

O-213-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2538478
BY THOMAS PLANT (BIRMINGHAM) LIMITED
TO REGISTER:**

HOME MADE

&

home made

**AS A SERIES OF 2 TRADE MARKS IN
CLASSES 8, 9, 16 & 21**

AND:

**OPPOSITION THERETO UNDER NO. 101037
BY 151 PRODUCTS LIMITED**

BACKGROUND

1. On 8 February 2010, Thomas Plant (Birmingham) Limited ("Plant") applied to register the series of two trade marks shown on the cover page of this decision. The application was accepted and published for opposition purposes on 2 July 2010 for a range of goods in the classes mentioned including the following in classes 8 and 21:

8 - Mortars and pestles; hand tools and implements (hand operated); cutlery; bottle and jar openers (hand operated), hand-operated mandolines; food mashers (hand implements); cutters, chippers, slicers; peelers, corers, tongs for food, skewers, knife holders; knives, kitchen knives, forks, spoons, pizza slicers; cake slicers, spatulas, pasta cutters; BBQ tools; mandolines; scissors, scissor-sharpening apparatus, knife sharpening apparatus; ice crushers; cooks' blowtorches and burners (hand operated), parts, fittings and accessories for all the aforesaid goods.

21 - Household or kitchen utensils (not of precious metal or coated therewith); butchery blocks; chopsticks; brushes (except paint brushes); unworked or semi-worked glass (except glass used in building); kitchen stands and cutlery drainers; glassware; strainers and straining kits for jam-making; straining bags; stoneware; bakeware; porcelain and earthenware not included in other classes; cookware; stainless steel, aluminium, tri-ply, copper, hard anodized aluminium, cast-iron and cast aluminium cookware; food graters, shredders, pressers, presses, rolling pins and pastry boards, chopping boards, buckets, roasting racks and cooling trays; toaster bags; table mats; food scrapers; trays, trivets, ice cream scoops, cast-iron cookware, oven gloves, fruit squeezers; spice racks; mincers (non- electric); biscuit/tea/coffee jars; kitchen utensil holders; cups, plates, dishes, serving bowls, mixing bowls, basins, mugs, frying pans, roasting pans, grill pans, steamers, casseroles, poachers, stockpots, roasting dishes, saucepans and woks; ceramics, mills for domestic purposes, drainers, salt and pepper mills and salt and pepper shakers; food-warming stones; bread-warming stones; hand-operated food processors; juice pressers, corkscrews; bottle-openers; jar-openers; drainers, sieves and colanders; food mashers; garlic presses; fruit reamers; teapots, coffee pots, jugs, measuring jugs and utensils; blanching baskets, chip baskets, wine coolers, butter curlers and ballers; kitchen/recipe/cookery book stands; corn-on-the-cob holders and plates; skewers, orange and lemon zesters; food scoops, basting brushes, food whisks and beaters; brushes for food; eggcups and plates; icing sets, cake-servers and cutters, icing syringes; food piping sets; pots, covers for food; egg separators; toast racks; flour/sugar sprinklers; butter dishes; egg poachers; steamers, woks (non-electric); kettles (non-electric); bread bins and breadboards; funnels, water-carriers; gloves for household purposes; trivets and silicone trivets; wine coolers; pastry cutters; garlic presses; mug trees; melamine, polycarbonate and acrylic cutlery, plates, bowls, drinking vessels, cups, dishes, jugs and mugs; spice bags and spice balls; kitchen splatter guards; honey dippers; egg rings; parts, fittings and accessories for all the aforesaid goods.

2. On 4 October 2010, 151 Products Limited (“151”) filed a notice of opposition. 151’s opposition is based upon a single ground under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) for which it relies upon the following trade mark registration:

UK no. 2316280 for the trade mark **HOME MAID** applied for on **20 November 2002** and registered on **16 May 2003** for the following goods:

8 - Domestic hand tools and utensils; cutlery, knives, forks and spoons; disposable cutlery, knives, forks and spoons; scissors.

21 - Household and kitchen implements, utensils and containers; cookware, bakeware, roastware; articles and materials for cleaning, washing, dusting, scouring or polishing; brushes, mops, carpet sweepers, carpet cleaners; glassware, porcelain and earthenware; crockery; disposable plates, dishes and cups; plates, dishes and cups made of paper, plastic or non-precious metals.

3. Having explained that it relies upon (and has used) all of the goods for which its trade mark is registered, in response to question 4 of the notice of opposition which reads: “Which goods or services in the application do you claim are identical or similar to those covered by the earlier mark...”, 151 checked the box which reads “Some (please specify)” and said:

“Those in classes 8 and 21 namely:

Class 8: Hand tools and utensils; cutlery, knives, forks and spoons; scissors.

Class 21: Household or kitchen utensils; brushes; glassware; porcelain and earthenware; cookware; food graters, shredders, pressers, rolling pins and pastry boards, buckets, roasting racks and cooling trays; kitchen utensil holders; cups, plates, dishes, serving bowls, mixing bowls, basins, mugs, frying pans, roasting pans, grill pans, steamers, casseroles, poachers, stockpots, roasting dishes (sic), saucepans and woks; juice pressers, corkscrews; bottle-openers; jar-openers; sieves; food mashers; garlic presses; teapots, coffee pots, jakes (sic), measuring jugs and utensils; but her (sic) curlers and ballers; corn-on-the-cob holders and plates; skewers; food scoops, basting brushes, food whisks and beaters; brushes for food; A cups (sic) and plates; icing sets, cake-servers and cutters; potts (sic), covers the food (sic); bread bins and breadboards; pastry cutters; garlic presses; mug trees; melamine, polycarbonate and acrylic cutlery, plates, bowls, drinking vessels, cups, dishes, jugs and mugs.”

And:

“The presence in the earlier mark of the opposed mark, when applied to identical and to similar/related goods creates a likelihood of confusion. The names are

very similar and sound identical, and when applied to identical and to similar/related products are likely to cause confusion...”

4. 19 April 2012, Plant filed a counterstatement. In its counterstatement Plant said:

“1. Formal proof of use [of 151’s trade mark] is hereby requested. Specifically, use of the HOME MAID word mark is requested to be proved...”

2. It is not disputed that there is a degree of similarity between the marks...Similarly, [Plant] do not dispute that there is some overlap (in the opposed classes – 8 and 21) between the goods applied for and those covered by [151’s trade mark]. However, [Plant] do not consider that the earlier word mark has been used as a trade mark [in the relevant period]. In the alternative, should trade mark use be shown of the earlier mark during the relevant period, [Plant] submit that this will only be in relation to a narrow subset of the registered goods and that the scope of the earlier registration should be reconsidered (for the purposes of this opposition, at least), accordingly.”

5. At the time of filing its counterstatement, Plant filed a Form TM21 which restricted its goods in classes 8 and 21 to the following:

8 - Mortars and pestles; bottle and jar openers (hand operated), hand-operated mandolines; food mashers (hand implements); cutters, chippers, slicers; peelers, corers, tongs for food, skewers, knife holders; pizza slicers; cake slicers, spatulas, pasta cutters; BBQ tools; mandolines; scissors, scissor-sharpening apparatus, knife sharpening apparatus; ice crushers; cooks' blowtorches and burners (hand operated), parts, fittings and accessories for all the aforesaid goods.

21 - Household or kitchen utensils (not of precious metal or coated therewith and not of plastic); butchery blocks; chopsticks; unworked or semi-worked glass (except glass used in building); kitchen stands and cutlery drainers; glassware; strainers and straining kits for jam-making; straining bags; stoneware; bakeware; porcelain and earthenware not included in other classes; cookware (not being disposable and not being for microwave use); stainless steel, aluminium, tri-ply, copper, hard anodized aluminium, cast-iron and cast aluminium cookware; shredders, pressers, presses, rolling pins and pastry boards, chopping boards, buckets, roasting racks and cooling trays (not being disposable); toaster bags; table mats; food scrapers; trays, trivets, ice cream scoops, cast-iron cookware, oven gloves, fruit squeezers; spice racks; mincers (non- electric); biscuit/tea/coffee jars; kitchen utensil holders; non-disposable cups, non-disposable plates, non-disposable dishes, non-disposable serving bowls, mixing bowls, basins, frying pans, non-disposable roasting pans, non-disposable grill pans, steamers, non-disposable roasting dishes, saucepans; ceramics, mills for domestic purposes, drainers, salt and pepper mills and salt and pepper shakers; food-warming stones; bread-warming stones; hand-operated food processors;

juice pressers, corkscrews; bottle-openers; jar-openers; drainers, sieves and colanders; food mashers; fruit reamers; teapots, coffee pots, jugs, measuring jugs and utensils; blanching baskets, chip baskets, wine coolers; kitchen/recipe/cookery book stands; orange and lemon zesters; food scoops, icing syringes; food piping sets; pots, covers for food; egg separators; toast racks; flour/sugar sprinklers; butter dishes; egg poachers; steamers, woks (non-electric); kettles (non-electric); funnels, water-carriers; gloves for household purposes; trivets and silicone trivets; wine coolers; pastry cutters; spice bags and spice balls; kitchen splatter guards; honey dippers; egg rings; parts, fittings and accessories for all the aforesaid goods.

6. Of these restrictions Plant says:

“3...As the registrar will note, all of the opposed goods in class 8 have been deleted, and significant amendments have been made to the goods in class 21. The opposition against class 8 is thus now redundant, and we submit that the opposition against class 21 should be rejected, in the light of any proof of use that may be filed, and in view of the restrictions made today.”

7. I note that although Plant asked for “scissors” to be removed from its specification in class 8 when it filed the Form TM21 on 19 April 2012, this request was incorrectly actioned by the Trade Marks Registry (“TMR”) and “scissors” remains in its specification in this class; I will return to this point below.

Scope of the opposition

8. In paragraph 3 above, I reproduced verbatim the wording used by 151 in its notice of opposition. Having explained that classes 9 and 16 of Plant’s application were not being opposed, 151 itemised the goods in classes 8 and 21 to which it objected. In its submissions Plant says:

“First, we remind the registrar that the opposition was filed against a subset of the goods applied for...”

And:

“Thus, class 8 must proceed to registration as now amended.”

Notwithstanding the above, it is clear from comments contained in both Mr Hilton’s witness statement (see below) and 151’s submissions, that Plant’s amended specification in classes 8 and 21 are still, in its view, objectionable. On 22 February 2013, I wrote to 151. In that letter I said:

“In box 4 of its notice of opposition 151 defines the scope of its opposition by reference to the phrase “Those in classes 8 and 21, **namely**” and then itemises a range of goods in each class. Plant reacted to this pleading in its

counterstatement and at the same time filed a form TM21 to restrict its application. A normal reading of the scope of the opposition in classes 8 and 21 is that it is restricted to the goods that are namely identified.

However, in both your witness statement and written submissions, you appear to be seeking total refusal of Plant's application in classes 8 and 21. Thus 151 is resiling from the position in its notice of opposition; there has, as far as I am aware, been no request by 151 to amend its pleadings.

You are allowed **14 days from the date of this letter** to comment on the above. Your letter should be copied to [Plant], who are allowed **a further 14 days from receipt by them of your letter** to provide any comments they may have."

9. 151 responded to the above in a letter dated 7 March 2013 (received by Plant on 8 March). Following an enquiry from the TMR, Plant responded to 151's letter on 3 April; 151 responded to that letter on the same day. I will return to this issue later in this decision.

10. Only 151 filed evidence. While neither party asked to be heard, Plant filed submissions during the evidential rounds and 151 filed submissions in lieu of attendance at a hearing; I will refer to these submissions as necessary below.

EVIDENCE

11. This consists of a witness statement dated 24 August 2012 (accompanied by exhibit MJH1 consisting of 82 pages) from Mark Hilton, a partner and solicitor at Hilton Law, 151's professional representatives. Mr Hilton's statement consists of a mixture of evidence and submissions. It is not appropriate for me to record his submissions here, but I will bear them in mind and, if necessary, refer to them later in this decision. Mr Hilton says:

"3. I am duly authorised by [151] to make this witness statement..."

And:

"4. I make this witness statement from the facts and matters within my own knowledge. Where I refer to facts and matters outside my own knowledge I identify the source of those facts and matters and confirm that such facts and matters are true to the best of my knowledge and belief. I confirm that those matters which are within my own knowledge are true to the best of my knowledge and belief.

5. I have taken my instructions in relation to (i) this statement and (ii) the application and the resulting opposition proceedings, from Steven Shonn, who is a Director of [151]. Mr Shonn has provided me with full details of [151's] use of its registered trade mark ("Home Maid") and of [151's] sales figures in respect of the

product range which it has manufactured, marketed and sold under the trade mark.”

Under the heading “Background and summary of events” (and erroneously also marked paragraph 4) Mr Hilton goes on to say:

“4. I have reviewed the Form TM8 and the counterstatement of [Plant], together with all other documentation between [Plant] and [151] in the course of these proceedings. I have also discussed the same at length with Mr Shonn.”

12. Mr Hilton explains that 151 began designing, manufacturing, marketing and selling products under the HOME MAID trade mark in 2003. He adds that 151 has supplied products under the HOME MAID trade mark to:

“stores around and throughout the United Kingdom including supermarket groups, discount stores and pound shops, general trade and independent retailers, and wholesalers.”

Sales of products sold under the HOME MAID trade mark have been as follows:

Year	Sales (£)
2003	44,000
2004	105,000
2005	202,000
2006	267,000
2007	344,997
2008	490,413
2009	665,250
2010	788,919
2011	724,487
2012	800,000 (projected)

13. Pages 13 to 82 of exhibit MJH1 consists of pages taken from 151’s Product Guides for the years 2007, 2008, 2009 and 2010. All of the pages are headed “kitchen accessories”. The following trade mark appears on the top of many of the pages, and although the photocopied pages provided are of poor quality, it also, I think, appears on the packaging of the majority of the goods themselves:



The following trade mark appears on pages 74, 76, 78 and 80 of the exhibit:



14. In his statement Mr Hilton identifies (i) 86 separate products sold under the HOME MAID trade mark in the 2007 product guide, (ii) 72 separate products in the 2008 guide, (iii) 64 separate products in the 2009 guide and 82 separate products in the 2010 guide. As the products listed in the 2010 product guide do not, it appears to me, differ to any significant extent from the products guides from earlier years, it is the 2010 guide that I shall refer to. This guide lists the following products: Paper bowls, paper plates, plastic bowls, plastic plates, disposable plates and bowls, plastic cups, foam cups, food storage containers, compartment plates, platter covers, foil dishes, cases, tins, platters, sheets, liners and trays, cake cases, straws, cooking liners, cooker hood filters, plastic knives, forks and spoons, stainless steel forks, knives and spoons, stainless steel ladles, spaghetti servers, skimmers, turners, mashers, strainers, bowls, trays, charger plates, paper doilies, barbeque brush sets, cocktail sticks and skewers.

15. That concludes my summary of the evidence filed to the extent that I consider it necessary.

DECISION

16. Before I deal with the substantive issues in these proceedings, there is one point I need to deal with first, albeit briefly. In its evidence and submissions, 151 states that Plant is both using its trade mark and, contrary to Section 95 of the Act, falsely representing that it is a registered trade mark (an example is provided at page 1 of exhibit MJH1). However, as this is not an issue before me, I need say no more about it.

17. Section 5(2)(b) of the Act reads as follows:

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

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

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

18. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

19. In these proceedings 151 is relying upon the trade mark shown in paragraph 2 above, which constitutes an earlier trade mark under the above provisions. Given the interplay between the date on Plant’s application was published i.e. 2 July 2010 and the date on which 151’s registration completed its registration procedure i.e. 16 May 2003, 151’s registration is subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004. As I mentioned above, in its counterstatement Plant asks 151 to provide evidence that it has used its earlier trade mark on all the goods upon which it relies in these proceedings. The relevant sections of the Proof of Use Regulations read as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Proof of use

20. In reaching a conclusion on this point, I must apply the same factors as I would if I were determining an application for revocation of a trade mark registration based on grounds of non-use; the relevant period for present purposes is the five year period ending with the date of publication of Plant’s application for registration i.e. 3 July 2005 to 2 July 2010. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch) Arnold J commented on the case law of the Court of Justice of the European Union (CJEU) in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-*

Strickmode GmbH [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

"(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(3) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(4) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine

commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”

21. In its submissions, Plant argues that as 151’s evidence in these proceedings was filed by its solicitor (Mr Hilton) rather than a director of 151, the weight given to that evidence “should be greatly diminished”. In its written submissions, 151 responded to this point in the following terms:

“6...in a witness statement made by a solicitor and partner in the firm of Hilton Law who acts for [151] in this matter (as well as in many other matters for [151]). The information and evidence was provided to Hilton Law by a director of [151], Steven Shonn, and Mr Hilton’s witness statement is endorsed with a statement of truth...”

7. In fact, the suggestion that [151’s] evidence...is in any way questionable...would likely be considered a contempt of court were a similar assertion made in court proceedings. [Plant’s] implication appears to be that the evidence is false, and [151] and its solicitors take exception to [Plant’s] comments in this regard.

9. The information and evidence is as correct, accurate and truthful as if a director of [151] had submitted the evidence him or herself...”

22. Notwithstanding 151’s comments above, the fact remains that some of 151’s evidence i.e. those facts outside of Mr Hilton’s own knowledge must be regarded as hearsay. The TMR’s approach to hearsay evidence is outlined in Tribunal Practice Notice (“TPN”) 5 of 2009 (albeit in the context of correspondence solicited for proceedings). This TPN makes it clear that hearsay evidence is admissible under rule 64(1)(b) of the Trade Marks Rules 2008 read in conjunction with section 1 of the Civil Evidence Act 1995 and in particular the following:

“4. Considerations relevant to weighing of hearsay evidence.

(1) In estimating the weight (if any) to be given to hearsay evidence in civil proceedings the court shall have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence.

(2) Regard may be had, in particular, to the following—

(a) whether it would have been reasonable and practicable for the party by whom the evidence was adduced to have produced the maker of the original statement as a witness;

(b) whether the original statement was made contemporaneously with the occurrence or existence of the matters stated;

- (c) whether the evidence involves multiple hearsay;
- (d) whether any person involved had any motive to conceal or misrepresent matters;
- (e) whether the original statement was an edited account, or was made in collaboration with another or for a particular purpose;
- (f) whether the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight."

23. 151's approach to its evidence i.e. Mr Shonn providing information to Mr Hilton rather than providing a statement himself, means that Mr Shonn cannot be cross examined. In estimating the weight to be given to Mr Hilton's evidence (some of which appears to be outside his own knowledge) whereas some (the product guides for example) consists of documentary evidence, I must keep in mind the factors mentioned above and that Mr Shonn has, it appears, been involved through the preparation of 151's case (including its evidence). Although it would have been preferable for Mr Shonn to have provided a witness statement himself, given what appears to be his close involvement in the preparation of 151's case, I am prepared to give Mr Hilton's hearsay evidence based upon information provided to him by Mr Shonn considerable weight.

24. Turning to 151's use of its earlier trade mark, in its counterstatement Plant said:

"1. Formal proof of use [of 151's trade mark] is hereby requested. Specifically, use of the HOME MAID word mark is requested to be proved..."

In its submissions Plant went on to say:

"In simple terms, [151] has filed evidence in which the distinctive character of the registered mark has been significantly altered. No use of the earlier mark, exactly or substantially as registered has been shown. The Product Guides depict three different versions of the earlier mark. Two of these contain additional elements which clearly alter the distinctive character of the mark.

The first version of the earlier mark consists of the word Home in a bold simplistic font, with the word MAID depicted in a small typeface (and in capitals – MAID) and the two words are separated by a large and prominent horizontal spoon. As the word Home is twice the size of the word MAID, this is quite clearly intended to be the dominant feature of the mark, which can be contrasted to the mark applied for in which each element is of equal weight...The depiction of the word Home as the dominant element of the mark is further supported by the spoon which separates the two words, and of course, the visually arresting spoon device forms a dominant part of the mark in itself."

The trade mark Plant is referring to is as follows:



25. Plant goes on to say:

“The second version of the earlier mark...consists of a human figure holding a knife and fork, to the left of the underlined word “homemad”, with a spoon device appearing separating the “a” and “d”, with the word KITCHENWARE underneath in a smaller font. Without prior knowledge of the brand, the mark could easily be read as “homemald” or “homemad”. This version of the mark is actually coloured, although [151] has opted not to mention that.

Again, the distinctive character of the earlier mark has been altered.”

The trade mark Plant is referring to is as follows:



26. And finally, Plant say:

“The third version of the earlier mark...in relation (solely) to paper doilies. Here, the words Home and Maid are heavily stylised (in a swirly/ornate script) and the word COOKWARE appears beneath them, in a frame, connected to the stylised script. Again, this is a significant departure from the registered mark – and in any event only paper doilies are shown.”

As I am, given the quality of the evidence provided by 151, unable to discern the trade mark to which Plant refers, it cannot feature in my considerations.

27. In paragraph 24 above I reproduced Plant’s comment to the effect that 151 has provided no evidence of its trade mark being used in the form in which it is registered. In its written submissions 151 said:

“16...[151’s] trade mark (whilst it has appeared in different fonts on the packaging of the various products within the overall range covered by the trade mark) is a word mark represented in capital letters (as is clear from the registration)...”

And:

“Further and in any event, on the question of prior use, it is patently clear that the trade mark has been used continuously (and appropriately) since the trade mark was registered in May 2003...”

28. 151’s evidence indicates that in the period 2005 to 2010 it sold some £2.8m worth of goods in the UK under what it considers to be its trade mark (of course this figure needs to be reduced somewhat to take account of the fact that the relevant period began in July 2005 and ended in July 2010). Although it indicates that these sales were made to a range of supermarkets, discount stores, pound shops, general trade and independent retailers and wholesalers, none of its customers are identified nor does it provide, for example, copies of invoices issued to any of these customers. However, notwithstanding these omissions, when considered realistically and as a totality (and giving Mr Hilton’s evidence the weight I mentioned above), it is, I think, clear that in the relevant period 151 has made significant sales under a number of trade marks in relation to a range of goods which it describes in its product guides as “kitchen accessories” and which I have listed at paragraph 14 above. Despite Plant raising the issue of the form in which 151’s trade mark had been used in its counterstatement and again in its submissions filed during the evidence rounds, 151 did not file any evidence in response to these submissions (although it did provide the comments I have referred to above). As far as I can tell, the evidence provided by 151 does not contain any examples of its trade mark being used in the form in which it stands registered. In those circumstances, I need to decide whether the trade marks used by 151 constitute use in a form differing in elements which do not alter the distinctive character of its trade mark in the form in which it is registered.

Use in a differing form

29. The relevant case law focuses on the alteration of distinctive character. The Court of Appeal dealt with what I will refer to as use of “variant marks” in *Bud/Budweiser Budbrau* [2003] RPC 25. Of relevance are the statements of Lord Walker of Gestingthorpe where he stated:

“43. ...The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?”

44. The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry: ‘Bare ruin’d choirs, where late the sweet birds sang’ is effective whether or not the reader is familiar with Empson’s commentary pointing out its rich associations (including early music, vault-like trees in winter, and the dissolution of the monasteries).

45. Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of ‘whose eyes? - registrar or ordinary consumer?’ is a direct conflict. It is for the registrar, through the hearing officer’s specialised experience and judgement, to analyse the ‘visual, aural and conceptual’ qualities of a mark and make a ‘global appreciation’ of its likely impact on the average consumer, who: ‘Normally perceives a mark as a whole and does not proceed to analyse its various details.’ The quotations are from para [26] of the judgement of the Court of Justice in Case C-342/97 Lloyd Schuhfabrik Meyer GmbH v Klijsen Handel BV [1999] E.C.R. I- 3819; the passage is dealing with the likelihood of confusion (rather than use of a variant mark) but both sides accepted its relevance.”

30. Also of relevance are the comments of Sir Martin Nourse; he stated at paragraph 12:

“Mr Bloch accepted that, in relation to a particular mark, it is possible, as Mr Salthouse put it, for the words to speak louder than the device. However, he said that it does not necessarily follow that the entire distinctive character of the mark lies in the words alone. That too is correct. But there is yet another possibility. A mark may have recognisable elements other than the words themselves which are nevertheless not significant enough to be part of its distinctive character; or to put it the other way round, the words have dominance which reduces to insignificance the other recognisable elements....”

31. I must also keep in mind the comments of Mr Arnold QC (sitting as the Appointed Person) in *NIRVANA* and *Remus* Trade Marks (BL O/262/06 and O/061/08). In these cases Mr Arnold undertook a thorough analysis of the relevant case law, including judgments of the GC and CJEU, and he then put forward the following questions, the answers to which will assist in determining whether a variant form of use represents an acceptable variant (the text is from *NIRVANA* but it is also adopted in *REMUS*):

“33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the subquestions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not

registering the differences at all....”

32. The above case-law deals with the concept of variant marks. This is equally applicable in the context of proof of use, bearing in mind the analogous provision set out in section 6A(4)(A) of the Act.

33. Although in its submissions Plant refers to three versions of the trade mark being used by 151, as I mentioned above, I am only able to discern two; these are shown at paragraph 13 above. Of these two versions, it is, I think, fair to say that the overwhelming majority of use shown is of the first of these trade marks. This, then, is the answer to the first of the questions posed in *Nirvana* i.e. “what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period?”.

34. Insofar as the first part of the second question is concerned i.e. “what is the distinctive character of the registered trade mark?”, as the words HOME and MAID are presented on one line in the same size upper case letters, they are, in my view, likely to evoke the concept of a female servant (i.e. a maid) working in one’s home. As a consequence, the distinctiveness of 151’s registered trade mark lies in the totality rather than the individual elements of which it is made up. As to the second part of the second question i.e. “what are the differences between the mark used and the registered trade mark?”, insofar as the first version of 151’s trade mark is concerned, the word “Home” is presented in title case and is significantly larger than the word “MAID” which is presented in upper case below and to the right of the word “Home” but within the confines of the letters “me” in the word “Home”. These words, which are presented against a square black background, are separated by a horizontal spoon device which runs from the second stem in the letter “H” to the end of the letter “e” in the word “Home”; the bowl of the spoon extends further, from the right hand end of the handle.

35. I now turn to the final question i.e. “do the differences identified...alter the distinctive character...” In my view, neither the addition of a black background nor the presentation of the words “Home” and MAID” in different cases or on different lines is likely to effect the distinctive character of 151’s registered trade mark. However, the presentation of the word “Home” in significantly larger letters than the word MAID changes not only the visual appearance of the trade mark as registered (to one in which the word Home is clearly the dominant visual element), but it also, in my view, is likely to alter the average consumer’s perception of the trade mark from one which sends the conceptual message I have mentioned above to one that does not. In those circumstances, the distinctive character of 151’s registered trade mark will, in my view, be altered.

36. However, even if that conclusion is considered arguable, the differences I have already identified, even if considered insufficient on their own, will, when considered in combination with the inclusion of a stylised device of a spoon (which would, arguably, be distinctive for anything other than spoons) in circumstances in which the stylised device of a spoon forms an integrated part of the trade mark as used, also, in my view,

alters the distinctive character of 151's registered trade mark. Having reached that conclusion in relation to the first version of 151's trade mark that has been used, it will come as no surprise that I consider the even more significant differences (commented upon by Plant above) between the trade mark as registered and the form in which it has been used by 151 in the second version, will also alter the distinctive character of 151's registered trade mark. Having concluded that neither of the trade marks 151 has used falls within the provisions of section 6A(4)(a) of the Proof of Use Regulations, it is not necessary for me to consider what would constitute a fair specification as per the guidance in: *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, *Animal Trade Mark* [2004] FSR 19 and *Reckitt Benckiser (Espana), SL v OHIM*, Case T- 126/03.

151's opposition to Plant's application in classes 8 and 21 falls at the first hurdle.

Scope of the opposition

37. I referred to this issue in paragraphs 8 and 9 above. In its letter of 7 March 2013, 151 confirmed that its opposition was, in fact, directed against all of the goods in classes 8 and 21 of the application. 151 explained the approach it adopted when it completed its notice of opposition and apologised for any misunderstanding or confusion which arose from its approach. It asked, should it be necessary, for leave to amend its notice of opposition. In its (belated) response dated 3 April 2013, Plant argued that:

"It is quite improper and unfair for any party to "move the goal posts" during opposition proceedings, by expanding the scope of their case/attack, long after the original opposition has been filed",

and went on to say:

In that light, the phrase "those in classes 8 and 21, namely..." should be interpreted in the way it was originally intended – i.e. by reference to the *specific* list of goods which it preceded.

We should be grateful if the registrar/hearing officer would exercise common sense and discretion in this matter..."

151 responded to Plant's letter reiterating its request, if necessary, to amend its pleadings.

38. In its letter of 3 April Plant:

"As an ancillary point, we remind the hearing officer that the issue of what has been opposed may well be irrelevant, given our view that the earlier mark relied upon has not been properly/sufficiently used, in order for the opposition to be maintained."

39. Given the decision I have reached on the proof of use point, it is no longer necessary for me to decide this issue. Although Plant may have reacted differently had the scope of 151's opposition been made clear to it from the outset, the fact remains that Plant filed a form TM21 to amend its application and there is nothing before me to suggest that it is not content with its amended specifications. While I need take no further action in this regard, it will, however, be necessary (as per paragraph 7 above) for the TMR to take the appropriate action to amend Plant's specification in class 8 by deleting "scissors".

Overall conclusion

40. 151's opposition to Plant's application in classes 8 and 21 has failed. Plant's application will, in due course, proceed to registration for the goods in classes 9 and 16 as published, and, following the deletion of "scissors" in class 8 and subject to any appeal against this decision, for its amended specifications in classes 8 and 21.

Costs

41. Plant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. Using that TPN as a guide, I award costs to Plant on the following basis:

Preparing a statement and considering 151's statement:	£200
Considering 151's evidence:	£300
Written submissions:	£300
Total:	£800

42. I order 151 Products Limited to pay to Thomas Plant (Birmingham) Limited the sum of **£800**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 20th day of May 2013

C J BOWEN
For the Registrar
The Comptroller-General