

O-257-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION Nos 2350948 and 2366753
BY DUALIT LTD
TO REGISTER THE TRADE MARKS:**

**DUALIT,
DUALIT DAB**

IN CLASS 9

AND

**THE OPPOSITION THERETO
UNDER NOS. 92481 and 93010
BY KARSTADT QUELLE AG & SCHNEIDER UK Ltd.**

AND

**IN THE MATTER OF APPLICATION NO 2368710
BY KARSTADT QUELLE AG
TO REGISTER THE TRADE MARK:**

DUAL

IN CLASS 9

AND

**THE OPPOSITION THERETO
UNDER NO. 93484
BY DUALIT LTD**

Trade Marks Act 1994

**IN THE MATTER OF Application Nos 2350948 and 2366753
by DUALIT LTD
to register the trade marks:
DUALIT and DUALIT DAB
in Class 9
and the opposition thereto
under nos 92481 and 93010
by KARSTADT QUELLE AG & SCHNEIDER UK Ltd**

and

**IN THE MATTER OF Application No. 2368710
by KARSTADT QUELLE AG
to register the trade mark:
DUAL
in Class 9
and the opposition thereto
under no 93484
by DUALIT LTD**

BACKGROUND

1. This decision relates to 3 oppositions involving the same two parties which, at their request, were heard at the same time.

FIRST OPPOSITION – UK trade mark registration 2350948 for the trade mark DUALIT

2. On 8 December 2003, Dualit Ltd of County Oak Way, Crawley, West Sussex, RH11 7ST, United Kingdom, whom I will refer to as Dualit, applied to register the trade mark DUALIT under registration number 2350948. The application was published for opposition purposes in the “Trade Marks Journal” on 6 February 2004 with the following specification:

Apparatus for recording, transmission or reproduction of sound or images; radios, DAB radios, home entertainment systems, DVD players, DVDs CD-ROMs, digital cameras, mobile telephones, computer hardware, software and peripherals; automatic vending machines; weighing and measuring apparatus; parts and fittings of the aforesaid goods.

The above goods are in class 9 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

3. On 6 May 2004, Karstadt Quelle AG of Theodor-Althoff Strasse 2, D-45133, Essen, Germany, hereafter referred to as Karstadt, and Schneider UK Limited of 77 Dane Road, Sale, Manchester M33 7BP, UK filed a notice of opposition, hereafter referred to as Schneider. Karstadt is the owner, and Schneider is the exclusive licensee, of UK registration number 961804 for the trade mark:



which is registered for the following goods:

Record players, tape recorders, sound amplifiers, radio receiving apparatus, loudspeakers and fitted cabinets contained loudspeakers, and tuners for use with all the aforesaid goods, but not including metal framed fitted cabinets for loudspeakers.

The above goods are in class 9 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

4. Karstadt & Schneider are opposing this first application from Dualit on the basis of Sections 5(2)(b), 5(3), 5(4)(a) and 56 of the Trade Marks Act 1994 as amended, hereafter referred to as the Act. They seek refusal of the application in its entirety and an award of costs.

SECOND OPPOSITION – UK trade mark registration 2366753 for the trade mark DUALIT DAB

5. On 25 June 2004, Dualit applied to register the trade mark DUALIT DAB under registration number 2366753. The application was published for opposition purposes in the “Trade Marks Journal” on 3 September 2004 with the following specification:

Apparatus for recording, transmission or reproduction of sound or images; radios, DAB radios, home entertainment systems, DVD players, DVDs, CD-ROMs, digital cameras, mobile telephones, computer hardware, software and peripherals; automatic vending machines; weighing and measuring apparatus; parts and fittings of the aforesaid goods.

The above goods are in class 9 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

6. The specification sought by Dualit for this mark DUALIT DAB under registration no. 2366753 is the same as that sought by Dualit for the mark DUALIT under registration number 2350948, i.e.;

Apparatus for recording, transmission or reproduction of sound or images; radios, DAB radios, home entertainment systems, DVD players, DVDs CD-ROMs, digital cameras, mobile telephones, computer hardware, software and peripherals; automatic vending machines; weighing and measuring apparatus; parts and fittings of the aforesaid goods.

7. On 7 December 2004, Karstadt and Schneider filed a notice of opposition to registration number 2366753. This opposition is also based on UK registration number 961804 of the trade mark DUAL and device for the goods in class 9 referred to above.

8. Karstadt & Schneider are also opposing this second application from Dualit on the grounds of Sections 5(2)(b), 5(3), 5(4)(a) and 56 of the Trade Marks Act 1994 as amended. They seek refusal of the application in its entirety and an award of costs.

THIRD OPPOSITION – UK registration 2368710 for the trade mark DUAL

9. On 21 July 2004, Karstadt applied to register the trade mark DUAL under registration number 2368710. The application was published for opposition purposes in the “Trade Marks Journal” on 10 February 2005 with the following specification:

Record players, tape recorders, sound amplifiers, radio receiving apparatus, loudspeakers and fitted cabinets containing loudspeakers, and tuners for use with all the aforesaid goods; but not including metal framed cabinets for loudspeakers.

The above goods are in class 9 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. This notification also stated that the registration was proceeding because of prior rights in registration no. 961804. The applicant is the registered proprietor of UK registration no. 961804 for identical goods (as stated above)

10. On 14 June 2005, Dualit filed a notice of opposition to registration no 2368710. The grounds of the opposition, from paragraphs 2 and 3 of the statement of grounds, are:

“2. The mark DUAL is not an unusual way of describing the goods of the application, e.g. a dual turntable, namely a turntable having two decks, and therefore the public would not distinguish the goods by reference to those words from those products provided by other undertakings. The application should therefore be refused under S.3(1)(b).

3. The Mark DUAL conveys to potential customers that the goods of the application provided under the mark will have more than one purpose or function. The application should therefore be refused [*sic – refused*] under S.3(1)(c).”

Dualit seeks refusal of the application in its entirety and an award of costs.

11. On 19 September 2005, Karstadt filed a counterstatement denying all grounds of the opposition on the basis of “the existence of U.K. registered Trade Mark No 961894 DUAL Logo registered to the Applicant in relation to identical goods” and that the trade mark DUAL had “in fact acquired distinctive character as a result of the use made of it”. Karstadt seeks registration of the mark and costs in its favour.

12. On 16 January 2007, Karstadt assigned UK registration 961804 to Linmark Electronics Limited, Aura House, 77 Dane Road, Sale, Manchester, M33 7BP, UK, hereafter referred to as Linmark. Notification of the assignment was published in the Trade Marks Register.

13. Both sides filed evidence in all three oppositions. There was a significant level of overlap in some of the evidence filed in relation to the three oppositions.

14. Following various correspondence between the two sides, it was agreed that all three oppositions would be heard before me at a single hearing on 18 January 2007. Dualit was represented by Mr Richard Arnold, Queens Counsel, instructed by Jenson & Son. Linmark, formerly Karstadt, and Schneider was represented by Mr Henry Ward of Counsel, instructed by William A. Shepherd and Son.

15. For the purposes of this case, I consider that ‘record players’ and ‘turntables’ are synonymous terms for the same item – a piece of equipment that plays records using a rotating turntable.

EVIDENCE

16. At the hearing, the first and second oppositions on grounds under Section 5 in relation to Dualit’s applications were considered together and then the third opposition on grounds under Section 3 in relation to Karstadt’s application was considered. I have used the same approach in my summary of the evidence.

17. I have sought to identify where possible the evidence that is common to more than one opposition and also highlight that evidence that applies only to a specific opposition, for example, because of the relevant date of the application.

FIRST & SECOND OPPOSITIONS

Application no 2350948 for DUALIT and Application no. 2366753 for DUALIT DAB

EVIDENCE IN CHIEF OF THE OPPONENT – KARSTADT/SCHNEIDER

18. Karstadt filed separate evidence in chief in relation to both oppositions. In each case, this evidence comprised a witness statement and associated exhibits from Mr Ray Nugent. The witness statement from Mr Nugent dated 4 January 2005 with 4 associated exhibits RN1 to RN4 relates to application 2350948 to register the mark DUALIT. The witness statement from Mr Nugent dated 8 August 2005 with 7 associated exhibits RAN1 to RAN7 relates to application 2366753 to register the mark DUALIT DAB. Although there is some overlap, there are significant differences between both witness statements. I have summarised the evidence filed in relation to the mark DUALIT first and then that in relation to DUALIT DAB second, indicating where any overlay occurs.

19. I also note that the evidence that Karstadt has filed in its role as applicant in relation to the Third Opposition (application 2368710 for the trade mark DUAL - see below) also comprises a witness statement from Mr Ray Nugent with Exhibits RAN1 to RAN6. Other than the inclusion of some comments on the opponents evidence filed in that opposition, this witness statement from Mr Nugent, dated 24 March 2006, is identical to that dated 8 August 2005 and filed in relation to the mark DUALIT DAB. Exhibits RAN1-6 filed with this witness statement in relation to the mark DUAL are identical to Exhibits RAN1-RAN6 filed in relation to the mark DUALIT DAB (see below).

FIRST OPPOSITION – Application No 2350948 for the mark DUALIT

Witness Statement of Ray Nugent, dated 4 January 2005

20. Mr Nugent has been the managing Director of Schneider UK since 2002. He has been involved with this company since it was incorporated in 1995. He is the majority shareholder of Schneider UK and is fully conversant with all aspects of the company's business. Prior to his involvement with Schneider UK, Mr Nugent managed his own chain of specialist electronic retail shops.

21. Schneider were appointed as the agents of the German company Schneider Rundfunkwerke AG on 5 August 1995, hereafter referred to as SR. This company was the parent company of Dual GmbH who were the former proprietor of trade mark registration 961804. In July 1994, Karstadt purchased the DUAL registration from Dual GmbH.

22. Schneider UK's role as an agent of SR was to take orders for various electrical consumer products bearing the DUAL mark such as tape recorders, record turntables, televisions and video tape recorders, from customers which were then supplied directly to these customers by SR. From the date of appointment in August 1995 until June 2002, sales by Schneider consisted of turntables and parts and fittings for turntables. Sales were made to Richer Sounds PLC, a retailer of electronic goods, and to BBG Distribution Ltd, a wholesaler and importer of electronic goods and supplier to retail electronic goods stores. In the period 1 January 1999 to December 2002, 955 turntables worth just over £56,000 were sold to these two companies. In the period June 2001 to January 2002, 199 items of spare parts worth £805 were sold to the same two companies. I note that turntable sales varied significantly in this period, with sales of £32,000 in 1999, no sales at all in 2000, sales of just over £21,300 in 2001 and sells of only 2,800 for 2002.

23. Exhibit RN2 attached to the statement dated 4 January 2005 shows copies of invoices from Schneider to BBG Distribution Ltd and Richer Sounds PLC. These invoices are printed on plain paper only and I note that the formatting and presentation is not very consistent which makes these printouts somewhat difficult to decipher. It is possible to identify the name and address of Schneider and of Richer Sounds PLC on the invoices dated 6/1/99 and 30/7/99 which refer to the product ordered as a "Dual Automatic Turntable". It is possible to identify the name and address of Schneider and of BBG Distribution Ltd on 11 invoices: 2 of these are dated 21/6/01, 3 are dated 20/10/01, 3 are dated 26/11/01, 2 are dated 11/1/02 and the remaining 1 is dated 6/9/01. None of the BBG Distribution Ltd invoice printouts in Exhibit RN2 or Exhibit RAN2 contain any reference to the trade mark DUAL.

24. After June 2002, Schneider entered into an exclusive license with Karstadt to manufacture and sell class 9 goods under the DUAL mark. These goods could be manufactured in the UK or elsewhere. Schneider began selling a range of electronic hi-fi goods in 2003 and received orders from the ASDA supermarket chain for various of these goods. Exhibit RN1 provides a list of 256 towns and cities throughout the UK where ASDA stores are selling goods bearing the DUAL mark. The electronic goods sold by ASDA under the DUAL mark included turntables, walkman players, drive belts, DVD home cinema centres, DVD micro systems and super compact players.

25. In paragraph 7, Mr Nugent provides a list of orders for specific items received from ASDA on various dates in 2003 and 2004. Only those orders received up to 8 December

2003 the filing date for application no 2350948 can be taken into account for the mark DUALIT. These items are the DUAL 5 disc home cinema system (DHC501), the DUAL D38056 Personal CD player, the DUAL 2 Channel DVD Player, the DUAL mini CD System (MP200) which is a combined CD, radio & cassette player, the DUAL MP200 MIDI hi-fi system, the DUAL RCD 12 Personal CD Player, DUAL headphones and Accessories, and the DUAL ML904, which is a combined CD & cassette player.

26. In paragraphs 8 and 9, Mr Nugent provides details of the total number of items sold and the net sales value of these goods. He states that these are “For the period since Schneider’s appointment as licensee”. This appointment began in June 2002 and was still in place at the time that the opposition were filed. However, I am unable to determine from this evidence what was the situation on 8 December 2004, the filing date for the DUALIT mark. I do note that in paragraph 9, Mr Nugent states that in 2003 the following total net sales were achieved:

#	Product bearing DUAL trade mark	NET SALES VALUE (£)
1	DVD players	213,348.00
2	CD/cassette/radio players	482,563.30
3	CD players	1,065,625.44
	TOTAL (2003)	1,761,536.64

Almost all of these sales would have been achieved prior to 8 December 2003 and so I consider that these represent the sales of DUAL branded goods prior to the application date for the DUALIT mark.

27. A comparison of the net sales value in paragraph 9 and the number of products identified in paragraph 8, indicates that all the CD players (30,257) and all the CD/cassette/radio players (22,470) and 10% of the DVD players were sold in 2003. All the DVD Home Cinema Systems (1,102) and 90% of DVD players were sold in January & February 2004 which is after the filing date of the DUALIT mark.

28. Exhibit RN3 provides examples of orders received by Schneider from ASDA and examples of invoices from Schneider to ASDA for various electronic goods bearing the DUAL mark which cover the period May 2003 to February 2004. All the order forms clearly identify Schneider as the addressee and the products being ordered are all referred to as DUAL products and by a model number for example DUAL PLL Boombox , model no. DP160 (order dated 7 May 2003), Dual 3 Disc mini System, model no. MP300 (order dated 7 June 2003); Dual Micro System, model no. ML904. Unfortunately, many of the invoices provided in this exhibit have not been photocopied very well and the start of each entry is missing, so I am unable to determine with any certainty what products are listed on these invoices, if any reference has been made to the trade mark DUAL or to the model number associated with the product. I have been able to identify that the order dated 11 November 2003 corresponds to invoice dated 25 September 2003 for Dual 3 Disc Mini System, Model no. MP200, and to invoice dated 27 October 2003, for the same item, as both invoices refer to the relevant ASDA order numbers under ‘Our Ref’ and at the end of the list of products on each invoice. Only some of the products listed on these invoices are identified by reference to the word DUAL, for example, DUAL 2 Channel Superslim DVD Player (see for example copy of invoice #9207, dated 26 November 2003), DUAL Headphones (see for example copy of invoice #11571, dated 20 October 2003), DUAL RCD Personal CD Player (see for example copy of invoice #9049, dated 27 October 2003); or by the appropriate model no., for

example MP200, is the model number for the DUAL mini Hi-Fi system (see, for example, copy of invoice #9570, dated 3 December 2003).

29. Mr Nugent provides as exhibit RN4 some photographs of goods bearing the DUAL trade mark on the shelf in the ASDA Store, Eastfields, Manchester. I am unable to attach a date to the photographs. I note that they show packaging for some of the products referred to in paragraphs 7-9 of Mr Nugent's statement (such as the DUAL 5 disc home cinema system, the DUAL 2 Channel DVD Player, the DUAL mini CD System (MP200), and the DUAL ML904 system and some products, such as a DUAL branded TV, which is not referred to.

30. Exhibit RN4 also contains copies of two articles from Hi-Fi magazines that refer to DUAL turntables. The first article is a review of a DUAL turntable from Hi-Fi Choice magazine which appeared in the printed version of this magazine dated 2 March 2004. This date is after the filing date of the DUALIT mark. The second article is a review published in the May 2002 issue of Hi-Fi World magazine of the Dual CS5000 Semi-automatic turntable. It introduces the review with the following "It is hard to overstate the grip that the Dual brand had on Britain's 1980s hi-fi scene" and goes on to say that the reason for this success was based on a combination of its high quality build and value for money which was sustained through a number of generations of DUAL turntable products in this period.

31. In paragraph 2 of his statement, Mr Nugent states, that prior to 1995, "I understand that SR had an exclusive distribution agreement with a company called Ram Projects Limited who generated turnover of some £10 million from sales of products bearing the DUAL mark being televisions (TVs), video tape recorders (VCRs), turntables and audio products." No evidence is provided in support of this statement,

SECOND OPPOSITION – Application No 2366753 for the mark DUALIT DAB

Witness Statement of Ray Nugent, dated 8 August 2005

32. Mr Nugent states in paragraph 1 that he is the managing director of Schneider UK and that he makes his statement on its behalf and that he has unfettered access to the company's records. He then goes on to give a more detailed account of the origin and history of the DUAL brand and trade mark in paragraph 2 and in Exhibit RAN1 then he did in his witness statement dated 4 January 2005. He explains that the DUAL brand was first used in Leipzig, Germany, in 1908 to promote and sell a "spring wound motor". From these beginnings, DUAL became associated with hi-fi turntables and hi-fi equipment generally. Exhibit RAN1 provides a chronology of the major events in the history of the DUAL trade mark from 1908 to 2001. This chronology includes the same information provided by Mr Nugent in paragraphs 1 and 2 of his statement of 4 January 2005 which explains the relationship between Dual GmbH, Schneider Rundfunkwerke AG and Karstadt Quelle AG.

33. Mr Nugent adds new information to that provided in paragraph 2 of his witness statement dated 4 January 2005 when he states that DUAL "managed to compete effectively with cheaper imports during the 1970s and early 1980s" and that "Karstadt Quelle AG is wholly owned by TCL holdings" of China who also now own the DUAL brand.

34. Paragraphs 3, 4, 5, 6, 8 and 9 comprise the same information as that filed in Mr Nugent's witness statement dated 4 January 2005 in relation to the DUALIT mark.

35. Paragraph 7 provides details of some further sales of specific products bearing the DUAL mark to the ASDA Group over and above those provided in paragraph 7 of Mr Nugent's statement dated 4 January 2005. These extra sales relate to the following items: DUAL 2 Channel DVD Player (17/2 & 9/3/04); DUAL RCD Personal CD Player (22/3/04, 31/3/04); DUAL headphones and accessories (17/2/04, 26/2/04, 27/2/04 and the DUAL ML904 mini hi-fi system (17/3/04). As the application for the mark DUALIT DAB was not filed until 25 June 2004 all of this evidence can be considered. No further sales were reported for the DUAL 5 Disc Home Cinema System, the DUAL D3056 Personal CD player, the DUAL mini CD System (MP200), the DUAL MP200 MIDI hi-fi system.

36. Exhibit RAN2, referred to in paragraph 4, comprises the same a list of all the ASDA stores where goods bearing the DUAL mark are being sold as does the earlier RN2 Exhibit but, in addition, it also provides the addresses of these stores.

37. Exhibit RAN6 shows copies of invoices from Schneider to BBG Distribution Ltd, orders from ASDA to Schneider, and invoices from Schneider to ASDA. In addition to the invoices to BBG Distribution Ltd included by Mr Nugent in Exhibit RN3 attached to his witness statement of 4 January 2005, Exhibit RAN6 shows 1 new sale to BBG Distribution Ltd on 16/7/01; 4 further sales to the company on 11/01/02 (4); and 2 further sales on 21/6/01. However, none of the BBG Distribution Ltd invoice printouts in Exhibit RAN2 contain any reference to the trade mark DUAL. Despite Mr Nugent's assertion in paragraph 3 there are no invoices from Schneider to Richer Sounds PLC in this exhibit. But Exhibit RAN2 does include a spread-sheet summary entitled 'DUAL Sales by product years 1999 to February 2004' which confirms that sales to BBG Distribution Ltd on these dates were for DUAL branded goods and also that confirms that sales of 'Dual Automatic Turntable' were made to Richer Sounds Plc on 6/1/99 and 30/7/99.

38. Exhibit RAN3 comprises samples of the packaging used for DUAL products. Mr Nugent states in paragraph 10 that these are "copies of recent and current DUAL packaging". None of these samples are dated and the mark used on these packaging is different in form to that as registered, the strapline '80 years of innovation' and the symbol ® have been added, see below.

This exhibit also comprises a catalogue not included with the witness statement dated 4 January 2005 showing various DUAL turntables being distributed by a company called 'PACIFIC TECHNOLOGIES'. However, this also is not dated. However, I note that this catalogue shows the trade mark in the form as registered.

39. Mr Nugent also provides 3 new exhibits to his witness statement dated 8 August 2005 which comprises various materials not provided with his earlier witness statement. These are:

- (a) Exhibit RAN4: copies of advertising and promotional materials from ASDA for electrical goods including DUAL trade marked goods. I am only able to establish a date when 2 of these promotional leaflets were in use. The first entitled 'NOW crossword' has a closing date of 27 January 2005 and the second entitled 'Teen Now

competition' has a closing date of 9 May 2005. is before the filing date of the application. unable to establish when these materials were used.

- (b) Also included in RAN4 are a number of review articles from various electronic goods magazines. I am only able to establish dates for 2 of them: the review of the Dual DVD-859 DVD player in What HI-Fi? Sound & Vision dated June 2005 and the review from WHC (What Home Cinema) of the DUAL 501, dated September 2004.
- (c) Exhibit RAN5 comprises pages from the Schneider product catalogue, which while clearly showing the Dual trade mark on each page does not give any indication of when this catalogue was produced or in use.
- (d) Exhibit RAN7 is a copy of the Preliminary indication issued by the Trade mark registry in relation to the application to register the DUALIT mark. However, this has no relevance to the matters to be decided in the present case and I have treated it accordingly.
- (e) Exhibit RAN8 is an extract from the Trade Marks register showing that there is a UK registration for the trade mark DAB. This is so-called state of the register evidence and I will treat it accordingly in making my decision.

EVIDENCE IN CHIEF OF THE APPLICANT - DUALIT

40. Although Dualit filed separate evidence in relation to both oppositions, these are almost identical and for this reason I have summarised them together and noted any specific difference in relation to one or other of the applications as they arise.

Witness Statement of Martin Shires

41. The witness statement from Mr Shires dated 2 September 2005 filed in relation to application 2350948 for the mark DUALIT is identical to that dated 21 December 2005 filed in relation to application 2366753 for the mark DUALIT DAB.

42. Mr Shires is a buyer of multimedia equipment for House of Fraser PLC and has held buying positions in the company for eight years, House of Fraser have 52 stores in UK and stock over 40 multimedia products. He is familiar with Schneider UK as a business but has no experience dealing with them as they concentrate on goods sold through supermarkets. In the context of multimedia products, home entertainment systems and the like, Mr Shires does not consider "DUAL and DUALIT as being similar" and he thinks it unlikely that a customer of the House of Fraser would confuse the two brands.

Witness Statement of David Moore

43. Paragraphs 1-4 and 6-11 of the witness statement from Mr Moore dated 14 July 2005 filed in relation to application 2350948 for the mark DUALIT are identical to paragraphs 1-10 of the witness statement from Mr Moore dated 30 November 2005 filed in relation to application 2366753 for the mark DUALIT DAB.

44. Mr Moore is a chartered Patent Agent and partner at Jenson & Son and is representing Dualit in this case.

45. Exhibit DSM1 is a letter that Mr Moore received from the Novagraaf /William A Shepherd & Son, Patent Agents acting on behalf of Schneider UK Ltd. In the existence of

the opponent's DUALIT mark is acknowledged and Schneider is seeking consent to the use and registration of the mark DUAL in relation to domestic appliances in classes 7, 8, 9, 11, and 21. Examples are referred to such as kitchen blenders, toasters, kettles and liquidisers and blenders. Novagraaf go on to state it is their view that the marks DUAL and DUALIT are visually, conceptually and phonetically different and there is little potential (if any) for confusion. Exhibit DSM2 is the reply from Jenson which states that Dualit does not consent to use of the mark DUAL in relation to class 11 goods and asks that Schneider not register or use the mark DUAL in relation to class 11 goods.

46. Paragraph 5 refers to Exhibit DSM3, an unattributed witness statement, which is not signed and so has no value in relation to the current proceedings and I have treated it accordingly. Mr Moore deleted this paragraph and Exhibit from his witness statement dated 30 November 2005 filed in relation to application 2366753 for the mark DUALIT DAB.

47. Mr Moore comments on the dictionary meaning of the word 'dual' as an adjective meaning two or twofold, or double (see paragraph 6 and Exhibit DSM4). He then goes on to consider the meaning of 'dual' in relation to various audiovisual goods. Following various internet searches using Google to search UK sites only, Mr Moore provides examples of how the term 'dual' is used descriptively in relation to these goods. I have summarised these in Table 1 of the Annex to this decision. The products listed all use the term 'dual' to describe a feature or characteristic of the goods, all of these goods were available in the UK on the date the search was performed, 17 July 2005. The same evidence is filled in relation to both applications but different Exhibit numbers are used to identify it (see Table 1 in Annex to this Decision). The search was performed after the filing date of both applications.

48. Much of this evidence was also filed by Mr Moore in relation to the Third Opposition (application 2368710 for the mark DUAL) (see below) where Dualit is the Opponent.

Witness Statement of Leslie Gore Barten

49. Mr Barten is the Managing Director and principal share holder of Dualit and has held this position since 1985. He has worked for the company since 1974 and is authorised to make statements on behalf of the company.

50. Paragraphs 1-12 and 14-17 of the witness statement from Mr Barten dated 6 July 2005 filed in relation to application 2350948 for the mark DUALIT are identical to paragraphs 1-12 and 14-17 of the witness statement from Mr Barten dated 30 November 2005 filed in relation to application 2366753 for the mark DUALIT DAB. Exhibits LGB1-8 and 10-15 filed with both witness statements are identical. In addition to the quantity and value of sales figures for the years 1998-2003 listed in Exhibit LGB9 filed with the witness statement from Mr Barten dated 6 July 2005, Exhibit LGB9 filed with the witness statement from Mr Barten dated 30 November 2005 comprises some additional figures describing quantity and value of sales for first six months of 2004.

51. Paragraph 13 of the witness statement from Mr Barten dated 6 July 2005 provides figures for expenditure on advertising and promotion of the DUALIT product range for the years 1998-2003. Paragraph 13 of the witness statement from Mr Barten dated 30 November 2005 differs from this only in that it contains figures for one additional year, 2004, i.e. it covers the period 1998-2004.

52. Dualit was founded in 1946 by Mr Barten's father and was incorporated as Dualit Ltd in 1948. The company's first product, an electric heater which had two electrical heating bars that could be moved between two positions. This provided a dual light fire and the founder Mr Barten was coined for the trade mark DUALIT an engineer from this feature. This mark has been used by Dualit Ltd since 1946.

53. Mr Barten provides 16 exhibits with his witness statement. Exhibits LGB1-LGB3 show various types of 'state of the register' material which I have noted accordingly:

- (a) Exhibit LGB1, an extract from the Companies House register shows that only two companies have the word DUALIT in their name: Dualit Ltd and Dualit Marketing Ltd a subsidiary of Dualit, the applicant.
- (b) Exhibit LGB2 shows that Dualit is the owner of 15 registered trade marks, 10 UK marks and 5 Community Marks.
- (c) Exhibit LGB3 show the first 120 of 246,000 results of a Google™ search on the word DUALIT which Mr Barten states "shows that in commerce in the UK all uses of DUALIT refer to products of my company".

54. Mr Barten states in paragraph 8 and 9 that Dualit designed and commenced sales of toasters in 1948. He states that these were "catering toasters". Dualit has traded in toasters for over 50 years and these items have become known for their reliability and durability despite a relatively high price. In the 1990s, Mr Barten states that at this time Dualit was effectively known just for its catering equipment, in particular for its toasters. Exhibit KGB4 is a photograph of a cocktail shaker which Mr Barten states in paragraph 9 is from 1948. This appears to be provided as evidence that Dualit was selling products other than toasters. The name Dualit is engraved in the top lid of the shaker.

55. Mr Barten decided to expand the DUALIT product range into the market for domestic appliances. This move was prompted by his awareness that customers appreciated the durability of the company's products and of the trade marks.

56. Between 1995 and 2003, Mr Barten and Dualit extended the range of domestic kitchen appliances that it provided. He provides examples of UK design registrations for these various appliances in Exhibit LGB5 including coffee machines, a soup kettle, a bread bin, a corkscrew and foil cutter. However, again this is 'state of the register type evidence' which has little real value in this instance. There is no evidence that any of the items featured in these design registrations were manufactured or sold.

57. Exhibit LGB7 comprises a printout of the catalogue of all the Dualit products offered on the company's website (www.dualit.com). This includes a range of toasters, a range of catering equipment (blenders, catering grills, soup kettles, waffle iron), kettles, mixers, coffee grinders, weighing scales, cups. Mugs corkscrews and bottle stoppers. However, this printout is dated 3 July 2005 which is between 18-12 months after the relevant application dates for the DUALIT and DUALIT DAB marks respectively.

58. A significant amount of money was spent by Dualit in promoting its product range to the wholesale as well as retail trade. Mr Barten reports the following expenditure on various promotion activities in the years 1998-2003:

Table 1: Expenditure on promotional activities by Dualit Ltd in the period 1998-2003

<i>Activity</i> \ <i>Year</i>	<i>1998</i>	<i>1999</i>	<i>2000</i>	<i>2001</i>	<i>2002</i>	<i>2003</i>
Advertising & PR	14,155	33,429	46,868	64,740	52,425	42,390
Exhibitions	26,282	29,566	70,101	58,455	82,312	75,777
Other Promotional Activities	6,331	6,420	6,015	13,740	11,234	34,978
Promotional Material	56,934	4,037	45,987	57,686	24,124	17,431
Total	103,702	73,452	168,972	194,621	170,095	171,116

59. Exhibit LGB8 provides more specific details of the above expenditure indicating that expenditure was made throughout the UK to a variety of magazine publishers (such as Scottish Media Group, Reed Business Information); to retail suppliers of kitchen equipment, (such as Leekes); and to business directories such as the Yellow Pages.

Table 2: Quantity of various DUALIT products sold in period 1998-2004

<i>Activity</i> \ <i>Year</i>	<i>1998</i>	<i>1999</i>	<i>2000</i>	<i>2001</i>	<i>2002</i>	<i>2003</i>	<i>2004 (Jan-June only)</i>
Toasters	111,696	102,658	95,630	112,996	109,768	112,636	30,007
Kettles	6,389	6,830	6,781	10,235	11,965	40,138	18,499
Hotpot (soup kettles)	4,740	4,276	4,310	3,595	2,811	2,315	592
Toastie/Waffle	1,219	1,134	1,197	906	853	619	403
Conveyor/Grill	1,040	1,092	1,174	1,245	1,195	1,107	468
Coffee machines	973	1,206	1,235	6,159	9,699	14,672	4,320
Drink Preparation	95	86	79	66	55	45	-
Blender	26	14	22	18	17	127	665
Coffee Grinders	-	35	1,561	2,847	3,406	5,494	2,237
Bathroom & Kitchen Scales	-	-	11,252	7,803	8,719	10,141	1,996
Hand Mixer	-	-	-	-	-	-	9,032
Other	436	7,023	14,837	6,513	6,511	5,577	1,059
Total (#)	342,274	323,831	335,699	337,849	313,002	338,752	69,278

60. Exhibit LGB9 provides details of the sales of Dualit products in terms both of numbers of items sold (see Table 2) and in terms of cash value of items sold (see Table 3) in the same period 1998-2004 by both Dualit companies, Dualit Ltd and its subsidiary Dualit marketing Ltd. Mr Barten points out that although the total number of toasters being sold under the DUALIT brand has increased, the share of the business represented by sales of toasters has fallen from 77% (1998) to 68% (2003). The figures relating to quantity and cash value (in £) of sales for the first six months of 2004 can only be taken into account in relation to the second application from Dualit for the mark DUALIT DAB.

Table 3: Value of sales of various DUALIT products sold in period 1998-2004 in UK£ Sterling

<i>Year</i>	<i>1998</i>	<i>1999</i>	<i>2000</i>	<i>2001</i>	<i>2002</i>	<i>2003</i>	<i>2004 (Jan-June only)</i>
<i>Activity</i>							
Toasters	9,097,516	8,679,148	7,888,353	9,163,732	8,853,481	8,706,910	2,387,160
Kettles	297,197	308,648	301,285	459,054	501,943	1,200,000	522,755
Hotpot (soup kettles)	655,705	583,540	577,178	448,222	368,966	309,598	77,440
Toastie/Waffle	217,617	204,901	219,245	164,214	150,856	107,649	73,110
Conveyor/Grill	590,679	633,568	670,904	655,867	610,271	551,928	241,692
Coffee machines	91,722	117,524	122,594	612,450	996,706	1,062,744	360,431
Drink Preparation	24,128	20,598	19,244	17,737	13,232	10,154	-
Blender	3,236	2,709	3,380	2,943	2,793	8,797	43,060
Coffee Grinders	-	1,067	47,464	87,038	102,301	163,555	67,183
Bathroom & Kitchen	-	-	258,994	203,106	264,471	310,873	59,744
Hand Mixer	-	-	-	-	-	-	268,030
Other	27,950	106,735	166,720	79,787	76,010	75,572	16,879
Total (£)	11,844,577	11,424,478	11,019,796	12,652,853	12,496,694	12,756,113	4,117,484

61. Mr Barten then provides photocopied examples of various promotional materials and articles which mention Dualit products and/or show use of the trade mark DUALIT. These have all appeared in a variety of daily, weekly or monthly publications in the UK in the period July – December 2003 and are aimed both at the general retail consumer as well as at the trade or wholesale customer. These materials were provided to Dualit by a company called Romeike Limited and have been organised into 6 exhibits based on the month that the material was extracted: Exhibit LGB10 provides materials extracted in July 2003, Exhibit LGB11 provides materials extracted in August 2003; Exhibit LGB12 provides materials extracted in September 2003; Exhibit LGB13 provides materials extracted in October 2003; Exhibit LGB14 provides materials extracted in November 2003 and Exhibit LGB15 provides materials extracted in December 2003. Each example included in these exhibits gives details of the date the article was published, the frequency and the circulation of the publication as well as its target audience. These materials fall into two main categories:

- (a) articles in the general press including daily national papers, weekly Sunday papers and daily regional papers. Examples include:

Daily Mirror (12 July 2003)	A kitchen weighing scales referred to as a 'Dualit balance'. DUALIT mark visible on face of weighing scales
The Times (19 July 2003)	Dualit desk-top fan promotion from The Times Offer Direct by mail, phone or internet
The Guardian (G2, 7 August 2003)	Review of Dualit bathroom scales
The Mail on Sunday (28 September 2003)	Dualit filter coffee maker. DUALIT mark clearly visible on front of machine.
The Observer Magazine: Food Monthly (13 July 2003)	Dualit Espresso coffee machine competition. DUALIT mark clearly visible on espresso machine pictured
The Wall Street Journal (Europe Edition, 1 August 2003);	Dualit four-slice toaster. DUALIT mark just visible on front of toaster
Sunday Herald : Magazine (Scotland, 6 July 2003),	Dualit bathroom scales

Western Daily Press (west and south of England region, 23 July 2003)	A manually operated Espresso machine from Dualit
Wales on Sunday (Wales, 5 October 2003)	Dualit four-slice toaster.

- (b) articles from specialist magazines and periodicals that describe interior design, interior decorating, kitchen design, general home design, wedding preparation. A wide range of such magazines and periodicals which appear monthly, quarterly or bi-annually are represented. Examples, with the Dualit product, illustrated and/or discussed, include:

BBC Good Homes Magazine (August 2003),	A Dualit toaster and kettle help to provide a 'contemporary urban edge to the kitchen'
Period House (August 2003)	A three slot Toaster from Dualit. DUALIT mark visible on the toaster
Period House (September 2003)	A three slot Toaster from Dualit. DUALIT mark visible on the toaster
The World of Interiors (August 2003),	'Axis' cordless kettle from Dualit
Ideal Home (August 2003)	Toaster – a 'design classic' from Dualit
Ideal Home (September 2003)	Dualit Espresso coffee machine. DUALIT mark clearly visible on front of machine.
Real (9 September 2003)	Dualit two-slot toaster. DUALIT brand just discernible on side and front of toaster
The Real Homes Magazine (September 2003)	Dualit two-slice toaster. DUALIT brand visible on front of the toaster.
Kitchens, Bedroom & Bathrooms (October 2003)	Dualit Toaster and kettle. DUALIT mark visible on front of toaster shown.
In Style (December 2003)	Dualit Toaster. DUALIT mark clearly visible on side of toaster shown
Hello! (15 July 2003),	DUALIT Corkscrew – example of a stylish kitchen accessory. The DUALIT mark is visible on the body of the corkscrew
Woman (14 July 2003)	A Dualit four-slice Toaster – review of toasters, selected as winner on grounds of speed, reliability & efficiency although more expensive
Boys Toys (September 2003)	Dualit Filter Coffee machine reviewed. DUALIT mark visible on front and side of coffee machine.
The Independent Electrical Retailer (June 2003)	refers to updates to Dualit Toasters while retaining overall 'retro design'
Housewares Focus: Worlds Best Housewares Retailers (September 2003)	Both review 'The Steamer Trading Cookshop, Sussex, UK' – the managing director of the business refers to Dualit as a supplier of 'small electricals'.
Ideal Home (November 2003)	
Brides (September-October 2003)	Dualit Combi toaster. DUALIT brand visible on front and side of the toaster.
Wedding and Home (October-November 2003)	Three slice DUALIT toaster – 'Kitchen equipment doesn't get any better looking than this!'

62. The trade mark DUALIT was applied for on 8 December 2003 thus I am only able to take account of those extracts in Exhibit LGB15 that were published before that date. Some of the examples in this exhibit have a publication date of January 2004 which I have not taken into account in relation to this registration. However, all of Exhibit LGB15 can be taken into account in relation to the application for the DUALIT DAB trade mark (filing date 25 June 2004). Taking account of the relevant materials in Exhibits LGB10-15 in relation to the respective trade mark applications, it is clear that by far the most commonly mentioned Dualit product is the toaster (at least 80 references). DUALIT branded Coffee Machines of all types (17 references); Weighing Scales (11 references); and Kettles (6 references) also are

mentioned. Other items such as a Dualit ice crusher and Dualit coffee grinders were mentioned twice, a Dualit Desk fan, a Dualit corkscrew, a Dualit Soup Kettle, and Dualit coffee cups were mentioned once, in this period.

63. The final exhibit provided by Mr Barten, Exhibit LGB16, is an extract from the Patent Office Annual Report of 2002 which shows a Dualit Corkscrew with the trade mark DUALIT clearly visible on the body of the corkscrew. This illustration is captioned “The original Dualit toaster was first produced in 1946 and has become recognised as the best in the world. Dualit Limited has used its Intellectual Property to help diversify into creating new and innovative products like the Dualit corkscrew pictured here.”. Mr Barten says, in paragraph 17, that this indicates that “Dualit’s reputation has expanded far beyond its origins in toasters and that the general public is aware of this and that the product range continues to expand. This has become sufficiently part of the general knowledge of this country that it featured in the 2002 Patent Office Report”.

EVIDENCE IN REPLY OF THE OPPONENT – KARSTADT/SCHNEIDER

Second Witness statement of Ray Nugent

64. Karstadt filed a second statement from Mr Ray Nugent in reply to the evidence filed by the Applicant in relation to the first and second oppositions. The second witness statement from Mr Nugent dated 26 March 2006 in relation to application 2366753 to register the mark DUALIT DAB is identical to the second witness statement from Mr Nugent dated 26 July 2006 in relation to application 2350948 to register the mark DUALIT.

65. In this second witness statement Mr Nugent comments on the evidence provided by Mr Barten, Mr Moore and Mr Shires. Most of this commentary is submission and has been treated according. However, he does mark a number of points in relation to the evidence that I take note of:

- (a) The DAB radio in Exhibit LGB6 is not yet on the market. Thus this exhibit does not provide any evidence of reputation or evidence that there is an expectation on the part of the public that Dualit will be providing such goods or entering this market.
- (b) Small domestic kitchen appliances are not sold on the same shelf as radios, DAB radios, hi-fi systems and home entertainment systems. They have their own specific shelves or aisles in high street stores such as Curry’s or Dixon’s. Similarly these stores also sell Mobile Phones, televisions and vacuum cleaners on separate aisles or shelves. As a result, Mr Nugent submits that the only reputation that the DUALIT mark has will be in relation to small domestic kitchen appliances in the nature of food and drink preparation items all of which are sold in the same area, specific aisle or department in a retail store.
- (c) Mr Nugent refers to Exhibits DSM1 and DSM2 (see above) and states that Schneider and Karstadt consider that the same thinking applies to the DUAL mark and its reputation and goodwill in class 9 as Mr Moore indicates that Dualit apply to the DUALIT mark and its reputation and goodwill in Class 11.
- (d) Schneider does not have any dealings with House of Fraser. Mr Nugent states that in his view House of Fraser are a “small player in the electrical and electronic sales industry” and Mr Shires is not “best qualified to make a judgement in relation to same”.

THIRD OPPOSITION – UK registration 2368710 for the trade mark DUAL

EVIDENCE OF THE OPPONENT – DUALIT

Witness Statement of Mr David Moore

66. Mr Moore is a chartered Patent Agent and partner at Jenson & Son and is representing Dualit in this case.

67. Mr Moore has provided Exhibits DSM1-DSM7 with his witness statement dated 28 December 2005. Nearly all of this material has been provided by Mr Moore already in relation to the First (DUALIT) and Second Oppositions (DUALIT DAB). The dictionary definition of the word ‘dual’ in Exhibit DSM1 and the results from internet searches conducted on Google using the word ‘Dual’ with various terms that refer to audiovisual goods in Exhibits DSM2-6 are identical with earlier exhibits as summarised in Table 1 above. The results of these searches show products which all use the term ‘dual’ to describe a feature or characteristic of the goods. All of these goods were available in the UK on the date the search was performed 17 July 2005.

68. Exhibit DSM7 comprises the result from an internet search conducted on Google using the word ‘Dual’ with ‘loudspeaker’. This search was conducted on 28 December 2005, five months later than those exhibited in DSM2-6. This search, in the words of Mr Moore, shows that the word (‘dual’) “is also used entirely descriptively in several different contexts with loudspeakers”. This include:

- (a) an article, published in the November 1998 issue of Hi-Fi World, which describes ‘Tannoy dual concentric loudspeakers’ which were first manufactured in 1946 and contained a dual concentric unit. This dual concentric unit comprised a high-frequency pressure unit firing through the centre of a large base cone, hence use of the terms dual and concentric to describe the unit.
- (b) ‘dual channel beltpack’ and ‘dual headset’ products provided by Stonewood Audio from the www.stonewood.co.uk website;
- (c) ‘dual bass drivers’ and ‘dual rear port’ in relation to loudspeaker cabinet design of the Meridian DSP5200 loudspeaker from www.meridian-audio.com
- (d) ‘dual cone loudspeakers’ for automobiles from Blaupunkt from www.blaupunkt.co.uk; and
- (e) ‘dual woofers’, ‘dual magnets’, and ‘dual active mid/bass drivers’ in the Contour 1.8 loudspeaker from www.frankharvey.co.uk.

EVIDENCE OF THE APPLICANT – KARSTADT/SCHNEIDER

69. This comprises a witness statement from Mr Ray Nugent dated 24 March 2006 with exhibits RAN1-RAN6. Paragraphs 1 and 3-11 of the witness statement and Exhibits RAN1-6 are identical to those in Mr Nugent’s witness statement dated 8 August 2005 filed in relation to the second opposition (the trade mark DUALIT DAB). Paragraph 3 and RAN1 relate to history of Dual brand up to the present. Paragraphs 4-11 and Exhibits RAN2-RAN6 discuss the value and volume of sales of various DUAL branded goods to ASDA Stores, RICHER SOUNDS Ltd and BBG DISTRIBUTION Ltd in the period 1999-2004. The comments I

have made in my earlier summary of this material (see paragraphs 22, 23 and 37 above) apply equally in this case.

70. I will now go on to summarise the new material in this witness statement dated 24 March 2006 from Mr Nugent.

71. In response to Exhibits DSM2-DSM7 provided with the witness statement of David Moore, Mr Nugent states, in paragraph 2 of his statement, that “words that have acquired distinctiveness by reason of use and reputation can be registered under the provisions of the Trade Marks Act, despite that word potentially having descriptive connotations. The trade mark DUAL has been used here in the United Kingdom on a substantial scale and over a long period of time”. In paragraph 11, Mr Nugent asserts that the DUAL brand has acquired distinctiveness through use because “the DUAL trade mark has been used here in the United Kingdom for many decades and more so in the last 10 years with significant sales by ASDA Stores and otherwise”. However, in this regard, I note that the earliest evidence of sales of DUAL Record turntables is January 1999 and of other consumer electrical goods with the DUAL brand is July 2002.

72. In response to Mr Moores contention that the internet searches conducted by him show that the word DUAL is being used in a purely descriptive sense, Mr Nugent points out that the examples used by Mr Moores to carry out his internet searches involve the use of the word dual in conjunction with another word. The word Dual on its own, while being allusive to some dual quality of a product is meaningless without the other word or words which indicate what the dual quality is.

73. This concludes my review of the evidence.

DECISION

74. A significant part of the issues to be decided in these proceedings is the question of how distinctive is the DUAL trade mark for goods in class 9. This is of relevance to both the absolute grounds objection under Sections 3 of the Act to the registration of the DUAL word mark (the third opposition as referred to above) and to the relative grounds opposition under Section 5 of the Act to both the DUALIT and DUALIT DAB word marks (the first and second oppositions as referred to above). The assessment of the distinctiveness of the word DUAL has a number of elements:

- (a) firstly, how distinctive is the word DUAL for the applied for goods. This is the key question to be answered in relation to the Third opposition. Dualit argues that the word DUAL is descriptive in relation to the goods in class 9 that Karstadt & Schneider have applied for and thus registration should be refused;
- (b) secondly, how distinctive is the earlier DUAL mark. This mark is not for the word DUAL on its own, it is for a device mark which includes the word DUAL. Dualit argues that, as the word DUAL is descriptive for the goods in class 9 for which this mark is registered, the only distinctiveness that lies in this earlier mark is from the device elements. These device elements include, in the registered mark, a noticeable font and use of white text on black background, and, in the mark as used, use of a

white border, inclusion of the ® symbol and addition of a strap line ‘50 years of innovation’, in addition to use of the same noticeable font and use of white text on black background as in the registered mark. Karstadt & Schneider argue that the distinctive element of the earlier mark is the word DUAL and that the device elements are trivial in this regard. As a consequence any evidence that shows acquired distinctiveness through use relates to the word DUAL and not to the device.

(c) thirdly, what distinctiveness, if any, has the DUAL mark acquired as a result of its use in relation to goods in class 9.

75. Once the distinctiveness or otherwise of the word DUAL for goods in class 9 has been established, I can then turn to consider how likely it is that a consumer seeing goods in class 9 identified by the word mark DUALIT or DUALIT DAB would bring to mind the earlier mark DUAL and so be confused as to the origin of these goods. This is the key question to be decided in relation to the Second and Third oppositions.

76. Thus in reaching my decision, I will first consider the grounds under Section 3 by which Dualit is objecting to the registration of the word mark DUAL as the issues raised here also bear directly on the decision to be made on the grounds under Section 5 by which Karstadt and Schneider are objecting to the registration of the word marks DUALIT and DUALIT DAB.

SECTION 3(1) – ABSOLUTE GROUNDS OF REFUSAL

77. Section 3(1)(b) and (c) of the Act read as follows:

(i) “3.-(1) The following shall not be registered -

(a),

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d)

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

78. The main thrust of the opponent’s case is that ‘DUAL’ “not merely may be used in trade to describe all of the goods covered by the application but is in fact so used”. I propose, therefore, to start with the objection under Section 3(1)(c).

Section 3(1)(c) - Relevant Authorities

79. There are now a number of judgments from the ECJ which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 and Article 7(1)(c) of Council Regulation 40/94 (the Community Trade Mark Regulation), whose provisions correspond to Section 3(1)(c) of the UK Act. I derive the following main guiding principles from the cases noted below:

- (i) subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark – *Wm Wrigley Jr & Company v OHIM* – Case 191/01P (Doublemint) paragraph 30;
- (ii) thus Articles 7(1)(c) (Section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all – *Wm Wrigley Jr v OHIM*, paragraph 31;
- (iii) it is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes – *Wm Wrigley Jr v OHIM*, paragraph 32;
- (iv) it is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word ‘exclusively’ in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question – *Koninklijke KPN Nederland NV and Benelux Merkenbureau*, Case C-363/99 (Postkantoor), paragraph 57;
- (v) if a mark which consists of a word produced by a combination of elements is to be regarded as descriptive for the purposes of Article 3(1)(c) it is not sufficient that each of its components may be found to be descriptive, the word itself must be found to be so – *Koninklijke KPN Nederland NV and Benelux Merkenbureau*, paragraph 96;
- (vi) merely bringing together descriptive elements without any unusual variations as to, for instance, syntax or meaning, cannot result in a mark consisting exclusively of such elements escaping objection – *Koninklijke Nederland NV and Benelux Merkenbureau*, paragraph 98;
- (vii) however such a combination may not be descriptive if it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements – *Koninklijke Nederland NV and Benelux Markenbureau*, paragraph 99.

80. Two other cases are relevant in considering the application of these principles. In *Campina Melkunie BV and Benelux-Merkenbureau* – Case C-265/00 (BIOMILD) the ECJ indicated that a mark consisting of a neologism composed of elements descriptive of characteristics of the goods was itself descriptive of those characteristics within the meaning of Article 3(1)(c), unless there was a perceptible difference between the neologism and the mere sum of its parts. In contrast, in *Procter & Gamble Company and OHIM*, Case C-383/99P (BABY-DRY) the Court held that, whilst the word combination, BABY-DRY

unquestionably alluded to the function of the goods, this did not satisfy the disqualifying criteria set out in Article 7(1)(c) of the Regulation. This was because, whilst each of the two words in the combination may form part of expressions used in everyday speech their syntactically unusual juxtaposition was not a familiar expression in the English language either for designating the goods in question (babies' nappies) or for describing their essential characteristics.

Acquired Distinctiveness – relevant authorities

81. The guiding principles to be applied in determining whether a mark has become distinctive through use are to be found in *Windsurfing Chiemsee Produktions v Huber* [1999] E.T.M.R. 585.

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: 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 class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

82. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.”

83. I also bear in mind Morritt LJ's observation in *Bach and Bach Flower Remedies Trade Mark* [2000] RPC 513 that:

“..... use of a mark does not prove that the mark is distinctive. Increased use, of itself, does not do so either. The use and increased use must be in a distinctive sense to have any materiality.”

84. There are degrees of distinctiveness/indistinctiveness. It is well established that, when comparing marks the distinctive character of the earlier trade mark is a factor to be taken into account (*Sabel BV v Puma AG* [1998] E.T.M.R. 1). A borderline distinctive mark will not attract the same penumbra of protection as an invented word or otherwise highly distinctive mark. The same must also be true in the case of marks that do not have the requisite degree of distinctiveness to achieve registration. A mark may narrowly fail the test or in the case of, say, a generic word or description it may be so wanting in distinctive character that it is incapable of improving its status. Use may assist the former but not the latter as the *Bach* case indicates. It must also follow that the amount of use required to demonstrate that the requisite distinctiveness has been achieved is likely to be dependent on the strength of the objection in the first place.

ANALYSIS

85. There was no disagreement between both sides as to the law and relevant authorities to be applied. Mr Ward, in his skeleton argument, accepted that it would be “futile” to argue that the word mark DUAL was not descriptive in relation to some of the goods applied for, in particular, “dual turntables, dual cassette decks and tape recorders, dual CD players, dual band radios and dual DVD players”. However, the word, he argued, has no meaning in relation to sound amplifiers, loudspeakers and fitted cabinets containing loudspeakers. He makes no comment in relation to ‘tuners for use with all the aforesaid goods’.

86. Mr Ward thus considers that the question to be answered in relation to Section 3 is has the word DUAL acquired distinctiveness through use in relation to those goods where the descriptive connotation of this word exists. In order to demonstrate that it has, Mr Ward relies on the decision of ECJ case C353-03, *Societe des Produits Nestle v Mars UK Ltd* (HAVE A BREAK Trade Mark), which states that “*the distinctive character of a mark referred to in Article 3(3) of the directive may be acquired in consequence of the use of that mark as part of or in conjunction with a registered trade mark*”. Thus, use of the earlier registered DUAL mark can be taken into account because the distinctive character or element of this earlier mark, and of the mark applied for, is the word DUAL.

87. Mr Arnold did not accept that the word DUAL was not descriptive in relation to sound amplifiers and loudspeakers. He considers that DUAL is descriptive in relation to all the goods applied for by Karstadt/Schneider. He refers to the evidence and exhibits provided by Mr Moore in support of this point which is discussed below.

88. The evidence of Mr Moore shows use of the word dual to refer to some characteristic of various goods applied for by Karstadt & Schneider under the word mark DUAL. This was established by conducting internet searches using the word ‘dual’ and the additional search term shown in Table 1. Column 3 of this table lists all the terms using the word ‘dual’ which were found in the Exhibited materials. I note that the word ‘dual’ has many and different uses in relation to various characteristics of these goods and that additional words are usually necessary to give the term ‘dual’ its descriptive meaning (see Table 1 and Exhibits DSM1-6). This evidence shows that the word ‘dual’ can be used to refer to any number of parts of this equipment which has a two-fold character.

89. Mr Moore also conducted a search using ‘dual + loudspeaker’ to address the specific point made by Mr Arnold that use of the word Dual was not descriptive in relation to loudspeakers and amplifiers. The results are shown in Exhibit DSM7. The article from Hi-Fi world dated November 1998, refers to a dual concentric loudspeaker where two loudspeaker cones are inserted one within the other. This feature has existed since 1946. The term ‘dual port’ also appears to be commonly used in relation to loudspeakers. Two examples are provided in this Exhibit (DSM7), one from November 1998 and one from 12 December 2005. Although the latter is a date falling after the application date for the DUAL mark, it does confirm that the term or phrase ‘dual rear port’ or ‘dual port’ in the earlier 1998 article continues in use up to the present. There is also use of the word ‘dual’ in a reference to two way communication equipment as dual channel communication equipment. The extract from the website of Frank Harvey Hi-Fi in Exhibit DSM7 also shows use of the word dual to describe various features of a loudspeaker. It refers to ‘dual woofers’, ‘dual magnets’ and ‘dual active mid/bass drivers’. Although, this page is dated 12 December 2005, 17 months

after the application date, it still is relevant in establishing how widely used the term 'dual' is used to describe features of audiovisual goods such as loudspeakers. However, I find that while the term 'dual' is used to refer to the presence of some two-fold element in the loudspeakers, it is not clear to me that it is being used to describe a feature, quality or characteristic of these goods which will serve in trade to describe these goods. Even taking account of the fact that use of the descriptive term does not have to be common or often, it just has to be possible, I do not consider that the examples provided by Mr Moore are sufficient to show that the word 'dual' may serve in trade to designate a quality or other characteristic of loudspeakers. At best, I consider that the word DUAL in relation to loudspeakers may allude to the idea of two-fold but is not descriptive. Thus I disagree with Mr Arnold that use of the word dual is descriptive in relation to loudspeakers and amplifiers.

90. However, what I am concerned with is not whether the word 'dual' can be used to describe some feature of these goods in general but whether, as Section 3(1)(c) requires, it serves in trade to denote a quality or other characteristic of the goods or services at issue. Is the word 'dual' descriptive of a feature on which sales of the goods are made, i.e., a sign or indication which may serve in trade to designate the kind, quality, ..., or other characteristic of goods or services". Having looked carefully at all Mr Moores evidence, I find that not all of his examples show goods that are sold on the basis of a dual feature or characteristic. I am satisfied that use of the word dual to refer to the presence of two output devices, e.g., dual turntable, dual CD player and dual cassette deck is use in trade to denote a characteristic of the goods. I am also satisfied that this word is used to describe an important characteristic of radio receiving apparatus which would influence consumers in purchasing such goods, namely, dual band receivers such as FM and AM bands or FM and digital bands. However, I do not find that the same can be said in relation to loudspeakers, amplifiers or tuners. In respect of the latter regard, I consider that use of the word 'dual' in relation to the goods applied is allusive rather than descriptive.

Acquired Distinctiveness through Use

91. In order to decide if a trade mark has acquired distinctiveness through use, it is first necessary to examine the inherent distinctiveness of the mark in order to determine how much evidence of use is required to show that the mark has acquired distinctiveness. If a mark has a high level of inherent distinctiveness, for example because it is an invented word, then the amount of evidence required to show that the mark has acquired distinctiveness in the minds of consumers is less than if a mark has a low level of inherent distinctiveness, for example, because it is a dictionary word. If the mark has very low distinctiveness, for example, PETROL for cars and related goods, then one can appreciate that the amount of evidence required showing that this mark has become distinctive enough to denote trade origin to the general consumer will be very high and may even be impossible.

92. As Mr Moore has pointed out in his witness statement, DUAL is a dictionary word meaning two or two-fold, Thus it has less distinctiveness than an invented word. In addition and as discussed above, the word 'dual' can describe a feature or quality that could impact on the trade (e.g., sale) in some of the goods for which registration is sought, namely, record players, tape recorders and radio receiving apparatus. Thus, Karstadt has a higher threshold to meet to show that the word DUAL has acquired distinctiveness in relation to these goods than it does in relation to loudspeakers, sound amplifiers and tuners.

93. The DUAL mark as registered and as used is shown below. The dominant and distinctive element of both of these marks is the word DUAL. When compared together, the extra device elements in the mark as used are not sufficient to alter the distinctive element of the mark as registered – the word DUAL. If asked to describe these marks, an observer would, I am satisfied, be drawn to the word DUAL and would refer to either mark as a DUAL word mark.

Mark as registered	Mark as used (see, Exhibit RN4)
	

94. Mr Arnold argues that both of these marks are device marks. Inclusion of a descriptive word such as dual into these marks does not alter the fact that the word is descriptive and thus incapable of serving as an indicator of trade origin. The distinctiveness of these marks must therefore reside in the device elements that they contain. However, the device elements that Mr Arnold refers to – white text on a black background or an unusual font where the lower case letters are almost as large as the capital letters – is not enough to alter the fact that both these marks are highly similar and that the dominant and distinctive element of both of these marks is the word DUAL.

95. Turning to consider the evidence that Schneider and Karstadt have provided to show that the word DUAL has acquired distinctiveness through use in relation to various goods in class 9, I note that there is evidence of sales of turntables and related spare parts for 3 years (1/1/99 to 31/12/02) to wholesalers of audiovisual goods, Richer Sounds PLC and BBG Distribution Ltd. According to Mr Nugent’s witness statement, both of these wholesalers cover the whole of the UK. Richer Sounds Plc has a network of 48 stores throughout the UK. Sales for 1999, 2000 and 2001 were significant but dropped off significantly in 2002 (see paragraph 4, 6 and 7 of Mr Nugent’s witness statement).

96. The drop off in sales of record players corresponds to the change in role of Schneider from the UK agent for sale and promotion of Kardstadt’s DUAL branded turntables and spare parts to the exclusive licensee for all DUAL branded products in the UK. This led to significant expansion in the goods being offered under the DUAL brand. In 2003, these included a range of audiovisual goods such as CD players, DVD players, radio’s, tape recorders, both alone and in combination with each other. In 2003, Schneider gained a contract to supply this wide range of DUAL branded goods to the UK Supermarket group, ASDA. The evidence of use of the earlier mark since 2003 relates to this one customer. ASDA had, at that time, 256 stores throughout the UK (see list of stores in Exhibit RAN2) so I am satisfied that DUAL branded audiovisual goods were being made available throughout the UK on a significant scale. For example, in the period 7 August 2003 to 31 March 2004, over £2.4 million worth of CD/cassette/radio playing equipment was sold. Thus significant sales of DUAL branded Goods were taking place throughout the UK before the application

date for the mark DUAL (21 July 2004). The invoices and summary of sales by product provided in Exhibit RAN7 confirm this.

97. I am unable determine what use was made of the DUAL brand prior to 1999 despite the statement in paragraph 4 of Mr Nugent's witness statement regarding sales of DUAL branded goods in Europe, including the UK, in the period 1995-1999. However, as the issue of the distinctiveness of the earlier DUAL mark is also relevant to the objections to Dualit's applications under Section 5, I also take note of the evidence that Karstadt have filed in respect of its opposition to these applications. In particular, I note the review article from May 2002 issue of Hi-Fi World magazine attached in Exhibit RN4 to the witness statement of Mr Ray Nugent, dated 4 January 2005, which describes the high degree of recognition and reputation amongst the trade and the general consumers that DUAL branded record players enjoyed in the 1980's.

98. The most useful material provided by Mr Nugent to answer this question on acquired distinctiveness is the sales data referred to above. Much of his remaining evidence has very little value in answering this question. The evidence of advertising and promotional activities provided by Mr Nugent is very limited. As Mr Arnold pointed out in his submissions, the examples of 'recent and current packaging' provided by Mr Nugent in Exhibit RAN4 are undated. The situation is not improved if I consider the corresponding Exhibits filed by Mr Nugent in relation to the opposition to the DUALIT mark (see Exhibit RN4) and to the DULAIT DAB mark (see Exhibit RAN4). At best I can consider that they relate to the date of the latest of Mr Nugent's witness statements, 24 March 2006, which is a long time after the relevant date (20 months). As such goods were not being sold in the UK until 2003, this packaging must relate to goods being sold under the DUAL brand after 1 January 2003. Although, the date of this packaging is uncertain, what is clear however is that some of these products are using the word dual in a descriptive sense to describe a characteristic of the goods and that this is use that may have an influence on their sale. This is even more obvious if one considers the original copies of the packaging filed in relation to the opposition to the DUALIT DAB application (see Exhibit RAN4) rather than the black & white photocopies filed in relation to the application for the DUAL mark. I note from all three of these exhibits that the packaging refers to a 'dual mini system' (two examples, code numbers mp 200 and mp201) which comprises a dual tape deck, a 'dual CD-cassette-radio' (three examples, code numbers p40, p100, p101) and a dual micro system (code number m1100).

99. The advertising and promotional materials referred to in Exhibit RAN5 are also very limited. Although it does show that ASDA was involved in promoting the DUAL trade mark, for example, through phone-in competitions in a magazine entitled as 'Chat', through various competitions, such as crosswords, multi-choice questions or word puzzles, it is not possible to establish that this had occurred to any great extent prior to the relevant date. The only dated material in this exhibit relates to a cross word competition with a closing date in June 2005 which shows use of the DUAL mark as registered, a review of a DUAL 859 DVD player from June 2005 and of the DUAL 501 DVD system from September 2004. At best, all I can conclude from this material is that ASDA was involved in promoting DUAL products and that by 2005, DUAL products were gaining recognition within the market as being a reasonable compromise between quality and price. The product catalogue from Schneider which is exhibited as RAN6 is also of very little help because it is undated. I cannot decipher when it was produced or downloaded from the internet. At best, I can assume that this relates to the situation at the time Mr Nugent made his witness statement, 24 March 2006. As a result, all it does is provide me with a list of all the products that Schneider UK has available

under the DUAL brand at that time. I cannot determine if all, or indeed any, of these goods were available at the relevant date in July 2004 when the DUAL mark was applied for.

100. In relation to loudspeakers, amplifiers and tuners, there is no specific reference to these goods in the evidence provided by Mr Nugent. However, these items are usually sold as part of the audiovisual equipment in order to provide an audible output sound. Loudspeakers have to be included with a CD player or a turntable or a cassette deck in order for a user to hear what is being played. I note that many of the items sold under the DUAL brand combine a number of different types of audiovisual equipment in one piece of equipment, for example, a combination of a cassette deck, a CD-player and a radio and loudspeakers in a so-called mini- or micro-system (models mp200 and mp201) or a combination of a DVD player, speakers, tuner and amplifier in the DVD Home Cinema system [model dhc501, see witness statement of Mr Nugent (paragraphs 5, 8, 9 and 10), relevant packaging & products in Exhibits RAN3 and review of model dhc501 from September 2004 in Exhibit RAN4]. These combinations of equipment, especially the home cinema system, include loudspeakers, amplifiers and tuners as a necessary part in order to provide an audible sound output.

Conclusion

101. Taking all of the above into account, I do not think that there is sufficient evidence to meet the threshold necessary to show that the word 'dual' has acquired distinctiveness in the mind of UK consumers so that they will associate the word DUAL when seen on goods such as record players, cassette players and radio receiving apparatus as being an indicator or origin rather than descriptive of a characteristic of the goods. There is clear evidence of use of the DUAL mark in the UK over the period 1999 to 2004 but this is not sufficient to establish distinctiveness. In the absence of further information, for example, the share of the market that DUAL branded goods have in relation to the whole market for such audiovisual goods, the effectiveness of promotional and advertising activities, a survey of consumers or other evidence from the trade that the word dual has gained distinctiveness, I have to conclude that the threshold required has not been met in relation to record players, tape recorders and radio receiving apparatus.

102. As I mentioned above, the threshold to show acquired distinctiveness through use in relation to loudspeakers, amplifiers and tuners is not as high as that required in relation to the other goods applied for in class 9. The evidence provided by Mr Nugent shows use of the DUAL mark on various items of audiovisual goods that include loudspeakers, amplifiers and tuners. I am satisfied that this is sufficient to meet the acquired distinctiveness threshold in relation to these goods given the greater distinctiveness of the word dual in relation to these goods.

103. I find that the opposition by Dualit to registration of trade mark registration no. 2368710, DUAL, by Karstadt on grounds of Section 3(1)(b) and 3(1)(d) of the Act is successful in relation to:

Record players, tape recorders, and radio receiving apparatus.

But is not successful in relation to:

sound amplifiers, loudspeakers and fitted cabinets containing loudspeakers, and tuners for use with all the aforesaid goods; but not including metal framed cabinets for loudspeakers.

81. The ground of opposition by Dualit under section 3(1)(c) of the Act to the registration of trade mark no 2368710 for the word DUAL by Karstadt is successful in part.

Section 3(1)(b) – Devoid of Distinctive Character

104. In relation to the objection under this ground, it was held in *Postkantoor* that:

“86 In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.”

105. On that basis the objection under Section 3(1)(b) will also have been made out without my needing to consider whether there is also an independent objection under this head.

106. As I have discussed above, I do not think that the word DUAL is descriptive for all the goods applied for in class 9. Mr Ward has conceded that it is descriptive in relation to Record players, tape recorders, and radio receiving apparatus and I agree. Thus, the objection to these goods under section 3(1)(b) is also made out. However, in relation to the other goods applied for, as I have also stated above, I do not think that the word DUAL is descriptive and as a consequence, I do not think that it is devoid of any distinctive character.

107. The word DUAL is allusive (to a two-fold feature) rather than descriptive in relation to these other goods, i.e., sound amplifiers, loudspeakers and fitted cabinets containing loudspeakers, and tuners for use with all the aforesaid goods; but not including metal framed cabinets for loudspeakers. Thus it has some element of distinctiveness although it may not be the highest.

108. The ground of opposition by Dualit under section 3(1)(b) of the Act to the registration of trade mark no 2368710 for the word DUAL by Karstadt is not successful

SECTION 5(2) – RELATIVE GROUNDS OF REFUSAL

109. Both sides agreed at the hearing that the most important grounds in relation to the DUALIT and DUALIT DAB applications (the first and second oppositions referred to above) was that under Section 5(2)(b). If the opponent fails on these grounds, they will fail on the Section 5(3) and 5(4)(a) grounds also. Section 56 adds nothing.

Section 5(2)(b) of the Act - Likelihood of confusion

110. According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

111. Section 6(1)(a) of the Act defines an earlier trade mark as:

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

112. UK registration 981604 for the trade mark DUAL has a filing date of 1 July 1970 and so constitutes an earlier mark under Section 6(1)(a) for the purposes of Section 5(2)(b).

Relevant Authorities

113. In determining the question under section 5(2)(b) of the Act, I take into account the guidance provided by the European Court of Justice (ECJ) in:

(i) *Sabel BV v Puma AG* [1998] RPC 199;

(ii) *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117;

(iii) *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77;

(iv) *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723;

and

(v) *Vedial SA v Office for the Harmonization of the Internal Market (marks, designs and models) (OHIM)* (case C-106/03 P) [2005] ETMR 23.

114. It is not required that actual confusion results between the marks in order for an opposition under Section 5(2)(b) to succeed. The test is the likelihood of confusion. In essence the test under section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion in the mind of a consumer. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the applicant's mark and the mark relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered within the respective specifications.

115. The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C. in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v. Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

116. Thus, I must consider whether the mark that the opponent is relying upon has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. I have already referred to the relevant authorities and issues to be taken account of when considering the distinctiveness that a trade mark can acquire through use.

ANALYSIS

117. The opponent’s DUAL mark and specification and the applied for DUALIT and DUALIT DAB marks and specifications are shown below for comparison purposes.

Comparison of the Marks

118. The nature and distinctiveness of the registered mark DUAL has been discussed above.

119. The differences between the DUAL mark as used and the DUAL mark as registered are not sufficient to alter the distinctive character of the mark which is the word DUAL and, as already discussed, while the device elements reinforce the visible impact of the mark they do not alter the fact that the comparison being made is in effect between the two words, DUAL and DUALIT.

Karstadt/Schneider (Opponent)	Dualit (Applicant)	
981604	2350948	2366753
	DUALIT	DUALIT DAB
Record players, tape recorders, sound amplifiers, radio receiving apparatus, loudspeakers and fitted cabinets containing loudspeakers, and tuners for use with all the aforesaid goods, but not including metal framed fitted cabinets for loudspeakers.	Apparatus for recording, transmission or reproduction of sound or images; radios, DAB radios, home entertainment systems, DVD players, DVDs CD-ROMs, digital cameras, mobile telephones, computer hardware, software and peripherals; automatic vending machines; weighing and measuring apparatus; parts and fittings of the aforesaid goods.	Apparatus for recording, transmission or reproduction of sound or images; radios, DAB radios, home entertainment systems, DVD players, DVDs CD-ROMs, digital cameras, mobile telephones, computer hardware, software and peripherals; automatic vending machines; weighing and measuring apparatus; parts and fittings of the aforesaid goods.

120. The applied for marks DUALIT and DUALIT DAB are word marks only, they comprise no device element. The word DUALIT has no meaning, it is an invented word [see explanation of the origin of the mark by Mr Gore-Barten (paragraph 3 of his witness statement)]. The term DAB is a known term or abbreviation for ‘Digital Audio Band’ and is commonly used to distinguish digital radio receiving apparatus from their analogue counterparts, for example in adverts. Thus while I do not consider that DUALIT is descriptive in relation to the goods applied for in class 9, I do consider that DAB is. As a result, the distinctive element in the DUALIT DAB mark is also the word DUALIT. Thus, I consider that the comparison that I must make in relation to the 5(2)(b) ground is between DUAL and DUALIT.

121. Dual is a four letter, two syllable word DU-AL. DUALIT is a six letter, three syllable word DU-AL-IT that shares the first two syllables with the earlier mark. The extra two letters adds a noticeable extra element at the end of the word from a visual and aural point of view. Aurally, the extra syllable does add quite a distinct and definite IT sound at the end of the word. Conceptually there is no link between the two marks. DUAL may be taken to allude to the characteristic of two or twofold as mentioned above. However, DUALIT does not bring this same concept to mind.

Comparison of the Goods

122. Before turning to the comparison of the goods, I note that the specification of goods for earlier mark has been partially revoked resulting in removal of the term ‘record players’ from the specification with effect from the 26 January 2004 (see UK Trade Marks Registry Decision BL O/301/05 in *Baillie v Karstadt Quelle AG*). The current specification for UK registration 961804 is thus:

Tape recorders, sound amplifiers, radio receiving apparatus, loudspeakers and fitted cabinets containing loudspeakers, and tuners for use with all the aforesaid goods, but not including metal framed fitted cabinets for loudspeakers.

I am entitled to take account of the earlier specification in relation to all use prior to 26 January 2004.

Nature of the Goods

123. The opponent's specification and the applied for marks specifications are shown above for comparison purposes. The applied for marks cover a wider range of goods in class 9 than the earlier DUAL mark does. Mr Arnold suggested that the goods applied for should be considered in the following five categories:

- (1) Apparatus for recording, transmission & reproduction of sound, radios, DAB radios
- (2) Apparatus for recording, transmission & reproduction of images, home entertainment systems, DVD players, DVDs
- (3) Digital cameras, mobile phones
- (4) CD-ROMs, computer hardware, software & peripherals
- (5) Automatic Vending machines, weighing & measuring apparatus

124. He then went on to argue that there is no similarity between the goods of the registered mark in relation to categories (3), (4) and (5) above and that the issue to be decided is the likelihood of confusion in relation to the goods in categories (1) and (2). Mr Ward argued that most of the goods in the specification were identical but acknowledged that automated vending machines, weighing and measuring apparatus, digital cameras and mobile phones, computer software and hardware were exceptions to this. However, he did consider that as Digital cameras and mobile phones fall in the category of electrical goods that would be sold in with or near the goods sold by the opponent that this similarity of the goods in question will increase the likelihood of confusion.

125. I agree only in part with these submissions. I agree that Automatic Vending machines, weighing & measuring apparatus (Mr Arnold's category (5)) are not identical or similar goods to those of the registered mark. However, I do not agree in relation to CD-ROMs, computer hardware, software & peripherals (Mr Arnold's category (4)). A computer and its related software can be used to transmit sound and images from a variety of sources, such as a CD, a CD-ROM, a DVD, a computer disc (though these are becoming increasingly rare) and by downloading from the internet, e.g., podcasts. Mobile phones can also be used to download and view images or listen to music. Digital cameras are used to create images and store images which can be downloaded directly to a computer or printer. Thus, I consider that the goods in Mr Arnold's categories (1) and (2) adequately describe all the goods in categories (3) and (4) respectively. Apparatus for recording, transmission & reproduction of sound, will include radios, DAB radios, mobile phones, computers, and equipment such as home entertainment centres which combine a CD player, a cassette player and a radio. Increasingly, digital TVs and computers are being used to broadcast TV programmes, i.e., images and sound, and radio programs, i.e., sound. Apparatus for recording, transmission & reproduction of images will include home entertainment systems, DVD players, DVDs, CD-ROMs, computers, digital cameras and mobile phones. Also, apparatus that is capable of recording, transmission & reproduction of both sound and images will also fall into both categories. I consider also that there is a significant degree of overlap between Apparatus for

recording, transmission & reproduction of sound and Apparatus for recording, transmission & reproduction of images. Apparatus used for one is often capable of doing the other, for example, a mobile phone, a home entertainment centre, a computer.

The Market for the Goods

126. The goods of the registered mark are commonly referred to as consumer electrical goods or audiovisual goods. They are usually sold in high street stores such as Curry's or Dixon's or via the internet. The person buying the goods is clearly not buying a bag of sweets, but neither is he buying a house or a car. I accept that it is the case that such consumer electrical goods have become cheaper and more widely available in recent years so the degree of care exercised in choosing and purchasing these goods may not be as high as it was in the past. However, the cost of these items is still a significant one and a consumer will usually make the decision to purchase based on a combination of factors not just on price, for example, does this equipment have the features I want, does it do other things, is it reliable?

127. Goods such as radios, CD players, DVD player, mobile phones, digital cameras are sold in the same types of stores or in the same areas of larger stores, on the same shelves or side by side. Many products are sold which do both functions. Visual means is the principle means that the consumer will use to identify these goods and decide whether to purchase or not. This will apply whether the purchase is made directly at a shop or via an internet site. I consider that aural means will be much less important in making the decision to purchase. As a consequence, the visual appearance of the trade name or mark used to identify these goods will be an important factor in distinguishing the product of one undertaking from that of another.

Acquired Distinctiveness of the DUALIT mark

128. The applicant has argued that the mark DUALIT is well established in the minds of consumers and that they have been educated to associate this mark with goods produced by Dualit Ltd. As a result this acquired distinctiveness means that consumers will identify this word as an indicator of trade origin for the applied-for goods in Class 9. The first witness statement provided by Mr Gore-Barten and associated exhibits provides a lot of material which shows use of the mark DUALIT in relation to various goods all of which fall into class 11. Nearly all of these goods are for use in the kitchen whether domestic kitchens or those in cafes and restaurants. The only example of non-kitchen equipment is bathroom scales and possibly, air conditioner, which can be used in all areas of the house. However, the extent of the use of the DUALIT mark in relation to these goods is much more limited than in relation to toasters.

129. Although weighing and measuring apparatus, i.e., bathroom and kitchen scales, are goods which fall in class 9, these types of goods are not closely related to the consumer electrical or audiovisual goods of the specification as registered. They would not normally be sold in the same part of the shop or under the same category on a website as the consumer electrical audiovisual goods. Thus, while I am happy to accept that a person seeing the DUALIT mark on bathroom and kitchen scales would associate them with the same people that make the well-known toasters, this is not enough in my opinion to make the same link to other goods in class 9 applied for.

130. Having considered the evidence of Mr Gore-Barten in some detail, I am content that the mark DUALIT is very well known in relation to toasters. I am also content that this mark also has a reputation in relation to coffee machines (blenders, espresso etc) and kettles. However, I do not consider that the reputation established by the DUALIT mark in relation to toasters and some other goods in class 11 extends beyond the general area of kitchen equipment. I do not consider that this reputation, or as Mr Arnold puts it “the fame of DUALIT’s mark”, stretches far enough into the mind of the consumer purchasing goods in class 9 to firmly fix in their mind that these goods must be from the same people who make DUALIT toasters. In effect I do not consider that it is strong enough to ‘roll-over’ into the area of electrical goods in class 9.

Conclusion

131. Based on a global appreciation of all the above factors and bearing in mind the imperfect recollection of the consumer who will rarely if ever see both trade marks side by side, I am satisfied that a consumer, seeing the mark DUALIT on a radio or other apparatus for recording, transmission & reproduction of sound or on a DVD player or other apparatus for the recording, transmission & reproduction of images, is unlikely to confuse it with the applicants DUAL mark for the same goods. DUALIT is an invented word and as such it attracts a high degree of inherent distinctiveness. I do not think that, on balance, a consumer will see this mark as anything other than the word DUALIT. For example, I do not think that they will see it as a ‘DUAL + IT’ mark. There is nothing to prompt such a break down, especially in relation to these goods in class 9. Although, it is well established case law that the ends of words are less important than the beginning of words in establishing how a trade mark is brought to mind by a consumer, in this case, I am satisfied that on balance the extra syllable does make a difference. I do not think that on balance, even allowing for imperfect recollection that word DUALIT will be recalled as DUAL.

132. If a consumer is unlikely to be confused by the trade mark DUALIT in comparison to the trade mark DUAL, then this is also the case between the trade mark DUALIT DAB and the trade mark DUAL.

133. The ground of opposition by Karstadt under section 5(2)(b) of the Act to the registration by Dualit of trade mark no 2350948 for the word DUALIT and registration of trade mark no. 2366753 for the words DUALIT DAB does not succeed.

Costs

134. Karstadt has failed in their opposition to the registration of trade mark no 2350948 for the word DUALIT and trade mark no. 2366753 for the words DUALIT DAB by Dualit. As such Dualit is entitled to a contribution towards their costs.

135. Dualit have succeeded only in part in their opposition to registration of trade mark no 2368710 for word DUAL under Section 3(1)(c) and they have not succeeded in their opposition to this mark under Section 3(1)(b). As a result I consider that the overall amount awarded to Dualit should be reduced to take account of this.

136. Also, much of the evidence filed by Karstadt in relation to all three oppositions was substantially the same. Similarly, the evidence filed by Dualit in relation to the opposition to

trade mark no 2350948 for the word DUALIT and trade mark no. 2366753 for the words DUALIT DAB was also substantially the same and I have taken account of this also.

137. I order Karstadt, or their successor in title Linmark, to pay Dualit the sum of **£1400**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5th day of September 2007

**Dr Lawrence Cullen
For the Registrar,
the Comptroller-General**

O-257-07

ANNEX

**IN THE MATTER OF APPLICATION Nos 2350948 and 2366753 BY DUALIT LTD
TO REGISTER THE TRADE MARKS:**

**DUALIT,
DUALIT DAB**

**IN CLASS 9
AND THE OPPOSITION THERETO UNDER NOS. 92481 and 93010 BY KARSTADT
QUELLE AG & SCHNEIDER UK Ltd.**

&

**IN THE MATTER OF APPLICATION NO 2368710 BY KARSTADT QUELLE AG
TO REGISTER THE TRADE MARK:**

DUAL

**IN CLASS 9
AND THE OPPOSITION THERETO UNDER NO. 93484 BY DUALIT LTD**

Table 1: Descriptive use of the term DUAL in relation to Consumer Electrical Audiovisual goods – summary of results and relevant Exhibits.

	<i>Search Term Used (Google, UK)</i> <i>(search date: 14 July 2005 unless otherwise specified)</i>	<i>Examples found of Equipment available for purchase from UK websites (direct or via auction websites)</i>	<i>Use of word Dual</i>	<i>Exhibit TM application 2350948 (DUALIT)</i>	<i>Exhibit TM application 2366753 (DUALIT DAB)</i>	<i>Exhibit TM application 2368710 (DUAL)</i>
1	DUAL + RADIO	<p>dual band DAB/FM radios (1) Relisys RDAB100 Dual Band Digital Radio (DAB)</p> <p>(2) Crown CDR240 Portable Dual Band DAB/FM</p> <p>dual radio microphones, (3) Gemini UF2064 UHF Dual Radio Microphone System with 2 handheld microphones</p>	<p>Dual band</p> <p>Dual receiver</p> <p>Dual radio microphone</p> <p>Dual radio module</p> <p>Dual radio capability</p> <p>Dual zone</p>	DSM5	DSM4	DSM2
2	DUAL + TURNTABLE	<p>dual turntable disks (5) Gator GDJ-COFFIN-19 Dual Turntable w/19" 8U rack</p>	<p>Dual turntable</p> <p>Dual turntable scratching</p> <p>Dual independent scratching rings,</p>	DSM6	DSM5	DSM3

3	DUAL + TAPE RECORDER	<p>dual channel tape recorders (6) Sony D10 PRO dual channel tape recorder</p> <p>dual Speed DAT Recorders (7) Sony Dual Channel battery operated DAT recorder, model TCD D8 (Gracey & Associates Hire, UK) (8) TEAC DAT Recorder, model RD 135T</p> <p>dual cassette systems (9) Marantz PMD510 Dual record Deck with dual peak holding meters, dual digital real time counters (10) Sony TC-WE675 Dual record Deck</p>	<p>Dual channel</p> <p>Dual speed</p> <p>Dual cassette Dual cassette deck Dual-well cassette deck Dual auto-reverse cassette deck</p> <p>Dual peak holding meters</p> <p>Dual tape counters Dual digital real-time counters with memory</p> <p>Dual record decks</p>	DSM7	DSM6	DSM4
4	DUAL + CD PLAYER	<p>dual CD player (11) American DJ Velocity Dual Deck CD player (12) Numark Dual CD player with Mixer</p>	<p>Dual CD player Dual Deck CD player</p> <p>Dual seamless loop & reloop</p>	DSM8	DSM7	DSM5

5	DUAL + DVD	Dual DVD drives (13) Toast 6 Titanium 8x Dual DVD±RW Drive Two DVD players = Dual players	Dual DVD drive Dual layer Dual-format DVD drives Dual RW burners	DSM9	DSM8	DSM6
6	DUAL + LOUDSPEAKER search date: 28 December 2005	Dual loudspeakers (14) Tannoy Dual Concentric Loudspeakers (15) Stonewood SA-CMLS2 Loudspeaker Station (16) Meridian DSP5200 Digital Active Loudspeaker (17) Dynaudion Lifestyle Contour 1.8 Loudspeaker	Dual concentric unit Dual cone loudspeaker Dual channel Dual channel belt pack Dual intercom system Dual headset Dual bass driver Dual magnets Dual woofers	n/a	n/a	DSM7