

**O-487-15**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3067854  
BY FOSHAN SHUNDE HUIERJIA ELECTRICAL PRODUCT CO., LTD**

**TO REGISTER THE TRADE MARK:**

**Delong**

**IN CLASS 11**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 403298 BY DE' LONGHI APPLIANCES S.R.L.**

## BACKGROUND AND PLEADINGS

1. On 11 August 2014, Foshan Shunde HuiErJia Electrical Product Co., Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the following goods in class 11:

Lamps; cooking utensils, electric; pressure cookers [autoclaves], electric; refrigerators; extractor hoods for kitchens; heating apparatus; taps [cocks, spigots] [faucets (Am.)] for pipes; radiators, electric; heaters for baths; sterilizers; disinfectant apparatus.

The application was published for opposition purposes on 05 September 2014.

2. The application is opposed by De' Longhi Appliances S.R.L. (“the opponent”). The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all of the goods in the application. The opponent relies upon Community Trade Mark (“CTM”) registration no. 1334291, shown below, applied for on 04 October 1999 and for which the registration procedure was completed on 16 January 2001:



The opponent relies upon all of the goods for which the earlier mark is registered, namely:

- Class 07 Heat pumps, electric machines and appliances for household purposes; electric machines and apparatus for cleaning; steam cleaning machines; vacuum cleaners; machines for cleaning and washing floors and carpets; window washers; wax-polishing appliances; kitchen apparatus and utensils, electric; dishwashers, washing machines; ironing machines.
- Class 09 Flat irons, hygrometers, thermometers.
- Class 11 Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.
- Class 21 Household or kitchen utensils and containers; cooking pots; cookware; small hand-operated appliances and utensils, for kitchen and household purposes; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass; glassware, porcelain and earthenware not included in other classes.

3. In its Notice of Opposition, the opponent states:

“4. The applicant’s sign is very similar to the Opponent’s sign and covers goods that are identical or similar to the goods covered by the Opponent’s registration. As a result, confusion on the part of the average consumer is inevitable [...]”.

4. The applicant filed a counterstatement in which it denies the basis of the opposition. As these are the only comments I have from the applicant, they are reproduced in their entirety below:

“The applicant deems that the applied trademark is quite different from the opponent’s registered trademark. Here are the grounds:

1: The applied mark consists of the stylized wording of “DeLong” while the opponent’s mark consists of the white stylized wording “Dē Longhi” in a black background with a white and a black frame. It is easy to tell the difference at the first sight of the two marks and thus, they will not cause any confusions in the market.

2: A big difference exists in the structure of the two marks. The applied mark is just the stylized wording while the opponent’s mark is designed as a device with a surround.

3: From the business impression point, the opponent’s mark focus on the wording of “Dē Longhi” with a eye-catch surround, while the applied mark catch the customers’ eyes only with the different term of “DeLong”. The opponent’s mark, as a whole, is impressed by the consumers with its designed wording in a frame, while the applied trademark is only the word of DeLong.

Therefore, we deem that the applied will not create any confusion in the mark with the opponent’s trademark and the opponent’s opposition could not be workable”.

5. Only the opponent filed evidence. Whilst neither party asked to be heard, the opponent filed written submissions in lieu of attendance at a hearing. I will bear these submissions in mind and refer to them, as necessary, below.

### **The opponent’s evidence**

6. The evidence consists of a witness statement from Marco Piccitto, who has been General Counsel for the opponent since 2004, with one exhibit. I do not intend to summarise the evidence here but will refer to it as appropriate later in this decision. However, I pause to note that the witness makes a number of submissions which go to grounds under sections 5(3), 5(4)(a) and 3(6). None of these grounds has been pleaded by the opponent and my decision will be made in relation to the pleaded 5(2)(b) ground only.

## DECISION

7. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

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

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

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

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

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

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

9. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. As the opponent's earlier mark had been registered for five years or more at the publication date of the opposed application it is, in principle, subject to the proof of use provisions under section 6A of the Act. The opponent provided a statement that it had used its mark for all of the goods for which it is registered. In its counterstatement, the applicant indicated that it did not require proof of use. The opponent can, as a consequence, rely upon all of the goods it has identified.

### **Section 5(2)(b) – case law**

10. 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 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

11. The competing goods are as follows:

Opponent's goods	Applicant's goods
<p><u>Class 07</u> Heat pumps, electric machines and appliances for household purposes; electric machines and apparatus for cleaning; steam cleaning machines; vacuum cleaners; machines for cleaning and washing floors and carpets; window washers; wax-polishing appliances; kitchen apparatus and utensils, electric; dishwashers, washing machines; ironing machines.</p> <p><u>Class 09</u> Flat irons, hygrometers, thermometers.</p> <p><u>Class 11</u> Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.</p> <p><u>Class 21</u> Household or kitchen utensils and containers; cooking pots; cookware; small hand-operated appliances and utensils, for kitchen and household purposes; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass; glassware, porcelain and earthenware not included in other classes.</p>	<p><u>Class 11</u> Lamps; cooking utensils, electric; pressure cookers [autoclaves], electric; refrigerators; extractor hoods for kitchens; heating apparatus; taps [cocks, spigots] [faucets (Am.)] for pipes; radiators, electric; heaters for baths; sterilizers; disinfectant apparatus.</p>

12. The General Court confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, that, even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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”.

13. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs [30] to [38]).

14. Other than the opponent’s assertion in both its statement of grounds and its written submissions that the goods are “partly identical and partly similar”, I have no submissions from the parties on the similarity or identity of the goods. As both marks have goods in class 11, it is appropriate to begin my assessment with that class.

15. The opposed application includes “lamps”, which are used to generate either light or heat. They fall either within the ambit of “apparatus for lighting” or “apparatus for heating” in class 11 of the opponent’s earlier trade mark registration. The goods must consequently be considered identical.

16. The opposed application includes other goods whose purpose is to generate heat, namely “heating apparatus”, “radiators; electric” and “heaters for baths”. All of those goods are covered by the broader category “apparatus for heating” in the opponent’s earlier mark and the goods are, therefore, identical.

17. The applicant’s “cooking utensils, electric” are encompassed by the opponent’s “apparatus for cooking” and are identical. As “pressure cookers [autoclaves], electric” may also be used for cooking, they too are covered by the opponent’s wider term “apparatus for cooking” and are identical.

18. In addition to their use as cooking apparatus, pressure cookers may be used for sterilisation. Other goods with the same purpose in the applicant’s specification are “sterilizers” and “disinfectant apparatus”. All of these goods come under the scope of the opponent’s “apparatus for sanitary purposes” and are identical.

19. The applicant’s “taps [cocks, spigots] [faucets (Am.)] for pipes” fall within the ambit of “apparatus for water supply” and must be considered identical. Alternatively, taps may be used in the pipework of heating or steam generation systems and would therefore be encompassed by and are identical to “apparatus for heating, steam generating”.

20. The applicant’s “extractor hoods for kitchens” are used for ventilation and are covered by the opponent’s “apparatus for ventilating”. “Refrigerators” are self-evidently

within the scope of “apparatus for refrigeration”. Both of these goods are, consequently, identical to the opponent’s goods.

21. As I have found that all of the goods within the applicant’s specification are identical to the class 11 goods of the opponent’s earlier registration, I do not need to consider the other classes in the opponent’s specification.

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

22. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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. 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.”

23. In view of my findings, above, regarding the identity of the goods in the parties’ specifications in class 11, the relevant average consumer is the average consumer of the identical goods in class 11. As the opponent would be in no better a position were I to extend my analysis to its other classes, I will consider only the average consumer of the goods in class 11. That average consumer is, in my view, a member of the general public. For some goods, for example, heating apparatus and taps for pipes, the average consumer may also be a tradesperson. I have no submissions on the likely channels of trade of these goods. However, in my experience, the general public purchasing such goods would do so by selecting the items from shelves in a retail shop, or from a catalogue or website. This method of selection involves primarily visual considerations, although there may be an aural component, particularly if advice is sought from a salesperson. For the tradesperson, selection of goods is also likely to be primarily visual, by selection off a shelf, catalogue or online but there will also be an aural consideration, as orders may be placed by telephone or over the counter at, for example, a builders’ merchant, without a visual inspection of the goods.

24. Turning to the degree of care taken in selecting the product, the nature of the goods is such that they are bought fairly infrequently, particularly among the general public. In addition, the cost of the goods is not trivial and may be significant for some items, for example, refrigerators and extractor hoods for cookers. The goods at issue are also technical in nature. For all of these reasons, I come to the view that the goods are not casual purchases. However, notwithstanding what I have said, nor do I consider that

they will be purchased with the highest degree of care and attention. It is my view that both groups of average consumer will take an average degree of attention in choosing the majority of these goods, although I accept that, for the general public, a slightly higher degree of attention may be paid in the selection of goods such as refrigerators and extractor hoods for cookers.

### Comparison of trade marks

25. 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 trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“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.”

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

Opponent’s trade mark	Applicant’s trade mark
	

27. According to the applicant, the application “consists of the stylized wording of “Delong” while the opponent’ [sic] mark consists of the white stylized wording “Dē Longhi” in a black background with a white and a black frame”. For its part, the opponent submits that “[t]he Applicant’s sign consists of the word DELONG in stylised form. The Opponent’s sign consists of the word DE’ LONGHI in an oval frame. [...] The comparison to be made is essentially between DELONG and DE’ LONGHI”.

28. I agree with the parties to the extent that the applicant's mark is the six-letter word "Delong". The initial letter is capitalised, with the other letters being in lower case. It is printed in black in a slightly stylised font. There are no other elements to contribute to the overall impression, which is dominated by the word itself. The stylisation plays only a minimal role.

29. The opponent's mark is comprised of the eight-letter word "DēLonghī", in a bold typeface, which appears on a black oval background with a line border. The initial 'D' and the 'L' are in upper case, while the remaining letters are in lower case. Additionally, there is a horizontal line over the 'ē' in the opponent's mark. It could be said that the effect of the capitalisation is to create a break in the mark and give the impression of two words brought together. There is, however, no space between the 'ē' and the 'L' to reinforce any separation of elements. Even if it were recognised as a word of foreign, possibly Italian, origin, I think it more likely that the average consumer would perceive "DēLonghī" as a unit, essentially as one word. Furthermore, I consider the word "DēLonghī" to be the element that has the greatest impact in the overall impression of the mark. A weaker role is played by the black background and border.

30. Visually, there are some presentational differences between the marks, including, as the applicant points out, the presence of a background and border in the opponent's mark. Further differences are in the typefaces, and the upper case 'L' and the horizontal line above the 'ē' in the opponent's mark. Given the role of these aspects in the overall impression, however, such differences are not greatly significant, though I do not disregard them. The main point of similarity is in the shared six letters "Delong", with the same upper case "D", at the beginning of both marks, although the similarity is slightly tempered by the difference created by the additional letters "hī" at the end of the opponent's mark. Having regard to all the similarities and differences, and bearing in mind my assessment of the overall impression of the respective marks, I consider there to be a medium degree of visual similarity.

31. In terms of aural similarity, the opponent argues that "the words DELONG and DE' LONGHI are very similar since they share the same six letters "D-E-L-O-N-G"; the letter H is mute and is not pronounced". The applicant has made no submissions on this point. The opponent's mark would, in my view, be articulated either as "dee-long-ee" or "day-long-ee", although I do not discount the possibility that it may also be pronounced as "dee-lon-gee" or "day-lon-gee". The applicant's mark would be articulated either as "dee-long" or "day-long". The marks share the first two syllables but, as the opponent's mark has a third syllable, the marks are not aurally identical. I consider that the marks are aurally similar to a reasonably high degree.

32. Regarding the conceptual similarity of the marks, I indicated above that the opponent's mark may be perceived as a word of foreign, possibly Italian, origin. I would put it no higher than that. The opponent asserts that "DēLonghī" has no particular meaning. I agree that the average consumer would not attribute a particular meaning to "DēLonghī" and would probably perceive it as an invented word. I consider that the

same would apply to the applicant's "Delong". As a consequence, the conceptual similarity between the marks is neutral.

### **Distinctive character of the earlier trade mark**

33. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. 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).”

34. I indicated at paragraph 32 that I consider that the average consumer would perceive “DēLonghi” as an invented word. As a result, I am of the view that the earlier mark is inherently highly distinctive.

35. The opponent filed evidence in support of its opposition. In that evidence, the opponent states that the De' Longhi family started the business in 1902 and goes on to detail the history of the business's expansion. The opponent's evidence also includes a number of turnover figures, both for international and for UK sales. However, no breakdown of these figures is provided and there are no exhibits to support the claims.

On the basis of the evidence filed, I am not in a position to determine that the earlier mark has an enhanced distinctive character in relation to goods in class 11. I should make it clear that, even if the opponent's evidence were persuasive on this point, it is unlikely that its position would be improved materially, given my finding that the earlier mark is inherently highly distinctive.

### **Likelihood of confusion**

36. In determining whether there is a likelihood of confusion, 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 vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind.

37. Earlier in this decision I found that:

- the average consumer is a member of the general public or a tradesperson, who will select the goods primarily by visual means (though I do not discount an aural component) and who will pay, in the main, an average degree of attention in their selection;
- the goods are identical;
- the marks are visually similar to a medium degree, aurally similar to a reasonably high degree and conceptually neutral;
- the opponent's mark is inherently highly distinctive. The evidence provided does not enable me to make a finding of enhanced distinctiveness.

Bearing all of these factors in mind, and taking into account the principle of imperfect recollection, I am satisfied that there is a likelihood of direct confusion between the marks, i.e. that the average consumer will mistake one mark for another. For the avoidance of doubt, I would have reached the same conclusion even if I had concluded that the average consumer would pay a high degree of attention to the selection of the goods.

### **Conclusion**

38. The opposition succeeds in full.

## Costs

39. As the opponent has been successful it is entitled to a contribution towards its costs. The evidence filed by the opponent did not assist me in making a decision, the single exhibit being a printout from the Register for the opposed mark: I make no award in respect of the opponent's evidence. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. Using that TPN as a guide but bearing in mind my comments, above, I award costs to the opponent on the following basis:

Official fees:	£100
Preparing a statement and considering the other side's statement:	£200
Written submissions:	£200
Total:	£500

40. I order Foshan Shunde HuiErJia Electrical Product Co., Ltd to pay to De' Longhi Appliances S.R.L. the sum of **£500**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 20th day of October 2015**

**Heather Harrison  
For the Registrar  
The Comptroller-General**