

Neutral Citation Number: [2004] EWHC 1930 (Ch)

Case No: HC07C02299

IN THE HIGH COURT OF JUSTICE
CHANCERY DIVISION
COMMUNITY TRADE MARK COURT
INTELLECTUAL PROPERTY

Royal Courts of Justice
Strand, London, WC2A 2LL
Date: 04/08/2008

Before :

MR. GEOFFREY HOBBS Q.C (Sitting as a Deputy High Court Judge)

Between :

- 1. WHIRLPOOL CORPORATION**
(a company existing under the laws of Delaware, United States of America)
- 2. WHIRLPOOL PROPERTIES INC**
(a company existing under the laws of Michigan, United States of America)
- 3. KITCHENAID EUROPA INC.**
(a company existing under the laws of Delaware, United States of America)

Claimants

- and -

KENWOOD LIMITED

Defendant

Mr. James Mellor QC and Mr. Thomas Moody-Stuart (instructed by Lewis Silkin LLP)
for the Claimants

Mr. Iain Purvis QC, Mr. Andrew Lykiardopoulos and Ms. Iona Berkeley (instructed by Dechert
LLP) for the Defendant

Hearing dates: 7 to 9 and 12 to 16 May 2008

Approved Judgment

I direct that pursuant to CPR PD 39A para 6.1 no official shorthand note shall be taken of this Judgment and that copies of this version as handed down may be treated as authentic.

1. The claimants in these proceedings are members of the Whirlpool group of companies. They are Whirlpool Corporation (a Delaware company responsible for manufacturing KitchenAid products under licence from Whirlpool Properties Inc); (2) Whirlpool Properties Inc. (a Michigan company responsible for the protection and licensing of Whirlpool Group intellectual property rights); and (3) KitchenAid Europa Inc. (a Delaware company responsible for sales and marketing of KitchenAid products throughout the EEA). It is generally unnecessary to distinguish between them for the purposes of the claims they have made against the defendant, Kenwood Ltd. Except where there is a particular need to be more specific, I shall refer to them collectively as '*Whirlpool*'. I shall refer to the defendant simply as '*Kenwood*'.

2. The ultimate question in the action is whether Whirlpool is entitled, either on the basis of the rights conferred by registration of Community trade mark number 2, 174, 761 or on the basis of the law relating to passing off, to prevent Kenwood from marketing stand mixers having the shape and appearance of its kMix mixer launched in July 2007. No claim was advanced under the provisions of Section 56 of the Trade Marks Act 1994 relating to the protection of well-known marks.

3. In its pleadings Kenwood raised a counterclaim for invalidity of the Community trade mark registration upon the premise that there would be invalidity for lack of distinctiveness if there was similarity sufficient to support a finding of infringement. However, this backwards to forwards reasoning disclosed no sustainable basis for declaring the registration invalid under Articles 92(d), 96 and 97(3) of Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community trade mark ('*the CTMR*'). First, it apparently conceded that the registration would be valid and infringed by use of a trade mark identical to the registered mark. Second, it apparently conceded

that the registration should be presumed valid pending determination of the question of liability for infringement, even though there could be no liability for infringement if the trade mark was invalidly registered. Third, it ran counter to the established principle that the grounds for refusal of registration should be applied independently of the defences that might be available to traders accused of infringement¹. Whirlpool rightly regarded the counterclaim as insufficient hence ineffective to displace the presumption of validity under Article 95 CTMR. In the end, Kenwood decided not to dispute the validity of the registration in suit.

4. The kMix mixer is marketed in the United Kingdom and other Member States. There are two points arising out of that which need to be mentioned at this juncture. First, Whirlpool is claiming a Community-wide injunction under Articles 94(1) and 98(1) CTMR. There are unresolved issues as to whether those Articles permit or require a Community Trade Mark Court designated under Article 91 CTMR to grant an injunction covering areas of the Community which cannot, on the basis of the evidence before the court, be positively identified as areas in which the defendant's activities would satisfy the requirements for a finding of liability under Article 9 CTMR². It is anticipated that the ECJ will, in the near future, provide guidance on that point.³ In the meantime I simply record that the evidence before me concentrated on the position in the marketplace in the United Kingdom and to a much lesser extent in France and Germany, with the position elsewhere in the Community being for all practical purposes left unexplained. The second point is that in relation to trading activities extending across national boundaries within the EU, a claim for passing off no less than a claim for trade mark

¹ Case C-104/01 Libertel Groep BV v. Benelux-Merkenbureau [2003] ECR I-3793, paras 57 to 59; Case C-404/02 Nichols plc v. Registrar of Trade Marks [2004] ECR I-8499, paras 32 to 34; Case C-102/07 Adidas AG v. Marca Mode CV [2008] ECR I-00000, paras 26 and 49.

² Alexander von Mülendahl Community Trade Mark Riddles: Territoriality and Unitary Character [2008] EIPR 66 at pp.68 et seq.

³ In Case C-301/07 PAGO International GmbH.

infringement should be resolved by reference to the presumed expectations of the average consumer of the goods or services concerned, who must for that purpose be taken to be reasonably well-informed and reasonably observant and circumspect.⁴ This was common ground between the parties at the hearing before me.⁵

5. The aim of both claims is to compel Kenwood to further differentiate the shape and appearance of its kMix mixers from the shape and appearance of Whirlpool's KitchenAid Artisan mixers. This is a KitchenAid Artisan mixer:



⁴ Case C-220-98 Estée Lauder Cosmetics GmbH & Co. OHG v. Lancaster Group GmbH [2000] ECR I-117 at paras. 27 to 31. See also paras. 59 to 65 of the Opinion of Advocate General Jacobs in Case C-312/98 Schutzverband Gegen Unwesen In Der Wirtschaft EV v. Warsteiner Brauerei Haus Cramer GmbH & Co KG [2000] ECR I-9187.

⁵ Transcript Day 8, p.1116.



The images are of a mixer in Empire Red, shown achromatically. The mixers are available in a variety of rich colours, the most popular in recent years having been red, almond and white. They are also available in an all-metallic finish. On the evidence before me it is clear that the selection of colour (or an all-metallic finish) is made with care by purchasers buying for domestic use. People buy these mixers for their style and presentation as well as for their functional qualities.

6. This is a Kenwood kMix mixer:



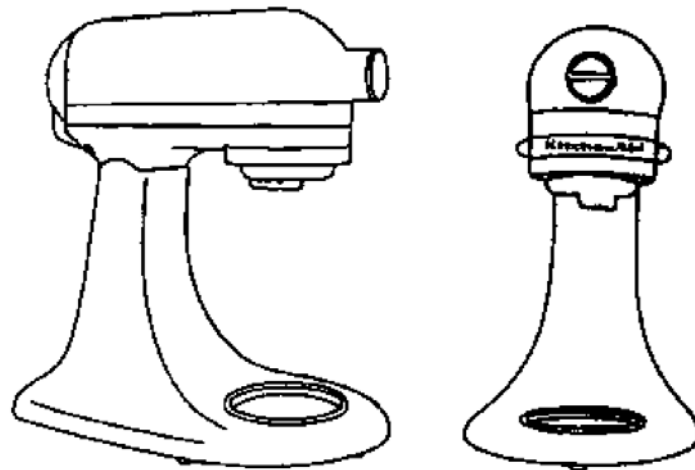


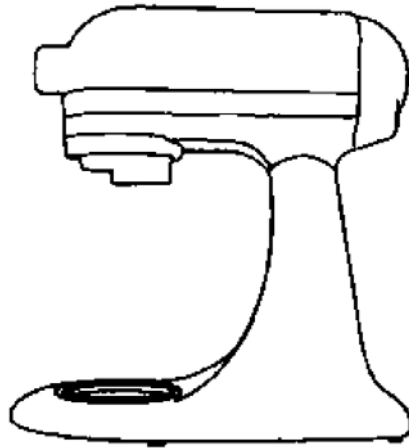
The images are of a mixer in Raspberry, shown achromatically. The mixers are available in other colours including almond and white.

7. The evolution of the design of the kMix was examined at some length in the evidence at trial. There was and remains no allegation by Whirlpool that the kMix was actually designed to deceive or mislead people. The suggestion is that there was a miscalculation as to what would be an acceptable design to adopt. I accept that this is a matter that can properly be looked into. On looking into it, I find that the kMix is indeed what it appears to be. It is the means by which Kenwood intended to move into the premium price sector of the market occupied by the Artisan mixer and make sales to design conscious consumers as best they could by matching the KitchenAid offer. Kenwood undoubtedly had the KitchenAid Artisan mixer in its sights at all material stages of the process leading up to the finalisation of the design of the kMix. Those involved in the process were in varying degrees sensitive about the parallels between the design proposals they were considering and the design of the Artisan mixer. That, in itself, is not sinister. I will, however, say that one of the proposals should have been seen as so clearly inappropriate as to require it to be excluded from consideration without a

second thought. I am referring to the proposal which would, if adopted, have led to the kMix having a nose-like attachment hub protruding from the front of the mixer head in the same way as the attachment hub on the mixer head of the Artisan. It also appears to me that there was colour matching, with the red and almond colours used for the kMix being brought up tight against the red and almond of the Artisan. Whilst the KENWOOD branding beneath the dial could easily have been larger, I do not regard it as inappropriately small. In my view there was a calculated decision to proceed with the finalised design of the kMix in the sense only that it was thought to be an acceptable design with which to compete head on with the KitchenAid mixer. It was not, on the evidence before me, chosen for that purpose by reason of any anticipated propensity to deceive or mislead.

8. This is the registered representation of Community trade mark number 2,174,761:





At this point, it is relevant to recall that the graphic representation of a mark should be clear, precise, self-contained, easily accessible, intelligible, durable, unequivocal and objective.⁶ This gives effect to the requirement for legal certainty. The graphic representation is expected to be definitive as to the identity of the protected mark, with that being taken to consist only of the particular features which have actually been recorded in the register.⁷

9. Colour is not an element of the mark as registered. The claim for infringement necessarily relates to what I shall call the bodywork of the unitary mixer head and stand recorded in the registered representation, irrespective of the finished appearance of the mixers which actually embody it. By contrast, the claim for passing off relates to the finished appearance of the Artisan mixer as a whole. The registered trade mark is to that extent a disaggregation of features that are, in fact, integral to the overall get-up of the mixers as marketed. The claim for infringement and the claim in passing off are thus made from different (albeit related) vantage points. They should, in my view, be recognised for what they are: separate prongs of a two-pronged attack. I am reinforced in

⁶ Case C-273/00 Sieckmann v. Deutsches Patent-und Markenamt [2002] ECR I-11737 at paragraphs 54, 55.

⁷ L'Oréal SA v. Bellure NV [2007] EWCA Civ. 968 at para. 110 per Jacob LJ.

my unwillingness to unify the two claims by the need to pay particular attention to the content of the Community trade mark registration for the reasons to which I now turn.

10. An application to register a three-dimensional shape as (or as part of) a Community trade mark must comply with the requirements of Rule 3 of the Regulation implementing the CTMR⁸:

Representation of the mark

(1) If the applicant does not wish to claim any special graphic feature or colour, the mark shall be reproduced in normal script, as for example, by typing the letters, numerals and signs in the application. ...

(2) In cases other than those referred to in paragraph 1 and save where the application is filed by electronic means, the mark shall be reproduced on a sheet of paper separate from the sheet on which the text of the application appears. ...

(3) In cases to which paragraph 2 applies, the application shall contain an indication to that effect. The application may contain a description of the mark.

(4) Where registration of a three-dimensional mark is applied for, the application shall contain an indication to that effect. The representation shall consist of a photographic reproduction or a graphic representation of the mark. The representation may contain up to six different perspectives of the mark.

(5) Where registration in colour is applied for, the representation of the mark under paragraph 2 shall consist of the colour reproduction of the mark. The colours making up the mark shall also be indicated in words and a reference to a recognized colour code may be added.

(6) ...

⁸ Commission Regulation (EC) No. 2868/95 of 13 November 1995 as amended by Council Regulation (EC) No. 782/2004 of 26 April 2004 and further amended by Council Regulation (EC) No. 1041/2005 of 29 June 2005.

11. The registration of a three-dimensional shape is liable to be refused under Article 7(1)(b) CTMR if it is ‘*devoid of any distinctive character*’, with the word ‘*devoid*’ being taken to refer to the absence of innate distinctiveness in the shape in question. The case law of the ECJ indicates that the litmus test for innate distinctiveness is whether members of the relevant public who had not become accustomed to the shape through use⁹ would, without analytical examination and without paying particular attention¹⁰, immediately and with certainty distinguish goods of that shape from those of another commercial origin¹¹.

12. The required approach to assessment under Article 7(1)(b) in cases relating to the registrability of three-dimensional shapes has repeatedly been summarised by the ECJ in terms to the following effect¹²:

23. ...it is settled case-law that the distinctive character of a trade mark, within the meaning of Article 7(1)(b) of Regulation No. 40/94, must be assessed, firstly, by reference to the goods or services in respect of which registration has been applied for and, secondly by reference to the perception of them by the relevant public, which consists of average consumers of the goods or services in question who are reasonably well informed and reasonably observant and circumspect (see Joined Cases C-456/01P and C-457/01P *Henkel v. OHIM* [2004] ECR I-5089, paragraph 35, and Case C-173/04P *Deutsche SiSi-Werke v. OHIM* [2006] ECR I-551, paragraph 25).

24. According to equally established case-law, the criteria for assessing the distinctive character of three-dimensional marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade mark (see *Henkel v. OHIM*, paragraph 38, Case C-136/02P *Mag Instrument v. OHIM* [2004] ECR I-9165, paragraph 30, and *Deutsche SiSi-Werke v. OHIM*, paragraph 27).

⁹ Case C-136/02P *Mag Instrument Inc. v. OHIM* [2004] ECR I-9165 at paras. 50, 55 and 56.

¹⁰ Case C-136/02P *Mag Instrument Inc* at para. 32.

¹¹ Case C-24/05P *August Storck KG v. OHIM (Storck I)* [2006] ECR I-5677 at para. 29.

¹² Quoted from Case C-24/05P *Storck I*.

25. None the less, for the purpose of applying those criteria, the relevant public's perception is not necessarily the same in the case of a three-dimensional mark, which consists of the appearance of the product itself, as it is in the case of a word or figurative mark, which consists of a sign unrelated to the appearance of the products it denotes. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element, and it could therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark (see, in particular, *Henkel v. OHIM*, paragraph 38, *Mag Instrument v. OHIM*, paragraph 30, and *Deutsche SiSi-Werke v. OHIM*, paragraph 28).
26. In those circumstances, only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No. 40/94 (see, in particular, *Henkel v. OHIM*, paragraph 39, *Mag Instrument v. OHIM*, paragraph 31, *Deutsche SiSi-Werke v. OHIM*, Paragraph 31).

13. Registrability cannot be made to depend upon compliance with a requirement for peculiarity of shape which is stricter than that stated in the last paragraph of this citation¹³. It is therefore not essential for the shape in question to include some capricious addition, such as an embellishment which has no functional purpose¹⁴. However, that does not detract from the basic proposition that in order to be registrable ab initio under Article 7(1)(b) the shape must be sufficiently arresting to achieve immediate and certain recognition as an indication of trade origin when seen through the eyes of average consumers who are not in the habit of making assumptions about the trade origin of goods on the basis of their shape in the absence of any graphic or word element. It follows that

¹³ Case C-24/05P *Storck I* at paragraphs 28 to 30; Case C-25/05P *August Storck KG v. OHIM (Storck II)* [2006] ECR I-5719 at paragraphs 31 to 33.

¹⁴ Case C-299/99 *Philips* at paras. 49, 50.

a shape can be the embodiment of excellence in terms of design without also serving as an indication of the trade origin of the goods which embody it¹⁵.

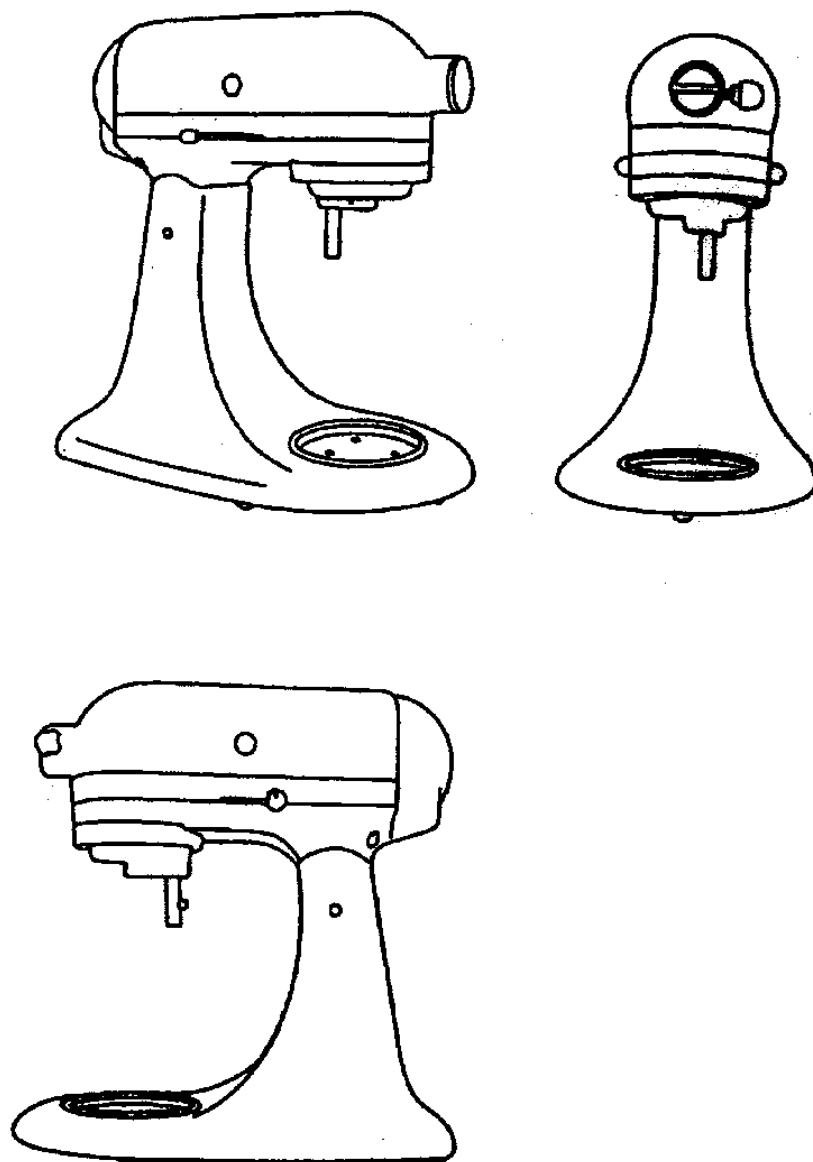
14. Put simply, the question under Article 7(1)(b) is whether the shape presented for registration differs and differs distinctively (in the trade mark sense of the word) from the norm or customs of the relevant sector. The relevant sector may, in order to reflect the realities of the marketplace, be taken to extend beyond goods of the particular kind for which registration has been requested¹⁶. Whilst it remains difficult to establish that a three-dimensional shape is free of objection under Article 7(1)(b), there do still appear to be differences in the degree of difficulty encountered in different courts and tribunals operating within the framework of the harmonised law of trade marks in the Community.¹⁷

15. On 1 October 1999, Whirlpool Properties Inc applied under number 1,331,685 to register the following three-dimensional shape as a Community trade mark for '*electric beating and mixing machines and attachments for such machines*' in Class 7:

¹⁵ Case C-136/02P Mag Instrument Inc at paras. 64 to 68; Société de Produits Nestlé SA v. Unilever Plc [2002] EWHC 2709 (Ch), [2003] ETMR 53, p.681 at para. 18 (Jacob J).

¹⁶ Case C-173/04P Deutsche SiSi-Werke GmbH & Co. Betriebs KG v. OHIM [2006] ECR I-551 at paragraphs 31 to 33.

¹⁷ Compare Bongrain SA's Trade Mark [2004] EWCA Civ. 1690, [2005] ETMR 47, p.604 with the judgment of the German Supreme Court in Case I ZB 38/00 Cheese Shape IR-Mark No. 670, 278 (4 December 2003) noted at [2005] EIPR N-3.



The examiner objected to registration under Article 7(1)(b) on the basis that the shape as a whole was devoid of any distinctive character for goods of the kind specified. The applicant tried, but failed to persuade the examiner that the objection should be waived. On 12 January 2001, the Office issued a decision formally refusing the application. The applicant did not appeal. Nor did it file a fresh application with a view to securing registration under Article 7(3) CTMR.

16. Article 7(3) allows for the possibility that a shape which fails to qualify for registration when considered without regard to any distinctiveness it may have acquired

through use, may nevertheless qualify for protection at the Community level upon evidence that it has become distinctive, in relation to the goods for which registration is requested, in consequence of the use which has been made of it. That is not an easy thing to establish.

17. Firstly, there is the difficulty of proving that the distinctiveness acquired through use extends to the parts of the Community where the objection to registration under Article 7(1)(b) would otherwise be well-founded.¹⁸ That will be the Community en bloc in the case of a shape which is not *prima facie* registrable. Secondly, there is the difficulty of proving that the shape can stand alone as an indication of trade origin, notwithstanding that it will usually if not invariably have been commercialised by reference to words or devices that are (because they are intended to be) recognised as trade marks for the goods to which the shape has been applied. The ECJ has addressed this point¹⁹ in the following terms:

57. ... the Court has ruled, in Case C-353/03 *Nestlé* [2005] ECR I-6135, that a mark may acquire distinctive character within the meaning of Article 3(3) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p.1) in consequence of use of that mark in conjunction with a registered trade mark.

58. The same is true in relation to distinctive character acquired through use for the purposes of Article 7(3) of Regulation No 40/94, since that provision and Article 3(3) of Directive 84/104 are essentially identical.

59. Therefore, a three-dimensional mark may in certain circumstances acquire distinctive character through use even if it is used in conjunction with a word mark or a figurative mark. Such is the case where the mark consists of the shape

¹⁸ Case C-25/05P *Storck II* at paragraphs 83 to 86.

¹⁹ In Case C-24/05 *Storck I*.

of the product or its packaging and where they systematically bear a word mark under which they are marketed.

...

61. Furthermore, in regard to acquisition of distinctive character through use, the identification by the relevant class of persons of the product or service as originating from a given undertaking must be as a result of the use of the mark as a trade mark (Case C-299/99 *Philips* [2002] ECR I-5475, paragraph 64, and *Nestlé*, paragraph 26). The expression ‘use of the mark as a trade mark’ must therefore be understood as referring to use of the mark for the purposes of the identification by the relevant class of persons of the product or service as originating from a given undertaking (*Nestlé*, paragraph 29).

62. Therefore, not every use of the mark ... amounts necessarily to use as a mark.

18. It must, accordingly, be a matter for careful consideration whether the evidence establishes that the shape has successfully been used to identify the product as originating from a given undertaking: use of a shape does not prove that the shape is distinctive; increased use, of itself, does not do so either; the use and increased use must be in a distinctive sense in order to have any materiality.²⁰

19. For applicants wishing to avoid the rigours of Articles 7(1)(b) and 7(3), there is another way of obtaining registration for a three-dimensional mark. It is described in Communication No.2/98 of the President of the Office for Harmonization in the Internal Market concerning the examination of three-dimensional marks.²¹ This states as follows (with emphasis added by me):

The purpose of this Communication is to explain the practice of the Office in examining applications for registration of three-dimensional marks.

²⁰ cf *Bach and Bach Flower Remedies Trade Mark* [2000] RPC 513 (CA) at paragraph 49 per Morritt LJ.
²¹ 8 April 1998. OJ OHIM 1998, 701.

1. In accordance with Rule 3(4) of the Implementing Regulation, applicants applying for registration of three-dimensional marks must make a corresponding indication in the application. The application form prepared by the Office provides a box that is to be checked in these cases. In addition a representation of the mark must be supplied. The representation in photographic or graphic form may contain up to six different perspectives of the mark.

When the application does not contain a corresponding indication and when it is not clear from the circumstances that registration of a three-dimensional mark is requested, the Office will treat the application as a request for a two-dimensional “figurative mark”. ...

2. Three-dimensional marks may, in addition to the three-dimensional shape itself, also contain verbal or figurative elements applied to that shape.

3. An application requesting registration of a three-dimensional mark may also claim colour at the same time, by making a corresponding indication to that effect, as is provided for in Rule 3(5) of the Implementing Regulation. In these cases, the colours making up the mark must be indicated. The representation must also be in colour.

4. Pursuant to Rule 3(3) of the Implementing Regulation, the applicant, when requesting registration of a three-dimensional mark, may also provide a description of the mark. Such a description is not mandatory but may be useful because it may permit the Office to determine the nature of the mark. The Office will object to a description only if it obviously is at variance with the representation of the mark.

5. In examining three-dimensional marks for absolute grounds of refusal, primarily the provisions of Article 7(1)(b), (c), (d) and (e) of the Community Trade Mark Regulation are involved. Under these provisions, a mark may only be refused if it consists exclusively of one of the elements referred to in these provisions and the ground of refusal exists in relation to the goods or services for which registration is requested.

Accordingly, the Office will reject, on one or several of the grounds referred to above, three-dimensional marks consisting exclusively of standard or ordinary containers (bottles, boxes, etc.) or the standard or usual shape of the goods for which registration is sought. Where the three-

dimensional mark contains other elements (verbal or figurative elements or colour) and when these other elements alone or in combination with the three-dimensional shape are sufficient to render the mark registrable, the Office will not refuse registration.

As in cases of word marks and figurative marks consisting of several elements, some or all of which by themselves would not be registrable, the Office, when accepting such combination three-dimensional marks, will not point out to the applicant, or to the public when publishing the mark, the basis for accepting the application.

Consequently, when such combination three-dimensional marks are published or registered, this cannot be taken as an indication that the Office would have accepted the three-dimensional shape itself as registrable.

20. It can be seen that the Office allows unregistrable shapes to be registered pursuant to applications for registration filed under Rule 3(4) of the Implementing Regulation if a word or device that would be independently registrable for goods of that shape is visibly applied to the embodiment of the unregistrable shape graphically represented in the application for registration. This is likened in Communication No.2/98 to the practice of accepting '*word marks and figurative marks consisting of several elements, some or all of which by themselves would not be registrable*'. The assumption appears to be that a distinctively marked shape can and should in every case be taken to constitute a single composite mark for goods of that shape. However, the reality is that there may in any given case be no composite mark, only a graphic representation of goods bearing the distinctive marking without which there would be nothing capable of distinguishing goods of that or any similar shape from those of another commercial origin.

21. I am not confident that this practice is compatible with the standard for examination required by the scheme of the applicable legislation. As to that, the ECJ has emphasised with reference to the provisions of the Trade Marks Directive corresponding

to Articles 4, 7 and 12 CTMR²² that the examination of an application for registration must be *'stringent and full'* in order to prevent trade marks from being improperly registered and that it is not appropriate to adopt a practice of *'withdrawing the assessment of the grounds of refusal ... from the competent authority at the time when the mark is registered, in order to transfer it to the courts with responsibility for ensuring that the rights conferred by the trade mark can actually be exercised'*.²³

22. This, to my mind, indicates that the need for a disclaimer under Article 38(2) CTMR should be recognised and accepted when performing the required assessment in relation to an application filed under Rule 3(4) of the Implementing Regulation for registration of an unregistrable shape with additional elements. Article 38(2) states:

Where the trade mark contains an element which is not distinctive, and where the inclusion of said element in the trade mark could give rise to doubts as to the scope of protection of the trade mark, the Office may request, as a condition for registration of said trade mark, that the applicant state that he disclaims any exclusive right to such element. Any disclaimer shall be published together with the application or the registration of the Community trade mark, as the case may be.

The disclaimer would serve to ensure that the rights conferred by registration were taken to reside in the combination of elements and not in the shape alone, thus aligning the scope of protection with the logic of the decision to allow registration upon the basis that the *'other elements alone or in combination with the three-dimensional shape are sufficient to render the mark registrable'*. The power to require a disclaimer under Article 38(2) is exercisable by the Office and not, so far as I can see, by the Community Trade

²² i.e. Articles 2, 3 and 6 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks.

²³ Case C-104/01 Libertel Groep BV v. Benelux-Merkenbureau [2003] ECR I-3793 at paras. 57 to 59; see also Case C-363/99 Koninklijke KPN Nederland NV v. Benelux-Merkenbureau [2004] ECR I-1619 at paras. 123 to 126.

Mark Courts designated under Article 91 CTMR. That reinforces me in the view that the aims and objectives of Article 38(2) should be achieved via the '*stringent and full*' examination for registrability which the Office is required to undertake.

23. Whirlpool Properties Inc took advantage of the opportunity to apply for registration under the procedure prescribed by Communication No.2/98. The relevant application was filed on 14 March 2003. The three-dimensional mark shown in paragraph 8 above was put forward for registration in respect of '*electric beating and mixing machines and attachments for such machines*' in Class 7. Although the word KitchenAid appeared in small lettering in the graphic representation filed by the applicant under Rule 3(4) of the Implementing Regulation, the examiner did not see it in the scanned version captured for inclusion in the register. It might have been thought that the illegibility of the word KitchenAid in the scanned image would prevent implementation of the abbreviated examination procedure. Not so. The applicant's professional representatives wrote to the examiner invoking the procedure in the following terms:

Further to your telephone conversation with Ramón Cañizares of our Alicante office, we wish to stress that the subject trademark application includes the term **KitchenAid** as a word element, the presence of which you were unable to see.

From the paper copy of the application that you have on file, you will be able to verify that the mark sought does indeed include the word **KitchenAid**.

Please keep in mind that this word element is particularly important given that it constitutes the subject of several Community trademark registrations, including Nos. 000095778 and 001159276.

We therefore assume that this indication should allow the examination for absolute grounds to take place on an expedited basis and the application to proceed immediately.

The examiner evidently agreed that the word KitchenAid did not need to be clearly legible in the scanned image that was supposed to define the identity of the mark as registered. She appreciated that the word element had been omitted from the official record of the application because *'due to the size of the word in relation to the rest of the mark, the word became illegible when it was scanned into our electronic system'*. Even so, she proposed only that a verbal description be added under Rule 3(3) of the Implementing Regulation. Her suggested wording was:

The mark consists of an electric beating and mixing machine on which the word KitchenAid appears.

The applicant then inserted additional wording into the suggested description so as to make it read as follows:

The mark consists of a ***fanciful*** electric beating and mixing machine ***configuration*** upon which the word KitchenAid appears (my emphasis).

The examiner accepted the applicant's wording and it became part of the registration of Community trade mark number 2,174,761.

24. The end result was a Community trade mark registration featuring a three-dimensional shape described in the register as possessing a fanciful configuration, even though it had previously been judged unregistrable by the Office under Article 7(1)(b) and despite the fact that no claim to distinctiveness acquired through use had been made or substantiated under Article 7(3). The word element which rendered the mark eligible for registration was neither conspicuous nor legible in the registered representation, even though it formed part of the mark as registered. It is tempting to think that in these

circumstances the registration should be taken to have given the proprietor no right to prevent others from using the graphically represented shape per se. Tempting, but not correct. There is no claim for invalidity. There is, in particular, no claim alleging invalidity for lack of an acceptable graphic representation under Articles 4 and 7(1)(a) CTMR. The registration must be presumed valid under Article 95. In the absence of a disclaimer, the question whether the rights of the proprietor are infringed by the use of another sign must be answered with reference to the registered trade mark as a whole, taking account of the likely perceptions and recollections of the relevant public at the time when the other sign began to be used.²⁴

25. In principle, it remains necessary to consider whether the rights conferred by registration of the Community trade mark reproduced in paragraph 8 above subsist in relation to a mark comprising a shape which:

- (1) functions as a trade mark for mixers embodying that shape, even without assistance from the word element **KitchenAid**; or
- (2) only functions as a trade mark for mixers embodying that shape with assistance from the word element **KitchenAid**²⁵; or
- (3) does not function as a trade mark for mixers embodying that shape, even with assistance from the word element **KitchenAid**.

In making that assessment, it is appropriate to take account of the guidance I have referred to in paragraphs 11 to 14 and 16 to 18 above. The fact that the bodywork of the

²⁴ Case C-145/05 Levi Strauss & Co v. Casucci SpA [2006] ECR I-00000, see paras. 16, 17, 20, 24, 25, 29, 30, 33 and 34.

²⁵ in the words of Jacob J. in Philips Electronics BV v. Remington Consumer Products [1998] RPC 283 at pp. 296 and 312, a 'limping trade mark'.

KitchenAid Artisan has been registered as a three-dimensional trade mark at the national level in other Member States²⁶ underlines the need for such assessment in the present proceedings. The question whether and, if so, how far it can be maintained that the bodywork of the graphically represented shape performs an independent distinctive role²⁷ in the context of the registered trade mark as a whole is a question of fact. There is nothing, in point of law, to prevent a finding that there are two marks (one verbal, the other non-verbal) in the same field of view where that accords with the reality of the case.²⁸ The willingness and ability of the relevant public to rely on the shape in question as a means of source identification may, of course, increase or decrease across the Community or in different parts of it as trading activities expand or contract and competing products come and go.

26. The following compilation of images²⁹ shows various stand mixers available for purchase in the EU in 2007:

²⁶ Bundle E1/Tab. 1 at pp.240 to 248 and Bundle C3 Tab 42.

²⁷ Case C-120/04 Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH [2005] ECR I-8551 paras. 30 to 36.

²⁸ Case C-488/06P L&D SA v. OHIM [2008] ECR I-00000, paras 31, 55 and 84; Case I ZR 37/04 Golden Rabbit Trade Mark [2007] ETMR 30, p.465 (BGH); Julius Sämann Ltd v. Tetrosyl Ltd [2006] EWHC 529 (Ch) (Kitchin J.); BP Amoco Plc v. John Kelly Ltd [2002] FSR 5, p.87 (CA. NI); Reckitt & Colman Products Ltd v. Borden Inc. [1990] RPC 341 (HL); Levi Strauss & Co. v. Shah [1985] RPC 371 (Whitford J.).

²⁹ Exhibit IR5, Bundle D2/Tab. 5 as shown in para. 117 of the Expert Report of Trudy Watson, Bundle B(1)/Tab. 3.



Kenwood KM336



Kenwood KMC560



Kenwood kMix



Kenwood Prospero



Breville SHM2



John Lewis FP250



Morphy Richards 48955



Russell Hobbs Professional Stand Mixer



Kenwood Patissier



KitchenAid Artisan



Clatronic KM 3118



Krups Prep Expert



Bosch Mm 82R1



Bonammi B332



Breville KM 1



Wahl ZX 409



Argos Hand and Stand Mixer

The only organisations which have a significant share of the market in the United Kingdom are Kenwood and Whirlpool.³⁰ Even so, I think it is appropriate to keep these mixer shapes in mind when considering issues of distinctiveness and similarity, both in relation to the bodywork of the unitary mixer head and stand recorded in the Community-wide trade mark registration and in relation to the finished appearance of the Artisan mixer.

27. KitchenAid mixers of substantially the same shape and appearance as the Artisan have been sold and supplied in the United States for upwards of seventy years. The ‘New Model K’ was introduced by the KitchenAid Division of The Hobart Manufacturing Co of Ohio in 1937. In an advertisement from the time³¹ it was presented as the **Sensational New KitchenAid. The Food Mixer that ‘Does It All’...at an Exciting Price. The New Model ‘K’...beautiful modern lines – gleaming white Dulux trimmed in chromium’**. At that time, the mixer had a chrome carrying handle in the form of a rail running from a front end fixing to a back end fixing lengthwise of the mixer head. The product was designed by Egmont Arens, a renowned industrial designer. The appearance of it was protected by US Design Patent No. 116,747 filed on 6 November 1937³². There were minor changes to the design in the 1950’s. The product became available in different colours from about 1955 onwards. Hobart sold its KitchenAid business to Dart and Kraft Corporation in 1980. Whirlpool acquired the business from Dart and Kraft Corporation in 1985. The ‘New Model K’ has been known by a number of different names over the years. It has been called the Artisan since about 2004. It is one of a number of products in the Artisan range of KitchenAid appliances marketed by Whirlpool.

³⁰ Transcript Day 4, pp. 557, 558.

³¹ Exhibit BM4, Bundle C3/Tab 37.

³² Exhibit BM6, Bundle C3/Tab 39.

28. I think it is right to infer that there were sales of the Model K through the United Kingdom branch of the Hobart company³³, which appears to have been established by as early as 1910. Mr. Vermeiren, the Managing Director of KitchenAid Europa Inc., recollected seeing records of sales in the United Kingdom going back to 1989. However, Whirlpool is not now in a position to bring forward hard evidence of sales prior to 1994. In 1994, approximately 16,000 units of what is now called the Artisan mixer were sold in the European market. The figure for 2007 was about 99,000 units. The figures for sales and sales revenues covering the period 1994 to 1998³⁴ in 15 EU countries confirm that Germany, France and the United Kingdom were the principal markets for the mixer, followed by Italy, the Netherlands, Austria and Belgium. In recent years the gross revenues from sales of the mixer in the European market have been €33 million (2004), €39 million (2005) and €41 million (2006) with approximately €6 million, €7 million and €8 million being derived from sales in the United Kingdom in each of those years respectively. Over the same period, advertising and marketing spend for the KitchenAid brand in the EU has been at the levels of €1 million (2004), €2 million (2005) and €2 million plus (2006) with about 95% of that expenditure relating to advertising and marketing of the KitchenAid Artisan mixer. I understand it to be accepted on a rough and ready basis that the relative positions of Kenwood and Whirlpool in the stand mixer market from 2004 to 2006 were as follows:

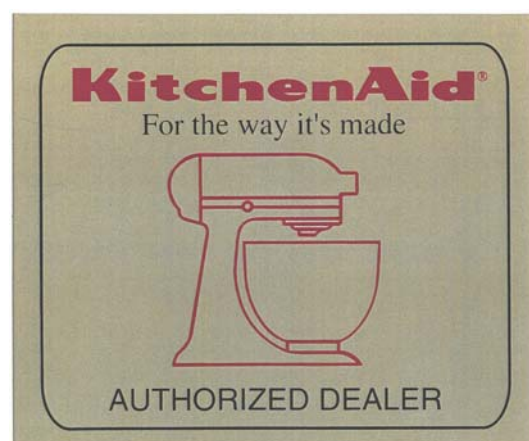
	Kenwood		KitchenAid	
	Value %	Units %	Value %	Units %
2004	68	70	31	29
2005	64	70	34	25
2006	61	75	38	25

³³ The company brought proceedings for infringement of its UK registered trade mark **KitchenAid** against a defendant using **Kitchen Aid** for 'mixing machines and the like' in 1959: Hobart Manufacturing Coy v. Cannon Industries Ltd [1959] RPC 269.

³⁴ Bundle E1/Tab 1 (Exhibit A, Exhibit B).

29. The Artisan mixer has been promoted through in-store, point of sale, online and public relations promotions rather than by way of paid for press and television advertising. The product has also benefitted from large amounts of editorial coverage in publications that are likely to have been read by consumers of the kind who would be interested in knowing about it. I am satisfied that Whirlpool's promotional efforts resulted in good levels of public awareness among such consumers in the United Kingdom (and, I would accept, in France and Germany). Photographic images displaying the finished appearance of the Artisan are ubiquitous in the editorial and other printed materials I have seen.

30. Over the past 10 years or so Whirlpool has used emblematic representations of the shape of the Artisan mixer on consumer facing items such as stickers, stamps, badges, envelopes, folders, brochures, packaging and bags³⁵. These are examples of the kind of representations that have been used:



31. The KitchenAid Artisan mixer has received public exposure as an appliance seen in cooking programmes broadcast on mainstream television channels in the United Kingdom. In each episode of a series on Christmas cooking broadcast on BBC2 in

³⁵ Exhibits DV13 to DV15 and DV35 to DV43.

December 2006 and repeated on BBC4 in December 2007 it was seen to be celebrity chef Nigella Lawson's mixer of choice. Examples of the mixer have also been put on public display in recognition of the status of its design. It has been displayed in the Pompidou Centre in Paris and at the Science Museum in London. There is one in the kitchen display at the Smithsonian Institution in Washington. There is another exhibited in The Henry Ford Museum in Dearborn, Michigan as an example of great industrial design. In 1997 there was an exhibition at the San Francisco Museum of Modern Art devoted to 12 central icons and themes, one of which was 'KitchenAid Mixer: Gadgets Galore'. The mixer was also written up as '*one of the classic design icons of the early 20th century*' in the 2005 and 2007 editions of the panel monitored handbook 'CoolBrands. An insight into some of Britain's coolest brands'.³⁶

32. I gather that Whirlpool has had feedback from market research identifying the aspects of the appearance of the Artisan that impinge on the recollections of consumers.³⁷ However, I have not seen any documentary records of the information obtained. From the research work I have seen³⁸ it is evident that a liking for the design of the mixer is a major factor in the appeal of the product. In the overview of perceptions found in research carried out for Kenwood in England and France in 2004 it is noted that '*Kitchen Aid consumers love the design of their machine. They view it as a statement of them and their stylish, discerning lifestyle. A piece of equipment to show off*'.³⁹

33. Several public surveys were undertaken by Whirlpool for the purposes of the present proceedings. They addressed the issue of distinctiveness as an aspect of perception linked to the issue of similarity. Interviewees were shown one or other of four

³⁶ Exhibits BM15 and BM16, Bundle C3/Tabs 48, 49.

³⁷ Transcript Day 2 p.215

³⁸ Exhibit BM14, Bundle C3/Tab 47; Exhibit TAW 14, Bundle B3/Tab 14.

³⁹ Bundle B3/Tab 14 p.209.

flashcards (each of which carried a photograph of a kMix mixer) and asked to respond to the questions set out in an associated questionnaire. Responses which imported a reference to KitchenAid mixers were reviewed for significance in terms of their tendency to indicate that the shape and appearance of the kMix so closely resembled the shape and appearance of the Artisan mixer as to make them not only similar, but distinctively similar products from the consumer's point of view. It was envisaged that questions referring to the kMix product shown in the flashcard photograph would yield answers referring to the KitchenAid product from which inferences could be drawn both as to the existence of distinctiveness (in the trade mark sense of the word) and as to the existence of overclose resemblance between the two products. Interviewees whose responses appeared to be supportive of Whirlpool's case were identified as persons who might be worth inviting to participate, if they were willing, in a more comprehensive interview. Then, as a result of further selection, some of them were asked to provide witness statements for use at trial.

34. Without at this point differentiating between the public surveys, I note that 660 questionnaires were obtained, with 164 of them recording the responses of interviewees who provided sufficient contact details to enable them to be contacted again. Witness statements for use at trial were obtained from 23 of these interviewees. Others of the 164 were contacted. Their comments and observations were not disclosed in any witness statements or other documents put forward for consideration at trial. The screening of interviewees was carried out by Whirlpool's legal advisers. Litigation privilege was claimed for that aspect of their work on the preparation of the claimants' case. The process as a whole was referred to as a 'witness gathering exercise'. Factual information as to the conduct of the exercise and the results obtained was provided by way of witness

statements and disclosure. No attempt was made to attach statistical significance either to the results of the exercise as a whole or to the evidence of the 23 interviewees who provided witness statements. The questionnaires containing the responses of those interviewees were exhibited to their witness statements. Other questionnaires were included in the trial bundles at the instigation of the parties or at my request. However, the great majority of the 660 questionnaires were not in evidence at the trial.

35. The need for circumspection in the assessment of questionnaire survey evidence is well-understood. The concern is that to a greater or lesser degree: *“Interviews and questionnaires intrude as a foreign element into the social setting they would describe, they create as well as measure attitudes, they elicit atypical roles and responses, they are limited to those who are accessible and will co-operate and the responses obtained are produced in part by dimensions of individual differences irrelevant to the topic at hand”*.⁴⁰ There is, accordingly, a practical requirement for information relating to the structure, method and results of questionnaire surveys to be full enough to enable the strengths and weaknesses of the research work to be evaluated.⁴¹ It is now the practice for the utility of any proposed survey work to be considered as a matter of case management during the interim stages of actions for infringement of registered trade mark and passing off.⁴²

36. If the research work provides no sufficient or proper basis for extrapolation, the responses of individual interviewees can really only be taken into account for what they

⁴⁰ Webb, Campbell, Schwartz and Sechrest *Unobtrusive Measures* (Revised edn, Sage Publications Inc, 2000).

⁴¹ *Imperial Group Plc v. Philip Morris Ltd* [1984] R.P.C. 293 at 302, 303 (Whitford J.).

⁴² *esure Insurance Ltd v. Direct Line Insurance Plc* [2008] EWCA Civ 842 (Arden, Jacob and Maurice Kay L.JJ) at paras. 63, 78 and 79.

may individually be thought to be worth. That may be little or nothing. This has been forcefully pointed out by the Full Court of the Federal Court of Australia⁴³:

One theoretical possibility, in a case like the present, would be for a party to call such of the 1200 respondents to the Roy Morgan survey as were contactable. This course would have the advantage of providing a fairly selected group of witnesses, subject to any distortion which might be caused by difficulties in locating respondents. But it would add enormously to the cost and duration of a trial.

The second possibility would be for a party to call evidence from a lesser number of selected witnesses. This course was taken in Ritz. The plaintiff there called 152 members of the public. The majority of these witnesses were stopped in a public place by a representative of the plaintiff and questioned as to the significance to them of the word 'Ritz'. It seems that those who gave answers favourable to the plaintiff's case were asked to give evidence. Those who did not, were not. As a result, the evidence of these persons was of negligible value. All that it established was that, with the expenditure of sufficient effort and money, 152 people could be found somewhere in Australia who claimed to associate the word 'Ritz' with the plaintiff. The 152 witnesses were not a fair sample of the general public; so that, as McLelland J noted (NSWLR at 215) there was 'no ground in the evidence for any extrapolation on a statistical basis, or on the basis of any mathematical or logical probability, of the views of the "public" witnesses (or any selection from them) as representing the views of the relevant class of the Australian public or a significant section of that class'. The plaintiff was not even willing to reveal the total number of persons interviewed; for all the judge knew, the persons who associated the word 'Ritz' with the plaintiff may have been a tiny minority. The tender of such partisanly selected evidence was an absurdity.

37. It is unrealistic to suppose that the evidence of survey respondents can be divorced from the context of the survey to which they were subjected simply by classifying the

⁴³ Arnotts Ltd v. Trade Practices Commission (1990) 97 ALR 555 at 606.

survey as ‘a witness collection exercise’. Thus the Court of Appeal observed in Scott Ltd v. Nice-Pak Products Ltd⁴⁴:

Nor, it seems to me in view of the incorrect premises upon which the poll was conducted as I have indicated, can one safely place any reliance upon the affidavits subsequently obtained by the plaintiff from the respondents. They are respondents who were subjected to an unsatisfactory poll and asked questions at the poll upon false premises and those are matters which plainly affected their minds by the time they came to swear their affidavits. In the circumstances, I would not myself be prepared to rely upon those affidavits at all. The result in my view is that the plaintiff has produced no evidence in this court of confusion or misrepresentation.

The evidence given by survey respondents should normally be evaluated in the context of the ‘witness collection exercise’ (including the questionnaire survey) as a whole. That is, indeed, the reason why the agreed directions for the conduct of the present proceedings provided for full disclosure of information in that connection.⁴⁵

38. These are the flashcards that were used for the purposes of the surveys:

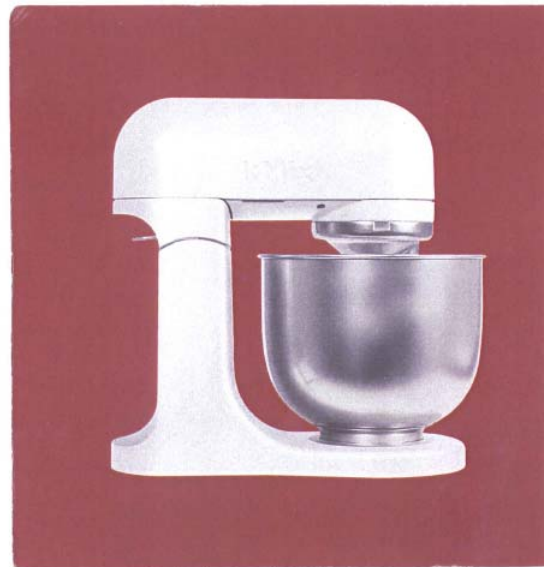
⁴⁴ [1989] FSR 100 at 109 per Fox LJ.

⁴⁵ Order of Lightman J. dated 13 November 2007, paras. 12 et seq.; Bundle A/Tab. 15.

FLASH CARD 1



FLASH CARD 2



FLASH CARD 3



FLASH CARD 4



The cards were quite small, in each case no larger than 9.5 centimetres x 9.5 centimetres. In Flashcard 1 the kMix is shown with the trade mark KENWOOD visible beneath the dial. In Flashcards 2 and 3 it is shown from the opposite side, on which there is no KENWOOD trade mark. In Flashcard 4, the trade mark KENWOOD can just about be seen beneath the dial. Flashcard 4 was shown to 13 of the 23 interviewees who provided

witness statements. Of the remaining 10 who provided witness statements, 4 were shown Flashcard 2 and 6 were shown Flashcard 3.

39. The questionnaires used in conjunction with Flashcards 2 and 3 contained the following questions and instructions:

Q1. Please look at this card.

[GIVE THE CARD TO THE INTERVIEWEE AND ALLOW THEM TO LOOK AT THE CARD FOR AS LONG AS THEY WISH. MAKE SURE THEY HOLD THE CARD THROUGHOUT THE INTERVIEW]

What can you tell me about this product?

[POINT TO THE MIXER ON THE CARD]

[IF THEY HAVE NO RESPONSE AT ALL OR DO NOT UNDERSTAND THE QUESTION, THEN GO TO QUESTION 1(A), OTHERWISE GO TO QUESTION 2]

Q1(a). What do you think of it?

Q2. Anything else?

[IF THEY MENTION OUR CLIENT IN ANY WAY, THEN GO TO QUESTION 3, OTHERWISE GO TO QUESTION 4]

Q3. Why do you say that?

Q4. Would you mind if I made a note of your occupation and age band?

The answers elicited by these questions were likely to be inconclusive for a number of reasons. Interviewees were invited to talk '*about this product*' from a perspective of their own choosing. References to shape and appearance from a trade mark point of view would be random occurrences. There was a risk that the first question would be taken to imply that '*this product*' was one which the interviewee was able from experience to '*tell*

me about', thus nudging interviewees into thinking and speaking of it as a product that was known rather than unknown to them. Interviewees were not asked to indicate whether they were to any degree familiar with either the shape and appearance of the kMix or the shape and appearance of the Artisan. No relevant trends or patterns could be identified in the answers provided by the different respondents without that information.

40. A total of 623 interviewees were questioned on various dates between 4 October and 18 November 2007 in the course of the survey work conducted by reference to Flashcards 2 and 3.⁴⁶ The bulk of the survey work was carried out at the BBC Good Food Show in London between 16 November and 18 November. A request for volunteers willing to be interviewed was circulated at Leiths School of Food and Wine. That led to 4 students being interviewed on 16 October. The rest of the survey work was carried out at different locations in London⁴⁷. At the end of it all, Whirlpool tendered witness statements from 10 of the 623 interviewees who had been shown one or other of the two flashcards. These witness statements were in each case provided following a second stage interview at the London offices of Whirlpool's solicitors.

41. Selected interviewees were invited to attend in return for a payment intended to cover their time and travel expenses. They were shown copies of their questionnaires and asked to expand on the answers they had given. Having done so, they were guided through a product perception study. There were, in most cases, three boxes covered in plain brown paper on the tables in the main interview room. One of the boxes was removed from the table to reveal a debranded KitchenAid Artisan mixer in red. The

⁴⁶ Exhibit NDW1, Bundle C5/Tab. 1.

⁴⁷ at Leon Jaeggi & Sons in Shaftesbury Avenue, London W1; outside Pages Cookware in Shaftesbury Avenue, London WC2; inside La Cuisinière Cookware and Tableware in London SW11; outside Peter Jones in Sloane Square, London SW1; at the Theo Randall restaurant in the Intercontinental Hotel on Park Lane, London W1; at Regents Park Road, London NW1; at Chalk Farm Road, London NW3; outside Whole Foods Market, London W8.

branding on the metal strip around the head of the mixer and the branding on the nose of the attachment hub were covered by silver masking tape. The bowl was removed and the mixer shaft was left untooled. The Artisan thus presented for inspection was a debranded embodiment in full colour of the branded mixer represented figuratively in the Community trade mark registration. The interviewees were invited to walk around the mixer and inspect it in whatever way they wished. As that was happening, they were asked a number of predetermined questions. So far as I am aware, the template for the questions has not been disclosed⁴⁸. On completion of that part of the interview, a second box was removed from the table to reveal two kMix mixers, one in red the other in white. The process of inspection and questioning continued as before. Then the third box was removed from the table to reveal two KitchenAid Artisan mixers, one in red the other in white, with all branding and fittings visible in the usual way. The process of inspection and questioning ran its full course. The interviewees' comments and observations were noted on a laptop computer as the interview proceeded. The laptop record was displayed for the interviewees to check and comment upon before they left. It was then used to prepare their witness statements for trial. In quite a few instances it took more than a month for the witness statements to be finalised and signed. So far as I am aware, the laptop records of the interviews have not been disclosed.

42. Two of the 4 interviewees who were shown Flashcard 2 provided witness statements⁴⁹ that were taken as read for what they might be thought to be worth in the context of the evidence as a whole. The other two were cross-examined on their

⁴⁸ The questions can, perhaps, be deduced from the witness statements of Philip Humbert at C6/Tab. 1 and Tracy Wilson at C6/Tab 3.

⁴⁹ Ruth Pitcher WS C6/Tabs 7 and 8; Helga Olafsson WS C6A/Tabs 39 and 40.

statements.⁵⁰ Mrs Mansey is a chef. She owns a KitchenAid mixer. In her oral evidence she confirmed that she realised when the flashcard was first shown to her at the BBC Good Food Show that the mixer it depicted was not a KitchenAid mixer and also realised when she was subsequently shown the kMix mixers at the solicitors' offices that they were Kenwood not KitchenAid mixers. She had been conscious of the differences between them, although she saw them as mixers of a generally similar shape. The debranded KitchenAid mixer was, as a result of her familiarity with it through use, instantly recognisable to her by its shape. She thought that if she had seen the kMix on sale in a shopping environment, the shape of it would have aroused her curiosity and made her want to find out what brand it was.

43. Miss Hughes is a student at Leiths School of Food and Wine. At the solicitors' offices in London she had been shown a copy of the graphic representation reproduced in paragraph 8 above. Her witness statement recorded that she had noticed the word KitchenAid in small lettering on one of the line drawings. In her oral evidence she said (and I think correctly said) that she had not noticed the word KitchenAid on the graphically represented appliance. It also emerged that the designation KitchenAid was, as she understood it, used at Leiths School and in catering in general as a generic term for stand mixers. In re-examination she confirmed that the Patisier (shown in paragraph 26 above) was a stand mixer of the kind she would refer to generically as a 'KitchenAid'. She realised when the flashcard was first shown to her that it depicted a mixer of a different design from the 'KitchenAids' used at Leiths and I understood her to confirm that although she thought there were similarities in terms of shape, she had realised when

⁵⁰ Bethany Hughes WS C6A/Tabs 41 and 42, Transcript Day 4 pp. 583 et seq; Anny Mansey WS C6A/Tabs 45 and 46, Transcript Day 1 pp. 62 et seq.

she was subsequently shown the kMix mixers at the solicitors' offices that they were, from a brand point of view, Kenwood not KitchenAid mixers.

44. Five of the 6 interviewees who were shown Flashcard 3 provided witness statements⁵¹ that were taken as read on the basis I have indicated above. The sixth interviewee was cross-examined on her statement.⁵² Ms. Bauer is an assistant merchandiser in the fashion industry. She owns a KitchenAid mixer. In her oral evidence it emerged that she was with her mother when she responded to the questionnaire at the BBC Good Food Show and that the questionnaire recorded, in part, what her mother had said on that occasion. She confirmed that she knew when the flashcard was first shown to her that the mixer it depicted was not a KitchenAid mixer because it had a very different shape. When she was subsequently shown the kMix mixers at the solicitors' offices, she realised they were Kenwood not KitchenAid mixers. On that occasion she was concentrating on the shape of the products that were shown to her. She thought she was engaged in the assessment of a prototype for a new model from a design point of view and was not thinking about things from a brand point of view. Because she had a KitchenAid mixer at home, she recognised the debranded Artisan by its appearance as soon as it was shown to her.

45. The questionnaires used in conjunction with Flashcard 4 contained the following questions and instructions:

Q1. Please look at this card.

[GIVE THE CARD TO THE INTERVIEWEE AND
ALLOW THEM TO LOOK AT THE CARD FOR AS

⁵¹ Philip Humbert WS C6/Tabs 1 and 2; Jane Grey WS C6/Tabs 5 and 6; Patricia Morrison WS C6/Tabs 19 and 20; Roger Adams WS C6A/Tabs 33 and 34; Emma Cave WS C6A/Tabs 49 and 50.

⁵² Mirja Bauer WS C6/Tabs 13 and 14, Transcript Day 1 pp. 94 et seq.

LONG AS THEY WISH. MAKE SURE THEY HOLD THE CARD THROUGHOUT THE INTERVIEW]

What can you tell me about this product?

[POINT TO THE MIXER ON THE CARD]

[IF THEY HAVE NO RESPONSE AT ALL OR DO NOT UNDERSTAND THE QUESTION, THEN GO TO QUESTION 1(A), OTHERWISE GO TO QUESTION 2]

Q1(a). What do you think of it?

Q2. Anything else?

[IF THEY MENTION OUR CLIENT IN ANY WAY, THEN GO TO QUESTION 3, OTHERWISE GO TO QUESTION 4]

Q3. Why do you say that?

Q4. Does the shape tell you anything about the product?

Q5. Would you mind if I made a note of your occupation and age band?

Question 4 added significantly to the questions that had been asked in the course of the survey work carried out with Flashcards 2 and 3.

46. This questionnaire was used at the second stage of a three stage process. Consumers previously identified as having purchased KitchenAid mixers and consumers previously identified as interested in purchasing kitchen stand mixers were initially contacted by telephone. I shall refer to the interviewees in the first category as 'KitchenAid users' and those in the second category as 'prospective purchasers'. The interviewees in both groups were asked various questions intended to weed out those who either did not own a KitchenAid mixer or had no intention of buying a mixer for £300 or

more.⁵³ Some of them will have realised that they had been targeted because they had sent off for the free cookery book that went with the KitchenAid mixer they had recently purchased. The KitchenAid users that the interviewers particularly wanted to identify were regular users who knew their mixers well.⁵⁴ Although the interviews were scripted in the sense that the telephone interviewers were expected to work their way through a list of predetermined questions,⁵⁵ that does not appear to have happened in all cases.

47. Selected interviewees were invited to attend a 'marketing research interview' in London. They were offered a payment intended to cover their time and travel expenses. A total of 26 interviewees were selected for interview at the offices of Whirlpool's solicitors on 21 and 22 November 2007. At the outset, they were shown Flashcard 4 and asked the questions set out in paragraph 45 above. Their completed questionnaires were then taken through to another room for assessment by one or more of the legal team acting for Whirlpool. That resulted in 13 of the 26 interviewees being selected for participation in the third stage of the process and elimination of the remainder from further consideration.

48. The third stage of the process was a product perception study which followed the path I have summarised in paragraph 41 above.

49. At this point I think it is necessary to focus on the degree of screening involved in the three stage process. Of the 26 interviewees selected at stage one, 14 were KitchenAid users and 12 were prospective purchasers. The assessment at stage two resulted in 4 of the KitchenAid users and 9 of the prospective purchasers being eliminated from the process. The 13 witness statements resulting from stage three were therefore provided by

⁵³ Transcript Day 2 p.262.

⁵⁴ Transcript Day 2 pp.265 to 267.

⁵⁵ Exhibit PW1, Bundle C5/Tab 9.

KitchenAid users (10 witness statements) rather than prospective purchasers (3 witness statements).

50. At the end of stage two, the responses obtained by means of the questionnaire used in conjunction with Flashcard 4 were as noted in the following tables, with Table A covering the responses of the 4 KitchenAid users and the 9 prospective purchasers who were eliminated from the process on assessment of the answers they had given and Table B covering the responses of the 10 KitchenAid users and the 3 prospective purchasers who were selected for the third stage of interviewing.

TABLE A

Interviewee	Questions 1 and 1(a)	Questions 2 and 3	Question 4
<u>Judith Bentley</u> Age band 56-65. Interviewed on 21 November 2007. Kitchen Aid owner. No WS.	It's a Kenwood. I know it's not a Kitchen Aid. I haven't seen any two-tone Kenwoods. I wouldn't buy anything with a coloured top. It has to match your kitchen.		It's fairly sleek and modern. Can't tell much else, about the speeds for example.
<u>Janine Blair</u> Age band 46-55. Interviewed on 21 November 2007. Not Kitchen Aid owner. No WS.	It's a food mixer. Holds big capacity. Like that it's stainless steel. Like the red and stainless steel. I like that it has one little dial. Doesn't look overly bulky like some of them. If that is a handle (points to handle) that is useful.		Neat and tidy and compact. Like the colouring.
<u>Sue Dundas</u> Age band 56-65. Interviewed on 21	Food processor. Looks quite hi-tech and industrial. Looks quite robust. I like the	I wonder if it comes in any other colours. Black or chrome.	It looks like it could be used for large quantities. Not a liquidiser as I can't

Interviewee	Questions 1 and 1(a)	Questions 2 and 3	Question 4
November 2007. Not Kitchen Aid owner. No WS.	look of it. Like the shape and design of the bowl. Looks easy to use. It's a stylish and simple design. Therefore uncomplicated to use and [...].		see the top. Looks like a sturdier version of what I use already. I haven't seen this anywhere before. I have a Robo Chef and a hand blender. I would use this for bread making and dough [...].
<u>Maxine Gordon</u> Age band 35-45. Interviewed on 21 November 2007. Not Kitchen Aid owner. No WS.	It's obviously a food mixer. Can't tell who it is by. I like the colour. Nice big bowl. Multi-purpose. Good for baking.	Not really. Looks like it's got a few speeds. Easy to wash.	The shape tells me it's a well designed and compact product. Looks like it can do a lot which makes it appealing. Looks like the head hinges back which is good for not disrupting what you are doing.
<u>Julia Hickman</u> Age band 56-65. Interviewed on 21 November 2007. Kitchen Aid owner. No WS.	Looks nice and smart. Personally wouldn't buy it in red but that's very personal.	No, I can (sic) see how it works but looks very smart.	Very pleasing and lovely. Not sure about the very, very shiny bowl.
<u>Nina Leach</u> Age band 36-45. Interviewed on 21 November 2007. Kitchen Aid owner. No WS.	It is a mixer. I was going to say like a Kitchen Aid but it's not. More modern as opposed to a traditional one.	Practically, how would you lift up the top? It's a variation on a theme because the Kitchen Aid is the style of mixer I chose because of how it looked. Do Kenwood have one too? If I was looking at this next to the one I bought (KA) I would still have mine. I don't know what make this product is.	I would say again it's modern and the matt silver is modern. It doesn't work for me due to the colour. Would look nice in a minimal kitchen. Looks about the same size as other food processors.
<u>Alice Parsons</u>	Is it a Kenwood? Looking into	Like the look of it. Saw the 'K' on side	Don't know if it particular to

Interviewee	Questions 1 and 1(a)	Questions 2 and 3	Question 4
Age band [—]. Interviewed on 22 November 2007. Not Kitchen Aid owner. No WS.	Kenwoods. Very reliable. Can't tell whether it looks old or new. Quite retro very 70's.	and could make out the 'Kenwood' on side. Looking at different brands on John Lewis website.	Kenwood. Seen something similar. If it wasn't for the 'K' and the 'Kenwood' she wouldn't know it was another brand.
<u>Nina Patel</u> Age band 26-35. Interviewed on 21 November 2007. Not Kitchen Aid owner. No WS.	Looks nice, obviously a food mixer, nice big bowl. Is it Kenwood? I think it's a Kenwood. Nice if there were other colours.	Don't like matt silver. Stainless steel is harder to clean.	I know it's a food mixer straightaway. Different settings. Probably could mix quite a lot.
<u>Sandra Polimis</u> Age band [—]. Interviewed on 22 November 2007. Not Kitchen Aid owner. No WS.	It looks very much like a Kenwood apart from the colouring. High quality one because of the stainless steel bowl.	Because my Mum has a Kenwood one.	If I was looking for a mixer I would be put off by the rounded top and the red.
<u>Lis Steedon</u> Age band 56-65. Interviewed on 22 November 2007. Kitchen Aid owner. No WS.	Quite funky. Colours are becoming the essence of food processors these days. Like chrome bowl and matt chrome stand. I've got an apple green Kitchen Aid.	Presumably it would be made in other colours and chrome. Is it a Kenwood – yes it is. Because I can see the logo on the side. It is because it is going forward to be a more rounded model which would be the next step – they have to renew themselves to follow the market trend.	Kenwood a reliable machine. Kitchen Aid is more retro and more funky – slightly less bulky.
<u>Julie Thelwell</u> Age band [—]. Interviewed on 22 November 2007. Not Kitchen Aid owner.	Looks like a coffee machine/maker. Like the size of it – nice and compact.	Like the colours. Like style – smooth lines – like shape (ladies shape).	Doesn't tell you outright what it is. Can't see what is inside the big bowl.

Interviewee	Questions 1 and 1(a)	Questions 2 and 3	Question 4
No WS.			
<p><u>Carolyn Tinning</u> Age band [—]. Interviewed on 22 November 2007. Not Kitchen Aid owner. No WS.</p>	<p>It's a food mixer. It is a food blender and/or chopper.</p>	<p>Looks expensive. Might come in other colours.</p>	<p>Not really – has a handle on it.</p>
<p><u>Astrid Weiner</u> Age band [—]. Interviewed on 22 November 2007. Not Kitchen Aid owner. No WS.</p>	<p>Very up to date one – seen these quite recently. Don't use them any more. It was one of the big names. Can't remember what it was. It's fantastic. Used to have a Kenwood or Braun.</p>		<p>Not particularly.</p>

TABLE B

Interviewee	Questions 1 and 1(a)	Questions 2 and 3	Question 4
<p><u>Anne Banks</u> Age band 36-45. Interviewed on 21 November 2007. Kitchen Aid owner. WS C6/Tab 21</p>	<p>I like it. Modern like the shine and the look of it. I want it. I like the colour red. I've got one in yellow. Isn't this ...? This says Kenwood but it looks like a Kitchen Aid. Is it a Kenwood?</p>	<p>There is a K on it so it must be a Kenwood. Dial is not like a Kitchen Aid. The bowl looks like Kitchen Aid and the top looks like a Kitchen Aid. My first impression was definitely it looked like a Kitchen Aid.</p>	<p>My first impression was that it was a Kitchen Aid product, but then I looked closely at the dial. I wouldn't say it looks like a Kenwood.</p>
<p><u>Mary Bell</u></p>	<p>It looks like a Kitchen Aid food</p>	<p>I don't like the two tone colour. It looks</p>	<p>It seems to be a copy of a Kitchen Aid.</p>

Interviewee	Questions 1 and 1(a)	Questions 2 and 3	Question 4
<p>Age band 56-65. Interviewed on 21 November 2007. Kitchen Aid owner. WS C6A/Tab 37.</p>	<p>mixer, but it's different from the one I have. Several differences. The colour, the controls, not as stylish as the one I have.</p>	<p>rather flimsy because of the two tone colour. Well, in particular it has the same sort of design, but there are differences (colour/control).</p>	
<p><u>Laura Dubois</u> Age band [—] Interviewed on 22 November 2007. Not Kitchen Aid owner. WS C6A/Tab 43.</p>	<p>Similar to the one I wanted. Like the retro look and the colour red. Looked at one from Kitchen Aid because it was red and I like all red and design because it is retro.</p>	<p>The fact that is [—] does not bother her – she likes that.</p>	<p>Because it's big it will not move about. Sort of mixer you would find in a professional kitchen.</p>
<p><u>Clare Flatman</u> Age band 46-55. Interviewed on 22 November 2007. Kitchen Aid owner. WS C6/Tab 11.</p>	<p>It's a mixer. See by quality that it's a good quality one. Is it 'Krupps' or maybe 'Kenwood'? Like the colours but not sure about the silver casing.</p>	<p>The one I've got is similar shape. I can tell by round curves. Mine is all enamel – it's more classic design – the one in the picture is more modern. Because I can see 'K' on the mixing bowl and underneath the dial it looks like 'Kenwood'.</p>	<p>By the shape you can tell you can add accessories/attachments.</p>
<p><u>Sara Gronmark</u> Age band 46-55. Interviewed on 21 November 2007. Kitchen Aid owner. WS C6A/Tab 29.</p>	<p>Nice and solid. Big bowl. Like the handle, knob looks easy to use. I assume it has instructions on it. I like the rounded curve but don't like the colour combination.</p>	<p>Looks quite expensive. I'm assuming the K means Kitchen Aid or Kenwood. Kitchen Aid probably. Looks heavy, which is good. I have bought a Kitchen Aid recently and they have very similar bowls. Kenwood is an English make but this looks too sturdy as Kitchen Aid is at</p>	<p>Curves invite you to handle it. I imagine the top hinges back. It would feel good to do that. Bowl would [—] into place. Not many settings.</p>

Interviewee	Questions 1 and 1(a)	Questions 2 and 3	Question 4
		the top end of the market.	
<p><u>Sarah Hershman</u> Age band [—] Interviewed on 22 November 2007. Not Kitchen Aid owner. WS C6/Tab 17.</p>	<p>Retro mixer. Not very attractive. Only got one function.</p>	<p>Quite American looking.</p>	<p>Like a Kenwood mixer for making cakes.</p>
<p><u>Jennifer Johannes</u> Age band [—] Interviewed on 22 November 2007. Kitchen Aid owner. WS C6A/Tab 47.</p>	<p>It's a table top mixer. It's not the one I've got – can't remember the name of the one I've got. It's got a K on it – does that mean it's a Kenwood? I don't know. Difficult to know unless you use it. Nice and bright. Handle on the side which I like.</p>	<p>Looks quite easy to clean. The one I've got has a lever on the side to release it.</p>	<p>Very solid. Good for commercial use.</p>
<p><u>Joanne Langston</u> Age band 36-45. Interviewed on 21 November 2007. Not Kitchen Aid owner. WS C6A/Tab 27.</p>	<p>Looks very stylish and modern. Hopefully will be receiving. Something I will be getting for Christmas. Looks like the same shape as Nigella Lawson uses. That is the one I want. Very posh, nice. Is it Kenwood? It is Kenwood. It is similar to the one I'm after. It's a Kenwood though.</p>	<p>It's nice but not in that colour (red with silver) especially the colour and type.</p>	<p>Not really. Bowl is large which attracted me to the one I've seen. Looks like it would be easy to use as it has one dial on the side. Different speeds.</p>
<p><u>Vicky Leffman</u> Age band [—] Interviewed on 22</p>	<p>It's a mixer. Hybrid between a Kitchen Aid and a Kenwood. Don't like colours.</p>		<p>Not really no.</p>

Interviewee	Questions 1 and 1(a)	Questions 2 and 3	Question 4
November 2007. Kitchen Aid owner. WS C6/Tab 9.	Bowl looks good as it looks quite big.		
<u>Vanessa O'Donnell</u> Age band 26-35. Interviewed on 21 November 2007. Kitchen Aid owner. WS C6A/Tab 31.	It's a Kenwood. It's got a big K on it. Looks like it's trying to be a Kitchen Aid in disguise. Bottom looks plastic (more like a Kenwood). The top looks like a sturdy Kitchen Aid. Bowl looks good. Simple controls. Is the front circle for attachments?	Lifts up presumably. Not overly impressed, but that may not be the point! My immediate reaction was 'Is that a new KitchenAid?' From the look of it it looks like a Kitchen Aid. But now I can see it says Kenwood on the side. Looks like two machines as one.	The shape makes me think that it's more like a classic KitchenAid. Especially the rounded/heavy top. Kenwood's one more square than this traditionally. Looks very top heavy which would suggest it had a good motor on it. Interesting to know how it lifts.
<u>Pamela Stoker</u> Age band 36-45. Interviewed on 21 November 2007. Kitchen Aid owner. WS C6/Tab 15.	It's a food mixer. It's very modern looking. Looks expensive.		It's a similar shape to my Kitchen Aid. It's a hands free mixer. Just the shape of it. It looks the same in the way you would lift the top up to change the bowl. It seems the obvious shape for a mixer.
<u>Victoria Wells</u> Age band 26-35. Interviewed on 21 November 2007. Kitchen Aid owner. WS C6/Tab 23.	Industrial looking. Not as elegant as the other version, compared to the classic KitchenAid model. The Kitchen Aid goes in a lot more kitchens.	Don't like the two tone. Because I own the Kitchen Aid and I like the design. There are others on the market that are cheaper.	Looks very similar to the Kitchen Aid I've got. I like the sturdiness. Looks slightly less sturdy than a Kitchen Aid.
<u>Tracy Wilson</u> Age band [—] Interviewed on 22 November 2007. Kitchen Aid owner. WS C6/Tab 3	It's a food mixer. I think it's a Kenwood one. Quite similar to the one I have at home – I have a black top not a red top.	I recognise the logo as I have a Kenwood toaster. I bought a mixer a few months ago. Spend quite a bit of money – so did research. It's a Kitchen Aid Artisan from John Lewis.	Shape tells me it's a food mixer – same shape as the one I own – very similar.

51. I think it is clear from the responses noted in these tables that the 26 interviewees were commenting upon the aesthetic and functional aspects of the kMix shown in the flashcard either: (1) without regarding the shape or appearance of it as an indication of trade origin; or (2) without forming any or any enduring belief that the shape or appearance of it was indicative of a trade origin linked to that of the KitchenAid product they were aware of. The responses to Question 4 point to the conclusion that most of the 26 interviewees gave their answers from the first rather than the second perspective. The 13 interviewees whose responses are noted in Table B appear to have been chosen to participate in stage three of the process on the basis that they may have been regarding shape or appearance as an indication of trade origin when giving the answers they did.

52. Nine of these 13 interviewees provided witness statements⁵⁶ that were taken as read on the basis I have already indicated. The other four were cross-examined on their statements.⁵⁷ Mrs. Flatman is an art teacher. She is a KitchenAid owner and assumed that she had been contacted by the telephone interviewer as a result of sending off for the free cookery book that went with it. When she was first shown Flashcard 4 she thought it depicted a Krups or Kenwood mixer because she could see there was a K on the bowl. The lettering under the dial led her to think it was a Kenwood. She immediately recognised the debranded Artisan as a KitchenAid mixer by its shape, the front attachment hub and the silver bowl. She thought she was being asked to comment in relation to the look and style of the kMix. In her witness statement she said that on seeing

⁵⁶ Tracy Wilson WS C6/Tabs 3 and 4; Vicky Leffman WS C6/Tabs 9 and 10; Pamela Stoker WS C6/Tabs 15 and 16; Victoria Wells WS C6/Tabs 23 and 24; Joanne Langston WS C6A/Tabs 27 and 28; Sarah Gronmark WS C6A/Tabs 29 and 30; Mary Bell WS C6A/Tabs 37 and 38; Laura Dubois WS C6A/Tabs 43 and 44; Jennifer Johannes WS C6A/Tabs 47 and 48.

⁵⁷ Clare Flatman WS C6/Tabs 11 and 12, Transcript Day 2 pp. 154 et seq; Sarah Hershman WS C6/Tabs 17 and 18, Transcript Day 5 pp. 665 et seq; Anne Banks WS C6/Tabs 21 and 22, Transcript Day 2 pp. 164 et seq; Vanessa O'Donnell WS C6A/Tabs 31 and 32, Transcript Day 2 pp. 137 et seq.

all the mixers together she thought they looked very similar, but *'when side-by-side I think you can see they are different mixers from different sources'*.

53. Mrs. Hershman is a housewife. She owns a Magimix mixer. Her mother has a Kenwood Chef. If she were to buy a new mixer she would buy a KitchenAid. She thought that she was being asked to compare the looks and styles and similarities of the different mixers shown to her at the solicitor's offices. In her witness statement she said that she *'thought the Kenwoods were trying to look like KitchenAids'*. In her oral evidence she confirmed that she was commenting on the design aspects of the machines and looking for branding to work out why they looked so similar. She thought the shape, the head and the bowl made the KitchenAid machine very distinctive looking and *'if you walk into a store, you automatically know which one it is'*. Her expectation was that the similarities between the kMix and the KitchenAid would make her want to compare them if she was looking for that style of mixer.

54. Mrs. Banks is a company director in the television industry. She is a KitchenAid owner. When she was shown Flashcard 4 she initially thought the mixer it depicted was a KitchenAid, but realised it was a Kenwood when she looked more closely. She thought when responding to the questionnaire that she was engaged in market research about a new product design. She confirmed that she had not thought and would not have thought of the kMix as an updated version of the KitchenAid once she had seen it identified as a Kenwood. Beyond that, she thought *'the fact the kMix looks like the KitchenAid would make me more likely to buy it'*. In her witness statement she confirmed that when she was shown the debranded Artisan she immediately recognised it as a KitchenAid mixer. *'The shape is very recognisable, quirky, it looks really old, like a 1930s mixer. It has also got a*

very distinctive strong chrome bowl, although there wasn't one in the one I was shown. It has become quite fashionable and works well'.

55. Mrs. O'Donnell is a registrar in a Government department. She is a KitchenAid owner. The interviewer who telephoned her said something along the lines of 'I know you have bought a mixer recently', but did not answer when asked 'How do you know that?'. When she was first shown Flashcard 4, Mrs. O'Donnell thought she was being asked about the prototype for a new design. She did not recognise the mixer it depicted. On thinking about it, she came to the conclusion it was a Kenwood. When she saw the debranded Artisan she immediately recognised it by its appearance as a KitchenAid mixer. She was clear in her own mind that the kMix mixers she was shown were Kenwood products. Her perception was that the kMix was a Kenwood that looked like a KitchenAid. She thought that in the absence of positive identification of it as a Kenwood, she would have regarded it as a revamped version of the KitchenAid.

56. Two non-survey witnesses⁵⁸ were called to give evidence of mis-identification. Mr. Morrissey is a partner in the firm of solicitors acting for Whirlpool. He was not involved in the conduct of the case. He was, however, aware that his firm was acting for Whirlpool in a contentious matter relating to a new Kenwood stand mixer and from time to time he had lunch with the trade mark advisers in his firm who were working on that matter. He had seen various mixers in boxes in their office and other offices, but did not know which side his firm was acting for and did not know that the KitchenAid mixer was a Whirlpool product. He knew what the KitchenAid mixer looked like, having previously seen examples on display in stores such as John Lewis. He was impressed by them and wanted to own one. At lunchtime on or about 6 September 2007 he dropped into the

⁵⁸ Simon Morrissey WS C6A/Tabs 25 and 26, Transcript Day 1 pp. 110 et seq.; Bruce Hutchison WS C6A/Tabs 35 and 36, Transcript Day 2 pp. 122 et seq.

office used by his trade mark colleagues. He caught sight of an example of Flashcard 1, picked it up, looked at it and said: *'Doesn't it look great. I would love to have one of those appliances in the kitchen'*. He was then told *'No, that is the opposition, the kMix'*. It was a very brief conversation. He did not study the photograph on the flashcard 'forensically' for the purpose of determining the identity of the product it depicted. I think the photograph was merely the stimulus for a passing remark about his fondness for KitchenAid mixers. The remark was too casual and there were too many special situational factors affecting his thought processes for me to be able to attach significance to this incident in the broader context of the issues I have to decide.

57. Mr. Hutchison is based in South Africa. Having trained as a chef, he is now a hotelier. Approximately 5 years ago he bought a KitchenAid mixer on a visit to London. He is very familiar with KitchenAid mixers and would recognise them by their shape, with or without the 'KitchenAid' name or logo. He is a friend and business associate of Mr. Piers Schmidt, the expert witness retained by Whirlpool for the purposes of the present proceedings. They are partners in a consultancy specialising in branding in the field of hotels, tourism and real estate linked to hotels and tourism. In January 2008 Mr. Hutchison met Mr. Schmidt in London to discuss a hotel related business venture. The meeting took place in the lounge area of the Ferndale Hotel. Mr. Schmidt was already there when Mr. Hutchison arrived. He (Mr. Schmidt) had a number of files on the table in front of him. He said he was *'working on the KitchenAid project'*. Mr. Hutchison was aware, as a result of a discussion on a previous occasion, that this referred to his work as an expert witness for the makers of the KitchenAid mixer.

58. Mr. Schmidt showed Mr. Hutchison one of a number of photographs from the files. These were photographs in which individual images of a red KitchenAid Artisan

mixer were presented for the purposes of comparison alongside corresponding images of a red kMix. The evidence as to what happened leaves me with the impression that Mr. Schmidt invited Mr. Hutchison to comment on the comparison. In each photograph, the image of the Artisan appeared under the caption '**KitchenAid**' and the corresponding image of the kMix appeared under the caption '**Kenwood kMix**'. Mr. Hutchison looked across the table and said as he pointed to the KitchenAid '*I have got one of those*'. Mr. Schmidt then drew his attention to the other image in the photograph by a question along the lines of '*Have you seen this?*' at which point Mr. Hutchison's comment in relation to the kMix was something along the lines of '*My God, what have KitchenAid done*'. By that time he was holding the photograph. In his witness statement he said that he looked hard at the images. In his oral evidence he said that he looked at them very carefully. He nonetheless maintained that he did so without noticing either the KENWOOD trade mark on the front of the kMix or the caption '**Kenwood kMix**' above the image he was looking at and therefore without realising that it was a Kenwood mixer until that was pointed out to him. I think his obliviousness to the positive identification of the kMix as a Kenwood mixer is significant and all the more so in circumstances where KENWOOD is a brand that was known to him and he actually had a Kenwood mixer in the kitchen of his apartment in Johannesburg. It appears to me that he was actively correlating the design of the kMix with that of the KitchenAid as a direct result of the context and manner in which the photographic images were put to him. I am not willing to regard that as a relevant mindset for the purposes of the assessment I am required to make.

59. In the period following the introduction of the kMix, both sides monitored public reaction to it in stores in the United Kingdom. Kenwood has 20 (or maybe more) in-store demonstrators. Mr. Fry, Kenwood's Company Secretary, spoke to them (or some of them) at a training conference and made them aware of Whirlpool's allegation that the kMix and

the KitchenAid Artisan were so similar in appearance that consumers would be likely to confuse the two products. He asked them to report any such instances. The demonstrators send written reports to their manager at regular intervals. He kept in contact with her. There were, to his knowledge, no reports of any instances of confusion. He gave evidence to that effect on Day 4 of the trial. Whirlpool's solicitors then called for disclosure of the demonstrators' reports and any related documents covering the period since launch. I understand that approximately 2,000 pages of documents were collated and examined.⁵⁹ Three documents were added to the trial bundles.⁶⁰ A March 2008 report from Southampton referred to *'Lots of passing general interest – some good comparison questions re. KitchenAid similarities'* and *'A couple on Saturday this week claimed we had "just copied KitchenAid". I explained unique features of kMix'*. A January 2008 report from Birmingham noted that *'Some customers here have commented that kMix "looks like a KitchenAid". I've explained the retro design, highlighted its benefits and the fact that "Kenwood" is clearly written on the product to avoid confusion!'* An email of 4 March 2008 observed in passing that *'Apparently KitchenAid, which is very similar and for the same price, offers a 5 year guarantee'*. These documents evidence perceptions of similarity. They do not evidence any instances of confusion resulting from the existence of such perceptions.

60. Whirlpool's in-store demonstrators also prepare written reports for their manager. Those for the relevant period were obtained from her during the course of the trial. I understand that only one of them contained anything that might possibly be regarded as

⁵⁹ Transcript, Day 6 p. 829.

⁶⁰ Bundle X/Tab. 13.

relevant. This was added to the trial bundles.⁶¹ It merely reported on arrangements for in-store demonstrations of the kMix in Scotland in February 2008.

61. Three KitchenAid demonstrators gave evidence of public reaction to the kMix following launch.⁶² Mrs. Champion is primarily based at the John Lewis store in Bristol. She also visits other stores in the South West of England. Two members of the John Lewis sales staff in Bristol independently told her they thought the kMix was very similar to the KitchenAid mixer. Customers have commented to the effect that the kMix is a direct copy of the KitchenAid or in the same style as the KitchenAid. A ‘*handful*’ of customers have asked her whether the kMix is a new version of the KitchenAid or made by KitchenAid. No one asked her to make a contemporaneous record of any instances of confusion that she might come across in relation to the kMix. Her witness statement provided as much detail as she could remember when she prepared it from memory in February 2008 or thereabouts. She acknowledged that her memory was no better and probably worse by the time of the trial. Whilst I accept her evidence, it is not informative with regard to the exchanges between herself and the ‘*handful*’ of customers to which she refers.

62. Mrs. Pollock was until January 2008 a KitchenAid demonstrator at the John Lewis store in Bluewater, Kent. This is the second largest John Lewis store, after the Oxford Street store in London. At busy times in November and December she might sell 8 or more mixers per week. Her highest tally in the run up to Christmas would have been about 15 mixers in one week. She received ‘*lots of comments*’ from members of the public about the kMix. In her witness statement she said:

⁶¹ Bundle X/Tab. 16.

⁶² Julie Champion WS C1/Tab. 6, Transcript Day 3 pp. 322 et seq; Samantha Pollock WS C1/Tab. 7, Transcript Day 3 pp. 312 et seq; Janet Evans WS C1/Tabs 8 and 9, Transcript Day 4 pp. 519 et seq. Similar evidence was given by Geert van Lantschoot WS C21/Tab 5. His statement was taken as read on the basis I have described.

3. During the period between October 2007 and the first week of January 2008 I had customers asking me questions at the John Lewis store in Bluewater which made me think they were confused about the KitchenAid and kMix mixers. For example, some people came up to me and told me that they wanted a KitchenAid mixer but then moved to the display of the kMix mixers to ask me to tell them about the product. I would have to say that they were now looking at a kMix mixer and move them back to the displays of KitchenAid mixers. Some were surprised as they clearly hadn't realised that they were looking at different mixers and some just didn't realise the KitchenAid mixers and kMix mixers were different brands coming from different companies. Other times, people would ask me to tell them about "these KitchenAid mixers" while pointing at the display of kMix mixers.

There were other customers who appeared to think that the KitchenAid and the kMix looked very similar, but who nonetheless seemed to be aware that they were different brands from different companies. She told me that she had most probably referred to the instances of apparent confusion in the weekly reports she sent to her manager. She also agreed that her recollection of events was unlikely to be any better at trial than it was when she prepared her witness statement in February. However, she was not cross-examined on the evidence given in paragraph 3 of her witness statement as quoted above. I accept her evidence, subject to the fact that the subsequent letter from Whirlpool's solicitors⁶³ indicated that the weekly reports they had obtained from her manager did not include any reports of confusion.

63. Mrs. Evans works as a KitchenAid demonstrator in Fenwicks at the Brent Cross Shopping Centre in North London. On two or three occasions in October 2007 members of the public who had seen the kMix on sale in the John Lewis store at Brent Cross commented on its similarity to the KitchenAid mixer. They mentioned the overall shape, colours and enamel type finish. In addition she had in March 2008 approached a female

⁶³ Letter of 15 May 2008, Bundle X/Tab. 16.

customer who was looking at a KitchenAid Artisan mixer on display in her sales area at Fenwicks. The customer asked her about the ‘free blender’ that came with it. She explained that the KitchenAid was not being offered with a ‘free blender’. The customer was adamant that she had just come from the nearby John Lewis store where she had seen it being sold with a ‘free blender’. She (the customer) then went back to check. An hour or so later she returned, saying that she had discussed the matter with the sales staff at John Lewis. Having done so, she understood that they were running a promotion where a Kenwood blender was being offered ‘free’ with every purchase of a Kenwood kMix mixer. According to Mrs. Evans ‘*She said she had been confused about the mixers and thought they were the same*’. The customer bought a KitchenAid mixer at Fenwicks. The price of the mixer may have been slightly less than in John Lewis. Mrs Evans said she had reported the incident to her manager. I accept her evidence, again subject to the fact that the subsequent letter from Whirlpool’s solicitors⁶⁴ indicated that the weekly reports they had obtained from her manager did not include any reports of confusion. I understand that attempts to trace the customer who bought the KitchenAid mixer were unsuccessful. It must, I think, be recognised that although the customer’s apparent confusion may have been attributable to perceptions and recollections of shape and appearance as indications of trade origin, that is not an inevitable inference from the evidence I have received.

64. Each side adduced expert evidence under the permission given for ‘*one additional expert in relation to the goodwill and/or reputation (if any) of the brands and/or products in issue and the impact (if any) of the products complained of*’.⁶⁵ This was a very broad remit. It opened the door to expert evidence directed to issues (not being issues of law)

⁶⁴ letter of 15 May 2008, Bundle X/Tab. 16.

⁶⁵ Order of Lightman J. dated 13 November 2007, para. 21; Bundle A/Tab. 15..

upon which the outcome of the proceedings ultimately depends.⁶⁶ However, in order to be of any real value, the evidence would have to provide insight into the matters it relevantly addressed by drawing independently and objectively upon appropriate knowledge and experience.⁶⁷ Moreover, the Court of Appeal has recently re-emphasised that the question of consumer confusion is not properly to be regarded as a matter for expert evidence in cases involving the marketing of ordinary goods or services to the general public.⁶⁸ That is the case here.

65. Whirlpool's expert witness, Mr. Piers Schmidt, has extensive experience of marketing and brand consultancy. However, he has no expertise in the area of stand mixers or kitchen appliances more generally. His comments and observations were necessarily dependent on research into the matters relating to mixers that he was asked to consider⁶⁹. Those matters included the status and reputation of the KitchenAid stand mixer in the EEA and worldwide (in particular in relation to its shape and colours) and the distinctiveness (if any) of the shape and get-up (with and without bowl) of the KitchenAid stand mixer. Kenwood's expert witness, Mrs. Trudy Watson, has extensive experience as a commercial buyer of small domestic appliances (including stand mixers) for retail sale to consumers in the United Kingdom and other Member States. It has been a key part of her work to understand the buying patterns of consumers, the relevance of brands, new design, trends in the market and ultimately what makes the consumer take the final decision to purchase one product over another.

⁶⁶ Sections 3(1) and (3) of the Civil Evidence Act 1972; Technip France SA's Patent [2004] EWCA Civ 381, [2004] RPC 46, p. 919 at paras 13, 14 per Jacob LJ.

⁶⁷ esure Insurance Ltd v. Direct Line Insurance Plc [2008] EWCA Civ 842 at paras. 67, 75 to 77 and 80 to 82 (per Jacob and Maurice Kay L.JJ).

⁶⁸ esure Insurance Ltd v. Direct Line Insurance Plc [2008] EWCA Civ 842 at paras. 57 and 62 per Arden LJ, paras. 72 to 77 per Jacob LJ and paras. 80 to 82 per Maurice Kay LJ.

⁶⁹ Annex F to Report; Bundle B(2)Tab 1 p.44.

66. Mr. Schmidt evidently saw it as his job to correlate the design of the kMix with that of the KitchenAid Artisan mixer to the fullest extent possible by concentrating on similarities and discounting differences.⁷⁰ Moreover his intention was to remark on the similarities between the two products and not between those products and the rest of the market.⁷¹ On viewing the products through the lens of the similarities he had identified and by treating those similarities as aspects of branding, he felt able to censure Kenwood and its kMix product. His stance can clearly be seen from the language of his conclusions⁷²:

... the shape is so similar that it must surely infringe on the KitchenAid shape mark if the mark's registration is valid (para. 254)

... I believe that the branding of the kMix is at best naïve and may actually be deliberately trying to benefit from the goodwill that rightly belongs to KitchenAid (para. 297)

What we see with the kMix is a lame and frankly cynical spoiler (para. 321)

I personally have little doubt that Kenwood have attempted to mimic the KitchenAid stand mixer in nearly every aspect ... (para. 321)

... hitching a subsidised rise on the coat tails of a successful competitor in a sly attempt to erode their market share (para. 322)

It's not quite a cheap 'Gucci' from Patpong market but neither is it original (para. 324)

It appears to me not only from his approach as I have thus far outlined it, but also from the way in which he constructed his report, that he was endeavouring to collate information and develop arguments in support of Whirlpool's case. In particular, I have in mind his searching of the internet for textual material to deploy and the presentation of it

⁷⁰ Transcript Day 3 pp. 472, 473 and 493; Day 4 pp. 507, 508.

⁷¹ Transcript Day 4 p. 490.

⁷² Report I, Bundle B(1)/Tab. 1.

(sometimes with adjustment) as his own. Mr. Schmidt was cross-examined at some length about this.⁷³ He had no satisfactory explanations to give in response to most of the questions that were asked of him. I cannot be confident that his selective recycling of other people's comments and observations was confined to the detected instances on which he was questioned.⁷⁴ It was certainly not satisfactory to hear him repeatedly say that he was 'puzzled' by his own evidence to the effect that a Swedish website featuring various kitchen products (including the KitchenAid mixer) was a fan site created by and for brand lovers, when anyone who visited the website would have seen that it was a commercial site operated by a cookware retailer.⁷⁵ I think I have at this point said enough to explain why I intend to regard Mr. Schmidt's 'expert evidence' as search-supplemented advocacy for Whirlpool and nothing more.

67. Mrs. Watson acknowledged in her report⁷⁶ that Kenwood with its kMix product is appealing to consumers at the premium end of the market and '*is certainly trying to compete with KitchenAid for a very similar type of consumer*' for whom style and design would be an important factor in product choice. She expected them to be clear about their preference when they came to purchase in the course of the 'real life' process of buying an expensive stand mixer. '*Once the consumer had had a proper look at the Kenwood kMix product the Kenwood branding would be clear to the consumer*'. In cross-examination she agreed that the shape of the KitchenAid mixer is distinctive⁷⁷. She agreed that the brand name KitchenAid would be '*the handle for everything else*', including the shape in terms of which design conscious purchasers would naturally be

⁷³ Transcript Day 3 pp. 375 to 380, 396 to 401, 403 to 410, 417, 419 to 421.

⁷⁴ Listed at Bundle X/Tab. 12.

⁷⁵ Transcript Day 3 pp. 380 to 386; pages downloaded from the website are at Bundle X/Tab. 6.

⁷⁶ Bundle B(1)/Tab 3.

⁷⁷ Transcript Day 5 p.817.

inclined to think of the mixer⁷⁸. She agreed that there is a distinct competitive advantage in being an iconic brand when selling to consumers moving from initial interest through to purchase in this sector of the market⁷⁹. She thought that consumers ‘*might fleetingly associate the KitchenAid stand mixer with the Kenwood KMix or vice versa*’ and also that having a similar ‘*look appeal*’ potentially attracts customers who would not have looked at the Kenwood Chef, but expected the initial reaction to be very quickly dispelled when potential customers looked properly at the products and observed the differences in style, specification and branding⁸⁰. In circumstances where the kMix had been introduced and sold in the same premium market and to the same type of customers as the KitchenAid mixer she thought that there would have been lots of comment by customers talking to in-store demonstrators about the two products comparatively and was surprised that there were not more comments than there appeared to be from the evidence before the Court⁸¹. Mrs. Watson gave her evidence fairly. She gave the kMix a reasonably good character reference on the basis of her experience as a commercial buyer. I take note of what she said, without regarding it as decisive of the issues I must determine from the perspective of the relevant average consumer.

68. I now turn to discuss the issues of distinctiveness and similarity in the light of the evidence and materials before me. My assessment takes account of the evidence and materials that were to be taken as read, as I have previously described. It also takes account of the need for circumspect evaluation of the evidence of the witnesses who passed through the special filter of the ‘witness gathering exercise’. I do not accept that the bodywork or finished appearance of the KitchenAid Artisan mixer can to any real extent be regarded as fanciful or capricious. That said, there is in my judgment a degree

⁷⁸ Transcript Day 5 pp.821, 822.

⁷⁹ Transcript Day 6 pp.843 to 848.

⁸⁰ Transcript Day 6 pp.849 to 851.

⁸¹ Transcript Day 6 pp.841 to 843.

of specific individuality in the finished appearance of the KitchenAid Artisan mixer which is sufficient, albeit with relatively little scope for deviation from the paradigm form, to render it thereby distinguishable from mixers of a different trade origin in the minds of design conscious consumers. Whirlpool have successfully capitalised on that by making the finished appearance of the Artisan a point of reference for such consumers in the stand mixer market. So much so that the more familiar they are with the mixer, the more likely they are to perceive and remember the finished appearance of it as an indication of trade origin. The mindset I am referring to is not simply association in the sense of awareness that supplier **X** markets goods having the finished appearance **Y**⁸². I am referring to the degree of recognition implicit in a settled belief that **KitchenAid = finished appearance A (for Artisan)** and **finished appearance A (for Artisan) = KitchenAid**. There is, in my judgment, a not insubstantial body of design conscious consumers in the United Kingdom (and I would expect in France and Germany) for whom the finished appearance of the Artisan functions as an indication of trade origin even without assistance from the denomination **KitchenAid**⁸³. I have paused over the question whether that is also the position with regard to the disaggregated mixer head and stand graphically represented in the Community trade mark registration. In the end I have come to the conclusion that it is, on the basis that the bodywork of the unitary mixer head and stand is liable to cut through the finished appearance of the Artisan in much the same way as the bodywork of a stylish motor car is liable to cut through the finished appearance of the vehicle as marketed.

⁸² As to which see Unilever Ltd's (Striped Toothpaste No.2) Trade Marks [1987] RPC 13 (Hoffmann J); Vibe Technologies Ltd's Application BL O-166 08, 16 June 2008 (Mr. Richard Arnold QC) at paras. 72 to 91; and Kerly's Law of Trade Marks and Trade Names 14th Edn (2005) paras. 8-023 to 8-025.

⁸³ These are the consumers that the Artisan is specifically targeted at: Transcript Day 2 pp. 229, 230.

69. It is at this point necessary to consider whether Whirlpool can pursue a claim for infringement by reference to the presumed expectations of design conscious consumers.⁸⁴ It was suggested on behalf of Kenwood that the relevant assessment should be made by reference to the average among all consumers in the market for all of the different types of *'electric beating and mixing machines'* that would be covered by the Community trade mark registration in Class 7. I do not agree. The ECJ has confirmed that it is the circumstances characterising the allegedly infringing use which must be considered in order to determine the question of liability for infringement.⁸⁵ It is necessary to conduct a risk assessment. The tribunal must assess the likelihood of the conduct in question giving rise to consequences of the kind proscribed. The 'average consumer' test standardises the approach to assessment. It does so by requiring the tribunal to judge the matter from the viewpoint of a consumer exercising neither too low nor too high a degree of perspicacity. It does not permit or require the tribunal to exclude any relevant factors from the assessment of risk. The Artisan and the kMix are both premium priced products targeted at design conscious consumers. It follows, in my view, that the question of liability for infringement can properly be determined by taking the presumed expectations of such consumers into account. To hold otherwise would be to apply a test divorced from the actualities of the case.

70. I am aware that in some Member States the average consumer test is regarded as a means for determining the scope of protection on a 'normative' or 'regulatory' basis. The rationale is that trade mark owners are entitled to the benefit of an exclusive right with appropriate scope of protection, just as patent owners are entitled to the benefit of an exclusive right with appropriate scope of protection. The appropriate scope of protection

⁸⁴ I do not doubt that their expectations can and should be taken into account for the purposes of a claim in passing off in a case such as the present, involving head to head competition in a premium price sector of the market.

⁸⁵ Case C-533/06 O2 Holdings Ltd v. Hutchison 3G UK Ltd [2008] ECR I-00000, at para. 67.

is a matter of law, not a matter of fact: the notional average consumer in the law of trade marks should, like the notional technician skilled in the relevant art in the law of patents, be viewed as a synthetic person with the ‘correct’ mindset and behaviour patterns. However, I believe that this approach can be too abstract. In my view, the average consumer is meant to be a person of the type whose mindset and behaviour patterns conform to the norm among reasonably well-informed and reasonably observant and circumspect people in the market for the goods or services in question. That appears to me to bring into consideration the real world thought processes of real people. I therefore think that the appropriate scope of protection should in each case be determined with as great a sense of reality as the circumstances of the case will allow. Empirical evidence should therefore not be ignored. That is the basis on which I am proceeding in this case.

71. In the context of my findings as to distinctiveness, I consider that the presence of a mark identical or similar to the denomination **KitchenAid** is not essential for a finding that the rights conferred by the Community trade mark registration have been infringed. And I think there is a likelihood that in the United Kingdom (and other Member States where the Artisan mixer was likewise known and recognised) a mixer replicating the finished appearance of the Artisan would, for that reason, be thought to have a commercial origin linked to that of the KitchenAid product, whether or not it carried a denomination that was identical or similar to the denomination **KitchenAid**. However, the kMix is not a replica of the Artisan. It is, as one of the survey respondents observed when shown Flashcard 3, ‘*KitchenAid-ish*’ in its appearance⁸⁶. There is clearly enough similarity for each to remind people of the other. On the other hand, there does not appear to me to be sufficient similarity in terms either of their bodywork or their finished appearance to lull the relevant average consumer into thinking one is the other on seeing

⁸⁶ Bundle G1/pp. 189 to 191 (Libby Tune).

them together or separately at different times or in different settings. What is the effect of consumers being aware that the product they are looking at is not the product it reminds them of? If (and I emphasise the word if) they are interested in the provenance of the mixer they are looking at, their natural reaction would be to refer to the badges of origin in the form of the word and device marks conventionally used in relation to the products for the purposes of source identification. That reflects the position that *'average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packing in the absence of any graphic or word element'* in a market such as this, where consumers would be alive to the potential for variations in appearance to be indicative of differences in trade origin. It requires no real effort to appreciate that the Artisan is a KitchenAid product and that the kMix is a Kenwood product. No one who was actually contemplating the possibility of spending more than £300 on the purchase of either product would be under any misapprehension as to their true trade origin. KENWOOD is a strong and well-established trade mark for mixers. I can see no likelihood of confusion occurring during the process leading from selection through to purchase of a kMix product.⁸⁷

72. The following provisions of the CTMR relate to the present claim for infringement:

Article 9
Rights conferred by a Community trade mark

1. A Community trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be

⁸⁷ and I note that Mr. Vermeiren accepted in his evidence on behalf of Whirlpool that no one reading the word KENWOOD on the kMix or on labelling for the kMix would think it was a version of the KitchenAid mixer: Transcript Day 2, p.246.

entitled to prevent all third parties not having his consent from using in the course of trade:

- (a) ...
- (b) any sign where, because of its identity with or similarity to the Community trade mark and the identity or similarity of the goods or services covered by the Community trade mark and the sign, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;
- (c) any sign which is identical with or similar to the Community trade mark in relation to goods or services which are not similar to those for which the Community trade mark is registered, where the latter has a reputation in the Community and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the Community trade mark.

2. The following, *inter alia*, may be prohibited under paragraph 1:

- (a) affixing the sign to the goods or to the packaging thereof;
- (b) offering the goods, putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder;
- (c) importing or exporting the goods under that sign;
- (d) using the sign on business papers and in advertising.

3. ...

Article 12

Limitation of the effects of a Community trade mark

A Community trade mark shall not entitle the proprietor to prohibit a third party from using in the course of trade:

- (a) ...
- (b) indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;
- (c) ...
provided he uses them in accordance with honest practices in industrial or commercial matters.

73. The case law of the ECJ⁸⁸ establishes that the operation of Article 9(1) is confined to situations in which a third party is, without consent, using a sign identical or similar to the protected trade mark ‘*in relation to*’ his goods or services, in the course of commercial activity with a view to gain and not as a private matter, so as to affect or be liable to affect the functions of the trade mark and in particular its essential function as a guarantee of origin. Use ‘*in relation to*’ means use ‘*for the purpose of distinguishing*’ the goods or services in question, irrespective of whether the claim for infringement is brought under sub-paragraph (a), (b) or (c) of Article 9.⁸⁹ If and insofar as the third party maintains that he is using the sign in question descriptively rather than for the purpose of distinguishing his goods or services from those of other traders, he is expected to defend himself within the scope of Article 12(b)⁹⁰. In cases where the sign in question is not being used descriptively within the scope of Article 12(b), a defence to the effect that it is being used non-distinctively (for example, purely decoratively) stands or falls on the proposition that there is no use for the purpose of distinguishing any goods or services in a manner liable to affect the functions of the protected trade mark⁹¹.

74. Kenwood maintained that the kMix embodied nothing in the nature of a ‘*sign*’ to which Whirlpool’s claim for infringement of its three-dimensional trade mark registration could apply. What is a sign? Something that tells you something. In Philips Electronics NV v. Remington Consumer Products⁹² Jacob J. said:

⁸⁸ Case C-48/05 Adam Opel AG v. Autec AG [2007] ECR I-1017, paras. 17 to 22 and 29; Case C-17/06 Céline SARL v. Céline SA [2007] ECR I – 7041, paras. 15 to 27; Case C-533/06 02 Holdings Ltd v. Hutchison 3G UK Ltd [2008] ECR I-00000, paras. 34 to 36 and 56 to 68.

⁸⁹ Case C-17/06 Céline, para. 20; Case C-63/97 Bayerische Motorenwerke AG v. Deenik [1999] ECR I-905, para. 38; Case C-245/02 Anheuser-Busch Inc. v. Budejovicky Budvar NP [2004] ECR I-10989, paras. 59 to 64; Case C-23/01 Robelco NV v. Robeco Groep NV [2002] ECR I-10913, paras. 28 to 31.

⁹⁰ Case C-102/07 Adidas AG v. Marca Mode CV [2008] ECR I-00000, paras. 44 to 49.

⁹¹ Case C-102/07 Adidas, paras. 26 and 32 to 36; Case C-408/01 Adidas-Salomon AG v. Fitnessworld Trading Ltd [2003] ECR I-12537, paras. 38 to 41; RxWorks Ltd v. Dr. Paul Hunter [2008] RPC 13, p.303 (Mr. Daniel Alexander QC) at paras. 52 to 54.

⁹² [1998] RPC 283 at 298.

I think a “sign” is anything which can convey information. I appreciate that this is extremely wide, but I can see no reason to limit the meaning of the word. The only qualification expressed in the directive is that it be capable of being represented graphically.

Later cases in the ECJ support that view by distinguishing between that which is ‘*a simple property*’ of something and that which can ‘*convey meaning*’ and therefore be a ‘*sign*’⁹³. The bodywork of the kMix is informative. It makes a non-verbal statement to the effect that the kMix is a mixer. It thus operates as a ‘*sign*’. There is ample confirmation of that in the completed questionnaires I have seen in this case. So much so that I thought I would be asked to decide whether Article 12(b) provided Kenwood with a defence to Whirlpool’s claims for infringement under Articles 9(1)(b) and 9(1)(c) on the basis that the bodywork of the kMix indicated ‘*the kind...intended purpose...or other characteristics of the goods*’⁹⁴ and that Kenwood were using it ‘*in accordance with honest practices in industrial or commercial matters*’. However, Kenwood preferred to defend the claims for infringement without relying on the provisions of Article 12(b). I therefore take its ‘*no sign*’ defence to be an abbreviated version of its ‘*no conflict*’ defence under Articles 9(1)(b) and 9(1)(c).

75. It is sufficient for the purposes of Article 9(1)(b) to establish the existence of a likelihood of confusion in only part of the Community⁹⁵. The concept of ‘*using in the course of trade*’ is amplified by Article 9(2) in a way that appears to make it sufficient for the purpose of establishing liability under Article 9(1)(b) for there to be ‘*a likelihood of confusion on the part of the public*’ at any material stage or in relation to any material

⁹³ Case C-49/02 Heidelberger Bauchemie GmbH’s Trade Mark Application [2004] ECR I-6129, paras. 22, 23; Case C-104/01 Libertel Groep BV, paras. 26 27.

⁹⁴ As contemplated by the ECJ in Joined Cases C-53/01 to C-55/01 Linde AG, Winward Industries Inc., Rado Uhren AG [2003] ECR I-3161, paras. 69, 70; and Case C-218/01 Henkel KGaA v. Deutsches Patent-und Markenamt [2004] ECR I-1725, paras 42 and 44.

⁹⁵ Case T-246/06 Redcats SA v. OHIM [2008].ECR II-00000, paras. 27, 28; Case T-168/04 L&D SA v. OHIM [2006] ECR II-00000, paras 67 to 71;

aspect of the commercialisation of the sign in question. From that I think it follows that ‘bait and switch’ selling can be prevented under Article 9(1)(b) on the basis that the process of buying goods or services should, from selection through to purchase, be free of the distorting effects of confusion. I mention that because Whirlpool’s claim under Article 9(1)(b) relied on the proposition that there would be a likelihood of confusion unless and until the branding of the kMix as a KENWOOD product impinged upon the consciousness of interested consumers: the shape and appearance of the kMix would initially tell them it was a ‘KitchenAid’ product and the KENWOOD branding would not tell them otherwise until after they had gone down the road of selection with a view to purchase. It is possible for a claim to succeed on that basis⁹⁶. However, I do not accept that in the present case there will be any initial confusion in the mind of the relevant average consumer. There will, in my view, be nothing more than an awareness that the product they are looking at is not the one it reminds them of. I am not persuaded otherwise by the evidence of the KitchenAid demonstrators. Their evidence relating to the incidents to which they refer provides no firm basis for concluding that there is similarity between the bodywork of the Artisan and that of the kMix sufficient to give rise to a risk that the relevant public might believe the mixers come from the same undertaking or, as the case may be, from economically linked undertakings⁹⁷. The claim for infringement under Article 9(1)(b) is not made out on the evidence and materials before me.

76. Article 9(1)(c) provides protection for Community trade marks which have a reputation ‘*in the Community*’. Kenwood suggested that this means a reputation across

⁹⁶ See BP Amoco Plc v. John Kelly Ltd [2002] FSR 5, p.87 (CA. NI) at para. 44 and the other cases cited in footnote 28 above.

⁹⁷ Case C-102/07 Adidas AG, paras. 27 to 29.

the Community as a whole or at least a large area of it⁹⁸. I do not agree. In the case of a trade mark registered at the national level, protection of the kind provided by Article 9(1)(c) can be claimed for trade marks which have a reputation in the sense that they are known by a significant part of the public concerned by the products or services covered by that trade mark in the territory of registration⁹⁹. Since the territory of registration is part of the Community, the trade mark has a reputation in the Community. The trade mark does not cease to have a reputation in the Community if the national registration is either subsumed within a Community trade mark registration under Article 34(2) CTMR on the basis of a valid claim to seniority¹⁰⁰ or duplicated by a Community trade mark registration. In principle, a Community trade mark should not receive less protection than a national trade mark with a reputation in the same territory. I think that the aim should generally be to prevent conflict occurring in any substantial part of the Community¹⁰¹ and that the United Kingdom can for that purpose be regarded as a substantial part of the Community, with or without the addition of France and Germany. It thus appears to me that Whirlpool's Community trade mark has a reputation in the Community.

77. The operation of Article 9(1)(c) has recently been summarised by the ECJ (in the context of the equivalent provisions of Article 5(2) of the Trade Marks Directive) in the following terms¹⁰²:

40. Article 5(2) of the Directive establishes, for the benefit of trade marks with a reputation, a form of protection whose implementation does not require the existence of a likelihood of confusion. Article 5(2) applies to situations in which the specific condition of the protection consists of a use of the sign in question without due cause which takes

⁹⁸ This issue has been raised in the pending reference to the ECJ in Case C-301/07 PAGO International GmbH.

⁹⁹ Case C-375/97 General Motors Corp. v. Yplon SA [1999] ECR I-5421, paras. 24 to 27.

¹⁰⁰ RAPIER Trade Mark (BL O-170-07) 13 June 2007, paras. 1 to 5.

¹⁰¹ compare Case T-93/06 Mühlens GmbH & Co KG v OHIM [2008] ECR II-00000, paras. 33, 34.

¹⁰² Case C-102/07 Adidas AG.

unfair advantage of, or is detrimental to, the distinctive character or the repute or the trade mark (see *Marca Mode*, paragraph 36, and *Adidas-Salomon and Adidas Benelux*, paragraph 27).

41. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them. It is not therefore necessary that the degree of similarity between the mark with a reputation and the sign used by the third party is such that there exists a likelihood of confusion between them on the part of the relevant section of the public. It is sufficient for the degree of similarity between the mark with a reputation and the sign to have the effect that the relevant section of the public establishes a link between the sign and the mark (see *Adidas-Salomon and Adidas Benelux*, paragraphs 29 and 31).

42. The existence of such a link must be appreciated globally, taking into account all the relevant factors relevant to the circumstances of the case (*Adidas-Salomon and Adidas Benelux*, paragraph 30).

So there must be ‘*similarity between the sign and the mark*’ resulting in ‘*the establishment of a link*’ productive of the consequences required for fulfilment of the ‘*specific condition*’ before there can be liability for infringement under Article 9(1)(c).

78. When making the required assessment in a case such as the present it is appropriate to bear in mind that the registration of a Community trade mark cannot validly deprive third parties of the right to use signs of the kind specified in Article 7(1)(e)¹⁰³. That Article absolutely excludes from protection by registration:

- (e) signs which consist exclusively of:
 - (i) the shape which results from the nature of the goods themselves; or
 - (ii) the shape of goods which is necessary to obtain a technical result; or

¹⁰³ Case C-371/06 Bennetton Group SpA v. G-Star International BV [2007] ECR I-00000.

- (iii) the shape which gives substantial value to the goods;

It seems to me that the policy considerations underlying the sub-paragraphs of Article 7(1)(e) also have a role to play in the determination of the question whether there is similarity between the bodywork of the Artisan and kMix mixers such that the latter without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the former.

79. In a nutshell, Whirlpool objects to the bodywork of the kMix on the basis that it is a lookalike which comes too close to the Artisan. For the purpose of deciding whether the sign and the mark are too close, it is necessary to bear in mind that distinctiveness and similarity are different concepts which must each be weighed appropriately when making the required global assessment.¹⁰⁴ That is necessary because the Community trade mark system establishes a regime for protection in which (say) 50% similarity to a ‘strong’ mark may be just as objectionable as (say) 75% similarity to a ‘weak’ mark. In the overall assessment there could be a finding that the bodywork of the kMix and that of the Artisan were too close if upon weighing distinctiveness and similarity factorially it was concluded: (1) that the shapes were relevantly similar (by being similar in respects related to the distinctiveness of the protected trade mark); and (2) that they were sufficiently similar (by being relevantly similar to a degree which impinged upon the distinctiveness of the protected trade mark) to satisfy the ‘*specific condition*’ for liability under Article 9(1)(c).

80. As I have said, I consider there is enough similarity between the bodywork of the kMix and that of the Artisan for each to remind people of the other whilst leaving them

¹⁰⁴ Case C-235/05 P L’Oréal v OHIM [2006] ECR I-57, paras. 23 to 25 and 40 to 45, Case C-171/06 P T.I.M.E. ART v. OHIM [2007] ECR I-00000, paras. 26, 27 and 41.

aware that the one they are looking at is not the one it reminds them of. Is that ‘*similarity between the sign and the mark*’ resulting in ‘*the establishment of a link*’? Left to my own devices I would have regarded it simply as a calling to mind, rather than the establishment of a link. However, in view of the approach to cross-referential use recently adopted by the ECJ¹⁰⁵ and taking account of the observations of Advocate General Sharpston in her recently delivered Opinion in the Intel case,¹⁰⁶ I think the mnemonic effect I have described should be taken to involve ‘*the establishment of a link*’. Is it a link which is liable

- to take unfair advantage of the distinctive character or repute of the trade mark represented by the bodywork of the Artisan mixer?
- to be detrimental to the distinctive character or repute of the represented by the bodywork of the Artisan mixer?

I cannot see that it is. The reminder appears to me to leave the distinctive character and repute of the trade mark represented by the bodywork of the Artisan mixer completely untouched. It is apt to erode the market share of the KitchenAid product, but without impinging upon any aspect of the property appertaining to the trade mark. So it comes within the scope of the principle that:

No economic operator can claim a right to property in a market share ... a market share constitutes only a momentary economic position exposed to the risks of changing circumstances.¹⁰⁷

¹⁰⁵ Case C-533/06 O2 Holdings, paras. 35 to 37.

¹⁰⁶ Case C-252/07 Intel Corporation Inc v. CPM United Kingdom Ltd. Opinion delivered on 26 June 2008. See paragraphs 46 to 61.

¹⁰⁷ Case C-210/03 Swedish Match AB v. Secretary of State for Health [2004] ECR I-11893 at para. 73. Likewise ‘*There is no tort of taking a man’s market or customers. Neither the market nor the customers are the plaintiff’s to own*’: Hodgkinson & Corby Ltd v. Wards Mobility Ltd [1994] 1 WLR 1564 (Jacob J.) at 1569.

The trade mark represented by the bodywork of the Artisan is, as I have said, distinctive with relatively little scope for deviation from the paradigm form. I do not think that the bodywork of the kMix is relevantly similar to a degree which impinges upon the distinctiveness of the trade mark so as to satisfy the '*specific condition*' for liability. I think it would be excessive, in the realm of product shapes, to apply the concepts of 'free riding', 'blurring', 'tarnishment' or 'dilution' more generally so as to hold that the bodywork of the kMix was too close to the bodywork of the Artisan for the purposes of Article 9(1)(c). I am not persuaded otherwise by the evidence indicating that consumers may or will be drawn into choosing the kMix by reason of its resemblance to the Artisan. Resemblance can have that effect without being objectionable from a trade mark point of view. The claim for infringement under Article 9(1)(c) is not made out on the evidence and materials before me.

81. The claim in passing off relates, as I have said, to the finished appearance of the Artisan mixer. That brings colour into consideration as an element of the right claimed. The necessary elements of the action for passing off have been restated by the House of Lords¹⁰⁸ as being three in number:

- (1) that the claimant's goods or services have acquired a goodwill in the market and are known by some distinguishing name, mark or other indicium;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the claimant; and

¹⁰⁸ Reckitt & Colman Products Ltd v. Borden Inc [1990] RPC 341 (HL) at 406 per Lord Oliver of Aylmerton and 417 per Lord Jauncey of Tullichettle.

- (3) that the claimant has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

My findings in relation to the claim for infringement lead me to the conclusion that although the first of the three elements is satisfied with regard to the finished appearance of the Artisan mixer, the second element is not established with regard to the finished appearance of the kMix. The third element therefore cannot be established. I conclude that the claim in passing off is not made out.

82. It was suggested that there might be liability for trade mark infringement or passing off as a result of the marketing of a special edition of the kMix, even if there was no such liability in relation to the KENWOOD branded KMix shown in paragraph 6 above. The special edition was a kMix bearing the trade mark AGA in lieu of KENWOOD beneath the dial and carrying the following wording on the backplate: **special edition by KENWOOD.**¹⁰⁹ The special edition is marketed through AGA cookware shops.¹¹⁰ It displaced the KitchenAid Artisan mixer in their shops. I can well understand why this was commercially disconcerting from Whirlpool's point of view. However, on considering the evidence relating to the changeover and such evidence as there is in relation to the marketing of the special edition I cannot see any reason why it should not stand on the same footing with regard to liability as the KENWOOD kMix I have considered above. There are no additional concerns that I can identify with regard to the introduction or marketing of the special edition.

83. The parties did not ask me to refer any questions of Community law to the ECJ under Article 234 of the EC Treaty. I for my part have considered it appropriate to

¹⁰⁹ photographs at Bundle D5/Tab 85.

¹¹⁰ online marketing material at Bundle X/Tab 15.

determine the issues arising without making an order for reference. For the reasons I have given the action will be dismissed. I will hear submissions as to the appropriate form of order in the light of the judgment I have given.
