

## TRADE MARKS ACT, 1963

Decision in Hearing under Section 26

IN THE MATTER OF two applications for the registration of trade marks (Nos. 152919 and 152920) and in the matter of an opposition thereto.

KELLY HUNTER LIMITED Applicant

BOYNE VALLEY FOODS LIMITED Opponent

### The applications

1. On 7 December, 1992, KELLY HUNTER LIMITED, an Irish company, of Molesworth House, Molesworth Street, Dublin 2, Ireland, Manufacturers and Merchants made applications (Nos. 92/6400 and 92/6401) to register the word KITCHENMATE as a Trade Mark in Part A of the Register in Classes 8 and 21 in respect of the following specifications of goods:

<b>Appln. No.</b>	<b>Class</b>	<b>Goods</b>
92/6400	8	Cutlery, forks and spoons; tongs; vegetable shredders and slicers.
92/6401	21	Small domestic containers (not of precious metals or coated therewith); cutting boards for use in the kitchen; tableware; salad bowls; kitchen utensils; soup bowls; sieves; all the aforementioned goods being included in Class 21

2. The Applications were subsequently accepted for registration in part B of the Register and advertised accordingly under Nos. 152919 and 152920 in Journal No. 1740 on 10 August, 1994.
3. Notices of Opposition to the registration of the marks pursuant to Section 26 of the Act were filed on 5 May, 1995 by BOYNE VALLEY FOODS LIMITED, an

Irish company of Mell, Drogheda, Co. Louth. The Applicant filed counter-statements on 31 May, 1995 and evidence was, in due course, filed by the parties under Rules 37, 38, 39 and 40 of the Trade Marks Rules, 1963.

4. The Opposition became the subject of a Hearing before me, acting for the Controller, on 10 December, 2003. The parties were notified on 12 February, 2004 that I had decided to dismiss the opposition and to allow the marks to proceed to registration. I now state the grounds of my decision and the materials used in arriving thereat.

### **Notices of Opposition**

5. In its Notices of Opposition the Opponent itemises a number of facts and grounds of opposition, which may be summarised as follows:
  - (i) The Opponent is a manufacturer and merchant of, *inter-alia*, cleaning sponges for household cleaning purposes, and related products.
  - (ii) The Opponent is the proprietor of the trade mark KITCHEN MATE registered under No. B125544<sup>1</sup> in Class 21 in respect of cleaning sponges with both abrasive and non-abrasive sides for household cleaning purposes.
  - (iii) Owing to the identity of the respective trade marks of the Opponent and the Applicant, and having regard to the similarity of the relevant goods, the applications for registration should be refused under Section 20 of the Act.
  - (iv) The Applicant's trade mark would not be entitled to protection in a court of law because of the pre-existing reputation that the Opponent has in the mark and because of the likelihood of confusion and deception that would arise from use by the Applicant of the mark; accordingly, the applications should be refused under Section 19 of the Act.
  - (v) The Applicant is not the proprietor of the mark and does not intend to use the mark and registration should, therefore, be refused under Sections 2 and 25 of the Act.

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<sup>1</sup> reproduced at APPENDIX I

- (vi) The mark is neither adapted to distinguish nor capable of distinguishing the Applicant's goods and registration would be contrary to Sections 17 and 18 of the Act.
- (vii) Registration of the mark would prejudice and embarrass the Opponent in the conduct of its business and registration should be refused in exercise of the Controller's discretion.

### **Counter-Statements**

6. In its Counter-Statements the Applicant denies all of the grounds of opposition raised against its applications and admits only the Opponent's statement of its ownership of registration No. B125544, KITCHEN MATE in Class 2.

### **The evidence**

#### *Rule 37*

7. Evidence submitted by the Opponent under Rule 37 consisted of a Statutory Declaration (and Exhibits PC1 and PC2) dated 8 February, 1996 of Philip Cozens, Manager of Boyne Valley Foods Limited. Mr. Cozens refers to his company's registration of the trade mark KITCHEN MATE under No. B125544 and states that the mark was first used in the State in January, 1988 in relation to cleaning sponges for domestic use. He exhibits a sample of the relevant product in packaging that bears the mark together with the word "Killeen" and the slogan "Fly through the washing up". Since 1988, 3.5 million individual cleaning sponges have been sold under the mark yielding a figure of approximately £850,000 in turnover (individual figures for the years 1988-1995 are quoted). Goods bearing the mark have been sold throughout the State through wholesalers and retailers, including major supermarket chains. A list of the Opponent's customers and copies of invoices are exhibited. Mr. Cozens goes on to state that it is his opinion that use by the Applicant of the trade mark propounded for registration in relation to its goods is likely to lead to confusion and deception and to the association of the Applicant's goods with the Opponent.

#### *Rule 38*

8. Evidence submitted by the Applicant under Rule 38 consisted of a Statutory Declaration (and Exhibits KH1-KH4) dated 12 June, 1996 of Brian Doyle,

Managing Director of Kelly Hunter Limited. Mr. Doyle says that his company has been using the trade mark KITCHENMATE in the State since September, 1989 in relation to “*spoons, boards and other related products*” and that turnover in goods sold under the mark in the previous 7 years amounted to over £50,000 (individual figures for the years 1989-1995 are quoted). Products bearing the mark have also been exported throughout the EU and to the Far East, Canada, Australia and New Zealand. Total export sales for the period 1989-1995 exceeded £7,000,000. Mr. Doyle exhibits a brochure and other material showing how the trade mark has been used; this material includes pictures of display stands and cases holding chopping boards and bowls bearing the trade mark together with the slogan “Very Hygienic!”. Samples of products labelled with the mark are also exhibited. Mr. Doyle also states that approximately £5,000 has been spent on advertising under the mark in the previous 7 years and he exhibits an advertisement from the magazine “Housewares” (January/February, 1996 edition) which features the mark. He also exhibits further pages from the January/February, 1996 and March, 1996 editions of that magazine in which references to the mark are to be found. On the basis of this evidence, Mr. Doyle asserts that the trade mark KITCHENMATE is well known by both the trade and the public. Referring to the Opponent’s evidence under Rule 37, he disputes the claim that there is a likelihood of confusion between the marks of the respective parties; he states that the respective goods are different, that the marks are somewhat different and that there is no evidence of actual confusion despite the fact that both marks have been used in the State for a number of years.

*Rule 39*

9. Evidence submitted by the Opponent under Rule 39 consisted of a Statutory Declaration dated 24 January, 1997 of Denis Moynihan, Financial Director of Boyne Valley Foods Limited. Referring to the Statutory Declaration of Brian Doyle, Mr. Moynihan disputes that deponent’s claim that the Applicant in these proceedings has been using the trade mark KITCHENMATE in the State since 1987; he states that the Opponent conducted a survey of all major retail outlets in the first half of 1995 and could not find any products of the Applicant bearing the mark. Nor has the Applicant produced evidence in the form of invoices, orders, etc. of use of the mark in the State until well after the date of the present

applications for registration. Mr. Moynihan also criticises the Applicant's evidence of its advertising under the trade mark, stating that no breakdown has been given of the figure of £5,000 spent on advertising and pointing out that the "Housewares" magazine referred to in the Applicant's evidence appears to be a UK publication. As to the Applicant's claim to have exported over £7,000,000 worth of products under the trade mark, Mr. Moynihan states that no evidence supporting this claim has been filed. He denies that the trade mark would have been associated with the Applicant at the date of filing of the present applications for registrations and he refutes Mr. Doyle's contentions to the effect that the respective marks of the parties are different and that the goods to which they are applied are significantly different.

*Rule 40*

10. Evidence submitted by the Applicant under Rule 40 consisted of a further Statutory Declaration (and Exhibits KH5-KH7) dated 2 May, 1997 of Brian Doyle in which the deponent addresses a number of the criticisms of his earlier evidence under Rule 38. Firstly, he exhibits a letter from B.L. Hanly & Co. Ltd. (the Applicant's sole distributors in the State) in which the writer states that his company has been distributing products for Kelly Hunter Limited since 1987 and that sales of KITCHENMATE spoons were launched in October 1989 and have, since then, been made in regular quantities to the leading multiple retailers such as Dunnes Stores, Quinnsworth and Roches Stores. Next, Mr. Doyle exhibits a letter from Marsh Mackey & Co. (the Applicant's auditors) in which the writer states that the KITCHENMATE brand was used on a significant proportion of the products sold by the Applicant over the period 1990-1996 and that, for the year ended 31 August, 1996, 50% of customers and 40% of sales were KITCHENMATE related. Exhibited in support of this latter assertion is a copy of an analysis of the UK market in 1995 by an entity called Housewares Business Centre, which shows that KITCHENMATE products accounted for over 40% of sales in the Hyper/Supermarket sector and over 20% in the Specialist Stores sector. Also exhibited is a letter from a Mr. John Fagan, Sales Director of Future Print Limited, who says that between 4 and 5 million KITCHENMATE labels have been supplied to Kelly Hunter Limited since that company started up in 1987. With regard to advertising, Mr. Doyle states that his company confines

itself to point of sale advertising, samples of which were exhibited with his earlier Declaration. As to Mr. Moynihan's comments with regard to the claimed figure of £7,000,000 in respect of exports of KITCHENMATE products, Mr. Doyle gives a breakdown of the figures for the individual years 1989 to 1995 and states that the Irish Trade Board has helped his company in developing its brand worldwide; he cites a number of large retail chains in the UK and continental Europe that stock his company's products, which he says are also strong in Eastern European countries including Poland, Czech Republic, Hungary, Slovakia, Croatia, Slovenia and Russia. He estimates that sales worldwide of KITCHENMATE Products in 1997 will total approximately £2,000,000, all of which products will be exported from the State. Finally, he refutes Mr. Moynihan's assertion that the marks of the parties are almost identical, stating that his company has developed a distinctive lettering and colour combination for its KITCHENMATE brand; in addition, he states, the respective products of the parties are sold in different areas of retail stores and no confusion will arise between them.

### **The hearing**

11. At the Hearing the Opponent was represented by Mr. Paul Coughlan, BL instructed by Messrs. Tomkins & Co. and the Applicant by Mr. Cliff Kennedy, Trade Mark Agent of MacLachlan & Donaldson. Of the grounds of opposition stated in the Notice of Opposition filed on behalf of the Opponent, only those under Sections 19 and 20 of the Act were canvassed at the hearing. I am satisfied that my consideration of the matter may be confined to these sections.

*Section 19 – would the mark be disentitled to protection in a court of law?*

12. Section 19 of the Act reads as follows:

“It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of law, or would be contrary to law or morality, or any scandalous design.”

13. The Opponent argues that the present mark would be disentitled to protection in a court of law by reason of its being likely to cause confusion among consumers who, having come to know the Opponent's mark as used on its goods, will be caused to wonder whether goods of the Applicant bearing the disputed mark are not those of the Opponent. The Applicant responds that, in order for the prohibition under Section 19 to apply, there must be a real danger of confusion, which danger does not exist in this case owing, largely, to the differences in the respective goods. The parties agree on the test to be applied in determining an objection to registration under Section 19 but they are at odds as to the result of the application of that test to the facts of the case at hand.

14. The test for an objection under Section 19 was formulated by Evershed J in *Smith Hayden & Co. Ltd.'s Application* [1946] 63 RPC 97, as follows:

*“having regard to the reputation acquired by the [earlier mark], is the Court satisfied that the mark applied for, if used in a normal and fair manner in connection with any goods covered by the registration proposed, will not be reasonably likely to cause deception and confusion amongst a substantial number of persons.”*

15. That statement was considered by Lord Upjohn in *BALI Trade Mark* [1969] RPC 472, who asserted that the reference to the “*reputation acquired by*” the earlier mark should, more correctly, have been to the “*user of*” it. He went on,

*“... it is not necessary ... to prove that there is an actual probability of deception leading to passing-off.... It is sufficient if the result of the registration of the mark will be that a number of persons will be caused to wonder whether it might not be the case that the two products come from the same source. It is enough if the ordinary person entertains a reasonable doubt, but the Court has to be satisfied not merely that there is a possibility of confusion; it must be satisfied that there is a real tangible danger of confusion if the mark which it is sought to register is put on the Register.”*

16. Much of the argument presented at the hearing centred on the degree of emphasis that should be placed on each of the potentially contradictory remarks in the foregoing statement, viz., on the one hand that it is sufficient that a number of persons are merely *caused to wonder* whether the products have the same commercial origin and, on the other, that there must be *a real tangible danger* of confusion. The Opponent makes its case by reference to the terms of the former remark while the Applicant relies on the latter for its defence. For my part, I do not think it necessary to conduct a painstaking analysis and assessment of judicial dicta in order to decide the present case. Such pronouncements have been made in the context of analogous statutory provisions but, also, within the specific factual contexts of earlier cases; the words in question are not the words of the statute itself and I am satisfied that they must serve only as a guide to the correct interpretation of the statutory prohibition in the context of the specific facts of this case.

17. Those facts are that the Opponent has, since January 1988, used the KITCHEN MATE mark on its cleaning sponges, which have been sold through retail outlets throughout the State. The Applicant has been manufacturing and selling KITCHENMATE spoons and boards in the State since at least October, 1989 and its products are retailed through a number of the same outlets that stock the Opponent's goods, as well as through other stores. The applications for registration were made on 7 December, 1992 and the question of whether a likelihood of confusion would arise from the registration of the Applicant's mark must be assessed as of that date. By that time, the Opponent had achieved significant sales of its products in money terms and, given the low cost of the items in question, it is fair to infer that a substantial number of individual items had been sold. While the Applicant has achieved very high sales of its products through exports, sales in the State have been significantly lower and are not such as to suggest that its products would have come to the attention of a substantial number of people as of the relevant date. For this reason, I attach no weight to the fact that no evidence of actual confusion has been adduced; the determination of the likelihood of confusion involves an essentially theoretical inquiry.



18. That inquiry may be phrased in the following terms: Given the fact that there have been substantial sales of the Opponent's KITCHEN MATE cleaning sponges, is it likely that the use by the Applicant of the word KITCHENMATE in relation to the goods of the applications (cutlery, kitchen utensils, chopping boards, etc.) will cause a substantial number of people to think that the goods so marked might be made by the Opponent? The assessment must be made from the perspective of the average consumer of the relevant goods and it must have regard to all relevant factors including, of course, the similarities between the marks and the goods but, also, the circumstances of the trade, the level of attention that the consumer may be expected to apply to the purchase of the goods, the degree to which brand identity is important in relation to the goods and the distinctiveness, or lack of it, of the Opponent's mark.
19. While the Applicant argues that the marks are not quite identical, I think that even the Applicant must accept that the differences are very minor and I have attached no significance to those differences in assessing the matter. As to the respective goods, I regard these as being quite dissimilar. The Opponent's goods are household cleaning sponges and the Applicant's are cutlery, domestic containers, kitchen utensils, chopping boards, etc. Those goods are different in their nature, their composition and their purpose. They do not compete with each other in the market-place and nor are they complementary of each other in use. While the Opponent has made much of the fact that the respective goods are retailed through the same stores, the fact is that the retail outlets in question are supermarkets in which one finds a wide array of very different goods. The respective goods have the same end-users and they are all used in the kitchen but they are not goods that I believe the ordinary consumer would regard as similar or would expect to have a common commercial origin.
20. Looking at the Opponent's mark itself, it is immediately clear that the Opponent has devised the mark with a view to making an allusion to the purpose of the goods in relation to which it is used; the KITCHEN MATE cleaning sponge is apt to be understood as being "*a friend in the kitchen*", ready to assist with all one's cleaning needs. This is a perfectly legitimate thing for the Opponent to have done and I make no criticism of it, as such. I refer to it here for the purpose only of

pointing out that the Opponent's trade mark does not possess an inherent distinctiveness and it was, of course, accepted for registration in Part B of the Register, as were the present applications. I think that there is a very obvious difference between the facts of this case and those of a number of the authorities that the Opponent referred me to in the course of the hearing. Those cases, all of which are very well-known, related to marks such as KODAK, LEESONA and PANDA and I think it is fair to say that each involved a mark that was inherently distinctive in relation to the relevant goods. The inherent distinctiveness of those marks must have been a factor in the determination of whether a likelihood of confusion would arise from the use of identical or similar marks. That factor does not apply in this case and I regard the semi-descriptive nature of the Opponent's mark as significant in the assessment of whether the use of the Applicant's mark is likely to cause confusion.

21. An additional, and related, factor in this regard is the way that the Opponent has used its mark. The evidence shows that the mark is used in combination with the word "Killeen" when applied to the packaging of the Opponent's goods (Exhibit PC1 with Mr. Cozens' evidence under Rule 37). The manner in which the words are presented on the package suggests to me that the product in question is called KITCHEN MATE and it is one of a number of products from the "Killeen" range or group. I think this is how the average consumer would perceive and interpret the packaging of the product. This is likely to reduce the impact made by the trade mark KITCHEN MATE in the mind of the consumer and would, I think, reinforce the allusive nature of that mark in his mind.
  
22. I have also considered the circumstances of the trade in the goods of the Applicant and the Opponent and the level of attention that is likely to be paid to the purchase of those goods by the average consumer. The Opponent's goods are very low cost items that are intended for use for a relatively short period prior to disposal. For that very reason, they are, of course, items that are purchased over and over again by the average consumer and the opportunity for brand identity reinforcement is increased accordingly. Nevertheless, I would respectfully suggest that they are not items to whose purchase the consumer is likely to pay more than fleeting attention. The Applicant's goods are more durable in nature and include items

whose selection and purchase is likely to involve a higher level of consideration and attention on the part of the consumer. In terms of the likelihood of confusion between the marks, I do not regard these differences as very significant but they are, nonetheless, a factor that must be taken into account in making that assessment.

23. Having regard to all of the foregoing, I have attempted to make a global assessment (to use the modern phraseology) of the likelihood of confusion arising from the use of the Applicant's mark and, while I would concede that it is a somewhat subjective assessment and might be determined otherwise by someone else, I have concluded that there is no appreciable such likelihood. To my mind, a person who is familiar with the Opponent's mark used on its goods and who subsequently encounters the Applicant's mark on its goods may well be reminded of the Opponent's goods and may even be caused to remark on the fact that the marks are the same. But that is as far as I would go. I do not think that such a person is likely to seriously wonder whether the KITCHENMATE cutlery, utensils, chopping boards, etc. have the same commercial origin as the KITCHEN MATE cleaning sponges. I think it much more likely that he will simply conclude that two unrelated undertakings have each independently come up with the same highly allusive trade mark for their respective kitchen products. The coincidence is not so far-fetched as to be improbable, far less impossible. Notwithstanding the near identity of the marks, all of the other surrounding circumstances (as per Parker J in *Pianotist* [1906] 23 RPC 774) point, in my view, to the conclusion that there is unlikely to be any real danger of confusion. Accordingly, I have decided to dismiss the opposition under Section 19 of the Act.

*Section 20 – should the applications be refused in light of the Opponent's earlier registration?*

24. Section 20 of the Act prohibits the registration of marks that are identical with or closely resemble existing registered marks. The relevant part of the Section reads as follows:

“(1) ..... no trade mark shall be registered in respect of any goods or description of goods that is identical with a trade mark belonging to a different

proprietor and already on the register in respect of the same goods or description of goods, or that so nearly resembles such a trade mark as to be likely to deceive or cause confusion.”

25. In considering the opposition under Section 19, I have already addressed the issues that arise for consideration under Section 20, viz., similarity of marks, whether goods are of the same description and likelihood of confusion. For the reasons set out in paragraph 19, I have decided that the goods for which the Opponent’s mark is registered – household cleaning sponges – are not the same description of goods as those for which the Applicant seeks registration. That being the case, the prohibition against registration under Section 20 cannot apply and I dismiss the opposition under that Section also.

### **Conclusion**

26. The opposition has failed under those provisions of the Act that call for mandatory refusal of registration. The applications may still be refused in the exercise of the Controller’s discretion but I have been given no reasons to exercise that discretion adversely to the Applicant. Accordingly, the opposition is dismissed and the applications are allowed to proceed to registration.

Tim Cleary  
Acting for the Controller

5 March, 2004

# **KITCHEN MATE**