pixton's statement was accompanied by 11 exhibits (REP1-REP11) with the aim of establishing the difference between the opponent's and applicant's goods (in nature, price and trade channels).

10. Whilst I do not propose to summarise it here, I have taken all of the evidence and the parties' submissions into consideration in reaching my decision and will refer to them where necessary below.

## **DECISION**

11. Section 5(2) reads as follows:

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

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

(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.”

12. The opponent’s mark qualifies as an earlier mark in accordance with section 6(1)(a) and 6(1)(ab) as its filing date is an earlier date than the priority dates of the applicant’s marks. As the opponent’s mark had completed its registration process more than five years before the priority dates of the marks in issue, it is subject to proof of use pursuant to section 6A of the Act.

### **Proof of use**

13. I will begin by assessing whether there has been genuine use of the earlier marks. The relevant statutory provisions are as follows:

14. Section 6A of the Act states:

“(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 opponent’s 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. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five years ending on the priority dates of the applicant’s marks, i.e. 13 October 2015 to 12 October 2020 (428 Mark) and 6 October 2015 to 5 October 2020 (422 Mark).

17. 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 I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken 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].”

18. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

19. I note that any evidence that falls outside of the relevant period will not be referred to within my decision if it does not assist the opponent. I note the following from the opponent’s evidence:

- a) Mr Eremia states that the opponent is “the largest Romanian household appliances manufacturer and one [of] the largest manufacturers in Europe”.
- b) By 2009, the opponent “had a production capacity of 1.5 million refrigerators”.
- c) Mr Eremia provides the following table of unit sales from 2015 to 2021 broken down by various appliances:

Domestic ARCTIC	2015	2016	2017	2018	2019	2020	2021
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
<b>GRAND TOTAL</b>	<b>687.369</b>	<b>971.943</b>	<b>1.194.154</b>	<b>1.183.666</b>	<b>1.287.781</b>	<b>1.291.705</b>	<b>1.353.286</b>

d) I have also been provided with the following table turnover in '000 Euros for 2015 to 2021:

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
<b>GRAND TOTAL</b>	<b>97.502</b>	<b>134.619</b>	<b>155.214</b>	<b>168.139</b>	<b>182.239</b>	<b>184.784</b>	<b>201.952</b>

- e) Mr Eremia confirms that all of the above figures (unit and turnover) are for sales within Romania and do not include export sales to the UK and other EU countries.
- f) **Exhibit GAE2** contains invoices, including those dated from 2017 to 2020, to show evidence of sales within Romania. I note that the invoices are in Romanian and I have not been provided with official translations. However, Mr Eremia has provided a product list in **exhibit GAE3**. Based on this information, I have prepared the following table in relation to the goods that I have been able to cross-reference from the product list and invoices provided:

Date	Invoice number	Product	Product number
11/01/2017	4400174633	Hood (standard)	8906630920
14/01/2017	4400174947	Hood (standard)	8906630920
03/03/2017	4400179852	Refrigerator (2 doors freezer)	7511410008
26/01/2018	4400219713	Oven (standard cooker)	7787182118 7738482132
12/01/2018	4400217405	Hood (standard)	8906640910 8906530920
15/01/2018	4400217747	Oven (multifunction) Hood (standard)	7768282101 8906530920
07/02/2018	4400221096	Oven (standard cooker)	7753282135 7738482130
11/05/2018	4400230481	Hood (standard)	8906640910
11/01/2019	4400265950	Oven (standard cooker) Hood (standard)	7753282194 8906640910
18/01/2019	4400267270	Oven (standard cooker)	7738482151
13/03/2019	4400274180	Hood (standard)	8906640910
07/01/2020	4400320760	Oven (standard cooker) Oven (multifunction)	7753282135 7768282101
07/01/2020	4400320777	Hob (Gas)	7712282106
08/01/2020	4400320851	Hood (standard)	8906530920
09/01/2020	4400321115	Oven (standard cooker) Oven (standard cooker) Oven (multifunction)	8906640910 7753282135 7768282101
20/02/2020	4400327254	Oven (standard cooker)	7753282194
09/06/2020	4400335639	Hood (standard)	8906530920 8906630920

- g) As the invoices are not translated, I am unable to determine the value of sales made by the above goods (as it is not immediately clear which column contains this information). However, the word ARCTIC is used in what I assume to be

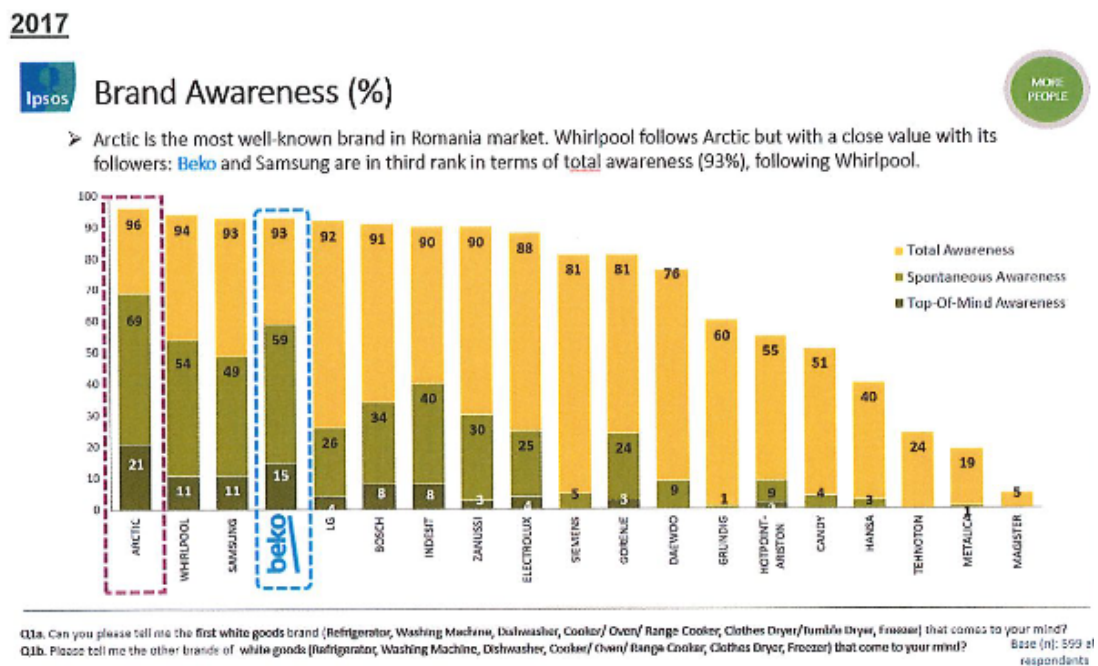
the product description column, and the following mark has been used on the top of every invoice:



h) Mr Eremia also provides the following table regarding the opponent’s domestic adverting and expenditure in Romania:

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

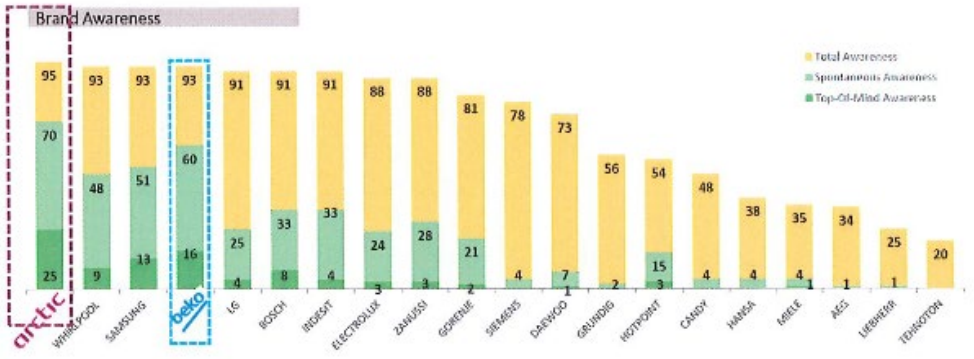
i) Mr Eremia states that ARCTIC “has the highest level of brand awareness for domestic appliances” in Romania. I note that this is supported by screenshots provided in his witness statement in regard to the “previous market awareness studies done by IPSOS”, including the following:



2018



- Arctic is the most well-known brand in the Romanian MDA market, with the highest top of mind score.
- followed by Beko, Samsung & Whirlpool.

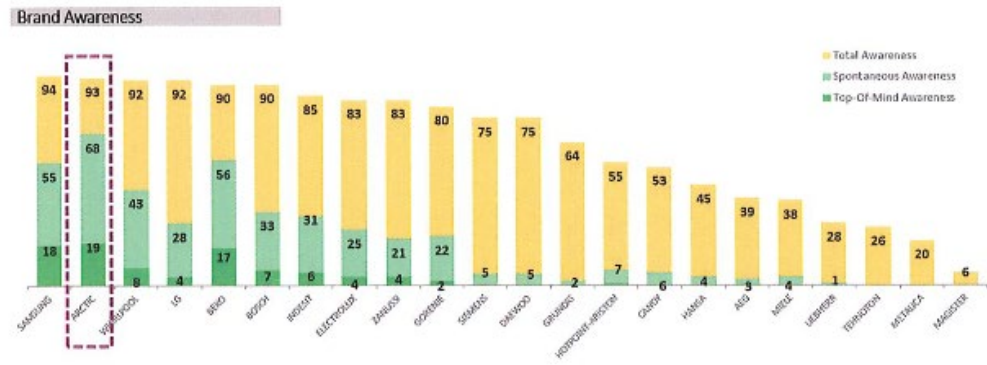


Q1a. Can you please tell me the first white goods brand (Refrigerator, Washing Machine, Dishwasher, Cooker/Oven/ Range Cooker, Clothes Dryer/Tumble Dryer, Freezer) that comes to your mind? Base (n): 612 all respondents  
 Q1b. Please tell me the other brands of white goods (Refrigerator, Washing Machine, 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?

2019



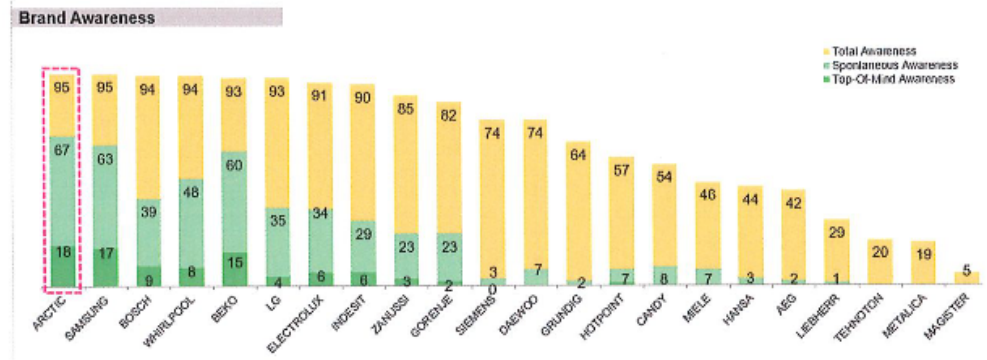
- Top brands have no awareness problems. Good news, Arctic and Beko shine out with their high mind share. They are the top brands in terms of spontaneous awareness
- Grundig seems to have a heritage in this market when prompted it is recalled by 64%; however it has no mind share.



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.



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? Base (n): 603 all respondents  
 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?

j) Mr Eremia also states that they have extensively advertised “over many decades” using digital, outdoor, magazine and TV advertising. He has provided the following illustrations of advertisements:

**Bucharest outdoor 2017**

**TV&Digital advertising – Arctic How it's made Discovery & TLC 2018**

**Digital advertising 2020**

k) I note that the above advertisements have not been officially translated and therefore I am unable to read the contents of them.

l) Lastly, **exhibit GA4** is said to contain images of ARCTIC products demonstrating how the mark is affixed to the goods. Albeit these pictures are very unclear, pixilated and undated, there is one image which does show the ARCTIC mark clearly being used on what I assume to be a fridge or freezer. However, at **exhibit REP1**, the applicant has provided clearer images of the opponent's goods using the mark (dated 4 January 2023), as follows:



20. As far as the form of the mark is concerned, I am satisfied that the mark has been used as registered; with the word ARCTIC appearing on the invoice evidence (within the goods description). For the sake of completeness, I note that the word ARCTIC also appears in a stylised typeface as highlighted by the above evidence. However, the stylisation is very minimal and does not alter the distinctive character of the mark.<sup>3</sup> Therefore it is acceptable variant use.

### **Conclusions from the evidence on genuine use**

21. 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.<sup>4</sup>

22. As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

23. As the earlier mark is a comparable mark, and as the relevant periods in which to prove use ended in October 2020 i.e. before the IP Completion Day (31 December 2020), the relevant territory to assess use is in the EU.

24. Clearly, there are some issues with the opponent’s evidence. I note that some of the evidence is not translated, undated, or falls after the relevant periods. However, the turnover and unit figures that have been provided within the above tables are notable, particularly as these sales are focused within one EU country (Romania). I note that these figures are supported by invoice evidence which has been cross-referenced. I also note that the opponent has provided advertising and promotional

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<sup>3</sup> *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19

<sup>4</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

figures, and some examples of advertising. Although this evidence is untranslated, it is clear that the ARCTIC mark is used on them.

25. The case law 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.<sup>5</sup> I consider that to be the case here. Therefore, taking all of the above into account, I am satisfied that the opponent has demonstrated use of its mark in the EU during both relevant periods.

26. I must now consider whether, or the extent to which, the evidence shows use of the goods and services relied upon. 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.”

27. 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:

“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].

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<sup>5</sup> *Leno Merken BV v Hagelkruis Beheer BV*, Case C149/11, paragraphs 36, 50 and 55.

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."

28. The goods for which the earlier mark is registered and upon which the opponent relies is its class 7 and 11 machines and appliances.

29. I consider that the earlier mark has been put to genuine use for cookers, cooker hoods, hobs, stoves, 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 supported with invoice evidence, the product list and also products being visible in the advertisements.

30. I note that, for example, “dishwashers” and “tumble dryers”, are terms which are already contained within its class 7 specification. However, I also note that the earlier mark is registered for broader terms such as “electric kitchen machines” and “machines for the preparation of food and beverages”. I consider that this would need to be narrowed down to reflect the opponent’s above goods only (which I consider to be appropriate sub-categories).

31. For the opponent’s remaining class 7 terms, the opponent has not shown use for anything in relation to washing carpets or upholstery, polishing machines, ironing, sewing, embroidering and knitting machines, waste disposal machines and electrical hair trimmers/clippers. I also 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.

32. I note that the terms “refrigerators”, “freezers”, “ovens”, “gas and/or electric cookers”, “cooker hoods” and “stoves” are already contained within the opponent’s class 11 specification, and for which use has been shown. However, there is also the broader 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”, “installations, apparatus, appliances and utensils all for cooking”, “cooling and freezing appliances and containers” and “apparatus for drying and airing clothes”, once again these are very broad terms, which would need to be narrowed down to reflect the opponent’s above goods only (which I consider to be appropriate sub-categories).

33. Lastly, the opponent has not provided any evidence supporting use of the following class 11 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” and “portable steamers for fabrics”.

34. Taking all of the above into account, I consider a fair specification for the opponent’s mark 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) - case law**

35. 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

36. The competing goods are as follows:

Opponent's goods	Applicant's goods
<u>Class 7</u> Washing machines; tumble dryers; dishwashers.	<b>428 Mark</b> <u>Class 11</u> Personal portable humidifier and air purifier in the nature of a cooling device; fans and personal cooling fans.
<u>Class 11</u> Gas and/or electric cookers; cookers; refrigerators; freezers; stoves; ovens; tumble dryers; cooker hoods; freezers and refrigerators.	<b>422 Mark</b> <u>Class 11</u> Portable personal cooling devices; wearable cooling apparatus.

37. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. 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.”

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;

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

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

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

40. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal*

*Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

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

## **428 Mark**

### Class 11

*Personal portable humidifier and air purifier in the nature of a cooling device.*

41. The applicant’s humidifiers are used to increase moisture in the air, and air purifiers are used to trap airborne particles which filters the air. I therefore do not consider that any of the opponent’s goods overlaps with the applicant’s above goods. Its best comparison would be with the opponent’s “refrigerators” and “freezers” on the basis that the applicant’s goods are stated to be “in the nature of a cooling device”. However, they are to be used in such different ways, one to keep the user’s produce such as foods and drink, cool, and the other to keep the user cool, that I do not consider that they overlap in nature and purpose. They clearly do not overlap in method of use. I also do not consider that the same undertaking would produce all of the goods, and they are neither in competition nor complementary. I consider that the goods may overlap in distribution channels, as general undertakings will sell a range of appliances, including all of the above the goods. However, they would not be sold within the same aisle, or near each other. I consider that the goods are dissimilar.

*Fans and personal cooling fans.*

42. The applicant’s above goods are used to circulate air around the room, which in turn cools the air down, and creates a more comfortable environment for the user. I therefore consider that the same comparison applies in paragraph 41 above. I consider that the opponent’s goods and applicant’s goods are dissimilar.

## 422 Mark

### Class 11

#### *Portable personal cooling devices.*

43. I consider that the applicant's above broader category would include fans, smaller air conditioning units and air coolers. I consider that these goods are dissimilar to all of the opponent's goods. The opponent's strongest comparison, again, would be with its "refrigerators" and "freezers" on the basis that the applicant's goods are "cooling devices". However, I consider that the same comparison applies in paragraph 41 above. I consider that the opponent's goods and applicant's goods are dissimilar.

#### *Wearable cooling apparatus.*

44. I consider that the applicant's above broader category would also include wearable fans, which would hang around the user's neck. It may also cover clothing items which are used to cool the user down (such as cooling vests etc.) I therefore consider that the same comparison applies in paragraph 41 above. I consider that the opponent's goods and applicant's goods are dissimilar.

45. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that (my emphasis):

"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."

46. As established in the case law above, under section 5(2)(b), for there to be a likelihood of confusion between the marks, there has to be a finding of similarity

between the goods. Since I have determined that they are not similar, the opposition fails here.

## **CONCLUSION**

47. The opposition is unsuccessful, and the application may proceed to registration.

## **COSTS**

48. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£1,050** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a Counterstatement	£200
Preparing and filling evidence	£500
Preparing and filling submissions in lieu	£350
<b>Total</b>	<b>£1,050</b>

49. I therefore order Ardutch B.V. to pay Ontel Products Corporation the sum of £1,050. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 3<sup>rd</sup> day of July 2023**

**L FAYTER**

**For the Registrar**