

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2203013
BY PRACTICK LIMITED
TO REGISTER THE TRADE MARKS:**



IN CLASSES 9, 16, 41, 35

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No 51045
BY PRAKTIKER BAU- UND HEIMWERKERMÄRKTE AG
BASED UPON THE EARLIER RIGHTS:**

Praktiker

and



**TRADE MARKS ACT 1994
IN THE MATTER OF Application No 2203013
by Practick Limited
to register the trade marks:**



**as a series of three
in classes 9, 16, 35 and 41
and**

**IN THE MATTER OF Opposition thereto under No 51045
by Praktiker Bau- und Heimwerkermärkte AG**

Background

1) On 14 July 1999 Practick Limited applied to register the above trade marks as a series of three in respect of the following goods and services:

computer software and publications in electronic form supplied on-line from databases or from facilities provided on the Internet, including websites and CD ROMs – class 9

printed matter, instructional and teaching materials, books, periodicals, magazines, handbooks, product and system operating manuals; all in relation to the field of business management – class 16

business management and consultancy – class 35

educational services, workshops, seminars and other training; publishing of instructional and teaching materials; all in relation to the field of business management – class 41

The application was published on 8 March 2000.

2) On 2 June 2000 Praktiker Bau- und Heimwerkermärkte AG filed notice of opposition to this application.

3) The opponent states that he is the registered proprietor the following trade mark registrations:

- United Kingdom registration no 2022473 of the trade mark **Praktiker** which is registered in respect of the following goods:

paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters,

decorators, printers and artists – class 2

industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels, motor spirit and illuminants; candles, wicks – class 4

common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks, non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; goods of common metal; ores – class 6

machines, metal-, wood-, plastics working machines, machines for the chemistry industry, for agriculture, mining, textile machines, machines for the beverage industry, construction machines, packaging machines and machine tools; motors and engines (other than for land vehicles); machine coupling and transmission components (other than for land vehicles); agricultural implements included in Class 7; incubators for eggs – class 7

hand tools and implements (hand operated); hand operated implements for use in agriculture, horticulture and forestry, for the construction of machines; apparatus and vehicles, for the building industry; cutlery; side arms; razors – class 8

apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes – class 11

paper, cardboard and goods made from these materials; goods made from these materials included in Class 16; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (other than furniture); instructional and teaching material (other than apparatus); plastic materials for packaging, playing cards; printers' type; printing blocks – class 16

leather and imitations of leather, goods made of these materials included in Class 18; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery – class 18

building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; non-metallic monuments – class 19

carpets, rugs, mats and matting; linoleum and other materials for covering existing floors; wall hangings (non-textile) – class 27

agricultural, horticultural and forestry products and grains; propagation materials, raw cereal, eggs for hatching, raw woods; living animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt – class 31

- Community trade mark registration no 834945 of the trade mark:



which is registered in respect of the following goods:

chemicals used in industry, science, agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; fertilizers; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry – class 1

bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices – class 3

industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles, wicks – class 4

pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides – class 5

scientific, nautical, surveying, electric, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, electric apparatus and instruments (included in class 9), except optical, photographic or cinematographic apparatus and instruments, or apparatus and instruments for optical, photographic or cinematographic purposes; apparatus for recording, transmission or reproduction of sound; magnetic data carriers, automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus – class 9

vehicles; apparatus for locomotion by land, air or water -12

firearms; ammunition and projectiles; explosives; fireworks – class 13

precious metals and their alloys and goods in precious metals or coated therewith (included in class 14); jewellery, precious stones; horological and chronometric instruments – class 14

paper, cardboard and goods made from these materials (included in class 16); printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging, included in Class 16. playing cards; printers' type; printing blocks – class 16

rubber, gutta-percha, gum, asbestos, mica and goods made from rubber, gutta-percha or gum in the form of blocks, plates, rods, foils, cord or bands (all being semi-finished products); plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal – class 17

leather and imitations of leather, and goods made of these materials and included in class 18; animal skins; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery – class 18

furniture, mirrors, picture frames; goods, included in class 20, of wood, cork, reed, cane,

wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics – class 20

household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware (included in class 21) – class 21

ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (so far as included in class 22); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials – class 22

clothing, footwear, headgear – class 25

carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile) – class 27

games and playthings; gymnastic and sporting articles (included in class 28); decorations for Christmas trees – class 28

tobacco; smokers' articles; matches – class 34

The colours blue and yellow are claimed.

4) The opponent claims that the respective trade marks are similar and that the class 9 and 16 specifications of the application in suit encompass identical or similar goods to those of his earlier registrations; consequently registration of the trade mark in suit would be contrary to Section 5(2)(b) of the Act. The opponent also states that he enjoys a reputation in the European Union in respect of the goods and services for which his Community trade mark is registered. In so far as non-similar goods and services are involved registration of the trade mark in suit would take unfair advantage of or be detrimental to his Community trade mark registration. Consequently registration of the trade mark in suit would be contrary to section 5(3) of the Act.

5) The applicant filed a counterstatement denying the above grounds.

6) Both parties seek an award of costs.

7) Both parties filed evidence.

8) The parties were advised that I considered that a decision on the case could be made without recourse to a hearing. They were advised that if they did not request a hearing it would be assumed that they were content for a decision to be made from the papers. The applicant did not respond. The opponent filed submissions in lieu of attendance at a hearing. Consequently a decision will be taken from a careful study of the papers.

9) Acting on behalf of the registrar I duly give the following decision.

Opponent's evidence

10) The opponent's evidence consists of a witness statement dated 8 June 2001 by Gerald Hobler, who is the permanent legal adviser of the opponent.

11) Mr Hobler states that the opponent commenced use of his trade marks in Germany in 1979 and states that his company has used the PRAKTIKER trade mark extensively in Germany and other European Union states since that time. He exhibits at GH1 material relating to the opponent's activities. He states that the opponent operates a total of 323 establishments of which forty three are located in European countries other than Germany. Mr Hobler gives figures for sales of goods under the PRAKTIKER trade mark for the years 1989 – 1999. He also gives advertising figures for the year 2000 in Germany, Greece, Luxembourg and Austria. He exhibits at GH2 and GH3 samples of advertising and publicity materials used in Austria and Germany respectively. He exhibits at GH4 similar materials relating to Luxembourg. The trade mark shown in GH4 is *bâtiself*; I am not sure how the opponent considers that this assists his case. The material exhibited at GH2 and GH3 is made up of catalogues advertising DIY goods. The catalogues carry the trade mark PRAKTIKER but few of the goods do, they either do not bear brand names or bear brand names such as Bosch, AEG, Black and Decker. In GH3 for instance the only goods that I could readily see bearing the trade mark of the opponent in the 1999 and 1997 brochures were a hammer drill and a circular saw, *Rustikaler Reibeputz* and *Reibeputz Elegant* (the latter two items are both types of roughcast or plaster).

12) Mr Hobler then goes on to make what can be best described as submissions rather than presenting evidence of fact. If necessary I will deal with these submissions in my decision and so will say no more about them here.

Applicant's evidence

13) The applicant's evidence consists of a witness statement dated 17 October 2001 by Geoffrey Owen Peppiatt, who is the chairman of the applicant.

14) Mr Peppiatt states that the applicant is a management consultancy company. He exhibits at GOP1 and GOP2 documentation relating to the business of the applicant. He states that the applicant provides consultancy services to international clients from its United Kingdom base. Mr Peppiatt states that the applicant has no plan to set up an office in Germany. He states that the opponent is a DIY merchant and exhibits at GOP3 documentation relating to this.

15) Mr Peppiatt exhibits at GOP6 an extract from "The New Shorter Oxford Dictionary" to show definitions of the word "practick". The extract indicates that "practick" now only has the following meaning "Chiefly *Sc Law* (now *Hist*). Legal usage, case law. He also exhibits an extract from "The Collins German Concise Dictionary" to show the definition of the word "practick". This is defined as meaning practical man.

16) Mr Peppiatt states that the trading name PRACTICK has been in use since July 1993. He states that to the best of his knowledge no confusion has arisen in relation to the respective signs. He then goes on to state that the applicant spent approximately £7,300 on its marketing in the last financial year (including branding under the PRACTICK name). I am not sure what I am supposed to infer from the last statement – it would appear to imply that not all of the

sum was spent in relation to the PRACTICK name. He states that the applicant also devoted personnel time, costed internally at approximately £54, 000, on marketing and £10, 150 on recruitment advertising. He states that the annual turnover of sales under the trade mark in suit is £1, 717, 923. He does not state to which year this figure relates.

17) The rest of Mr Peppiatt's witness statement can best be characterised as submissions rather than evidence of fact. I will deal with the issues raised therein where I consider it appropriate in my decision and so say no more about them here.

Opponent's evidence in reply

18) The opponent's evidence in reply consists of a witness statement dated 1 February 2002 by Jane Harlow. Ms Harlow is a trade mark attorney.

19) Ms Harlow exhibits at JH1 a copy of the results of an "Awareness Measurement" conducted on behalf of the opponent in May 2001, together with a certified translation thereof. Ms Harlow states that the survey took the form of a telephone survey of 1, 010 individuals (both males and females) in Germany. She states that the survey shows that 40.6% of respondents spontaneously mentioned the PRAKTIKER trade mark when asked to name DIY superstores. When prompted with a list of 10 DIY stores a further 44.3% of respondents knew of the PRAKTIKER name. She states that this was the second highest response. Ms Harlow states that this demonstrates that PRAKTIKER is well known in Germany.

20) This evidence does not reply to anything which can be considered to be unforeseen or surprising in the evidence of the applicant and could have readily been furnished as evidence in chief. So taking into account the parameters set out in *Peckitt's Application* [1999] RPC 337 I do not consider that it is evidence strictly in reply. However, as the applicant has not questioned its admission into the proceedings I do not consider it appropriate to discount it. (Little turns upon this evidence anyway.)

Submissions of the opponent

21) The opponent states that the respective signs are phonetically and visually similar. He states that the respective meanings of the signs will not be known to the relevant public in the United Kingdom. Consequently the respective signs will be viewed as invented words which allude to the word "practical". He, therefore, asserts that the respective signs are semantically similar also.

22) The opponent submits that the class 9 goods of the application in suit will be included in "apparatus for recording, transmission or reproduction of sound" and "magnetic data carriers" of the Community trade mark. He also submits that the specifications in class 16 of his earlier registrations in class 16 must encompass the goods in class 16 of the application in suit.

23) The opponent states that the services encompassed by classes 35 and 41 of the application in suit are not similar to the goods of his earlier registrations. He states that owing to his reputation and that use of the trade mark in suit would undeniably "dilute (his) rights in that mark" that the application in suit should be refused pursuant to section 5(3) of the Act.

Decision

24) The grounds of opposition pursued by the opponent are those under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994. The relevant provisions read as follows:

Section 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.

(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

The term 'earlier trade mark' is defined in section 6 of the Act as follows:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark 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."

Section 5(2)(b) objection

25) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224; 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27.

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 224;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 7, paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 8, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 224;

(h) further, 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; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 9 paragraph 29.

26) In considering the issue of likelihood of confusion I will deal with the Community trade mark registration only. I do not consider that anything turns upon the slight stylisation of the sign and this registration encompasses goods in both classes 9 and 16. I do not consider that the opponent could be in a better position in relation to his United Kingdom registration.

Comparison of goods

27) The earlier registration encompasses the following goods in classes 9 and 16:

scientific, nautical, surveying, electric, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, electric apparatus and instruments (included in class 9), except optical, photographic or cinematographic apparatus and instruments, or apparatus and instruments for optical, photographic or cinematographic purposes; apparatus for recording, transmission or reproduction of sound; magnetic data carriers, automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus – class 9

paper, cardboard and goods made from these materials (included in class 16); printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging, included in Class 16. playing cards; printers' type; printing blocks – class 16

The goods of the application in suit in classes 9 and 16 are:

computer software and publications in electronic form supplied on-line from databases or from facilities provided on the Internet, including websites and CD ROMs – class 9

printed matter, instructional and teaching materials, books, periodicals, magazines, handbooks, product and system operating manuals; all in relation to the field of business management – class 16

“Magnetic data carriers” of the earlier registration encompasses a huge spectrum of goods; anything that is recorded in magnetic form. Consequently these goods would encompass computer software and publications in electronic form. **I, therefore, consider that goods encompassed by class 9 of the application in suit are identical to those of the earlier registration.**

28) The class 16 specification of the earlier registration clearly encompasses all the goods of the application in suit in class 16. The former specification is not qualified and so encompasses goods that relate to business management as well as those that do not. **I, therefore, find that the goods encompassed by class 16 of the application in suit are identical to those of the earlier registration.**

Comparison of signs

29) The trade marks to be compared are as follows:

Earlier registration:



Application in suit:



30) I do not consider that anything turns upon the stylisation of the earlier registration and the bottom two marks of the series of the application in suit. The stylisation is limited and does not alter the essential nature of the respective trade marks.

31) The applicant has argued that the respective trade marks have different conceptual associations. This is based upon the premise that the relevant public will have a knowledge of

German and be aware of an obscure English word. That a word appears in an English dictionary does not mean that the majority of the population will be aware of it. In the instant case I do not believe that the relevant public will be aware either of the meaning of the earlier registration or of the application in suit. I have no evidence to suggest that they would be so aware and I do not consider that this issue can be considered to be covered by judicial notice. I, however, equally cannot concede the argument of the opponent that both signs will be seen as alluding to practical. This is a mere assertion, there is no evidence to support the claim. I have nothing before me which indicates that the relevant public would assign any particular conceptual association to either sign. I, therefore, find that the respective signs are not conceptually similar. However, absent conceptual association I do not consider that distance is put between the signs owing to a conceptual divergence.

32) Phonetically the only difference will arise from the “er” at the end of the earlier registration. In consideration of the respective signs it is necessary to take into account the well known premise of *Tripcastroid* 42 RPC 264 at page 279 that in assessing similarity the beginnings of words are more important than the ends. This decision reflects the way people speak and hear and so is as relevant under the new act as under the old. It is also the position that OHIM follows, for instance in decision no 1126/2000 – Official Journal 10/2000 at page 1506. The final letters “er” will have a vowel sound that is likely to be falling away. It represents a very small phonetic difference between the respective trade marks, a difference that could easily disappear in oral use altogether. I, therefore, consider that the respective trade marks are phonetically similar. Indeed, that they are phonetically highly similar.

33) As the respective trade marks are essentially word marks I consider that the visual impact of the letters is the most important element in a consideration of visual similarity. The respective signs all commence with the same three letters. They also include the letters “tik” In considering the issue of visual similarity I take into account that the public rarely compare trade marks side by side and that they need to rely upon the vagaries of imperfect recollection. Taking into account all these factors I consider that the respective signs are visually similar.

34) Consequent upon the above, considering and comparing the signs in their entirety, I consider that they are similar.

Conclusion

35) The applicant referred in his evidence to the different nature of the businesses of the parties. This is not relevant in my assessment of the likelihood of confusion. I have to consider notional and fair use of the respective signs for the spectrum of goods that they encompass. The applicant also referred to the absence of confusion in the market place. There is no evidence that the opponent has used his trade mark in the United Kingdom, nor that he has used it in respect of the goods encompassed by classes 9 and 16. Absent such use the issue of confusion in the market place is irrelevant; there has been no opportunity for confusion to arise.

36) In considering the likelihood of confusion I have to take into account the interdependency principle of proximity of signs or goods and vice versa. In the instant case the goods are identical. Therefore, a lesser degree of similarity of the signs could lead to a likelihood of confusion. In the instant case I consider that there is also a good degree of similarity between the signs. I have to consider the distinctiveness of the earlier sign, either by nature or nurture. In *Lloyd* the European Court of Justice stated:

“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, judgement 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).”

On the basis of the above criteria I consider that the earlier sign enjoys a good deal of inherent distinctiveness.

37) It is necessary to take into account the nature of the purchasing decision. In respect of the goods of the application in suit it is likely that the purchase will involve a careful and considered decision. However, the purchaser will still be prey to imperfect recollection.

38) Even if I had not found that the signs were similar visually I would have still found that they were similar overall on the basis of the phonetic similarity (see *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* re mere aural similarity being able to create a likelihood of confusion.)

39) Having made a global appreciation, taking into account all the relevant factors, I find that there is a likelihood of confusion in respect of the goods encompassed by classes 9 and 16 of the application in suit.

Section 5(3) objection

40) I have already found that the respective signs are similar. The parties do not dispute that the services of the application in suit in classes 35 and 41 are dissimilar to the goods of the Community trade mark. Consequently the first two criteria of section 5(3) are satisfied.

41) The opponent has to show that his earlier trade mark enjoys a reputation. As this relates to an earlier trade mark as per section 6(1) this reputation must relate to the goods for which it is registered. The evidence of the opponent shows use in relation to DIY stores, i.e. a retail service. His Community trade mark does not include this service, it encompasses goods only. In relation to actual goods there is some very limited evidence of use in relation to certain goods, as referred to in my summary of the evidence. However, I have no additional evidence which shows that these limited number of goods enjoys a reputation. That the opponent sells goods bearing other trade marks such as Bosch and AEG does not mean that he can claim a reputation in respect of such goods.

Jacob J stated in *Euromarket Designs Inc. v. Peters and Crate & Barrel Ltd* [2001] FSR. 20

“For instance, if you buy Kodak film in Boots and it is put into a bag labelled "Boots", only a trade mark lawyer might say that Boots is being used as a trade mark for film. Mere physical proximity between sign and goods may not make the use of the sign "in relation to" the goods. Perception matters too.”

If a German purchaser buys Kreisel combined grout and adhesive (see GH3 – catalogue for 1999) in a PRAKTIKER shop he is not going to perceive the goods as being the product of the opponent or anything to do with the opponent. He could have bought the same product in another shop.

42) Certain of the goods in the catalogues of the opponent do not clearly bear trade marks. It could be that they are “own brand” goods but I cannot tell if this is the case. The evidence of the opponent does not identify goods which are sold under the trade mark PRAKTIKER, it gives an overall picture of a chain of DIY stores.

43) The European Court of Justice in *General Motors Corporation v Yplon SA* Case C-375/97 [2000] RPC 572 set out the criteria by which the issue of reputation should be determined. There is nothing in the evidence of the opponent which convinces me that they have established such a reputation. I take note of the survey evidence exhibited at JHI. However, this relates to a period nearly two years after the relevant date. It tells me nothing about the position at the date of the filing of the application. Also this evidence tells me that at the relevant time the opponent was known for a chain of DIY stores and so this does not move the issue on. It is also a moot point if the survey satisfies the criteria set out in *Imperial Group plc & Another v. Philip Morris Limited & Another* [1984] RPC 293. However, as I do not consider that anything turns upon this survey evidence, this is a matter which can be left to lie.

44) The opponent has failed to establish that he enjoys a reputation in respect of the goods encompassed by his Community trade mark registration. The grounds of objection under section under 5(3) of the Act must, therefore, fail.

45) In the witness statement of Mr Peppiatt he refers to the absence of evidence of reputation in the United Kingdom. This is not a relevant issue. The opponent bases his attack under section 5(3) on his Community trade mark and so he needs to establish a reputation in the European Union, he does not need a specific reputation in the United Kingdom.

46) For the sake of completeness I will deal briefly with the issue of detriment.

47) The opponent claims that there would be dilution of his earlier trade mark. I have assumed that he is claiming that such dilution would be to the detriment of the distinctive character of his earlier trade mark. In *Daimler Chrysler AG v Javid Alavi (t/a MERC)* [2001] RPC 813 Pumfrey J stated:

“The words “detriment to the distinctive character” also give difficulty. Mr Hobbs Q.C. and Neuberger J. discuss them. I find the concept to which they refer somewhat fugitive. The presence of two similar marks where there was only one before seems to me to be detrimental to the distinctive character of the first. I am satisfied that this is not what the words are talking about.”

The opponent is not going to succeed under this head by a vague claim to dilution. There has to be something more.

In *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767 at 801 Neuberger J stated:

“As I have mentioned, the mere fact that the way in which the sign is used by TEL may give rise to an association between the sign and the mark in the minds of some

members of the public is, in my judgement, simply not enough on its own to enable the proprietor of the mark, however well known and valuable it may be, to invoke section 10(3).”

In *Daimler Chrysler AG v Javid Alavi (t/a MERC)* [2001] RPC 813 Pumfrey J held:

“...but Jacobs AG emphasises that the provision is not to be used to give marks ‘an unduly extensive protection’, emphasising that there is a question of a risk of unfair advantage or detriment: there must be actual unfair advantage or detriment. But, for this to happen, there must be some sort of connection formed (I avoid the word association) between the sign used by the defendant and the mark and its associated reputation.”

The “something more” that the opponent has to establish to show that there would be detriment through dilution is a connection. Such a connection will depend to a large extent upon the nature of the respective goods and services. Would the relevant public make a connection? In the instant case I can see nothing that would form a connection between the services of the applicant and the goods of the opponent. The opponent has not put forward any evidence or clear argument as to why or how such a connection should be formed. Indeed in both his pleadings and his submissions he is vague as to the basis of his claim under this head.

48) Consequent upon the above if the opponent had established a reputation I would have still dismissed the grounds of opposition under section 5(3) owing to the failure to establish that there would be detriment to the distinctive character or repute of his earlier trade mark.

49) Consequent upon the above the applicant should file within one month of the expiry of the appeal period from the decision a form TM21 to delete all goods in classes 9 and 16. If no form TM21 is filed within the period set the application will be refused in its entirety.

50) As each party has been successful on some heads I order that they should each bear their own costs.

Dated this 10TH day of April 2002

**D.W.Landau
For the Registrar
the Comptroller-General**