

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2109763
BY PRADEEKPUMAR NANDLAL DHOOT
TO REGISTER A TRADE MARK IN CLASSES 7,8,9,11 & 21

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 46862
BY KENWOOD MARKS LIMITED

BACKGROUND

1) On 11 September 1996, Pradeekpkumar Nandlal Dhoot of Gangapurwala, 2275 Adat Bazar, Ahmednagar 414 001, State of Maharashtra, India applied under the Trade Marks Act 1994 for registration of the following trade mark:



2) In respect of the following goods:

Class 7: “Washing machines; dish washers; machines; machines for dispensing and manufacturing beverages; machines for preparing popcorns; grinding machines; electric mixing and/or grinding machines for kitchen use; mixers and juicers included in Class 7; food processors; kitchen waste pulverizers; sewing machines; electric motors; incubators.”

Class 8: “Electric shavers.”

Class 9: “Audio and visual equipments and instruments; television sets; picture tubes; VCPs and VCRs; accessories for television sets, VCRs and VCPs; video signal transmitting, receiving and recording equipments, instruments and devices; antennas; aerials; films; audio and video tapes, records, discs and cassettes; video games; sound reproducing and recording equipment and parts and fittings for the above being goods included in Class 9; micro phones, loud speakers, amplifiers; cables and wires; terminals; voltage stabilizers; calculating machines; electric cigarette lighters; electronic timers; measuring, signalling, testing and checking apparatus in instruments included in Class 9; electric irons; electric floor carpet cleaners.”

Class 11: “Installations for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; refrigerators; electric room air conditioners; electric air coolers; electric water coolers; electric freezers; electric rice cookers; electric home appliances included in Class 11; electric domestic and kitchen utensils; electric lamps; electric toasters; parts and fittings included in Class 11; hair dryers; hot plates and trolleys for heating and cooking foods.”

Class 21: “Electric toothbrushes.”

3) On the 19 May 1997 Kenwood Marks Limited of New Lane, Havant, Hampshire PO9 2NH filed notice of opposition to the application. The grounds of opposition are in summary:

1) The opponent is the proprietor of a number of registered trade marks (detailed in annex A) and has built up a considerable goodwill and repute in them.

2) The mark applied for is similar to the opponent's earlier trade marks and is for goods identical or similar to those for which the earlier marks are registered. The application therefore offends against Section 5(2)(b).

3) Use of the mark in suit is liable to be prevented by the law of passing off and so the application is contrary to Section 5(4)(a).

4) By virtue of the above the mark also offends against Section 3(4).

5) Registration of the mark in suit is contrary to Section 3(3)(b) as it is of such a nature as to deceive the public. They would consider the goods to originate from the applicant or in the alternative the inclusion of the words "United Kingdom" would deceive the public if goods did not originate in the UK.

4) The opponent further requested that the Registrar refuse application number 2109763 in the exercise of her discretion. However, under the Trade Marks Act 1994 the Registrar does not have a discretion to refuse an application as she did under the old law. An application can only be refused if it fails to comply with the requirements of the Act and Rules in one or more respects.

5) The applicant subsequently filed a counterstatement denying all of the grounds of opposition, other than accepting that the opponent is the proprietor of the marks claimed. The counterstatement also stated that it was the applicant's intention only to use the mark on goods of UK origin. Both sides ask for an award of costs.

6) Only the opponent filed evidence in these proceedings and the matter came to be heard on 11 December 2000 when the applicant was represented by Ms Wakerley of Messrs Reddie & Grose, and the opponent by Mr Stacey of Messrs Baron & Warren.

OPPONENT'S EVIDENCE

7) The opponent filed a declaration, dated 26 January 1998, by Thomas David Michael Hatton. Mr Hatton is the Company secretary of Kenwood Marks Ltd, Kenwood Appliances Plc, Kenwood International Ltd and Kenwood Ltd.

8) Mr Hatton gives a potted history of the company and the introduction of products. The first KENWOOD product, a toaster, was launched in 1947. Between 1948 and 1960 a number of food mixers were launched. In the 1970's "washing machines and the like" were also marketed. In 1987 they began to introduce a new generation of products including ovens, fryers, kettles, toasters and irons. In 1992 a range of water filters was introduced.

9) In addition to their own registrations, a licence was granted to Kenwood Corporation of

Japan to use the mark. The licence for UK registration 915256 is under Register User No 62576.

10) Turnover figures for Kenwood branded electrical appliances in the UK are provided. The figures for non electrical houseware products (such as water filters weighing scales etc) in the UK do not relate exclusively to goods under the Kenwood brand.

Year	Electrical Goods £Million	Houseware products £Million
1992	30	
1993	32.5	
1994	34.3	3.4
1995	33.2	5.8
1996	35.3	5.8
1997	40.3	5.4

11) Mr Hatton states that the current worldwide turnover for Kenwood branded products is approximately £150 million. He also states that for a number of years not less than £1 million per annum has been spent on promoting and marketing the KENWOOD brand in the UK.

12) The opponent's goods are sold through a variety of retail outlets throughout the UK. At exhibit DMH4 are brochures showing the range of goods available worldwide. These are dated 1997 and 1998 and show a range of kitchen appliances.

13) It is claimed that the opponent has a number of marks with the prefix KEN (Kenmix, Kenpart) and that no other domestic appliances have a brand with the prefix KEN. Mr Hatton states that the use of a laudatory word "STAR" in conjunction with the prefix KEN will suggest that the opponent has launched an exclusive premium brand of appliances.

14) Regarding the claim in the applicant's counterstatement that "it is the applicant's intention only to use the mark on goods that are of UK origin." Mr Hatton comments:

"I am surprised that a company based in India would look to source products in a relatively high cost country such as the United Kingdom when cheaper products could be sources domestically or in countries such as China."

APPLICANT'S EVIDENCE

15) The applicant, Pradeekpkumar Nandlal Dhoot, filed a declaration. Mr Dhoot states that he is in business manufacturing so called white and brown goods. At exhibit PND2 he provides literature relating to the use of the mark KENCO by the Kenco Coffee Company in relation to coffee machines. These all relate to catering units and none of the brochures are dated. He comments that the opponent's KENPART marks have all lapsed (in 1998). Mr

Dhoot also comments that the KENWOOD mark, as used by licensees, and the mark in suit have coexisted in India for a number of years. He also provides turnover and promotional figures for his mark in India, however this is of little assistance in determining the case, other than to show that the applicant trades primarily in kitchen ware.

OPPONENT'S EVIDENCE IN REPLY

16) This consists of a declaration by James Maxwell Stacey, a partner of the opponent's trade mark advisors.

17) Commenting on the licence with Kenwood Corporation, Mr Stacey states that the licence is for "brown goods" (hi-fi etc) whilst the opponent's manufacture "white goods" kitchen appliances. They are therefore not in competition with each other. Regarding the use identified by the applicant's of the mark KENCO on coffee machines by Kenco, Mr Stacey comments that these are vending machines and so unsuitable for domestic use. The other comments regarding the applicant's evidence and the "survey" undertaken by Mr Stacey, intended to establish the non-use of KENCO on domestic electrical goods, does not assist me.

18) That concludes my review of the evidence. I now turn to the decision.

DECISION

19) At the hearing the opponent withdrew the grounds of opposition under Sections 3(4) and 3(3)(b) as it relates to deception of trade origin, although this ground [3(3)(b)] is still relied upon in relation to the incorporation of the words "United Kingdom" in the mark in suit.

20) I first consider the ground of opposition under Section 3(3)(b) which is as follows:

"3 (3) A trade mark shall not be registered if it is -

(a)

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service)."

21) The opponent contends that there is a risk of deception being caused by the inclusion of the words "United Kingdom" in the mark. The opponent believes that the applicant will manufacture goods outside the UK and points to its own experience of sourcing from outside the UK to achieve lower unit prices. The applicant has made a clear statement of intent to the effect that the mark will only be used on goods that are of UK origin. The ground of opposition therefore fails.

22) I turn first to the ground of opposition under Section 5(2)(b) which is as follows:

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

(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 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.”

23) An earlier right is defined in Section 6, the relevant parts of which state

6.- (1) *In this Act an ‘earlier trade mark’ means -*

(a)...a registered trade mark, international trade mark (UK) or Community trade mark 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.

24) I have to determine whether the marks are so similar that there exists a likelihood of confusion on the part of the relevant public. In deciding this issue I rely on the guidance of the European Court of Justice in *Sabel Bv v Puma AG [1998 RPC 199 at 224]*, *Canon v MGM [1999 ETMR 1]* and *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel BV [1999 ETMR 690 at 698]*. It is clear from these cases that: -

(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 / 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;

(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 therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2);

(h) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section.

25) I also take into account the recent case of *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723. The European Court of Justice said of Article 4(1)(b) (transposed into UK law in Section 5(2)(b):

“The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character.....Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense.”

26) The Court felt that the concept of association of marks in the global assessment of the likelihood of confusion was over emphasised. It is not sufficient for the average consumer to merely associate marks in the sense that if prompted a consumer will call to mind another mark. Thus a mere possibility of confusion, even in situations where a mark clearly has a strong reputation, is not a valid ground for opposition to a trade mark.

27) As is clear from the Annex to this decision the opponents are relying on a number of registrations. From the views expressed by Mr Stacey at the hearing it was clear that the opponent believes that the mark KENWOOD provides their strongest case, with the KENMIX mark being a secondary issue. No arguments were put forward in relation to the KENPART mark.

28) At the hearing it was common ground that the goods contained in the applicant’s specification were identical to the goods registered for the KENWOOD and KENMIX trade marks other than for the following items in the applicant’s specification: sewing machines, incubators and electric toothbrushes.

29) It is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of goods is but one aspect. Due regard should be given to the closeness of the respective marks, the reputation the earlier mark enjoys in respect of the goods or services for which it is registered, and any other relevant factors.

30) For ease of reference I reproduce the marks of both parties below:

Applicant’s mark	Opponent’s marks
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	KENWOOD
	KENMIX

31) The applicant's mark consists of three words and contains a modicum of stylisation. However the last two words UNITED KINGDOM are not, in my opinion, particularly distinctive and would be largely overlooked by consumers. Similarly the stylised "S" would, I believe, be largely ignored by the average consumer. In my view the dominant part of the mark in suit is the word KENSTAR. In my analysis I have considered the applicant's mark as being essentially the word KENSTAR as this provides the opponent with its strongest case. I accept that for the purposes of the global assessment I need to consider the applicant's mark in full.

32) Visually all three marks begin with the same three letters, thereafter however they differ in their endings. Aurally all the marks comprise of two syllables the first being identical, with the second syllables being very divergent. The second syllables also comprise of known dictionary words WOOD, MIX and STAR.

33) Although the opponent's main mark KENWOOD is a composite of the name of the companies originator Kenneth Wood I doubt that the majority of the public would be aware of this fact.

34) The opponent provided turnover figures for their KENWOOD mark in the UK. However, these figures were not put into context by reference to the company's market share. I accept that the opponent has a reputation in the UK in its KENWOOD mark but this reputation cannot, on the evidence provided, be regarded as above average.

35) In the evidence presented by the opponent was the assertion that the onus was on the applicant to demonstrate that there would be no likelihood of confusion. In fact, under the 1994 Act, the onus is on the opponent to make out its case (see Kerly' 14-258).

36) With all of this in mind I come to the conclusion that although the goods are largely identical this is more than counterbalanced by the differences in the marks Kenwood, Kenmix and Kenstar. This difference is even greater when the applicant's trade mark is considered in its entirety. When all factors are considered, that there is no realistic likelihood of confusion at 11 September 1996. Consequently, the opposition under Section 5(2)(b) fails.

37) Lastly, I consider the other ground of opposition under Section 5(4)(a) which states:

(4) *A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -*

(a) *by virtue of any rule of law (in particular, the law of passing*

off) protecting an unregistered trade mark or other sign used in the course of trade

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.

(5) *Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.*

38) The only potential “earlier right” which the opponent has identified arises under the common law of passing off. I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the WILD CHILD case (1998 14 RPC 455). In that decision Mr Hobbs stated that:

“The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art.4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the Applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England 4th Edition Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd - v - Borden Inc [1990] RPC 341 and Even Warnik BV - v - J. Townend & Sons (Hull) Ltd [1979] AC 731 is (with footnotes omitted) as follows:

‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

39) At the hearing Mr Stacey referred to the longevity of the mark and it’s reputation in the UK. Both of these factors were taken into account in my finding under Section 5(2) that there was no likelihood of confusion between the marks. There is therefore no misrepresentation which would lead the public to believe that the applicant’s goods are goods of the opponent.

40) The opponent seeks to rely upon its KENMIX and KENPART marks to demonstrate a “family” of marks with KENWOOD. This could, in suitable circumstances, give rise to an objection under Section 5(4). However, as the opponent has filed no evidence of actual use of KENMIX or KENPART, prior to the relevant date, it cannot in this case present an issue under Section 5(4)(a).

41) The opposition having failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £1335. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 28 day of February 2001

George W Salthouse
For the Registrar
The Comptroller General

ANNEX A

Mark	Number	Effective Date	Class	Specification
KENMIX	705697	14.3.52	7	Mixing machines for treating foodstuffs
KENWOOD	705698	-	-	Merged with 932705 (9.11.95)
KENWOOD	712436	19.11.52	7	Machines for mixing, pulping, grinding, mincing and shredding foodstuffs; and machines for peeling vegetables
KENWOOD	877937	-	-	Merged with 932705 (9.11.95)
KENWOOD	913966	-	-	Merged with 932705 (9.11.95)
KENWOOD	915256	2.10.67	9	Electronic and electrical apparatus and parts and fittings therefor, all included in Class 9 and for use in the home and in the kitchens of other establishments
KENWOOD	916351	-	-	Merged with 932705 (9.11.95)
KENWOOD	932705	21.10.68	7,11 & 21	<p>Dishwashing machines and parts and fittings therefor included in Class 7..... Machines for mincing, pulping, grinding, mixing and shredding.</p> <p>Electrically operated installations for lighting, heating, cooking, refrigerating, drying and ventilating; and parts and fittings included in Class 11 for all the aforesaid goods.</p> <p>Bowls, baskets, racks and trays, all included in Class 21; small domestic utensils and containers (not of precious metal or coated therewith); none being made of wood and all for use with domestic electrical apparatus; and ice-cube trays included in Class 21 made of plastics and for use in refrigerators.</p>
KENWOOD	1202783	-	-	Merged with 1500277 (9.11.95)
KENWOOD	1249919	-	-	Merged with 1500277 (9.11.95)
KENWOOD	1278288	-	-	Merged with 1500277 (9.11.95)
KENWOOD	1336999	-	-	Merged with 1500277 (9.11.95)
KENWOOD	1337296	-	-	Merged with 1500277 (9.11.95)
KENWOOD	1337297	-	-	Merged with 1500277 (9.11.95)
KENWOOD	1358873	-	-	Merged with 1500277 (9.11.95)

KENWOOD	1437915	-	-	Merged with 1500277 (9.11.95)
KENWOOD	1437916	-	-	Merged with 1500277 (9.11.95)
KENPART	1452688	14.1.91	7	Parts and fittings for machines for mixing, kneading, pulping, grinding, mincing, blending and shredding foodstuffs and drinks and for peeling vegetables; parts and fittings for dish washing machines, washing machines, drying machines, machines for airing clothes, rotary ironing machines, waste disposal machines, machines for making, mixing or dispensing beverages, machines for making ice-cream or sorbet, liquidizers, food processors, can openers, juice extractors; all included in Class 7.
KENPART	1452689	14.1.91	9	Parts and fittings for electric irons, vacuum cleaners, kettles, carpet cleaners, electric hair curlers, floor cleaning and polishing apparatus, electric, wax, polishing and cleaning machines for domestic use, apparatus and instruments for charging or recharging battery operated domestic kitchen appliances, tea infusers, electric jugs; all included in Class 9.
KENPART	1452690	14.1.91	21	Bowls, baskets, racks, trays, small domestic utensils and containers, appliances for making carbonated drinks; parts and fittings for all the aforesaid goods; all included in Class 21
KENPART	1452691	14.1.91	11	Parts and fittings for lighting, heating, cooking and drying, cooking hobs, coffee percolators, toasters, electric saucepans, pancake and waffle devices, deep fat fryers and water filtration apparatus; all included in Class 11.
KENPART	1452692	14.1.91	37	Installation, maintenance and repair of domestic electrical and electronic appliances, machines and apparatus, and of small domestic containers and utensils; all included in Class 37.

KENWOOD	1500277			<p>Water purifying machines; filtering machines; cartridges for filtering machines; parts and fittings for all the aforesaid goods; all included in Class 7. ...</p> <p>Washing machines, drying machines, machines for airing clothes, rotary ironing machines, domestic laundry machines, waste disposal machines, parts and fittings included in Class 7 for all the aforesaid goods.</p> <p>Electric and non-electric shavers and razors; machines for extracting facial and body hair; beard clippers; blade sharpening instruments; crimping irons; curling tongs; electric and non-electric fingernail polishers and manicure sets; electric and non-electric nail clippers; electric and non-electric pedicure sets; razor cases; shaving cases; hand operated tools and apparatus, all for use in the kitchen; manually operated can openers; parts and fittings for all the aforesaid goods; all included in Class 8.</p> <p>Kitchen weighing scales; electric irons; electric vacuum cleaners; polishing, scrubbing and floor/carpet shampooing apparatus; tools adapted for use with the aforesaid vacuum cleaners and polishing, scrubbing and floor/carpet shampooing apparatus; parts and fittings for all the aforesaid goods; all included in Class 9.</p> <p>.....</p> <p>Electric kettles and parts and fittings therefor all included in Class 9</p>
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	150027 (cont)			<p>Water filtration and filtering apparatus and installations; water purification installations and apparatus; water softening apparatus and installations; filters; air conditioning, air filtering apparatus and installations; air purifying apparatus and machines; ionisation apparatus for the treatment of air; parts and fittings for all the aforesaid goods; all included in Class 11.</p> <p>Household or kitchen utensils and containers; bowls, dishes, baskets, racks and trays; cookware and cooking pots and pans; all included in Class 21.</p> <p>Toys, games and playthings; operating model replicas of kitchen appliances or machines used in the preparation of food or drink; parts and fitting for all the aforesaid goods; all included in Class 28.</p> <p>Repair of gas cylinders and of pressurised containers; repair and maintenance of beverage dispensing machines; all included in Class 37. Repair services and maintenance services included in Class 37, all for domestic electrical or kitchen appliances or apparatus.</p>
KENWOOD	915256*	2.10.67	9	Electronic and electrical apparatus and parts and fittings therefor, all included in Class 9 and for use in the home and in the kitchens of other establishments.

* Opponent has licensed mark to Kenwood Corporation of Japan.