

O-399-17

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3128392
IN THE NAME OF UK DAMIELE CO., LIMITED
FOR
THE TRADE MARK**

Damiele

**IN CLASSES 07 & 11
AND
OPPOSITION THERETO (UNDER NO. 405816)
BY
MIELE & CIE KG**

Background

1) On 23 September 2015, UK Damiele Co., Ltd ('the applicant') applied to register **Damiele** as a trade mark, in respect of the following goods:

Class 07: Food processors; Food processors (electric-) for domestic use; Beverage preparation machines, electromechanical; Wringing machines for laundry; Mixing machines; Dishwashers; Coffee grinders, other than hand-operated; Electric fruit presses for household use; Spin driers [not heated]; Washing machines [laundry]; Agitators.

Class 11: Autoclaves [electric pressure cookers]; Microwave ovens [cooking apparatus]; Refrigerating cabinets; Freezers; Ice machines and apparatus; Refrigerators; Refrigerating display cabinets [display cases]; Air conditioning installations; Air purifying apparatus and machines; Fans (Electric -) for personal use.

2) The application was published in the Trade Marks Journal on 09 October 2015 for opposition purposes and notice of opposition was later filed by Miele & Cie KG ('the opponent'). The opponent claims that the trade mark application offends under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ('the Act'). In support of the grounds under section 5(2)(b) of the Act, the opponent relies upon the following six earlier marks:

- UK registration 1014957 for the mark **MIELE** which has a filing date of 26 July 1073 and was entered in the register on the same date. The following goods are relied upon:

Class 11: Appliances included in Class 11 for heating, cooking, cooling, drying and for ventilating; electric kitchen utensils included in Class 11; electric cooking stoves, extractor hoods for cookers and for cooking stoves; electric hairdryers (not being machines); electric toasters; electric table fans (not being parts of machines), refrigerating installations and apparatus, steam

generating apparatus for the treatment of fodder; sterilizing apparatus for milking appliances.

- International registration 707088 for the mark **MIELE** which designated the UK for protection on 08 July 1998 and protection was subsequently conferred on 29 October 1999. The following goods are relied upon:

Class 07: Machines and appliances for the preparation of beverages, electromechanical appliances for the preparation of beverages, electric food processing machines, electric mixers for household use, electric presses for domestic purposes.

Class 09: Drinks dispensers.

Class 11: Electric coffee machines, drinks cooling apparatus.

Class 14: Kitchen and household appliances, made of precious metal, kitchen receptacles made of precious metal, non-electric percolators made of precious metal.

- EU registration 3404639 for the mark  which has a filing date of 21 October 2003 and was entered in the register on 14 February 2005. The following goods and services are relied upon:

Class 07: Machines for treating household and industrial linen, in particular washing machines, washing machines (laundry), washing machines with disinfectant properties, washing machines with sterilising properties, washing and spinning machines for linen; spin driers; ironing machines; hot mangles for linen; electric ironing presses; rinsing machines for household and industrial use, in particular dishwashers, rinsing machines for hotels, laboratories, hospitals, houses and doctors' surgeries, rinsing machines for medical apparatus, rinsing machines with disinfectant properties, rinsing machines with sterilising properties; machines and mechanical apparatus for preparing

beverages, electromechanical apparatus for preparing beverages; electric food processors, electric household blenders, electric presses for household purposes; electric cleaning apparatus for household purposes, namely vacuum cleaners, brushes controlled by blast air for vacuum cleaners, electric brushes for vacuum cleaners, floor nozzles for vacuum cleaners, air supplying pipes and air supplying flexible pipes and tubes for vacuum cleaners, filters for vacuum cleaners; floor polishers.

Class 11: Heating, steam generating, cooking, refrigerating, freezing, ventilating and water supply apparatus, in particular ovens (electric, gas), cookers, kitchen ranges, cooking utensils (electric), cooking apparatus and installations, hobs, cooking rings, hot plates, baking muffles and cookers for household and industrial kitchen use, microwave ovens, grilling equipment and apparatus (electric, gas), hot-air simmering apparatus (electric), deep fat fryers (electric), frying plates and griddles, pressure cookers (electric), steaming apparatus (electric); electrically-heated water bath apparatus, electrically heated food cabinets, cooker hoods, ventilating hoods; chillers, refrigerating apparatus, refrigerators, freezers, deep freezing apparatus, freezer cabinets, chest freezers, beverage cooling apparatus, ice boxes; ice-making machines and apparatus, coffee makers (electric); laundry drying machines, machines for drying laundry, electric laundry dryers, in particular spin dryers for laundry, electric drying cupboards.

Class 20: Furniture of metal, wood, cork, reed, cane, wicker, horn and substitutes for these materials, or of plastic or laminated material, in particular kitchen furniture, cabinets, fitted, support, suspended, high and modified cabinets; work tops of metal, wood, plastic or ceramic for kitchen furniture; doors for furniture, laminated panels for furniture; chairs, stools, tables.

Class 37: Repair, maintenance, servicing, assembly (installation) of industrial and household appliances and apparatus, and of kitchen furniture; washing, drying and ironing of linen.

- EU registration 28084 for the mark **Miele** which has a filing date of 01 April 1996 and was entered in the register on 18 December 1998. The following goods and services are relied upon:

Class 07: Laundry machines for domestic and industrial use, especially washing machines, laundry washing machines, washing machines with a disinfectant program, washing machines with a sterilizing program, washing machines and spin-dryers for laundry, spin dryers, ironing machines, heated mangles for laundry, electrically driven smoothing presses, dish washing machines for domestic and industrial use, especially dish washers, dish washers for use in hotels, laboratories, hospitals, homes and doctors' practices, washers for medical apparatus, washers with a disinfectant program, washers with a sterilizing program; electric motors, blowing machines (air-suction machines), pumps for washing machines or dish washers; milking machines, electrical kitchen apparatus for chopping, grinding, squeezing, electric tin openers; parts included in class 7 for all the aforementioned goods.

Class 09: Electric cleaning apparatus for household purposes, namely vacuum cleaners, air-driven brushes for vacuum cleaners, electric brushes for vacuum cleaners, floor nozzles for vacuum cleaners, air pipes and air tubes for vacuum cleaners, filters for vacuum cleaners, wax-polishing machines; electric irons; data processing equipment and computers, programmable electronic switches, electronic control equipment for household apparatus, electronic components included in class 9; parts for all the aforesaid goods included in class 9.

Class 11: Apparatus for heating, steam generating, cooking, refrigerating, freezing, ventilating and water supply, especially ovens (electric, gas), cookers, stoves, cooking appliances (electric), cooking apparatus and installations, hobs, cooking rings, hot plates, muffle furnaces, boilers, microwave ovens, grilling apparatus and equipment (electric, gas), deep fryers (electric); extractor hoods, ventilation hoods, air conditioning apparatus and installations, filters (parts of domestic or industrial installations);

refrigerating appliances, refrigerating installations, refrigerators, freezing appliances, freezing installations, upright freezers, chest freezers, beverage cooling apparatus, ice boxes, ice machines and apparatus; drying machines for laundry, machines for drying laundry, electrically driven laundry dryers, especially drum-type dryers for laundry, electrical drying cabinets for laundry; parts included in class 11 for all the aforesaid goods.

Class 16: Dust bags of paper, filters of paper for vacuum cleaners.

Class 20: Furniture of metal, wood, cork, reed, cane, wicker, horn and substitutes of these materials or of plastic or laminated material, especially kitchen furniture, cupboards, fitted cupboards, low cupboards, hanging cupboards, high cupboards, enclosed cupboards, work tops of metal, wood, plastic or ceramics for kitchen furniture, doors for furniture, laminated panels for furniture, seats, stools, tables.

Class 21: Small hand-operated household or kitchen utensils, household and kitchen containers (not of precious metal or coated therewith), dustbins, filters for household purposes, deep fryers (not electric), household appliances (not of precious metal), vacuum cleaner attachments for disseminating perfumes and disinfectants.

Class 37: Repair, servicing, maintenance, assembly and installation of all the aforesaid goods, washing, drying and ironing of laundry.

- EU registration 28092 for the mark **Miele** which has a filing date of 01 April 1996 and was entered in the register on 04 August 1999. The following goods and services are relied upon:

Class 07: Machines for treating household and industrial linen, in particular washing machines, washing machines (laundry), washing machines with disinfectant properties, washing machines with sterilising properties, washing and spinning machines for linen, spin dryers, ironing machines, hot mangles

for linen, electric ironing presses, rinsing machines for household and industrial use, in particular dishwashers, rinsing machines for hotels, laboratories, hospitals, houses and doctors' surgeries, rinsing machines for medical apparatus, rinsing machines with disinfectant properties, rinsing machines with sterilising properties, electric motors, fans (air suction machines), pumps for washing machines and dishwashers; milking machines; electrical kitchen machines for chopping, milling, pressing, electric can openers; machine parts included in class 7 for all the aforementioned goods.

Class 9: Electrical cleaning apparatus for the household, namely vacuum cleaners, brushes controlled by blast air for vacuum cleaners, electric brushes for vacuum cleaners, floor nozzles for vacuum cleaners, air supplying pipes and air supplying flexible tubes for vacuum cleaners, filters for vacuum cleaners, wax polishing machines. electric flat irons; Data processing apparatus and computers, electronic cycle control timer devices, electronic control apparatus for household appliances, electronic units included in class 9; parts included in class 9 for all the aforementioned goods.

Class 11: Apparatus for heating, steam generating, cooking, refrigerating, freezing, ventilating and water supply, in particular stoves, (electric, gas), cookers, kitchen ranges (ovens), cooking utensils, electric, cooking apparatus and installations, cooking rings, hot plates, baking muffle, kilns, microwave ovens, grill equipment and apparatus (electric, gas), deep-fat fryers, electric; range hoods, ventilation hoods, air-conditioning apparatus and installations, filters (parts of household or industrial installations); refrigerating equipment and apparatus, refrigerating cabinets; freezing equipment and apparatus, freezers, freezer chests, apparatus for chilling drinks, ice chests, ice machines and apparatus; laundry drying machines, machines for drying laundry, electric laundry dryers, in particular spin dryers for laundry, electric drying cupboards; parts included in class 11 for all the aforementioned goods.

Class 16: Vacuum cleaner bags of paper, filters of paper for vacuum cleaners.

Class 20: Furniture of metal, wood, cork, reed, cane wicker, bone and substitutes for all these materials of plastic or laminated material, in particular kitchen furniture, cupboards, build in, build under, hanging, high and modified cupboards, work surfaces of metal, wood, plastic or ceramic for kitchen furniture, doors for furniture, laminated panels for furniture, chairs, stools, tables.

Class 21: Household and kitchen utensils and containers (not of precious metal or coated therewith), trash cans; filters for household use, fryers (not electric), household equipment (not of precious metal), fittings for vacuum cleaners for disseminating perfumes and disinfectant preparations.

Class 37: Repair; maintenance; assembly, installation of all the aforesaid goods, washing, drying and ironing of laundry.



- EU registration 11998408 for the mark **IMMER BESSER** which has a filing date of 19 July 2013 and was entered in the register on 12 December 2013. The following goods and services are relied upon:

Class 07: Washing machines for household and industrial use, including automatic washing machines, washing machines (laundry), washing machines with disinfectant properties, washing machines with sterilising properties, washing and spinning machines for linen, washing machines incorporating drying facilities, spin dryers; Ironing machines, Hot mangles for linen, mangles, electric ironing presses; Rinsing machines for household and industrial use, including dishwashers, rinsing machines for hotels, laboratories, hospitals, houses and doctors' surgeries, rinsing machines for medical apparatus, rinsing machines with disinfectant properties, rinsing machines with sterilising properties; Large-chamber washing and cleaning installations, large-chamber washing and cleaning installations with disinfectant properties; Electrical engines; Machines and mechanical apparatus for making beverages, Beverage preparation machines, electromechanical; Electrical food processors, Electric blenders for household

purposes, Electric presses for household purposes; Electrical household cleaning appliances, In particular, vacuum cleaners, Robotic vacuum cleaners, Brushes driven with blast air for vacuum cleaners, electric brushes for vacuum cleaners, floor nozzles for vacuum cleaners, air pipes and air hoses for vacuum cleaners, Filters for vacuum cleaners, Vacuum cleaner bags, Vacuum cleaner accessories, Vacuum cleaner attachments for disseminating perfumes and disinfectants, Floor polishers; Parts of the aforesaid goods, included in class 7.

Class 08: Electric flat irons, steam ironing stations and systems, comprising steam irons, ironing boards with integrated ventilator function and/or board heaters.

Class 11: Apparatus for heating, steam generating, cooking, refrigerating, freezing, drying, ventilating and water supply, including ovens (electric, gas), cookers, kitchen ranges, cooking utensils (electric), cooking apparatus and installations, hobs, cooking rings, hot plates, oven cabinets and cookers for household and industrial kitchen use, self-heating saucepans, microwave ovens, grilling equipment and apparatus (electric, gas), hot-air cooking apparatus (electric), deep fat fryers (electric), frying plates and griddles, pressure cookers (electric), steaming apparatus (electric), electrically heatable bain-maries, electrically heatable hot cupboards for foods; Apparatus for ventilating and apparatus for improving air quality, including range hoods, ventilation hoods, air conditioning apparatus and installations, fragrance dosing apparatus (not for personal use), filters (parts for household or industrial use); Electrical tea and coffee makers, espresso coffee machines, automatic coffee machines (included in class 11); Refrigerating apparatus, including refrigerating appliances, refrigerating cabinets, chest refrigerators, refrigerating display cabinets (display cases), beverage cooling apparatus, fridge freezers, mechanical dispensers for dispensing chilled beverages for use with apparatus for refrigerating beverages, freezing equipment, freezing apparatus, freezer cabinets, chest freezers, ice chests, ice machines and apparatus; Drying apparatus, including drying machines for laundry, machines for drying laundry, electrically operated laundry dryers, including drum dryers

for laundry, electrically operated drying cabinets for laundry; Heat pumps; Sterilizers, Sterilisers; Parts for all the aforesaid goods, included in class 11.

Class 37: Repair, maintenance, installation of household appliances, industrial apparatus and equipment and household appliances and equipment operated electrically and/or electronically and/or with fuel, including gas, and kitchens (furniture); Washing, drying and ironing of laundry.

3) All of the above marks, with the exception of the mark listed at the final bullet point, are also relied upon under section 5(3) of the Act. It is claimed that the earlier marks have a significant reputation in the EU and the UK and that there is a risk that the use of the contested mark by the applicant will take unfair advantage of, and cause detriment to, the distinctive character and repute of the earlier marks. It is said that the applicant would free ride on the reputation of the earlier marks, that the opponent has no control over the quality of the goods that the applicant may sell and that the distinctive character of the earlier marks will also be diluted.

4) All of the marks set out above are earlier marks in accordance with section 6 of the Act. The marks listed at the first five bullet points had been registered for more than five years before the publication date of the applicant's mark and are therefore subject to the proof of use requirements, as per section 6A of the Act. The opponent made a statement of use for all of the goods and services relied upon.

5) Under section 5(4)(a), the applicant relies upon use of the sign **MIELE** throughout the UK since 31 December 1963 in relation to *Domestic appliances and related goods*. It is claimed that the opponent has goodwill associated with that sign such that the use of the applicant's mark is liable to be prevented under the law of passing off.

6) The applicant filed a very brief counterstatement in which it put the opponent to proof of use in relation to international registration 707088 (for the goods in class 07 and 11) and UK registration 1014957 (for all goods in class 11) only. The applicant states that the marks are not identical. It mentions nothing about whether the marks

are similar. It denies that there is a likelihood of confusion. It mentions nothing about the claims under sections 5(3) and 5(4)(a).

7) Only the opponent filed evidence. The applicant filed nothing beyond the counterstatement. Neither party requested to be heard; only the opponent filed written submissions in lieu. I make this decision on the basis of the papers before me.

Evidence

8) This comes from Dirk Ellerbrächter, the opponent's Corporate Director of Intellectual Property Rights/Contracts.

9) Mr Ellerbrächter explains that the opponent was founded in 1899 in Germany for the purpose of producing cream separators. Over the years, it has expanded its product range to include many domestic appliances, including washing machines, vacuum cleaners, dishwashers, irons, coffee machines, ovens, cooker hobs and hoods, refrigerators and freezers. Exhibit WS1 is a print taken from the opponent's website detailing its history and product expansion since 1899.

10) Mr Ellerbrächter further explains that the opponent is recognised worldwide as a manufacturer and supplier of premium domestic appliances that are designed, tested and engineered to last for up to 20 years and to give a high standard of performance. He states that, as a result of the opponent's significant reputation, the MIELE brand featured in a 1996 publication named *The World's Greatest Brands*. The relevant extract from that publication is shown in exhibit WS2.

11) The opponent has sold MIELE branded products in the UK since 1963 and is recognised as a provider of high-end domestic appliances. Exhibit WS3 shows a selection of prints, some from the Wayback Machine, from the opponent's UK websites and extracts from catalogues and brochures which Mr Ellerbrächter states shows the wide selection of goods sold under the MIELE mark in the UK from 2010. The website prints (dated August 2015, June 2014, June 2013, June 2012, June 2011 and June 2010) show the mark **Miele** used in relation to hobs, cooker hoods,

ovens, coffee machines/grinders, refrigerators, freezers, dishwashers, washing machines, tumble dryers, vacuum cleaners and sterilisers.

12) Mr Ellerbrächter states that MIELE has been recognised as “Best Domestic Appliance Brand” in the UK by Which? Magazine in 2007, 2008, 2010, 2012 and 2015. Exhibit WS4 is a press article from ‘The Independent’ newspaper dated 19 December 2012 regarding Miele’s success in 2012 in seven out of nine home appliance categories. The seven categories are: upright vacuum cleaners, cylinder vacuum cleaners, washing machines, tumble dryers, washer dryers, built-in ovens and fridge-freezers. There is also a screenshot from Which? magazine showing Miele’s success as “Best Home Appliance Brand” in the 2015 Which? awards.

13) The opponent sells its **Miele** goods through operation of showrooms and experience centres within the UK, as well as in large UK retailers such as John Lewis, Currys PCWorld, Argos and AO.com. Exhibit WS5

[REDACTED]

14) Exhibit WS6 is a selection of prints from some of the websites of the retailers referred to in the preceding paragraph and pages from some of their catalogues, all dating from 2010 to 2016. They show various **Miele** branded goods being offered for sale in the UK including washing machines, dishwashers, refrigerators, freezers, vacuum cleaners, ovens, hobs, cooker hoods and extractor fans, microwaves, tumble dryers, coffee machines.

15) Mr Ellerbrächter states that all of the opponent’s domestic appliances feature the Miele mark on the goods themselves and on their packaging. Exhibit WS7 is a selection of photographs of boxed vacuum cleaners and goods on display in a retail environment, namely fridge freezers, microwaves, washing machines and dishwashers all bearing the mark **Miele**.

16) The following figures are provided for the period 2005 to 2015 for Miele products sold in the UK:

Year	Approximate Turnover (£millions)
2005	99
2006	114
2007	127
2008	124
2009	115
2010	113
2011	113
2012	116
2013	121
2014	137
2015	145

17) Exhibit WS8 [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

18) Mr Ellerbrächter states that approximate marketing spend figures relating to the Miele brand in the UK were:

Year	Approximate Marketing Spend (£millions)
2005	3.7
2006	3.1
2007	4.3
2008	4.6
2009	3.6
2010	3
2011	4.4
2012	4.1

2013	5.5
2014	6
2015	6.8

19) Exhibit WS9 is a selection of marketing materials relating to Miele products. Mr Ellerbrächter states that the materials are demonstrative of the adverts that the opponent has placed in UK newspapers such as the Daily Telegraph, Daily Mail, The Guardian, The Times and The Independent and monthly magazines such as Good HouseKeeping and Homes and Gardens. All show various goods such as washing machines, vacuum cleaners and dishwashers advertised under the mark **Miele**.

20) Exhibit WS10 [REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]

21) Exhibit WS11 is a selection of newspaper articles. An article from The Guardian dated 13 March 2014 entitled “Buying a washing machine: a guide” states that “The Miele W3370 is high on the Which? Best Buy list.” A further article from www.independent.co.uk dated 30 June 2015 entitled “11 best upright vacuum cleaners” lists the “Miele Dynamic U1: £370, John Lewis” as fourth in its list and describes Miele as “The premium German brand”.

Approach

22) The opponent’s strongest case lies with its earlier EU registration 28084 for the mark **Miele**. This is because: i) the applicant has not put the opponent to proof of use in respect of that mark, ii) the goods covered by it appear to be essentially the same as those covered by the other marks (at least in terms of those which represent the opponent’s strongest case), iii) the mark itself appears to offer the opponent its best

prospect of success in terms of the assessment of the similarity of the marks and iv) the evidence in support of the claimed reputation shows use of that mark. I will proceed on that basis.

Section 5(2)(b)

23) Sections 5(2)(b) and 47 of the Act provide:

“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.”

“47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).”

24) The leading authorities which guide me are from the Court of Justice of the European Union (‘CJEU’): *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.

The principles

(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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

25) In the judgment of the CJEU in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment 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”.

26) 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 users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

27) In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria 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 General Court 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 that the responsibility for those goods lies with the same undertaking”.

28) In *Sanco SA v OHIM*, Case T-249/11, the General Court (‘GC’) indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

29) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05 (*Merici*), 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 fur 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”.

30) The opponent’s strongest case lies with its goods in classes 07 and 11 which are underlined in the following table. On that basis, the goods to be compared are:

Opponent’s goods	Applicant’s goods
<p>Class 07: <u>Laundry machines</u> for domestic and industrial use, especially washing machines, laundry washing machines, washing machines with a disinfectant program, washing machines with a sterilizing program, washing machines and spin-dryers for laundry, spin dryers, ironing machines, heated mangles for laundry, electrically driven smoothing presses, <u>dish washing machines</u> for domestic and industrial use, especially dish washers, dish washers for use in hotels, laboratories, hospitals, homes and doctors' practices, washers for medical apparatus, washers with a disinfectant program, washers with a sterilizing program; electric motors,</p>	<p>Class 07: Food processors; Food processors (electric-) for domestic use; Beverage preparation machines, electromechanical; Wringing machines for laundry; Mixing machines; Dishwashers; Coffee grinders, other than hand-operated; Electric fruit presses for household use; Spin driers [not heated]; Washing machines [laundry]; Agitators.</p>

blowing machines (air-suction machines), pumps for washing machines or dish washers; milking machines, electrical kitchen apparatus for chopping, grinding, squeezing, electric tin openers; parts included in class 7 for all the aforementioned goods.

Class 11: Apparatus for heating, steam generating, cooking, refrigerating, freezing, ventilating and water supply, especially ovens (electric, gas), cookers, stoves, cooking appliances (electric), cooking apparatus and installations, hobs, cooking rings, hot plates, muffle furnaces, boilers, microwave ovens, grilling apparatus and equipment (electric, gas), deep fryers (electric); extractor hoods, ventilation hoods, air conditioning apparatus and installations, filters (parts of domestic or industrial installations); refrigerating appliances, refrigerating installations, refrigerators, freezing appliances, freezing installations, upright freezers, chest freezers, beverage cooling apparatus, ice boxes, ice machines and apparatus; drying machines for laundry, machines for drying laundry, electrically driven laundry dryers, especially drum-type dryers for laundry, electrical drying cabinets for laundry; parts included in class 11 for all the aforesaid goods.

Class 11: Autoclaves [electric pressure cookers]; Microwave ovens [cooking apparatus]; Refrigerating cabinets; Freezers; Ice machines and apparatus; Refrigerators; Refrigerating display cabinets [display cases]; Air conditioning installations; Air purifying apparatus and machines; Fans (Electric -) for personal use.

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31) I will deal first with the applicant's goods in class 07. The applicant's 'Food processors; Food processors (electric-) for domestic use; Beverage preparation machines, electromechanical; Coffee grinders, other than hand-operated; electric fruit presses for household use' fall within the opponent's 'electrical kitchen apparatus for chopping, grinding, squeezing'. These goods are identical in accordance with *Meric*.

32) The applicant's 'Wringing machines for laundry; Spin driers [not heated]; Washing machines [laundry]' fall within the opponent's 'Laundry machines' and are therefore identical.

33) The applicant's 'dishwashers' are identical to the opponent's 'dish washing machines'.

34) The applicant's 'agitators' fall within the opponent's 'parts included in class 7 for all of the aforementioned goods' as the latter term would cover agitators for washing machines (for example).

35) The applicant's 'mixing machines', which I understand to mean food mixers, have an obvious similarity in purpose with the opponent's 'electrical kitchen apparatus for chopping, grinding and squeezing'. Their respective methods of use are likely to be similar and the trade channels are likely to be the same. The respective goods are highly similar.

36) I now turn to the applicant's goods in class 11. The applicant's 'Autoclaves [electric pressure cookers]; Microwave ovens [cooking apparatus]; Refrigerating cabinets; Freezers; Ice machines and apparatus; Refrigerators; Refrigerating display cabinets [display cases]' fall within the opponent's 'Apparatus for heating, steam generating, cooking, refrigerating, freezing' and are therefore identical.

37) The applicant's 'Air conditioning installations; Air purifying apparatus and machines' fall within the opponent's 'air conditioning apparatus and installations' and are therefore identical.

38) The applicant's 'Fans (Electric -) for personal use' are highly similar, if not identical, to the opponent's 'air conditioning apparatus and installations' given the obvious similarity in nature (air conditioning apparatus being likely to consist of, or incorporate, a fan element), intended purpose, method of use and trade channels.

Average consumer and the purchasing process

39) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

40) The goods at issue are, generally speaking, household appliances including washing machines, dishwashers and goods for cooking, preparing food, refrigerating and freezing. The average consumer is the general public. The majority of the goods are likely to be purchased infrequently and are likely to be not insignificant in terms of cost. Factors such as size, ease of use and practicality may all be taken into account. Bearing all of these factors in mind, I would expect at least an average degree of attention to be paid by the average consumer during the purchase. The goods are likely to be selected from retail displays or from photographs on websites and such that the purchase is likely to be primarily a visual. However, the potential

for aural use of the marks is also borne in mind such as during discussions with sales representatives.

Comparison of marks

41) 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.”

It would therefore be wrong, artificially, to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

Miele v **Damiele**

42) The overall impression of each mark lies in the whole; neither naturally breaks down into more than one element.

43) Visually, the marks coincide in respect of the letters m-i-e-l-e being the only letters in the opponent's mark and the last five letters of the applicant's mark. A point of visual difference arises due to the letters D-a at the beginning of the applicant's

mark which are absent from the opponent's mark. I find there to be a medium degree of visual similarity. Aurally, the 'Da' sound at the beginning of the applicant's mark has no counterpart in the opponent's mark. However, the manner in which the opponent's mark and the –miele part of the applicant's mark are spoken may be the same or, if not, highly similar. There is a medium degree of aural similarity. Both marks are likely to be perceived as invented words or perhaps as foreign words with an unknown meaning; either way, the conceptual position is effectively neutral as neither mark is likely to create a clear and immediate conceptual hook in the consumer's mind.

Distinctive character of the earlier mark

44) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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 *WindsurfingChiemsee 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).”

45) As I stated earlier, Miele is likely to be perceived as either an invented word or one of foreign origin with an unknown meaning. It neither describes nor alludes to the goods covered by the registration in any way. I find that it has a high degree of inherent distinctiveness.

46) I now turn to the question of whether the mark’s inherent distinctiveness has been elevated in the UK through the use made of it. Turnover and marketing figures in the UK for the ten years preceding the application date of the contested mark have been consistently substantial and have steadily increased year on year over that period. Turnover for the year 2014, for example, was £137 million and marketing spend for the same year was £6 million. Examples of advertising under the mark in numerous widely distributed UK publications have been provided such as in the Daily Telegraph newspaper and Good House Keeping magazine. A wide variety of home appliances bearing the mark have been sold through major UK high street retailers such as John Lewis and Argos and the Miele brand has won numerous awards such as “Best Home Appliance Brand” in the 2015 Which? awards. None of the evidence has been challenged by the applicant. I find that the earlier mark has been used to such an extent in the UK that its distinctiveness has been elevated to a very high degree in relation to all of the opponent’s goods which I found to be identical or highly similar to the applicant’s goods.

Likelihood of confusion

47) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must

rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

48) I remind myself that I have found either identity or a high degree of similarity between the parties' goods and that the earlier mark has a very high degree of distinctiveness. Both of the latter factors weigh heavily in the opponent's favour. In terms of the marks, I found a medium degree of visual and aural similarity and that the conceptual position is effectively neutral. Weighing these factors against each other, but keeping in mind that at least an average degree of attention is likely to be paid during the mainly visual purchase, I come to the view that, notwithstanding the potential for imperfect recollection, there is no likelihood of direct confusion. Neither do I consider that the circumstances are such as to give rise to a likelihood of indirect confusion. The ground under section 5(2)(b) fails.

Section 5(3)

49) Section 5(3) of the Act provides:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

50) The leading cases in assessing a claim under section 5(3) of the Act are the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

- (a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.
- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the later mark would cause an average consumer to bring the earlier mark to mind; *Adidas Saloman, paragraph 29 and Intel, paragraph 63*.
- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*
- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.
- (f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious likelihood that this will happen in future; *Intel, paragraphs 76 and 77*.

- (g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.
- (h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L’Oreal v Bellure NV, paragraph 40*.
- (i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court’s answer to question 1 in L’Oreal v Bellure*).

Reputation

51) The required level of reputation was described by the CJEU in *General Motors* in the following way:

“23. ... In so far as Article 5(2) of the Directive, unlike Article 5(1), protects trade marks registered for non-similar products or services, its first condition implies a certain degree of knowledge of the earlier trade mark among the public. It is only where there is a sufficient degree of knowledge of that mark that the public, when confronted by the later trade mark, may possibly make an association between the two trade marks, even when used for non-similar

products or services, and that the earlier trade mark may consequently be damaged.

24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

52) I have already commented earlier in this decision on the use that has been made of the opponent’s European **miele** mark. It has been longstanding use throughout the UK for a variety of home appliances. Advertising and promotional spend has been significant with adverts in wide reaching UK newspapers and magazines. In *Pago International GmbH v Tirolmilch registrierte GmbH*¹ the CJEU held that a reputation in a single member state may be sufficient to constitute the required reputation in “*a substantial part of the territory of the Community*”. I find that the **miele** mark had a strong reputation in the UK at the date of filing of the opposed application for the goods covered by its mark underlined in the table at paragraph 30 above. I also find that that reputation qualified as a reputation in the community (or,

¹ Case C-301/07

as it is now known, the EU) at the relevant date. The evidence shows that the nature of that reputation is one of high-end, superior quality domestic appliances. This is borne out by a numerous aspects of the evidence such as the Which? Awards for 'Best Domestic Appliance Brand' given to the opponent's Miele brand in 2007, 2008, 2010, 2012 and 2015 and newspaper articles such as that from 'The Independent' which describes the opponent's Miele mark as being a "premium German brand".

The link

53) In addition to having a reputation, a link must be made between the applicant's trade mark and the earlier mark. In *Adidas-Salomon*, the CJEU stated:

"The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23). The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, *SABEL*, paragraph 22, and *Marca Mode*, paragraph 40)."

54) In *Intel* the CJEU provided further guidance on the factors to consider when assessing whether a link has been established. It stated:

"41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case..."

42 Those factors include:

–the degree of similarity between the conflicting marks;

- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public”.

55) Most of the above factors have already been assessed under section 5(2)(b). As to the first factor, I have found that the marks are visually and aurally similar to a medium degree and are effectively, conceptually neutral. As to the second factor, the respective goods are either identical or highly similar. In respect of the third and fourth factors, the opponent’s mark has a strong reputation and a high degree of inherent distinctiveness which has been elevated to a very high degree through the use made of it. Finally, as regards the fifth factor, I found there to be no likelihood of confusion.

56) Carefully weighing all of the abovementioned factors against each other, I come to the view that the similarities that exist between the marks, together with the strong reputation and very high degree of distinctiveness of the earlier mark and the identity/high degree of similarity between the respective goods will result in the relevant public bringing the opponent’s mark to mind when encountering the applicant’s goods bearing the contested mark. In other words, a link will be made.

Unfair advantage

57) There is no evidence to suggest that the applicant chose the subject trade mark with the intention of exploiting the opponent’s reputation. However, I note that in *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.” (my emphasis)

58) I find that there is a non-hypothetical risk that the link consumers will make between the respective marks will result in the positive characteristics associated with the earlier mark, namely the mark's reputation for high end, superior quality domestic appliances transferring to the applicant's mark. The consumer may, for instance, wonder whether they can expect the same level of quality from the applicant's goods which might make them more inclined to try them. This association with the opponent's reputed mark would give the applicant more custom it would not otherwise have enjoyed and make its job of marketing its goods easier. As this would come without paying any compensation to the opponent, and without the applicant expending the money necessary to create a market for its own goods and services in the UK, this is unfair advantage. The applicant has not pleaded any 'due cause' defence. The ground under section 5(3) succeeds.

59) Having reached this conclusion, I do not consider it necessary to consider the other heads of damage under this ground or the claim under section 5(4)(a) as they do not put the opponent in any stronger position.

COSTS

60) As the opponent has been successful, it is entitled to a contribution towards the costs it has incurred in these proceedings. Using the guidance in Tribunal Practice Notice 4/2007 (which was in force at the time of commencement of these proceedings), I award the opponent costs on the following basis:

Preparing a statement and considering the counterstatement	£200
Official fee	£200
Preparing evidence	£500
Written Submissions	£300
Total:	£1200

61) I order UK Damiele Co., Limited to pay Miele & Cie KG the sum of **£1200**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 23rd day of August 2017

Beverley Hedley
For the Registrar,
the Comptroller-General