

O/0229/24

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3740463
IN THE NAME OF RONIX (UK) LTD
TO REGISTER THE FOLLOWING TRADE MARK:**

CHEFCHY

IN CLASSES 7, 8, 11 & 21

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 433024
BY DE LONGHI BENELUX SA**

Background and pleadings

1. On 7 January 2022, RONIX (UK) LTD (“the applicant”) applied to register the trade mark **CHEFCHY** in the UK under number 3740463 (“the contested mark”). It was published for opposition purposes on 28 January 2022. Registration is sought for the following goods:

Class 7: Kitchen tools [electric utensils]; electric kitchen machines; kitchen knives (electric -); kitchen machines, electric; utensils (electric -) for stirring liquids; electric kitchen tools; utensils (electric -) for mixing liquids; utensils (electric -) for blending liquids; electric kitchen mixers; electric kitchen appliances for chopping, mixing, pressing; electrical appliances used in kitchen for whisking; mixers [kitchen machines].

Class 8: Knife sharpeners; knife holders; knife bags; knife steels; knife sheaths; knife handles; diving knife holders; knife sharpeners [hand tools]; knife sheaths of leather; knife sharpeners [hand operated tools]; scoring knife for veneer sheets.

Class 11: Cooking appliances; kitchen ranges; appliances for cooking; appliances for heating; kitchen stoves; appliances for cooking foodstuffs; appliances for smoking foodstuffs; appliances for drying hair; electrical appliances for cooking; cooling appliances and installations; electric domestic cooking appliances.

Class 21: Knife blocks; knife rests; knife boards; knife rests for the table; kitchen utensils; molds [kitchen utensils]; spatulas [kitchen utensils]; mixing spoons [kitchen utensils]; aluminium moulds [kitchen utensils]; household or kitchen utensils; kitchen utensils of silicon; cooking utensils; baking utensils; household utensils; dishes [household utensils]; kitchen mitts; kitchen sponges; kitchen containers; basting spoons [cooking utensils]; utensils for household purposes; cooking utensils, non-electric; kitchen paper holders; kitchen grinders, non-electric; household or kitchen containers.

2. On 28 March 2022, De Longhi Benelux SA (“the opponent”) partially opposed the contested mark under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opposed goods are those in classes 7 and 11.

3. For the purposes of its claims under sections 5(2)(b) and 5(3), the opponent relies upon its UK trade mark number 3438050, **CHEF** (“the earlier mark”). The earlier mark was filed on 21 October 2019 and became registered on 20 March 2020. It stands registered in respect of *food mixers; attachments and accessories for food mixers* in class 7.

4. The opponent’s trade mark qualifies as an earlier mark in accordance with section 6 of the Act. As it had not completed its registration process more than five years before the filing date of the contested mark, it is not subject to the proof of use provisions in section 6A of the Act.

5. Under section 5(2)(b), the opponent contends that the parties’ goods are identical or similar. The opponent also claims that the competing marks are similar. Based upon these factors, the opponent submits that there is a likelihood of confusion.

6. Under section 5(3), the opponent claims that the earlier mark has a significant reputation. It submits that this reputation is such that use of the contested mark would, without due cause, take unfair advantage of, and/or be detrimental to, the repute of the earlier mark. The opponent also contends that the relevant public would believe there is an economic connection between the users of the competing marks.

5. As for its claim under 5(4)(a), the opponent claims that it has a protectable goodwill in relation to which it has used the sign **CHEF** in the UK since the 1950s. The goods for which the sign is said to have been used are *food mixers and food preparation equipment and machines; attachments and accessories for the aforesaid goods*. The opponent submits that use of the proprietor’s mark would be contrary to the law of passing off.

6. The applicant filed a counterstatement, denying the grounds of opposition. Whilst it concedes that the parties’ goods are similar, it denies that the competing marks are

similar. In addition, the applicant put the opponent to proof of its claimed reputation and goodwill.

7. The opponent is professionally represented by Mathys & Squire LLP, whereas the applicant represents itself. Only the opponent filed evidence. A hearing was not requested and neither party filed written submissions in lieu of attendance. However, I note that both parties filed written submissions during the evidence rounds. This decision is taken following careful consideration of all the papers before me.

Relevance of EU law

8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence and submissions

9. The opponent's evidence is given in the witness statement of Gary Johnston dated 6 September 2022 and Exhibits GWAJ6-GWAJ29.¹ Mr Johnston is a Chartered Trade Mark Attorney and Partner at the firm representing the opponent, a position he has held since November 2008. He gives evidence as to the use made of the earlier mark and the alleged earlier sign.

10. The opponent and the applicant filed written submissions on 6 September 2022 and 13 April 2023, respectively.

11. I have read all the evidence and submissions and will return to them to the extent I consider necessary in the course of this decision.

¹ Exhibits GWAJ1-GWAJ5 were removed by the opponent to comply with the Registrar's directions regarding the volume of evidence originally filed in these proceedings.

Preliminary remarks

12. Within its written submissions, the applicant states that the evidence shows the parties' products are "totally different", that they have "different functionality", and that the opponent's products are "mechanical" unlike the applicant's. The applicant contends that these factors defeat any possibility of confusion. For reasons I will now explain, these matters will have no material bearing on the outcome of this opposition, nor can they in law.

13. A trade mark registration is essentially a claim to a piece of legal property. Every registered trade mark is entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar goods if there is a likelihood of confusion. Once a trade mark has been registered for five years, section 6A of the Act is engaged and the opponent can be required to provide evidence of use of its mark. Until that point, however, the mark is entitled to protection in respect of the full range of goods for which it is registered.

14. The mark relied upon by the opponent had not been registered for five years at the date on which the contested mark was filed. Consequently, the opponent is not required to prove use of it. The earlier trade mark is entitled to protection against a likelihood of confusion with the contested mark based on the 'notional' use of that earlier mark for the goods listed in the register. The concept of notional use was explained by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 like this:

"22. [...] It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade

in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place”.

15. So far as the applicant's claimed use of the contested mark is concerned, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06), the Court of Justice of the European Union (“CJEU”) stated at paragraph 66 of its judgment that when assessing the likelihood of confusion in the context of registering a new trade mark it is necessary to consider all the circumstances in which the mark might be used if it were registered. As a result, even though the applicant has suggested the goods for which the contested mark will be used, my assessment later in this decision must take into account only the contested mark – and its specification – and any potential conflict with the earlier mark. Any differences between the actual goods provided by the parties are not relevant unless those differences are apparent from the applied-for and registered marks. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

16. Additionally, within its counterstatement and written submissions the applicant highlights three other registered trade marks which contain the word ‘Chef’. However, I must clarify that the existence of other registered marks will not have any bearing on the outcome of these proceedings; their mere existence is not material to whether there is a likelihood of confusion, whether the relevant public will make a link between the competing marks, or whether use of the contested mark constitutes a misrepresentation. This is because there is no evidence that the marks are in use and

that consumers have become accustomed to differentiating between them.² Whether parties are able to coexist, notwithstanding the existence of any similar registrations, is a matter for those parties.

Section 5(2)(b)

Legislation and case law

17. Sections 5(2)(a) and 5A of the Act read as follows:

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

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

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

18. 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:

² See *Zero Industry Srl v OHIM*, Case T-400/06

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

19. In comparing the parties' specifications, all relevant factors should be considered, as per *Canon*, in which the CJEU stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, [...] 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”.

20. Furthermore, the criteria identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 for assessing similarity between goods also include an assessment as to their users and channels of trade.

21. In addition, the law requires that goods be considered identical where one party's description of its goods encompasses the specific goods covered by the other party's description (and vice versa).³

22. The goods to be compared are outlined at paragraphs 1 and 3 above.

³ *Gérard Meric v OHIM*, Case T-33/05

Class 7

23. The opponent's *food mixers* are a particular type of kitchen machine used to mix food or liquids. These goods are encompassed by the applicant's *electric kitchen machines; kitchen machines, electric*. As such, they are to be regarded as identical.

24. Moreover, whilst the applicant's *electric kitchen appliances for [...] mixing [...]; electrical appliances used in kitchen for whisking; electric kitchen mixers; mixers [kitchen machines]* are worded slightly differently to the opponent's *food mixers*, it is my view that they describe the same goods. They are, therefore, identical. If that is not correct, it remains the case that the respective goods are highly similar. This is because they significantly overlap in nature, method of use and intended purpose, they share users and are likely to reach the market through the same trade channels. Given the strong overlap in purpose, the respective goods are also in competition.

25. I do not consider the applicant's *electric kitchen tools; kitchen tools [electric utensils]; utensils (electric -) for stirring liquids; utensils (electric -) for mixing liquids; utensils (electric -) for blending liquids* to be identical to the opponent's *food mixers; attachments and accessories for food mixers*. This is because the former are typically handheld tools and utensils, whereas the latter are typically free-standing machines and attachments therefor. However, given that the applicant's goods can all be used to mix food or liquids, there is an overlap in purpose with the opponent's goods. There may also be an overlap in nature since attachments for food mixers will resemble their standalone (handheld) counterparts. Clearly, users will overlap. The respective goods are likely to be sold in the same retailers and may be produced by the same undertakings. The respective goods are in competition to the extent that a consumer could purchase an attachment for a food mixer or purchase a standalone electric tool or utensil to achieve the same result. Taking all of this into account, I find that the respective goods are similar to between a medium and high degree.

26. The applicant's *kitchen knives (electric -); electric kitchen appliances for chopping, [...], pressing* and the opponent's *food mixers; attachments and accessories for food mixers* overlap in nature and purpose insofar as the opponent's goods could include attachments for chopping, slicing or pressing during food preparation. Again, users will

overlap. The respective goods are likely to reach the market through shared channels of trade and may be produced by the same undertakings. As they could be used for the same purpose, they are also in competition. Overall, I find that there is a medium degree of similarity between the respective goods.

Class 11

27. The applicant's goods in this class include a range of appliances for cooking, heating, smoking and cooling. When comparing these goods with the opponent's goods, it can be said that they overlap in user to the extent that they are used by members of the general public. Moreover, with the exception of *appliances for drying hair*, the respective goods could all be purchased from retailers which specialise in cooking apparatus and kitchenware. However, I do not consider it likely that the respective goods will be produced by the same undertakings. There is also no evidence that this is common in trade. Moreover, the respective goods have different natures, purposes and methods of use. They are not in competition. Some of the applicant's goods may be used at the same time as the opponent's goods when preparing and cooking a meal. Nonetheless, as they are not important or indispensable for the use of one another,⁴ they are not complementary in a trade mark sense. Balancing all of the above, and to give effect to the applicant's concession that there is some similarity between them, I find that the respective goods are similar to a low degree.

The average consumer and the nature of the purchasing act

28. 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 the 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 (as he then was) described the average consumer in these terms:

⁴ *Boston Scientific Ltd v OHIM, Case T-325/06*

“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.”

29. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.⁵

30. The average consumer of the goods at issue is likely to be a member of the general public or a professional user, such as a restaurateur or chef. The cost of the goods will vary, from less expensive tools and utensils to more expensive cooking appliances. Although I accept that the frequency at which the goods are purchased is also likely to vary, overall, I consider them to be relatively infrequent purchases. The purchasing process will not be merely casual, given that the average consumer will use the goods in food preparation, either for themselves or their customers. It is my view that the average consumer is likely to exhibit at least a medium level of attention during the purchasing process. The goods are likely to be purchased from retailers and their online equivalents. They are typically purchased after a visual inspection of the goods, or after viewing information in brochures, catalogues or websites. As a result, the purchasing process is predominantly visual in nature. However, I do not discount aural considerations as it is possible that advice will be sought from sales assistants prior to making a purchase.

⁵ *Lloyd Schuhfabrik Meyer*, Case C-342/97

Distinctive character of the earlier mark

31. In *Lloyd Schuhfabrik Meyer*, 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 *WindsurfingChiemsee*, paragraph 51).”

32. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods will be somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced as a result of it having been used in the market.

33. The earlier mark is in word-only format and consists of the word 'CHEF', with no other elements. The word is an ordinary dictionary word used to refer to a cook. Given this meaning, the word is strongly allusive, if not descriptive, of the food preparation goods relied upon in these proceedings. As such, I find that the earlier mark possesses a low level of inherent distinctive character.

34. Evidence has been filed by the opponent and I am now required to assess whether it has demonstrated that the earlier mark had an enhanced distinctive character at the relevant date of 7 January 2022.

35. The opponent was formed out of the merger of De'Longhi Benelux SA and De Longhi Household SA, with the opponent acquiring all assets and liabilities, including a portfolio of intellectual property which includes the earlier mark and common law rights in the alleged earlier sign.⁶ Rights in the earlier mark were licensed to Kenwood Limited, which is, itself a member of the De Longhi Group of companies.⁷ On the basis of the evidence, I consider any use by Kenwood to be use with the opponent's consent.

36. Mr Johnston gives evidence that the 'CHEF' branded mixer was launched by the opponent's predecessors in title in 1950.⁸ A prospectus for the placing and public offer of shares in Kenwood Appliances Plc. (1992) is in evidence,⁹ which refers to the 'Kenwood Chef' mixer. It says that the product was a redesigned version of its original mixer with various attachments to assist with various food preparation tasks; whisking, beating, mixing, mincing and blending are listed as uses. For the financial year ending March 1992, 'Kenwood Chef' mixers accounted for around 28% of Kenwood's sales. The prospectus also indicates that the UK constituted approximately one third of Kenwood's sales at the time of its publication and that over seven million units had been sold up to the date of the prospectus. Financial information suggests that, between 1988 and 1992, turnover for 'CHEF' mixers and attachments was over £120million.

⁶ Witness statement of Gary Johnston, §§6-9

⁷ Johnstone, §§6-9

⁸ Johnston, §10

⁹ Exhibit GWAJ6

37. Moreover, 'Chef' mixers and attachments featured in a 50th anniversary brochure issued in 1996.¹⁰ Printouts from kenwoodworld.com from 2017 and 2020 have also been exhibited.¹¹ These show various 'Chef' models of mixers. Further printouts from the website show a wide variety of attachments for the 'Chef' mixers, including, *inter alia*, pasta makers, beaters, blenders, bowls, grinders, whisks and peelers.¹² Those predating the relevant date are from 2017. Copies of marketing materials and product literature, albeit undated, contain a similar range of attachments and accessories for 'CHEF' mixers.¹³ Further marketing materials from the 60th anniversary of the 'Chef' model in 2010 have been exhibited; the mixers and attachments are clearly visible in postcards and recipe booklets.¹⁴ Similarly, advertisements featuring 'Chef' mixers, said to be from the 1950s and 1960s, have also been provided.¹⁵

38. [REDACTED].¹⁶ [REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]. A selection of supporting invoices is in evidence.¹⁷ They are dated between 2009 and 2021 and concern the sale of 'CHEF' mixers and attachments. Whilst only the product codes and (in some cases) the word 'CHEF' are visible in the invoices, printouts from various websites assist with linking the product codes to the goods. The invoices are addressed to customers across the UK, including several major retailers. Mr Johnston says that 'CHEF' mixers and attachments are available from a number of specialist kitchen shops, retailers and department stores, including John Lewis and Lakeland.¹⁸ Photographs taken from a John Lewis store in London have been provided.¹⁹ From the product labels, they appear to be from 2013. Printouts of the John Lewis and Lakeland websites are also in evidence.²⁰ They are from 2015, 2016 and 2017. 'Chef'

¹⁰ Exhibit GWAJ7

¹¹ Exhibit GWAJ8

¹² Exhibit GAWJ9

¹³ Exhibit GWAJ10

¹⁴ Exhibit GWAJ11

¹⁵ Exhibit GWAJ12

¹⁶ Confidential Exhibit GWA13

¹⁷ Exhibit GWA15

¹⁸ Johnston, §32

¹⁹ Exhibit GWAJ20

²⁰ Exhibit GWAJ20

branded mixers are clearly visible throughout the photographs and printouts. Further photographs and printouts show attachments for the mixers available at these outlets in 2013.

39. Copies of market research reports suggest that 'CHEF' mixers were the second highest selling kitchen machine in the world in 2012.²¹ Further statistics are available in the reports, but these relate to the 'Kenwood' brand as a whole, not the 'Chef' range of products. Moreover, UK market share information from 2005 to 2013 has been provided.²² However, this relates to the 'Kenwood' brand as a whole and not the 'Chef' range of products.

40. 'CHEF' food mixers have featured in a number of publications, including *The Telegraph* (2006), *Good Housekeeping* (2006), *Ideal Home* (2007), *Delicious* (2006 and 2009), *BBC Good Food* (2009 and 2012), *Woman* (2009), *The Sun* (2010), *Mail Online* (2017) and *The Times* (2020).²³ Circulation figures are provided which suggest that some of these publications have a readership in the tens/hundreds of thousands. Further extracts evidencing media coverage from 2020 have been provided.²⁴ These show that 'CHEF' products featured in, *inter alia*, *The Times*, *Metro Online* and *Which?*.

41. The evidence also shows that 'CHEF' mixers have won numerous awards between 2005 and 2021.²⁵ These were given by Red Dot Product Design and IFProduct Design. 'Chef' products have also featured at trade events and shows, including IFA 2019 (referred to as "Europe's largest tech show" by *techradar.com*).²⁶ Mixers bearing the 'Chef' mark were also reviewed by *Which?* regularly between 2009 and 2020.²⁷ The products achieved ratings of around 70% or more. 'Chef' product recommendations from, *inter alia*, *Good Housekeeping* (regularly between 2002 and 2007), *Ideal Home* (2006), *The Times* (2012), *Daily Express* (2012), *IndyBest* (2016) and *BBC Good Food*

²¹ Exhibit GWAJ16

²² Exhibit GWAJ17

²³ Exhibit GWAJ18

²⁴ Exhibit GWAJ18

²⁵ Exhibits GWAJ19 and GWAJ23

²⁶ Exhibits GWAJ21-GWAJ22

²⁷ Exhibits GWAJ24 and GWAJ25

(2020) are also shown in evidence.²⁸ Some have readership figures in the hundreds of thousands.

42. There is no evidence of the market share held by products sold under the earlier mark in the UK (global figures or figures relating to the 'KENWOOD' brand as a whole not being sufficient for this purpose). Moreover, no information regarding the amounts invested by the opponent in promoting the earlier mark have been provided. Nevertheless, the evidence shows that the 'CHEF' mixer and related attachments were launched in 1950, around 70 years before the relevant date. Evidence of advertisements featuring the mixers can be seen in the materials provided, which are said to have been from the 1950s and 1960s (a point which has not been challenged). 'CHEF' mixers and attachments can also be seen in brochures from 1996 and 2010 as well as in printouts from the website of the opponent's predecessors in title from 2017 and 2020. Although the evidence of actual use of the earlier mark does not confirm that such use has been intensive in the UK, it does suggest that the use has been regular and long-standing. Moreover, 'CHEF' products were available to purchase in major retailers with outlets across the UK, and the invoices show that actual sales were made to customers in a variety of areas, such as Hertfordshire, Glasgow, Somerset and London, prior to the relevant date. Accordingly, I consider the use shown to be significant in terms of its geographical reach. As for turnover, the evidence shows that, between 1988 and 1992, 'CHEF' products accrued over £120million for the opponent's predecessor in title, with the UK accounting for around one third of that figure. The confidential turnover figures also demonstrate significant sales of 'CHEF' branded products in years much closer to the relevant date. The turnover figures are supported by invoices sent to customers in this territory between 2009 and 2021. It is also clear that 'CHEF' products were regularly referred to and promoted via a variety of publications for over a decade before the relevant date; some of those were national in reach with significant readerships. Over a similar time period, 'CHEF' products won a number of design awards and received positive reviews from *Which?*. Taking all of the above into account, I am satisfied that the distinctive character of the earlier mark had been enhanced at the relevant date in respect of the goods relied upon. However, given its low level of inherent distinctiveness, I consider

²⁸ Exhibits GWAJ26 and GWAJ27

this to result in the distinctiveness of the earlier mark being at no more than a medium level overall.

Comparison of trade marks

43. It is clear from *Sabel* 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 *Bimbo* 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.”

44. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

45. The competing marks are as follows:

The earlier mark	The contested mark
CHEF	CHEFCHY

46. The competing marks are both in word-only format and consist of the words 'CHEF' and 'CHEFCHY', respectively. As these words are the only elements in the marks, they dominate their respective overall impressions.

47. Visually, the competing marks are similar because they share four letters in the same order, i.e. 'CHEF'. These letters comprise the entirety of the earlier mark and appear at the beginning of the contested mark, a position which is generally considered to have more impact.²⁹ However, these letters are subsumed within the longer (invented) word 'CHEFCHY' in the contested mark. The competing marks differ in that the contested mark contains an additional three letters, i.e. 'CHY'. Bearing in mind my assessment of the overall impressions, I find that there is a medium degree of visual similarity between the competing marks.

48. The word 'CHEF' in the earlier mark will be articulated in the ordinary way. This pronunciation is shared by the first syllable of the contested mark. However, the contested mark is longer as it contains an additional syllable, 'CHY'. Overall, I find that there is a medium degree of aural similarity between the competing marks.

49. Conceptually, the earlier mark will be understood as referring to a cook. The contested mark is an invented word with no recognised meaning. However, notwithstanding the established principle that consumers normally perceive a trade mark as a whole, consumers will break down the mark into verbal elements which suggest a concrete meaning or resemble words known to them.³⁰ In this connection, it is my view that, given the goods at issue in these proceedings, the presence of the first four letters 'CHEF-' renders the contested mark evocative of a cook. Consumers will be unaware of the precise meaning of the contested mark but will understand that the mark is referring to a cook in some way. Overall, I find that there is a medium degree of conceptual similarity between the competing marks.

²⁹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

³⁰ *Usinor SA v OHIM*, Case T-189/05

Likelihood of confusion

50. 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. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful 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 they have retained in their mind.

51. 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 down to the responsible undertakings being the same or related.

52. Earlier in this decision, I concluded that:

- The parties' goods in class 7 are identical or similar to at least a medium degree;
- The applicant's goods in class 11 are similar to a low degree to the opponent's goods;
- The average consumer of the goods will be a member of the general public or a professional user who will demonstrate at least a medium level of attention during the purchasing process;
- The purchasing process will be predominantly visual in nature, though aural considerations have not been discounted;

- The earlier mark possesses a low level of inherent distinctive character, which has been enhanced to a medium level through use;
- The competing marks are visually, aurally and conceptually similar to a medium degree.

53. I acknowledge that that there is a moderate degree of similarity between the competing marks overall and that the sole element of the earlier mark is identically reproduced at the beginning of the contested mark. I also accept that the earlier mark is factually distinctive to a medium level. Nevertheless, the proposition that the beginnings of trade marks have more impact than their endings is a general rule that is not always decisive.³¹ In this case, there are differences between the competing marks which are not negligible. The contested mark contains an additional three letters, i.e. 'CHY'. These letters have no counterpart in the earlier mark but form part of the singular word which dominates the overall impression of the contested mark. I do not consider that these additional letters would be overlooked by the average consumer, whether encountered visually or aurally. Moreover, whilst there is an element of conceptual overlap between the competing marks, this stems from a meaning which describes or strongly alludes to the goods at issue in these proceedings. It is not, therefore, a distinctive similarity. Taking all of the above into account, it is my view that the differences between the competing marks are likely to be sufficient for the average consumer – paying at least a medium level of attention – to distinguish between them and avoid mistaking one for the other. I can see no reason why, even factoring in the principles of imperfect recollection and interdependency, the average consumer would mistake or misremember the invented word 'CHEFCHY' for the common dictionary word 'CHEF' or vice versa. Accordingly, it follows that there will be no direct confusion, even in respect of identical goods.

³¹ *CureVac GmbH v OHIM*, T-80/08

54. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

“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.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

55. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach.³² I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.³³ I also bear in mind that, where there is no direct confusion, there must be a “proper basis” for finding indirect confusion.³⁴

56. Having regard to all the above principles, I do not believe that the average consumer, having noticed the differences between the competing marks, will assume that the opponent and the applicant are economically linked undertakings on the basis of the competing trade marks. I am unconvinced that the average consumer would assume a commercial association or licencing arrangement between the parties, or sponsorship on the part of the opponent, merely because of the shared word/letters ‘CHEF’. This word is not so strikingly distinctive that the average consumer would assume that only the opponent would be using it in a trade mark. To the contrary, I have found that the word describes or strongly alludes to the goods at issue in these proceedings. Whilst I have found that the earlier mark is factually distinctive to a medium level, the word appears on its own in the earlier mark but as part of the invented word ‘CHEFCHY’ in the contested mark. As such, there is no sharing of an independent distinctive element which would give rise to this kind of indirect confusion. Moreover, the differences between the competing marks are not simple additions or removals of non-distinctive elements. Nor are the differences consistent with any logical brand extensions with which the average consumer would be familiar. I can see no reason why an undertaking would add an additional three (seemingly arbitrary) letters to an ordinary dictionary word, resulting in an invented word. The opponent claims that the letters ‘CHY’ form a “non-distinctive suffix” which qualifies the word ‘CHEF’. However, it has not explained why or provided any evidence to support its

³² *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207

³³ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

³⁴ *Liverpool Gin Distillery*

claim. That is not my own understanding of the letters, and I am not persuaded by the opponent's bare assertion. Whilst acknowledging that the categories above are not exhaustive, to my mind there is no other basis for concluding that the average consumer would assume an economic connection between the parties on the basis of the competing marks. Rather, it is my view that the average consumer – paying at least a medium level of attention – would attribute the shared presence of the word/letters 'CHEF' to coincidence, particularly considering the message it conveys is descriptive or strongly allusive. Taking all of this into account, I do not consider there to be a likelihood of indirect confusion, even in relation to identical goods.

Conclusion

57. The opponent's claim under section 5(2)(b) is dismissed.

Section 5(3)

Legislation and case law

58. Section 5(3) states:

“(3) A trade mark which-

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 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”.

59. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected”.

60. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oréal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. 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 public calls the earlier mark to mind; *Adidas-Salomon*, 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 risk that

this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(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'Oréal 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'Oréal v Bellure*).

61. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier mark is similar to the contested marks.³⁵ Secondly, the opponent must show that the mark has achieved a level of knowledge, or reputation, amongst a significant part of the public. Thirdly, the opponent must establish that the public will make a link between the marks, in the sense of the earlier mark being brought to mind by the

³⁵ Given my findings in the mark comparison section of this decision, the opponent has satisfied this first requirement.

contested mark. Fourthly, assuming the foregoing conditions have been met, section 5(3) requires that one or more types of damage claimed by the opponent will occur. It is not necessary for the purposes of section 5(3) that the goods are similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

62. The relevant date for the assessment under this ground is the filing date of the contested application, that being 7 January 2022.

Reputation

63. In *General Motors*, Case C-375/97, the CJEU held that:

“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.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

64. At paragraph 42 I found that the distinctive character of the earlier mark had been shown in evidence to have been enhanced to a medium level by the relevant date in

respect of *food mixers; attachments and accessories for food mixers*. For the same reasons, I find that the opponent has also demonstrated a moderate reputation in the UK in relation to these goods at the relevant date.

Link

65. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take into account all relevant factors. The factors are identified in *Intel* at paragraph 42. I will take these in turn.

The degree of similarity between the conflicting marks

66. I have found that the competing marks are visually, aurally and conceptually similar to a medium degree.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

67. I have found that some of the applicant's goods in class 7 are identical to the opponent's goods, whilst others are similar to at least a medium degree. I have found that the applicant's goods in class 11 and the opponent's goods are similar to a low degree.

68. As I have already outlined, the goods are likely to be purchased by members of the general public and professional users. At least a medium level of attentiveness will be exhibited. The goods are likely to be purchased visually, but I have not discounted aural considerations.

The strength of the earlier mark's reputation

69. I have found that the earlier mark has a moderate reputation in the UK.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

70. I have found that the earlier mark possesses a low level of inherent distinctive character, which has been enhanced to a medium level for the reputed goods.

Whether there is a likelihood of confusion

71. I have found that there is no likelihood of direct or indirect confusion between the earlier mark and the contested mark.

Conclusions on link

72. I acknowledge that the opponent has demonstrated that the earlier mark has a moderate reputation and that the distinctive character of the same has been enhanced above its inherent characteristics. Moreover, I accept that the earlier mark is entirely reproduced at the beginning of the contested mark, leading to visual, aural and conceptual similarities between the competing marks. Nevertheless, it is my view that the earlier mark will not be called to mind by the contested mark. To my mind, the difference created by the additional letters 'CHY' is too great and the distinctiveness of the word 'CHEF' is inherently too weak. This word is subsumed within the (invented) word 'CHEFCHY' in the contested mark. Although the presence of the shared word/letters leads the contested mark to evoke the meaning conveyed by the earlier mark, that meaning is descriptive or strongly allusive of the goods at issue. As such, when confronted with the contested mark, it is my view that the relevant public is likely to think of the meaning of the word itself, rather than the earlier mark. In other words, the shared use of 'CHEF' is likely to be attributed to a coincidental use of a descriptive or strongly allusive word. The distinctiveness of the earlier mark and the similarities between the competing marks are not sufficient to overcome this, even in relation to identical goods. If the earlier mark is brought to mind, it is my view that such a link will be too fleeting to result in any damage arising; it will constitute no more than a momentary bringing to mind. Any brief wondering about any connection would be swiftly dismissed due to the differences between the marks, resulting in the relevant public – exhibiting at least a medium level of attentiveness – concluding that these are

two unconnected brands which happen to be using the word/letters 'CHEF' in different ways.

Conclusion

73. The opponent's claim under section 5(3) is dismissed.

Section 5(4)(a)

Legislation and case law

74. Section 5(4)(a) states:

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(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.”

75. Subsection (4A) of section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

76. 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).”

77. Halsbury’s Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other indicium which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action”.

78. There has been no claim by the applicant that the contested mark had been used prior to its filing date or the earliest claimed use of the opponent’s alleged earlier sign. Further, no evidence to that effect has been filed. Therefore, the relevant date for assessing the opponent’s claim under section 5(4)(a) is the filing date of the contested mark, that being 7 January 2022.³⁶

³⁶ *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11

Goodwill

79. The first hurdle for the opponent to show that it had the necessary goodwill resulting from the trading activity relied on under the 'CHEF' sign at the relevant date. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) in the following terms:

"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 custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

80. I have already found that the evidence filed by the opponent was sufficient to support findings that a registered mark identical to the earlier sign had a reputation and enhanced distinctive character at the relevant date. For the same reasons as provided at paragraph 42, I am satisfied that the opponent had accrued a moderate level of goodwill in relation to its business in *food mixers; attachments and accessories for the aforesaid goods*. However, I do not consider the evidence establishes goodwill in respect of any other *food preparation equipment and machines*; the evidence is limited to food mixers and attachments therefor.

Misrepresentation

81. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt LJ 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."

82. In *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501, Lewison LJ had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that "a substantial number" of the relevant public are deceived, which might not mean that the average consumer is confused. However, considering the Court of Appeal's later judgment in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes.³⁷ This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

³⁷ Although this was an infringement case, the principles are equally applicable to section 5(2) of the Act: *Soulcycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch).

83. I have already found that there is no likelihood of confusion between the contested mark and a registered mark identical to the opponent's earlier sign. For the same reasons given at paragraphs 53 and 56, I do not consider that a substantial number of members of the relevant public would be misled into purchasing the applicant's goods in the mistaken belief that they were the goods of the opponent.

84. This finding applies to situations wherein the parties' goods are identical. Therefore, even if I had found that the opponent had demonstrated goodwill in respect of the wider category of *food preparation equipment and machines; attachments and accessories for the aforesaid goods*, this would not improve its position.

Conclusion

85. The opponent's claim under section 5(4)(a) is dismissed.

Overall outcome

86. The opposition has been unsuccessful. Subject to any appeal against my decision, the contested mark will proceed to registration in the UK.

Costs

87. The opposition having failed, ordinarily the applicant would be entitled to an award of costs. As the applicant has not instructed professional representatives, it was invited by the Tribunal to indicate whether it intended to make a request for an award of costs, by filing a costs pro-forma including accurate estimates of the number of hours spent on a range of given activities relating to defending the proceedings.

88. It was made clear by letter dated 17 May 2023 that if the pro-forma was not completed, no costs would be awarded. The applicant did not return a completed pro-forma to the Tribunal and, on this basis, no costs are awarded.

Dated this 18th day of March 2024

James Hopkins
For the Registrar