

O/629/19

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001386331
DESIGNATING THE UNITED KINGDOM
IN THE NAME OF UTOPIA TOWELS INC.:

Utopia Kitchen

IN CLASSES 8 AND 21

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 413630 BY
UTOPIA TABLEWARE LIMITED

BACKGROUND AND PLEADINGS

1. International trade mark 1386331 (“the IR”) consists of the following sign:

Utopia Kitchen

2. The holder is Utopia Towels Inc. The IR is registered with effect from 13 October 2017. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The holder seeks protection for the mark in relation to:

Class 8 Can openers; cleavers; cutlery; flatware, namely, forks, knives, and spoons; hand-operated choppers; hand-operated slicers; kitchen knives; knife sharpeners; non-electric fruit peelers; non-electric vegetable peelers; pizza cutters; scissors for kitchen use; tool aprons.

Class 21 Bakeware; bowls; cheese graters; citrus squeezers; coffee cups; compost containers for household use; containers for household or kitchen use not of precious metal; containers for household or kitchen use of precious metal; cookware, namely, pots and pans; cutting boards for the kitchen; drinking straws; garlic presses; graters for kitchen use; hand-operated grinders; household utensils, namely, kitchen tongs; household utensils, namely, spatulas; household utensils, namely, strainers; household utensils, namely, turners; kitchen containers; kitchen ladles; kitchen mitts; kitchen utensils, namely, pouring and straining spouts; kitchen utensils, namely, splatter screens; knife blocks; non-electric coffee makers; non-electric deep fryers; non-electric fruit squeezers; non-electric griddles; oven mitts; skilletts; whisks; woks; non-electric garlic peelers.

3. The word “KITCHEN” is disclaimed. The request to protect the IR in the UK was published for opposition purposes on 6 July 2018. Utopia Tableware Limited (“the

opponent”) opposed the protection of the IR in the UK based upon sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

4. For the purposes of its opposition based upon section 5(2)(b) of the Act, the opponent relies upon UK registration no. 3173711 for the following trade mark:



5. The opponent’s mark was filed on 8 July 2016 and registered on 14 October 2016. The opponent relies upon all goods for which the mark is registered, namely:

Class 8 Hand tools and implements (hand operated); cutlery; tableware (knives, forks and spoons); silverware [cutlery, forks and spoons]; canteens of cutlery.

Class 21 Household or kitchen utensils and containers (not of precious metal or coated therewith); tableware; vitrified tableware; dinnerware; crockery; plates; dinner plates; side plates; bowls; dishes; mugs; cups; saucers; bowls; condiments containers, shakers and pots; coffee-pots; table mats; trays for household purposes; knife rests; pans; cookers (non-electric); kettles (non-electric); napkin rings and ice pails (not of precious metal); unworked or semi-worked glass (except glass used in building); glasses (receptacles); tumblers; decanters; jugs; bottles; works of art, of crystal, porcelain, terracotta or glass; glassware; porcelain ware; porcelain products; crystal [glassware]; earthenware products; ceramic products; stoneware products.

6. The opponent claims that there is a likelihood of confusion because the respective marks are similar, and the goods are identical or similar.

7. For the purposes of its opposition based upon section 5(4)(a) of the Act, the opponent relies on the following signs:

Utopia Tableware

The opponent claims use throughout the UK since 2001 in respect of the following class 21 goods and since 2006 in respect of the following class 8 goods:

Class 8 Cutlery; flatware namely knives, forks and spoons; kitchen knives; steak knives; dessert spoons; soup spoons; tea spoons; coffee spoons; butter knives; dessert knives, forks and spoons.

Class 21 Tableware; dinnerware; crockery; plates; dinner plates; side plates; bowls; dessert bowls; sugar bowls; dip pots; dishes; mugs; mixing bowls; cups; saucers; bowls; mugs; teapots; jugs; condiments containers, shakers and pots; coffee-pots; trays for household purposes; cutting boards for the kitchen; household utensils, namely, kitchen tongs, spatulas, strainers, turners, servers; serving scoops; ladles; slotted spoons; pans; skillets; platters; ice pails (not of precious metal); glasses (receptacles); tumblers; decanters; jugs; bottles; glassware; porcelain ware; porcelain products; crystal [glassware]; ceramic products; gravy boats; stoneware products; drinking straws; water bottles; salt cellars; pepper cellars; salt mills; pepper mills; ramekins; casserole dishes; chargers [serving plates]; glass bottles; vinegar bottles; oil bottles; carafes; vitrified tableware; tumblers; cocktail strainers; bar scoops; wine buckets; beer glasses; wine glasses; tankards; goblets; flutes; cocktail glasses; conical flasks [barware]; beakers [barware]; cocktail shakers; shot glasses; barware; lemon slice squeezers; pitchers; glass flasks; pots; covers for dishes; plate covers; squeeze bottles; brushes; baskets; storage baskets; candle holders; night light holders; cloches; butter dishes; cake plates; 3-tier cake plates; footed cake stands; wire baskets [cooking utensils]; wire baskets [serveware];

bottle stoppers; pourers; wooden serving boards; melamine serveware; bamboo shot paddles; serving trays; vases; fish bowls; ice cream scoops; egg cups; butter dishes; cup/glass racks; bar caddy/tydy; punch barrels.

utopia

The opponent claims use throughout the UK since 2001 in respect of the following class 21 goods and since 2006 in respect of the following class 8 goods:

Class 8 Cutlery; flatware namely knives, forks and spoons; kitchen knives; steak knives; dessert spoons; soup spoons; tea spoons; coffee spoons; butter knives; dessert knives, forks and spoons; fish forks; fish knives; sporks, latte spoons; cake forks; silverware [cutlery, forks and spoons]; children's cutlery; pizza cutters; corkscrews; hand-operated choppers; hand-operated slicers; knife sharpeners.

Class 21 Household or kitchen utensils; tableware; cookware and containers; containers for household or kitchen use not of precious metal; containers for household or kitchen use of precious metal; tableware; vitrified tableware; dinnerware; crockery; plates; dinner plates; side plates; bowls; dessert bowls; sugar bowls; dip pots; dishes; mugs; mixing bowls; cups; saucers; bowls; mugs; espresso cups; teapots; jugs; condiments containers, shakers and pots; coffee-pots; latte glasses; table mats; trays for household purposes; cutting boards for the kitchen; household utensils, namely, kitchen tongs, spatulas, strainers, turners, servers; serving scoops; ladles; slotted spoons; pans; skillets; platters; ice pails (not of precious metal); glasses (receptacles); tumblers; decanters; jugs; bottles; glassware; porcelain ware; porcelain products; crystal [glassware]; earthenware products; ceramic products; gravy boats; stoneware products; drinking straws; water bottles; salt cellars; pepper

cellars; salt mills; pepper mills; ramekins; casserole dishes; chargers [serving plates]; glass bottles; vinegar bottles; oil bottles; carafes; tumblers; cocktail strainers; bar scoops; wine buckets; beer glasses; wine glasses; tankards; goblets; flutes; cocktail glasses; conical flasks [barware]; beakers [barware]; cocktail shakers; shot glasses; barware; lemon slice squeezers; pitchers; glass flasks; pots; pans; covers for dishes; plate covers; squeeze bottles; brushes; baskets; storage baskets; candle holders; night light holders; cloches; butter dishes; cake plates; 3-tier cake plates; footed cake stands; wire baskets [cooking utensils]; wire baskets [serveware]; bottle stoppers; pourers; wooden serving boards; melamine serveware; bamboo shot paddles; serving trays; vases; fish bowls; ice cream scoops; egg cups; butter dishes; cup/glass racks; bar caddy/tidy; punch barrels.

8. The holder filed a counterstatement denying the grounds of opposition.

9. The opponent is represented by Franks & Co Limited and the holder is represented by Withers & Rogers LLP. The opponent filed evidence in the form of the witness statement of Kathryn Ann Oldershaw dated 6 February 2019. The holder filed written submissions during the evidence rounds. The opponent did not file evidence in reply. No hearing was requested, and both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE

10. The witness statement of Ms Oldershaw was accompanied by 11 exhibits. Ms Oldershaw is a Director of the opponent; a position she has held since September 2000.

11. Ms Oldershaw has provided the following sales figures for **utopia** branded goods in the UK:¹

¹ Witness Statement of Kathryn Ann Oldershaw, para. 12

| | | | |
|------|------------|------|-------------|
| 2005 | £524,126 | 2012 | £5,790,764 |
| 2006 | £1,089,530 | 2013 | £7,082,222 |
| 2007 | £1,626,589 | 2014 | £7,927,198 |
| 2008 | £2,440,809 | 2015 | £8,963,797 |
| 2009 | £3,462,468 | 2016 | £9,195,690 |
| 2010 | £6,404,894 | 2017 | £10,321,092 |
| 2011 | £5,997,701 | 2018 | £11,073,453 |

12. Ms Oldershaw has given these figures broken down by the particular item to which they relate.² However, these specific sales figures are subject to a confidentiality order dated 26 March 2019. It is clear that the opponent has used the **utopia** sign in relation to a range of cutlery, kitchen utensils, cookware, tableware and drinkware.

13. Ms Oldershaw has provided the following sales figures for **Utopia Tableware** branded goods in the UK:³

| | | | |
|------|------------|------|------------|
| 2005 | £13,871 | 2012 | £1,695,508 |
| 2006 | £375,834 | 2013 | £2,189,807 |
| 2007 | £930,961 | 2014 | £2,345,534 |
| 2008 | £1,105,952 | 2015 | £2,698,330 |
| 2009 | £1,137,585 | 2016 | £2,530,521 |
| 2010 | £1,979,420 | 2017 | £2,919,039 |
| 2011 | £1,581,108 | 2018 | £2,643,942 |

14. Again, Ms Oldershaw has provided these figures broken down by the particular item to which they relate.⁴ However, these are also subject to the confidentiality order referred to above. Nonetheless, it is clear that the opponent has used the sign **Utopia Tableware** in relation to a range of cutlery, kitchen utensils, cookware, tableware and drinkware.

² Confidential exhibit KAO02

³ Witness Statement of Kathryn Ann Oldershaw, para. 14

⁴ Confidential exhibit KAO03

15. Ms Oldershaw has provided a range of images which she states show use of the signs **utopia** and **Utopia Tableware** on goods in the period 2005 to present.⁵ Examples of these are as follows:



16. Ms Oldershaw has also provided a range of invoices dated between June 2005 and May 2018.⁶ These are also subject to the confidentiality order referred to above. Ms Oldershaw states that these relate to goods sold under the mark and, indeed, the later invoices display the earlier mark relied upon by the opponent.

17. Ms Oldershaw confirms that the opponent’s marketing and advertising expenditure in relation to **Utopia Tableware** and **utopia** amounts to:⁷

| | | | |
|------|----------|------|----------|
| 2002 | £11,162 | 2011 | £223,875 |
| 2003 | £16,077 | 2012 | £301,303 |
| 2005 | £81,719 | 2013 | £231,389 |
| 2006 | £102,351 | 2014 | £311,937 |
| 2007 | £93,660 | 2015 | £258,912 |
| 2008 | £124,887 | 2016 | £266,361 |
| 2009 | £119,020 | 2017 | £322,593 |

⁵ Exhibit KAO04 and KAO05

⁶ Confidential exhibit KAO06

⁷ Witness Statement of Kathryn Ann Oldershaw, para. 30

2010 £129,960 2018 £260,206

18. Ms Oldershaw has provided a range of print outs from the opponent's website dating back to 2007 which show the word UTOPIA in use in a range of variants.

19. The opponent's evidence was accompanied by written submissions. The holder filed submissions in reply during the evidence rounds and both the opponent and the holder also filed written submissions in lieu. Whilst I do not propose to summarise those submissions here, I have taken them into consideration and will refer to them in my decision where necessary.

DECISION

Section 5(2)(b)

20. Section 5(2)(b) of the Act reads as follows:

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

(a) [...]

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

21. The opponent's mark qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark completed its registration process less than 5 years before the UK publication date of the IR in issue in these proceedings, it is not subject to proof of use pursuant to section 6A of the Act.

22. The following principles are 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 greater 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 to mind the earlier mark, 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

23. The competing goods are as follows:

| Opponent's goods | Holder's goods |
|---|--|
| <p><u>Class 8</u> Hand tools and implements (hand operated); cutlery; tableware (knives, forks and spoons); silverware [cutlery, forks and spoons]; canteens of cutlery.</p> <p><u>Class 21</u> Household or kitchen utensils and containers (not of precious metal or coated therewith); tableware; vitrified tableware; dinnerware; crockery; plates;</p> | <p><u>Class 8</u> Can openers; cleavers; cutlery; flatware, namely, forks, knives, and spoons; hand-operated choppers; hand-operated slicers; kitchen knives; knife sharpeners; non-electric fruit peelers; non-electric vegetable peelers; pizza cutters; scissors for kitchen use; tool aprons.</p> <p><u>Class 21</u></p> |

| | |
|--|---|
| <p>dinner plates; side plates; bowls; dishes; mugs; cups; saucers; bowls; condiments containers, shakers and pots; coffee-pots; table mats; trays for household purposes; knife rests; pans; cookers (non-electric); kettles (non-electric); napkin rings and ice pails (not of precious metal); unworked or semi-worked glass (except glass used in building); glasses (receptacles); tumblers; decanters; jugs; bottles; works of art, of crystal, porcelain, terracotta or glass; glassware; porcelain ware; porcelain products; crystal [glassware]; earthenware products; ceramic products; stoneware products.</p> | <p>Bakeware; bowls; cheese graters; citrus squeezers; coffee cups; compost containers for household use; containers for household or kitchen use not of precious metal; containers for household or kitchen use of precious metal; cookware, namely, pots and pans; cutting boards for the kitchen; drinking straws; garlic presses; graters for kitchen use; hand-operated grinders; household utensils, namely, kitchen tongs; household utensils, namely, spatulas; household utensils, namely, strainers; household utensils, namely, turners; kitchen containers; kitchen ladles; kitchen mitts; kitchen utensils, namely, pouring and straining spouts; kitchen utensils, namely, splatter screens; knife blocks; non-electric coffee makers; non-electric deep fryers; non-electric fruit squeezers; non-electric griddles; oven mitts; skillets; whisks; woks; non-electric garlic peelers.</p> |
|--|---|

24. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, 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.”

25. Guidance on this issue has also 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.

26. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

27. 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 Harmonisation 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.”

28. In *Sanco SA v OHIM*, Case T-249/11, the 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 Amalia Mary Elliot v LRC Holdings Limited* BL-O-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.”

Class 8

29. The holder admits that “cutlery” and “flatware namely, forks, knives, and spoons” in its own specification are identical to the opponent’s goods.

30. “Can openers”, “hand-operated choppers”, “hand-operated slicers”, “knife sharpeners”, “non-electric fruit peelers”, “non-electric vegetable peelers”, “pizza cutters” and “scissors for kitchen use” in the holder’s specification will all fall within the broader term “hand tools and implements (hand operated)” in the opponent’s specification. These goods are, therefore, identical on the principle outlined in *Meric*. If I am wrong in this finding, then these goods will all overlap in trade channels, use and nature with the opponent’s other class 8 goods. They will, therefore, be similar to at least a medium degree.

31. “Cleavers” and “kitchen knives” in the holder’s specification will also, in my view, fall within the term “hand tools and implements (hand operated)” in the opponent’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*. However, if I am wrong in this finding then they will overlap in nature, use, method of use, trade channels and user with “tableware (knives [...])” in the opponent’s specification. These goods will be highly similar.

32. “Tool aprons” in the holder’s specification will overlap in user with “hand tools and implements (hand operated)” in the opponent’s specification. There may be a degree of overlap in trade channels. The goods will clearly differ in nature, method of use and purpose. They are complementary. I consider the goods to be similar to a medium degree.

Class 21

33. The holder admits that “bowls”, “compost containers for household use”, “containers for household or kitchen use not of precious metal” and “pots and pans” in its own specification are identical to the opponent’s goods.

34. “Cheese graters”, “citrus squeezers”, “garlic presses”, “graters for kitchen use”, “hand-operated grinders”, “household utensils, namely, kitchen tongs”, “household utensils, namely, spatulas”, “household utensils, namely, strainers”, “household utensils, namely, turners”, “kitchen containers”, “kitchen ladles”, “kitchen utensils, namely, pouring and straining spouts”, “kitchen utensils, namely, splatter screens”, “non-electric fruit squeezers”, “whisks” and “non-electric garlic peelers” in the holder’s

specification all fall within the broader category of “Household or kitchen utensils and containers (not of precious metal or coated therewith)” in the opponent’s specification. These goods can be considered identical on the principle outlined in *Meric*.

35. “Coffee cups” in the holder’s specification falls within the broader category of “cups” in the opponent’s specification. These goods can be considered identical on the principle outlined in *Meric*.

36. “Bakeware” in the holder’s specification covers goods used in baking such as tins and trays. In my view, it would also cover mixing bowls used for baking. Consequently, “bowls” and “trays for household purposes” in the opponent’s specification would fall within this broader category and can be considered identical on the principle outlined in *Meric*. If I am wrong, then there will be overlap in trade channels, user, nature and purpose and the goods will be highly similar.

37. “Containers for household or kitchen use of precious metal” in the holder’s specification will overlap in trade channels, user, method of use and purpose with the opponent’s “household or kitchen utensils and containers (not of precious metal or coated therewith)”. The only real difference between the goods is the material with which they are made. In my view, these goods are in competition with each other. I consider them to be highly similar.

38. “Non-electric deep fryers” and “non-electric griddles” in the holder’s specification are both types of non-electric cookers. They will, therefore, fall within the broader category of “cookers (non-electric)” in the opponent’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

39. A skillet and a wok are both types of frying pans used in cooking. Consequently “skillets” and “woks” in the holder’s specification will fall within the broader category of “pans” in the opponent’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

40. A knife block is typically a piece of wood or other material which is used to store knives when they are not being used. The purpose of “knife blocks” in the holder’s

specification, therefore, overlaps with “knife rests” in the opponent’s specification. They will be similar in nature and method of use and are likely to be sold to the same users through the same trade channels. I consider these goods to be highly similar.

41. “Coffee-pots” in the opponent’s specification would cover cafetières which enable coffee to be brewed without the need for electricity. Consequently, I consider these goods to be identical to “non-electric coffee makers” in the holder’s specification.

42. “Cutting boards for the kitchen”, “drinking straws”, “kitchen mitts” and “oven mitts” are all kitchenware goods that would be sold by businesses specialising in kitchen utensils and other household items. There will, therefore, be overlap in trade channels and user with the opponent’s “household or kitchen utensils and containers (not of precious metals)”. There may be a degree of complementarity between them. Consequently, I consider these goods to be similar to a medium degree.

The average consumer and the nature of the purchasing act

43. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which these goods are likely to be selected by the average consumer. 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.”

44. The holder states that the average consumer for the goods will be a member of the general public or a professional in the food industry. I agree. The frequency of

purchase of the goods and their cost is likely to vary significantly. For example, drinking straws are likely to be purchased reasonably frequently and will be of low cost, whereas some kitchen utensils or bakeware items will be purchased less frequently and will be of higher cost, particularly where they are purchased for industrial use (although they are unlikely to be highly expensive). Generally, a number of factors will be taken into account when purchasing the goods such as material, suitability for the user's purpose and ease of use. Overall, I consider that a medium degree of attention will be paid during the purchasing process, although I recognise that a lower degree of attention may be paid for some goods (such as drinking straws).

45. The goods are most likely to be obtained by self-selection from the shelves of a retail outlet or from an online or catalogue equivalent. The purchasing process is likely, therefore, to be predominantly visual. However, given that advice may be sought from a sales assistant or orders may be placed by telephone, I do not discount that there may also be an aural component to the purchase of the goods.

Comparison of trade marks

46. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade 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.”

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

48. The respective trade marks are shown below:

| Opponent's trade mark | Holder's trade mark |
|---|--|
|  | <p data-bbox="858 797 1342 875">Utopia Kitchen</p> |

49. The opponent's mark consists of the word UTOPIA presented in lowercase with a circular disc device above it, overlaid with the image of a knife and fork. The presence of the knife and fork in the device indicates the type of goods offered by the opponent. Taking this into account and the fact that the eye is naturally drawn to the wording, the word UTOPIA will play a greater role in the overall impression for many of the goods. The holder's mark consists of the words UTOPIA KITCHEN, presented in title case. Given the descriptive nature of the word KITCHEN in relation to many of the goods for which the holder's mark is registered, the word UTOPIA will play the greater role in the overall impression. Where the word KITCHEN is not descriptive, the words will play a roughly equal role.

50. Visually, the marks coincide in the presence of the word UTOPIA which is identical in both marks. The points of visual difference are the presence of the device in the opponent's mark and the word KITCHEN in the holder's mark (although, as noted above, UTOPIA will play a greater role in the overall impression for many of the goods). The marks are also presented in different fonts but given that word only marks can be

used in any standard typeface, this is not a point of significant difference. I consider that the marks are visually similar to between a medium and high degree.

51. Aurally, the marks coincide in the pronunciation of the word UTOPIA which will be identical in both marks. Given that the word KITCHEN will be descriptive of the type of goods sold under the mark it may not be pronounced by the average consumer. Clearly, the device in the opponent's mark will also not be pronounced. In this case, the marks will be aurally identical. If the word KITCHEN in the holder's mark is pronounced, then the marks will be aurally similar to between a medium and high degree.

52. Conceptually, the word UTOPIA will be given the same meaning in both marks. The word KITCHEN will be viewed as descriptive of the type of many of the goods sold under the holder's mark and will not, therefore, add anything significant to the conceptual meaning conveyed by the mark. Similarly, the device in the opponent's mark which is overlaid with the image of a knife and fork is also likely to be seen as indicating the type of goods sold under the mark. Overall, I consider the marks to be conceptually highly similar.

Distinctive character of the earlier trade mark

53. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in *Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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).”

54. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

55. The opponent’s evidence is, in my view, insufficient to demonstrate enhanced distinctiveness of the earlier mark through use. Whilst I recognise that the advertising expenditure is not insignificant, no market share figures have been provided and, in my view, the sales figures shown do not represent a significant market share in what must be an extensive market.

56. I have, therefore, only the inherent position to consider. The opponent’s mark consists of the word UTOPIA which is an ordinary dictionary word. However, it has no connection with the goods for which the mark is registered. In my view, the word UTOPIA is inherently distinctive to at least a medium degree and this is increased further by the addition of the device in the mark.

Likelihood of confusion

57. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible

undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective goods and services may be offset by a greater degree of similarity between the marks and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

58. Direct and indirect confusion were described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

59. I have found the parties' marks to be visually similar to a medium to high degree, aurally similar to between a medium and high degree or identical. They are conceptually highly similar. I have found the opponent's mark to have a higher than medium degree of inherent distinctive character. I have identified the average consumer to be a member of the general public or a professional in the food industry who will select the goods primarily by visual means (although I do not discount an

aural component). I have concluded that the level of attention paid during the purchasing process will generally be medium, although I recognise that it may be lower for some goods. I have found the parties' goods to vary from identical to similar to a medium degree.

60. Where the average consumer perceives the device in the opponent's mark and the word KITCHEN as indicating the type of goods sold under the mark, it will be the word UTOPIA that acts as a hook in the mind of the consumer. Taking into account the principle of imperfect recollection, I consider that the marks may be misremembered or mistakenly recalled as each other. I consider there to be a likelihood of direct confusion.

61. If the differences between the marks are recognised and recalled, I consider that the average consumer is likely to view them as alternative marks used by the same or economically linked undertakings. In my view, the use of the word UTOPIA in both marks will be viewed as identifying goods sold by the same or linked businesses. I consider there to be a likelihood of indirect confusion.

62. The opposition under section 5(2)(b) is successful in its entirety.

Section 5(4)(a)

63. Section 5(4)(a) of the Act states as follows:

“5(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, or

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”.

64. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

65. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of section 5(4)(a) of the Act and concluded as follows:

“43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceeding as follows:

“Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about,

and then to assess whether the position would have been any different at the later date when the application was made.””

66. There is no suggestion that the holder had used its mark prior to the date of the application for protection in the UK. The relevant date for assessing whether section 5(4)(a) applies is, therefore, the date of the application for protection in the UK i.e. 13 October 2017.

Goodwill

67. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in customers. It is the one thing which distinguishes an old-established business from a new business at its first start.”

68. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

69. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

70. Goodwill arises as a result of trading activities. Whilst I do not consider that the opponent's evidence is sufficient to demonstrate enhanced distinctiveness in the UK, I am satisfied that it does demonstrate goodwill. Clearly there has been trading with the effect that goodwill will, undoubtedly, have been generated in relation to a range of cutlery, kitchen utensils, cookware, tableware and drinkware. I am also satisfied that the evidence shows that the signs **utopia** and **Utopia Tableware** are distinctive of that goodwill.

Misrepresentation

71. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

72. I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation requires “a substantial number of members of the public are deceived” rather than whether “the average consumers are confused”. However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. I believe that is the case here. I consider that members of the public are likely to be misled into purchasing the holder's goods in the belief that they are the opponent's goods.

Damage

73. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirement for damage in passing off cases like this:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff’s business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff’s goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff’s reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant’s plastic irrigation equipment might be dissuaded from buying one of the plaintiff’s plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.”

74. In *Ewing v Buttercup Margarine Company, Limited*, [1917] 2 Ch. 1 (COA), Warrington L.J. stated that:

“To induce the belief that my business is a branch of another man’s business may do that other man damage in various ways. The quality of goods I sell, the kind of business I do, the credit or otherwise which I enjoy are all things which may injure the other man who is assumed wrongly to be associated with me.”

75. The goods in respect of which the opponent has demonstrated goodwill and the goods for which the holder seeks protection in the UK are similar to at least a medium degree. Many of them will be identical. In a case such as this, where signs that are similar to at least a medium degree are used in relation to goods which are similar to at least a medium degree, damage to the opponent’s business through diversion of sales is easily foreseeable. Damage is made out.

76. The opposition under section 5(4)(a) is successful in its entirety.

CONCLUSION

77. The opposition is successful and the holder's application for protection of the IR in the UK is refused.

COSTS

78. The opponent 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 opponent the sum of **£1,500** as a contribution towards the costs of the proceedings. This sum is calculated as follows:

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|---|---------------|
| Preparing a statement and considering the holder's statement | £300 |
| Preparing evidence, considering the holder's submissions in reply | £700 |
| Preparing written submissions in lieu | £300 |
| Official fee | £200 |
| Total | £1,500 |

79. I therefore order Utopia Towels Inc. to pay Utopia Tableware Limited the sum of £1,500. This sum should 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 18th day of October 2019

S WILSON
For the Registrar