

O-250-19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3258822
BY GFY INNOVATIONS LTD TO REGISTER:**

HOOVER

AS A TRADE MARK IN CLASS 7

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 411237 BY
CANDY HOOVER GROUP S.R.L.**

BACKGROUND & PLEADINGS

1. On 23 September 2017, GFY Innovations Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the following goods in class 7:

Lawn mowers; robotic lawnmowers; Electric lawn rakes; trimming machines; lawn edgers; hedge trimmers; garden shredders; blowers; high pressure washers; parts and accessories for the above mentioned goods.

The application was published for opposition purposes on 6 October 2017.

2. The application has been opposed in full by Candy Hoover Group S.R.L. (“the opponent”). The opposition was originally based upon sections 3(6), 5(1), 5(2)(a), 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). However, in its skeleton argument, the opponent indicated that it was no longer pursuing the ground under section 3(6) and, as a consequence, I need say no more about it in this decision. In relation to its opposition based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Act, following a Case Management Conference held in March 2018, the opponent now relies upon the following trade marks:

European Union Trade Mark (“EUTM”) no. 2397131 for the trade mark **HOOVER** which was applied for on 2 October 2001 and which was entered in the register on 12 March 2003. The opponent indicates that it now relies upon the goods and services shown in Annex A to this decision.

The opponent states:

“This registration is identical to the word element of the applicant's mark. The stylisation of the applicant's mark is not sufficient to alter this. In the event that the marks are found not to be identical, it is submitted that they are extremely

similar. The goods covered by the registration include the goods covered in the application and are therefore identical. In the event that the goods are not found to be identical, and in respect of all remaining goods and services, there is extreme similarity...”

EUTM no. 2396620 for the trade mark shown below which was applied for on 2 October 2001 and which was entered in the register on 14 January 2003 (I shall refer to this trade mark as the opponent’s device trade mark). The opponent indicates that it now relies upon the goods and services shown in Annex A to this decision:



3. Insofar as its objection based upon section 5(3) of the Act is concerned, the opponent relies upon eight trade marks (two of which are shown above). Four of the trade marks relied upon are for the plain word HOOVER and the other four are for the device trade mark. Full details of the registrations are shown in Annex B to this decision. The opponent states that all of its trade marks enjoy a reputation in relation to all the goods and services upon which it relies, adding that it considers all the goods for which registration is sought would take unfair advantage of, or be detrimental to the distinctive character or reputation of its trade marks. In addition to claiming that:

“the similarity between the [trade marks being relied upon] and the later trade mark is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks”,

the opponent further states:

“...As such the applicant is seeking either to confuse consumers or to ride on the coattails of the opponent’s reputation. Either way, this will be detrimental to the opponent’s profit and goodwill.”

4. In relation to its opposition based upon section 5(4)(a) of the Act, the opponent states that it has used the word HOOVER and the device trade mark throughout the UK since 1949 and 1950 respectively, for “all of the goods covered by the UK and/or EUTM registrations on which [the opposition is based].” In its Notice of opposition, the opponent states:

“As a result of extensive use of their trade mark, the opponents have amassed a great deal of goodwill and reputation therein. Use by the applicant of the mark applied for in respect of the goods applied for would misrepresent to the public the origin of the goods. The average consumer would believe the goods to emanate from, or be connected to the opponents. Subsequent loss and/or damage to the opponents’ profits and or reputation is inevitable. As such the requirements for the tort of passing off are fulfilled and the application should be refused on this ground.”

5. The applicant filed a counterstatement in which its Managing Director, Martin Oliver, stated:

“We do not consider that the word element of the mark would cause confusion, it differs in style and font and is not identical or similar.

It is nor our Intention to "ride on the coattails of the opponents reputation" the opponent has no reputation in [the goods for which registration is sought]. How

we could be detrimental to the opponents profit and goodwill when they have no products in this field.

With regard to passing off, does the opponent consider It has the rights to the mark "Hoover" for any product, this must be wrong, we are building our own brand in Gardening Equipment.

I own many companies and import and retail various goods, from sanding equipment to paint and that includes owing trademarks for any areas we are already in or just about to enter. We have intent on using any marks registered, the opponent wishes to block a mark in an area that it is not in and has no intention of entering, as such I struggle with the term used "not honest".

6. In these proceedings, the opponent is represented by Urquhart-Dykes & Lord LLP ("UDL"); the applicant represents itself. Both parties filed evidence. The matter came before me at a hearing held on 12 February 2019, at which the opponent was represented by Ms Alison Cole, a trade mark attorney in the employ of UDL; the applicant was not represented at the hearing nor did it elect to file written submissions in lieu of attendance.

EVIDENCE

The opponent's evidence

7. This consists of two witness statements. The first, is from Abrar Hussain Bokhari, the opponent's Group General Counsel; it is accompanied by fifteen exhibits. Exhibit AHB1 consists of a number of documents outlining the history of the opponent company together with pages obtained from the opponent's website (bearing printing dates of 23 July 2018). Mr Bokhari explains that the website pages outline the opponent's "current

product areas". It lists products in the following categories "Vacuuming", "Cleaning", "Ironing", "Laundry", "Cooking" and "Cooling". He states:

"4...It can be seen that the trade mark HOOVER was first used in the USA in 1908, with expansion into other continents, including the UK and Europe, in the decades that immediately followed. In 1948 my company expanded into the production of washing machines and then into other home appliances for cleaning, cooking and refrigeration, all goods being sold by reference to the trade marks."

8. Mr Bokhari states that "turnover in the EU was approximately €1.148 billion for the year closing 31 December 2017", adding that:

"4...Specific turnover figures are commercially sensitive and as such my company has chosen to keep them confidential at this time."

9. Exhibit AHB2 consists of a report from www.innovativeelectricalretailing.co.uk dated 30 May 2018 which, under the heading "Candy Group announces positive financial statement", contains, inter alia, the following:

"...Candy has reported a further growth in the market share held in Europe, where it obtained a 0.4% year-on-year increase in the market share of large household appliances.

The Group – that operates Candy, Hoover and Rosières brands – is active in three main sectors: washing, built-in appliances, and small domestic appliances. The Group's turnover is largely achieved within the European Union, with the U.K. (21%), France (18%), Italy (17%), the Iberian Peninsula (6.5%) and Germany (4.5%) playing a leading role together with Russia, which is currently growing strongly...

In recent years Candy Group has become a leader in connected household appliances and in the sale of smart appliances where, in particular in the washing machines segment, it holds 61% of the market share in Europe, the statement noted.

Candy Group chief executive Beppe Fumagalli commented: “The positive results of 2017 confirm the growth of Candy Group, which for the second year in a row has been the group that grows the most in Europe in the market of large household appliances. Thanks to an increasingly diversified and wider offer, particularly on the international brands Candy and Hoover, both in terms of product range and technological solutions, we are at the forefront of innovation on the European market...”

10. Mr Bokhari states that in the last ten years the opponent’s advertising expenditure “in the UK for goods bearing the trade marks has been on average more than €2mil per year.”

11. He states that exhibits ABH3-10 consists of “samples of instruction manuals and publicity materials relating to the [opponent’s goods] in the UK over the last 10 years...”. As Mr Bokhari’s statement is dated July 2018, I take this to be a reference to the period 2008-2018. Although the instructions manuals do refer to the categories of goods Mr Bokhari has identified i.e. “Vacuums & Floor Cleaners”, “Refrigerators”, “Ironing systems”, Tumble dryers”, “Cooker hoods”, “Hobs”, “Dishwashers” and “Ovens”, as far as I can tell, only two pages within the eight exhibits can be positively dated i.e. from 2009 and March 2017, respectively. At paragraph 7 of his statement Mr Bokhari refers to “old advertisements for [the opponent’s products]” and he provides a number of links to YouTube. However, as, for example, no screenshots from such videos are provided, this information does not assist the opponent.

12. Exhibit AHB11 consists of various documents relating to the promotion of the HOOVER trade marks and the goods sold under them. These include an ARGOS promotion from 2014 and a campaign to support the launch of the opponent's Wizard range of connected appliances which began in June 2015. The latter consisted of a campaign directed at both the trade and general public and included a wide range of print, outdoor, social media and television promotion. Not all of the documents provided are dated whilst others, the television advertising campaign for example, are from after the material date.

13. Mr Bokhari states that the opponent "is the proprietor of all EU country code domain names with "hoover" as the domain name itself" and exhibit AHB12 is provided in support. He adds that the opponent is the proprietor of the following social media handles "@HooverUkpage" (Facebook), "Hoover" (Pinterest) and "@Hoover_UK" (Twitter) and he provides the number of subscribers/followers at, I assume, the time of his statement. Exhibit AHB13 consists of what Mr Bokhari describes as "copies of [its] current Twitter and facebook pages" and examples from 2011 from its "website and mobile webpages."

14. Exhibit AHB14 consists of a printout from analyticsgoogle.com which indicates that in the period 1 January 2005 to 31 December 2017, www.hoover.co.uk was visited by 5,171,420 users. Although he provides no evidence in support, Mr Bokhari states that the opponent has won "numerous awards for their products and innovations" which, prior to the material date, I note, included the following:

"Leading Design MDA Collections" by Get Connected Product Design Awards 2017:

Designer magazine awards 2009, 2010, 2011, 2012 and 2015;

"Leading Design - dishwashing product" at the EMRA awards 2013;

KBB Review Kitchen product innovation of the year 2016;

SIRIUS Manufacturer of the year 2015 & 2016;

Euronics Best Independent Retailer 2016.”

15. Mr Bokhari states:

“11 As a result of the promotion of goods bearing the trade marks in the UK, my company can state that it has sold 1 in 8 washing machines, 20% of 55cm fridge freezers and 1 in 9 of all appliances in the UK. Attached at "Exhibit AHB15" are infographics produced by my company illustrating these and other achievements.”

16. At the hearing, Ms Cole pointed out that at the bottom right of page 170 (in such small print it is difficult to discern), there appears a reference to “Source data 2016.” I note there are references to:

“Award winning after sales service SoS Rated No. 1 for the fastest service and the most reliable supplier of same/next day in home service”;

And:

“9 out of 10 consumers would buy again based on their positive experience with our service department.”

17. The second statement comes from Ms Cole; it is accompanied by three exhibits. As the first two exhibits relate to the now abandoned objection based upon section 3(6) of the Act, I need say no about them. Exhibit AJC3 consists of the results of Google searches conducted on 30 July 2018 which Ms Cole explains show:

“2...examples of companies that make both garden and home appliances. Companies such as Bosch, Hitachi, LG, Siemens, Gtech, Hyundai, Black + Decker and Karcher all produce lawnmowers, garden tools as well as house and home appliances.”

The applicant's evidence

18. This consists of a witness statement from Mr Oliver. He states:

“ 2. I refer to (Exhibit A) a statement made by Abar Hussain Bokhari dated 30 July 2018. Within paragraph 2 he states that " in respect of all goods which we state are similar to those covered by the opposed application" we do not agree that our application for Lawn mowers; robotic lawnmowers; Electric lawn rakes; trimming machines; lawn edgers; hedge trimmers; garden shredders; blowers; high pressure washers are in anyway similar with any of the goods claimed by the opponent.

3. The Opponent has no reputation within class 7.”

19. That conclude my summary of the evidence to the extent I consider it necessary.

DECISION

20. The opposition is now based upon sections 5(1), 5(2)(a), 5(2)(b), 5(3) and 5(4)(a) of the Act which read as follows:

“5 (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(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, or

(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.

(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 (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(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.”

21. An earlier trade mark is defined in section 6 of the Act, which states:

“6. - (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

22. Under sections 5(1), 5(2)(a) and 5(2)(b) of the Act, the opponent is relying upon the two trade marks shown in paragraph 2 above, both of which qualify as earlier trade marks under the above provisions. Given the interplay between the dates on which the opponent’s trade marks were entered in the register and the publication date of the application for registration, both are subject to the proof of use provisions contained in section 6A of the Act, the relevant period for which is 7 October 2012 to 6 October 2017. In its Notice of opposition, the opponent states that it has used its earlier trade marks in relation to all the goods and services upon which it now relies.

23. In its counterstatement, the applicant asks the opponent to make good that claim but only in relation to the following goods in class 7:

Machines; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles).

24. The consequence of the above decision is that the opponent can rely upon all of its other named goods and services in classes 8, 9, 11, 17, 21, 35 and 37 without having to demonstrate genuine use. At the hearing, Ms Cole argued that the use the opponent had made of its trade mark in relation to goods in class 7 was sufficient to preserve in its specification the goods identified by the applicant in its counterstatement. Following the hearing, Ms Cole provided a list of the goods upon which the opponent considers it has used its earlier trade marks (Annex C refers). I will, if necessary, return to this point later in this decision.

My approach to the proceedings/the applicant's request for proof of use

25. In his statement, Mr Bokhari stated:

“2. This witness statement will provide proof that my company has used the trade marks HOOVER and [the device trade mark] ("the trade marks") in respect of all of the goods which we state are similar to those covered by the opposed application, as well as provide evidence of the repute and reputation of my company's trade marks...”

26. I have reproduced the applicant's comments in its counterstatement and in its response to the opponent's evidence in paragraphs 5 and 18 above. The applicant does not, I note, appear to dispute any of the factual statements contained in Mr Bokhari's statement relating to: (i) the trade marks used, (ii) the length of use, (iii) the categories of goods in relation to which the trade marks have been used, (iv) the quantum of use, (v) the promotional spend or (vi) the territories in which use has taken place. When read together, there is, in my view, no suggestion that the applicant disputes that the opponent's trade marks have been used in, inter alia, the UK for many years in relation to a range of, broadly speaking, domestic appliances. Rather, what the applicant disputes is that the opponent has used its trade marks in relation to the goods of interest to it, or to any goods which it considers are similar to its own goods.

27. I shall proceed on that basis, dealing first with the objection based upon section 5(3) of the Act, returning to the alternative grounds if I consider it necessary to do so.

The objection based upon section 5(3) of the Act

28. At the hearing, Ms Cole submitted that the opponent's best case lies with the word only version of its trade mark i.e. HOOVER; I agree. Consequently, I shall conduct the comparison on the basis of EUTM no. 2397131 in relation to which the opponent relies upon a wide range of goods and services which includes goods in classes 7 and 11.

29. The relevant case law can be found in the following judgments of the Court of Justice of the European Union ("CJEU"): Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

- a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.
- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.
- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant

consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation

and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

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

“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.”

31. In Case C-408/01, *Adidas-Salomon*, the CJEU held:

“28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

32. As the opponent’s earlier trade mark is an EUTM, the comments in *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07 are relevant, in which the CJEU held:

“20. By its first question, the national court in essence asks the Court, first, to clarify the meaning of the expression ‘has a reputation in the Community’, by means of which, in Article 9(1)(c) of the regulation, one of the conditions is laid down which a Community trade mark must fulfil in order to benefit from the protection accorded by that provision and, second, to state whether that condition, from a geographical point of view, is satisfied in a case where the Community trade mark has a reputation in only one Member State.

21. The concept of 'reputation' assumes a certain degree of knowledge amongst the relevant public.

22. The relevant public is that concerned by the Community trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector (see, by way of analogy, *General Motors*, paragraph 24, with regard to Article 5(2) of the directive).

23. It cannot be required that the Community trade mark be known by a given percentage of the public so defined (*General Motors*, by way of analogy, paragraph 25).

24. The degree of knowledge required must be considered to be reached when the Community trade mark is known by a significant part of the public concerned by the products or services covered by that trade mark (*General Motors*, by way of analogy, paragraph 26).

25. In examining this condition, 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 (*General Motors*, by way of analogy, paragraph 27).

26. In view of the elements of the main proceedings, it is thus for the national court to determine whether the Community trade mark at issue is known by a significant part of the public concerned by the goods which that trade mark covers.

27. Territorially, the condition as to reputation must be considered to be fulfilled when the Community trade mark has a reputation in a substantial part of the

territory of the Community (see, by way of analogy, *General Motors*, paragraph 28).

28. It should be noted that the Court has already ruled that, with regard to a Benelux trade mark, it is sufficient, for the purposes of Article 5(2) of the directive, that it has a reputation in a substantial part of the Benelux territory, which part may consist of a part of one of the Benelux countries (*General Motors*, paragraph 29).

29 As the present case concerns a Community trade mark with a reputation throughout the territory of a Member State, namely Austria, the view may be taken, regard being had to the circumstances of the main proceedings, that the territorial requirement imposed by Article 9(1)(c) of the regulation is satisfied.

30. The answer to the first question referred is therefore that Article 9(1)(c) of the regulation must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, a Community trade mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the Community, and that, in view of the facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community.”

33. In *Burgerista Operations GmbH v Burgista Bros Limited* [2018] EWHC (IPEC), Judge Hacon considered whether an EU trade mark registered for restaurant services had a reputation under article 9(2)(c) of the EU Trade Mark Regulation (which is equivalent to s.10(3) of the Trade Marks Act). The judge summarised the law as follows:

“69. I draw the following from the judgments of the Court in *PAGO* and *Iron & Smith* and from the opinion of Advocate General Wahl in *Iron & Smith*:

- (1) An EU trade mark has a reputation within the meaning of art.9(2)(c) if it was known to a significant part of the relevant public at the relevant date.
- (2) The relevant public are those concerned by the products or services covered by the trade mark.
- (3) The relevant date is the date on which the defendant first started to use the accused sign.
- (4) From a geographical perspective, the trade mark must have been known in a substantial part of the EU at the relevant date.
- (5) There is no fixed percentage threshold which can be used to assess what constitutes a significant part of the public; it is proportion rather than absolute numbers that matters.
- (6) Reputation constitutes a knowledge threshold, to be assessed according to a combination of geographical and economic criteria.
- (7) All relevant facts are to be taken into consideration when making the assessment, 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 undertaking in promoting it.
- (8) The market for the goods or services in question, and from this the identity of the relevant public, ought to assume a paramount role in the assessment.
- (9) The territory of a single Member State (large or small) may constitute a substantial part of the EU, but the assessment must be conducted without consideration of geographical borders.”

34. In the above case, the registered EU trade mark had been used for 8 months prior to the relevant date in the proceedings, in relation to 7 restaurants, mainly in Austria.

The Judge concluded as follows:

“85 In July 2015 the Trade Mark was far from being known throughout Austria. It had not become known outside Austria, save possibly to a very limited extent in Mönchengladbach. It was known in two local areas of Vienna, two in Linz, one in Salzburg and one in Pasching. No figure has been attempted for the share of the European Union restaurant business held by the restaurants trading under the mark, but it must have been very small indeed, even if presented as a share of the burger restaurant business. Marketing was largely confined to social media sites, although it is not clear how much of this had been done by July 2015.

86 In my view, although at the relevant date the Trade Mark had a reputation of some sort by dint of restaurants having traded under the Trade Mark, it did not have a reputation in the Union within the meaning of art.9(2)(c).”

Reputation

35. The article provided as exhibit AHB2 dated 30 May 2018 indicates that the opponent conducts a trade in relation to “washing, built-in appliances and small domestic appliances” under three trade marks (including HOOVER). It further explains that the Group’s turnover is “largely achieved within the European Union” with the UK, France, Italy and Germany accounting for 21%, 18% , 17% and 4.5%, respectively. The article further refers to the opponent becoming a “leader in connected household appliances and in the sale of smart appliances where, in particular in the washing machines segment, it holds 61% of the market share in Europe” and, by reference to comments from the opponent’s Chief Executive, that the opponent’s group “for the second year in a row has been the group that grows the most in Europe in the market of large

household appliances” and to “an increasingly diversified and wider offer, particularly on the international brands Candy and Hoover”.

36. The opponent has provided a turnover figure for 2017 indicating that in that year its turnover in the EU amounted to some €1.1 billion. It has, however, provided no turnover figures (or even estimates) prior to 2017. Although in his statement, Mr Bokhari states that in relation to the figure of 21%: “the majority...relates to goods bearing [the trade marks being relied upon]”, not even estimates are provided of, inter alia, what percentage of this turnover figure relates to specific goods. Mr Bokhari further states that promotional spend in the UK in relation to goods sold under the trade marks has been on average €2 million per year for the last ten years. I note that in 2014 the opponent’s carpet cleaners and irons were available from ARGOS and in 2015 an extensive advertising campaign was launched to promote the opponent’s range of WIZARD connected appliances. The opponent has a range of social media sites featuring the word Hoover and in the period January 2005 to December 2017, the opponent’s UK website was visited in excess of five million times. While in 2016 the opponent sold: 1 in 8 washing machines, 1 in 9 appliances and 20% of all 55cm fridge freezers sold in the UK, no indication is provided as to how this relates to the opponent’s HOOVER trade mark. Finally, I note that prior to the material date the opponent had won a wide range of awards.

37. I remind myself that in *Burgerista Operations GmbH v Burgista Bros Limited*, the Judge concluded, inter alia:

“(9) The territory of a single Member State (large or small) may constitute a substantial part of the EU, but the assessment must be conducted without consideration of geographical borders.”

38. While the opponent's evidence leaves a great deal to be desired, as I mentioned earlier, the factual statements it contains have not been challenged. When the opponent's evidence is considered as a totality, on the basis of the evidence which relates to the UK alone i.e. in terms of length of use, quantum of use and promotional spend, it would, I think, be unrealistic for me not to conclude that during the relevant period (i.e. 7 October 2012 to 6 October 2017) the opponent had not only made genuine use of its HOOVER trade mark in relation to, broadly speaking, a range of domestic appliances, but that its use in the UK alone is sufficient to constitute a qualifying reputation for the purpose of section 5(3) of the Act. While I accept that domestic appliances is a broad term, I would have been prepared to accept on judicial notice alone that, at the material date, the opponent had a qualifying reputation in at least vacuum cleaners and washing machines.

The Link

39. In its skeleton argument, the opponent states:

“30...not only would the average consumer draw a link [between the parties' trade marks], but also the average consumer would be confused... Specifically, it is submitted that the average consumer is likely to be confused into believing that the applicant's products are licensed, authorised or otherwise approved of/endorsed by the opponent.”

40. I shall, nonetheless determine whether a link will be made. In reaching a conclusion on that point, I need to consider a number of factors including: the degree of similarity between the respective trade marks and between the respective goods, the extent of the overlap between the relevant consumers for those goods and the strength of the earlier trade mark's reputation and distinctiveness.

41. The opponent's trade mark consists of the word HOOVER presented in block capital letters; the evidence shows it has been used in, inter alia, that format. The applicant's trade mark consists of what, in my view, relevant consumers will regard as the word HOOVER, albeit presented in a slightly stylised script i.e. in which there are gaps in the letters "H", "O" and "O" and in which the letters "V", "E" and "R" are incomplete. That the applicant intends its trade mark to be understood as HOOVER is, as Ms Cole pointed out at the hearing, borne out by comments in its counterstatement. The competing trade marks are aurally and conceptually identical and although not visually identical, are visually similar to the highest degree.

42. Insofar as the competing goods are concerned, the opponent conducts a trade in relation to what I have described as a range of domestic appliances, whereas the applicant seeks registration for a range of goods for use in gardening, pressure washers and parts and accessories for such goods. Although the evidence which is contained in exhibit AJC2 (dated 30 July 2018) is from after the material date, there is nothing to suggest that the position was materially different some ten months earlier. That evidence shows that a number of household names produce both gardening equipment and domestic appliances. Thus while the purpose of, for example, carpet cleaning apparatus and washing machines is clearly different to the applicant's goods, I am satisfied that at the material date relevant consumers are likely to have been aware that the same commercial undertakings conduct a trade in a wide range of both domestic and garden appliances under the same trade mark. The relevant consumer for the competing goods is the same i.e. members of the general public and business users.

43. Finally, the opponent's earlier trade mark has been used in the UK for many years in relation to, at least, the goods I have mentioned. Although a well-known surname, it is, in my experience relatively rare. Absent use, it has a normal degree of inherent distinctiveness. However, the extent and nature of the use that has been made of it in relation to the goods I have mentioned has, inevitably, built upon its inherent

credentials, resulting in a trade mark possessed of a high degree of distinctive character and a strong reputation.

44. In reaching a conclusion on whether a link will be made, I remind myself of (i) the degree of visual, aural and conceptual similarity between the competing trade marks, (ii) that the same undertakings conduct a trade in relation to a wide range of domestic appliances, (iii) the relevant consumers may be identical, and (iv) the strength of the opponent's reputation in its HOOVER trade mark and its high degree of distinctiveness. Having done, I have no hesitation concluding that in the mind of the relevant consumer a link will be made.

The heads of damage

45. As I mentioned earlier, in its Notice of opposition, the opponent explained that it considers the relevant public will believe that the trade marks are used by the same or economically linked undertakings. The opponent stated:

“...As such the applicant is seeking either to confuse consumers or to ride on the coattails of the opponent's reputation. Either way, this will be detrimental to the opponent's profit and goodwill.”

46. The reference to riding “on the coattails of the opponent's reputation” is clearly a claim to unfair advantage which is likely to arise when relevant consumers assume an economic connection between the parties. In its skeleton argument and at the hearing, the opponent also explained why the trade mark the subject of the application would be detrimental to the reputation and distinctive character of its HOOVER trade mark. Given the nature of the original pleading, at the hearing, I expressed my reservations as to whether these additional claims could be relied upon. For reasons which will shortly become clear, as the opponent only needs to succeed on one of the heads of damage, my decision in this respect is not crucial. However, as the claim to detriment to the

“opponent’s profit and goodwill” may be construed as claims to both detriment to distinctive character (“profit”) and reputation (“goodwill”) respectively, the opponent ought, I think, to be entitled to rely upon them and I will return to them shortly.

Unfair advantage

47. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded:

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

48. However, I also note that more recently, in *Argos Limited v Argos Systems Inc* [2018] EWCA Civ 2211, Floyd LJ (with whom Lord Kitchen and Sir Colin Rimer agreed) stated:

“108. That brings be to the central question of whether ASI’s use of the sign ARGOS in relation to the service of provision of advertising space took unfair

advantage of the trade mark. I reject Mr Mellor's contention that, in a case such as the present, unfairness is established by the fact of economic advantage and no more. So to hold would be to empty the word "unfair" of any meaning.

Like the Court of Appeal in *Whirlpool* I do not consider the effect of the CJEU's judgment in *L'Oreal* to go that far."

49. In relation to unfair advantage, in its skeleton argument, the opponent stated:

"34. In this case, the creation of a link between the opponent and the applicant will enable the applicant to take unfair advantage of the opponent's reputation and thereby increase the numbers of customers buying its products without having to make the associated investment.

35. Furthermore, it is submitted that the applicant plainly intended to take advantage of the opponent's reputation, or alternatively knew of the opponent's reputation and intended to sail close to the wind. The opponent points to the following matters in particular:

(a) The opponent's earlier trade marks are very well known worldwide. It is inconceivable that the applicant chose the highly similar contested mark without knowing of the opponent and its rights in the word HOOVER.

(b) No legitimate reason has been put forward as to why the name HOOVER was chosen as the name of the applicant's business. That term has no descriptive relevance to lawnmowers. It is therefore reasonable to infer that the applicant chose that name with the specific intention of drawing on the opponent's reputation."

50. As the evidence shows, the opponent has for many years conducted a trade under its HOOVER trade mark in the UK in relation to a range of domestic appliances. Given the strength of the opponent's reputation and the image it portrays (which as the evidence shows and as Ms Cole fairly characterised at the hearing as including, longevity, quality, innovation and diversification), the use by the applicant of the trade mark the subject of the application is likely, in my view, to make consumers more inclined to select goods sold under its trade mark than might otherwise have been the case. That, in my view, results in an obvious advantage to the applicant, as it would free-ride on the reputation the opponent had established without having to go through the marketing effort and expense of educating its customers in the same manner as did the opponent.

51. As to whether the advantage is unfair, the applicant could have chosen any trade mark under which to conduct its trade in the goods for which registration is sought. In those circumstances, it is an irresistible inference that its decision to adopt a trade mark highly similar to the opponent's HOOVER trade mark was to create in the relevant consumer's mind a connection with the opponent and its business. That, in my view, is sufficient to result in the advantage gained being regarded as unfair. As a consequence, the objection based upon unfair advantage succeeds as does the opposition under section 5(3) of the Act. I will, however, go on to consider the other heads of damage as well.

Detriment to repute - tarnishing

52. In *Unite The Union v The Unite Group Plc*, Case BL O/219/13, Ms Anna Carboni as the Appointed Person considered whether a link between an earlier mark with a reputation and a later mark with the mere potential to create a negative association because of the identity of the applicant or the potential quality of its goods/services was sufficient to found an opposition based on detriment to reputation. She said:

“46. Indeed, having reviewed these and other opposition cases, I have not found any in which the identity or activities of the trade mark applicant have been considered in coming to a conclusion on the existence of detriment to repute of an earlier trade mark. I can understand how these matters would form part of the relevant context in an infringement case, but I have difficulty with the notion that it should do so in an opposition. After all, many, if not most, trade mark applications are for trade marks which have not yet been used by the proprietor; some are applied for by a person or entity that intends to license them to a third party rather than use them him/itself; and others are applied for by an entity that has only just come into existence.

47. I do not exclude the possibility that, where an established trading entity applies to register a mark that it has already been using for the goods or services to be covered by the mark, in such a way that the mark and thus the trader have already acquired some associated negative reputation, perhaps for poor quality goods or services, this fact might be taken into account as relevant “context” in assessing the risk of detriment to repute of an earlier trade mark. Another scenario might be if, for example, a trade mark applicant who was a known Fascist had advertised the fact prior to the application that he was launching a new line of Nazi memorabilia under his name: I can see how that might be relevant context on which the opponent could rely if the goods and services covered by the application appeared to match the advertised activities. But I would hesitate to decide an opposition on that basis without having had confirmation from a higher tribunal that it would be correct to take such matters into account.”

53. The opponent’s position is that as its goods are known for their quality, its lack of control over the applicant’s goods (which may be of an inferior quality to its own), would tarnish its reputation, leading to, for example, “damaging online reviews or viral postings on social media.” However, as there is no evidence to suggest that the applicant’s

goods are or will be of poor quality, I reject this submission on the basis of the comments in *Unite The Union v The Unite Group Plc*. The opposition based upon tarnishing fails.

Detriment to distinctive character - dilution

54. In *Environmental Manufacturing LLP v OHIM*, Case C-383/12P, the CJEU stated:

“34. According to the Court’s case-law, proof that the use of the later mark is, or would be, detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered, consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future (*Intel Corporation*, paragraphs 77 and 81, and also paragraph 6 of the operative part of the judgment).

35. Admittedly, paragraph 77 of the *Intel Corporation* judgment, which begins with the words ‘[i]t follows that’, immediately follows the assessment of the weakening of the ability to identify and the dispersion of the identity of the earlier mark; it could thus be considered to be merely an explanation of the previous paragraph. However, the same wording, reproduced in paragraph 81 and in the operative part of that judgment, is autonomous. The fact that it appears in the operative part of the judgment makes its importance clear.

36. The wording of the above case-law is explicit. It follows that, without adducing evidence that that condition is met, the detriment or the risk of detriment to the distinctive character of the earlier mark provided for in Article 8(5) of Regulation No 207/2009 cannot be established.

37. The concept of 'change in the economic behaviour of the average consumer' lays down an objective condition. That change cannot be deduced solely from subjective elements such as consumers' perceptions. The mere fact that consumers note the presence of a new sign similar to an earlier sign is not sufficient of itself to establish the existence of a detriment or a risk of detriment to the distinctive character of the earlier mark within the meaning of Article 8(5) of Regulation No 207/2009, in as much as that similarity does not cause any confusion in their minds.

38 The General Court, at paragraph 53 of the judgment under appeal, dismissed the assessment of the condition laid down by the *Intel Corporation* judgment, and, consequently, erred in law.

39. The General Court found, at paragraph 62 of the judgment under appeal, that 'the fact that competitors use somewhat similar signs for identical or similar goods compromises the immediate connection that the relevant public makes between the signs and the goods at issue, which is likely to undermine the earlier mark's ability to identify the goods for which it is registered as coming from the proprietor of that mark'.

40. However, in its judgment in *Intel Corporation*, the Court clearly indicated that it was necessary to demand a higher standard of proof in order to find detriment or the risk of detriment to the distinctive character of the earlier mark, within the meaning of Article 8(5) of Regulation No 207/2009.

41. Accepting the criterion put forward by the General Court could, in addition, lead to a situation in which economic operators improperly appropriate certain signs, which could damage competition.

42. Admittedly, Regulation No 207/2009 and the Court's case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.

43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on 'an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case'.

55. The required change in economic behaviour may be inferred. In *32Red Plc v WHG (International) Limited and others* [2011] EWHC 665 (Ch), Henderson J. held that a change in consumers' economic behaviour could be inferred from the inherent probabilities of the situation. He said:

"133. Is there evidence of a change in economic behaviour brought about by the use of the Vegas signs? In the nature of things, direct evidence of such a change is likely to be hard to find in cases of the present type, although Mrs F provides a suggestive example of a customer who was nearly persuaded to change her allegiance as a result of a perceived connection between 32Red and 32Vegas. However, I see no reason why I should not have regard to the inherent probabilities of the situation, and in particular to the contrast between the marketing models of the two casinos. The similarity of their names, and the fact that 32Vegas was always operated as one of a number of linked casinos on the carousel model, lead me to conclude that an average online gambler would have been far readier to switch his allegiance from 32Red to 32Vegas, or to play with 32Vegas in the first place, than he would have been in the absence of such similarity. These are changes in economic behaviour, and I am satisfied on the balance of probabilities that such changes are likely to have occurred to a significant extent."

56. The opponent states:

“(a) Confusion as to origin would blur the distinctive character of the earlier marks by weakening their ability to identify domestic appliances as originating from the opponent and to distinguish the opponent’s goods from those which have a different origin.

(b) Thus, the strong exclusive character of those marks and their hold upon the public mind, obtained through extensive trade and promotion on the part of the opponent, would gradually be lost.”

57. I have already commented upon the extent and nature of the opponent’s reputation in its HOOVER trade mark. I accept that a further trade mark so similar to the opponent’s HOOVER trade mark may diminish the hold the opponent’s HOOVER trade mark may have on the relevant consumer. I also agree that given the extent and nature of the opponent’s reputation in its HOOVER trade mark, the applicant’s trade mark may lead to relevant consumers believing that some form of commercial link or association exists between the parties. However, even when considered from the perspective of the opponent’s trade in a range of domestic appliances, given the goods for which the applicant seeks registration, I do not see how that would equate to a change in the economic behaviour of the opponent’s customers and, as a consequence, the objection based upon dilution fails.

Conclusion under section 5(3) of the Act

58. The opposition based upon EUTM no. 2397131 succeeds in relation to unfair advantage but fails in relation to detriment to reputation and distinctive character.

The opposition based upon section 5(4)(a) of the Act

59. Although not strictly necessary, I will also deal with this ground of objection, albeit briefly. 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).”

60. As there is no evidence that the applicant has used the trade mark the subject of the application, the material date is the date of the application for registration i.e. 23 September 2017. In view of my earlier conclusions, I have no hesitation finding that at the material date the opponent had, for many years, been conducting a business in the UK under its HOOVER trade mark in relation to, broadly speaking, a range of domestic appliances and, as consequence, it had the necessary goodwill to launch its claim to passing off. I also have no doubt that the highly similar nature of the applicant's trade mark to that under which the opponent's business had been conducted, will result in a significant proportion of the relevant public being confused, leading to misrepresentation. That in turn will lead to damage to the opponent's business in, at

least, the manner described by Warrington L.J. in *Ewing v Buttercup Margarine Company, Limited*, [1917] 2 Ch. 1 (COA), when he stated:

“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.”

Conclusion under section 5(4)(a) of the Act

61. As a consequence of the above conclusions, the opposition based upon section 5(4)(a) of the Act also succeeds.

The oppositions based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Act

62. Having reached what I regard as very clear conclusions under both section 5(3) and 5(4)(a) of the Act, I see no need to consider these alternative grounds and, in the interests of procedural economy, decline to do so.

Overall conclusion

63. The opposition based upon section 5(3) of the Act in relation to unfair advantage has succeeded, as has the opposition based upon section 5(4)(a) of the Act. Subject to any successful appeal, the application will be refused.

Costs

64. As the opponent has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. At the hearing, Ms Cole pointed to: (i) the multiple Forms TM8

the opponent needed to consider, (ii) what she regarded as the irrelevant nature of the applicant's evidence, and (iii) as the opponent was not advised that the applicant would not be attending the hearing, the additional time spent preparing for the hearing to ensure that the applicant fully understood the case against it, as factors justifying an award to the opponent at the upper end of the scale outlined in the TPN mentioned.

65. While it is true that the unrepresented applicant had some difficulty in understanding the basis on which proof of use may be requested, it is also the case that the CMC which was held to discuss this issue dealt with what the tribunal considered were the excessive number of earlier rights being relied upon by the opponent under sections 5(1) and 5(2) of the Act. Although I agree Mr Oliver's statement and the accompanying exhibit was of little evidential value, that ought to have been immediately obvious to the opponent and, as a consequence, would have taken it very little time to review. Finally, whilst it is laudable that the opponent took extra time in preparing for the hearing in an effort to ensure that the applicant was aware of the case against it, the fact remains that it was the opponent who requested the hearing, a hearing the applicant elected not to attend. In summary, none of the factors I have identified persuades me that an award of costs at the upper end of the scale is appropriate.

66. Bearing the above in mind and reminding myself of my criticisms of the opponent's evidence, having applied the guidance in the TPN, I award costs to the opponent on the following basis:

Filing the Notice of Opposition and reviewing the counterstatement:	£300
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Preparing evidence and reviewing the applicant's evidence:	£600
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Preparing for and attending a hearing:	£500
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Official fee: £200

Total: £1600

67. I order GFY Innovations Ltd to pay to Candy Hoover Group S.R.L the sum of **£1600**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated 13 May 2019

C J BOWEN

For the Registrar

Goods and services being relied upon

EUTM nos. 2397131 & 2396620

Class 7

Machines; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); electrically operated commercial, domestic, household, industrial and kitchen apparatus, instruments and machines; electrically operated commercial, domestic household and industrial apparatus, instruments and machines for abrading, cleaning, polishing, scrubbing, sweeping and waxing floors and other surfaces; vacuum cleaning apparatus, instruments and machines; carpet cleaning apparatus, instruments and machines, apparatus, instruments and machines for extracting soil from carpets; apparatus, instruments and machines for washing and laundry purposes; washing machines; ironing machines; dishwashers; dish washing machines; spin drying machines; clothes wringing machines; clothes rinsing machines; saucepan scouring machines; filters and filtration devices; being parts of machines; drive belts; agitators for vacuum cleaners; brushes for electric motors; pumps and valves; compressors for apparatus, instruments, machines and installations for refrigerating, cooling and freezing; parts and fittings for the aforesaid goods.

Class 8

Hand tools and implements (hand operated); hand tools for polishing and scrubbing non-electric flat irons; parts and fittings for the aforesaid goods.

Class 9

Electric and electronic apparatus and instruments; electric irons; thermostats; timers and operating cycle programmers for stoves, ovens and microwave ovens, for drying, washing and dish washing apparatus and machines, and for electrically operated commercial, domestic, household, industrial and kitchen apparatus, instruments and machines; time switches; parts and fittings for the aforesaid goods.

Class 11

Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, cooling, water supply and sanitary purposes; refrigerated cabinets; apparatus and instruments for producing and dispensing chilled and hot beverages; air conditioning apparatus, instruments and installations; gas and electric ranges, stoves and ovens; water coolers; microwave ovens; barbecues; electrically-driven barbecue units for electric stoves; heating and cooling elements; electrically heated clothes drying apparatus; ventilating hoods; food warming and cooking apparatus; hot plates; toasting

apparatus; space heaters; humidifiers and dehumidifiers; deep freezing apparatus; water heaters; parts and fittings for the aforesaid goods.

Class 17

Parts and fittings included in class 17 for electrically operated commercial, domestic, household, industrial and kitchen apparatus, instruments and machines; parts and fittings included in class 17 for electrically operated commercial, domestic household and industrial apparatus, instruments and machines for abrading, cleaning, polishing, scrubbing, sweeping and waxing floors and other surfaces; parts and fittings included in class 17 for electrical and electronic apparatus and instruments; parts and fittings included in class 17 for apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, cooling, water supply and sanitary purpose; cleaning attachments, nozzles, tools and heads for cleaning apparatus, instruments and machines; dust receptacles non-metallic hoses and pipes.

Class 21

Household and kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paintbrushes); articles for cleaning purposes; parts and fittings included in class 21 for electrically operated commercial, domestic, household, industrial and kitchen apparatus, instruments and machines; parts and fittings included in class 21 for electrically operated commercial, domestic, household and industrial apparatus, instruments and machines for abrading, cleaning, polishing, scrubbing, sweeping and waxing floors and other surfaces; parts and fittings included in class 21 for electrical and electronic apparatus and instruments; parts and fitting included in class 21 for apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, cooling, water supply and sanitary purposes; devices for use in applying preparations to carpets, furniture and upholstery; brushes, cloths and pads for electrically operated commercial, domestic household and industrial apparatus, instruments and machines for abrading, cleaning, polishing, scrubbing, sweeping and waxing floors and other surfaces; parts included in class 21 of all such machines; and floor scrubbing, floor waxing and floor polishing machines, all for domestic use (none being electrically operated) and parts included in class 21 of all such machines.

Class 35

Retail services; retail store services; retailing; merchandising services; supply and provision of goods; mail order services; on-line shopping.

Class 37

Installation, repair, maintenance and rental of machines; installation, repair, maintenance and rental of electrical and electronic apparatus and instruments and machines; installation, repair, maintenance and rental of apparatus for lighting, heating,

steam generating, cooking, refrigerating, drying, ventilating, cooling, water supply and sanitary purposes.

Annex B

European Union Trade Mark (“EUTM”) no. 2397131 (shown in paragraph 2). The opponent indicates that it relies upon all of the goods and services for which the trade mark is registered i.e.

Class 1 - Chemicals for commercial, domestic and industrial use; bleaching preparations; bacteriological and chemical cleaning preparations; and polish and wax removing substances.

Class 3 - Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring, waxing and abrasive preparations; soaps; polish and wax; cleaning preparations for carpets, floors and other surfaces; degreasing preparations; detergents; washing soda; washing preparations; preparations for treating carpets and floors.

Class 6 - Non-electric cables and wires of common metal; ironmongery and small items of metal hardware; pipes and tubes of metal; safes; locks; windows and door security devices, fasteners, bolts and chains; window and door fittings; door springs and closers; door handles; cash boxes; ladders and step ladders; parts and fittings for the aforesaid goods.

Class 7 - Machines; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); electrically operated commercial, domestic, household, industrial and kitchen apparatus, instruments and machines; electrically operated commercial, domestic household and industrial apparatus, instruments and machines for abrading, cleaning, polishing, scrubbing, sweeping and waxing floors and other surfaces; vacuum cleaning apparatus, instruments and machines; carpet cleaning apparatus, instruments and machines, apparatus, instruments and machines for extracting soil from carpets; apparatus, instruments and machines for washing and laundry purposes; washing machines; ironing machines; dishwashers; dish washing machines; spin drying machines; clothes wringing machines; waste compactors and disposal apparatus, instruments and machines; clothes rinsing machines; shoe polishing machines; electric window cleaning machines and butter chums; saucepan scouring machines; tin-opening machines; juice extracting and squeezing machines; grinding machines; vegetable-peeling machines; potato chipping machines; vegetable slicing machines; fish cutting and preparing machines; bread and back slicing machines; hairdressing machines; furniture polishing machines, car cleaning and polishing machines; food mixing, blending, liquidising, juicing and grinding machines; knife sharpening machines; electric knives; coffee grinding machines; filters and filtration devices; being parts of

machines; drive belts; agitators for vacuum cleaners; brushes for electric motors; pumps and valves; compressors for apparatus, instruments, machines and installations for refrigerating, cooling and freezing; parts and fittings for the aforesaid goods.

Class 8 - Hand tools and implements (hand operated); hand tools for polishing and scrubbing mixers, blenders, liquidisers, grinders, juicers, mincers and chippers, all being hand tools and for use with food; knife sharpeners and can openers, all being hand tools, razors and non-electric flat irons; parts and fittings for the aforesaid goods.

Class 9 - Electric and electronic apparatus and instruments; electric irons; thermostats; timers and operating cycle programmers for stoves, ovens and microwave ovens, for drying, washing and dish washing apparatus and machines, and for electrically operated commercial, domestic, household, industrial and kitchen apparatus, instruments and machines; smoke, fire and heat detectors; fire extinguishers; detectors and surveillance apparatus and instruments, all being electrical; time switches, irons; door bells and chimes; burglar and fire alarms; door and window opening apparatus; parts and fittings for the aforesaid goods.

Class 11 - Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, cooling, water supply and sanitary purposes; refrigerated cabinets; apparatus and instruments for producing and dispensing chilled and hot beverages; air conditioning apparatus, instruments and installations; gas and electric ranges, stoves and ovens; water coolers; microwave ovens; barbecues; electrically-driven barbecue units for electric stoves; heating and cooling elements; electrically heated clothes drying apparatus; hair drying appliances; ventilating hoods; food warming and cooking apparatus; hot plates; toasting apparatus; space heaters; humidifiers and dehumidifiers; deep freezing apparatus; electric coffee percolators; kettles; water heaters; fans; electrically heated blankets for non-medical use; parts and fittings for the aforesaid goods.

Class 16 - Paper, cardboard and goods made from these materials, not included in other classes; printed matter; instruction manuals and booklets; dust bags for vacuum cleaning apparatus, instruments and machines.

Class 17 - Parts and fittings included in class 17 for electrically operated commercial, domestic, household, industrial and kitchen apparatus, instruments and machines; parts and fittings included in class 17 for electrically operated commercial, domestic household and industrial apparatus, instruments and machines for abrading, cleaning, polishing, scrubbing, sweeping and waxing floors and other surfaces; parts and fittings included in class 17 for electrical and electronic apparatus and instruments; parts and fittings included in class 17 for

apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, cooling, water supply and sanitary purpose; cleaning attachments, nozzles, tools and heads for cleaning apparatus, instruments and machines; dust receptacles non-metallic hoses and pipes; fire extinguishing blankets.

Class 21 - Household and kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paintbrushes); articles for cleaning purposes; steel wool; parts and fittings included in class 21 for electrically operated commercial, domestic, household, industrial and kitchen apparatus, instruments and machines; parts and fittings included in class 21 for electrically operated commercial, domestic, household and industrial apparatus, instruments and machines for abrading, cleaning, polishing, scrubbing, sweeping and waxing floors and other surfaces; parts and fittings included in class 21 for electrical and electronic apparatus and instruments; parts and fitting included in class 21 for apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, cooling, water supply and sanitary purposes; devices for use in applying preparations to carpets, furniture and upholstery; coffee pots and coffee grinders; hair brushes and tooth brushes; brushes, cloths and pads for electrically operated commercial, domestic household and industrial apparatus, instruments and machines for abrading, cleaning, polishing, scrubbing, sweeping and waxing floors and other surfaces; parts included in class 21 of all such machines; and floor scrubbing, floor waxing and floor polishing machines, all for domestic use (none being electrically operated) and parts included in class 21 of all such machines.

Class 28 - Toys, games and playthings; toy domestic appliances.

Class 35 - Retail services; retail store services; retailing; merchandising services; supply and provision of goods; mail order services; on-line shopping.

Class 37 - Installation, repair, maintenance and rental of machines; installation, repair, maintenance and rental of electrical and electronic apparatus and instruments and machines; installation, repair, maintenance and rental of apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, cooling, water supply and sanitary purposes

UK trade mark no. 680079 for the trade mark **HOOVER** which was applied for on 3 June 1949. The opponent indicates that it relies upon the following goods in class 7:

Washing machines, electric motors (not for land vehicles), electric clothes rinsing machines, electric shoe polishing machines, electric window cleaning machines and butter churns; floor polishing and floor waxing machines (not being for domestic use); and hairdressing machines, floor scrubbing machines, ironing

machines, mixing machines (domestic), saucepan scouring machines, tin-opening machines, juice extracting or squeezing machines, grinding machines (domestic), vegetable-peeling machines, potato chipping machines, vegetable slicing machines, fish cutting and preparing machines, and bread or bacon slicing machines.

UK trade mark no. 952459 for the trade mark **HOOVER** which was applied for on 12 December 1969. The opponent indicates that it relies upon the following goods in class 7:

Clothes washing machines, dish washing machines, clothes wringing machines, spin drying (water extracting) machines, tumbler drying machines, machines for ironing clothes, hair drying machines; floor polishing machines, shoe polishing machines, furniture polishing machines, car cleaning and polishing machines, floor washing and scrubbing machines, carpet sweeping machines (none being for domestic use), electric food mixing, blending, liquidising, juicing and grinding machines (non-domestic); electric motors included in Class 7; knife sharpening machines, electric knives, coffee grinding machines.

UK trade mark no. 1148682 for the trade mark **HOOVER** which was applied for on 13 February 1981. The opponent indicates that it relies upon the following goods in class 7:

Parts and fittings included in Class 7 for clothes washing machines, clothes wringing machines, spin drying (water extracting) machines, tumbler drying machines, and for electric motors (not for vehicles).

European Union Trade Mark ("EUTM") no. 2396620 (shown in paragraph 2). The opponent indicates that it relies upon the same goods and services shown in relation to EUTM no. 2397131.

UK trade mark no. 689068 for the device trade mark which was applied for on 15 May 1950. The opponent indicates that it relies upon the following goods in class 7:

Washing machines, electric motors (not for land vehicles), electric clothes rinsing machines, electric shoe polishing machines, electric window cleaning machines and butter churns, floor polishing, floor waxing and floor scrubbing machines (none being for domestic use); and hairdressing machines, ironing machines, mixing machines, (domestic), saucepan scouring machines, tin opening machines, juice extracting machines, fruit and vegetable squeezing machines,

grinding machines (domestic), vegetable-peeling machines, potato chipping machines, vegetable slicing machines, fish cutting and preparing machines, and bread or bacon slicing machines.

UK trade mark no. 952458 for the device trade mark which was applied for on 12 December 1969. The opponent indicates that it relies upon the following goods in class 7:

Clothes washing machines, dish washing machines, clothes wringing machines, spin drying (water extracting) machines, tumble drying machines, machines for ironing clothes, hair drying machines, floor polishing machines, shoe polishing machines, furniture polishing machines, car cleaning and polishing machines, floor washing and scrubbing machines, carpet sweeping machines, (none being for domestic use), electric food mixing, blending, liquidising, juicing and grinding machines (non-domestic); electric motors included in Class 7; knife sharpening machines, electric knives, coffee grinding machines.

UK trade mark no. 1148683 for the device trade mark which was applied for on 13 February 1981. The opponent indicates that it relies upon the following goods in class 7:

Parts and fittings included in Class 7 for clothes washing machines, dish washing machines, clothes wringing machines, spin drying (water extracting) machines, tumbler drying machines, and for electric motors (not for vehicles)

Annex C

Class 7 - Machines; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); electrically operated commercial, domestic, household, industrial and kitchen apparatus, instruments and machines; electrically operated commercial, domestic household and industrial apparatus, instruments and machines for cleaning, polishing, floors and other surfaces; vacuum cleaning apparatus, instruments and machines; carpet cleaning apparatus, instruments and machines, apparatus, instruments and machines for extracting soil from carpets; apparatus, instruments and machines for washing and laundry purposes; washing machines; ironing machines; dishwashers; dish washing machines; spin drying machines; clothes rinsing machines; filters and filtration devices; being parts of machines; drive belts; agitators for vacuum cleaners; brushes for electric motors; pumps and valves; parts and fittings for the aforesaid goods.

Class 9 - Electric and electronic apparatus and instruments; electric irons; thermostats; timers and operating cycle programmers for stoves, ovens and microwave ovens, for drying, washing and dish washing apparatus and machines, and for electrically operated commercial, domestic, household, industrial and kitchen apparatus, instruments and machines; time switches; parts and fittings for the aforesaid goods.

Class 11 - Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, cooling, refrigerated cabinets; gas and electric ranges, stoves and ovens; microwave ovens; heating and cooling elements; electrically heated clothes drying apparatus; ventilating hoods; food warming and cooking apparatus; deep freezing apparatus; parts and fittings for the aforesaid goods.

Class 17 - Parts and fittings included in class 17 for electrically operated commercial, domestic, household, industrial and kitchen apparatus, instruments and machines; parts and fittings included in class 17 for electrically operated commercial, domestic household and industrial apparatus, instruments and machines for cleaning, polishing, floors and other surfaces; parts and fittings included in class 17 for electrical and electronic apparatus and instruments; parts and fittings included in class 17 for apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, cooling; cleaning attachments, nozzles, tools and heads for cleaning apparatus, instruments and machines; dust receptacles non-metallic hoses and pipes.

Class 21 - Brushes (except paintbrushes); articles for cleaning purposes; parts and fittings included in class 21 for electrically operated commercial, domestic, household, industrial and kitchen apparatus, instruments and machines; parts and fittings included in class 21 for electrically operated commercial, domestic, household and industrial apparatus, instruments and machines for cleaning, polishing, floors and other surfaces;

parts and fittings included in class 21 for electrical and electronic apparatus and instruments; parts and fitting included in class 21 for apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, cooling; devices for use in applying preparations to carpets, furniture and upholstery; brushes, cloths and pads for electrically operated commercial, domestic household and industrial apparatus, instruments and machines for cleaning, polishing floors and other surfaces; parts included in class 21 of all such machines; and floor polishing machines, all for domestic use (none being electrically operated) and parts included in class 21 of all such machines.