

**O/228/18**

**TRADE MARKS ACT 1994**

**TRADE MARK APPLICATION No. 3175431**

**BY MR CHEF LIMITED**

**AND**

**OPPOSITION No. 407756**

**BY SHINE TV LIMITED**

## Background and pleadings

1. This is an opposition by Shine TV Limited (“the opponent”) to an application filed on 19<sup>th</sup> July 2016 (“the relevant date”) by Mr Chef Limited (“the applicant”) to register MISTER CHEF as a trade mark for:

“Baking tins and utensils, cake decorating, aluminium trays, silicone moulds, baby products, freezer products, cupcake carriers, chocolate mould, blenders; Aluminium bakeware; Aluminium cookware; Aluminium moulds [kitchen utensils]; Bakeware; Baking dishes; Baking tins; Baking trays made of aluminium; Baking utensils; Basting brushes; Cooking pans; Cooking pans [non-electric]; Cooking pot sets; Cooking pots; Cooking pots and pans [non-electric].”

2. The trade mark was published for opposition purposes on 5<sup>th</sup> August 2016.

3. The opponent opposes the registration of the trade mark on the basis of sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). This opponent relies on earlier trade marks UK 2118654, UK 2563306, EU 8316135 and EU 6952733. The earlier marks are comprised of the word MASTERCHEF. In fact UK registration 2118654 covers a series of three marks, including two with minor variations to the presentation of the word, i.e. MASTER CHEF & MasterChef.

4. All of the earlier marks, except UK 2563306, is registered in class 21. I note that both the earlier EU trade marks cover *kitchen utensils and containers (not of precious metal or coated therewith)*. Apart from UK 2563306, the opponent argues that the respective goods are identical or similar and that the marks are also similar. Therefore, there is a likelihood of confusion on the part of the public.

5. Additionally, or alternatively, the opponent claims that UK 2563306 is registered in class 41 and has a substantial reputation with the public for “*a television series in the reality genre in the field of cooking and food and presentation of competitions, games and studio entertainment.*”

6. According to the opponent, MASTERCHEF is heavily merchandised by the opponent and the public are therefore accustomed to seeing cooking goods related to the TV show. Consequently, the public may think that MISTERCHEF cooking goods are related to the MASTERCHEF TV show. Use of the contested mark would therefore (without due cause) take unfair advantage of the earlier mark.

7. Each of the earlier marks, except EU 8316135, was registered more than 5 years prior to the date of publication of the contested mark.

8. The applicant filed a counterstatement essentially denying the claims made and requesting that the opponent to provide proof of use. However, the applicant did not specify which trade marks were the subject of its request for proof of use, or in relation to which goods or services. The registrar therefore wrote to the applicant on 26<sup>th</sup> January 2017 requiring it to particularise its request for proof of use by 16<sup>th</sup> February 2017. The applicant failed to reply. The registrar sent a second letter on 10<sup>th</sup> April 2017 giving the applicant a further 7 days to particularise the request for proof of use. The applicant still did not respond. Both of the registrar's letters warned that a failure to particularise matters may result in the request for proof of use being struck out. Consequently, on 8<sup>th</sup> May 2017 the request for proof of use was struck out in accordance with Rule 62(3) of the Trade Mark Rules 2008.

9. This means that the opponent can rely on the registrations of its earlier MASTERCHEF marks in class 21 without having to show use of any of the marks in relation to the goods for which they are registered.

### **The evidence**

10. Only the opponent filed evidence. This consists of a short witness statement by Ms Sophie Harris, who is a Senior Legal and Business Affairs Executive of the opponent. Ms Harris says that MASTERCHEF is used for a TV competitive reality cooking show. It started in the UK in the 1990s and is now in its 21<sup>st</sup> season. The 2015 final of the competition had around 5 million viewers, around 25% of the TV viewing public. The 2014 final has nearer 6 million viewers. Other episodes of the

series have also attracted over 4 million viewers. There is also a Celebrity Masterchef, which also attracts audiences of 4 million or more.

11. Exhibit 5 to Mr Harris's statement show examples of MASTERCHEF merchandise, which she says indicates that the relevant public is familiar with cooking goods related to the TV show. The exhibit comprises two documents. The first is in French. It appears to show, inter alia, MASTERCHEF kitchen knives and crockery on sale. However, it is not clear where these goods were sold and there is nothing to indicate that any such offers for sale occurred prior to the relevant date in these proceedings. The second document is in English. It appears to be a presentation about merchandising MASTERCHEF goods. However, it does not show that any such goods were offered for sale prior to the relevant date in these proceedings (or at all).

## **Representation**

12. The opponent is represented by Chiever B.V. of the Netherlands. The applicant has no legal representation. A hearing took place on 27<sup>th</sup> March 2018. The opponent was not represented. It filed written arguments in lieu of attendance. The applicant was represented by Mr Charley Kish.

## **The section 5(2)(b) ground**

13. Section 5(2)(b) of the Act is 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, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

## Comparison of goods

14. At the hearing, Mr Kish stressed that the opponent did not trade in kitchenware or any other goods. In this connection, I note that (a) one of the earlier marks (EU 8316135) is not subject to proof of use because it had not been registered for 5 years by the relevant date, and (b) the applicant's request for proof of use (to the extent that it could have applied to the other earlier marks) has been struck out for lack of particularisation. In these circumstances it is necessary to consider all the earlier marks to have been used in relation to all the goods/services covered by the registered specifications. As Kitchen L.J. explained in *Roger Maier and Another v ASOS*:<sup>1</sup>

“78. ....the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

15. Mr Kish also attempted to draw a distinction between the applicant's goods, which he characterised as bakeware, and cookware which might more possibly be associated with the opponent's TV show. In fact the application overtly covers items of cookware, such as cooking pots. Further, it is not appropriate to draw a distinction as to the purpose to which the goods are intended beyond that which is apparent from the descriptions used in the application. So 'cooking pots' must be understood to cover all types of cooking pots, not merely those particularly suitable for use in

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<sup>1</sup> [2015] EWCA Civ 220

baking (if there is such a pot). Additionally, in *Gérard Meric v Office for Harmonisation in the Internal Market*,<sup>2</sup> the General Court stated that:

“29. ....the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM-Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

16. Therefore, to the extent that ‘bakeware’ constitutes a sub-category of ‘kitchen utensils and containers’, the goods must be considered identical.

17. It is sufficient for present purposes to compare the respective goods covered by the contested mark and those covered by EU 8316135. These are shown below:

Applicant’s goods	Goods covered by earlier marks
Baking tins and utensils, cake decorating, aluminium trays, silicone moulds, baby products, freezer products, cupcake carriers, chocolate mould, blenders; Aluminium bakeware; Aluminium cookware; Aluminium moulds [kitchen utensils]; Bakeware; Baking dishes; Baking tins; Baking trays made of aluminium; Baking utensils; Basting brushes; Cooking pans; Cooking pans [non-electric]; Cooking pot sets; Cooking pots; Cooking pots and pans [non-electric].	EU 8316135 MASTERCHEF  Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush making materials; articles for cleaning purposes; steel wool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.  UK 2118654 MASTER CHEF [Inter alia] Bowls, dishes, chinaware, earthenware, enamelware, pots, trays,

<sup>2</sup> Case T- 133/05

	kitchen tools; covers for dishes, lids for pots, pastry moulds.
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18. In my view, all of the applicant's goods bar one are examples of *household or kitchen utensils and containers (not of precious metal or coated therewith) and/or glassware, porcelain and earthenware not included in other classes*. The exception is *baby products*. I am not clear what these goods are in class 21. Mr Kish told me that they are containers for baby food. If that is right they would also fall within *household or kitchen....containers*. I conclude that all the goods covered by the contested mark must be considered as being identical to those covered by EU 8316135.

19. It is also clear that some of the applicant's goods are identical to some of the goods covered by UK 2118654 (which are also shown above). For example, *cooking pots and pans* are identical to *enamelware, pots*. And *kitchen tools* covers *baking utensils; basting brushes*.

#### Global assessment of likelihood of confusion

20. I am guided by the following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

#### *The principles*

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;



(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

#### Average consumer and the selection process

21. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.<sup>3</sup> I find that the average consumer in this case is likely to be either a professional cook/restaurant business or a member of the general public with an interest in cooking (or someone buying cookware/bakeware for such a person). The goods are not impulse purchases, but neither are they highly expensive or highly specialist goods likely to be selected with more care than normal. I therefore find that the goods are likely to be selected by consumers paying a normal degree of attention.

22. The selection process is likely to be a mainly visual one, from in-store displays/shelves, websites or published advertisements. However, oral recommendations and orders will also play some part. So the way the marks sound must also be considered.

#### Degree of distinctive character of the earlier mark

23. The more highly distinctive the earlier mark the greater is the risk of confusion. I must therefore assess the distinctiveness of the earlier mark. In *Lloyd Schuhfabrik Meyer & Co* the CJEU stated that:

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<sup>3</sup> *Lloyd Schuhfabrik Meyer*

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

24. The word ‘Chef’ is self-evidently highly allusive of the character of goods for use by chefs or in cooking (including baking). *MASTERCHEF* (or *MASTER CHEF*) designates a top chef. In the context of cooking goods, there is a clear allusion to goods that are good enough for use by a master chef. I therefore find that both the *CHEF* element, and the earlier mark as a whole, have a below average degree of inherent distinctiveness in relation to the goods at issue.

25. There is no evidence of use of *MASTERCHEF/MASTER CHEF* in the UK prior to the relevant date in relation to goods in class 21. Consequently, the distinctive character of the mark rests on its inherent level of distinctiveness.

#### Comparison of marks

26. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the

average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The respective trade marks are shown below:

<p>MASTERCHEF</p> <p>MASTER CHEF</p>	<p>MISTER CHEF</p>
<p>Earlier trade marks</p>	<p>Contested trade mark</p>

27. The opponent points out that respective marks are both comprised of 10 letters, 9 of which are the same and in the same order. The only visual difference is that the second letter of the contested mark is an ‘I’ whereas the equivalent letter in the earlier marks is an ‘A’. This means that the marks are visually similar to quite a high degree.

28. At the hearing, Mr Kish asked me to take into account that the marks are used with different logos. However, the contested mark, like the earlier marks, has been applied for as a word-only trade mark. Consequently, it is not possible to take account of features which are not present in the respective trade marks as registered, or proposed to be registered.

29. The level of aural similarity between the marks is similar to the level of visual similarity. Both marks are comprised of three syllables: MISS-TER-SHEF v MASS-TER-SHEF. They are aurally similar to quite a high degree.

30. The opponent submits that the marks are also conceptually similar. I disagree. MISTER is plainly a title for an adult male. The meaning of CHEF is obvious. The combination conveys the meaning of a person or chef called Mister Chef. By contrast, the word MASTER in MASTERCHEF/MASTER CHEF will be understood by relevant average consumers as meaning *“a skilled practitioner of a particular art*

or activity.”<sup>4</sup> Therefore, MASTERCHEF/MASTER CHEF means a highly skilled chef. This means that, when compared as wholes, the marks have quite distinct meanings. I therefore find that the marks are conceptually dissimilar.

#### Conclusion on likelihood of confusion

31. The goods are identical and the marks are quite highly similar to the eye and to the ear. These factors point towards a likelihood of confusion. On the other hand, the marks are conceptually dissimilar and it is well established that conceptual differences may counter visual and aural similarities,<sup>5</sup> although they do not always do so.<sup>6</sup>

32. There are two other particularly relevant factors. Firstly, the difference between the marks is towards the beginning of the marks and, as a rule of thumb, these tend to be noticed more than a difference in the middle or at the end of words.<sup>7</sup> Secondly, the earlier marks have a below average degree of distinctiveness for cookware and kitchen goods.

33. Weighing all the relevant factors against one another, I find that the differences between the respective marks are sufficient to avoid a likelihood of confusion. In coming to this conclusion I have considered the possibility of confusion through consumers misreading or mishearing one mark for the other, which appears to me to be the high point of the opponent’s case. However, I have decided that the visual and aural difference towards the beginning of the respective marks, in combination with the different meanings of MISTER CHEF and MASTERCHEF/MASTER CHEF, are sufficient to avoid any significant level of confusion amongst average consumers. I have also considered the possibility of confusion occurring through imperfect recollection. However, I find that the different meanings of the marks make this unlikely.

34. The opposition under s.5(2)(b) fails accordingly.

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<sup>4</sup> Per the third meaning in the Oxford English Dictionary.

<sup>5</sup> See *The Picasso Estate v OHIM*, CJEU, Case C-361/04 P at paragraph 20 of the judgment.

<sup>6</sup> See, for example, *Nokia Oyj v OHIM*, the General Court, Case T-460/07

<sup>7</sup> See, for example, *El Corte Inglés, SA v OHIM*, the General Court, Cases T-183/02 and T-184/02

## The section 5(3) ground

35. Section 5(3) states:

“(3) A trade mark which-  
(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

36. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the

relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of

the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

### Reputation

37. I accept that earlier mark 2563306 (MASTERCHEF) has a substantial reputation for “a television series in the reality genre in the field of cooking and food and presentation of competitions, games and studio entertainment.”

### Link

38. As I noted above, my assessment of whether the public will make the required mental ‘link’ between the marks must take account of all relevant factors. The factors identified in *Intel* are:

#### *The degree of similarity between the conflicting marks*

The respective marks are quite highly visually and aurally similar, but (as a whole) conceptually dissimilar.

#### *The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public*

The goods covered by the contested mark are dissimilar to the entertainment services specified at paragraph 37 above, but there is a link between them in that they are both connected with cooking. The users of the respective goods and services are therefore likely to have some interest in cooking.

Consequently, the section of the public who are potential users of the applicant's goods are likely to be aware of the services provided under the earlier mark.

*The strength of the earlier mark's reputation*

The earlier mark has a substantial reputation for the entertainment services relied upon by the opponent.

*The degree of the earlier mark's distinctive character, whether inherent or acquired through use*

The earlier mark has a below average degree of distinctive character for a TV show based on a competition to identify highly skilled chefs (for which MASTERCHEF appears rather descriptive). However, the mark has acquired at least a normal level of distinctive character through extensive use in relation to such services.

*Whether there is a likelihood of confusion*

In my view, the differences between the marks and the goods and services are sufficient to avoid a likelihood of confusion. I note that the opponent seeks to rely on the established merchandising of MASTERCHEF goods as a factor which increases the likelihood of the public expecting that MISTER CHEF cookware and bakeware to be connected with the MASTERCHEF TV show. However, the opponent's evidence does not establish that, at the relevant date, the UK public would have been aware of the merchandising of MASTERCHEF goods. Consequently, this does not assist the opponent's case.

39. Although the absence of a likelihood of confusion is relevant to the question of whether the relevant public will make a mental link between the marks (in the sense that if there is a likelihood of confusion there is a bound to be such a link), it is not necessarily decisive.<sup>8</sup> However, I find that the UK public would not make any link between, on the one hand, the contested mark and the goods covered by the

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<sup>8</sup> Although as the opponent's case in this opposition appears to be that the public will think that the opponent is economically connected in some way to the goods covered by the contested mark, the absence of a likelihood of confusion, which includes the likelihood of this kind of association, is decisive in this particular case.



application and, on the other hand, the earlier mark and the entertainment services for which it has a reputation. The opposition under section 5(3) therefore fails. This is because, unless the public will make a link between the marks, use of the contested mark cannot take unfair advantage of the reputation acquired by the earlier mark.

### **Outcome**

40. Subject to appeal, the contested mark will be registered.

### **Costs**

41. The applicant has been successful and would normally be entitled to a contribution towards its costs. However, as the applicant is not professionally represented it was sent a pro-forma inviting it to set out the number of hours spent on the different stages of this opposition. The applicant was told that no award of costs would be made unless it completed the pro-forma. The pro-forma was not returned. I take this to mean that the applicant has not made an application for costs. Consequently, I direct that each side should bear its own costs.

**Dated this 10<sup>th</sup> day of April 2018**

**Allan James  
For the Registrar**