

TRADE MARKS ACT 1994

**IN THE MATTER of Application No 2224196
by Robert Morrison**

and

**IN THE MATTER of Opposition thereto under No 51310
by William Levene Ltd**

Background

1. On 1 March 2000, Robert Morrison applied under the Trade Marks Act 1994 to register the trade mark **CULINOX**, for specification of goods which reads:

Class 08:

Hand operated bottle openers; scissors; knives; can openers; hand tools and implements; cutlery; coffee servers; boxes for cutlery; servers; lifting forks; scoops (being hand tools); food tongs; nut crackers; cleavers; pickle forks; pickle servers; salad spinners; spaghetti servers; egg toppers, egg piercers, egg slicers; chopsticks (for eating), slices/turners; ladles; oyster knives; buffer curlers; garneting knives; jar openers; melon ballers; apple corers; apple segmenters; pastry wheels; pizza wheels; fruit pitters; mashers; bean slicers, servers, knife blocks (with knives); spatulas; barbecue tools; relish servers; tenderisers; ice cream scoops; zesters; palette knives; potato peelers; tongs; pestle and mortars; pastry cutters; crinkle cutters; rocking choppers; sharpening steels; knife sharpeners; salad servers; cheese slicers; metal skewers and wood skewers, all being hand tools; corn forks; grapefruit knives, grapefruit spoons; cake servers; poultry shears; food choppers; mandolins(SLICERS).

Class 21:

Pans, bakeware, teapots, teapot stands, tea strainers, hand operated pepper and salt mills; colanders; ceramic holloware; glassware; soap boxes; cork screws, non electric bottle openers; frying pans; chopping boards; non electric cheese graters; cake moulds; boards for domestic, household and kitchen use; bottle pourers; chopsticks for cooking; cheese graters; garlic presses; barbecue tools; moulds, basters; "waiters friend" cork screws; bottle openers; cork screws; tea infusers; tea bag squeezers; pastry brushes; wine coolers, wine buckets; ice cube trays; cocktail sticks; pepper and salt shakers; bottle brushes; teapot spouts; colanders, strainers, kettles (non electric); covered roasters, lattice cutters, mug trees, paper towel holders; tinsplate bakeware, non stick bakeware, enamel bakeware, steel bakeware, aluminium bakeware, roasters; loaf pans; cooling racks; oven gloves; double oven gloves; magnetic knife racks; oil pouring cans for kitchen use; spoon rests; graters; kitchen boards, chopping boards, made of wood, glass, marble, or plastic; non electric whisks, non electric beaters; trivets; pan stands, food covers, dish brushes, dish mops; metal skewers, wood

skewers for domestic use; sink drainers (trays); scourers; egg poachers; scoops (tableware); vegetable brushes; wine bottle holders; utensil holders; egg cups, funnels, muslin pads (unless impregnated); bread bins; honey dippers; asparagus steamers; butter dishes; banana hangers; carving boards; chip baskets; cooking rings (moulds); crepe pans; cutlery trays; dry (ridged) fry pans; fish poachers; piping bags and nozzles; food warmers; gravy boats; jelly bags; jam funnels; milk pans; rotary graters; rotary mills; nutmeg graters; pasta mills; pastry blenders; shakers; splatter guards; woks; stirfry pans; metal teapots; toast racks; flour sifters.

2. The application was accepted and published. On 17 August 2000, William Levene Limited filed notice of opposition to the application. The statement of grounds accompanying the notice of opposition set out two grounds of opposition, these can be summarised as follows:

- (a) under section 5(2)(b) of the Trade Marks Act 1994 in that the trade mark the subject of the application **CULINOX** is similar to the opponents' earlier trade marks **CULINARE**, and **CULINARE (stylised)** and that the goods for which the application is made are identical or similar to those for which the earlier trade marks are protected and there exists a likelihood of confusion; and
- (b) under section 5(4)(a) of the Act in that, having regard to the goodwill and reputation in the opponents' trade mark **CULINARE**, registration of the trade mark the subject of the application is liable to be prevented by the law of passing off.

3. The statement of grounds at paragraph 4 states:

“4. For the reasons herein stated, the mark applied for is not distinctive of the Applicants' goods within the meaning of the Act.”

4. The applicants filed a counterstatement admitting that the opponents were the proprietors of the earlier trade marks referred to in their statement of grounds and admitting that some of the earlier marks covered goods identical or similar to those for which the applicants seek protection. The counter-statement does not admit that the marks are similar such that there exists a likelihood of confusion. Further, it goes on to indicate that the applicants will rely on the fact that the prefix CULIN is a clear and recognised reference to the ordinary English word “culinary” and is an obvious allusion to the intended nature and purpose of the goods concerned. In addition, the counter-statement asserts that the mark is distinctive of the applicants' goods.

5. Both parties seek an award of costs and both parties filed evidence in the proceedings. Following completion of the evidence rounds, I reviewed the pleadings and the evidence and concluded that I could reach a decision on this matter without the need for an oral hearing. The parties were informed of my view but retained the right to an oral hearing. A period of time was set for them to request an oral hearing or file written submissions to be taken into account when reaching my decision. The applicants and opponents in letters dated 1 May and 13 May 2002 indicated that they did not wish to be heard. Both parties filed written submissions and these were received by the Office on 12 June. Therefore, after a careful

study of the pleadings, evidence and submissions filed in these proceedings, I give my decision.

Evidence

Opponents' Evidence

6. The opponents' evidence consists of a witness statement dated 13 August 2001, by Mr Max Crosby-Browne, Managing Director of William Levene Limited, a position he has held since 2000. The information he gives is from his own knowledge or from the records of the opponents (his company).

7. Mr Crosby-Browne states that his company was founded in 1947 and they first used the trade mark CULINARE in relation to kitchenware and household products in September 1990. At exhibit 1 he attached promotional catalogues featuring products offered by the opponent under the trade mark. There are a number of catalogues covering a range of household and kitchen utensils. Predominantly, these show use of the trade mark CULINARE (stylised). The first catalogue confirms the information given by Mr Crosby-Browne concerning the founding of the company in 1947.

8. Mr Crosby-Browne states that the opponents' trade mark has been registered since 1989 and that his company is the proprietor of a number of trade marks, details of which are set out in an Annex to this decision. Details of their trade mark registrations throughout the world are exhibited at exhibit 4. Mr Crosby-Browne states that the mark has been used in the United Kingdom in relation to a range of over 500 kitchenware and household products. As a consequence of such use, he claims that the opponents enjoy an extensive goodwill and common law rights in the trade mark in respect of these goods in the United Kingdom. At exhibit 3 he provides examples of product packaging. These photographs again show a range of products that I would describe as cooking and kitchen utensils. They show use of the mark CULINARE (sometimes stylised).

9. Mr Crosby-Browne goes on to give details of turnover under the trade mark in the United Kingdom. He estimates that, since first use, this will be approximately £81 million. He gives the following approximate annual figures of sales turnover of goods bearing the trade mark sold by the opponents:

Year	Turnover in million (£)
1991	4
1992	6
1993	6
1994	7
1995	8
1996	10
1997	10
1998	12
1999	10

10. He estimates that worldwide turnover under the trade mark as £120 million.

11. Mr Crosby-Browne says that sales of these goods have been made through independent hardware shops, department stores, supermarkets, wholesalers, mail order catalogues and other retailers. He gives a list of retailers as follows:

Department Stores : Argos, Boots, John Lewis, Fenwicks, Owen Owen, Debenhams, House of Fraser, Selfridges, Harrods, Alders.

Supermarkets: Safeway, Sainsburys, Tesco, Asda, Morrisons, Co-op, Waitrose.

Wholesalers: Decco (who he states are the largest in the UK), and UHM (who he states are an extremely large wholesales selling to the majority of hardware shops in the UK).

Mail Order: Littlewoods, Kaleidoscope, GUS, Shop TV, QVC, Teleshop, Screen Shop.

12. In addition he states that Best Direct Limited (a sister company of the opponents) has its own shopping channel which has 14 hours airtime daily and which features goods branded with the trade mark. Mr Crosby-Browne says that since its launch, the opponent has spent approximately £3.3 million in advertising the goods in the UK and £10 million worldwide. He gives approximate figures for advertising in the years 1991-2000. These start at around £250,00 but from 1998 they rise to £400,000. He states that advertisements have appeared on television (ITV and channel 4) and that one such advert featured the celebrity Nick Hancock. Examples are exhibited at exhibit 5 and show an advertisement for a can opener. Also included are video tapes of the sort of in-store advertisements shown in department stores. The products shown are a can opener, a cafetiere that keeps the contents hot and a grinding mill. He states that other advertisements have appeared in various trade journals such as Housewares, DIY Week, Gourmet Retailing, Hardware and Garden Review and Superstore Management. They have also appeared in other printed publications such as Good Housekeeping, Bella and other women's magazines. He provides examples of these at exhibit 5. Further, he states that the trade mark has been given free press coverage in national newspapers.

13. Mr Crosby-Browne states that the opponents attend and participate in all the major trade exhibitions. Recent exhibitions attended include Spring Fair which is held at the NEC and which is the UK's biggest housewares fair and AIS (Associated Independent Stores). Mr Crosby-Browne says that Housewares Business Centre, an independent trade association for housewares manufacturers in the UK, states that MAGICAN (a product sold under the trade mark) is the biggest selling can opener in the UK market and that they describe the opponents as a market leader since 1991.

14. Turning to the reference made by the applicants in their counter-statement of third parties' use of the prefix CULIN, he states that absent any evidence from the applicants showing use of those marks it is not possible for him to address that point. However, he indicates that the

Community Trade Mark application for Q-LINAIR was opposed by the opponents and that enquiries are being made into the alleged use of another mark.

15. Mr Crosby-Browne concludes by stating his view that the opponents' trade mark is extremely well-known in the United Kingdom and that the opponents have a substantial goodwill and reputation under the trade mark in connection with the goods. In his opinion, any use or registration of other trade marks consisting or containing prominently a mark which features the element CULIN will be likely to cause confusion in the minds of consumers. In particular, he suggests that any use in respect of goods covered by classes 8 and 21 would lead consumers to assume the goods to be a product of the opponents or to assume that the goods were licenced or associated with the opponents in some way.

Applicants' Evidence

16. This consists of a witness statement by the applicant himself, Mr Robert Morrison. He states that he is managing director of seven retail outlets which specialise in the sale of Kitchenware and Cooking Utensils. These are located in Westbourne, Winchester, Christchurch, Boscombe, Weymouth, Poole and Swindon. He says that he has worked in the retail sector of kitchenware and cooking utensils since 1992 when the business was founded in Ross-on-Wye. He says that this retail outlet was subsequently sold as a going concern and still trades as a cookshop.

17. Mr Morrison says that he specialises in sourcing products from abroad and his family operates three other retail outlets and these are located in Warwick, Banbury and Rugby. He explains that he has also acted as a consultant to Poole Pottery Limited advising about their retail activities.

18. Mr Morrison makes various comments concerning the evidence submitted by Mr Crosby-Browne and the comparison between the two trade marks. He states his view that the only common element between the two trade marks is CULIN which he says is the ordinary prefix to the word 'culinary' and that it is an obvious allusion to the intended nature or purpose of the goods. At RM1 he exhibits a copy of the definition of 'culinary' taken from the Concise Oxford Dictionary which he states supports his view. He notes that culinary is defined as "pertaining to kitchen or cooking" and stems from the Latin "culinarius".

19. Mr Morrison states that the bulk of the opponents' evidence aims to prove use of the various registrations and therefore the reputation of the marks in question. However, he states his view that it does not support the claim that CULINOX and CULINARE would be confused. Nor does it rebut the claim that in view of the descriptive nature of CULIN- the burden of comparison should fall on the terminal portion of each mark. In his view the question of whether or not any confusion would arise is most relevant, not whether CULINARE has a reputation. These comments are submissions, not evidence, but I will consider them when reaching my decision. Mr Morrison goes on to make a comparison of the suffix of the two marks. Again, these are submissions and I will consider them later.

20. At RM2, Mr Morrison exhibits details of International Registration 271878R for the mark CULINOX in classes 8 and 21 in the name of Spring AG. He notes that this registration dates from February 1963 and that the countries covered by that registration include Austria,

Germany, Spain, France, Italy, Portugal and Benelux. He states that this international registration has apparently coexisted with CULINARE registrations covering those countries. He refers to various registrations mentioned by the opponents and notes that the oldest of these dates from 19 September 1995. He states his view that given that the registration for CULINOX in the name of Spring AG dates from before various CULINARE registrations, it would suggest that coexistence of these two marks in practice does not lead to any confusion in the marketplace, whether the market be in the UK or abroad.

21. Mr Morrison makes further comments concerning the opponents' evidence, at RM3 he exhibits examples which he states shows use of the CULIN- prefix by third parties as follows:

Mark	Goods	User
CULINAR	Cooks knife, cutlery	Wustof Dreizack supplied through A J Boulton, Stoke on Trent
Culina	Kitchen Scales	Soehnle supplied through Austin White Northampton
POTERIE CULINAIRE	Kitchen Utensils	Emile Henry/Travffler
ARTS CULINARE	Stainless Cookware	Supplied by I Grunweg Limited; Sheffield
HEART OF ENGLAND SALON CULINAIRE	British Open Cookery Championship Hospitality Week 97	
WELSH INTERNATIONAL SALON CULINAIRE 2001	North Wales Chefs Guild	
CUSINAR	Cutlery, kitchen utensils	World Kitchen (UK) Limited

22. Mr Morrison goes on to note the reference in the opponents' evidence to the Community Trade Mark 444562 Q-LINAIR. He states that although the mark was opposed by the opponent in this case, the application was withdrawn by the applicants and that no reason for the withdrawal is given.

23. Referring to exhibit 5 of the opponents' evidence he notes that the video featured three videos for different markets, only one of which was the UK. He states that the videos aimed at overseas markets are not relevant. Further he notes that the voice-over on the "safety-can" video mentions CULINARE but that the word CULINARE is not visible on the screen at any time. He also makes various comments concerning the counter-statement and the absence of any evidence from Mr Crosby-Browne concerning the similarity of some of the goods.

24. Mr Morrison concludes by stating that although the mark CULINARE may be a distinctive mark, this does not give the opponents exclusive rights to the CULIN- prefix. He

states that the opponent through this opposition is attempting to extend the monopoly rights to all trade marks which contain the prefix CULIN-.

Opponents' evidence in reply

25. This consists of a further witness statement by Mr Max Crosby-Browne. He makes various comments concerning the way in which the marks would be pronounced and the relative importance of prefixes and suffixes and the relevance of reputation when assessing the question under section 5(2). As with the evidence of Mr Morrison, this is not evidence but merely submission and I will not summarise it here but will take account of it when reaching my decision.

26. Referring to the applicants' comments on International Registration number 271878R in the name of Spring AG, he notes that this trade mark does not cover the United Kingdom and so is, in his view, irrelevant. Concerning the alleged use by third parties of trade marks which feature the element CULIN- , he makes the following comments.

CULINAR

27. He refers to various pages of exhibit RM3 and the use on these of the trade mark CULINAR. At MCB1 he exhibits a copy of a declaration of prior rights and licence agreement executed by Ed, Wusthof Dreizackwerk Solingen. He notes from the agreement that use of CULINAR by this company is under licence from the opponents.

CULINA

28. He states his view that RM3 does not refer to CULINA and is therefore not relevant.

POTERIE CULINAIRE

29. He states his view that the use of these words in the exhibit show is used as the french words 'culinary pottery' which appears to be descriptive use and not trade mark use.

ARTS CULINAIRE

30. He notes that pages 34-37 do show reference to these words but as the origin of the extracts is not stated he cannot comment on the words other than to point out that it is obviously a two word mark.

31. Referring to the other references at exhibit RM3, he notes that no information has been provided by the applicants as to where the photographs were taken or what these references relate to. Mr Crosby-Browne states that a search of the internet revealed a reference to "Salon Culinaire" on the Food and Beverage Training Company website and an extract is attached at exhibit MCB2. He says that this describes nine national competitions for chefs and food and beverage service staff, one of which is "salon culinaire". He concludes that use of these words on the award plates would be seen as the french translation of the English "Culinary Show". He states that the use on plates shows it as an award rather than as a trade mark on plates.

CUSINAR

32. Mr Crosby-Browne states that page 40 of exhibit RM3 refers to World Kitchen but that there is no use of the word CULIN as a prefix on this page.

Decision

33. The grounds of opposition refer to sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994. The relevant provisions read as follows:

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

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

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

(3).....

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

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

34. The term ‘earlier trade mark’ is defined in section 6 of the Act as follows:

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

- (a) 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,”

Section 5(2)(b)

35. I will deal first with the opponents’ ground of opposition under section 5(2)(b). In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon*

Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 132, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 224;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 224;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 133 paragraph 29.

36. Under section 5(2), the test is a composite one, involving a global appreciation taking into account a number of factors. With these comments in mind I proceed to consider the opponents' case under section 5(2)(b).

The earlier trade mark

37. The opponents are the proprietors of a number of trade marks set out in an annex to this decision. All are earlier trade marks within the meaning of section 6 of the Trade Marks Act 1994. The opponents' registrations cover a range of goods, and they seek in their statement of grounds to rely on the trade marks CULINARE and CULINARE (stylised). The stylised version of the mark is not, in my view, highly stylised (see below) and as such it does not seem to me to matter whether I consider the question under section 5(2) with reference to their word mark CULINARE in plain block capitals or their stylised mark.



38. I will consider the question with reference to the opponents' CULINARE in block capitals. Again, they have a number of registrations for this mark covering a range of goods. Two of their earliest marks are reproduced below alongside the applicants' mark.

Applicants' trade mark

Opponents' trade marks

CULINOX

CULINARE

1391235

Class 8

Class 8

Hand operated bottle openers; scissors; knives; can openers; hand tools and implements; cutlery; coffee servers; boxes for cutlery; servers; lifting forks; scoops (being hand tools); food tongs; nut crackers; cleavers; pickle forks; pickle servers; salad spinners; spaghetti servers; egg toppers, egg piercers, egg slicers; chopsticks (for eating), slices/turners; ladles; oyster knives; buffer curlers; garneting knives; jar openers; melon ballers; apple corers; apple segmenters; pastry wheels; pizza wheels; fruit pitters; mashers; bean slicers, servers, knife blocks (with knives); spatulas; barbecue tools; relish servers; tenderisers; ice cream scoops; zesters; palette knives; potato peelers; tongs; pestle and mortars; pastry cutters; crinkle cutters; rocking choppers; sharpening steels; knife sharpeners; salad servers; cheese slicers; metal skewers and wood skewers, all being hand tools; corn forks; grapefruit knives, grapefruit spoons; cake servers; poultry shears; food choppers; mandolins(SLICERS).

Hand-held kitchen implements and tools; all included in class 8.

1474962

Class 21

Class 21

Pans, bakeware, teapots, teapot stands, tea strainers, hand operated pepper and salt mills; colanders; ceramic holloware; glassware; soap boxes; cork screws,

Household or kitchen utensils and containers; kitchen apparatus, utensils and tools for the

<p>non electric bottle openers; frying pans; chopping boards; non electric cheese graters; cake moulds; boards for domestic, household and kitchen use; bottle pourers; chopsticks for cooking; cheese graters; garlic presses; barbecue tools; moulds, basters; "waiters friend" cork screws; bottle openers; cork screws; tea infusers; tea bag squeezers; pastry brushes; wine coolers, wine buckets; ice cube trays; cocktail sticks; pepper and salt shakers; bottle brushes; teapot spouts; colanders, strainers, kettles (non electric); covered roasters, lattice cutters, mug trees, paper towel holders; tinplate bakeware, non stick bakeware, enamel bakeware, steel bakeware, aluminium bakeware, roasters; loaf pans; cooling racks; oven gloves; double oven gloves; magnetic knife racks; oil pouring cans for kitchen use; spoon rests; graters; kitchen boards, chopping boards, made of wood, glass, marble, or plastic; non electric whisks, non electric beaters; trivets; pan stands, food covers, dish brushes, dish mops; metal skewers, wood skewers for domestic use; sink drainers (trays); scourers; egg poachers; scoops (tableware); vegetable brushes; wine bottle holders; utensil holders; egg cups, funnels, muslin pads (unless impregnated); bread bins; honey dippers; asparagus steamers; butter dishes; banana hangers; carving boards; chip baskets; cooking rings (moulds); crepe pans; cutlery trays; dry (ridged) fry pans; fish poachers; piping bags and nozzles; food warmers; gravy boats; jelly bags; jam funnels; milk pans; rotary graters; rotary mills; nutmeg graters; pasta mills; pastry blenders; shakers; splatter guards; woks; stirfry pans; metal teapots; toast racks; flour sifters.</p>	<p>preparation and processing of food; dispensers; sponges; brushes and brooms; articles for cleaning purposes; steel wool; glassware, porcelain and earthenware for household and kitchen purposes; ovenware, tableware, ceramics; parts and fittings for all the aforesaid goods; all included in class 21.</p>
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Reputation/Inherent distinctiveness of the earlier trade mark

39. The opponents' earlier trade mark is the word CULINARE. In the opponents' submission this mark is inherently distinctive for the goods in question. In addition, they argue that because of the use made of it, it has acquired an enhanced level of recognition amongst the relevant public.

40. In contrast, the applicants argue that the inherent distinctive character of the opponents' mark is low. They refer to the dictionary definitions of the word culinary - "pertaining to kitchen or cooking". Further, the applicants filed evidence purporting to show the use by third parties of the prefix CULIN in relation to goods and services associated with food and the opponents filed evidence seeking to rebut this.

41. Having considered the evidence and submissions on this point, I reach the view that the opponents' trade mark has some inherent distinctive character, however, it is not in my view very high. It seems to me that, having regard to the nature of the goods in question, the prefix

CULIN would, to the average consumer of the goods in question, carry some descriptive meaning. That is, that the goods were intended for use in the kitchen or in cookery.

42. However, in my view, the evidence also shows that the opponents' trade marks have been in the market place for a number of years. Their products bearing the trade mark have been available through a number of high street department stores such as Debenhams and House of Fraser and through catalogues and independent retailers. Their turnover has been consistently high and they have shown use across a wide range of kitchen and cookery utensils. The evidence also shows expenditure on advertisements for products under the trade mark including television commercials and magazine advertisements. The early use shown seems to be predominantly of the stylised version of the mark but there is also use of the mark in plain block capitals. However, given my conclusions that this mark is not a highly stylised mark, it seems to me that use of the stylised mark would, in any event have had an effect on the distinctiveness of the plain word mark. Therefore, it seems to me that having regard to the evidence on file, I can find that the mark in question has an enhanced level of recognition with the relevant public as a result of the use made of it.

43. To conclude, I find that although the opponents' mark CULINARE does not possess a high degree of distinctiveness per se, that distinctive character has been enhanced through the use that has been made of the trade mark.

Comparison of the Trade Marks

44. I now proceed to compare the trade marks, taking into account any visual, aural or conceptual similarities. I must judge the matter through the eyes of the average consumer who is deemed to be reasonably well informed and circumspect. The average consumer of both the applicants' and opponents' products would be ordinary members of the public.

45. Visually, both marks are similar in overall length, the applicants mark CULINOX is seven letters in length and the opponents' mark CULINARE is eight letters. Both marks start with the same five letters CULIN. At first sight, this seems to present a strong point of visual reference. However, balanced against that is the fact that I have found that the prefix CULIN is semi-descriptive of the goods in question. The marks have different endings ARE and OX but as this dissimilarity occurs at the end of the marks one would think that this would have less visual impact on the eye of the average consumer. Although marks must be judged as a whole, given the semi-descriptive nature of the prefix CULIN this would, in my view, draw the attention of the average consumer to the endings of the marks in question. To conclude, I find that there is a degree of visual similarity between the two trade marks.

46. Aurally, similar considerations apply; both start with the same prefix CULIN. It is well established that in oral use the beginning of words assume more importance, with endings tending to become slurred or lost. However, in my view, that is not so here. In addition to my comments above concerning the prefix CULIN, the endings ARE and OX have a very different sound to the ear. It seems to me that the opponents' mark would be pronounced CULIN AIR, and indeed, this is how it is pronounced on the television commercials put in evidence. Although I have no evidence as to how the applicants' mark would be pronounced it seems to me fair to assume that it would be pronounced CULIN OX. As noted above, these endings are

quite different and even taking into account the tendency of English language speakers to slur endings I think that they would enable the average consumer to differentiate between the two. Thus, although there is some aural similarity between the marks it is not very strong.

47. Conceptually, I have already determined that CULIN carries with it some descriptive meaning to the average consumer in relation to the goods for which the earlier mark is protected and the goods for which registration is sought. Therefore, it seems to me that both marks CULINOX and CULINARE would, conceptually, imply that the goods were connected with cookery or the kitchen. The endings do not appear to carry any descriptive meaning, although I note that the evidence shows that the word CULINAIRE is French for culinary. The average consumer would not necessarily be aware of this and so, in my view, the average consumer would view both marks as made up words with the prefix CULIN alluding to the purpose of the goods. There is therefore, some conceptual similarity between the marks.

Similarity of the Goods

48. Whilst there was some dispute as to the similarity between some of the goods listed in the opponents' earlier trade marks and those listed in the application, I think that it was common ground between the parties that the goods covered by the application are identical or similar to those for which certain of the opponents' trade marks are registered. **It seems to me, having regard to the opponents' two trade marks listed above 1397235 & 1474962, that these two marks registered in classes 8 and 21 respectively are registered for goods identical or very similar to those for which the applicants seek protection.**

Conclusions under section 5(2)(b)

49. Together with my finding in relation to the inherent distinctiveness of the opponents' mark, the level of recognition it enjoys, the degree of similarity of the marks and the identity/high degree of similarity of the goods, how do these findings come together under section 5(2)(b).

50. Mr Hobbs, Q.C., sitting as the Appointed Person in *Balmoral Trade Mark* [1998] R.P.C. 297 at page 301, found that section 5(2) raised a single composite question. Adapted to this case it can be stated as follows:

Are there similarities (in terms of marks and goods or services) which would combine to create a likelihood of confusion if the "earlier trade mark", **CULINARE** and the sign subsequently presented for registration, **CULINOX**, were used concurrently in relation to the goods or services for which they are respectively registered and proposed to be registered?

51. Having considered the various factors, I reach the view that this question must be answered in the negative. In so finding, I have taken account of the identity/ high degree of similarity of the goods and that a lesser degree of similarity between the marks can be offset by a greater degree of similarity/identity between the goods.

52. However, although I found that the opponents' trade mark enjoyed an enhanced degree of recognition in the market place, that must in my view be balanced against the fact that to some

degree, the mark is descriptive of the goods in question. As such, although there is some visual, aural and conceptual similarity in the marks, given that this occurs in an element that is at the very least, semi-descriptive of the nature of the goods in question, then the differences in the endings OX and ARE would be sufficient in my view to enable the average consumer to differentiate between the two marks. In so finding, I have taken into account the fact that the average consumer will not usually see the two marks side by side but instead must rely on their recollection of the marks which will not always be perfect.

53. I must also factor in the relevant consumer who will be ordinary members of the public and also take account of the nature of the goods themselves. These do not appear to be very expensive household items but neither in my view are they casual or frequent purchases. They are the sort of item that one would take some care over purchasing, either to ensure quality or to match items previously purchased and already in the household kitchen.

54. All these factors taken together, lead me to the view that the opponents have not shown the necessary likelihood of confusion if the marks CULINOX and CULINARE were used on the same goods. In so finding, I have considered whether the public would wrongly believe that the goods came from the same or economically linked undertaking. Again, given my findings above, in my view, they would not.

55. Therefore, I find that the opponents have failed to show that there is a likelihood of confusion within the meaning of section 5(2)(b) and the ground of opposition is dismissed.

Section 5(4)(a)

56. The opponents also seek to rely on the ground of objection under section 5(4)(a) of the Trade Marks Act 1994. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- (1) that the opponents' goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the applicants (whether or not intentional) leading or likely to lead the public to believe that goods offered by the applicants are goods or services of the opponents; and
- (3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicants' misrepresentation.

Goodwill and Reputation

57. Under section 5(2)(b) I found that the opponents' marks enjoyed an enhanced level of recognition amongst the relevant public. Given my findings there, I think that the same considerations apply here. They have in my view shown consistent use across a range of products over a prolonged period of time and included in their evidence examples of

advertisements. Based on that evidence I find that at the relevant date the opponents enjoyed a degree of goodwill and reputation in the mark CULINARE. However, that finding must be tempered with the conclusion that CULIN is somewhat descriptive in relation to the goods in question. It is well established that the more descriptive the mark is, the harder it is to show that the mark in question has acquired a goodwill and reputation; see for example the judgment of Mr Robert Englehart Q.C., sitting as a Deputy Judge of the High Court in *Radio Taxicabs (London) Limited v. Owner Drivers radio taxi Services Limited* (12 October 2001).

Misrepresentation

58. Mr Hobbs, in the *Wild Child* case mentioned above, referred to *Halsbury's Laws Of England* 4th Edition Vol 48 (1995 reissue) at paragraphs 184 - 188. The current edition reads:

“To establish a likelihood of deception or confusion in an action for passing-off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

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

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

59. The passage notes that whilst the first two elements appear to be two separate hurdles they are in fact inter-related. It seems to me that the question that I must answer is as follows:

Having regard to the goodwill and reputation found in the trade mark CULINARE for kitchen and household utensils amongst ordinary members of the public, will those persons mistakenly infer from the applicants’ use of the mark CULINOX on the same goods for which registration is sought, that they are provided by the opponents or are connected.

60. It seems to me that this question must be answered in the negative. This, in my view, is a case where the opponents cannot be in any better position under section 5(4)(a) than they were under section 5(2)(b). Although I have found that they have the necessary goodwill and reputation, that finding must be balanced against the fact that the common element in both marks is semi-descriptive of the goods in question. As such, the differences between the marks would in my view assume more importance and so avoid any misrepresentation. **Accordingly, the opposition under section 5(4)(a) is dismissed.**

Conclusions

61. The opponents’ grounds of opposition under section 5(2)(b) and 5(4)(a) are both dismissed.

Costs

62. The applicants have been successful and are entitled to a contribution towards their costs. I order that the opponents pay the applicants the sum of £1500-00. 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 03 day of January 2003

**S P Rowan
For the Registrar
the Comptroller General**

ANNEX

Available as 'order a copy'.