

O/994/22

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3692163
IN THE NAME OF SHENZHEN HUANGLINIAO TRADING CO., LTD.
IN RESPECT OF THE TRADE MARK**

knipan

IN CLASSES 8 & 21

AND

**THE OPPOSITION THERETO UNDER NO. 429599
BY KNIPEX-WERK C. GUSTAV PUTSCH KG**

Background and pleadings

1. Shenzhen Huangliniao Trading Co., Ltd. (“the applicant”) applied to register the trade mark ‘knipan’ with the application number 3692163 in the UK on 09 September 2021. It was accepted and published in the Trade Marks Journal on 01 October 2021 in respect of the following goods:

Class 8: Electric flat irons; Temperature controlled electric flat irons; Electric steam irons; Vegetable knives; Household knives; kitchen knives (non-electric -); tableware [knives, forks and spoons]; Table knives; mincing knives [hand tools]; Knives; Fruit knives; Chef knives; Bread knives; Ceramic knives; Plane irons.

Class 21: Whisks, non-electric, for household purposes; Waffle irons, non-electric; Tableware, other than knives, forks and spoons; scoops [tableware]; Plates; Frying pans; Reamers for fruit juice; cookware [pots and pans]; Pressure cookers, non-electric; Oven-to-table tableware; Oven gloves; Pancake frying pans; Non-electrical coffee grinders; Non-electric waffle irons; Mixing cups.

2. KNIPEX-Werk C. Gustav Putsch KG (“the opponent”) opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its earlier comparable UK Trade Mark registration number 801171610 for the mark KNIPEX. The following goods are relied upon in this opposition:

Class 8: Hand tools (hand-operated), hand implements (hand-operated) for agricultural, horticultural and forestry purposes, for the construction of machines, apparatus and vehicles, for repair, maintenance and assembly of pipes, for electrical installation, for sanitary installation and structural engineering, and for the production of electronic components; hand tools and implements (hand-operated) for processing and manufacturing cables and optical fibres, in particular dismantling, cutting and stripping tools and implements; hand tools (hand-operated) for producing crimp connections, in particular crimping pliers, crimping inserts for crimping pliers, interchangeable

magazines for crimping inserts for crimping pliers; hand-operated insertion and extraction tools; pliers, in particular universal pliers, wire strippers, gripping pliers, grip pliers, circlip pliers, carpenters' pincers, cutting pliers, pipe wrenches, water pump pliers, punch pliers, concretors' nippers, press pliers and press inserts for press pliers; hand-operated insertion tools; hand-operated striking tools, in particular hammers, chisels, drivers, centre punches; hand-operated riveting tools, in particular riveting pliers, rivet setters, rivet headers; hand-operated assembly tools, in particular assembly mandrels, drift punches, crowbars, flatteners, pry bars, straightening tools, tyre levers, chisels, box chisels, offset pins; screwdrivers; saws; tool inserts for use with hand-operated tools, in particular bit sockets and socket wrench inserts and inserts for wrenches (tools); reversible ratchets and coupler ratchets; screw extractors; scrapers; drill inserters; drill bits and milling bits; insulated hand tools hand-operated for conducting work under electric potential; hand-operated cutting tools, shears, in particular combination shears, ratchet cutters, cable shears, wire rope shears, mitre shears; pipe cutters, cable cutters, mitre cutters; tweezers; knives, in particular cable stripping knives, dismantling knives and cable knives; sheet metal nibblers; wrenches (tools), in particular open-end wrenches, box wrenches, nut drivers, adjustable wrenches, pliers wrenches, pen-style keys, spider wrenches, stopcock wrenches, torque wrenches and universal wrenches; control cabinet keys, pen-style control cabinet keys and device keys; dies and inserts for all the aforesaid goods; metal storage containers adapted for the aforesaid goods, in particular cases, bags, boxes, strongboxes, assortment boxes and reservoirs; storage containers of plastic adapted for goods of class 8, in particular cases, bags, boxes, strongboxes, assortment boxes and reservoirs; parts, spare parts and accessories for the aforesaid goods, included in this class.

3. The above registration claims priority from 25 April 2012 and was registered on 25 June 2014.¹ By virtue of its earlier filing date, the above registration constitutes an earlier mark in accordance with section 6 of the Act.

4. The opponent argues that the respective goods are identical and similar and that the marks are similar, and that as such there is a likelihood of confusion which includes a likelihood of association between the marks.

5. The applicant filed a counterstatement denying the claims made and requesting that the opponent provides proof of use of its earlier trade mark relied upon.

6. Only the opponent filed evidence in these proceedings. This will not be summarised but has been fully considered and will be referred to where appropriate within this decision. Only the opponent filed submissions during the evidence rounds, which again will not be summarised but will be referred to where appropriate. Neither party filed written submissions in lieu of a hearing and no hearing was requested. This decision is taken following a careful perusal of the papers.

7. Both parties are represented in these proceedings. The applicant is represented by Akos Suele, LL.M. and the opponent is represented by WP Thompson.

8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

¹ Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing EUTM or EU designation of an International Registration. As a result of the opponent's EU designation of International Registration number 1171610 being registered as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original International Registration priority date.

Proof of use

9. The relevant statutory provisions are as follows:

Section 6A:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a),
(aa) or (ba) 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 relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(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 relevant period 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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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)-(5A) [Repealed]

(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.”

10. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the “five-year period”) has expired before IP completion day—

- (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and
- (b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

- (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

Proof of Use case law

11. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(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 to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale

and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving 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. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

12. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

13. As the earlier mark was registered on 25 June 2014, it had been registered for a period of more than five years at the date on which the application was filed, that being 9 September 2021. The earlier mark is therefore subject to proof of use in accordance with section 6A of the Act. The opponent must provide proof it has made genuine use of its mark in the five-year period directly prior to and ending with the date that the application was filed, namely between 10 September 2016 – 9 September 2021, in respect of the relevant goods, and within the relevant territory. In this instance the

relevant territory is the EU including the UK for the period of 10 September 2016 – 31 December 2020, and the UK only between 1 January 2021 – 9 September 2021, in accordance with Schedule 2A of the Act as set out above.

Use of the mark

14. The opponent has filed its evidence in the form of a witness statement in the name of Stephan Saltenbrock, Corporate Legal Counsel for the opponent. The witness statement provides sales figures for “relevant goods under the earlier trade mark” as follows:²

YEAR	UK+EU (in €)	UK only (in €)
2017	134,621,065	5,379,331
2018	146,050,387	5,948,733
2019	156,948,575	6,429,697
2020	164,495,440	5,578,615
2021	142,407,044	5,554,778

15. Further, advertising and promotion expenditure figures for “goods sold under the earlier trade mark” are also provided as follows:

YEAR	Expenditure (in €)
2017	266,199.62
2018	294,112.17
2019	501,633.28
2020	1,128,484.72
2021	212,453.27



² See paragraph 4 of the witness statement of Mr Saltenbrock

17. Pages from the opponent's catalogues are provided at Exhibit S2. Within his witness statement, Mr Saltenbrock explains three of the catalogues provided are dated from 2018, and the fourth is from November 2020.



19. The first catalogue provided is entitled 'Pliers' and the initial page refers to the opponent as "The pliers company". This shows the mark in use in respect of a large range of pliers. Within his witness statement Mr Saltenbrock states the catalogue dates from March 2018.³ A second catalogue is dated by Mr Saltenbrock as being from June 2018, and a third as being from September 2018.⁴ The second catalogue is called KNIPEX Electrical Range and again shows a range of pliers including crimping pliers, in addition to what appear to be wire insulation strippers and wire cutters, and electrician's shears and pipe cutters. Tool boxes and tool cases are also shown, in addition to a product named the Knipex Twin Key which is described as a "[m]ultifunctional key for the actuation of locking systems from the areas of facilities engineering (heating and sanitation, air conditioning, electro technology), gas and

³ See paragraph 7 of the witness statement of Mr Saltenbrock

⁴ See paragraph 7 of the witness statement of Mr Saltenbrock

water supply shut-off-systems.” A third catalogue shows many of the same products as the previous catalogue, but also shows goods including screwdrivers, an ‘F-compression connector’, and ‘dismantling knives’ and ‘cable knives’ as shown below:

Dismantling Knives
Insulating multi-component handle, VDE-tested

98
5

- > Ergonomically designed handle shape with comfortable slip guard
- > Particularly confident grip thanks to slip-proof soft components
- > Thumb recess and “finger hook” at the end of the handle ensure a good transmission of force when the blade is pulled
- > Transparent protective cap

98 53 03

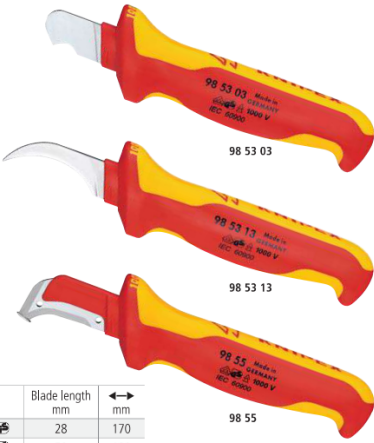
- > Solid, fixed hook blade
- > Suitable for round cables
- > Blade: special tool steel, oil-hardened

98 53 13

- > Narrow, fixed hook blade, sickle shaped
- > Suitable for sector cables
- > Blade: special tool steel, oil-hardened

98 55

- > Solid, fixed hook blade, sickle shaped
- > With guide shoe at the blade point
- > No damage of the conductor insulation
- > Blade: surgical steel, stainless, vacuum-hardened



Article No.	EAN 4003773-		Blade length mm	↔ mm
98 53 03	026549	⚡ 1000 V	28	170
98 53 13	026556	⚡ 1000 V	50	190
98 55	022558	⚡ 1000 V	38	180


Cable Knives
Insulating multi-component handle, VDE-tested

98
5

- > Ergonomically improved handle shape with comfortable slip guard
- > Particularly confident grip thanks to slip-proof soft components
- > Thumb recess and “finger hook” at the end of the handle ensure a good transmission of force when the blade is pulled
- > Solid, fixed straight blade
- > Transparent protective cap
- > Blade: special tool steel, oil-hardened

98 54

- > Back of the blade plastic coated to avoid short circuits



Article No.	EAN 4003773-		Blade length mm	↔ mm
98 52	035565	⚡ 1000 V	50	190
98 54	026563	⚡ 1000 V	50	190

20. One further catalogue is provided, which Mr Saltenbrock explains dates from November 2020.⁵ This shows largely the same goods as the previous catalogues.

21. Many of the goods shown in the catalogues, including what appear to be pliers, wire strippers and cutters, screwdrivers, and the ‘Knipex Twin Key’ are shown on

display in shops under the banner  in photographs provided at Exhibit S3. The images are undated.

⁵ See paragraph 7 of the witness statement of Mr Saltenbrock

22. Images from the opponent's website www.knipex.com clearly showing the mark




and KNIPEX are provided by web archiving website the WayBack Machine between November 2016 and May 2021, again showing some of the goods as described in the catalogues on the site itself. The pages do not provide prices or an indication of currency. Yearly website views are provided in the body of the witness statement. These give figures of several million visitors yearly between 2016 and 2021, but the location of the visitors is not given.

23. Exhibit S5 comprises a long list of companies in locations across the UK. These are in groups headed 'UK retailers 2016 – 2017', 'UK retailers 2018 – 2019', and 'UK retailers 2020 – 2021'. Within his witness statement, Mr Saltenbrock states that this is a list of UK retailers selling his company's goods between 2016 – 2021.

Variant use

24. Before I move on to consider if the use of the earlier mark constitutes genuine use, I firstly consider if the use of the mark as shown is use of the mark as registered or alternatively if it is use of an acceptable variant of the same. I note the opponent has made use of the mark KNIPEX in simple word format, including within the catalogues provided. Sometimes, the font colour is white or red, and on occasion the mark is very slightly stylised where it is displayed on the tools themselves. As the earlier mark is registered as a word mark it may be used in a range of standard fonts and colours, I find these differences to constitute normal and fair use of the mark that do not alter its distinctive character. This is therefore clearly acceptable use of the mark for the purpose of showing genuine use.



25. The mark is also frequently shown in the form . In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its

registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1)”. (emphasis added)

26. I find the element KNIPLEX within the red diamond shape clearly maintains its independent role as an indication of origin within the mark as shown. It is my view that

the use of the mark in this form is therefore use of an acceptable variant of the mark for the purposes of showing genuine use.

Genuine use

27. I note here the use in the EU (excluding the UK) dating back to 2017 is evidenced primarily via the turnover figures provided, and the number of EU territories within which use of the mark had been made up until 31 December 2021 is not clear. However, the extent of the use in the UK during that time is clearly defined, and I find the UK to constitute a significant part of the EU territory for the purposes of showing genuine use of the mark up until that date. Further, this is supplemented with significant turnover figures for goods under the mark throughout the EU. Considering the evidence as a whole, and particularly considering the reasonably high sales figures for the EU and the UK, and for the UK alone in 2021, the invoices provided to UK consumers, in addition to the catalogues showing a range of goods offered under the mark or an acceptable variant of the same, there is no doubt in my mind that the opponent has made genuine use of its mark, for the purpose of creating and maintaining a market for its goods, within the relevant territory and within the relevant time period in respect goods falling within the following terms in the specification relied upon:

Class 8: Hand tools (hand-operated), hand implements (hand-operated) for agricultural, horticultural and forestry purposes, for the construction of machines, apparatus and vehicles, for repair, maintenance and assembly of pipes, for electrical installation, for sanitary installation and structural engineering, and for the production of electronic components; hand tools and implements (hand-operated) for processing and manufacturing cables and optical fibres, in particular dismantling, cutting and stripping tools and implements; hand tools (hand-operated) for producing crimp connections, in particular crimping pliers, crimping inserts for crimping pliers, interchangeable magazines for crimping inserts for crimping pliers; hand-operated insertion and extraction tools; pliers, in particular universal pliers, wire strippers, gripping pliers, grip pliers, circlip pliers, carpenters' pincers, cutting pliers, pipe wrenches, water pump pliers, punch pliers, concretors' nippers, press pliers and

press inserts for press pliers; hand-operated insertion tools; screwdrivers; insulated hand tools hand-operated for conducting work under electric potential; hand-operated cutting tools, shears, cable shears, wire rope shears, pipe cutters, cable cutters, knives, in particular cable stripping knives, dismantling knives and cable knives; wrenches (tools), in particular pliers wrenches, torque wrenches; control cabinet keys, dies and inserts for all the aforesaid goods; metal storage containers adapted for the aforesaid goods, in particular cases, bags, boxes, strongboxes, assortment boxes and reservoirs; storage containers of plastic adapted for goods of class 8, in particular cases, bags, boxes, strongboxes, assortment boxes and reservoirs; parts, spare parts and accessories for the aforesaid goods, included in this class.

Fair specification

28. Now that I have established that genuine use has been made of the mark, I must consider what a fair specification for the opponent should look like based on that use.

29. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

30. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair

specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

31. With consideration to the terms applied in respect of which use has been shown, and with consideration to the case law set out above, it is my view that the majority of

the specification filed is fairly narrow and is how the consumer would fairly describe the goods.

32. Whilst I consider that the term *Hand tools (hand-operated), hand implements (hand-operated) for agricultural, horticultural and forestry purposes, for the construction of machines, apparatus and vehicles, for repair, maintenance and assembly of pipes, for electrical installation, for sanitary installation and structural engineering, and for the production of electronic components* remains fairly broad despite the limitations applied,⁶ I consider that the opponent does indeed provide a range of several types of hand tools and hand implements that may be used for the purposes described, and I consider the consumer would find the specification as it currently reads to be a fair description of the goods offered.

Decision

Section 5(2)(b)

33. 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

34. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

⁶ It is my view that the limitations applied to these goods apply to both *Hand tools (hand-operated)* and *hand implements (hand-operated)*. This will be discussed in more detail later in this decision.

The principles

35. 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.

Comparison of the goods

36. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975."

37. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

38. In the judgment of the Court of Justice of European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

39. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that goods may be considered “complementary” where:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

40. The case law provides further guidance on how the wording of goods and services as registered and filed should be interpreted within the comparison. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for

straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

41. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

42. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the GC stated that:

“29. In addition, 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 für 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”.

43. With this in mind, the goods for comparison are as follows:

Goods relied upon	Goods contested
<p><i>Class 8: Hand tools (hand-operated), hand implements (hand-operated) for agricultural, horticultural and forestry purposes, for the construction of machines, apparatus and vehicles, for repair, maintenance and assembly of pipes, for electrical installation, for sanitary installation and structural engineering, and for the production of electronic components; hand tools and implements (hand-operated) for processing and manufacturing cables and optical fibres, in particular dismantling, cutting and stripping tools and implements; hand tools (hand-operated) for producing crimp connections, in particular crimping pliers, crimping inserts for crimping pliers, interchangeable magazines for crimping inserts for crimping pliers; hand-operated insertion and extraction tools; pliers, in particular universal pliers, wire strippers, gripping pliers, grip pliers, circlip pliers, carpenters' pincers, cutting pliers, pipe wrenches, water pump pliers, punch pliers, concretors' nippers, press pliers and press inserts for press pliers; hand-operated insertion tools; screwdrivers; insulated hand tools hand-operated for conducting work under electric potential; hand-operated cutting tools, shears, cable shears, wire rope</i></p>	<p><i>Class 8: Electric flat irons; Temperature controlled electric flat irons; Electric steam irons; Vegetable knives; Household knives; kitchen knives (non-electric -); tableware [knives, forks and spoons]; Table knives; mincing knives [hand tools]; Knives; Fruit knives; Chef knives; Bread knives; Ceramic knives; Plane irons.</i></p> <p><i>Class 21: Whisks, non-electric, for household purposes; Waffle irons, non-electric; Tableware, other than knives, forks and spoons; scoops [tableware]; Plates; Frying pans; Reamers for fruit juice; cookware [pots and pans]; Pressure cookers, non-electric; Oven-to-table tableware; Oven gloves; Pancake frying pans; Non-electrical coffee grinders; Non-electric waffle irons; Mixing cups.</i></p>

<p><i>shears, pipe cutters, cable cutters, knives, in particular cable stripping knives, dismantling knives and cable knives; wrenches (tools), in particular pliers wrenches, torque wrenches; control cabinet keys, dies and inserts for all the aforesaid goods; metal storage containers adapted for the aforesaid goods, in particular cases, bags, boxes, strongboxes, assortment boxes and reservoirs; storage containers of plastic adapted for goods of class 8, in particular cases, bags, boxes, strongboxes, assortment boxes and reservoirs; parts, spare parts and accessories for the aforesaid goods, included in this class.</i></p>	
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44. In respect of class 8, the opponent has argued that the applicant's *knives* in class 8 are identical to its own goods *knives, in particular cable and stripping knives, dismantling knives and cable knives*. I agree, the opponent's goods will all fall into the category of *knives* in the applicant's specification, and the goods are therefore identical in accordance with the principles set out in *Meric*.

45. The opponent submits that the following goods filed by the applicant are also identical to those within its earlier specification:

Vegetable knives; Household knives; kitchen knives (non-electric -); tableware [knives, forks and spoons]; Table knives; mincing knives [hand tools]; Fruit knives; Chef knives; Bread knives; Ceramic knives

46. This submission appears to be, at least partially, based on the opponent's claim to hold protection for 'hand tools (hand-operated)' per se. However, I consider how this term is framed within the specification filed. The reference to 'hand tools (hand

operated)' that may be interpreted most broadly within the opponent's specification is as follows:

Hand tools (hand-operated), hand implements (hand-operated) for agricultural, horticultural and forestry purposes, for the construction of machines, apparatus and vehicles, for repair, maintenance and assembly of pipes, for electrical installation, for sanitary installation and structural engineering, and for the production of electronic components.

47. Generally the use of a comma in the place of a semi-colon following a term indicates that all the wording following this term until the next semi colon will apply to the same. Guidance on the use of commas is set out in section 2.17 of the UK Trade Marks Manual. I have set out part of this guidance below:

"In many other situations the correct use of commas and semi-colons is of great importance for example:

"Ingredients for food; hydrocarbon preparations and resins, all for use in the manufacture of paints; plastics and fertilizers".

Any alteration to the punctuation of the above specification would result in a change in the way the specification could be interpreted. The "all for use in the manufacture of paints" is only intended to apply to "hydrocarbon preparations and resins" and the semi-colons around this item and the comma before "all for use in the manufacture for example." achieve this.

The use of the term "all for" should also be noted in the above example. "Hydrocarbon preparations and resins for use in the manufacture of paints" This is not clear since it is uncertain whether the "hydrocarbon preparations" are for use in manufacture or not.

Qualifications which follow a comma only refer to those goods or services which follow the previous semi-colon for example:

“Pharmaceutical preparations; plasters and bandages, all for surgical use”

The qualification “all for surgical use”, refers only to plasters and bandages;

And in:

“Meat; fish, poultry and game; jams; fruit and vegetables, all being preserved”

The qualification “all being preserved” refers only to “fruit and vegetables” because these are the only goods which follow the previous semi-colon.

The qualification “all being preserved” refers only to “fruit and vegetables” because these are the only goods which follow the previous semi-colon.

Qualifications which follow a semi-colon refer to all the preceding goods or services, for example in a specification reading:

“Bleaching preparations, detergents and fabric softeners; all for laundry use”.

The qualification “all for laundry use” applies to all the preceding goods.

Where goods or services are to be qualified by a number of items or uses, the qualifications should be separated by commas and the last item worded so as to relate all the items in the qualification to the goods or services being qualified.

Where goods or services are to be qualified by a number of items or uses, the qualifications should be separated by commas and the last item worded so as to relate all the items in the qualification to the goods or services being qualified.

When specifications are framed as in the following example:

“Banking, life insurance and consultancy and advisory services relating to the aforesaid services”.

There is no need to edit this to:

“Banking, life insurance and consultancy and advisory services, all relating to the aforesaid services”

Since it is obvious that both the consultancy and advisory services relate to banking and life insurance.” (Emphasis added).

48. In this instance, I note the term *hand tools (hand operated)* is not followed by a semi-colon. It is my interpretation that the following limitations will apply to this term in addition to *hand implements (hand operated)*, but alternatively I note that it is at best unclear whether and to what extent they will apply. I note in *Sky v Skykick* as referenced above, Lord Justice Arnold stated that an unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers. In this case, as it is at best unclear whether the limitations apply to hand tools (hand operated), I find I should interpret the specification as if they do apply to the same. However, for completeness, I note in any case that if these limitations are not considered to apply to *hand tools (hand operated)* when considering the way the specification was originally drafted, I would nonetheless find that a fair specification of the goods would be to apply the limitation *for the construction of machines, apparatus and vehicles, for repair, maintenance and assembly of pipes, for electrical installation, for sanitary installation and structural engineering, and for the production of electronic components* to hand tools per se when considering the use of the same. This is because the term ‘*hand tools (hand operated)*’ is a particularly broad term which may refer to a huge range of goods across disparate industries, for example from engineering to hairdressing, and it is capable of being divided into many subcategories. Adding this limitation (if I am incorrect in considering it to already be in place) would not limit the opponent down to only specific goods, but nor would it provide unnecessarily broad protection. As such, even if I were to consider the applicant’s types of knives as *hand tools (hand operated)* per se, I still do not consider there to be any doubt that the applicant’s goods are not identical to the earlier types of *hand tools (hand operated)* covered by the opponent’s specification.

49. I note that the identity is also claimed based on the opponent’s goods *hand operated cutting tools, shears, in particular combination shears, ratchet cutters, cable shears, wire rope shears, mitre shears; and knives, in particular cable stripping knives, dismantling knives and cable knives*. As above, I find these goods, including *hand operated cutting tools, shears* and *knives* to both be subject to the limitation that

follows. I do not consider that they are identical to any of the goods to which they claim to be identical, either self evidently or in line with the principles as set out in *Meric*.

50. I therefore consider the similarity between the opponent's goods and the applicant's goods *Vegetable knives; Household knives; kitchen knives (non-electric -); tableware [knives, forks and spoons]; Table knives; mincing knives [hand tools]; Fruit knives; Chef knives; Bread knives; Ceramic knives*. I note the opponent's *stripping knives, dismantling knives and cable knives* will have a similar nature to the applicant's goods, on the basis that they will all have a handle and a blade, with the exception of forks and spoons which will not have a blade and will therefore be less similar in nature. However, whilst I accept, they may all be used for the purpose of cutting or slicing, again with the exception of forks and spoons, I find the purpose of the applicant's goods will be for food preparation and for eating, whereas the opponent's goods are for stripping and dismantling electrical wires. Due to their different purpose, I do not consider there will be competition between the goods, and I do not find the trade channels will be shared. If they end up in the same stores, I find it highly unlikely they will be near each other. I do not consider the users of the goods to materially overlap, with the opponent's knives being used by professionals for electrical work, and the applicant's being used by the general public or professionals such as chefs. There will be no complementarity between the goods. Overall, I find the applicant's goods *tableware [... forks and spoons]* to be dissimilar to the opponent's goods, and the rest of the applicant's goods mentioned to be similar to only a low degree at best.

51. The applicant's class 8 goods also include:

Class 8: Electric flat irons; Temperature controlled electric flat irons; Electric steam irons; Plane irons.

52. The opponent has again submitted these are identical to *hand tools (hand operated)* which as mentioned I do not find it holds protection for without limitation. However, I accept that the applicant's *plane irons* may fall within the category of *Hand tools (hand-operated), hand implements (hand-operated) for agricultural, horticultural and forestry purposes, for the construction of machines, apparatus and vehicles, for repair, maintenance and assembly of pipes, for electrical installation, for sanitary*

installation and structural engineering, and for the production of electronic components as they are hand implements that may be used for shaping woodwork for the construction of apparatus for example. Alternatively, I find these goods will share users with the opponent's *carpenters' pincers* as covered by the opponent, as both the goods will be used by professional and hobbyist wood workers. They are also likely to share trade channels on this basis, and they are likely to be sold in the same specialist stores and next to each other in larger stores. I note they are both small hand tools used for woodworking and so there some overlap in their intended purpose, although the specific purpose will differ. I do not find them to be complementary or in competition, and overall I find the goods to be similar to a medium degree.

53. However, in respect of the remaining class 8 goods, those being electric flat irons and steam irons, it is my view that these are items which are used for removing creases from fabric or clothing. I do not consider these to be identical to the opponent's goods. Further, I do not consider these will share a nature with any of the opponent's goods, and the intended purpose and method of use will differ significantly. I do not consider these will typically share trade channels, and where these goods do end up in the same large retailers, they are unlikely to be placed near each other. The goods are not complementary or in competition. They will not share users beyond the fact that in some instances the goods may both be used by the general public, and this alone is not enough to find any similarity between the goods. I therefore consider the applicant's *Electric flat irons; Temperature controlled electric flat irons; Electric steam irons* to be dissimilar to all of the opponent's earlier goods.

54. I now move on to consider all of the applicant's the goods filed in class 21.

55. The opponent has made further claims that the goods *whisks, non-electric, for house hold purposes; scoops [tableware]; and reamers for fruit juice* are identical to the opponent's *hand tools (hand operated)* per se. For the reasons already set out I do not find the opponent to hold protection for this broad category of goods without limitation, and in any case, I do not find its goods to be identical to those claimed. The opponent also submits there is similarity between its earlier goods and the class 21 goods for the following reasons:

“The opponent’s goods are used both in a professional context and by the general public in DIY/home improvement context. The goods claimed in the application and those claimed in the earlier registration have the same nature and use, all being hand tools, the same trade channels, as both sets of goods are commonly sold in stores selling homeware/home improvement products.”

56. I disagree with the majority of the opponent’s submissions. Whilst I note that some of goods in class 21 are hand held articles, they are very different to those *for agricultural, horticultural and forestry purposes, for the construction of machines, apparatus and vehicles, for repair, maintenance and assembly of pipes, for electrical installation, for sanitary installation and structural engineering, and for the production of electronic components* that are covered by the opponent’s specification, or any of the more specific tools listed within the opponent’s class 8 goods. Other than some of the goods being handheld, such as the whisks and frying pans, the actual method of use will differ considerably. The nature of the goods will differ, and the intended purpose of the goods will also differ considerably. The opponent’s goods are for a range of purposes to do with in construction and installation, whereas the applicant’s class 21 goods are for purposes such as whisking, cooking and serving. Whilst I accept that the general public may purchase some of the opponent’s hand tools and hand implements in addition to the applicant’s goods, users are not shared beyond this extent. I do not find there to be a material overlap in trade channels, and where the goods end up in the same large retailers such as supermarkets and department stores, I do not believe they would be placed near each other. I do not consider the goods to be in competition or to be complementary. Overall, I do not find the goods filed by the applicant in class 21 to be similar to opponent’s goods.

57. Where there is no similarity between the goods, the opposition based on section 5(2)(b) of the Act must fail. The opposition therefore fails in respect of the following goods:

Class 8: Electric flat irons; Temperature controlled electric flat irons; Electric steam irons; tableware [... forks and spoons]

Class 21: Whisks, non-electric, for household purposes; Waffle irons, non-electric; Tableware, other than knives, forks and spoons; scoops [tableware]; Plates; Frying pans; Reamers for fruit juice; cookware [pots and pans]; Pressure cookers, non-electric; Oven-to-table tableware; Oven gloves; Pancake frying pans; Non-electrical coffee grinders; Non-electric waffle irons; Mixing cups.

58. The opposition will continue in respect of the following goods only:

Class 8: Vegetable knives; Household knives; kitchen knives (non-electric -); tableware [knives ...]; Table knives; mincing knives [hand tools]; Knives; Fruit knives; Chef knives; Bread knives; Ceramic knives; Plane irons.

Comparison of marks

59. 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 Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

60. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

61. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
KNIPEX	knipan

62. The earlier mark is the word mark KNIPEX. The overall impression resides in the mark as a whole. The contested mark is the word mark knipan. Again, the overall impression resides in the mark as a whole.

Visual comparison

63. I note firstly that the applicant has included within its counterstatement a list of other marks beginning with the letters KNIP, which it states are marks on the register against which the opponent has raised no objection. Within its comments on the visual similarity of the mark, the applicant mentions these marks, reiterating that prefix KNIP has been commonly incorporated into marks in classes of the opponent's interest and the opponent has not taken action against them. There are six listed in total. I note that the table has not been filed in evidential format within or as an exhibit to a witness statement. However, in any case, it is well established that state of the register evidence is of no use when determining the visual similarity between marks, and I note here for completeness, nor is it likely to have an impact on the likelihood of confusion between the same. It does not show that the marks are in use on the marketplace or that the consumer has become accustomed to marks for these goods beginning with the letters KNIP. In *Zero Industry Srl v OHIM*,⁷ the GC stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that

⁷ Case T-400/06

evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71)."

64. Further, whether or not the opponent has opposed other trade marks beginning with the four letters of the applicant's mark is a commercial decision and is not of any relevance to these proceedings, or to the visual similarity between the marks. I will therefore not consider these arguments made by the applicant any further, either in respect of the visual similarity between the marks or in the context of the decision as a whole.

65. The marks are visually similar by virtue of the shared use of the initial 4 letters KNIP. This similarity is at the beginning of the mark where the consumer tends to pay more attention.⁸ They differ by way of the last two letters, those being 'EX' in the earlier mark and 'an' in the contested mark. Both marks are filed as word marks and so they may be used in both upper case and lower case lettering, and as such this does not create a point of visual difference between the marks. Overall, with consideration to both the visual similarities and the visual differences, I find the marks to be visually similar to between a medium and high degree.

Aural comparison

66. The opponent submits the marks will be pronounced as 'naipex' and 'naipan'. I accept some consumers will pronounce the marks in this way, whilst others will pronounce these as 'nih-pex' and 'nih-pan'. In both scenarios, the consumer is likely to pronounce the initial syllable identically, whilst the pronunciation of the second syllable will differ. Due to the aural similarities being present at the beginning of the mark, overall, I find the marks to be aurally similar to slightly above a medium degree.

⁸ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Conceptual comparison

67. The opponent submits that neither mark has a meaning and as such the conceptual factor is neutral to the comparison. The applicant also submits this is the case within its counterstatement. I accept the parties' submissions, and I find the marks to be conceptually neutral.

Average consumer and the purchasing act

68. 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: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

69. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

70. The average consumer of the applicant's remaining goods will primarily comprise members of the general public. The goods, with the exception of *plane irons*, are regular household items for the kitchen, and I do not consider particularly high level of attention will be paid when purchasing the same. That being said, I consider that the consumer will not purchase the goods overly frequently and will consider factors such

as the quality, functionality and aesthetics of the same when making a purchase. It is my view that a medium level of attention will be paid in respect of the same.

71. In respect of the applicant's plane irons, and in respect of the opponent's goods, where these are purchased by members of the public including by DIY enthusiasts or woodwork hobbyists for example, I consider that again they will not be purchased overly frequently, and attention is likely to be paid to the quality of the goods and their suitability for carrying out the required task. I consider that the general public will pay a medium degree of attention to these purchases.

72. I note the applicant's goods may also be purchased by professional consumers, including chefs, professionals working in hospitality and professionals in woodwork or construction. Further, I note that a primary consumer group of the opponent's goods will be professionals requiring tools for use in various trades. I consider that professional consumers will likely pay a higher degree of attention when purchasing the goods due to the direct impact this will have on their business and the work they are able to carry out, and as such I find the level of attention paid by this group of consumers in respect of all of the goods will be at least above medium.

73. I find all of the goods are most likely to be purchased visually, either in physical or online retail stores or via catalogues. However, I note that assistance may be sought from retail staff, and verbal recommendations may also play a part in the purchasing process, and so I cannot discount the aural comparison.

Distinctive character of the earlier trade mark

74. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“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).”

75. The earlier mark is the word KNIPEX. I consider this to be a made-up word with no meaning to the consumer, and as such I find the distinctive character of the mark to be inherently high.

76. I note the opponent has filed evidence of use of its mark, and as such, I must consider if the distinctive character of the mark has been enhanced by virtue of the use made of the same. When considering the distinctive character of the mark, I remind myself that it is the perception of the UK consumer that is key. I consider that the opponent has evidenced a reasonable turnover for goods sold under its mark in the UK over the last five years. I consider also that the list of UK suppliers of the goods is fairly lengthy and has been provided dating back to 2016. Whilst I also note the references to the considerable marketing spend, this is not defined by territory, and I am not aware of how much of this spending will have been targeted at the UK. This is also true for the website visits provided. I am unaware of the size of the market for the goods offered by the opponent however, I assume this will be at least reasonable. Considering the evidence as a whole, whilst I consider that the opponent to have shown a healthy level of use of its mark in the UK over a number of years, considering the inherent level of distinctive character is already high I do not find that the evidence

is sufficient to show the distinctive character of the mark will have been enhanced above its inherent level.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

77. Prior to reaching a decision under Section 5(2)(b), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 35 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier mark will have an impact on the likelihood of confusion. I must remember that the distinctive character of the earlier mark may be inherent, but that it may also be increased through use, and that the distinctiveness of the common elements is key.⁹ I must keep in mind that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that both the degree of attention paid by the average consumer and how the goods are obtained will have a bearing on how likely the consumer is to be confused.

78. I consider at this point that there are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.¹⁰

⁹ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.

¹⁰ *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

79. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

80. Where there is no similarity between the goods, the opposition has failed. I found the remaining goods applied for to range from identical to similar to a low degree to the earlier goods. I found that where the consumer is the general public, they will pay a medium degree of attention to the goods, and I found that the degree of attention paid by the professional consumer will be at least above medium. I found that the purchasing process will be primarily visual, but that I cannot completely discount the aural considerations, and I found that the marks are visually similar to between a medium and high degree, and aurally similar to slightly above a medium degree. I found the marks to be conceptually neutral. I found that the earlier mark holds a high degree of distinctive character inherently, which has not been enhanced further by virtue of the use made of the same.

81. With consideration to all of the factors, it is my view that bearing in mind the consumer's imperfect recollection, where the goods are similar to a medium degree or above, the consumer may misremember the mark, and directly confuse one for the other. I find this to be the case for both the general public and the professional consumer in this instance. However, where I have found that the similarity between the goods is low, with consideration to the interdependency principle, it is my view that the consumer is unlikely to mistake one mark for the other. I therefore find there to be a likelihood of direct confusion in respect of the following goods only:

Class 8: Knives; Plane irons.

82. I note for completeness I have also considered if there is a likelihood of indirect confusion between the marks. In *L.A. Sugar* Mr Iain Purvis Q.C. (as he then was), as the Appointed Person set out three examples of when indirect confusion may occur as below:

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

91. I note that the examples above were intended to be illustrative and are not exhaustive. However, it is my view that none of the above categories will apply to the marks in this instance. Further, it is my view that if the consumer is not directly confused, there is no logical reason for them to believe that the marks are economically linked based on the use of the first four letters KNIP. If this similarity between the marks is noticed in respect of the goods with a low level of similarity, it is my view this would be put down to coincidence, and not due to an economic connection between the marks. I therefore find there to be no direct or indirect confusion in respect of the following goods:

Vegetable knives; Household knives; kitchen knives (non-electric -); tableware [knives ...]; Table knives; mincing knives [hand tools]; Fruit knives; Chef knives; Bread knives; Ceramic knives;

Final Remarks

83. The opposition based on section 5(2)(b) if the Act has failed in respect of all goods other than:

Class 8: Knives; Plane irons.

84. Subject to any successful appeal, the application will be refused for the goods listed above, and will proceed to registration in respect of the following goods:

Class 8: Electric flat irons; Temperature controlled electric flat irons; Electric steam irons; Vegetable knives; Household knives; kitchen knives (non-electric -); tableware [knives, forks and spoons]; Table knives; mincing knives [hand tools]; Fruit knives; Chef knives; Bread knives; Ceramic knives.

Class 21: Whisks, non-electric, for household purposes; Waffle irons, non-electric; Tableware, other than knives, forks and spoons; scoops [tableware]; Plates; Frying pans; Reamers for fruit juice; cookware [pots and pans]; Pressure cookers, non-electric; Oven-to-table tableware; Oven gloves; Pancake frying pans; Non-electrical coffee grinders; Non-electric waffle irons; Mixing cups.

COSTS

85. The applicant has achieved considerably more success than the opponent and is entitled to a contribution towards its costs. In the circumstances I award the applicant scale costs in accordance with Tribunal Practice Notice 2/2016 to the sum of £540 as a contribution towards the cost of the proceedings, including a 10% cost reduction to account for the opponent's partial success. I have in this instance awarded costs below the scale for preparing and considering evidence as the applicant filed no evidence of its own, however I consider it will have incurred costs for considering the evidence filed by the opponent. The sum is calculated as follows:

Reviewing the TM7 and preparing and filing the TM8: £300

Considering the opponent's evidence:	£300
10% reduction for the opponent's partial success:	-£60
Total:	£540

86. I therefore order KNIPEX-Werk C. Gustav Putsch KG to pay Shenzhen Huangliniao Trading Co., Ltd. the sum of £540. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 14th day of November 2022

Rosie Le Breton
For the Registrar