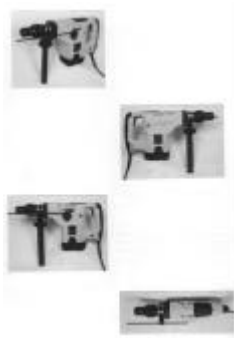


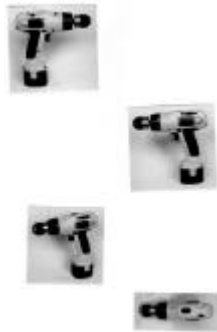
O-281-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NOS 2200505 AND 2200510
BY THE BLACK & DECKER CORPORATION
TO REGISTER THE TRADE MARKS:**



AND



IN CLASS 7

**AND THE OPPOSITIONS THERETO
UNDER NOS 52195 AND 52196
BY ATLAS COPCO AKTIEBOLAG**

TRADE MARKS ACT 1994

**In the matter of
application nos 2200505 and 2200510
by The Black & Decker Corporation
to register trade marks in class 7
and the oppositions thereto
under nos 52195 and 52196
by Atlas Copco Aktiebolag**

Background

1) The two oppositions were heard at the same time and, with a minor exception as to the specification of application no 2200505 which includes pneumatic hammers, they were dealt with as one. The issues are as one and the evidence is as one. Effectively the cases were dealt with as if they were consolidated. (In my view they should have been consolidated some considerable time ago.) If one application falls the other will fall and if one stands the other will stand. I, therefore, am writing a decision that covers both cases.

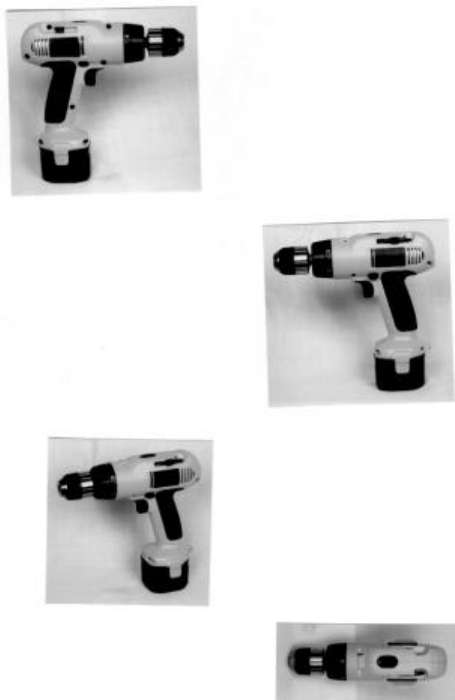
2) Trade mark application no 2200505 is for the following trade mark:



It was published with the following specification:

electrically powered hammers, rotary hammers and pneumatic hammers; parts and fittings for all the aforesaid goods.

Trade mark application no 2200510 is for the following trade mark:



It was published with the following specification:

electrically powered drills, percussion drills, screwdrivers, drill/drivers; parts and fittings for all the aforesaid goods.

Both sets of goods are in class 7 of the International Classification of Goods and Services. Each of the applications was published with the following description:

“The mark consists of the combination of the shape of the tool and the yellow and black colours applied to the surface of the tool as shown in the representation on the form of application.”

The representations of the trade marks have been filed in colour.

The applications were filed on 17 June 1999 and published in the “Trade Marks Journal”, for opposition purposes, on 29 November 1999.

3) On 28 February 2001 Atlas Copco Aktiebolag (afterwards referred to as Atlas) filed notices of opposition against the two applications. At the hearing Atlas relied upon the following grounds of opposition:

- Registration of the trade marks is contrary to section 3(1)(b) of Trade Marks Act 1994 (the Act) as the trade marks are not capable of distinguishing the goods of The Black & Decker Corporation (afterwards referred to as B&D) from other undertakings. The colour combination yellow and black is in use by a number of other traders, including Atlas, upon goods identical or similar to the goods of the applications. The colour combination offers high contrast and high visibility and is commonly used in the trade

- for these reasons without any proprietary meaning being attached or assumed.
- Registration of the trade marks is contrary to section 3(1)(c) of the Act as the trade marks consist exclusively of signs or indications which may serve in trade to indicate the quality, intended purpose or other characteristics of the goods. The colour combination yellow and black offers high contrast and high visibility and is used as a safety feature. Large amounts of equipment supplied to the construction industry is traditionally coloured yellow and black. This colour scheme makes it more visible when used by busy roadsides and makes tools easier to find in low light or dirty conditions. By association these colours call to mind construction equipment and give the impression of ruggedness. The combination of yellow and black is also a traditional warning sign and is often used to highlight danger.
 - Registration of the trade marks is contrary to section 3(1)(d) of the Act as the trade marks consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade. A number of other manufacturers of the goods applied for or similar goods, including Atlas, have been using the colours yellow and black on their products within at least the last three years. This colour combination offers high contrast and high visibility and is commonly used in the trade for these reasons without any proprietary meaning attached or assumed.
 - Atlas notes that B&D has used the colour combination yellow and black on its products, but does not accept that this use amounts to use as a trade mark, or is taken as such by consumers. At all times B&D's goods have been sold under the trade mark DeWalt and it is to this name that consumers ultimately refer to identify the products. Registration should be refused under section 3(1)(b) of the Act on the grounds that the colour per se combination is not serving to distinguish the goods of the applicant from those of other undertakings.

4) B&D filed a counterstatement in which it denies the grounds of opposition. It also claims that its trade marks do distinguish its goods as is illustrated by the evidence filed in support of the applications.

5) B&D also states that Atlas has opposed its Community trade mark application nos 498683, 498717, 498758, 499004, 541581 and 541607, all of which consist of the colours yellow and black applied to power tools. In each case the opposition is based on:

- An earlier non-registered mark and the right to prohibit use of a later mark under national law.
- An earlier sign and the right to prohibit use of a later mark under national law.

In each case the earlier sign is represented to be a tool coloured yellow with black attachments or additions. In relation to application no 541607, Atlas asserts that it has built up a significant trading goodwill in the United Kingdom in a wide range of tools presented in a yellow livery with black markings. Atlas has alleged that use by B&D of the Community trade mark constitutes passing-off. B&D claims that Atlas's position in relation to the Community trade mark opposition is based on the proposition that a proprietary meaning is attached to the yellow and black colour combination in the United Kingdom in relation to tools, in that it is exclusively associated with Atlas and no other trader. Atlas has claimed that it is entitled to deny use of this colour combination to other traders, including B&D. Atlas is advancing inconsistent contentions in its oppositions in the United Kingdom and before the Office for Harmonization in the Internal Market (OHIM). By this conduct Atlas is benefiting from inconsistent conduct. Accordingly, in the absence of an irrevocable election between its inconsistent stances, Atlas is estopped from asserting the objections it has pleaded. B&D

relies on the principle that a person may not approbate and reprobate.

6) Both sides filed evidence and both sides seek an award of costs.

7) The matter came to be heard on 3 September 2003 when B&D was represented by Henry Carr QC, instructed by Alexander Ramage Associates, and Atlas was represented by Richard Meade of counsel, instructed by Marks & Clerk.

EVIDENCE OF ATLAS

8) This evidence consists of three statutory declarations/witness statements by Royston Goodman and one by Simon Peter Alan Stanes.

9) Mr Goodman is director of Atlas Copco Construction & Mining Ltd. This company is a wholly owned subsidiary of Atlas Copco UK Holdings Ltd which is a wholly owned subsidiary of Atlas.

10) Mr Goodman states that the market in power tools in the United Kingdom ranges from tools used domestically by DIY enthusiasts to professional tools used by industrial users. He states DIY tools tend to be of the smaller, hand-held variety, although they can include bulkier equipment such as bench saws. Professional tools, according to Mr Goodman, encompass heavy-duty versions of the same hand-tools, but also include bigger items such as large drills and breakers. He states that these include pneumatic drills and breakers which you might expect to see being used on construction sites.

11) Mr Goodman states that DIY tools tend to be driven by mains or battery powered electric motors. Professional tools tend to be driven either by mains, battery or electro-pneumatically via an airline to a central compressor or with an on-board compressor powered by an electric motor. According to Mr Goodman pneumatic tools are seen to be more powerful than their equivalent sized electric counterparts. He states that in an industrial application, such as a factory line, the compressor and tools are normally part of a built-in installation. In the construction industry, the compressor is a mobile, trailer mounted unit. Mr Goodman exhibits a picture of a pneumatic breaker in use. He states that a wide variety of tools can be driven by air-lines and that professional tools are not exclusively pneumatic, there are a number of electrically driven versions. Mr Goodman exhibits a picture of what appear to be sanders. He states that the picture shows electric and pneumatic tools alongside each other. As the wording attached to the picture is not in English it is not possible to know what it is telling me. Mr Goodman states that pneumatic tools and their electric driven counterparts in many cases can be used to do the same jobs. Pneumatic tool systems are more likely to be bought by industrial companies as they require investment in the compressor and the individual tools.

12) Mr Goodman states that Atlas has been involved in the professional end of the market since the early 1900s; producing pneumatic tools and compressors and electrically driven models. He states that Atlas sell to large firms directly and through professional dealers. He states that many of Atlas's models are available for hire through high street tool hire businesses.

13) Mr Goodman describes the market that DeWalt tools is in as semi-professional.

14) Mr Goodman states that yellow and black has been widely used in the construction industry on tools, plants, equipment and clothing. He states that companies which use yellow and black are Caterpillar, JCB and Atlas. Mr Goodman exhibits an article from Simon Kinder in which he states that Mr Kinder refers to the colours yellow and black as the colours of construction. Mr Goodman states that the colour yellow is extremely bright and shows up well even in low light conditions and at night. The colour black when used in combination with yellow, he states, gives the maximum contrast possible. He exhibits pages from the Internet showing the colours yellow and black, amongst others, being used for warning signs. Mr Goodman states that visibility is important in construction sites.

15) Mr Goodman states that in 1976 Atlas developed a yellow and black colour scheme for the tools, because of its high visibility and contrast properties. He states that this colour scheme was adopted on the Atlas branded industrial, construction and mining tools worldwide where appropriate. He does not clearly state what goods within the United Kingdom use these colours. It is clear from the evidence of B&D that for a variety of tools Atlas have not used this colour scheme, at least not the colour scheme alone.

16) In 1994 Atlas bought Kango. Kango makes power tools for the construction industry. He states that Kango tools are electrically powered pneumatic driven hammer mechanisms. He exhibits details, which he states relate to 1976-1979, showing a Kango drilling hammer which is predominantly in yellow. At the time of the purchase Kango tools were produced in red and grey/black but in 1997 it was decided, Mr Goodman states, to use the yellow and black livery in line with other Atlas tools. He exhibits an article from "Professional Builder Magazine" of October 1997 discussing the change, a copy of a power-point presentation given in 1997 and an advertisement advertising the change. The power-point pictures show various tools in yellow and black livery, these include hammers, being drills, and a cutting tool.

17) Mr Goodman exhibits a 1995/96 Atlas catalogue for industrial power tools. The goods are aimed at the industrial market. The catalogue shows a large number of tools, they all appear to be pneumatic. They include screwdrivers, grinders and drills and are mainly in a yellow and black livery. Mr Goodman does not indicate how many of these tools have actually been sold in the United Kingdom. There is no indication as to whether the catalogue was distributed in the United Kingdom, that it is in English tells me little.

18) Also exhibited are covers for a 1985 catalogue for air tools and accessories, which shows various of the tools in drawing form with the clamshells in yellow. A cover for a Kango catalogue for 1998 shows a pneumatic drill, some form of cutting tool and a large quarrying machine, certainly not what I would describe as a tool, in yellow and black livery.

19) Mr Goodman states that in the three years leading up to 1998 sales of yellow and black tools in the United Kingdom by Atlas were as follows:

1995	£29 million
1996	£24 million
1997	£29 million
1998	£27 million

He states that approximately 60% of the sales are accounted for by construction tools, 30% by industrial tools and 10% by mining equipment and that sales of Kango branded tools account for 10% to 12% of the total sales each year; Kango tools are included in the construction tools

sector. Mr Goodman states prior to 1997 this percentage should be removed from the total as the Kango range was red and black. He states that in 1998 all tools sold were yellow and black.

20) Mr Goodman states that sales were made to companies throughout the United Kingdom including Tarmac, Amey, Amec and the installation division of British Telecom. He states that sales were also made to a large number of major distributors and hire companies such as HSS, Hewden Stuart, Travis Perkins and Jewsons.

21) The problem with the evidence of Mr Goodman in relation to the use of the colours yellow and black by Atlas is the absence of detail and specificity. I cannot tell what tools have been sold in the United Kingdom in this livery and when. The terms he uses to divide up the sectors tell me little. I have nothing to tell me what the proximity of the tools sold by Atlas is to those of the application. The best that I can accept, I believe, is that Atlas have sold Kango pneumatic drills in yellow and black livery, at the earliest from October 1997. In this context I note from the evidence that certain drills can serve the function of both drilling holes and “chiselling”, the sort of thing sold under the DeWalt name and referred to in paragraph 22 below.

22) Mr Goodman submitted a second statutory declaration, dated 6 August 2001. He exhibits “The Official Showguide” for SED 2001, a construction industry show. This shows various items of heavy plant and other equipment in bright yellow and bright yellow and black. I can see nothing that is akin to the goods the subject of the application. However, there is an advertisement for DeWalt for high performance industrial tools and accessories, including a pneumatic hammer drill. Mr Goodman also exhibits cuttings from “Professional Builder” from 1996, 1997 and 1998. The cuttings show compressors, cutters, mortisers, altimeter levels, nail gun, hammers and heavy duty saw in yellow and black. He also exhibits a brochure for Kaesor compressors, and picks which are in yellow and black livery. Various material for Wacker shows electric hammers, breakers and drills which are in a yellow and black livery. Mr Goodman exhibits a copy of Atlas’s in-house magazine from June 1976, in Swedish. A translation of the pertinent part states:

“A new yellow colour!

From now on, Atlas Copco’s program of industrial equipment will be delivered in a new colour: *yellow*. The transition from industrial grey will take place gradually, as the different production units modify their painting departments, and we take the opportunity to show some pieces of equipment in their new yellow appearance.”

23) There is a witness statement from Simon Peter Alan Stanes, a technical assistant for Marks & Clerk, the trade mark agents for Atlas. Mr Stanes deals with yellow being a “safety” colour and black being a contrast colour for it.

24) There is a further witness statement from Mr Goodman. The contents of this can best be characterised as representing submissions and/or a critique of the evidence and submissions, under the guise of evidence, of B&D. As this is not evidence of fact I need say no more about it here.

EVIDENCE OF B&D

25) The evidence of B&D divides into two parts. Part deals with the estoppel issue and part with establishing distinctiveness.

Witness statement of Benjamin Alexander Ramage

26) Mr Ramage is a trade mark agent. He states that he is responsible for the prosecution of Community trade mark application nos 498683, 498717, 498758, 499004, 541581 and 541607, which are in the name of B&D and are currently opposed by Atlas. Community trade mark no 541581 appears identical to 2200510 and Community trade mark no 541607 appears identical to 2200505. The descriptions of the trade marks are effectively the same. The Community trade marks are indicated as being three dimensional trade marks. The specifications of the Community trade marks are slightly larger than those of the United Kingdom applications but include the goods of the latter applications. Mr Ramage states that he has only received an explanation of grounds and evidence in respect of application no 541607.

27) The grounds of opposition in the notice of opposition are that Atlas is the owner of an earlier non-registered mark and earlier sign used in the course of trade in all fifteen member states and that it has the right to prohibit the use of B&D's trade mark under the national laws of the fifteen member states. For the earlier rights it has attached pictures of various power tools in yellow and black. In an attachment Atlas states:

“Due to the use which it has made of the sign, the opponent has the right to prohibit the use of the opposed Community Trade Mark in the United Kingdom under the common law tort of passing off and in other European jurisdictions under national unfair competition law.”

28) In Atlas's observations it only deals with the law of passing-off in the United Kingdom and makes no reference to the laws of the other fourteen member states. The crux of its case appears to be the following:

“It is the Opponent's contention that due to these various common points and the similarity of the appearance as a whole, use of the mark applied for in the UK is likely to lead a significant number of consumers to think that the product bearing the mark was produced by the opponent, in the absence of any clear statement to the contrary.”

29) In a witness statement Mr Raymond John Feasey of Atlas, amongst other things, states:

“4. The opponents contend that they have built up a significant goodwill in the United Kingdom through the sale of the tools shown at Annex A and more generally by sales of a wide range of tools presented in a yellow livery with black markings since the mid 1970. This goodwill, giving rise to rights under the tort of passing off was in existence prior to the filing of the opposed application, thus satisfying article 8(4)(a) of the regulation.

12. Due to these sales, I believe that a significant number of customers of industrial power tools are familiar with the configuration and external appearance of Atlas Copco

tools and more particularly the LMS86 and LMS64GR impact wrenches. As a result they associate this overall appearance with products from my Company.

13. I believe that due to the similarity of the appearance with the LMS86 and LMS64GR impact wrenches and other similar tools sold by my Company, if the mark applied for were to be used as shown on the application in the United Kingdom, it would be liable to lead a significant number of consumers of industrial power tools to believe that it was a tool sold by my Company.”

Statutory declaration of Geoffrey David Mullin dated 20 October 1999

30) Mr Mullin is the Commercial Director of Black & Decker Professional Tools Division in the United Kingdom. Mr Mullin exhibits two statutory declarations made by Simon Lawrence Kinder. In reference to the first declaration Mr Mullin states that there are 42 B&Q warehouses and 2,500 retail tool specialists in the United Kingdom. He states that of these 2,500 retailers between 1,500 and 2,000 sell “the yellow and black power tools”. I assume that by this term he means DeWalt tools. I am surprised that he can only estimate the number that sells his firms tools and then only give a very vague estimate. It seems to me a simple enough matter to know to how many distributors the tools are sent. Mr Mullin states that in addition to the specialist retailers and B&Q warehouses there are the following channels of distribution (with the market share they represent):

- (i) Builders merchants – 10%
- (ii) The hire industry – 8%
- (iii) Mail order – 7%
- (iv) Direct sales to the consumer (eg on building sites) – 9%
- (v) Wholesalers – 14%
- (vi) The “modern” channels (eg Argos, Do-It-All) – 3%

He does not state what he means by market share. Is this market share of the power tools market by DeWalt in the particular area or is it the percentage of DeWalt tools sold? As he states that B&D do not use the direct sales route, I conjecture, I can do no more, that these figures represent sales of “professional” tools at large. As he states that B&D only sell through specialist outlets and B&Q Warehouses, it would appear that 51% of the market outlets is excluded. In addition if only 1,500 of the 2,500 specialist outlets, see Mr Kinder’s declaration re this figure, carry DeWalt tools the figure of those outlets which B&D do not supply to, and here we are only talking about the so called professional tools outlets, is considerable. (It is important to bear in mind that this “exclusion” does not take into account the “non-professional” outlets where the man and woman in the street is likely to buy power tools.)

31) Mr Mullin states that the number of demonstrator vehicles increased from 21 vans in April 1997 to 22 vans, he does not say when this increase took place.

32) Mr Mullin states that the budgeted annual figures for promotional expenditure in the United Kingdom for yellow and black power DeWalt power tools in 1998 was:

£1.4 million on vans
£350,000 on events
£340,000 on promotions

£150,000 on advertising
£80,000 on sponsorship.

33) Mr Mullin exhibits examples of various advertisements and articles which appeared in trade journals in 1998 and 1999 and a video of the sponsorship of Superbikes and Truck by DeWalt in 1997.

34) Mr Mullin states that in 1998 22,786 yellow and black power tools were sold with a sales value of £27,405,628. The figure of the number of tools sold seems to have been subject to a typographical error, otherwise the average sales value of each tool would be over £1200, which from the evidence is not feasible. Mr Mullin states that for 1999 up to June 172,909 yellow and black DeWalt power tools had been sold with a sales value (NTD) of £20,610,000. He does not state what NTD stands for. For 1999, up to June, 397,048 accessories had been sold with an “NTD” value of £1,018,000.

35) Mr Mullin states that the market share figures for the yellow and black DeWalt brand as a percentage of the United Kingdom professional power tool market for 1998 and 1999 is as follows:

1998: volume 16.6%, value 20.9%
1999 volume 18.4% value 22.9%

He gives the source of these figures as Deloitte Touche but exhibits no report from Deloitte Touche. Mr Kinder gives details of how the Deloitte Touch figures are arrived at below.

36) Mr Mullin states that by the end of August 1999, after the relevant date, 69,820 mid-handled cordless drills, percussion drills, screwdrivers and combinations thereof had been sold with a sales value of £9,151,830. By the end of August 1999 697 mid-sized hammer and demolition hammers had been sold with a sales value of £227,137.

37) Mr Mullin states that he is aware that there are other yellow and black power tools on the market in the United Kingdom. He states that Kango commenced sales in or about January 1998 and believes that its level of sales is small. Mr Mullin states that Clarke Associates International Ltd and Duwit commenced sales of yellow and black power tools in the United Kingdom in or about December 1998 and Spring 1999 respectively. However, he understands, from Paul Harris, that both these companies have given undertakings not to sell yellow and black power tools and that no further sales of those products have taken place since on or about 30 September 1999. He states that, as far as he is aware, Peugeot, a picture of one of whose power tools was used in the surveys, has never sold power tools in the United Kingdom.

Witness statement of Simon Laurence Kinder

38) Mr Kinder was Director of Marketing for Black & Decker’s Professional Power Tools Division in the United Kingdom from November 1996 until January 1998. He exhibits to his witness statement two earlier statutory declarations with exhibits.

39) Mr Kinder states that he wishes to address an issue raised by Mr Goodman for Atlas in his first statutory declaration. He comments that Mr Goodman states that he refers to yellow and black as the colours of construction in an article from “Professional Builder Magazine” of

October 1997. He states that the article does not quote him directly. Mr Kinder does not dispute the yellow was already a colour seen in or on industrial/construction sites. Mr Kinder states that the black and yellow combination was unique to B&D in the power tools sector. It is for this reason that marketing materials used by Black & Decker will often refer to industrial yellow as the primary colour of the tools, usually followed by a reference to black highlights. In the context of Mr Kinder's statement it is worthwhile considering one of the video cassettes that has been exhibited, SK4. This video cassette shows the launch of the DeWalt brand in the United Kingdom, by Mr Kinder, at Pinewood Studios on 11 August 1995. Mr Kinder in launching the product describes the colours as "industrial yellow with black highlights" as he says this written on a screen behind him are the words "construction colour". He states that "while the colour is new to the professional power tools market it is certainly not new to the job site". He refers to the use of the colours from JCB to Caterpillar to safety helmets.

40) It is also to be noted, whilst referring to this video, that Mr Kinder states that DeWalt products are aimed at professionals and DIYers trading up and that they will be available across all channels of distribution serving the professional end user and top end DIYer.

Statutory declaration of Simon Laurence Kinder dated 12 January 1998.

41) Mr Kinder states that in the early 1980s B&D acquired Elu Power Tools. He states that Elu makes woodworking products aimed at the professional user. In 1959 B&D acquired the DeWalt business. DeWalt continued as a separate business "carrying on the tradition in producing high quality, high performance products for the professional user".

42) Mr Kinder states that B&D had in effect two groups which considered an approach into the professional market: the European group and the group serving the USA. The European group opted to expand the range of Elu power tool products; he states that this had been successful, particularly in Germany and Scandinavia. The colour chosen for Elu products was grey. The US group opted to use the DeWalt brand. Mr Kinder states that the US group "opted for a colour combination which in the power tool product market would be unique and wholly different to anything already on the market".

43) Mr Kinder exhibits a selection of brochures of what he describes as being for professional and consumer power tools on the market. He exhibits these brochures to attempt to show how power tool companies use colour on their products. Unfortunately, most of the exhibit is in black and white and so does not greatly help his cause; also the colour photocopies are not of the best quality. Included are the following:

New Bosch products – a shredder that appears to be in turquoise and black, a rotary drill and a compact belt sander – the colours of which are not very clear. The sander appears to be mauve and the drill the same colours as the shredder.

Metabo electric power tools – new for 1997 – the goods appears to be predominantly black with a silver trim in parts. A sander has a dust bag in yellow.

A Hitachi catalogue, in German, for 1996. It shows power tools in green and another colour, possibly silver.

Atlas Copco – in German, the tools appear to be black and silver.

Makita 1996/97, in German, nothing can be clearly seen of any assistance.

Kango 1991 Rangefinder – nothing can be clearly seen of any assistance.

Kress catalogue for 1997/98, in German, the tools displayed appear to be predominantly silver but the copy is of too poor a quality for certainty.

44) Mr Kinder states that, with the exception of the red used by Kango, most of the power tool market uses conservative colours.

45) Mr Kinder states that Bosch has used green on its products for at least twenty-five years and that it has about thirty percent of the market share. He states that Bosch has been using blue for twenty five years for the professional market and has approximately thirty percent of the market. Mr Kinder states that it is common in the trade to make reference to “Bosch Green” or “Bosch Blue” as opposed to Bosch DIY or Bosch professional range.

46) Mr Kinder states that with the advent of the use of moulded, plastic clamshells Bosch was able to use an all over colour. B&D chose a blue colour for its power tools.

47) The yellow and black DeWalt products were formally launched in the United Kingdom on 11 August 1995. It was decided to use B&Q Warehouse stores as well as specialist retailers. Mr Kinder states that B&Q Warehouse stores cater for the professional user. B&Q Warehouse stores might cater for the professional user but they also cater for the ordinary DIYer. In a clipping from “Engineering Distributor” of May 1996 the following is written:

“The 19 100,000sq ft B&Q Warehouse stores it has opened since 1990 carry a broader, deeper range of goods than any DIY fascia yet seen in the UK and are designed to attract DIY customers and trade customers within a 20 minute drive.”

“B&Q Warehouse carried the widest range of power drills (from £22.99 up to £299.46) and the cheapest and dearest hammers (£2.98 up to £29.95).”

Mr Kinder states that the specialist retail outlets account for a little over fifty per cent of sales of professional power tools. He states that there are 29 B&Q Warehouses and 2,500 retail tools specialists in the United Kingdom. He states that 1500 of the latter sell the yellow and black power tools. Mr Kinder states that he estimates that 95% of B&D’s customers are in the trade with the remainder being enthusiastic amateurs. He states that fifty percent of the 1,500 specialists will hold as many as 100-300 products in stock. Mr Kinder does not indicate if this refers to all products or just DeWalt products.

48) Mr Kinder states that in addition to the specialist retailers and B&Q Warehouses there are the following channels of distribution (with the market share they represent):

- (i) Builders merchants – 8%
- (ii) The hire industry – 8%
- (iii) Mail order – 7%
- (iv) Direct sales to the consumer (eg on building sites) – 10%
- (v) Wholesalers – 13%
- (vi) The “modern” channels (eg Argos, Do-It-All) – 3%

He does not state what he means by market share. As I have stated above I conjecture from the figures that they refer to outlets of professional tools at large, not just DeWalt tools. Mr Kinder states that B&D only sell through specialist outlets and B&Q Warehouses, it would appear that 49% outlets are excluded. In addition, if only 1,500 of the 2,500 specialist outlets

carry DeWalt tools, the percentage of those outlets which B&D do not supply to, and here we are only talking about the so called professional tools outlets, is substantial.

49) Mr Kinder exhibits a large number of press cuttings, from the trade and specialist press, about DeWalt products. In the majority no reference is made to colour, although the goods are invariably seen. Where reference to colour is used it is sometimes simply to yellow and at other times refers to yellow and black. Certain of the pieces, such as in "Tools and Equipment" for September 1995 and "Builders Merchants Journal" for October 1995 refer to industrial yellow and black. Mr Kinder states that a team of highly trained people has been employed to demonstrate the power tools to tradesmen on a one to one basis. The demonstrators wore yellow and black sweatshirts, drove yellow and black vehicles, kitted out with yellow and black power tools, and gave out yellow and black promotional materials such as hats, t-shirts, pens and mugs. Mr Kinder states that the demonstrators have visited all the B&Q Warehouses and retail outlets to which he has referred.

50) Mr Kinder exhibits copies of diaries completed by drivers of DeWalt vans which show some of the demonstrations they have attended. All of them are completed by hand except for one, which appears to be a download of a computer diary. There are no handwritten diaries for the periods leading up to the surveys. However, in the computer diary there is a marking for 24-27 March 1997 which shows ELLIOTS BLITZ. Pictures of some of the promotional material are exhibited as are pictures of the vans and demonstration areas. The colours yellow and black are used.

51) Mr Kinder states that in August 1995 there were six DeWalt vans, each staffed by a full-time salesman. He states that they travelled around the United Kingdom demonstrating DeWalt products in retail stores, at construction sites and in schools and colleges. The number of vans was increased to eight in 1996 and twenty-one in 1997.

52) Promotional activities have included the "DeWalt Challenge"; a competition for the person who can drill five screws into a piece of wood in the quickest time using a DeWalt cordless drill. The fastest person winning a drill. In 1996 DeWalt sponsored a TVR Tuscan and has sponsored a British Superbike and British Touring Car. At a race meeting at Donnington in November 1996 DeWalt set up a stand and over 1,000 people filled out cards for information about DeWalt products. Exhibits are produced showing the Tuscan TVR and Superbikes. Mr Kinder states that county shows were also attended in the United Kingdom.

53) The budgeted annual figures for promotion in the United Kingdom for DeWalt products are as follows:

1995	£300,000 on vans (including drivers)
	£100,000 on events
	£100,000 on promotions
	£100,000 on advertising
1996	£400,000 on vans
	£150,000 on events
	£150,000 on promotion
	£100,000 on advertising
	£20,000 on sponsorship

1997 £1.2 million on vans
£300,000 on events
£300,000 on promotion
£160,000 on advertising
£50,000 on sponsorship

The figures for promotion include brochures and leaflets, point of sale material, T-shirts, caps, mugs and pens. The advertising takes place mainly in the trade press. The sponsorship includes the Superbike in yellow and black. The touring car does not carry the yellow and black colours but DeWalt is allowed to have an event at all touring car race meetings to demonstrate its products. Mr Kinder does not actually state how often B&D take advantage of this facility.

54) Mr Kinder states that the sales of DeWalt products in the United Kingdom have been as follows:

1995 £596,000
1996 £3,205,000
1997 £11,263,000

Mr Kinder states that the 1997 figure is to the end of November 1996, I assume he means November 1997.

55) Mr Kinder finishes with commenting on the 1997 recognition survey. This is dealt with below and so I will say nothing more about it here.

Statutory declaration of Simon Laurence Kinder dated 26 November 1998

56) Mr Kinder gives sales figures for tools alone, his earlier figures had included accessories:

Year	No of tools	Sales value (£)
1995	5,202	565,459
1996	24,914	2,829,021
1997	91,206	12,395,341
1998 (to October)	149,071	23,358,341

The sales figures are based on the price at which the power tools are sold to the retailer. Mr Kinder states that on the whole retailers will add between 18 and 30% to the price of power tools before selling them.

57) Mr Kinder gives the market share for the DeWalt brand as a percentage of the United Kingdom professional power tools market:

1995	1995	1996	1996	1997	1997	1998	1998
						Q1&2	Q1&2
2.6	1.1	2.7	2.6	7.9	8.5	16.1	20.2

He states that the figures have been prepared by Deloitte Touche. The market share information is prepared quarterly on a confidential basis by Deloitte Touche on behalf of thirteen professional power tool manufacturers. Each manufacturer supplies sales figures and

volumes per product category to Deloitte Touche on a quarterly basis. Deloitte Touche then prepares the market share figures on the basis of this information. None of the manufacturers are provided with details of their competitors' market share. The combined sales of power tools by these manufacturers comprises approximately 95% of professional power tool sales in the United Kingdom. Mr Kinder also gives the following sales figures:

Sales for mid-handle cordless drills, percussion drills, screwdrivers and combinations thereof:

Year	No of tools	Sales value (£)
1995	433	59,676
1996	2,512	371,897
1997	31,574	4,778,288
1998	56,473	8,700,487

Sales of mid-size hammer and demolition hammers are as follows:

Year	No of tools	Sales value (£)
1995	0	0
1996	0	0
1997	430	169,086
1998	771	260,911

Witness statement of Geoffrey David Mullin of 24 July 2002

58) A large part of his evidence is submission/critique of the evidence of Atlas rather than evidence of fact. I will concentrate on those areas which can be considered as evidence of fact.

59) Mr Mullin does not dispute that the colour yellow has been used within the construction industry for some years. Mr Mullin exhibits material to show that various colour combinations are used in relation to warning signs as well as black and yellow.

60) Mr Mullin exhibits at GDM-3 a decision from United States District Court for the Eastern District of Virginia, Alexandria Division, of a case between B&D and Pro-Tech Power Inc. I note the findings in this case but I have to consider the case before me on the basis of the evidence filed by B&D within the parameters of European statute and case law, and for the position in the United Kingdom.

61) Mr Mullin exhibits at GDM4 a copy of the 2002 catalogue for HSS Hire Shops. This clearly emanates from after the relevant date but B&D have decided to exhibit it and I will comment upon it. It shows a great deal of use of the colours yellow and black for a variety of construction and industrial related items. A few examples are:

page 6 – narrow width tower and portable compressor

page 7 – ride-on scrubber and hydraulic post hole borer

page 21 – traffic ramp/conduit – as this is to act as a sleeping policeman as well as protection for hoses and leads the colours must be perceived as being highly visible

page 23 – pressure washer

page 31 – laser level, optical site level and measuring wheel

page 35 – floor tile stripper

page 36 – rammer
page 38 – bulk concrete mixer, forced action mixer
page 42 – self-priming pump
page 45 – video/monitor combination
pages 50 and 51– industrial heaters
page 56 – cooling fans and cool air blowers
page 75 – portable cut-off saws
pages 84 and 85 – breakers of various types and compressors
page 95 – spray gun and compressor
page 98 – high pressure washers
page 99 – hot washers
page 100 – blasters.

The catalogue, if in 2002, shows that goods predominantly in yellow with trims or parts in black were commonly in use.

62) Mr Mullin exhibits at GDM5-8 printouts from Atlas's United Kingdom website, downloaded in July 2002. The website divides Atlas's products into three areas: compressors and generators, industrial and electric tools and construction and mining. The industrial and electric tools "button" has an illustration of some form of tool in yellow and black. There are various pages downloaded with the heading Atlas Copco Electric Tool. These show a variety of tools, including drills and screwdrivers and angle grinders. Also included are details of rotary and demolition hammers, tools which can, as the name suggests, be used for drilling and demolishing eg chiselling concrete. None of the tools illustrated are in yellow.

63) Printouts from other pages show various goods in yellow and black livery:

various compressors
containerised diesel powered generating set
drill rigs for rock drilling
hammer rock drills
light hydraulic breakers
rig mounted crushers
pneumatic standard breakers
hydraulic power packs
rig mounted pulverisers
hand held hydraulic breakers
demolition hammers #
rotary hammers #
combi hammers #
electric saws and cutters #
pumps
DTH hammers for rock drilling

With the exception of the items marked with # all the goods appear to be a long way from the goods of the application eg the rig mounted crushers are for crushing concrete.

64) Mr Mullin states that B&D instructed Carratu International to undertake an investigation into the sales of certain Atlas tools that were shown on the website. He exhibits a copy of this report. The tools they were told to investigate were the Ergopulse Accu and Eliza range of

electric screwdrivers, these are shown in the evidence of Atlas. He states that these goods were chosen as they would fall into the specification of the applications. In fact they would fall within the specification of application no 2200510 but not 2200505. The report from Carratu is dated 3 September 2001. The conclusions that Carratu came to, following its investigations, are as follows:

- “7.1 The Ergopulse Accu and Eliza range of electric screwdrivers do not appear to be available to the general public via normal electric power tool retail outlets, including official Atlas Copco distributors.
- 7.2 None of the tools hire outlets we approached had even heard of either product. Attempts by them to obtain quotes from Atlas Copco met with a blank as even the sales staff at head office did not recognise the products or model numbers.
- 7.3 The ‘Eliza’ range and the ‘Ergopulse Accu’ are acknowledged as being gauged towards production and manufacturing environments. Both products were designed for assembly lines and mass production use.
- 7.4 However, although these products are very specialised, it is possible to purchase them in single units as a private individual.
- 7.5 During the course of our enquiries we have not been in a position to establish the sales figures for Atlas Copco yellow liveried electric tools in the UK. This would probably require a more elaborate approach to senior personnel within the Atlas Copco UK Head Office.”

The Survey Evidence

65) There were two surveys, conducted in April/May 1997 and May 1999.

66) The places that the surveys were conducted were decided by B&D:

“The Applicants provided a list of the power tool outlets I was to attend to attempt to question people. Each outlet specialised in professional power tools.”

It appears from other evidence, such as who was to be contacted in the case of problems, people carrying DeWalt tools as they left the premises, that the outlets were also DeWalt stockists. B&Q Warehouse stores are not included in the surveys.

67) In a witness statement, Paul Andrew Harris, a partner at Eversheds, solicitors for B&D, states:

“Each was provided with names of such suppliers selected at random by Ms Regan and provided to me.”

The surveys were conducted by staff of Eversheds, except in Scotland where another firm of solicitors took on the task for Eversheds.

68) Mr Harris gives the background and details of each survey.

69) Those interviewing were given written instructions as to how to conduct the surveys. The 1997 and 1999 instructions varied slightly but included the following:

“The aim of this survey is to show that members of the building trade identify the colour of power tools with particular manufacturers.”

“Black & Decker launched the DeWalt range of tools in the UK in 1996. The range of tools are distinctive in that the colour of the tools are yellow and black.”

“The survey is very important to Black & Decker as it is part of an extensive campaign to protect the colour of the DeWalt tools. The client takes a very hands on approach in these matters and will check each questionnaire.”

“We have enclosed a copy of the completed analysis for London so that you can see how it has been completed.”

The instructions also state:

“Black and Decker have been carrying extensive promotional activities for the DeWalt product and you may find DeWalt representatives or even the DeWalt vehicle (which is bright yellow) at the outlets. If this is the case, please make sure that they are as inconspicuous as possible and if necessary move the vehicle out of the way so it cannot be seen by the interviewees. Please also look out for prominent DeWalt displays i.e. in the window and do not stand by them.”

70) The main difference in the surveys and the instructions is that in the 1999 survey indicates those who were interviewed leaving the premises and those who were interviewed arriving at the premises, the 1997 survey does not include this information.

71) Ten colour pictures of power tools were shown to the interviewees. Five similar in shape to application no 2200505 and five similar in shape to 2200510. Two of each of the shapes are in yellow and black livery. Many of the pictures exhibited are not numbered. The interviewers do not appear to use the same pictures. In certain of the pictures three of the yellow and black liveried tools are shown with a picture of the tool sitting in a case. The presence of this case could be of importance. I note that in the presentation, shown on the videotape exhibited at SK4, Mr Kinder states that, “All our cordless drills have metal kit boxes as standard”. So this would seem to be a selling point that B&D are promoting in relation to the DeWalt brand. In the May 1999 questionnaires of Rowlands the Kango picture has the letters AVS and device upon it. The quality of certain of the pictures is poor and the colours, other than those in yellow and black, are not always clear. It is possible that the same tools are shown in different poses but this is not a certainty in relation to all the non yellow and black tools.

72) The make of tools shown are supposed to be:

Picture 1: Bosch

Picture 2: DeWalt

Picture 3: Bosch

Picture 4: AEG

Picture 5: Peugeot

Picture 6: Elu
Picture 7: Kango
Picture 8: Kango
Picture 9: Hitachi
Picture 10: DeWalt

Pictures 2, 5, 8 and 10 show tools in yellow and black livery.

73) Surveys were conducted in England and Cardiff and Glasgow.

74) Certain of the questionnaires prescribe that the pictures are each shown for ten seconds, others that they are shown for as long as the interviewee requires.

75) The interviewer asks the person, if they agree to be interviewed, if they use power tools. If the answer is no, the interview terminates. If the answer is yes they are asked if they use them at home and/or work and what kind of power tools they use. The next question states:

“I am going to show you some pictures of power tools and I would like you to tell me whether you recognise the make of tool. If you don’t know, try not to guess – just say “I don’t know”.”

If the interviewee identified any tools as DeWalt they are asked “What were your reasons?”

76) Mr Harris comments upon the 1997 survey. He states that of 257 people stopped who use power tools, 95 people identified one of more of the pictures as DeWalt. He states that of these 257, 187 were professional users and 80 of these users identified one of the pictures showing a power tool with a yellow and black livery as DeWalt. He states that in relation to the non-professional users, 15 people identified at least one of the pictures as DeWalt. Mr Harris defines the persons into professional users and non-professional users, however, the survey does not. It identifies those who use power tools at work, at home or both. Persons interviewed might not use power tools at work but could be in trades or jobs where they work closely with others who do. Mr Harris states that of the 95 people who identified one of the pictures as DeWalt, 85 gave colour as their reason. 19 people identified the yellow and black tools as Elu, another B&D undertaking.

77) Mr Harris also comments upon the 1999 survey. In relation to this survey he exhibits different pictures to the ones he exhibited for the 1997 survey, although he states that the same pictures were used. Mr Harris states that of 279 people stopped who used power tools, 185 identified one of the pictures as DeWalt. He states that of the 279, 215 were professional users and that of those who identified the yellow and black tools as being DeWalt 157 were professional users. He states that of the non-professional users, 28 people identified at least one of the pictures as DeWalt. Again the issue of “professional”, “non-professional” arises. Mr Harris states that 158 out of the 185 identified 3 or more of the yellow and black power tools as DeWalt. He states that out of the 185 people who identified one of the pictures as DeWalt, 178 gave “colour” as their reason. Mr Harris states that 9 people identified the tools as Elu or B&D.

78) At the hearing Mr Carr produced what I find a helpful breakdown of the 1997 and 1999 surveys (subject of course to the problems with the different pictures that were used in the surveys):

1997 Shown:	Pic. 2 DW	Pic. 5 Peugeot	Pic. 7 Kango	Pic. 8 Kango	10 DW
Named:					
Bosch	1	1	0	2	0
Peugeot	0	0	0	0	0
Hitachi	2	1	1	1	1
DeWalt	89	88	0	80	82
Elu	16	8	1	6	10
Kango	1	2	35	2	3
Makita	5	4	4	2	2
Hilti	1	0	85	1	1
Don't know	133	146	120	157	149
Other	8	6	10	5	8

	256	256	256	256	256

1999 Shown:	Pic. 2 DW	Pic. 5 Peugeot	Pic. 7 Kango	Pic. 8 "Kango"	10 DW
Named:					
Bosch	3	4	3	2	3
Peugeot	0	0	0	0	0
Hitachi	1	1	6	0	0
DeWalt	176	161	0	147	162
Elu	7	7	0	3	4
Kango	0	0	9	1	0
Makita	6	3	12	4	2
Hilti	0	0	83	1	1
Don't know	81	96	135	120	107
Other	9	11	35	5	4

	283	283	283	283	283

Pictures 2, 5, 8 and 10 being in the yellow and black livery and picture 7 being in the old Kango livery. So that in line 1 of the figures for the 1997 survey 1 person thought that the

first DeWalt picture was a Bosch, one person thought that the Peugeot picture was a Bosch etc, etc.

Interviews with people in the trade

79) Joanne Beth Davies, of Eversheds, states that she visited Rajini Patel of Monarch Tools on 10 December 1997 in Harrow to obtain his opinion of the impact of DeWalt tools. Ms Davies gives no indication as to why Mr Patel was chosen by her or how she was aware of him.

80) Mr Harris visited Colin Elcock of Elcocks of Fulford, York, Kevin Davies of Wrayways of Harrogate and David Allen Mather of Oldham Power Tools of Oldham on 12 September 1997. He states that the purpose of the visits was to ascertain the opinion of power tool retailers of the impact of DeWalt. He states that the retailers were chosen because of their geographical spread which still enabled them to be visited easily. He gives no other reasons for how they were chosen, or how he was aware of them. The declaration of Mr Mather has not been adduced into these proceedings.

81) Messrs Patel, Elcock and Davies were all DeWalt stockists and specialist power tool retailers. Both Davies and Patel were aware of DeWalt tools before their introduction into the United Kingdom.

82) Davies states, inter alia, “the trade customers are knowledgeable enough not to buy the product for colour alone if the power tool itself, as well as the backup service, were of not good enough standard..... In all my years in the power tool business, I have never come across anything with a bigger impact in relation to colour.”

83) Elcock states, inter alia: “However, it is the yellow and black colouring that is the initially attractive aspect. It displays itself extremely well when mounted on the walls of shelving, when compared to other coloured power tools.....To me yellow and black power tools mean De Walt.”

84) Patel states inter alia: “If I saw a yellow and black power tool, I would recognise it as coming from DeWalt. If a customer were to ask for a yellow and black or yellow power tool, then I would assume that they were asking for a DeWalt..... Because a lot of my business is done over the telephone, when people telephone they often ask for the tools by their colour because they cannot recall the name. People identify the manufacturer by the colour of the power tool.”

85) Mark Jonathan Hodgkin of Eversheds of Birmingham was instructed to visit three power tool trade retailers. B&D’s trade mark attorneys told him to which retailers he should go and with whom to speak in the undertakings. Mr Hodgkin visited:

ECA Industrial Supplies of Coventry – 14 October 1999

ECA Supplies Limited of Leicester – 14 October 1999

Price Tool Sales of Birmingham – 18 October 1999.

He states:

“Each of the interviews was conducted in the shop premises. There was a DeWalt display in each of the shops. However, the display was not visible (or was not noticed by the interviewee) at any time during the interview.”

86) It would be interesting to know how Mr Hodgkin knew what the interviewee noticed or did not notice. It also seems rather an odd comment as I assume that he was interviewing staff of the concerns on their premises and so it would be difficult for them not to be aware of the displays even if they could not see them whilst being interviewed.

87) Mr Hodgkin interviewed the commercial manager of ECA Supplies, Mark Lombard; the branch manager of ECA Supplies Coventry Limited, Mark Griffith and field sales director of Price Tools Sales Limited, Mark Winzor.

88) Owain Llyr Rowlands, of Eversheds, was instructed to visit two power tool trade retailers. Again B&D’s trade mark attorneys told him where to go and with whom to speak. He saw Mark Evans, managing director of CME Development Ltd of Swansea on 14 October 1999 and David Union, branch manager of Data Power Tools Ltd of Cardiff, on 12 October 1999. Again the interviews were carried out on the shop premises and there was DeWalt displays on the premises. Mr Rowlands states that display was not visible during the interview.

89) Wendy-Ann Claudette Van Halderen-Moss, of Eversheds, was instructed to visit four power tool trade retailers. Again B&D’s trade mark attorneys told her where to go and with whom to speak. She saw Stuart Shaw, shop manager of Shaws Electrical Ltd of Croydon, on 5 October 1999, Dave Sale, buyer/manager of Marshalls & Parsons of Leigh on Sea, on 7 October 1999, Ben Spicer, sales and technical assistant manager of M&M Distributors, on 7 October 1999 and Roger Blagg, product manager of HSS Hire Service Group of Surrey, on 5 October 1999. Ms Van Halderen-Moss had been instructed to meet a Mr Newport of HSS but saw Mr Blagg instead. Except for HSS, all the interviews were conducted on shop premises and there were DeWalt displays in all the shop premises and again I am told that the display was not visible during the interviews. The HSS interview took place in the main reception area of its office building.

90) In the case of all the interviews no explanation is given as to how the subjects were chosen by B&D’s trade mark attorneys nor how they even knew not just of the companies but of the specific individuals with whom the interviewers were to speak. Questionnaires were completed by the interviewers, however, there appears to have been no attempt to formalise them by requesting the interviewees to complete witness statements.

91) The interviewees were asked:

“If I say to you “yellow and black power tools” does it mean anything to you?”

The replies were:

“De Walt”;

“Yes – Primarily it means DeWalt power tools, but I know there are other makes on the market which use the same colours”;

“De Walt”;

“DeWalt”;
“DeWalt”;
“DeWalt”;
“Yes, DeWalt”;
“It says DeWalt”;
“DeWalt”;

The interviewees were asked if it meant anything else. Most of the responses were negative. However, the following was said:

“No – just DeWalt industrial products as far as professional power tools”.

“Quality, I suppose and Kango as well, I suppose, they just recently changed colours.”

“McCullough.”

“There is a number of cheap imports which go under the same colours – imported from the Far East.”

92) A further question asked if the interviewee was aware of any other power tool manufacturers who use the colours yellow and black and if so who. These were the responses where the interviewee answered yes:

“Only gimmicky type products in mail order catalogues – I don’t have the names.”

“I don’t know who the manufacturer is but I believe it is a Jewson product.”

“Don’t know the make.”

“Kango.”

“Kango.”

“Couldn’t tell you but I know there is some.”

“One coming out on the market, JCB, are going to be yellow and black, can’t think of any other.”

“Not actual power tool companies. JCB use yellow and black. There are manufacturers power tools in Far East but package them in yellow and black – outer casing is yellow and black. I can’t remember the name.”

DECISION

93) Atlas objects to the registration of the applications on the basis of sections 3(1)(b), (c) and (d) of the Act. Section 3(1) of the Act states:

“3.-(1) The following shall not be registered -

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

Stay of Proceedings

94) Mr Meade requested that the proceedings be stayed. Mr Meade considered that this was appropriate as the cases raised issues which were the subject of references to the European Court of Justice (ECJ). In *Société de Produits Nestlé SA v. Unilever Plc* [2003] ETMR 53, Jacob J decided that: “Although substantial public recognition of the shape as that of a particular trader has been established, it has not been shown that the trader has used the shape to denote trade origin or that the public rely upon the shape to denote trade origin”. Jacob J was for refusing the application. However, he decided that the issue warranted reference to the ECJ. This case was settled so the reference fell away. However, Patten J in *Dyson’s Application* [2003] EWHC 1062 (Ch) came to a similar conclusion and decided to refer the matter to the ECJ. A reference to the ECJ has also been made in *Société de Produits Nestlé SA v Mars UK Limited* [2003] EWCA Civ 1072. The question in this case is:

“Whether the distinctive character of a mark referred to in Article 3(3) Council Directive 89/104/EEC and Article 7(3) Council Regulation 40/94 may be acquired following or in consequence of the use of that mark as part of or in conjunction with another mark?”

Mr Carr considered that the facts of these applications are very different to those the subject of the cases above.

95) On previewing these cases I saw clear parallels to the cases to which Mr Meade referred and I also considered that they raised issues which might be settled by the findings of the ECJ. I also bore in mind that it might be necessary for me to make a reference to the ECJ, as per Article 234 of the Treaty Establishing the European Community. However, B&D first has to establish a factual basis that would get me into these knotty areas of the law. If the case fails on the facts before me I do not need to trouble myself with the issues raised. Consequently, I decided not to stay the proceedings at the hearing. I advised, nonetheless, that if on the basis of the facts I arrived at a situation where I considered that I needed to await the findings of the ECJ I would stay making a finding. I also advised counsel that if I felt that a reference to the ECJ was necessary I would go back to them in relation to the drafting of an appropriate question(s).

96) I have now considered all the evidence before me and come to a decision as to where it leads me. It leads me to the conclusion that I neither have to await the findings of the ECJ nor need to consider making a reference to the ECJ. The facts of the cases do not get B&D onto the plane where the ECJ issues come into play.

Estoppel

97) The estoppel issue forms part of the counterstatement (see paragraph 5 above). Mr Carr referred to *Job Trade Mark* [1993] FSR 118. The relevant passage reads:

“From this sequence of events Mr. Fysh went on to submit that a person may not "approve" and "reprobate" at the same time. Paragraph 1507 of Halsbury reads as follows:

On the principle that a person may not approve and reprobate, a species of estoppel has arisen which seems to be intermediate between estoppel by record and estoppel in pais. The principle that a person may not approve and reprobate expresses two propositions, (1) that the person in question, having a choice between two courses of conduct, is to be treated as having made an election from which he cannot resile, and (2) that he will not be regarded, in general at any rate, as having so elected unless he has taken a benefit under or arising out of the course of conduct which he has first pursued and with which his subsequent conduct is inconsistent.

Thus a plaintiff, having two inconsistent claims, who elects to abandon one and pursue the other may not, in general, afterwards choose to return to the former claims and sue on it; but this rule of election does not apply where the two claims are not inconsistent and the circumstances do not show an intention to abandon one of them.

The common law principle which puts a man to his election between alternative inconsistent courses of conduct has no connection with the equitable doctrine of election and relates mainly, though not exclusively, to alternative remedies in a court of justice.”

Is there an inconsistency in the claims of Atlas?

98) Although framed within the terms of Council Regulation (EC) No 40/94, the opposition is based upon the law of passing-off. Passing-off is, with a small exception which is not germane to these cases, completely separate from the Act. This has been clearly affirmed in *Inter Lotto (UK) Ltd v Camelot Group PLC* [2003] EWCA Civ 1132. A claim to passing-off is not a claim to the ownership of a sign, as is the case of a trade mark. It is a claim to the ownership of a goodwill and not a name. Laddie J at first instance in *Inter Lotto* stated:

“The ambit of the cause of action may well have expanded but not in a way which has any impact on the issues I have to consider. The above passages are of significance because they are early examples of the courts highlighting one of the crucial differences between passing off and trade mark rights. Under the former, the claimant acquires no property in his name or mark. The cause of action is dependant on deception of the customer. Misappropriation of the name or mark by the defendant may be the means by which that deception has been facilitated, but that does not mean that the claimant owns the mark.”

So the claim to passing-off does not claim an ownership in any sign. A trade mark is a piece of property. The very natures of the rights and the actions are so different that I cannot see how the claims of Atlas are inconsistent. This in itself disposes of the estoppel issue, however, I will deal with a few other points that are against the claim of B&D.

99) B&D claims that Atlas’s position in relation to the Community trade mark opposition is based on the proposition that a proprietary meaning is attached to the yellow and black colour

combination in the United Kingdom in relation to tools, in that it is exclusively associated with Atlas and no other trader. This is what B&D says in its counterstatement. I can find no mention in the opposition of Atlas to an exclusive association. An exclusive association is not a requirement of the law of passing-off and so cannot be presumed from the filing of the action. This matter is dealt with by Laddie J in *Associated Newspapers Limited, Daily Mail and General Trust PLC v Express Newspapers* [2003] EWHC 1322 (Ch):

“As Mr Watson implicitly accepts, there is no requirement in the law of passing off that the claimant's reputation has to be exclusive. There have been a number of cases where a claimant has succeeded even though he was not the only trader with a reputation in the mark. A newcomer who adopts a mark employed by more than one competitor and thereby deceives the public harms each of them. There is no reason in principle and no authority which suggests that because a number of proprietors are harmed, none of them can seek to restrain the interference with their trade. Mr Watson also did not put forward any reason why shared reputation could only be protected where there are "very few" traders using the same or similar marks. I can see no reason why this should be so. It may well be that where a number of traders use a similar name as or as part of their trade mark, the public will become more discerning about small differences between them. This may make misrepresentation less easy to prove. But that is quite different to saying that the traders do not have protectable reputations in their marks. It follows that I do not accept this argument.”

100) The grounds of opposition before OHIM suggest the very opposite to a claim to an exclusive right:

“It is the Opponent’s contention that due to these various common points and the similarity of the appearance as a whole, use of the mark applied for in the UK is likely to lead a significant number of consumers to think that the product bearing the mark was produced by the opponent, in the absence of any clear statement to the contrary.”

Any clear statement to the contrary would be, for instance, the use of the name DeWalt upon the tools. Atlas are not claiming an exclusivity in the get-up of their tools in the United Kingdom but, in the absence of a trade mark name, claiming that there would be deception.

101) I can find no inconsistency in the pleadings of Atlas. In fact they seem to be very much of a piece as they are stating, in the United Kingdom actions, that the colour applied to the tools per se is not distinctive of DeWalt. So before OHIM the logical outcome of this argument is that there could be passing-off, in the absence of a clear statement as to origin of the goods, as purchasers of Atlas tools might think that tools with no wording upon them were made by Atlas. The manner that Atlas has approached the opposition before OHIM has had to be different as it is not possible to oppose upon absolute grounds and only those with a locus standi can oppose.

102) The claim to estoppel on the basis of inconsistency is unsustainable.

103) Even if this were not the case B&D would have to show that there was a benefit arising from the action of Atlas. I cannot see what benefit there would be. Mr Carr, on my asking him what the benefit was, saw it as winning the opposition. I cannot see how a trade mark not being incorrectly registered can truly be seen as a benefit. It also strikes me that Mr Carr is pleading estoppel before the wrong forum. He should be attacking the subsequent action

which is considered inconsistent and so should be making his case before OHIM.

104) The cases before me are not estopped.

Distinctiveness of the trade marks

105) The hearing proceeded upon the basis that for the trade marks to be registered B&D would have to rely upon the proviso. Counsel for both sides agreed that if the trade marks had acquired a distinctive character through use then this would dispose of the objections under sections 3(1)(b), (c) and (d). This has to be correct. If a trade mark has acquired distinctiveness that is simply a fact and a fact that will not be varied depending on whether it was objected to under sections 3(1)(b) and/or (c) and/or (d). The nature of the objection and the trade mark might mean that it has to “work harder” to satisfy the proviso. There is no threshold for proving distinctiveness (see *Windsurfing Chiemsee Produktions-und Vertriebs GmbH v. Boots- und Segelzubehör Walter Huber and Franz Attenberger* (Joined Cases C-108/97 and C-109/97) [1999] ETMR 585 where the ECJ stated:

“Secondly, just as distinctive character is one of the general conditions for registering a trade mark under Article 3(1)(b), a distinctive character acquired through use means that the mark must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from goods of other undertakings.”)

106) B&D has been selling tools under the DeWalt name, it has established a business. It has from the outset sold them in a standard livery of yellow and black. In the various cuttings from the trade press the tools are often seen. Sometimes the colours are referred to, sometimes as yellow and sometimes as yellow and black. They have used the colours yellow and black in their promotional activities. These colours are clearly the “corporate colour scheme”. They are part of the branding. However, this does not mean that they will be seen as indicators of trade origin with no other sign present; as is the case of the applications. Use does not necessarily equal distinctiveness (*British Sugar Plc v. James Robertson & Sons Ltd* [1996] RPC 281). B&D needs to show that the colours applied to the tools shown in these applications is distinctive of it. Sales turnover will never do this, this is dependant upon the perception of the public concerned with the goods. The only way that is likely to be achieved is through survey evidence. B&D has furnished two surveys and these surveys, in my view, are pivotal to its case. If the surveys cannot be relied upon, or do not support the basis of its case, the applications must be refused. If the surveys fail the applications fall and I do not need to consider the other evidence filed in these proceedings.

107) The head note to *Imperial Group plc & Another v. Philip Morris Limited & Another* [1984] RPC 293 gives a useful summary to the requirements for a survey:

“If a survey is to have validity (a) the interviewees must be selected so as to represent a relevant cross-section of the public, (b) the size must be statistically significant, (c) it must be conducted fairly, (d) all the surveys carried out must be disclosed including the number carried out, how they were conducted, and the totality of the persons involved, (e) the totality of the answers given must be disclosed and made available to the defendant, (f) the questions must not be leading nor should they lead the person answering into a field of speculation he would never have embarked upon had the question not been put, (h) the exact answers and not some abbreviated form must be

recorded, (i) the instructions to the interviewers as to how to carry out the survey must be disclosed and (j) where the answers are coded for computer input, the coding instructions must be disclosed.”

The population, the sample chosen to be representative of the whole, must be valid. This is the cornerstone of any statistical analysis, and that is what a survey is attempting to be; extrapolating from the population to the group as a whole. If the population chosen is not sound then the survey is irreversibly tainted and no amount of fuller’s earth is going to make it white. One of the most oft quoted examples of the effects of unrepresentative population is the poll carried out by “The Literary Digest” in 1936 which came to the conclusion that Landon would defeat Roosevelt in the presidential election. In fact Roosevelt only lost in two states. The reason for the failure of the poll was simple. The survey was carried out by telephone and far more Republican voters had telephones than Democrat voters.

108) To consider a representative population in this case it is necessary to firstly consider the nature of the goods. These are:

*electrically powered hammers, rotary hammers and pneumatic hammers;
electrically powered drills, percussion drills, screwdrivers, drill/drivers.*

The specifications also include parts and fittings. The goods are in class 7; the class in which the goods or services are placed is relevant in determining the nature of the goods and services (see *Altecnic Ltd's Trade Mark Application* [2002] RPC 34). All the goods, because of the class, are power tools. From the nature of the trade mark it is possible to see what the goods actually are; to the lay person they are powered drills and powered drills/screwdrivers. B&D push that their goods are for tradesmen, but their evidence also shows that they are marketed for DIYers. However, even if this were not the case the way that the tools are marketed is extrinsic to the trade marks and the goods that they encompass. This is an issue that has been dealt with by the Court of First Instance on several occasions. In two of the latest cases the court stated:

Axion SA, Christian Belce v OHIM Joined cases T-324/01 and T-110/02

“The existence of a marketing concept is a factor that is extrinsic to the right conferred by the Community trade mark. Furthermore, since a marketing concept is purely a matter of choice for the undertaking concerned, it is liable to be altered after the Community trade mark has been registered and cannot therefore have any bearing on the assessment of the mark's registrability (*Case T-355/00 DaimlerChrysler v OHIM (TELE AID)* [2002] II-1939). OHIM is therefore right in maintaining that factors such as the price of the product concerned, which will not be the subject of the registration, cannot be taken into consideration in assessing a trade mark's distinctiveness.”

Case T-355/00 DaimlerChrysler v OHIM (TELE AID) [2002] II-1939

“However, contrary to what the Office argues, the Court finds that the descriptiveness of a word sign must be assessed individually by reference to each of the categories of goods and/or services listed in the application for registration. For the purposes of assessing the descriptiveness of a word sign in respect of a particular category of goods and/or services, whether the applicant for the trade mark in question is contemplating using or is actually using a particular marketing concept involving goods and/or

services in other categories in addition to the goods and/or services within that category is immaterial. Whether or not there is a marketing concept is of no consequence to the right conferred by the Community trade mark. Furthermore, since a marketing concept is purely a matter of choice for the undertaking concerned, it may change after a sign has been registered as a Community trade mark and it cannot therefore have any bearing on the assessment of the sign's registrability.”

Of course, marketing strategies also change and DeWalt tools could turn up in any outlet. The 2002 HSS catalogue shows them turning up there. HSS are visited by all and sundry.

109) The public concerned for the goods of the applications is the power tool buying and owning public at large; which is a very large spectrum of the population. The surveys were carried out at specialist power tool outlets which were also DeWalt stockists. These were the only premises that were visited. There is nothing to suggest that these specialist power tool outlets get a cross-section of the public concerned. From the comments of some of the trade interviewees it can be seen that these undertakings are very much trade based:

“We deal with everyone from a one man band up to the nationals” – Griffiths.

“Trade – builders/electricians/carpenters” - Union.

Some of the interviewees are identified as being non-trade but this certainly does not indicate that they are typical of the public concerned. B&D elected not to conduct interviews conducted at B&Q Warehouse stores, even though they carry DeWalt tools. As the public concerned is likely to be a large cross section of the public at large it would seem that a logical place to conduct the survey would be in the high street; after all only those who state that they use power tools would be interviewed. (The gender bias of those interviewed is also noticeable, probably because of the nature of the premises.)

110) Taking into account the nature of the population and the goods it seems to me to be even more unrepresentative than that population which Lloyd J found unacceptable in *Dualit Ltd's (Toaster Shapes) Trade Mark Applications* [1999] RPC 890. The unrepresentative nature of the population leads me to the inevitable conclusion that I can give no weight to the survey as to what the perception of the public concerned is. B&D's choice of population can in no way be considered representative. It is noticeable that B&D does not give an explanation for its choice of places to be surveyed.

111) For the sake of completeness I will go on to comment on other factors that I consider damage the validity of the surveys.

112) B&D list the means of distribution of professional power tools. I have referred to this in my summary. On the basis of those figures it would appear that a large percentage of outlets for professional power tools alone are excluded from the survey. So even as a survey of professional power tool outlets the survey is skewed.

113) The only indication as to how the particular DeWalt stockists were chosen is by Mr Harris:

“Each was provided with names of such suppliers selected at random by Ms Regan and provided to me.”

It appears that at the time Ms Regan was working for B&D, although later she was working for B&D's previous trade mark attorneys. This is, of course, hearsay. Ms Regan has not said anything. It leaves me puzzled on several fronts however. What is exactly meant by random? How could a survey be relevant if the places chosen were not representative, and if they were random how could they be representative? The evidence is silent and if B&D want weight to be given to its surveys it is for them to clearly identify the parameters in which the surveys are set.

114) I note that there are indications from certain of the exhibited evidence that in certain places where the surveys took place that there had been promotional drives recently. The diary that is exhibited indicates that at the end of March 1997 there had been a "blitz" at Elliots. Glen Brown, interviewed at Twickenham on 17 April 1997 states, "Because only ones who do yellow casing – did promotion here last week". Andrew Riley, interviewed in Manchester on 11 May 1999 states "Because they're yellow and there is a lot of promotional material around at the moment". I am left wondering as just how many of the locations had "blitzes" or the like before the surveys took place. I don't know but it is for B&D to show that its surveys were clean in this aspect. It has to produce the data to justify the surveys.

115) The survey instructions state:

"Black and Decker have been carrying extensive promotional activities for the DeWalt product and you may find DeWalt representatives or even the DeWalt vehicle (which is bright yellow) at the outlets. If this is the case, please make sure that they are as inconspicuous as possible and if necessary move the vehicle out of the way so it cannot be seen by the interviewees. Please also look out for prominent DeWalt displays i.e. in the window and do not stand by them."

Effectively the interviewer is told if there is a promotional event going on carry-on just don't stand in eye line of displays or vans. This sort of instruction hardly seems conducive to establishing a sterile environment. The instructions do not preclude standing beneath signage for DeWalt which might be on the premises. From one other questionnaire completed at Price Tool Sales on 10 May 1999 it is clear that the interviewer was not following that instruction, at least not initially. ("The colour and the display but I've only just noticed that!" [NB – the interviewer moved after this.]

116) There was no filtering of persons and the only filtering question is whether someone uses power tools. So even when someone states that they work in the power tools trade, for instance the man interviewed in Birmingham on 15 May 1997 states that he works for Hitachi, his answers are still used. Equally in Twickenham the answers of RP Garrison, an Elu demonstrator are used and in Birmingham the answers of Martin Jefferys are used. Mr Jefferys says, "colours and marketing strategy were explained to me by a DeWalt rep as I sell cases for power tools and I saw them being made." Various of those interviewed give their jobs as working for power tool retailers. It is not always possible to state categorically if they were all working for the firms where the interviews took place. However, a 1999 survey was taken from the chairman of Price Tool Sales and Andrew Townley of Till & Whitehead was also interviewed. It is impossible to tell how many of those interviewed worked on the premises. I note that the draft statutory declaration that was sent to Mr Townley includes the words "whilst visiting Till & Whitehead". I do not consider that someone going to his place of work can be described as "visiting". As many of the forms do not give the occupation of

the interviewee or other useful details it is impossible to tell how many persons fall into very unrepresentative categories.

117) The next problem with the surveys arises from the instructions:

“The aim of this survey is to show that members of the building trade identify the colour of power tools with particular manufacturers.”

“Black & Decker launched the DeWalt range of tools in the UK in 1996. The range of tools are distinctive in that the colour of the tools are yellow and black.”

“The survey is very important to Black & Decker as it is part of an extensive campaign to protect the colour of the DeWalt tools. The client takes a very hands on approach in these matters and will check each questionnaire.”

“We have enclosed a copy of the completed analysis for London so that you can see how it has been completed.”

The interviewers are clearly and directly told what the aim of the survey is and that the colours yellow and black are distinctive of DeWalt. They are also advised of the importance of the survey to B&D. To tell the interviewers exactly what is supposed to be proved and of the hands-on attitude of B&D hardly sends them out into the field with clean hands. At the best it will lend itself to the unconscious effects of intentionalism.

118) The questionnaires completed by Mr Cowan in Glasgow shed an interesting light upon the survey. There are a large number which he has completed where the interviewee states that he does not wish to answer the survey. This is the first indication, incidentally and accidentally, of response rate. Response rate is an effect that has to be taken into account in any statistical analysis (see Babbie, E (1975) “The Practice of Social Research” Wadsworth.) It is quite possible that the response rate would not have had any effect upon the result but it would have been useful to have known it. As Babbie says:

“The reader should bear in mind, however, that these are rough guides, they have no statistical basis, and a demonstrated lack of response bias is far more important than a high response rate.”

119) On a more mundane level the interviewers have been using at least three sets of pictures. I am afraid that I gave up looking for further discrepancies after I found the first three. I find it astonishing that the interviewers were not going out with the same pictures. As I have mentioned in the summary of the evidence certain of the pictures include a picture of the tool in a case and this is a selling feature of DeWalt battery drills. I do not even know what the quality of the pictures in certain cases was. Some of the pictures exhibited are in colour and some in black and white. What exactly were the pictures shown to the interviewees? Were they photocopies? Were they original photographs? A good number of the pictures are also not numbered.

120) The declarations that the interviewers and interviewees have completed follow a formula. They seem to me very much a matter of filling in the blanks. For practical purposes it might not have been possible to do otherwise for the interviewees but I do not see why the interviewers could not use their own words. The standardisation goes to the extent of the

misspelling of Middlesbrough by Mr Harris and Andrea Gail Wright. One would assume that as Ms Wright was in the North East that she would know how to spell the town's name. Lord Esher M.R. in *Re Christiansen's TM* [1885] 3 RPC 54 at 60 says:

"Now, to my mind, when you have evidence given upon affidavit, and you find a dozen people, or twenty people, all swearing to exactly the same stereotyped affidavit, if I am called upon to act upon their evidence, it immediately makes me suspect that the affidavits are then not their own views of things and that they have adopted the view of somebody who has drawn the whole lot of the affidavits, and they adopt that view as a whole and say 'I think that affidavit right' and they put their names to the bottom."

I don't say the declarations by rote are damning in themselves but it strikes me that they form part of the pattern in the way that the surveys have been handled.

121) The key question of the survey asks the interviewee if he or she recognises the make of tool from the pictures. This question presupposes that there is a connection between the pictures and the make of tool. It assumes that and sends that assumption to the interviewee. The question presupposes the answer. It leads the interviewee into "a field of speculation he would never have embarked upon had the question not been put".

122) The interviewee is told not to guess. As, as far as one can tell, none of the tools shown have been sold without the presence of a word mark upon them I cannot see how the answer can be anything other than a guess. If the goods have never been sold in the forms shown how can any answer be based on previously known fact and so how could it be anything other than a guess? Also if the interviewees are not guessing why are there question marks after many of their answers.

123) An anomaly is apparent from certain of the answers. The interviewee says that he identifies certain of the pictures as showing DeWalt tools, however he does not identify all four pictures of tools in the yellow and black livery as being DeWalt. So despite the comments of the interviewee there has to be something more to the identification. This is the case for instance with Gwyn Starkey (Manchester 15 May 1997), John Fraser Wands (Southampton 15 May 1997) and David Bardsley (Manchester 15 May 1997).

124) The pictures show what appear to be two basic designs of drill. If a person is being asked to try and link them to a make of tool he has little to make the link with other than colour. It is also likely that if he decides to link them by colour that he will choose the make that is best known to him.

124) Mr Carr put forward the proposition that it is always possible to find faults in surveys. This is probably the case but this is not a reason to ignoring fundamental faults. I do not believe that I have been captious in my attitude to the surveys. Their methodology is fundamentally flawed, flawed to the extent that no reliance can be put upon them for showing what B&D wishes to show from them. Once B&D had gone down the road of self-elected and unexplained population the results were certain not to be demonstrative or indicative of any proposition. However, the failings in the population were followed by numerous other failings. The failing of the surveys lead me to the conclusion that B&D have not established that the trade marks the subject of this application can be considered to have acquired a distinctive character. B&D's case fails.

Trade Evidence

125) Evidence has been put in from the trade. This does not tell me now the consumer concerned would perceive the trade marks. In *Dualit* Lloyd J considers trade evidence:

“The five trade witnesses include such people as a buyer of toasters for Harrods and a director of the relevant trade association, the Association of Catering Equipment Manufacturers and Importers. These five witnesses were asked, in January to April 1996, whether they associated the two designs, represented in two dimensions as in the application for registration, with any and if so what maker. They all said that they associated the design with the applicant. These, however, are people whose business it is to know the applicant's products and the products of other manufacturers in the market. The fact that they knew their job and could recognise the shapes as being those of the applicant's products does not seem to me to begin to show that "the relevant class of persons, or at least a significant proportion thereof, identify [the] goods as originating from a particular undertaking because of the trade mark". The relevant class of persons is not trade buyers such as these witnesses but customers.”

126) In this case the trade evidence also has additional problem. No person from a trade association has been chosen. Those contacted have been DeWalt stockists. All of them, with the exception of Mr Blagg of HSS, work for firms which are specialist power tool retailers. No explanation is given as to how these particular persons were chosen. It would appear that they were chosen by B&D and B&D thinks that that is enough for me and Atlas to know. The Rowlands, Hodgkin and Van Halderen-Moss interviews, with the exception of the HSS interview, were all conducted on the premises upon which there were DeWalt displays. These interviews tell me that persons who stock DeWalt tools and were chosen by DeWalt, again with the exception of Mr Blagg, associate black and yellow power tools with DeWalt. This is hardly surprising. I am told nothing about the trade generally. Even certain of the carefully controlled samples that Rowlands, Hodgkin and Van Halderen-Moss interviewed associated the colours with other undertakings.

CONCLUSION

127) Mr Carr emphasised the particular bases of the objections made by Atlas in its grounds of opposition and argued that it had not substantiated them. However, Atlas pleaded section 3(1)(b) on two counts. I rehearse the final ground from the beginning of this decision:

Atlas notes that B&D has used the colour combination yellow and black on its products, but we do not accept that this use amounts to use as a trade mark, or is taken as such by consumers. At all times B&D's goods have been sold under the trade mark DeWalt and it is to this name that consumers ultimately refer to identify the products. Registration should be refused under section 3(1)(b) of the Act on the grounds that the colour per se combination is not serving to distinguish the goods of the applicant from those of other undertakings.

A ground based simply on a lack of distinctive character. A ground that very much turns upon the survey evidence and the need for B&D to show that its livery had acquired a secondary meaning. **I find that the trade marks are devoid of any distinctive character and before**

the date of application for registration had not acquired a distinctive character as a result of the use made of them.

128) Jacobs AG in his opinion in *Procter & Gamble v. Office for Harmonization In the Internal Market* [2001] ETMR 75 stated:

“As the Court of First Instance rightly noted, it is sufficient for one of the absolute grounds for refusal to apply for a sign to be ineligible for registration as a trade mark. Moreover, I cannot envisage any circumstances in which, in practice, it might be important to determine whether more than one absolute ground might apply.”

As the applications are to be refused under section 3(1)(b) of the Act I see no need to consider the objections under section 3(1)(c) and (d).

129) Both applications are to be refused.

130) Atlas Copco Akteibolag having been successful it is entitled towards a contribution towards its costs. I take into account that there are two cases. However, the same evidence has been filed by both sides and the issues are the same in relation to both actions. As I have stated above these are cases that clearly should have been consolidated. I take this into account in making my award of costs. I order The Black & Decker Corporation to pay Atlas Copco Akteibolag the sum of £4650 in respect of the two oppositions. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 17th day of September 2003

**David Landau
For the Registrar
the Comptroller-General**