

**TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 1570241
IN THE NAME OF INDUSTRIE ZANUSSI S.p.A TO
REGISTER THE MARK CERAGLOW IN CLASS 11**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No 42075 BY CARL-ZEISS-STIFTUNG (TRADING
AS SCHOTT GLASWERKE)**

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**IN THE MATTER OF Application No 1570241
in the name of Industrie Zanussi S.p.A to register
the mark CERAGLOW in Class 11**

10 and

**IN THE MATTER OF Opposition thereto under
No 42075 by Carl-Zeiss-Stiftung (trading as
Schott Glaswerke)**

15

DECISION

20 On 29 April 1994 Industrie Zanussi S.p.A (Zanussi) of Pordenone, Italy applied under Section
17 of the Trade Marks Act 1938 to register the mark CERAGLOW for a specification of
goods which reads:

25 “Installations and apparatus, all for use in cooking; cookers, ovens, ranges; parts and
fittings for all the aforesaid goods; all included in Class 11.”

The application is numbered 1570241.


30 On 23 February 1995 Carl-Zeiss-Stiftung of Germany, trading as Schott Glaswerke, filed
notice of opposition to this application. The grounds of opposition were subsequently
amended (to reflect the fact that the application and these proceedings are being conducted
under the provisions of the old law). Nothing turns on this point. The grounds of opposition
are in summary:


- 35 (i) under Section 68 in that the trade mark is not capable of indicating a
connection in the course of trade between the goods and the applicant;
- (ii) under Sections 9 and 10 of the Act in that the trade mark is neither adapted to
40 distinguish or capable of distinguishing the applicants' goods;
- (iii) under Section 11 by reason of the opponents' use of and reputation in their
marks;
- 45 (iv) under Section 12 by reason of the opponents' registrations;

(v) under Section 17 in that the applicants cannot claim to be the bona fide proprietors of the mark applied for.

Details of the opponents' marks referred to above are as follows:-

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No	Mark	Class	Journal	Specification
10	1100244 CERAN	11	5295/0371	Glass-ceramic hob plates and panels, all for cookers; kitchen ranges; hotplates, heating apparatus and heating appliances, all included in Class 11.
15	1120407 CERAX	11	5352/0765	Plates, dishes and trays all made from glass-ceramics materials and being parts included in Class 11 of heating and cooking apparatus.
20	1234628	08	5688/2001	Hand-tools for the scraping of ceramic hobs and of ceramic heating panels for cookers.
25				
30				
35	1331204 CERA-TOP CERATOP	11	5754/0059	Glass-ceramics hot plates and panels; articles made from glass-ceramic materials being parts of cooking apparatus; all included in Class 11.
40	1417622 CERAMATIC	11	5854/0032	Heating and cooking appliances containing parts or elements of glass or of glass-ceramic material; all included in Class 11.

No	Mark	Class	Journal	Specification
5	1573142	11	6071/2471	Cooktops, cooker panels and heating plates, all made of glass ceramic and/or special glass, all for baking, cooking and heating apparatus of all kinds using all kinds of energy sources; all included in Class 11.
10				

15 The opponents also ask that the Registrar refuse the application in the exercise of his discretion.

The applicants filed a counterstatement denying the above grounds. Both sides seek an award of costs in their favour.

20 Both sides filed evidence in these proceedings. The matter came to be heard on 8 July 1998 when the opponents were represented by Mr C Morcom of Her Majesty's Counsel instructed by Stephenson Harwood and the applicants by Mr R Arnold of Counsel instructed by Withers & Rogers.

25 By the time this matter came to be heard, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act and as indicated earlier, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provisions of
30 the old law.

Opponents' evidence

35 The opponents filed a statutory declaration dated 11 March 1996 by Tibor Zoltan Gold, their representative in trade mark matters.

Mr Gold gives details of the registration of the opponents' trade mark CERAN both in this country and in some 90 jurisdictions worldwide along with what he describes as a family of CERA- marks.
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He says that the opponent is a group of companies with (1993 figures) 68 companies worldwide, 43 production facilities, 18,500 employees and sales turnover of about £1 billion, 65% of it outside Germany. One division at its manufacturing headquarters at Mainz, Germany is called "Cooking surfaces division" and has been making ceramic cooker hobs
45 sold under the trade mark CERAN since at least 1974. He exhibits (TZG2) a copy of the opponents' magazine "Schott Information" featuring the products.

CERAN ceramic hobs are said to be used by virtually all domestic cooker manufacturers. Mr Gold exhibits (TZG4) an annotated version of a document provided by the opponents showing sales figures in the UK and Ireland (not disaggregated), results of a survey of brand awareness and results of a survey of recognition of Schott product trade marks by United

5 Kingdom customers. The sales figures and promotional expenses are given as follows:

		“Thousands of pieces”	“Thousands of DM”	“Promotion expenses” (thousands of DM)
10	1990	193,7	17.110	-
	1991	177,5	15.695	500
	1992	175,5	15.438	46
	1993	141,7	12.671	50
	1994	116,1	10.277	96
15	1995	97,1	8.790	236

Mr Gold concludes from the survey figures (which I need not reproduce here) that there is a very high degree of awareness of the CERAN brand.

20 He goes on to say that in March 1995 he had a search conducted in Class 11 to establish the number of UK registrations which (a) have the prefix CERA-; (b) but do not belong to the Opponent; (c) and relate to cooking appliances; and (d) do not include wholly disclaimed words such as “CERAMICS”. On this basis, he believes that the only possibly relevant registrations, in the ownership of two different third parties, are numbers 1 441 951
25 CERAMALLOY and number 1 017 052, CERASINT. He exhibits the relevant search report (TZG5). However, the Opponent has not come across the use of cooker appliances or ceramic cooktop hobs or panels bearing those marks.

Mr Gold concludes in the light of all this that retail users and the trade have come to associate
30 the mark CERAN and the prefix CERA- with the opponents in relation to ceramic cooker hobs and panels. Furthermore because heating rings “glow” customers seeing the mark CERAGLOW would think they are purchasing the opponents’ goods. For reasons, therefore, of similarity of the respective trade marks, the potential for confusion and deception and lack of bona fides he says that the applicants have not discharged the onus on them to show why
35 the mark should be registered.

Applicants’ evidence

40 The applicants filed two statutory declarations. The first, dated 2 December 1996 comes from Peter Charles Turner, their representative in trade mark matters.

Mr Turner says that, like Mr Gold, he too arranged for a search for CERA- prefixed marks registered in Class 11. He exhibits (PCT/1) a copy of his instructions and the listing produced as a result of the search. He says that the listing shows some 30 CERA- marks in
45 Class 11 and suggests that this shows it to be a popular prefix.

Adopting Mr Gold's criteria in analysing the search results (as outlined above) Mr Turner says in addition to the marks CERASINT and CERAMALLOY (referred to by Mr Gold as not being in the opponents' ownership) there are also:

5	No 1043332	CERAMASPEED	(Ceramaspeed Ltd)
	No 1572426	CERANOX	(Robert Bosch GmbH)
	No 1522429	CERAMINI	(Robert Bosch GmbH)
10	No 1522431	CERAPUR	(Robert Bosch GmbH)

He says that he includes the latter three because their specifications cover "gas burning apparatus", a term which he takes to encompass gas cookers and the like. Thus there are, he says, at least three parties owning CERA- prefixed UK registrations covering cooking appliances. Widening Mr Gold's criteria to cover heating apparatus (on the basis that cooking involves heating) produces three more.

The second declaration, dated 3 January 1997, comes from Roger Derek Taylor who is the marketing manager for built-in appliances (including cooking appliances) in the Zanussi division of Emaco Ltd, a major UK trading subsidiary of Aktiebolaget Electrolux. He has been in his current post for three years and in the cooker field since 1985. He firstly describes the internal corporate arrangements of his company and says he is authorised by Zanussi to make his declaration.

He goes on to describe the extent and nature of Zanussi's activities in Italy and the United Kingdom. The company's annual UK turnover in Zanussi branded items amounts to some £155 million. Zanussi Italy has been selling ceramic cooking hobs and ceramic top cookers since 1979. Until recently the Opponents (he refers to them as Schott) were the only available source of the ceramic glass necessary to produce these particular hobs and cooker tops. However an alternative source, Eurokera, became available two or three years ago and currently supplies of ceramic glass for "Zanussi" ceramic hobs and ceramic top cookers are obtained from both sources. He is aware that Schott use the trade mark CERAN for the ceramic glass which they supply.

Mr Taylor says that late in 1993 Zanussi UK was engaged in looking for a new trade mark for use in connection with a range of ceramic hobs and ceramic top cookers due to be launched in the course of 1994. The hobs and cookers themselves were to be branded ZANUSSI but the company were seeking a sub-brand which could be used in referring to the heating zones in those hobs and cookers. They eventually settled on CERAGLOW - "CERA" alluding to "ceramic", and "GLOW" referring to the appearance of the heating elements when hot. Zanussi Italy applied for registration of the new mark on 29 April 1994 and the range of hobs and cookers incorporating CERAGLOW heating zones was launched in June 1994. Since then some 11,000 such hobs have been sold and approximately 7,000 such cookers in the United Kingdom at a total retail sales value of about £10 million. He exhibits (RDT/1) a leaflet illustrating the range.

Approximately 350,000 such leaflets have been printed and distributed to date at a cost of £40,000.

Mr Taylor then comments at length on Mr Gold's declaration. The main point he makes are that:-

- use of the opponents' CERAN mark is acknowledged but Mr Taylor is not aware of their use of any other CERA- prefixed marks. Nor in his view is there anything to support the view that the opponents' other marks have any degree of public recognition.
- he questions references to the opponents' selling hobs. So far as he is aware the opponents use CERAN only for their heat-resistant glass products. Such products include panels of ceramic glass for making up into hobs along with other items such as heating elements and controls.
- he comments on the sales figures and brand awareness/recognition figures relating to the opponents' CERAN mark as contained in Mr Gold's Exhibit TZG4. I do not need to summarise these comments here.
- he offers further observations on the opponents' claimed family of marks and says that they only use CERAN. Moreover the opponents are not the only people using a CERA- prefixed mark. According to Mr Taylor the mark CERAMASPEED has been used for a number of years in relation to ceramic hotplates and ceramic heating elements.
- he says that, despite Zanussi having used the mark since June 1994, no actual instances of confusion have been reported.
- he firmly rejects Mr Gold's suggestion that the applicants' mark was applied for in bad faith. He says that the applicants wanted "to coin a new trade mark which reflected both the basic material used (a ceramic) and the appearance of red-hot heating elements: hence CERAGLOW".

Opponents' evidence in reply

The opponents filed evidence in reply in the form of an affidavit dated 9 April 1997 from Wolfgang Wentzel who is employed by Schott Glaswerke as a corporate lawyer and Head of the Trademark Department. He is conversant with the English language and has read the preceding declarations.

He comments as follows:-

"Concerning Paragraph 14 of the Declaration of Roger Derek Taylor, whilst absence of confusion between CERAN and CERAGLOW in general is expressly refuted, any lack of confusion in practice may be explained by the fact that, as Mr Taylor points

5 out, the mark CERAGLOW is always used as a sub-brand only, in conjunction with
the distinctive name ZANUSSI in relation to ceramic top cookers and ceramic hobs.
The opposed application however is in respect of the word CERAGLOW on its own.
A further factor restraining confusion is that Schott sells its CERAN products as parts
10 for cookers to hob manufacturers such as Bosch, Siemens, AEG, etc, whereas Zanussi
sells its CERAGLOW products directly to consumers. However, registration of the
mark applied for would confer on Zanussi the right to use the mark CERAGLOW
(solus) in relation to glass ceramic cook top panels similar to those provided by Schott
and even license our competitors, Eurokera, to use the CERAGLOW mark and in
15 these events confusion between the respective marks CERAN and CERAGLOW
would be inevitable.

15 With reference to Paragraphs 7 and 12 of Mr Taylor's Declaration, I can confirm that
Schott Glaswerke use both the trade marks CERAN and CERAQUICK as a family of
marks in the UK in the context of ceramic hobs/glass panels and products for use with
hobs/glass panels.

20 With regard to Paragraph 13 of Mr Taylor's Declaration, the company called
Ceramasppeed is, to my knowledge, only using the mark CERAMASPEED in the
context of electrical heating components to be fitted under ceramic hotplates and
never in relation to ceramic hotplates or glass panels as such. This would explain the
absence of confusion between the respective marks CERAGLOW/CERAN and
CERAMASPEED."

25 The remainder of his declaration is given over to comments on each of the "CERA" marks
contained in Exhibit PCT/1 of Mr Turner's declaration. I do not propose to review all this
material here but will draw my own conclusions when dealing with my decision. I should
however comment that in respect of three marks owned by Robert Bosch GmbH the
opponents say they have a "pre-rights declaration" to exclude cooking apparatus.

30 Opponents' further evidence

A further affidavit dated 29 December 1997 by Wolfgang Wentzel was filed by the
opponents.

35 In summary his affidavit:-

- 40 - offers definitions of terms of art in the industry namely the terms "hob",
"cooker" and "panel".
- confirms that the opponents sell their CERAN panels to appliance
manufacturers including AB Electrolux of which Zanussi is a subsidiary. He
gives figures for deliveries to Electrolux which are generally in excess of
45 500,000 per annum.

- included in the above figures are panels supplied to a German company Electrolux Juno which is said to manufacture hobs and cookers bearing the trade mark ZANUSSI. These are fitted with CERAN panels. Thus both marks appear on the goods in the marketplace.

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- suggests that Zanussi market their hobs by reference to the particular qualities and characteristics of the panels with which they are fitted. He exhibits (WW1) an extract from Zanussi's 1995 catalogue showing a CERAGLOW halogen hob marketed with particular reference to its glass ceramic cooktop panel.

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- says that there is a "small but steady market" for replacement CERAN panels where the originals have been broken or scratched. CERAN panels intended for the replacement market are supplied by the opponents to AB Electrolux. In the UK panels for use with Zanussi hobs are supplied to a company called Distriparts UK Ltd and in the current year (up to 11 July 1997) some 50 such panels have been supplied to Distriparts.

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Applicants' further evidence

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Roger Derek Taylor has filed a further statutory declaration dated 3 April 1998 on behalf of the applicants. He comments on Mr Wentzel's affidavits.

In summary:-

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- he says that the opponents have provided no evidence to support their claim to have used the mark CERAQUICK in this country.
- he makes observations on Mr Wentzel's comments on the search results exhibited to Mr Turner's declaration. Again I do not think I need review these comments in detail in my evidence summary. In relation to the pre-rights declaration covering the three Bosch marks he says that the agreement to exclude "cooking apparatus" is not reflected in the specifications which cover, inter alia, gas burning apparatus.
- he takes issue with Mr Wentzel over certain aspects of the definitions offered.
- he says that Mr Wentzel's second affidavit makes it clear that the opponents manufacture panels for sale under the CERAN mark. There is no mention of their selling hobs. This, he suggests, contradicts Mr Gold's claims.
- he accepts that the opponents supply CERAN panels to AB Electronic but disputes the delivery figures which are considered to be too high.
- he clarifies issues relating to the use of the mark CERAGLOW in this country. In particular the mark is said to be used on free standing cookers, the panels

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for which are sourced from an alternative supplier (Eurokera). The mark is not used on built-in hobs, the panels for which bear the mark CERAN. Thus the applicants do not manufacture or market any appliance which carries both the CERAGLOW and CERAN marks.

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- he comments on Mr Wentzel's views on the way in which Zanussi market their hobs and also on the replacement market issue.

10 That completes my review of the evidence but I should record at this point that a request by the opponents for leave to file further evidence was dealt with as a preliminary point at the hearing. Briefly the opponents wished to file a copy (and translation) of the "pre-rights agreements" between the opponents and Robert Bosch GmbH. The applicants objected to this late request. I decided, after hearing the parties, that the further evidence should not be admitted. In addition to the normal evidence rounds both sides have already filed a round of
15 further evidence and it is very late in the day for yet more evidence to be introduced into the proceedings. In any case it seemed to me that the existence of the agreement had not been challenged. To the extent that this agreement between the opponent and a third party was relevant to the proceedings it was merely one of a number of issues that fell to be considered as a result of the register search each side had conducted. I did not therefore consider the
20 proposed further evidence to be of sufficient significance that it should be admitted. Nor in the overall context of the case did it seem that the opponents would be particularly prejudiced by my not admitting it.

25 At the outset Mr Morcom indicated that he would not be pursuing the grounds of opposition based on Sections 9, 10, 17 and 68 of the Act. Accordingly those grounds fall away. The matter, therefore, primarily falls to be decided under Sections 11 and 12 of the Act. These Sections read as follows:-

30 "11 It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

35 12 (1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

- 40 a. the same goods
- b. the same description of goods, or
- c. services or a description of services which are associated with those goods or goods of that description."

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The reference in Section 12(1) to a near resemblance is clarified by Section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

5 It was common ground at the hearing that the established tests for objections under these provisions are the ones set down in Smith Hayden and Company Ltd's application (Volume 1946 63 RPC 101) later adapted, in the case of Section 11, by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand, these tests may be expressed as follows:-

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(a) (under Section 11) Having regard to the user of the opponents' mark CERAN is the tribunal satisfied that the mark applied for CERAGLOW if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

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(b) (under Section 12) Assuming user by the opponents of their marks in a normal and fair manner for any of the goods covered by the registrations of those marks, is the tribunal satisfied that there will be no reasonable likelihood of deception among a substantial number of persons if the applicants use their mark CERAGLOW normally and fairly in respect of any goods covered by their proposed registration?

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Note I have expressed the Section 11 test in the above terms because the opponents' evidence of use relates to the mark CERAN. For Section 12 purposes the opponents' marks are those referred to at the start of the decision.

I will deal firstly with the position under Section 11.

On the basis of the evidence it is possible to make certain clear findings:

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- the only one of the opponents' marks on which use has been shown is CERAN. The opponents say they have used CERAQUICK but have not substantiated the claim nor is it clear how this Class 8 registration is relevant to these proceedings.

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- the mark (CERAN) is used on and in relation to glass ceramic panels for use in hobs and cookers.

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- there has been a reasonably substantial amount of use and the mark appears to command a high degree of recognition amongst the manufacturers to whom the panels are supplied.

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- the opponents' goods are sold, inter alia, to companies in the AB Electrolux group associated with the applicants for incorporation into hobs and cookers (there is some slight disagreement as to sales volumes but the fact that such trade occurs is not in dispute).

- there is a small replacement market for ceramic panels.

There are a number of areas of disagreement. There has been some debate in the evidence as to the meanings to be ascribed to the terms “panels”, “hobs” and “cookers”. Given the specification applied for and the nature of the Section 11 test (see also below) I do not think much turns on this point. Mr Arnold submitted at the hearing that what the evidence showed was trade recognition of the CERAN mark and that there was no evidence as to consumer (in the sense of end customer) recognition. He actually went further than this and suggested that consumers would place no reliance on the brand name of the panel but instead would purchase on the basis of the brand name of the hob or cooker. The point could arise, I suppose, either at the time of purchasing a new cooker (if, that is, the type and quality of panel is a selling point) or, more likely perhaps, when a replacement part is being ordered. Either way I do not think I can decide this point as there is no evidence as to customers’ views. Nor do I think I should approach the matter solely on the basis of whether or not customers have regard to the brand of panels. Mr Morcom was in my view quite correct to say that it is not what the applicants are doing but what they can do that is relevant. He referred me also to a passage in Jellinek’s application (the PANDA case) 1946 RPC 59 at page 78 lines 20-33. It is worth remembering at this point that the applicants’ specification covers not only cookers but also parts and fittings. It follows from this that, whilst I note the comments in Mr Taylor’s second declaration about how the mark CERAGLOW is currently used (on free standing cookers) I must for the purposes of the Section 11 test consider all the possibilities that might be open to the applicants in terms of normal and fair use in relation to the goods covered by their specification. (Mr Morcom was in any case inclined to question the reasons behind the applicants’ current pattern of use. However Mr Taylor has been quite open about the applicants’ current business practice. I do not think I can draw any adverse conclusions from the evidence or the exchanges at the hearing in relation to the point). With the above comments and circumstances in mind I go on to consider the marks themselves.

This is a case where both sides have filed a considerable body of evidence and analysis based on the state of the register. Each side seeks to draw from it conclusions that are helpful to their cause. Put briefly the applicants say that CERA- alludes to ceramic and this has descriptive connotations. Hence its popularity in relation to goods in Class 11. The opponents on the other hand question the basis of this claim and say that in any case they have a number of CERA- prefixed marks and that there are only a few such marks in third party ownership in the cooking apparatus field and there is no evidence that these marks are being used on appliances, hobs or panels.

The search report exhibited by Mr Gold lists well over 40 CERA- marks in Class 11. Details of potentially relevant registrations are given. Mr Turner, for the applicants, has provided details of some 30 cases drawn from the search he commissioned.

I draw the following points from the material supplied:

- CERA is a popular prefix in Class 11.

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- many of the specifications of the marks for which registration details are given specifically refer to “ceramic” (thus for instance the opponents’ CERAN mark is registered for “glass-ceramic hob plates and panels”). Almost all the registered marks have specifications covering equipment (kilns and furnaces etc) for producing ceramic goods or are goods which can be in ceramic form (cooking apparatus, sanitaryware, washhand basins, filaments etc).
- within the narrower area of cooking apparatus the parties have identified, in addition to their own marks, CERASINT, CERAMALLOY and CERAMASPEED though it is suggested that the first of these may now have lapsed.
- a number of other lapsed registrations CERABEL, CERAFLON, CERALIT also specifically covered cooking related apparatus.
- the Bosch registrations about which there has been some debate do not appear to be of particular significance given the areas of interest suggested by their specifications taken as a whole.

Whilst it is not suggested that CERA is a known abbreviation it seems to me to be an inescapable conclusion that when used as a prefix it is intended to allude to ‘ceramic’ and is likely to be so recognised by customers (the trade literature filed by both sides makes clear that hobs are advertised as being of the ceramic type).

Arising from this the applicants say that, where an element of a mark is descriptive or at least alludes in some way to a characteristic of the goods, this must reduce the impact of the element concerned in the overall appreciation of the mark. Mr Arnold referred me to two cases in support of this view. The first is F W Waide & Co Ltd’s application 1916 RPC 320 where the High Court upheld the decision of the Registrar to allow the mark ANCHOLA on to the register in the face of ANCHOVETTE (registered for, inter alia, fish pastes). The common stem ANCHO picked up the first two syllables of the word “anchovy”. Younger J quoted with approval the following extract from the Registrar’s decision:-

“The case simply turns on whether the two words resemble one another to such an extent as to be liable to deceive the trade and public having regard to all the circumstances of this case. In a case of this kind, where comparison is to be made between two words, it is difficult to get any assistance from reported cases. I have come to the conclusion that the words looked at as a whole are sufficiently unlike, and that no reasonable person ought to be so deceived by their resemblance as to accept the goods of the Applicants for those of the Opponents. I do not think that anyone can claim the monopoly of the prefix ‘Ancho’, which is clearly connected with the word ‘Anchovy’. The words, therefore, have to be looked at as a whole, and the suffixes in these two cases are widely different both in spelling and in sound.

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.....

5 The case, therefore, as I have already said, turns upon the comparison of the two words, and, on the best consideration I can give, I do not think that the Applicants' Mark, if registered would be likely to cause deception or confusion in the ordinary way of trade."

10 The F W Waide case was also referred to in a more recent case, Perfetti SpA v Warner Lambert Company, a High Court decision (unreported at the time of writing) allowing an appeal against the Registrar's refusal to allow the mark CHLORALIT in the face of the mark CLORETS. Laddie J said:-

15 "I do not understand Mr Tritton [Counsel for the respondents/opponents] to dispute that where a part of a mark is descriptive or suggestive it should be given less emphasis than when it is entirely artificial."

and

20 "Mr Alexander [Counsel for the appellants/applicants] relies on this. He says that, up to that stage of his decision, Mr Harkness has come to the right conclusion, namely that prima facie these marks are neither phonetically or visually confusing. He says furthermore that the "chlor" part of the marks must be down played a bit because in each case it refers to the fact that the product is said to have properties of chlorophyll, an ingredient which is added frequently to products to give a taste of freshness or
25 cleanliness. So, Mr Alexander says, the "chlor" part of these marks should be given less emphasis. He says that Mr Harkness is right, that visually the marks are different and phonetically members of the public would be likely to consider that on the whole these marks are sufficiently different not to be confused."

30 and

35 "It is undoubtedly true, at least on the evidence before Mr Harkness and before me, that there is no other company selling chewing gum which incorporates "chlor" or "clor" in its trade mark. However, it is also true, as appears from the evidence and as I think I can take on board as a matter of judicial notice, that chlorophyll is used on labels of chewing gums and similar products and is used to designate, as I have already mentioned, freshness and cleanliness."

40 I should say that this latter decision is understood to be the subject of an appeal. Subject, however, to that cautionary comment it appears to represent a continuation and acceptance of the reasoning set down in relation to F W Waide & Co Ltd's application. Mr Morcom on the other hand drew my attention to the reference to the Harrods case in Chapter 17-12 of Kerly's Law of Trade Marks. As Mr Arnold relied on an earlier passage from Chapter 17-12 it is
45 convenient to quote the full text as follows:-

5 In *Broadhead*, Evershed M.R. followed the observations of Lord Russell in
Coca Cola Canada v. Pepsi Cola Canada, where he stated: “Where you get a
common denominator, you must in looking at the competing formulae pay
much more regard to the parts of the formulae which are not common -
although it does not flow from that that you must treat the words as though the
common part was not there at all.” Where common marks are included in the
trade marks to be compared, or in one of them, the proper course is to look at
10 the marks as wholes, and not to disregard the parts which are common.

15 In the “*Kleenoff*” case, Maugham L.J. said: “In the present case my view is
that the test of infringement where the trade mark has a descriptive element is
the same as the test where it has no descriptive element, except so far as the
descriptive element is itself common to the trade.”

20 In *Harrods*, the Registrar stated: “It is a well-recognised principle that has to
be taken into account in considering the possibility of confusion arising
between any two trade marks, that, where those two marks contain a common
element which is also contained in a number of other marks in use in the same
market, such a common occurrence in the market tends to cause purchasers to
pay more attention to the other features of the respective marks and to
distinguish between them by those features. This principle clearly requires
that the marks comprising the common element shall be in fairly extensive use
and, as I have mentioned, in use in the markets in which the marks under
25 consideration are being or will be used.”

30 “It is not right to pull the words to pieces, ACCU- for one part and - IST and
-LARM for the other part, next to argue that ACCU reminds you of
“accurate”, no matter what the suffix, and to conclude that the upshot will be a
monopoly in the natural word”: *per* Harman L.J. in *Accutron*.”
(reference to footnotes omitted).

35 I take these submissions and authorities into account in coming to a view on the case before
me. There is no evidence before me to indicate how the trade or public view CERA- prefixed
marks in relation to cooking apparatus. It is not disputed that, in addition to the parties’
CERAN and CERAGLOW marks, the mark CERAMASPEED is also in use in relation to
heating elements for ceramic hot plates. The clear import of the evidence filed is that CERA-
is likely to carry descriptive connotations in relation to the goods at issue. In these
40 circumstances I think it would require some clear evidence to the contrary from the opponents
before I would be persuaded that the trade or public would see the element CERA- as
indicating a trade connection with the opponents rather than simply as an indication of the
nature of the goods. In my view, therefore, Mr Gold was going too far in suggesting that
retail users and the trade would associate the prefix CERA- (as opposed to the mark CERAN)
45 with the opponents.

In the final analysis, of course, I must consider the marks as wholes. The composition and appearance of the marks is in my view different. CERAN is a two syllable word with the emphasis likely to be on the second syllable (pronounced, I think, as a long A sound).

CERAGLOW on the other hand has three syllables with the stress most likely to be on the first syllable. Furthermore CERAGLOW has the additional feature of incorporating a recognisable word (GLOW) as its final element. All of this leads me to the view that there is unlikely to be a real tangible risk of confusion even allowing for the fact that the respective marks could be used in close proximity. Nor in my view can the applicants be said to have 'taken' the established mark CERAN. The opposition, therefore, fails under Section 11.

I think it is fair to say that Mr Morcom relied principally on Section 11 but for the sake of completeness I go on to consider the position under Section 12 taking account of the opponents' registrations as set out at the commencement of this decision. Although Mr Gold's evidence referred at one point to the opponents having a family of CERA- marks Mr Morcom did not pursue the point at the hearing and, as it is only the mark CERAN on which use has clearly been demonstrated, the claim could not be sustained (see the BECK KOLLER case 1947 RPC 76 particularly at page 83 lines 26 to 56). I must, therefore, consider the mark applied for against each of the opponents' registrations in turn. With the exception of Registration No 1234628 (see below) it is not disputed that the same goods and/or goods of the same description are involved.

The conclusion that I have already reached in relation to the prefix CERA- applies equally to the position under Section 12. I have dealt with the comparison between CERAGLOW and CERAN under Section 11 and have no reason for coming to a different view under Section 12 even allowing for the full range of goods covered by the CERAN registration. It follows that the mark CERAN SCHOTT TOPVIEW and device (No 1573142) is also of no assistance to the opponents. The mark CERAX (No 1120407) is also so different visually and phonetically from the applicants' mark that I see no danger of confusion.

The series mark CERATOP, CERA-TOP (No 1331204) highlights the CERA element rather more and combines it with the word TOP which must in itself be meaningful in relation to the goods (I note that the specification includes "cooktops"). The applicants' mark CERAGLOW is similarly constructed of elements which allude to characteristics of the goods. In these circumstances, as already indicated, care has to be taken not to unduly broaden the area of protection around the registered mark. Taking the marks as wholes I find them to be easily distinguishable and bearing in mind the circumstances under which such goods are likely to be purchased I think it unlikely that a substantial number of people will be confused. Similar considerations apply to the mark CERAQUICK (No 1234628). This registration is in any case in Class 8 and, quite apart from the differences in the marks, it has not been demonstrated that goods of the same description are involved. That leaves the mark CERAMATIC (No 1417622). I find this mark to be even further distanced from the applicants' mark both in construction, appearance and sound. Bearing in mind also that the mark CERAMASPEED (in third party ownership) appears also to be in use and living with CERAMATIC for closely associated goods I cannot see that the registration can form the basis of a successful opposition. In short the opposition under Section 12 fails.

Finally there is the matter of the Registrar's discretion. Mr Morcom reminded me again of the circumstances surrounding trade in these goods including the replacement part market. In my view these issues have been considered under Section 11 and I cannot see that there is anything in the circumstances of the case which suggests I should come to a different view and exercise discretion against the applicants. I therefore decline to do so.

As the opposition has failed the applicants are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £900.

10 Dated this 28th day of July 1998

15 **M REYNOLDS**
For the Registrar
the Comptroller General