

**O/0451/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003701258**

**BY BSH HAUSGERÄTE GMBH**

**TO REGISTER THE TRADE MARK:**

**CookIt**

**IN CLASSES 7 AND 11**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 431910 BY**

**VORWERK INTERNATIONAL AG**

## BACKGROUND AND PLEADINGS

1. On 27 September 2021, BSH Hausgeräte GmbH (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was published for opposition purposes on 17 December 2021 and registration is sought for the goods shown in paragraph 19 below. The application was filed pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union. Consequently, it is entitled to rely upon its earlier EU filing date of 2 April 2019. I also note that priority is claimed from a German trade mark (no. 3020190056791) from 6 March 2019.

2. On 16 March 2022, the application was opposed by Vorwerk International AG (“the opponent”) based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). Under section 5(2)(b) the opponent relies upon the following trade marks:

Cookidoo

UKTM no. 912433645<sup>1</sup>

Filing date 13 December 2013; registration date 15 January 2015

(“the First Earlier Mark”)

COOK-KEY

UKTM no. 912490629

Filing date 10 January 2014; registration date 3 June 2014

(“the Second Earlier Mark”)

COOK-KEY

UKTM no. 801260374

Filing date 10 July 2014; registration date 15 June 2016

(“the Third Earlier Mark”)

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<sup>1</sup> On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EUTM or IR(EU). As a result of the opponent having EUTMs or IR(EU)s being protected as at the end of the Implementation Period, comparable UK trade marks were automatically created. The comparable trade marks shown here (all three of the earlier marks) are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and retain their original filing dates.

3. The opponent relies upon some of the goods and services for which the marks are registered, as set out in the Annex to this decision. The opponent claims that the goods and services are highly similar and the marks are similar, with the result that there is a likelihood of confusion.

4. Under section 5(3), the opponent relies upon the First Earlier Mark only. The opponent claims a reputation for “providing of online databases featuring instructions for recipes, recipe selection, food planning, menu planning and with cooking and baking instruction”. The opponent claims that use of the applicant’s mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or repute of the First Earlier Mark.

5. The applicant filed a counterstatement denying the grounds of opposition.

6. The applicant is represented by Dr Walther Wolff & Co and the opponent is represented by Hogan Lovells International LLP.

7. The opponent filed evidence in chief. The applicant filed written submissions during the evidence rounds. The opponent did not file evidence in reply. Neither party requested a hearing, but both filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

## **EVIDENCE AND SUBMISSIONS**

8. The opponent’s evidence in chief took the form of:

- a) The witness statement of Raquel Alves dated 19 August 2022, which is accompanied by 2 exhibits. Ms Alves is Customer Marketing Manager at Vorwerk UK Limited, which is part of the same group of companies as the opponent. Ms Alves has been employed by Vorwerk UK Limited since 1 February 2017.

b) The witness statement of Michael Kabilka dated 22 August 2022, which is accompanied by 5 exhibits. Mr Kabilka is Director of Inhouse Consulting at Vorwerk Deutschland Stiftung & Co. KG, which is part of the same group of companies as the opponent. Mr Kabilka has been employed by that company since 2012 and was seconded to the opponent as Director Controlling Digital between October 2017 and September 2020.

9. The applicant filed written submissions dated 21 October 2022.

10. Although the opponent initially indicated that it wished to file evidence in reply, it confirmed that it would not be doing so by email on 23 January 2023.

11. Both parties filed written submissions in lieu dated 22 February 2023.

12. I have taken the evidence and submissions into account in reaching my decision and will refer to them below where necessary.

## **RELEVANCE OF EU LAW**

13. 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. This is why this decision continues to make reference to the trade mark case-law of EU courts.

## **DECISION**

### **Section 5(2)(b)**

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

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

(a)...

(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.”

15. 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.”

16. The trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As the earlier marks had not completed their registration process more than 5 years before the priority date of the mark in issue, they are not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods and services identified.

17. 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:

(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 greater 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 to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods and services**

18. As a preliminary point, I note that in its written submissions in lieu the opponent provided further explanation for the similarity between its own goods and services and those of the applicant. Its argument in relation to the specification of the Second Earlier Mark is that the goods covered by the specification of that mark would be components of the goods in the applicant's specification. In my view, this line of argument has no merit. Firstly, not all of the goods covered by the specification of the Second Earlier Mark (*Recorded and unrecorded mechanical, magnetic, magneto-optical, optical and electronic data carriers; Digital data carriers; Modems; Electronic publications (downloadable and/or stored on data carriers)*) can be said to form components of those in the applicant's specification. However, even if they do, the nature, method of use and purpose of the goods clearly differ. They are so different, in my view, that the average consumer would not believe that they originate from the same or economically linked undertakings; the opponent's goods would be sold by specialist technical goods retailers, whereas the applicant's goods would be sold by homeware or kitchen supply stores. There is no competition (given the differing purposes) and no complementarity (as the average consumer would not believe that they originate from the same undertaking). Consequently, the opposition based upon the Second Earlier Mark must fall at the first hurdle. I will, therefore, undertake the following comparison based upon the opponent's First and Third Earlier Marks only.

19. I have included only those goods that I consider to represent the opponent's best case in the table below. With that in mind, the competing goods and services are as follows:

<b>Opponent's goods and services</b>	<b>Applicant's goods</b>
<p data-bbox="193 246 794 286"><b>The First Earlier Mark</b></p> <p data-bbox="193 302 794 342"><u>Class 7</u></p> <p data-bbox="193 358 794 1272">Electric apparatus for household and industrial use in the field of nutrition and health, namely household knives, mills, grinders, fruit presses, blenders and whisks for household purposes; Mechanical apparatus for making food and beverages, in particular for chopping, cutting, milling, crushing, grating, mixing, beating, stirring, emulsifying and kneading, electric kitchen machines; Electric kitchen machines with integrated chopping, grinding and weighing functions; Fittings for all the aforesaid goods; Electric knives, Bread cutting machines, Electric can openers, Aerated beverage-making machines.</p> <p data-bbox="193 1350 794 1391"><u>Class 11</u></p> <p data-bbox="193 1406 794 1872">Electric cooking utensils; Electric containers for cooking, electric kitchen machines with integrated cooking functions, fittings for the aforesaid goods; Electric microwave ovens; Electric broilers; Electric appliances for making yoghurt, electric machines for making ices, beverage cooling apparatus.</p> <p data-bbox="193 1951 794 1991"><b>The Third Earlier Mark</b></p>	<p data-bbox="798 246 1399 286"><u>Class 7</u></p> <p data-bbox="798 302 1399 1991">Electric household and kitchen machines and apparatus, included in Class 7, in particular electric kitchen machines and apparatus, including grinders, beaters and kneading apparatus, fruit presses, juice extractors, juice centrifuges, mincing machines, cutting apparatus, electrically powered tools, tin openers, knife sharpening apparatus and machines and apparatus for making beverages and/or preparing food, beverage pumps for dispensing chilled beverages; electric vending machines for beverages or foods, automatic vending machines; electric welding devices for wrapping; electrical waste disposers, namely waste grinders and waste compacting machines; dishwashers; electric machines and devices for cleaning laundry and clothing (included in Class 7), including washing machines, spin dryers; ironing presses, ironing machines, included in Class 7; electric household cleaning equipment, including electric window cleaning equipment, electric shoe polishers and vacuum cleaners, wet and dry vacuuming apparatus; robotic vacuum cleaners, robots for household chores; parts for all the aforesaid goods, included in Class 7; hoses, pipes and tubes, dust</p>



Class 11

Electric containers for cooking, namely pressure cookers, electric kitchen machines with integrated cooking function, accessories for the aforementioned goods.

Class 35

Retail services with regard to [...] kitchen machines.

filters and dust filter bags, vacuum cleaners brushes, all of the aforesaid for vacuum cleaners.

Class 11

Apparatus for heating, steam generating and cooking, in particular stoves, baking, roasting, grilling, toasting, defrosting and heating devices, water heaters, immersion heaters, slow-cookers, microwave ovens, electric waffle irons, egg-boilers, deep-fat fryers (electric); kitchen machines comprising an integrated cooking and roasting function, and comprising an integrated mixing, cutting, chopping, grinding, blending, kneading and weighing function; electric tea and coffee makers, espresso coffee machines, automatic coffee machines (included in Class 11); refrigerating apparatus, in particular refrigerators, chest freezers, refrigerated cabinets, beverage-cooling apparatus, fridge-freezers, freezers, ice machines and apparatus; drying apparatus, in particular including tumble dryers, laundry drying machines, hand dryers, hair dryers; infrared lamps (not for medical purposes); heating pads (not for medical purposes), electric blankets (not for medical purposes); apparatus for ventilating, in particular fans; extractor hood filters, extractor hood equipment

	<p>and extractor hoods; air conditioning apparatus and devices for improving air quality; air humidifiers, air deodorisers, fragrance dispensing apparatus (not for personal use); air purifying apparatus; apparatus for water supply and sanitary purposes, in particular including fittings for steam generating, ventilating and water supply installations; water heaters, storage water heaters and instantaneous water heaters; kitchen sinks; heat pumps; parts for all the aforesaid goods included in class 11; mechanical taps (dispensers) for dispensing chilled beverages for use in combination with apparatus for chilling beverages (other than vending machines).</p>
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20. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the 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.”

21. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(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.

22. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“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 for 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.”

23. 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 Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...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.”

24. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

### Class 7

*Electric household and kitchen machines and apparatus, included in Class 7, in particular electric kitchen machines and apparatus, including grinders, beaters and kneading apparatus, fruit presses, juice extractors, juice centrifuges, mincing machines, cutting apparatus, electrically powered tools, tin openers, knife sharpening apparatus and machines and apparatus for making beverages and/or preparing food, beverage pumps for dispensing chilled beverages.*

25. The opponent submits that these goods are identical to “Electric apparatus for household [...] use in the field of nutrition and health, namely household knives, mills, grinders, fruit presses, blenders and whisks for household purposes” and “electric kitchen machines with integrated chopping, grinding and weighing functions” in the specification of the First Earlier Mark. I agree that there is identity in relation to at least some of these goods. However, even if I am wrong in that finding, they will overlap in trade channels, method of use, purpose, use and nature. Consequently, they will be highly similar.

26. The opponent identifies its best case in relation to the Third Earlier Mark as “accessories for the aforementioned goods” (being electric containers for cooking, namely pressure cookers, electric kitchen machines with integrated cooking functions). I am not convinced that these goods are identical because the applicant’s goods are the machines and apparatus themselves, whereas the opponent’s goods are accessories for those goods. However, I accept that there would be an overlap in trade channels and user and the goods would be complementary. Consequently, they are similar to a medium degree.

*Electric vending machines for beverages or foods, automatic vending machines.*

27. The opponent submits that its best case is in relation to “aerated beverage-making machines” and “electric machines for making ices, beverage cooling apparatus” in the specification of the First Earlier Mark. I accept that there may be an overlap in trade channels as businesses that sell the applicant’s goods may also sell the opponent’s goods, particularly where they are intended for use in commercial settings. There may also be an overlap in user. There will be some overlap in nature, method of use and purpose (although they are not exactly the same). The goods are not in direct competition, nor are they complementary (as one is not important or indispensable to the other). Consequently, I consider them to be similar to a medium degree.

28. The opponent has not identified any point of overlap with the specification of the Third Earlier Mark. Consequently, I find no similarity.

*Electric welding devices for wrapping.*

29. The opponent submits that these goods are similar to “electric apparatus for household and industrial use in the field of nutrition and health, namely household knives, mills, grinders, fruit presses, blenders and whisks for household purposes” in the specification of the First Earlier Mark. The opponent has also identified various other kitchen machines in the specification of the First Earlier Mark that it considers to be similar to the applicant’s goods. The reason for this is the same for all i.e. that electric welding devices for wrapping are “used to seal food in plastic for its protection and longevity. They are complementary to goods used in the preparation of food and will be likely sold by the same retailers of food/beverage related products, advertised in the same publications and purchased by the same consumers”. The applicant’s goods are used in the process of wrapping goods (including food). I have no evidence before me to suggest that such goods would be sold by the same businesses that sell goods used for making/preparing the food itself. I also have no evidence to suggest that the same users would purchase these goods. For example, commercial food producers may buy the kitchen machines covered by the First Earlier Mark, but I am unable to say whether they would also purchase packaging goods or whether that part of the process would be outsourced to a different undertaking. Clearly, the purpose and method of use will differ. There will be some overlap in nature to the extent that they are all electrical machines. They are not complementary, because one is not important or indispensable for the other and the average consumer would not consider them to originate from the same or economically linked undertakings. There is no competition. Consequently, I consider them to be dissimilar. If I am wrong in this finding, then they are similar to only a low degree.

30. The opponent makes similar arguments in relation to the class 11 goods and class 35 services covered by the specification of the Third Earlier Mark. However, for the same reasons, I can see no point of overlap. Certainly, in respect of the services, they would be even further apart (having different natures). Consequently, I consider the goods and services to be dissimilar or, if I am wrong in that finding, similar to only a low degree.

*Electrical waste disposers, namely waste grinders and waste compacting machines.*

31. The opponent notes that these goods can be used in kitchens to dispose of food and, consequently, claims that they are similar to the opponent's goods in classes 7 and 11 as they are all "kitchen items", likely to be sold through the same retailers to the same consumers. The opponent also claims that they are complementary. I note that the opponent does have various electric kitchen machines in its specification, but these are all limited to being for preparation of food/beverages or other related purposes. None of them cover waste disposal. I accept that there will be an overlap in user. The nature, method of use and purpose of the goods will clearly differ. I have no evidence before me that there is an overlap in trade channels. I accept that they may be sold through the same kitchen appliances stores (at a very general level), although the actual businesses that produce the goods are likely to differ. The goods are not complementary because they are not important or indispensable for each other. They are not in competition. Consequently, I consider them to be similar to a low degree.

32. The opponent submits that these goods are similar to "retail services with regard to [...] kitchen machines" in the specification of the Third Earlier Mark. I agree. There is clearly an overlap in user and trade channels and the goods and services are complementary. The goods and services are similar to a medium degree.

*Dishwashers.*

33. The opponent submits that these are similar to "electric kitchen machines" in class 7 of the First Earlier Mark. However, the opponent's specification does not include that term. It includes the terms: "mechanical apparatus for making food and beverages, in particular [...], electric kitchen machines" and "electric kitchen machines with integrated chopping, grinding and weighing functions". Both of these terms are limited to being for preparation of food and/or beverages; neither would include dishwashers. I accept that the goods may be sold through the same general retailers to the same users. However, the purpose and method of use of the goods differ. Any overlap in nature to the extent that they are electrical will be limited. They are neither in competition, nor complementary. Consequently, I consider the goods to be similar to a low degree.

34. The opponent also submits that these goods are similar to “retail services with regard to [...] kitchen machines” in the specification of the Third Earlier Mark. I agree. They are likely to be sold through the same trade channels to the same users, and they are complementary. I consider them to be similar to a medium degree.

*Electric machines and devices for cleaning laundry and clothing (included in Class 7), including washing machines, spin dryers; ironing presses, ironing machines, included in Class 7; electric household cleaning equipment, including electric window cleaning equipment, electric shoe polishers and vacuum cleaners, wet and dry vacuuming apparatus.*

35. The opponent submits that these are all household goods and will be sold through the same channels, to the same users, as the goods in classes 7 and 11 of the First Earlier Mark’s specification. I accept that there may be some limited overlap in trade channels at a high level due to all of these goods being sold by general retailers selling a variety of goods for the home. Clearly, there will be an overlap in user. However, the method of use and purpose of the goods clearly differ. Any overlap in nature by virtue of them all being electrical goods is minimal. They are neither in competition, nor complementary. I consider them to be similar to a low degree.

36. The opponent has not identified any point of overlap with the Third Earlier Mark. Consequently, I find no similarity.

*Robotic vacuum cleaners, robots for household chores.*

37. The opponent makes the same submissions in relation to these goods in respect of the specification of the First Earlier Mark. The same findings will apply i.e. they are similar to a low degree. I note that the opponent has also identified points of similarity on the basis that goods in the specifications of the First and Third Earlier Marks will be components in these goods. For the same reasons set out above, I dismiss this line of argument and find no similarity.



*Parts for all the aforesaid goods, included in Class 7.*

38. These goods will have varying degrees of similarity with the opponent's goods, depending upon how similar the substantive goods were to the opponent's specification. However, as they cannot be more similar than my findings above, I will proceed on the basis that they are similar to the same degree as their corresponding goods. For reasons that will become apparent, it will have no bearing on the outcome of this decision.

*Hoses, pipes and tubes, dust filters and dust filter bags, vacuum cleaners brushes, all of the aforesaid for vacuum cleaners.*

39. The opponent makes the same submissions in relation to these goods as outlined in paragraph 35 above. For the same reasons, any similarity is at a low degree (at best).

#### Class 11

*Apparatus for heating, steam generating and cooking, in particular stoves, baking, roasting, grilling, toasting, defrosting and heating devices, water heaters, immersion heaters, slow-cookers, microwave ovens, electric waffle irons, egg-boilers, deep-fat fryers (electric).*

40. The opponent submits that these goods are identical or highly similar to "electric cooking utensils", "electric kitchen machines with integrated cooking functions [...]", "electric microwave ovens" and "electric broilers" in the specification of the First Earlier Mark. I agree. Where they are not identical (self-evidently or on the principle outlined in *Meric*) they will overlap in purpose, method of use, nature, trade channels and user and will be highly similar.

41. In my view, these goods are identical or highly similar to "electric containers for cooking, namely pressure cookers, electric kitchen machines with integrated cooking function" in the specification of the Third Earlier Mark for the same reasons. However, the opponent has not actually relied upon these goods but has relied upon parts for

those goods. However, in any event, the parts would overlap in trade channels and user with the applicant's goods and would be complementary. Consequently, they would be similar to a medium degree.

*Kitchen machines comprising an integrated cooking and roasting function, and comprising an integrated mixing, cutting, chopping, grinding, blending, kneading and weighing function.*

42. These goods are self-evidently identical or identical on the principle outlined in *Meric* to "electric kitchen machines with integrated cooking functions" and "electric kitchen machines with integrated chopping, grinding and weighing functions" in the specification of the First Earlier Mark.

43. They are also identical (either self-evidently or on the principle outlined in *Meric*) or highly similar to "electric containers for cooking, namely pressure cookers, electric kitchen machines with integrated cooking function" in the specification of the Third Earlier Mark. If they are not identical, they will overlap in nature, purpose, method of use, trade channels and user and will be highly similar. However, the opponent has not actually relied upon these goods but has relied upon parts for those goods. However, in any event, the parts would overlap in trade channels and user with the applicant's goods and would be complementary. Consequently, they would be similar to a medium degree.

*Electric tea and coffee makers, espresso coffee machines, automatic coffee machines (included in Class 11); refrigerating apparatus, in particular refrigerators, chest freezers, refrigerated cabinets, beverage-cooling apparatus, fridge-freezers, freezers, ice machines and apparatus.*

44. The opponent identifies "aerated beverage-making machines" and "electric machines for making ices, beverage and cooling apparatus" in the specification of the First Earlier Mark as its best case. I accept that a number of these goods are identical. However, even where they are not, they will overlap in trade channels and user. There will also be an overlap in method of use, purpose and nature (albeit to a lesser degree). Consequently, I consider them to be similar to between a medium and high degree.

45. The opponent has not identified any point of overlap with the specification of the Third Earlier Mark and, consequently, I find no similarity.

*Drying apparatus, in particular including tumble dryers, laundry drying machines, hand dryers, hair dryers.*

46. The opponent make the same submissions in relation to these goods as identified at paragraph 35 above. For the same reasons given previously, any similarity is at a low degree (at best).

47. The opponent has not identified any overlap with the specification of the Third Earlier Mark and, consequently, I find no similarity.

*Infrared lamps (not for medical purposes).*

48. The opponent submits that its best case relates to “electric microwave ovens” and “electric broilers” because “these goods, like infrared lamps, are used to heat food”. I accept that there may be some overlap in purpose, as both can be used to warm food. However, microwaves are typically used to thoroughly heat (or cook) food, whereas infrared lamps are used to keep food that has already been cooked (or heated) warm. The nature of the goods will differ (albeit they are both electrical goods). The method of use will clearly differ. There may be some overlap in user as both could be purchased by those involved in large scale catering. I accept that there may be some overlap in trade channels in the commercial field. Consequently, I consider the similarity to be at no more than a medium degree.

49. The opponent has not identified any overlap with the specification of the Third Earlier Mark and, consequently, I find no similarity.

*Heating pads (not for medical purposes), electric blankets (not for medical purposes).*

50. The opponent submits that its best case in relation to these goods is “electric microwave ovens”, “electric broilers”, “electric cooking utensils”, “electric containers

for cooking” and “electric machines with integrated cooking functions” in the specification of the First Earlier Mark. This is because, the opponent states, “these goods all have the purpose of heating up another item”. However, there is no suggestion that the applicant’s goods would be used to heat food; in my view, they clearly would not. Consequently, any overlap in purpose is at a very superficial level. The nature and method of use of the goods would clearly differ. I consider it unlikely that there would be any meaningful overlap in trade channels. The user could clearly overlap. There would be no competition or complementarity. Consequently, I consider the goods to be dissimilar. However, if I am wrong in this finding, they would be similar to only a low degree.

51. The opponent has not identified any overlap with the specification of the Third Earlier Mark and, consequently, I find no similarity.

*Apparatus for ventilating, in particular fans; extractor hood filters, extractor hood equipment and extractor hoods.*

52. To the extent that these goods include extractor fans for use with cookers, I accept that there would be an overlap in trade channels with the opponent’s class 7 and 11 goods as they could all be sold through kitchenware stores. The users will clearly overlap. However, the nature, purpose and method of use of the goods differ. They are not in competition or complementary. Consequently, I consider them to be similar to between a low and medium degree.

53. The opponent has not identified any point of overlap with the specification of the Third Earlier Mark and, consequently, I find no similarity.

*Air conditioning apparatus and devices for improving air quality; air humidifiers, air deodorisers, fragrance dispensing apparatus (not for personal use); air purifying apparatus; apparatus for water supply and sanitary purposes, in particular including fittings for steam generating, ventilating and water supply installations; water heaters, storage water heaters and instantaneous water heaters; kitchen sinks; heat pumps; parts for all the aforesaid goods included in class 11.*

54. The opponent makes the same submissions in relation to these goods as set out in paragraph 35 above. I am not convinced that the same overlap applies for all of these goods. However, even if they are similar, the opponent's best case is that they are similar to a low degree.

55. The opponent has identified no point of overlap with the specification of the Third Earlier Mark and, consequently, I find no similarity.

*Mechanical taps (dispensers) for dispensing chilled beverages for use in combination with apparatus for chilling beverages (other than vending machines).*

56. The opponent has identified "aerated beverage-making machines" and "electric machines for making ices, beverage and cooling apparatus" in the specification of the First Earlier Mark as its best case. In my view, the applicant's goods are likely to be considered parts for the opponent's goods. Consequently, they will be sold through the same trade channels to the same users. They are also complementary. I consider them to be similar to a medium degree.

57. The opponent has identified no point of overlap with the specification of the Third Earlier Mark and, consequently, I find no similarity.

### **The average consumer and the nature of the purchasing act**

58. As the above case law indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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.”

59. The average consumer for the parties’ goods and services will be either a member of the general public or a professional user in the hospitality/catering sector. The cost of the goods and services will vary, but they are unlikely to be particularly frequent purchases. The cost is unlikely to be low but will also not be at the highest end of the scale, although it may be more for goods aimed at the commercial sector. In any event, various factors will be taken into consideration such as ease of use, functionality and performance (for the goods) and expertise and speed of service (for the services). Consequently, I consider a medium degree of attention is likely to be paid during the purchasing process.

60. The goods and services are likely to be purchased following perusal of signage at physical premises or on websites. Consequently, visual considerations will dominate the selection process. However, given that advice may be sought from retail assistants or word-of-mouth recommendations may play a role, I do not discount an aural component.

### **Comparison of trade marks**

61. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU 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.”

62. It would be wrong, therefore, to artificially dissect the trade marks, 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.

63. The respective trade marks are shown below:

<b>Opponent's trade marks</b>	<b>Applicant's trade mark</b>
Cookidoo (the First Earlier Mark)	CookIt
COOK-KEY (the Third Earlier Mark)	

### Overall Impression

64. The applicant's mark consists of the conjoined words CookIt. There are no other elements to contribute to the overall impression of the mark, which lies in the combination of these words. The First Earlier Mark consists of the invented word Cookidoo. There are no other elements to contribute to the overall impression of the mark, which lies in the word itself. The Third Earlier Mark consists of the words COOK and KEY, joined by a hyphen. The overall impression of the mark lies in the combination of these elements. Bearing in mind that the word COOK will be low in distinctiveness (at best) for these goods and services, I consider the distinctiveness of all of these marks to lie in their combinations (either as part of an invented word or two conjoined words, as the case may be).

### Visual Comparison

65. The First Earlier Mark and the applicant's mark overlap in their first five letters – COOKI. However, in the First Earlier Mark these form part of the invented word Cookidoo, whereas in the applicant's mark they form part of the conjoined words CookIt. Bearing in mind that the word COOK is low in distinctiveness (at best), the average consumer is likely to pay more attention to the ends of the marks. Consequently, I consider the marks to be visually similar to a medium degree.

66. The Third Earlier Mark and the applicant's mark overlap in the common first word, COOK. However, the second word in each mark (IT or KEY) act as points of visual difference. As above, the average consumer will pay more attention to the end of the mark due to the lowly distinctive (at best) word at the beginning. I consider the marks to be visually similar to between a low and medium degree.

### Aural Comparison

67. The First Earlier Mark will be pronounced COOK-IDD-OOO. The applicant's mark will be pronounced COOK-IT. The first syllable will be pronounced identically and the second syllable shares some similarity. Consequently, I consider the marks to be aurally similar to a medium degree.

68. The Third Earlier Mark and the applicant's mark share the common first syllable COOK. With regard to the second syllable, the opponent submits as follows:

“In relation to the Opponent's sign “COOK-KEY”, the “EY” at the end of the sign and the “I” in “COOKIT” are almost indistinguishable when spoken, and the signs are aurally highly similar.”

However, it is not clear to me from the opponent's explanation why these sounds should be considered “almost indistinguishable”. To my mind, the second syllables in the marks (IT and KEY) sound very different. Consequently, I consider them to be aurally similar to between a low and medium degree.



## Conceptual Comparison

69. Clearly, all three marks will overlap in that they share the common word COOK, which will be attributed its ordinary dictionary meaning. However, this will be seen as low in distinctiveness (at best) for the goods/services in issue. The applicant's mark conveys the meaning of an instruction/suggestion to cook something. The First Earlier Mark is an invented word with no real meaning as a whole, all be it with an allusion to cooking. The Third Earlier Mark suggests some sort of key to cooking (perhaps some sort of assistance or guide). In my view, the marks share no more than a medium degree of conceptual similarity.

### **Distinctive character of the earlier marks**

70. 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-2779, 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).”

71. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

72. I will begin by assessing the inherent distinctive character of the earlier marks. The First Earlier Mark consists of the invented word Cookidoo. Whilst it is an invented word, it is clearly allusive of goods/services related to cooking. I consider it to be inherently distinctive to a medium degree. The Third Earlier Mark consists of the words COOK-KEY. It consists of two ordinary dictionary words which are allusive of the goods/services. I consider the Third Earlier Mark to be inherently distinctive to between a low and medium degree.

73. I now turn to consider whether the distinctiveness of the earlier marks has been enhanced through use. I bear in mind that the relevant market for assessing enhanced distinctiveness is the UK market. With that in mind, I note the following from the opponent’s evidence:

- a) The Cookidoo website was set up as an ‘integrated recipe platform’ to provide access to recipes to be used with the Thermomix food processor (the opponent’s most successful product). The Cookidoo recipe database can be integrated with the Thermomix food processor using the Cook-Key, which presents step-by-step instructions from the Cookidoo database for customers to follow at home.
- b) As at the date of Mr Kabilka’s statement, a subscription to the service costs £40 or €48 per year, although prior to the relevant date the platform cost £30 per year.
- c) The subscription offering was launched in the UK and Ireland in August 2016.

d) The number of paid subscriptions of Cookidoo in the UK and Ireland, up to the relevant date, were as follows:

2017	394
2018	6,109
2019	13,544

Clearly, only part of the figures for 2019 would have been prior to the relevant date.

e) The following number of physical recipe books were sold under the COOKIDOO name in the UK:

2017	971
2018	7,906
2019	1,790

Again, only part of the sales made in 2019 would have been prior to the relevant date.

f) Examples of the cookbooks have also been provided.<sup>2</sup> The cookbooks make reference to the recipe platform.

g) The opponent provides the following turnover figures for subscription fees in the UK, which it states to be in thousands of euros:

<b>Year</b>	<b>2017 (TEUR)</b>	<b>2018 (TEUR)</b>	<b>2019 (TEUR)</b>	<b>2020 (TEUR)</b>
<b>United Kingdom</b>	2,54	91,81	272,24	653,75

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<sup>2</sup> Exhibit RA1

Clearly only part of these figures would be prior to the relevant date.

- h) These figures are supported by a selection of invoices.<sup>3</sup> As the applicant notes, not all of these relate to the period prior to the relevant date.
- i) The opponent has provided 'follower' figures for its social media account under the name Thermomix UK and Ireland, although I note that there is no reference to the First or Third Earlier Marks on these pages.<sup>4</sup>
- j) The First and Third Earlier Marks were referenced in an article in the *Metro* on 8 March 2019.<sup>5</sup> I note that other articles have been provided but these are either not (or not clearly) directed at the UK market or come from the opponent itself.
- k) Examples of booklets, letters and flyers that have been issued to customers bearing the COOKIDOO and/or COOK-KEY marks have been provided.<sup>6</sup>

74. There is nothing in the opponent's evidence to suggest that the distinctiveness of the earlier marks has been enhanced in relation to any of the goods or services that I have found to be similar to the applicant's specification. For the avoidance of doubt, I also do not consider the evidence sufficient to demonstrate enhanced distinctiveness for any of the goods or services covered by the specifications of the First and Third Earlier Marks. The subscription fees are clearly not insignificant. However, they are not reflective of a particularly large market share for the services in issue. The same applies to the sales of cookbooks. The service was only launched in 2016 (3 years prior to the relevant date) and so the length of use has not been particularly significant. I have no information about overall marketing and advertising expenditure and the evidence of marketing activities undertaken is limited. Taking all of this into account, I do not consider that the distinctiveness of the earlier marks has been enhanced through use.

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<sup>3</sup> Exhibit MK3

<sup>4</sup> Exhibit MK4

<sup>5</sup> Exhibit MK5

<sup>6</sup> Exhibit RA2

## **Likelihood of confusion**

75. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between them and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

76. I have found as follows:

- a) The goods vary from being identical to dissimilar. As it represents the opponent's best case, I will conduct my assessment on the basis of the identical goods.
- b) The average consumer will be a member of the general public or a professional user, who will pay a medium degree of attention during the purchasing process.
- c) The purchasing process will be predominantly visual, although I do not discount an aural component.
- d) The First Earlier Mark and the applicant's mark are visually, aurally and conceptually similar to a medium degree.

- e) The Third Earlier Mark and the applicant's mark are conceptually similar to a medium degree, and visually and aurally similar to between a low and medium degree.
- f) The First Earlier Mark is inherently distinctive to a medium degree and the Third Earlier Mark is inherently distinctive to between a low and medium degree.

77. The common word COOK in the marks is low in distinctiveness (at best). The additional element IDOO in the First Earlier Mark (to create an invented word), IT in the applicant's mark and -KEY in the Third Earlier Mark are all, in my view, not likely to be overlooked by the average consumer (notwithstanding the fact that both the application and the First Earlier Mark both contain the common letter I in addition to the common word COOK). Taking all of the above factors into account, the visual, aural and conceptual differences between the marks are, in my view, sufficient to avoid a likelihood of direct confusion, even when used on identical goods.

78. I now turn to consider indirect confusion. In this regard, I bear in mind the comments of Mr James Mellor Q.C. sitting as the appointed person in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, in which he stressed that a finding of indirect confusion should not be made merely because two marks share a common element. The word COOK for these goods and services is low in distinctiveness (at best) and the distinctiveness of the common element is an important consideration. In my view, it is unlikely that the average consumer would believe that only one undertaking could be using that word in relation to these goods and services. The use of the word COOK in differing constructions (as part of the invented word COOKIDOO in the First Earlier Mark, as part of the instructional statement CookIt in the applicant's mark and as part of the hyphenated words COOK-KEY in the Third Earlier Mark) is more likely to be viewed as simply coincidence rather than identifying goods and services that originate from the same or economically linked undertakings. I consider this to be the case even where the goods are identical. Taking all of the above factors into account, I do not consider there to be a likelihood of indirect confusion.

79. The opposition based upon section 5(2)(b) is dismissed.

## **Section 5(3)**

80. Section 5(3) of the Act states:

“5(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 and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

81. Section 5(3A) of the Act states:

“Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

82. As the earlier trade marks are comparable marks, paragraph 10 of Part 1, Schedule 2A of the Act is relevant. It reads:

“10.— (1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to—

(a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and

(a) the United Kingdom include the European Union”.

83. The relevant case law can be found in the following judgments of the CJEU: *Case C-375/97, General Motors, Case 252/07, Intel, Case C-408/01, Adidas-Salomon, Case C-487/07, L'Oreal v Bellure and Case C-323/09, Marks and Spencer v Interflora and Case C383/12P, Environmental Manufacturing LLP v OHIM*. 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 and Environmental Manufacturing, paragraph 34.*

(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*).

84. For the purposes of this ground, the opponent relies upon the First Earlier Mark only. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the First Earlier Mark and the applicant's mark are similar. Secondly, the opponent must show that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them in the sense of the First Earlier Mark being brought to mind by the later mark. Finally, assuming the first three conditions have been met, section 5(3) requires that

one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

## **Reputation**

85. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

86. In determining whether the opponent has demonstrated a reputation for the services relied upon, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with those goods services. In reaching this decision, I must take all of the evidence into account including “the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertaking in promoting it”.

87. I have summarised the opponent's evidence of use in relation to the UK above. I also note the following in relation to the EU market:

- a) The earliest introduction of COOKIDOO in the EU was August 2016 (it has been introduced in countries including Germany, Austria, France, Italy and Poland).
- b) The following figures have been provided for users of Cookidoo in the EU:

	<b>2017</b>	<b>2018</b>	<b>2019</b>
<b>Austria</b>	8,494	15,962	27,190
<b>Czech Republic</b>	708	1,313	2,533
<b>Spain</b>	29,106	78,038	133,937
<b>France</b>	116,237	184,288	249,418
<b>Germany</b>	224,592	318,279	469,912
<b>Italy</b>	28,475	53,774	85,979
<b>Poland</b>	10,341	34,763	78,773
<b>Portugal</b>	10,420	21,502	44,591

- c) The following figures have been provided for turnover figures (in thousands of euros) for Cookidoo subscriptions:

	<b>2017</b>	<b>2018</b>	<b>2019</b>
<b>Austria</b>	118,87	378,81	638,47
<b>Belgium</b>	0,82	22,27	64,93
<b>Czech Republic</b>	6,51	21,43	39,07
<b>Spain</b>	240,65	1.727,84	3.167,81
<b>France</b>	1.679,37	4.584,89	6.425,82
<b>Germany</b>	3.570,87	8.214,44	11.834,11
<b>Italy</b>	351,58	1.236,87	1,998,69
<b>Poland</b>	91,35	601,76	1.409,95
<b>Portugal</b>	135,75	469,19	780,10

d) Various examples of Cookidoo being reference in German publications are provided.<sup>7</sup>

88. For the same reasons already outlined above, I do not consider the opponent's evidence sufficient to establish the requisite reputation in the UK. I recognise that the sales figures are much higher for the EU as a whole and there has clearly been more widespread use. However, no advertising expenditure figures have been provided. There are no market share figures and very little information about promotional activities have been provided. The earliest use in the EU is 2016 and so there has only been a period of 3 years use prior to the relevant date. Taking the evidence as a whole into account, I am not satisfied that the opponent has demonstrated the requisite reputation in either the UK or the EU. However, even if I am wrong in my finding regarding the EU, the opponent has failed to explain how a link could be made in the mind of the UK relevant public absent a reputation here. Further, for the same reasons outlined above, I can see no reason why the average consumer would make a link between the marks based upon a common element which has low (or no) distinctiveness, particularly given the distance between the services the opponent claims a reputation for and the goods of the applicant. Consequently, the opposition based upon this ground would have failed in any event.

89. The opposition based upon section 5(3) is dismissed.

## **CONCLUSION**

90. The opposition is dismissed the application may proceed to registration.

## **COSTS**

91. The applicant has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£1,350**, calculated as follows:

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<sup>7</sup> Exhibit MK5

Filing a counterstatement and considering the Notice of opposition	£350
Considering the opponent's evidence and filing submissions during the evidence rounds	£650
Written submissions in lieu	£350
<b>Total</b>	<b>£1,350</b>

92. I therefore order Vorwerk International AG to pay BSH Hausgeräte GmbH the sum of £1,350. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 15<sup>th</sup> day of May 2023**

**S WILSON**  
**For the Registrar**

## ANNEX

The opponent relies upon the following goods and services:

### **The First Earlier Mark**

#### Class 7

Electric apparatus for household and industrial use in the field of nutrition and health, namely household knives, mills, grinders, fruit presses, blenders and whisks for household purposes; Mechanical apparatus for making food and beverages, in particular for chopping, cutting, milling, crushing, grating, mixing, beating, stirring, emulsifying and kneading, electric kitchen machines; Electric kitchen machines with integrated chopping, grinding and weighing functions; Fittings for all the aforesaid goods; Electric knives, Bread cutting machines, Electric can openers, Aerated beverage-making machines.

#### Class 9

Recorded computer programs for operating electric household apparatus in the field of nutrition and health, computer programs (downloadable software) for internet platforms relating to the topics of cooking, household, nutrition and health, and for operating electric household apparatus in the field of nutrition and health, recorded computer software for operating electric household apparatus in the field of nutrition and health, downloadable computer software for internet platforms relating to the topics of cooking, household, nutrition and health, and for operating electric household apparatus in the field of nutrition and health; Computer software for operating electric apparatus for household use in the field of nutrition and health; Electronic publications, being downloadable and/or recorded on data carriers, relating to the topics of cooking, household, nutrition and health, and household apparatus; Magnetic data carriers for use with electric household apparatus; Modems for use in or with electric household apparatus, apparatus for recording, transmission or reproduction of sound or images for use in or with electric household apparatus; Parts and fittings for all the aforesaid.

#### Class 11

Electric cooking utensils; Electric containers for cooking, electric kitchen machines with integrated cooking functions, fittings for the aforesaid goods; Electric microwave

ovens; Electric broilers; Electric appliances for making yoghurt, electric machines for making ices, beverage cooling apparatus.

#### Class 16

Printed matter relating to the topics of cooking, household, nutrition and health, and household apparatus; Printed publications relating to the topics of cooking, household, nutrition and health, and household apparatus; Documents relating to the topics of cooking, household, nutrition and health, and household apparatus; Instructional and teaching material (except apparatus) relating to the topics of cooking, household, nutrition and health, and household apparatus; Periodicals, magazines, newspapers, newsletters, books, recipe books, cookery books, recipe cards, book jackets, all of the aforesaid relating to the topics of cooking, household, nutrition and health, and household apparatus.

#### Class 35

Marketing, market research and market analysis; Business management and organisation consultancy; Arranging and concluding commercial transactions for others; Arranging contracts for the buying and selling of goods; Advertising; Online advertising on computer networks; Presentation of the aforesaid goods included in classes 7, 9, 11, 16 and 21, away from business premises by means of direct, personal contact between suppliers and customers, and arranging of contracts, for others, for the buying and selling of the aforesaid goods, arranging of contracts, for others, for the selling of goods via the Internet.

#### Class 38

Telecommunications; Providing access to computer programs on data networks, providing access to information on the Internet, providing access to databases, providing access to computer software on data networks, providing access to non-downloadable software applications on data networks, providing platforms on the Internet, providing portals on the Internet, providing access to virtual spaces, Internet platforms and/or social networks for the exchange of data and information; Providing access to computer networks; Providing telecommunication channels for teleshopping services; Providing access to a searchable online evaluation database for buyers and sellers.

### Class 41

Education; Providing of training; Entertainment; Sporting and cultural activities; Organisation and conducting of sporting and cultural events; Providing online electronic publications, not downloadable; Desktop publishing (design of publications supported by computers); Publication of texts (other than publicity texts); Publication of books; Publication of printed matter in electronic format, including on the Internet; On-line publication of electronic books and journals; Publication of magazines; Providing of online databases featuring instructions for recipes, recipe selection, food planning, menu planning and with cooking and baking instruction.

### Class 43

Information provided via an online database relating to recipes for meals and beverages, cooking and preparing of meals, cooking recipes and cooking tips.

## **The Second Earlier Mark**

### Class 9

Recorded and unrecorded mechanical, magnetic, magneto-optical, optical and electronic data carriers; Digital data carriers; Modems; Electronic publications (downloadable and/or stored on data carriers).

## **The Third Earlier Mark**

### Class 9

Computer programs (stored), computer programs (downloadable), computer software (stored), computer software (downloadable); software for the operation of household electric apparatus in the field of nutrition and health; electronic publications (downloadable and/or stored on data carriers); magnetic data carriers; recorded and blank mechanical, magnetic, magneto-optical, optical and electronic carriers for sound and/or image and/or data, digital data carriers; modems; apparatus for the recording, transmission and reproduction of sound and image; parts and accessories for the aforementioned goods.



### Class 11

Electric containers for cooking, namely pressure cookers, electric kitchen machines with integrated cooking function, accessories for the aforementioned goods.<sup>8</sup>

### Class 35

Retail services with regard to recipes, cooking instructions, cooking tips, recipe books, printed matters, electronic publications, data carriers, modems, data transmission apparatus, kitchen machines, electric cooking apparatus, electric kitchen machines with integrated cooking function and accessories for the aforementioned goods, also via the Internet.

### Class 38

Telecommunications; providing access to computer programs on data networks, providing of access to information on the Internet, providing access to databases, providing access to computer software on data networks, providing access to non-downloadable software applications on data networks, providing access to platforms on the Internet, providing access to portals on the Internet.

### Class 41

Providing of electronic publications (not downloadable); desktop publishing (design of publications supported by computers); publication of texts (other than publicity texts); publication of books; publishing of printed matter in electronic form, also via the Internet; publication of periodicals and books in electronic form, also via Internet; online publication of periodicals and books in electronic form; online publication of recipes for recipes selection, meal planning and menu planning and with cooking and baking instructions.

### Class 43

Information services via an online database relating to recipes for meals and beverages, cooking and preparation of meals, cooking recipes and cooking tips.

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<sup>8</sup> The opponent only relies upon the accessories in this class rather than the goods themselves, but has included them in their TM7 to identify what goods the accessories relate to.