O/0125/24

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001582184

DESIGNATING THE UK

BY DIRS D.O.O.:

CHEFdeluxe

IN CLASSES 7, 11 AND 21

AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 429075

BY DE LONGHI BENELUX S.A.

AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON

BY THE OPPONENT

AGAINST A DECISION OF S WILSON

DATED 28 FEBRUARY 2023

DECISION

Introduction

1. This is an appeal from a decision of S Wilson, acting for the Registrar, dated 28 February 2023, in which she found that the opposition by De Longhi Benelux S.A. ("the Appellant or the Opponent") partially failed against the registration in the UK in the name of DIRS d.o.o. ("the Applicant" or "the Respondent") of international trade mark number 1582184 for the mark shown above ("the Trade Mark").

2. The opposition succeeded in relation to the following goods:

   Class 7: *Whisks, electric, for household purposes; food processors, electric; beaters, electric; beverage preparation machines, electromechanical; food preparation machines, electromechanical.*

   Class 21: *Cooking utensils, non-electric; kitchen utensils; blenders, non-electric, for household purposes; whisks, non-electric, for household purposes.*

3. The opposition failed in relation to the following goods:

   Class 7: ***Electric arc cutting apparatus;*** *fruit presses, electric, for household purposes; scissors, electric; knives, electric; water heaters being parts of machines;* ***machines and apparatus for wax-polishing, electric; parquet wax-polishers, electric; dust exhausting installations for cleaning purposes; air suction machines; spin dryers [not heated] / spin driers [not heated].***

   Class 11: *Beverage cooling apparatus; bread-making machines; heating apparatus, electric; cooking utensils, electric; electric lamps; coffee percolators, electric; coffee machines, electric;* ***waffle irons, electric; deep fryers, electric;*** *heating plates; water heaters; cooking rings; cooking stoves / cookers; kitchen ranges [ovens]; microwave ovens [cooking apparatus]; cooking apparatus and installations; bread baking machines; bread toasters / toasters;* ***hearths;*** *stoves [heating apparatus];* ***kilns;*** *hot air ovens; roasting apparatus / griddles [cooking appliances] / grills [cooking appliances]; bakers' ovens; hot plates; fittings, shaped, for furnaces / fittings, shaped, for ovens / shaped fittings for*

furnaces / shaped fittings for ovens; rotisseries; roasting apparatus / griddles [cooking appliances] / grills [cooking appliances]; ***incandescent burners****.*

Class 21: *Tea strainers; strainers for household purposes; teapots;* ***autoclaves, non-electric, for cooking / pressure cookers, non-electric; deep fryers, non-electric;*** *ceramics for household purposes; cooking skewers of metal / cooking pins of metal; vessels of metal for making ices and iced drinks; cooking pot sets; kitchen containers; basting spoons [cooking utensils]; pots; spatulas for kitchen use; scoops for household purposes; pie servers / tart scoops; kitchen grinders, non-electric; kitchen grinders, non-electric; moulds [kitchen utensils] / molds [kitchen utensils]; cookery moulds / cookery molds; cake moulds / cake molds; tableware, other than knives, forks and spoons; cookie [biscuit] cutters; pastry cutters; napkin rings; bottle openers, electric and non-electric; pot lids; dish covers / covers for dishes; stew-pans; frying pans; containers for household or kitchen use; bread bins; heat-insulated containers; mills for household purposes, hand-operated; sieves [household utensils]; dishes; salad bowls; vegetable dishes; garlic presses [kitchen utensils].*

4. The reason for certain goods being shown in bold above is explained in paragraph 16 below.

5. The opposition was based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). Under 5(2)(b) and 5(3) the Opponent relied on the following earlier trade mark:

   CHEF

   UKTM no. 3438050

   Filing date 21 October 2019; registration date 20 March 2020

   Relying on all goods for which the mark is registered, namely:

   Class 7: *Food mixers; attachments and accessories for food mixers.*

6. Under s.5(4)(a), the Opponent relied on its use of the sign CHEF throughout the UK since the 1950's in relation to *"food mixers; attachments and accessories for food mixers"*.

7. Since the earlier mark had completed its registration process within five years of the date on which the application for registration of the Trade Mark was filed, the Opponent did not need to establish proof of use of the mark pursuant to s.6A of the Act.

8. Only the Opponent filed evidence, neither party requested a hearing and only the Opponent filed written submissions in lieu.

The Hearing Officer's Decision

9. The Hearing Officer made the following findings:

Section 5(2)(b):

The goods and services

The Hearing Officer found that the goods in respect of which the opposition succeeded were either identical or similar to at least a medium degree to those covered by the earlier mark. The remaining goods were found either to be dissimilar or similar to only a low degree.

The average consumer and the nature of the purchasing act

The average consumer would be a member of the public or a professional user, such as a chef or restaurant owner. The cost of the goods would vary but were likely to be relatively infrequent purchases. The level of attention would be at least medium (or average), and visual considerations would dominate the purchasing process as the goods were likely to be selected from the shelves of a retail outlet or their online equivalent, although the Hearing Officer did not discount an aural component as advice may be sought from sales assistants.

Similarity between the marks

The marks were visually similar to a medium degree, and aurally and conceptually similar to a medium to high degree.

Distinctive character of the earlier mark

The earlier mark possessed a low degree of distinctive character, and the evidence was insufficient to support a claim of enhanced distinctiveness.

Likelihood of confusion

There was no likelihood of direct confusion, but there was a likelihood of indirect confusion in relation to the goods which the Hearing Officer found to be similar to at least a medium degree.

The opposition under s.5(2)(b) therefore only succeeded in relation to the goods found to be similar to at least a medium degree.

Section 5(3)

The evidence was insufficiently clear to justify a finding of reputation in the UK. Even if there was a reputation, the distance between the goods in respect of which the opposition under s.5(2)(b) failed and the goods for which the Opponent would have a reputation would be sufficient to offset the Opponent's reputation and the similarity between the marks. There would therefore be no link or damage for the remaining goods. Accordingly, the opposition failed under s.5(3).

Section 5(4)(a)

The evidence was sufficient to establish a protectable goodwill (albeit a modest one). However, the distance between the goods in respect of which the opposition under s.5(2)(b) failed and the goods for which the Opponent had goodwill would be sufficient to offset the similarity of the marks and to avoid a misrepresentation and damage arising. Accordingly, the s.5(4) ground only succeeded to the same extent as the s.5(2)(b) ground.

The Appeal

10. The Opponent filed a Notice of Appeal to the Appointed Person under s.76 of the Act. At the hearing before me, which was held remotely, the Opponent was represented by Andrew Lomas instructed by Mathys & Squire LLP. The Respondent did not file a Respondent's Notice or attend the hearing.

Standard of review

11. It is well established that in order to interfere with the decision of the Hearing Officer I must be satisfied that there was a distinct and material error of principle in the decision or that the Hearing Officer was wrong. The relevant principles were set out in *Axogen Corporation v Aviv Scientific Limited* [2022] EQHC 95 (Ch) at [24]. An appeal is by way of review, not a rehearing. Neither surprise at a Hearing Officer's conclusion nor a belief that she or he has reached the wrong decision will justify interference. The decision of the lower court will be *"wrong"* if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. In the absence of an error of law, the appellate court would be justified in concluding that the

decision of the lower court was wrong if the judge's conclusion was *"outside the bounds within which reasonable disagreement is possible"* (*Actavis Group* at [80]). In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education v Pie Corbett Consultancy* [2017] RPC 17 at [52(iv)], *REEF Trade Mark* [2003] RPC 5 at [28] and *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11 at [50]-[51]).

12. In a recent trade mark appeal in *Stitch Editing Limited v. TikTok Information Technologies Ltd* [2023] EWHC 1167 (Ch), Sir Anthony Mann said at paragraphs [6] to [8]:

> *"6. The correct approach to appeals such as this has recently been confirmed in the decision of Richards J in Instagram LLC v Meta 404 Ltd [2023] EWHC 436 (Ch). In that case (which was another trade marks appeal case) the judge followed the guidance to be applied in appeals generally and set out in Volpi v Volpi [2022] EWCA Civ 464.*
>
> > *"i) An appeal court should not interfere with the trial judge's conclusions on primary facts unless it is satisfied that he was plainly wrong.*
> >
> > *ii) The adverb "plainly" does not refer to the degree of confidence felt by the appeal court that it would not have reached the same conclusion as the trial judge. It does not matter, with whatever degree of certainty, that the appeal court considers that it would have reached a different conclusion. What matters is whether the decision under appeal is one that no reasonable judge could have reached.*
> >
> > *iii) An appeal court is bound, unless there is compelling reason to the contrary, to assume that the trial judge has taken the whole of the evidence into his consideration. The mere fact that a judge does not mention a specific piece of evidence does not mean that he overlooked it.*
> >
> > *iv) The validity of the findings of fact made by a trial judge is not aptly tested by considering whether the judgment presents a balanced account of the evidence. The trial judge must of course consider all the material evidence (although it need not all be discussed in his judgment). The weight which he gives to it is however pre-eminently a matter for him.*

v) An appeal court can therefore set aside a judgment on the basis that the judge failed to give the evidence a balanced consideration only if the judge's conclusion was rationally insupportable.

vi) Reasons for judgment will always be capable of having been better expressed. An appeal court should not subject a judgment to narrow textual analysis. Nor should it be picked over or construed as though it was a piece of legislation or a contract."

7. So far as the decision below is evaluative, an appellate court should also approach the appeal with caution:

"76. So, on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out a balancing task afresh but must ask whether the decision of the judge was wrong by reason of some identifiable flaw in the judge's treatment of the question to be decided, "such as a gap in logic, a lack of consistency, or a failure to take account of some material factor, which undermines the cogency of the conclusion". (Re Sprintroom Ltd [2019] EWCA Civ 932)

8. And last, as Richards J observed in Instagram, proper respect should be paid to the decision of an expert tribunal in the field in question:

"26. Finally, it is relevant to observe that this is an appeal from a tribunal with particular expertise. As Lady Hale observed in AH (Sudan) v Secretary of State for the Home Department [2007] UKHL 49 at paragraph 30, the court should approach the appeal on the basis that it is probable that an expert tribunal, charged with applying the law in their specialist field, has probably got it right.""

13. I have borne those principles firmly in mind.

Grounds of Appeal

14. The Appellant appealed on the basis that the Hearing Officer erred in her assessment of:

    a. The similarity and/or complementarity of the disputed goods.

    b. The similarity of the marks

    c. The distinctiveness of the earlier mark

d. The likelihood of confusion

e. The reputation of the earlier mark

f. The Opponent's goodwill in CHEF.

15. The Opponent also appealed the costs order.

16. At the hearing before me, the Opponent decided not to maintain its grounds of opposition on appeal against the Trade Mark being designated in the UK for the goods shown in bold in paragraph 3 above.

17. I shall consider each of the Grounds of Appeal in turn.

Ground 1: The similarity and/or complementarity of the disputed goods

18. The Opponent submitted that the Hearing Officer had set out the applicable law correctly but then misapplied it on the basis of the evidence.

19. Before undertaking a review of the particular goods in the specifications, it is necessary to say something about the Appellant's evidence and the nature of the Appellant's Chef-branded products. The Appellant's earlier mark is registered in respect of *"food mixers"* and *"attachments and accessories for food mixers"*. This begs the question – what is a food mixer?

20. The evidence included extracts from Good Housekeeping magazine from December 2003 which features the Kenwood Chef KM001 Series product as a food mixer. The same model was described in a May 2004 issue of Good Housekeeping magazine as a *"freestanding mixer"* that came with a food processor attachment and a glass liquidising goblet, allowing it to mix, whisk, beat, chop, grate, shred, slice and liquidise. The article concluded that it had *"the potential to be the only kitchen machine you'll ever need."*. A May 2006 copy of Ideal Home magazine described the same model as a food mixer, saying *"It comes with a dough hook, flat beater, wire whisk and glass jug blender, and you can buy a range of optional extras including pasta roller, ice-cream maker and juice extractor."*.

21. An article from the Consumer Association's Which? magazine dated 2009 described the difference between kitchen machines, food processors and mini choppers, without ever using the term *"food mixer".* It explained that food processors were great for slicing, shredding, grating and pureeing and came with a wide range of accessories and different blades. Kitchen machines were described as being larger than food processors and were excellent at whisking eggs and whipping cream and were ideal for making large batches of

cake mix, batter or dough. Specifically, it said that *"they don't usually chop, slice or grate, but some models come with accessories that do".* The Kenwood Chef Classic KM336 was featured as a Best Buy, being described as a kitchen machine.

22. In extracts from the Which? website dated 2013, various of the Appellant's Chef products were reviewed under the heading "*Stand mixer reviews"*. The first product, The Kenwood Chef Classic Major KM636, is described as a kitchen machine. The second product reviewed, the Kenwood Chef KM010, is also described as a kitchen machine, and the review states *"whilst kitchen machines tend to stick to mixing, whipping, whisking and kneading, the KM010 Chef takes on extra tasks you'd normally expect from a food processor"*. The Titanium Chef KMC010 model was described as a *"versatile machine, acting as stand mixer, food processor, blender and ice-crusher."*.

23. Similarly, the Which? website, extracts from which also appeared in the evidence, said this about one of the Appellant's top of the range products, the Cooking Chef (first reviewed by Which? in December 2020): *"The recently launched Kenwood Cooking Chef XL is a stand mixer that also functions as a food processor, blender and steamer, and it can also cook an entire meal."*.

24. The Which? reviews allocated a type to the different products being reviewed. The Cooking Chef described in the previous paragraph was assigned the type *"Stand Mixer"*, despite the availability of other food processor attachments and accessories for it. However, the Kenwood KWC 3100S Chef Premier Stand Mixer was allocated the type *"Kitchen Machine"*, while having the description "*stand mixer"* in its title. The Kenwood Chef Titanium KVC7300S model was assigned the type *"Food Mixer"*.

25. An article from the Times in 2012 referred to the Kenwood Cooking Chef as the *"Kenwood Cooking Chef Food Mixer"*.

26. An extract from the Good Housekeeping website dated July 2022 headed *"Best stand mixers: the top 10 food mixers you can buy"* described stand mixers as *"covetable pieces of kit for bakers and cooks wanting to up their game in the kitchen. They take the hard work out of beating, whisking, and kneading and will help you produce show-stopping sponges, biscuits, breads and pastry in next to no time. With extra attachments, some can tackle everything from sausage meat to ice cream without so much as an aching wrist."*.

27. At the hearing before me, Mr Lomas described the Appellant's Chef-branded products as *"the Swiss Army Knife"* of kitchen equipment, with a plethora of accessories which enables

them to blend, slice, grate, juice, grind, dice, roll out pasta etc. In its evidence, the Appellant tended to describe its own products interchangeably as kitchen machines and mixers.

28. In addition to other evidence relied on by the Appellant, it therefore appears that the words *"food mixer"* and *"kitchen machine"* (which includes *"stand mixers"*) are widely used interchangeably, and that in more recent years kitchen machines have developed to include food processor attachments.

29. With that background, I will now consider the specific goods which were the subject of the appeal.

Fruit presses, electric, for household purposes

30. The Hearing Officer set out her findings for these goods as follows:

> *"23. The opponent has made no specific submissions in relation to these goods. However, I note the opponent's general submission as follows:*
>
> *"With regards the remaining terms not touched upon above, these are similar and/or complementary to the Opponent's Goods, as they would share one or more of the following:*
>
> *i. The same average consumer (for example, home keepers, home cooks etc);*
>
> *ii. The same purpose (for example, for food and beverage preparation);*
>
> *iii. The same (or at least highly similar) method of use; and*
>
> *iv. The same trade channels, as they would be found sold and advertised together in the same retail outlets dedicated for home, or in the 'home' sections of wider stores (and/or websites thereof)."*
>
> *24. To my understanding, these are goods that are typically used to crush fruit for the purposes of making juices or other beverages (such as cider). Whilst these are used in beverage preparation, they do not share the same overlap in nature or method of use with the opponent's goods as identified in relation to other types of beverage preparation machines above. There will also not be the same competition. The user will clearly overlap as both can be used by members of the general public. The purpose will differ and there will be no complementarity. I note that the opponent's evidence shows that it offers a fruit juice attachment for its food mixers i.e. an attachment that extracts the juice from fruit. However, I have no reason to believe*

that it is common practice for businesses to offer both and no evidence that it is. I recognise that there may be some overlap in retailers. Taking all of this into account, I consider the goods to be similar to a low degree."

31. The Appellant submitted as follows in its Skeleton Argument:

"This finding of a low degree of similarity was in error for a number of reasons.

a. *First, contrary to the Hearing Officer's finding, the goods share the same nature / method of use. The Applicant's goods are electric fruit presses, as are the Appellant's "food mixers" with their accompanying "attachments and accessories". Both types of products are used in the food and beverage making process, they both use electricity and involve the processing of solid foods into a softer/liquid consistency.*

b. *Second, it is clear from the Appellant's evidence that "food mixers" are used with citrus juicer/citrus press attachments; in the circumstances, they share the same nature and method of use as the Applicant's electric fruit presses. Thus, the goods are clearly in competition and have the same purpose.*

c. *Finally, given that both sets of goods: (i) are used in beverage preparation; (ii) share the same intended users; and (iii) may share the same retailers, should have led the Hearing Officer to find at least average level of similarity (if not high)."*

32. The Hearing Officer recognised that the Appellant's food mixers had an attachment which enabled them to extract juice but said that there was no evidence that this was a common feature on other machines. Mr Lomas submitted at the hearing before me that the Hearing Officer took an "*over-granular*" approach and that what she should have done was to construe the meaning of the words "*fruit presses, electric, for household purposes*" and *"food mixers; attachments and accessories for food mixers"* and assess their similarity, applying the factors laid down in cases such as *Canon* and *Treat*.

33. Mr Lomas took me through the evidence showing the various different attachments which have been sold with the Appellant's food mixers over the years.

34. For example, Mr Lomas took me to a document in the evidence dated 1996 called *"Celebrating Fifty Years Kenwood"*. This showed a Chef Excel System Plus KM210 which was described as including a 1 litre liquidiser, and showed a range of optional attachments. These included, in particular, a citrus juicer, an acrylic, glass or stainless steel liquidiser and a juice centrifuge. He also took me to what appeared to be screenshots from 2017 which

included the following text: *"We have moulded 65 years of food preparation know-how into the very fabric of our new Chef".* It went on to describe the features of the Chef Sense, which included under the heading *"Juicer"* a photograph of a juicing attachment showing an orange in a metal bowl or jug. Text underneath the photograph described a *"citrus press attachment"*, saying *"Simply fit onto your machine and enjoy freshly pressed orange juice, or add to cake and sauce recipes for some extra flavour"*.

35. Similarly, a product booklet for *"the Kenwood Chef kitchen machine range"* showed an accessory described as a *"fruit press"* said to be *"perfect for creating healthy juices and delicious purees, using a slow rotating scroll to crush the food to release the juice"*, a *"juice extractor"* and a *"citrus juicer"*.

36. Mr Lomas also took me to photographs in the evidence which were taken in the kitchen section of the retailer John Lewis. These photographs showed items of the Appellant's Chef machines in the foreground among other kinds of cooking equipment.

37. Coupled with the screenshots of the Appellant's machines and their attachments on various retail and consumer websites, as well as the Appellant's own website, and the references to other similar machines and their attachments and accessories in newspaper and magazine articles and reviews which appeared in the evidence, some of which I refer to below, in my opinion the evidence established that the average consumer would have been aware of the nature of the Appellant's machines and at least the more commonly featured attachments and accessories of food mixers. In particular, for this category of goods, that includes their juicing and smoothie-making abilities.

38. I therefore agree with the Appellant that the Hearing Officer erred in her conclusion that these goods were only similar to a low degree. The evidence showed that the average consumer would have been aware that food mixers are often sold with juicing and liquidising attachments, having seen the Appellant's juicing and liquidising attachments to its mixers being sold over a substantial period of time in prominent high street retailers such as John Lewis, as well as in its catalogues and on internet sites. The Hearing Officer does not explain why she concluded that "*they do not share the same overlap in nature or method of use"* – from the evidence, I can see no reason why they do not share the same nature or method of use. Nor does she explain her conclusion that *"the purpose will differ"*. When considering the fruit pressing/juicer/liquidiser attachments of a food mixer, the purpose is the same as the purpose of an electric household fruit press, namely, to obtain the juice from fruit. I also disagree with her conclusion that "*there will also not be the same*

competition". I consider that electric household fruit presses are likely to be sold very near to electric food mixers in the same section of department stores such as John Lewis. Furthermore, the average consumer looking to buy a machine to juice fruit may well decide to buy a food mixer with a fruit pressing/juicing/liquidiser attachment rather than a dedicated fruit pressing machine. The Hearing Officer appeared to recognise this possibility when she considered the similarity of *"beverage preparation machines, electromechanical"* (which she found to be similar to between a medium and high degree), saying *"There may be an element of competition where, for example, smoothie makers are concerned, as consumers may either buy a specific machine for the purposes of beverage preparation or may buy a general household food processor, which could be used for the same purpose."*. She should have applied the same logic to this category of goods too.

39. I believe that these differences are more than mere differences of opinion between my view and that of the Hearing Officer, and consider that the Hearing Officer's conclusion was one which no reasonable tribunal could have reached on the evidence. I therefore allow the appeal under this ground, which requires me to reassess the similarity of the respective goods. For the reasons set out above, together with the Hearing Officer's findings that the users would overlap and that there would be some overlap in retailers, I find that the respective goods are similar to at least a medium degree.

Scissors, electric; knives, electric

40. The Hearing Officer set out her findings for these goods as follows:

> *"I have no specific submissions from the opponent in relation to these goods. I accept that there will be overlap in user, as both parties' goods could be used by members of the general public. However, the purpose of the holder's goods is to cut food or other items, whereas the opponent's goods are for mixing. The nature of the goods will be different, as will the method of use. In the absence of any evidence, I see no reason why the same businesses would produce both, although I recognise that both could be sold through the same retailers and in similar aisles. I do not consider the goods to be in competition or complementary. Consequently, I consider the goods to be similar to a low degree.".*

41. I consider that the Hearing Officer's statement that the opponent's goods are for mixing overlooks the extensive evidence that the Appellant's Chef machines and other competitors' products were capable of doing much more than simply mixing in light of the numerous

different attachments which are sold for use with these types of machine. These attachments included attachments intended to chop, slice and shred different foods. A knife blade attachment was described in the evidence as being ideal for chopping meat, fish and vegetables, and pasta cutters were described for use in making lasagne, spaghetti, tagliatelle, taglioni or trenette.

42. However, there was no evidence or submissions before the Hearing Officer explaining what electric scissors are used for (e.g. they may be designed to cut fabric rather than for use in food preparation), how they work, what they look like etc. This is the kind of specialist equipment which would require evidence in order for the Hearing Office to appreciate their nature and intended use. The need to provide such evidence was explained in the decision of Mr Geoffrey Hobbs KC in *Raleigh International Trade Mark* [2001] RPC 11 at paragraph 20, where he said *"If the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered, the objection should be supported by evidence as to their "similarity" …."*. I therefore do not criticise the Hearing Officer's conclusion that, for the reasons she gave in relation to the nature and purpose of the goods, whether or not the same producers would make both goods, and the lack of competition or complementarity, there was only a low degree of similarity between *Food mixers; attachments and accessories for food mixers* and *electric scissors*.

43. However, the same cannot be said for *electric knives*, which are commonly used in food preparation, particularly for carving meats and slicing bread. While the nature of the goods may be slightly different, and the actual method of use may not be the same, they could well be in competition with each other, such that I consider it quite likely that the same businesses would produce both. I therefore find that the Hearing Officer overlooked the evidence relating to the accessories available for food mixers designed to chop, slice and shred different foods, for example, and therefore erred in concluding that there was only a low degree of similarity between *attachments and accessories for food mixers* and *electric knives.* I find that these goods are similar to a medium degree.

Water heaters being parts of machines

44. The Hearing Officer set out her findings for these goods (and other goods within class 7 which, as shown in paragraph 3 above, are no longer subject to this appeal) as follows:

"As far as I can see, the opponent's submissions in relation to "the remaining terms" do not apply to these goods. They do not share the same purpose; none of these goods relate to food or beverage preparation. I can see no reason why there would be any overlap in method of use, nor trade channels. To my mind, the fact that some of these goods may, as the opponent submits, be sold in "home" sections of stores (if, in fact, they would be), is not enough to justify a finding of similarity. I accept that some of these may be purchased by members of the general public, as would the opponent's goods. Taking all of this into account, I consider the goods to be dissimilar."

45. The Appellant argued that the fact that the Hearing Officer had found that some of the goods may be sold in the "home" section of stores and that there was an overlap in intended users was enough to require her to find a low degree of similarity between *Food mixers; attachments and accessories for food mixers* and *water heaters being parts of machines*. It is not clear from the Decision whether the Hearing Officer considered *water heaters being parts of machines* to be sold in the "home" section of stores, as she did not identify which particulars goods she was referring to when she said *"some of these goods"*. In any event, I do not agree with the Appellant that, just because there was a common user (the general public) and that the goods would be found in the "home" section of stores required the Hearing Officer to find a low degree of similarity. There are plenty of goods sold in "home" sections of stores which are dissimilar.

46. Mr Lomas also submitted to me at the hearing that *"while I do not think we have seen it in the evidence" … "it is not beyond the realms of possibility to have an attachment that boils or broils or steams"*. While that may be correct for certain specialist mixers (indeed, the evidence did in fact show that one of the Appellant's models, namely the Cooking Chef launched in 2009, was capable of steaming and making stew), the evidence did not show that this was a common aspect of a food mixer. Without more evidence to support that assertion I am not able to conclude that no reasonable tribunal would have found that the respective goods were dissimilar. The appeal therefore fails in respect of these goods.

Beverage cooling apparatus; bread-making machines; heating apparatus, electric; cooking utensils, electric; coffee percolators, electric; coffee machines, electric; heating plates; cooking rings; cooking stoves / cookers; kitchen ranges [ovens]; microwave ovens [cooking apparatus]; cooking apparatus and installations; bread baking machines; bread toasters / toasters; stoves [heating apparatus]; hot air ovens; roasting apparatus / griddles [cooking appliances] / grills

[cooking appliances]; bakers' ovens; hot plates; fittings, shaped, for furnaces / fittings, shaped, for ovens / shaped fittings for furnaces / shaped fittings for ovens; rotisseries; roasting apparatus / griddles [cooking appliances] / grills [cooking appliances]

47. All of these goods were taken together by the Appellant, even though some of them are quite different to each other. It will therefore be necessary for me to break down this category into individual items or smaller groupings of similar goods.

48. The Hearing Officer set out her findings for these goods as follows:

    "As far as I can see, the only point of overlap between these goods in the holder's specification and the opponent's goods is that both could be used by members of the general public and that both could be purchased from retailers specialising in cooking apparatus and kitchenware. I consider it unlikely that it is common for these goods to be produced by the same businesses. There is no overlap in purpose, nature or method of use and they are neither in competition nor complementary. In my view, this is not sufficient on its own for a finding of similarity. However, even if I am wrong in this finding, any similarity would be at a low level.".

49. The Appellant argued that the Hearing Officer should have found at least a medium degree of similarity for this category of goods, since that was her finding in relation to *"cooking utensils, non-electric; kitchen utensils; blenders, non-electric, for household purposes; whisks, non-electric, for household purposes"*. In particular, the Appellant said that it was inconsistent and illogical to find that *"cooking utensils, non-electric"* were similar to *"food mixers"* and *"attachments and accessories"* thereto, but that *"cooking utensils, electric"* and *"cooking apparatus and installations"* would not be.

50. The Hearing Officer set out her findings in respect of *"cooking utensils, non-electric; kitchen utensils; blenders, non-electric, for household purposes; whisks, non-electric, for household purposes"* in paragraph 28 of the Decision, where she described them all as being *"types of goods that can be used (or include goods that are used) to mix food"*. She therefore found that the respective goods had an overlap in purpose and that they could be in competition. Her other findings were the same as her findings in relation to the goods currently being considered, namely that the users would overlap, that they could be sold by the same retailers, but that the nature and method of use would differ, that it was unlikely that the manufacturers of those goods would be the same, and that there was no complementarity.

51. Once again, the Hearing Officer's reference to mixing food reinforces my belief that the Hearing Officer was taking an unduly restrictive interpretation of the meaning of food mixers and what they are capable of doing with their attachments and accessories. The evidence clearly showed that food mixers do far more than simply mix food.

Cooking utensils, electric; cooking apparatus and installations

52. With respect to *"cooking utensils, electric"* I agree with the Appellant's arguments that, once the Hearing Officer had found that *"cooking utensils, non-electric"* were similar to *"food mixers"* and *"attachments and accessories"*, she should have found that *"cooking utensils, electric"* were also similar, since the mere fact that one was powered by electricity and one was not would not alter any of the factors which the Hearing Officer identified as leading to her conclusion of medium similarity, namely the overlap of purpose and users, the potential to be sold by the same retailers and the fact that they were in competition. Since the Hearing Officer found a medium similarity with *cooking utensils, non-electric*, I find that these goods also share a medium similarity.

53. *"Cooking apparatus and installations"* is a very wide description of goods, which would encompass *"cooking utensils, electric"* and indeed *"food mixers"* when applying the ordinary meaning of the words *"cooking apparatus"*. It appears to me that the Hearing Officer must have lost sight of this specific category of goods when she considered most of the categories of goods under class 11 together. Accordingly, I consider that the Hearing Officer erred in respect of her findings for *"cooking apparatus and installations"* which she should have found to be similar to at least a medium degree, if not identical under the *Meric* principles.

Beverage cooling apparatus

54. The evidence showed that some of the Appellant's models had an ice cream making attachment and a frozen dessert making attachment available, which could be used for making ice cream, sorbets and frozen yoghurts. There were also references in the evidence to using food mixers (particularly the liquidising and blending attachments) to crush ice, which appears to be a common attribute of food mixers.

55. The Hearing Officer had previously found that *beverage preparation machines, electromechanical* were similar to between a medium and high degree, saying that such goods could include smoothie makers, which would overlap in nature with the Opponent's goods, that there would be an overlap in method of use, that some large undertakings might produce both goods, that they may be sold by the same retailers, that there may be an

overlap in competition as consumers may either buy a specific machine for beverage preparation or they may buy a general household food processor which could be used for the same purpose, and that the users would overlap. In my view, the Hearing Officer erred by not applying the same criteria to *beverage cooling apparatus* since ice is used to cool beverages and a frozen yoghurt, for example, is similar to a smoothie. I therefore find that these goods are similar to a medium degree.

Bread-making machines; bread baking machines

56. It was clear from the evidence that the Appellant's food mixers and several competitor products had accessories to be used in bread-making, such as a dough hook attachment and a stainless steel bowl described in respect of one of the Appellant's models as having a capacity to allow the user *"to knead enough dough for up to 4 loaves of bread."*. Since one of the main functions of a breadmaker is to knead the dough to make the bread, I disagree with the Hearing Officer that there is no overlap in purpose (while recognising that they do not go on to bake the bread), or that they could not share the same manufacturer. The methods of use are also similar in relation to the dough-mixing and kneading function. To the extent that a bread baking machine is different from a bread-making machine, in that the former only bakes the bread, then the respective goods would be complementary since the user of the bread baking machine would still need to mix and knead the dough. I therefore find that the Hearing Officer was wrong to find that there was no similarity, or alternatively low similarity, with bread making and bread baking machines, and I find that there is in fact a medium degree of similarity.

Coffee percolators, electric; coffee machines, electric

57. I saw nothing in the evidence which suggested that the Appellant's food mixers were capable of brewing coffee. However, there was evidence that they were capable of grinding coffee beans. Some types of coffee machine are capable of grinding coffee beans before making the coffee, in which case they would share a similar method of use and the same purpose of grinding the coffee beans. For coffee percolators and coffee machines which require pre-ground coffee beans, a food mixer with a grinding attachment would be complementary. They could be made by the same businesses, sold in the same retailers near to each other, and would share the same users. As I have already mentioned, the Hearing Officer found that *beverage preparation machines, electromechanical* were similar to between a medium and high degree. Since grinding coffee beans is part of the preparation process for a beverage, but recognising that the food mixer does not produce the ultimate

beverage in the same way that a coffee percolator or machine does, I find that the Hearing Officer erred in her finding of no similarity, or alternatively low similarity, and should have found a medium level of similarity for these goods.

Heating apparatus, electric; heating plates; cooking rings; cooking stoves / cookers; kitchen ranges [ovens]; microwave ovens [cooking apparatus]; bread toasters / toasters; stoves [heating apparatus]; hot air ovens; roasting apparatus / griddles [cooking appliances] / grills [cooking appliances]; bakers' ovens; hot plates; fittings, shaped, for furnaces / fittings, shaped, for ovens / shaped fittings for furnaces / shaped fittings for ovens; rotisseries; roasting apparatus / griddles [cooking appliances] / grills [cooking appliances]

58. This leaves the remaining items set out above in Class 11, which all relate to heating in some way.

59. As has been discussed already, although one of the Appellant's models was capable of induction heating, the evidence did not suggest that heating was a common aspect of a food mixer. I therefore reject the assertion that the Hearing Officer erred in her conclusion that these remaining goods were all dissimilar, or only similar to a low degree.

Tea strainers; strainers for household purposes; teapots; ceramics for household purposes; cooking skewers of metal / cooking pins of metal; vessels of metal for making ices and iced drinks; cooking pot sets; kitchen containers; basting spoons [cooking utensils]; pots; spatulas for kitchen use; scoops for household purposes; pie servers / tart scoops; kitchen grinders, non-electric; kitchen grinders, non-electric; moulds [kitchen utensils] / molds [kitchen utensils]; cookery moulds / cookery molds; cake moulds / cake molds; tableware, other than knives, forks and spoons; cookie [biscuit] cutters; pastry cutters; napkin rings; bottle openers, electric and non-electric; pot lids; dish covers / covers for dishes; stew-pans; frying pans; containers for household or kitchen use; bread bins; heat-insulated containers; mills for household purposes, hand-operated; sieves [household utensils]; dishes; salad bowls; vegetable dishes; garlic presses [kitchen utensils].

60. The Hearing Officer set out her findings for these goods as follows:

29. As far as I can see, none of these remaining goods in class 21 of the holder's specification overlap in purpose in the same way as the above goods. Consequently, there is no competition. Whilst there will clearly still be an overlap in user, and possibly some superficial overlap in trade channels, I do not consider this sufficient to give rise to similarity. I note that the opponent has filed evidence that it sells attachments for its food mixers which provide

additional functionality such as milling and grinding. However, by virtue of being included in class 7, the opponent's "attachments for food mixers" are powered rather than hand-held, whereas the holder's goods are handheld (by virtue of being in class 21). Further, I do not think that the ordinary meaning of "attachment for food mixers" would include attachments which provide entirely different functions to mixing foods. Taking this into account, I consider these goods to be dissimilar.

61. The Appellant's submissions on these goods were essentially that they are all complementary, in the sense that they are all items which consumers who are looking for equipment for their kitchen that will help them prepare a whole range of food and beverages will look to buy, and the Appellant's food mixers come with a wide range of attachments which can do the same sorts of things.

62. The approach taken by the Appellant was too broad regarding the concept of complementarity. Goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (*Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06). Mr Daniel Alexander KC sitting as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13 at paragraph 18 (approved in *Axogen* by Joanna Smith J at paragraph 40) said *"It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."*. The purpose of asking the complementarity question is to ask whether consumers might think that responsibility for the two sets of goods lies with the same undertaking. In my view, the average consumer would not assume that the type of common kitchen items under consideration, such as tea strainers, tea pots, napkin rings etc. would be the responsibility of the same business which made food mixers or attachments and accessories for them.

63. The issue of complementarity is not the only relevant factor, of course, nor indeed an essential factor, but where there is little more in common with these goods than an overlap in user and that they are likely to be sold by the same retailers (albeit in different sections of the kitchen department in many cases), I consider that it was reasonable for the Hearing Officer to find that such items were dissimilar. I therefore reject the appeal under this ground in respect of all of these goods, save for the goods expressly referred to below.

64. As I explained in paragraph 41 above, I consider that the Hearing Officer erred, in light of the evidence, in limiting the ordinary meaning of *accessories and attachments for food mixers* to those which mix food. The evidence showed that such accessories included bowls and jugs made from various different materials, including stainless steel, vessels for making ice cream and ice, food mills and grinders, and numerous different types of cutting and chopping accessories for making different shaped foods (such as pasta, biscuits etc). I therefore find that the Hearing Officer was wrong to find that the following items were dissimilar:

> ***ceramics for household purposes; vessels of metal for making ices and iced drinks; kitchen containers; kitchen grinders, non-electric; moulds [kitchen utensils] / molds [kitchen utensils]; cookery moulds / cookery molds; cake moulds / cake molds; tableware, other than knives, forks and spoons; cookie [biscuit] cutters; pastry cutters; containers for household or kitchen use; heat-insulated containers; mills for household purposes, hand-operated; sieves [household utensils]; garlic presses [kitchen utensils].***

65. I agree with the Appellant's submissions that these goods are used in the kitchen for food and beverage preparation, that they target the same consumers, are likely to travel through the same channels of trade and would be likely to be found in close proximity to each other in shops and department stores. They are likely to be in competition which each other. While their methods of use may differ where one product is hand-operated and the other requires electricity, their purpose is the same, and, as noted above, the Hearing Officer did find *cooking utensils, non-electric* to be similar to a medium degree to their powered equivalents. I therefore allow the appeal under this ground for these items, and find them to be similar to a medium degree.

66. In addition, the Hearing Officer had found that *cooking utensils, non-electric* were similar to *food mixers* and *attachments and accessories* to a medium degree on the basis that they were *"all types of goods that can be used (or include goods that are used) to mix food"*. Since ***spatulas for kitchen use*** would be used to mix food (e.g. cake mix) she was inconsistent in not finding that they were similar to a medium degree. Furthermore, having found *cooking utensils, non-electric* to be similar to a medium degree, it is difficult to understand why she did not also include ***basting spoons [cooking utensils]***. I therefore allow the appeal under this ground for these items as well and find that they are similar to a medium degree.

Goods found to be similar to at least a medium degree

67. I have therefore found that the Hearing Officer should have found the following goods to be similar to at least a medium degree:

Class 7: *Fruit presses, electric, for household purposes; knives, electric.*

Class 11: *Beverage cooling apparatus; Bread-making machines; cooking apparatus and installations; bread baking machines; cooking utensils, electric; coffee percolators, electric; coffee machines, electric.*

Class 21: *Ceramics for household purposes; vessels of metal for making ices and iced drinks; kitchen containers; basting spoons [cooking utensils]; spatulas for kitchen use; kitchen grinders, non-electric; moulds [kitchen utensils] / molds [kitchen utensils]; cookery moulds / cookery molds; cake moulds / cake molds; tableware, other than knives, forks and spoons; cookie [biscuit] cutters; pastry cutters; containers for household or kitchen use; heat-insulated containers; mills for household purposes, hand-operated; sieves [household utensils]; garlic presses [kitchen utensils].*

Ground 2: Similarity of marks

68. The Appellant submitted that the Hearing Officer erred in finding that the marks were only visually similar to a medium degree, rather than *"highly similar visually"*, arguing that the CHEF element was the dominant and distinctive element, whilst the "deluxe" element *"would be afforded little attention due to its descriptive/non-distinctive nature."*. The descriptiveness of the "deluxe" element is a relevant consideration when assessing the conceptual similarity of the marks, rather than visual similarity. The Appellant also argued that the consumer would focus on the CHEF element, since that is in bold capitals, so their eye would be drawn to that element rather than the "deluxe" element. The Hearing Officer found the marks overlapped to the extent that the CHEF element was replicated at the beginning of the Trade Mark, but that the addition of the word "deluxe" and the device acted as a point of difference. I do not agree with the Appellant's suggestion that those elements would be afforded little attention and see no reason to interfere with the Hearing Officer's conclusion that the marks were visually similar to a medium degree.

69. The Appellant also argued that the Hearing Officer erred in finding that the marks were only aurally and conceptually similar to a medium to high degree, rather than to a high degree, for the same reasons. I reject those submissions. The Hearing Officer was right to find that

the word CHEF would be pronounced identically but that the word “deluxe” will clearly act as a point of aural difference.

70. Furthermore, the difference between medium and medium to high is not a proper ground for appeal for the reasons given by Mr Iain Purvis KC sitting as the Appointed Person in *Greybox,* Case BL O/106/20 when he said at paragraph 23:

> *“This takes issue with the Hearing Officer's view that the conceptual similarities between the marks were at a 'fairly low level'. It is said that the conceptual similarity should have been found to be at least at a 'medium' level. I do not consider there is any great value in debating differences between 'fairly low' and 'medium' degrees of similarity in the context of the overall assessment of likelihood of confusion. Certainly, I do not consider that such fine distinctions can properly be characterized as errors of principle. They are at best simply disagreements about the precise 'weight' to be given to a factor in the overall assessment, something which the Courts have consistently rejected as a proper ground of Appeal.”.*

71. Ground 2 of the appeal therefore fails.

Ground 3: Distinctiveness of marks

Inherent distinctiveness

72. The Hearing Officer said the following in relation to the inherent distinctiveness of the earlier mark:

> *“The word CHEF is an ordinary dictionary word meaning a cook. For goods in the field of food and beverage preparation, I do not consider it to be particularly distinctive. In my view, the earlier mark has a low degree of inherent distinctive character.”*

73. The Appellant argued that these reasons did not justify her finding of a low degree of inherent distinctive character, saying that if a mark is not particularly distinctive, then it should be deemed to be of at least average distinctiveness. I agree with the Hearing Officer that the word CHEF clearly brings cooking to mind and I see no reason to interfere with her finding of low inherent distinctiveness when the word CHEF is used in relation to food mixers and their attachments and accessories. Accordingly, that aspect of ground 3 fails.

Enhanced distinctiveness

74. In assessing the possible enhanced distinctiveness of the earlier mark, the Appellant argued that the Hearing Officer erred in her assessment of the evidence. In particular, the Appellant

criticised the Hearing Officer for finding that there was no evidence as to what proportion of the Appellant's sales related specifically to *food mixers*. This was a reference to paragraph 42 of the Decision (redacted in the published version), where the Hearing Officer referred to some confidential sales figures for total sales in all markets under the CHEF mark before saying that she had not been provided with a breakdown as to the proportion of those sales that related specifically to the UK market (with a footnote referring to the confidential exhibit in the evidence which gave those figures). In fact, the figures she quoted appear to relate to a model described as "KITCHEN MACH CHEF". It should have been clear to the Hearing Officer that the table gave the total for all Chef kitchen machine sales, which was a much higher figure, and that sales figures for other model names which appeared in the table such as KITCHEN MACH TITANIUM, KITCHEN MACH CLASSIC, KITCHEN MACH SENSE etc., referred to other Chef models which appeared frequently elsewhere in the evidence. She would then have seen that the sales figures for the Appellant's food mixers sold under the CHEF brand were much higher than she had stated. While it is correct that these figures were not broken down into UK specific sales, but were global sales figures and Europe sales figures, there was other evidence which made it clear that UK sales formed a significant share of the Appellant's total sales. For example, a document from 1992 stated that UK sales of the Kenwood Group's products, of which the Chef food mixer was the best known, represented approximately one third of all global sales. I agree with Mr Lomas's submissions that there was enough evidence before the Hearing Officer which allowed her to extrapolate an estimate of the UK sales figures for products sold under the earlier mark, and to realise that those figures were significant.

75. The Hearing Officer also said that there was no information provided as to what proportion of the sales shown on an exhibited document related specifically to food mixers. She gave as an example of an item that she did not appear to consider to be a food mixer a reference to some of the products being able to cook food.

76. I have already referred to the evidence which explained that the Cooking Chef model was capable of cooking food, and numerous entries on this document referred to the various Chef models which appeared frequently elsewhere in the evidence.

77. I therefore agree with the Appellant that the Hearing Officer failed to assess the evidence correctly. Had she done so, she would have appreciated that the Appellant had filed sufficient evidence, including in particular the sales figures, the publicity materials covering a substantial period of time, the availability of the products in major retail outlets such as John

Lewis and Lakeland and the reviews by Which?, to demonstrate that the Appellant's CHEF food mixers had acquired an enhanced level of distinctiveness through use.

78. I therefore allow this aspect of ground 3 to the appeal and find that the earlier mark had acquired a high level of enhanced distinctiveness in relation to food mixers and their attachments and accessories.

Ground 4: Likelihood of confusion

79. Firstly, the Appellant claimed that the Hearing Officer failed to assess the overall similarity of the marks correctly, and that had she done so, she would have found the marks to be similar to a medium-high degree.

80. The Hearing Officer found that the marks were visually similar to a medium degree, and aurally and conceptually similar to between a medium and high degree, and then summarised these findings in paragraph 46 of the Decision together with her findings on the other relevant factors to be taken into account in her conclusions on direct and indirect confusion. This did not amount to an error of principle or law.

81. Secondly, the Appellant disputed the Hearing Officer's finding that the "deluxe" element would not be forgotten, because *"the term has no 'trade mark' significance"* so that consumers would not remember it in their imperfect recollection. This appears to be simply a disagreement of opinions between the Appellant and the Hearing Officer. Having summarised her findings in relation to the similarity of the marks, the fact that the earlier mark only had a low distinctive character, the similarity of the goods, the average consumer and the purchasing process, she said *"I do not consider that the additional word – DELUXE – in the IR will be forgotten by the average consumer, notwithstanding the principle of imperfect recollection. Consequently, I do not consider that there is a likelihood of direct confusion.".* This is a reasonable finding which I see no reason to interfere with.

82. In any event, it was not open to the Appellant to argue direct confusion on the appeal before me when it had argued in its written submissions in lieu of a hearing before the Hearing Officer that *"the average consumer would perceive the Applicant's Mark as a derivative/sub-brand of the main element 'CHEF' and would therefore perceive the mutual element 'CHEF' as the distinctive part of each mark."*. That was an argument for indirect confusion, not direct confusion.

83. With respect to indirect confusion, the Hearing Officer said the following in paragraph 47 of the Decision:

"I recognise that a finding of indirect confusion should not be made merely because two marks share a common element. However, the fact that the earlier mark has a weak distinctive character does not preclude a likelihood of confusion. The addition of the word DELUXE to the applicant's mark will, in my view, be seen as indicating a high quality subcategory of CHEF products sold by the same business. I consider that this addition, as well as the device and stylistic changes, will be viewed by the average consumer as an alternative mark being used by the same or economically linked undertakings. Consequently, I consider there to be a likelihood of indirect confusion. This will apply where the goods are similar to at least a medium degree. Where there is less similarity between the goods, this will offset the similarity of the marks."

84. The Appellant submitted that the Hearing Officer made an error of law by applying the interdependency principle *"in reverse"* and not finding a likelihood of indirect confusion in respect of goods found to be similar to a low degree. Mr Lomas did not seek to rely on any case law to support that proposition at the hearing before me, but argued that where the average consumer has recognised the marks to be similar, the fact that the similarity of the goods may be further apart does not preclude a finding of indirect confusion. That may be so, but equally it does not mean that, even where marks are similar, where goods only have a low degree of similarity, there is less likely to be indirect confusion than where the goods are more similar. The Hearing Officer found that the average consumer, seeing the Trade Mark used in respect of a non-electric whisk, for example, could well assume that it is an alternative mark being used by the same or an economically linked business. The same consumer seeing the Trade Mark used in respect of electric scissors, for example, a product which may not be typically associated with cooking or kitchens, is not likely to make the same assumption given that the earlier mark only has low inherent distinctiveness and I have found that it only has enhanced distinctiveness in relation to food mixers and attachments and accessories for food mixers. The lesser similarity between the goods makes it less likely that the consumer will assume an economic connection between the respective businesses. I therefore do not consider that paragraph 47 of the Decision evidences an error of law made by the Hearing Officer.

85. Although I have rejected the Appellant's arguments under this ground, since I have found that some of the goods which the Hearing Officer found to be either dissimilar or only similar to a low degree should have been found to have been similar to at least a medium degree, it is necessary for me to re-visit her findings in respect of no likelihood of confusion

in respect of those goods. Her conclusions on no likelihood of direct confusion would not have changed for the reasons I give in paragraph 81 above. However, since she found that there was a likelihood of indirect confusion for goods which had a medium degree of similarity, she should also have found a likelihood of indirect confusion in respect of all of the goods which I have found to share at least a medium similarity with the goods covered by the earlier mark. Accordingly, I find a likelihood of indirect confusion, and therefore the opposition succeeds under the s.5(2)(b) ground, in respect of the goods set out in paragraph 67 above.

Ground 5: reputation of the earlier mark

86. The Appellant argued that the Hearing Officer erred in finding that the earlier mark did not have a reputation in the UK for similar reasons to those she gave for her finding of no enhanced distinctiveness, and submitted that the evidence showed that the mark had acquired a reputation in the UK. For the reasons I have given above, I agree that the Hearing Officer erred in her assessment of the evidence and should have found that that evidence was sufficient to demonstrate a reputation in the UK in respect of food mixers and attachments and accessories for food mixers.

87. Having said that the appeal under s.5(3) failed at the first hurdle on the basis of lack of reputation in the UK, the Hearing Officer continued in paragraph 54 of the Decision:

> *"However, even if there were a reputation, I do not consider that this ground would put the opponent in any stronger position than it is under section 5(2)(b). This is because the distance between the remaining goods in the holder's specification (i.e. those that would not give rise to confusion under 5(2)(b)) and the goods for which the opponent would have a reputation, would be sufficient to offset the opponent's reputation and the similarity between the marks. I do not consider that there would be a link or damage for the remaining goods.".*

88. The Hearing Officer had previously set out the usual summary of the relevant case law on the application of s.5(3), which the Appellant did not criticise. If the earlier mark does have a reputation in the UK, then the next issue to consider is whether the public, when confronted with the mark applied for, would make a link with the earlier mark. One of the relevant factors to be considered as part of that global assessment is the degree of similarity between the goods/services. The Hearing Officer found that, where the similarity between the respective goods was low, or where they were dissimilar, that factor was sufficient to

offset the reputation in the earlier mark and the degree of similarity between the marks. While she did not expressly refer to the other factors which the case law required her to consider as part of the global assessment in paragraph 54, such as the extent of overlap between the relevant consumers and the strength of reputation and distinctiveness of the earlier mark, there is no reason to think that she did not also take these factors into consideration since she had expressly referred to them in paragraph 51 of the Decision. I must therefore decide whether this conclusion is one which a reasonable tribunal could have reached in respect of each of the goods in issue.

89. Given that the Hearing Officer found that the mark only had a low degree of inherent distinctiveness, and I have only found that the earlier mark had an enhanced level of distinctiveness through use in respect of food mixers and attachments and accessories for food mixers, but not for other goods, I consider that her conclusion that the average consumer, paying a medium degree of attention, would not make a link between the respective marks when confronted with goods which were either dissimilar or only similar to a low degree was one which a reasonable tribunal could have reached. The Appellant repeated its argument discussed above in relation to s.5(2)(b) that the interdependency principle should not be applied in reverse, so that the fact that the goods are less similar does not mean that it is less likely that consumers would make a link between the marks. I reject that submission for the same reasons I gave above in respect of the same argument under s.5(2)(b). The correctness of this approach for the purposes of s.5(3) was made clear by the CJEU in *Intel Corporation Inc v CPM United Kingdom Ltd* [2008] EUECJ C-252/07 at [42] when it described one of the relevant factors to be taken into account as part of the global assessment for establishing whether the relevant section of the public would establish a link between the marks as *"the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness* ***or dissimilarity*** *between those goods or services, and the relevant section of the public"* (emphasis added). If the Appellant was correct, then there would be no need to consider the dissimilarity between the marks. Accordingly, it was reasonable for the Hearing Officer to conclude that the less similar the goods are, the less likely it is that the consumer would make a link between the marks, while always remembering that that is just one of the relevant factors to be considered when making the global assessment under s.5(3).

90. The appeal therefore fails under this ground in respect of goods which were either dissimilar or similar only to a low degree. I find that consumers would have made a link between the marks in respect of goods which have at least a medium degree of similarity, taking into

account my findings on the evidence of the reputation of the earlier mark and its enhanced distinctiveness in respect of food mixers and attachments and accessories for food mixers, together with the other relevant factors. However, since I have already found that the opposition succeeds under s.5(2)(b) in respect of goods which have a medium degree of similarity or higher, there is no need for me to go on to consider the existence of one or more of the types of injury under s.5(3)

Ground 6: Section 5(4)(a)

91. The Appellant contended that the Hearing Officer erred in finding that the earlier mark only had a *"modest"* goodwill in the business associated with its CHEF marks, when the evidence demonstrated that the Appellant had in fact acquired significant goodwill. In light of my findings that the Hearing Officer erred in her assessment of the evidence, I agree that she should have found from the evidence that the Appellant had acquired significant goodwill in its CHEF marks in the UK in relation to food mixers and attachments and accessories for food mixers.

92. Once again, the Appellant also argued that the Hearing Officer was wrong to apply the interdependency principle in reverse. I reject this submission for the same reasons I gave previously when the same argument was raised in relation to s.5(2)(b) and 5(3). The Hearing Officer said in paragraph 58 of the Decision *"I do not consider that this ground would extend the opponent's success any further than its 5(2)(b) ground. This is because the distance between the remaining goods in the holder's specification and the goods for which the opponent has goodwill would be sufficient to offset the similarity of the marks and to avoid a misrepresentation and damage arising."*. I find that this is a finding a reasonable tribunal could have reached even where the Appellant has a significant goodwill in its CHEF marks in the UK in relation to food mixers and attachments and accessories for food mixers. Accordingly, as with the s.5(2)(b) ground, I only allow the appeal under s.5(4)(a) in respect of the goods which I have found the Hearing Officer should have found to be similar to a medium degree.

Conclusion

93. To summarise, I have found that the appeal succeeds in respect of the goods listed in paragraph 67 above which the Hearing Officer should have found were similar to at least a medium degree. Consequently, the Hearing Officer's findings of a likelihood of confusion in respect of goods which had at least a medium degree of similarity under s.5(2)(b), and her

findings that the s.5(4)(a) ground succeeded to the same extent as the s.5(2)(b) ground, are extended to apply to those goods now found to share a medium degree of similarity.

94. The Trade Mark shall therefore proceed to registration in respect of the goods not shown struck out in the Appendix at the end of this decision.

Costs

95. Since the Appellant has been partially successful on the appeal, I will order that the Respondent shall pay the Appellant £750 towards its costs of the appeal. The Hearing Officer had awarded the Respondent £1,050 towards its costs on the basis that she found that the Respondent had enjoyed the greater degree of success. That costs award included £300 for preparing written submissions when in fact the Respondent did not prepare any written submissions. I will therefore overturn that costs order and order no costs in respect of the proceedings before the Hearing Officer.

96. I therefore make an order that the Respondent pays to the Appellant £750 to be paid within 21 days of the date of this decision.

Simon Clark

The Appointed Person

19 February 2024

Representation:

Appellant: Andrew Lomas instructed by Mathys & Squire LLP

Respondent: Did not appear

APPENDIX

Class 7: *Electric arc cutting apparatus**;** ~~fruit presses, electric, for household purposes;~~ scissors, electric; ~~knives, electric;~~ water heaters being parts of machines; machines and apparatus for wax-polishing**,** electric**;** parquet wax-polishers, electric; dust exhausting installations for cleaning purposes; air suction machines; spin dryers [not heated] / spin driers [not heated].*

Class 11: ~~*Beverage cooling apparatus; bread-making machines;*~~ *heating apparatus, electric;* ~~*cooking utensils, electric;*~~ *electric lamps;* ~~*coffee percolators, electric; coffee machines, electric;*~~ *waffle irons, electric; deep fryers, electric**;** heating*

plates; water heaters; cooking rings; cooking stoves / cookers; kitchen ranges [ovens]; microwave ovens [cooking apparatus]; ~~cooking apparatus and installations; bread baking machines;~~ bread toasters / toasters; hearths; stoves [heating apparatus]; kilns; hot air ovens; roasting apparatus / griddles [cooking appliances] / grills [cooking appliances]; bakers' ovens; hot plates; fittings, shaped, for furnaces / fittings, shaped, for ovens / shaped fittings for furnaces / shaped fittings for ovens; rotisseries; roasting apparatus / griddles [cooking appliances] / grills [cooking appliances]; incandescent burners.

Class 21: *Tea strainers; strainers for household purposes; teapots; autoclaves, non-electric, for cooking / pressure cookers, non-electric; deep fryers, non-electric; ~~ceramics for household purposes;~~ cooking skewers of metal / cooking pins of metal; ~~vessels of metal for making ices and iced drinks;~~ cooking pot sets; ~~kitchen containers; basting spoons [cooking utensils];~~ pots; ~~spatulas for kitchen use;~~ scoops for household purposes; pie servers / tart scoops; ~~kitchen grinders, non-electric; kitchen grinders, non-electric; moulds [kitchen utensils] / molds [kitchen utensils]; cookery moulds / cookery molds; cake moulds / cake molds; tableware, other than knives, forks and spoons; cookie [biscuit] cutters; pastry cutters;~~ napkin rings; bottle openers, electric and non-electric; pot lids; dish covers / covers for dishes; stew-pans; frying pans; ~~containers for household or kitchen use;~~ bread bins; ~~heat-insulated containers; mills for household purposes, hand-operated; sieves [household utensils];~~ dishes; salad bowls; vegetable dishes; ~~garlic presses [kitchen utensils]~~.*