

OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET  
(TRADE MARKS AND DESIGNS)

The Boards of Appeal

**DECISION**  
**of the First Board of Appeal**  
**of 17 November 2011**

In Case R 94/2011-1

**The Procter & Gamble Company**

One Procter & Gamble Plaza  
Cincinnati, Ohio 45202-3315  
United States of America

Opponent / Appellant

represented by ELZABURU, S.L.P., Miguel Angel, 21, ES-28010 Madrid, Spain

v

**WS-INVENTION trade GmbH**

Ricoweg 7  
AT-2351 Wr. Neudorf  
Austria

Applicant / Respondent

represented by BARKHOFF REIMANN VOSSIUS, Grosjeanstr. 2,  
DE-81925 München, Germany

APPEAL relating to Opposition Proceedings No B 1 494 502 (Community trade mark  
application No 7 237 481)

**THE FIRST BOARD OF APPEAL**

composed of Th. M. Margellos (Chairperson), S. Martin (Rapporteur) and  
C. Bartós (Member)

Registrar: P. López Fernández de Corres

gives the following

## Decision

### Summary of the facts

- 1 By an application filed on 17 September 2008, WS-INVENTION trade GmbH ('the applicant') sought to register the word mark

### Pro V

for the following goods:

Class 7 – Electric household and kitchen utensils, food processors for grating, juicing, grinding and pureeing; electric chopping and shredding utensils, electric mixing, kneading and blending utensils for household purposes; stick blenders; blender attachments; blenders; electric can openers; electric fruit presses and juicers, juice extractors; appliances and devices for preparing beverages and foods; vacuum cleaners, vacuum cleaner accessories, in particular cyclone coarse particle separators; hand-held vacuum cleaners; sewing machines; polishing machines for motor vehicles;

Class 8 – Hand tools and implements (hand operated); Forks, knives and spoons; special-purpose knives; carving sets; hand-operated screwing, drilling and socket nut fittings; ratchet spanners; vegetable shredders;

Class 11 – Apparatus for lighting, cooking, refrigerating, drying and ventilating; foot massage tubs; refrigeration installations; wine coolers (cabinets); baking, roasting, grilling and toasting apparatus; electric grilling apparatus; electric hot plates; hair dryers; machines for making ices;

Class 21 – Household, kitchen utensils and containers; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware (not included in other classes); articles for cleaning purposes, saucepans, pasta pans; frying pans, pancake pans; glassware, lead crystal glassware, vases, glasses, balloon glasses, glass figurines; coffee pots; hand-operated crushers and grinders for household purposes; cocktail shakers; dredgers; corkscrews; hand operated pasta machines; fruit presses and juicers; brooms of plastic, household or kitchen sweeping apparatus, brushes and brush heads.

- 2 The application was published in the Community Trade Marks Bulletin No 49/2008 of 9 December 2008.
- 3 On 9 March 2009 the opponent filed a notice of opposition against all the goods covered by the contested mark.
- 4 The opposition is based on the following earlier rights and on all or part of their goods:
  - Community trade mark registration No 273 292 'PRO-V' a well-known mark in the territory of the European Union, filed on 6 May 1996, registered on 9 February 1999 for goods in Class 3, and renewed until 6 May 2016. The opposition is based on part of the goods, namely 'preparations for the cleaning, care and beautification of the skin, scalp and hair'.

- 'PRO-V', a well-known mark in the territory of the European Union for goods in Class 3 'preparations for the cleaning, care and beautification of the skin, scalp and hair'.
  - Community trade mark registration No 58 719 'PANTENE PRO-V' a well-known mark in the territory of the European Union, filed on 1 April 1996 and registered on 30 April 1998 for goods in Class 3 'preparations for the care, treatment and beautification of the hair of adults'.
  - 'PANTENE PRO-V', a well-known mark in the territory of the European Union for goods in Class 3 'preparations for the care, treatment and beautification of the hair of adults'.
- 5 The grounds of opposition are those laid down in Article 8(1)(b) and 8(5) of the Community Trade Mark Regulation ('CTMR').
  - 6 On 15 December 2010 the Opposition Division issued a decision ('the contested decision') rejecting the opposition in its entirety and ordering the opponent to bear the costs.
  - 7 The Opposition Division concluded that since the goods at hand are clearly dissimilar (essentially, household and kitchen utensils for the contested sign and 'preparations for the cleaning, care, treatment and beautification of the skin, scalp and hair' for the earlier sign), the opposition based on Article 8(1)(b) CTMR was rejected.
  - 8 With regard to the opposition based on Article 8(5) CTMR the Opposition Division noticed that apart from claiming reputation and arguing that consumers will establish a link between the trade marks in view of their similarities, the opponent did not provide any facts, arguments or evidence which could support the conclusion that use of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade marks. The Opposition Division added that the opponent had also failed to show 'what special quality of the image associated with its earlier mark "PANTENE PRO-V" would be incompatible with the contested mark "Pro V", nor in which way such a special image or the distinctiveness of the earlier mark would be harmed if the application is used for the goods applied for'.
  - 9 Consequently the opposition based on Article 8(5) CTMR was also rejected.
  - 10 On 7 January 2011 the opponent filed a notice of appeal against the contested decision. On 12 April 2011 the opponent filed its statement of grounds of appeal.
  - 11 The applicant submitted its observations on 25 May 2011.

#### **Submissions and arguments of the parties**

- 12 As its first argument, the opponent submits that the Opposition Division erred when it concluded that 'drying apparatus, hair dryers, brushes and brush heads'

are clearly dissimilar when compared to 'preparations for the cleaning, care, treatment and beautification of the skin, scalp and hair for the earlier sign'.

- 13 In support of its claim pursuant to Article 8(5) CTMR the opponent filed a new document consisting of a market survey conducted in Spain (Annex 3).
- 14 In addition, it argues that the contested mark will benefit from the reputation of the earlier sign which carries the image of glamour whereas in return its mark would be negatively affected by the use of a similar sign in relation to 'vegetable slicers' [sic].
- 15 Finally, the opponent makes a vague reference to the fact that its trade mark could be diluted 'following the registration of an identical trademark for PRO V'.
- 16 In its observations in reply, the applicant requests essentially the confirmation of the contested decision and an award of costs.

### Reasons

- 17 The appeal complies with Articles 58 to 60 CTMR and Rule 48 CTMIR. It is, therefore, admissible.

### *New evidence*

- 18 In view of Article 76(2) CTMR, the Board enjoys discretion to decide, while giving reasons for its decision, to take new evidence into account if said evidence is *prima facie* likely to be relevant to the outcome of the proceedings (see judgment of 13 March 2007, C-29/05 P, 'Arcol' paras 42 to 43). The Board should further consider the stage of the proceedings at which the late submission takes place and whether the circumstances surrounding it do not preclude such matters being taken into account (see judgment 'Arcol', cited above).
- 19 In the present case, the additional evidence filed in the course of the present appeal (a market study relating to the notoriety, perception and degree of confusion of the trade mark 'Pantene Pro-V', dated 10 October 2010, conducted by an entity doing business under the name of 'Sondea Internet S.L.' ('Market Study')) complements the evidence submitted before the Opposition Division and has been filed in response to certain findings of the contested decision. This evidence is therefore supplementary in the sense contemplated by Rule 50 CTMIR, hence it completes and enhances the documentation already filed before the Opposition Division. It is also both in the public interest and in the interest of the parties to have the dispute examined and decided on the basis of all relevant facts. The new evidence is therefore admissible.

### *Article 8(1)(b) CTMR*

- 20 Pursuant to Article 8(1)(b) CTMR, a likelihood of confusion presupposes that the marks at issue are identical or similar and that the goods or services which they

cover are identical or similar. Those conditions are cumulative (see judgment of 22 January 2009, T-316/07, 'easyHotel', para. 42 and the case-law cited therein).

#### *Relevant public*

- 21 The goods and services are intended for both the general public and professionals. However, in cases involving two groups of consumers with different level of attention, it is sufficient that there exists a likelihood of confusion for one of the groups (see judgment of 15 February 2011, T-213/09, 'Yorma's', para. 25).
- 22 Since the earlier mark is a Community trade mark, the relevant public consists of consumers throughout the whole European Union.

#### *Comparison of the signs*

- 23 In general terms, two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects, namely the visual, aural and conceptual aspects (see judgment of 23 October 2002, T-6/01, 'Matratzen', para. 39; judgment of 22 June 2005, T-34/04, 'Turkish Power', para. 43, upheld on appeal by order of 1 June 2006, C-324/05 P, 'Turkish Power').
- 24 The contested trade mark 'Pro V' is identical to the earlier right consisting of Community trade mark registration No 273 292 'PRO-V'. The omission in the contested sign of the hyphen only marginally affects the visual comparison of the signs at issue and plays no role whatsoever in the assessment of the aural and conceptual similarity.
- 25 In most languages of the Union, the term 'pro' is the standard abbreviation for the word 'professional'. As a result, both signs indicate that the products are addressed to professionals or are of a quality usually expected by professionals. In this regard, both signs are also conceptually identical.

#### *Comparison of the goods*

- 26 In relation to the ground of opposition based on Article 8(1)(b) CTMR the opponent disputes only the conclusion of the Opposition Division to the effect that 'drying apparatus, hair dryers, brushes and brush heads' ('the contested goods') are clearly dissimilar when compared to 'preparations for the cleaning, care, treatment and beautification of the skin, scalp and hair for the earlier sign'.
- 27 According to settled case-law, in order to assess the similarity between the goods or services concerned, all the relevant features of the relationship between them should be taken into account. Those features include, in particular, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary. Other factors may also be taken into account, such as the distribution channels of the goods concerned (see judgment of 11 July 2007, T-443/05, 'Pirafiam', para. 37 and the case-law cited therein).

28 In the present case, it cannot be reasonably disputed that the contested goods share the same intended purpose (i.e. the care of the hair and its stylization) and as they may also, in certain circumstances, be used together (for example curling sprays may be used in conjunction with hair irons) a clear complementary relationship between them also exists. In addition, the goods share the same distribution channels, being sold in perfumeries, in the cosmetics parts of supermarkets and beauty salons (see decision of 28 June 2007, R 979/2006-1, 'HAIR SPA / SPA THERMES *et al.*,' para. 17; decision of 9 February 2010, R 307/2009-1, 'MICKYlandia (FIG. MARK) / DISNEYLAND MICKEY MOUSE *et al.*,' para. 52). As a result the goods present a certain similarity albeit not very high.

#### *Likelihood of confusion*

- 29 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8 (1)(b) CTMR (see, to that effect, judgment of 11 November 1997, C-251/95, 'Sabèl', paras 16 to 18; judgment of 29 September 1998, C-39/97, 'Canon', para. 30).
- 30 The appreciation of a likelihood of confusion on the part of the public depends on numerous elements and, in particular, on the recognition of the trade mark on the market, the association which can be made with the used or registered sign, the degree of similarity between the trade mark and the sign and between the goods or services identified (eighth recital of the CTMR). It must be appreciated globally, taking into account all factors relevant to the circumstances of the case (see judgment of 22 June 1999, C-342/97, 'Lloyd Schuhfabrik', para. 18; judgment of 11 November 1997, C-251/95, 'Sabèl', para. 22).
- 31 Such a global assessment of a likelihood of confusion implies some interdependence between the relevant factors, and in particular, the similarity between the trade marks and between the goods or services. Accordingly, a greater degree of similarity between the goods may be offset by a lower degree of similarity between the marks, and vice versa (see, to that effect, judgment of 22 June 1999, C-342/97, 'Lloyd Schuhfabrik', para. 20; judgment of 11 November 1997, C-251/95, 'Sabèl', para. 24; judgment of 29 September 1998, C-39/97, 'Canon', para. 17).
- 32 In view of the above, taking into account the relevant factors, in particular the principle of imperfect recollection and their mutual interdependence, the degree of similarity between the marks as well as the similarity between the contested goods, the Board concludes that there is a likelihood of confusion between the marks at issue in relation to 'drying apparatus, hair dryers, brushes and brush heads'.
- 33 The appeal is therefore granted in so far as it rejected the opposition in relation to 'drying apparatus, hair dryers, brushes and brush heads'.

*Article 8(5) CTMR*

- 34 According to Article 8(5) CTMR, an opposition to an application for a Community trade mark may be founded on an earlier Community trade mark which has a reputation in the European Union or on an earlier national trade mark which has a reputation in the Member State concerned, even though the earlier mark is registered for goods or services which are not similar to the goods or services covered by the application for a Community trade mark, provided that the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to the distinctive character or the repute of the earlier trade mark.
- 35 The application of Article (5) CTMR is subject to the following conditions: (i) the marks at issue must be identical or similar; (ii) the earlier mark cited in the opposition must have a reputation; and (iii) there must be a risk that the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark. Since those three conditions are cumulative, failure to satisfy one of them is sufficient to render that provision inapplicable (see judgment of 25 May 2005, T-67/04, 'Spa-Finders', para. 30).

*Reputation*

- 36 A mark with a reputation is a mark that is known by a significant part of the public concerned by the products or services covered by that trade mark in a substantial part of the relevant territory which is, in the case at hand, Germany (see judgment of 6 October 2009, C-301/07, 'Pago', para. 30).
- 37 In assessing the reputation of a mark account shall be taken of the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it (see judgment of 14 September 1999, C-375/97, 'Chevy', para. 27).
- 38 In order to prove reputation the opponent has filed the following documents:

'a) An article from the Talkingretail.com website ... [granting] the opponents' [sic] PANTENE PRO-V product an award as Product of the Year 2008.

b) An article by CEW ("Building Leaders") reporting that the CEW Foundation honoured Pantene Pro-V at the annual Beauty of Giving Luncheon held in New York on 11 December 2007.'

This recognition pertains to the US market and is therefore not relevant to the present proceedings;

'c) An article from Advertising Age of 26 June 2006 listing the "100 Leading National Advertisers", including the opposing company and its PANTENE hair products in 2005 and 2004.'

This is a US publication and is therefore not relevant to the present proceedings;

'd) An article from *Beauty Packaging Magazine* ...';

Again this is a US publication which bears no relevance to the present proceedings;

'e) An article from *Advertising Age*, "Top 200 Megabrands", 2006 edition';

For the reason outlined in paragraph c) above, this article does not prove reputation of the marks in the European Union;

'f) A report by AC Nielsen entitled "Reaching the Billion Dollar Mark: A Review of Today's Global Brands", which likewise makes reference to the opponents' [sic] PANTENE product range and includes growth rates for 1999 to 2001.'

The document indicates that the 'PANTENE' brand's largest market is situated in North America and as such it does not support the opponent's claim of reputation in Europe;

'g) An article from *Cosmetics design-europe.com* dated 24 August 2004 ...';

which purports to provide information on the launch of a new product;

'h) An article on the Product Development and Management Association's website that makes reference to the opponents' [sic] acquisition of PANTENE PRO-V in 1985 ...;

i) A market survey on PRO-V conducted in Southampton, UK on 10-11 September 2007 and another in Ireland, the latter based on interviews with 97 people, all women between 18 and 50 years of age ...' (confidential);

The sample is far too limited to allow the decision maker to draw any conclusions;

'j) Copies of frames from the opponents' [sic] television commercials for their brand. PANTENE PRO-V ...' (confidential)

The document does not indicate on which channels the advertisements may have been broadcasted, when and on what frequencies;

'k) A table of sales of ... [shampoos and conditioners under the trade mark "PANTENE"]' in France in 2005, 2006, and up to September 2007 ...' (confidential);

l) A table presenting certain figures relating to 'shampoos, conditioners, styling' (confidential);

m) A table presenting certain figures relating to 'shampoos, conditioners, styling' for Italy, the United Kingdom, Germany, Italy and France (confidential);

'n) Table listing advertising expenditures for the opponents' [sic] PANTENE PRO-V mark ... ' (confidential);

o) A copy of a flyer used in stores in Italy in 2006;

p) PANTENE megabrand Western Europe Business Development' (confidential);

The figures contained in this document are not self explanatory and the Board is at a loss to understand how they can assist the opponent in proving the reputation of its earlier marks;

q) A written statement providing advertising and sales figures for the period from June 2006 to June 2007 in relation to hair products sold under the trade mark 'Pastene Pro-V' (confidential);

r) Four pages containing data about PANTENE Megabrand Western Europe Business Development from 2006 – 2007, containing data about the market share of the trade mark and the opponent's business development;

s) A study issued in April 2007 by the Spanish Ministry of Industry, Commerce and Tourism about the drugstore and perfumery items sold in Spain. It shows 'PANTENE PRO-V' in second place among the top 10 shampoos, with a volume of sales of around 11% in 2005 and 2006;

t) A copy of a note regarding the Hungarian perfumery and cosmetic market prepared in April 2008 by ICEX, the Spanish Foreign Trade Institute, under the supervision of the Economic and Commercial Office of the Spanish Embassy in Budapest. In the study it is indicated that during the period from 2003 to 2007, 'PANTENE PRO-V' is among the most visible trade marks for hair care preparations on the Hungarian market and is in second place among the best-selling brands for hair care preparations on the Hungarian market;

u) A copy of an article published on the website [www.alimarket.es](http://www.alimarket.es), dated 1 December 2000 and mentioning the opponent's company and the trade mark 'PANTENE PRO-V'. The article also contains a breakdown originating from A.C. Nielsen of the shampoo market in Spain. It indicates that the opponent is the leading company in the said market and 'PANTENE PRO-V' has the largest percentage (15.2%);

v) Copies containing samples of the bottles of shampoos and conditioners on which the marks 'PANTENE PRO-V' and 'PRO V' appear. These bottles are labelled in the following languages: Spanish, Portuguese, French and German.

39 In the course of the present appeal, the opponent has filed a Market Study in Spain (Annex 3). This study shows recognition of the trade mark 'Pantene Pro-V' by 96.2% of the participants. In addition, more than 96% of the respondents perceive the mark as 'a prestigious mark'.

40 However, the Board notes that the questions submitted to the participants are rather suggestive and leading. In addition, they imply legal concepts and considerations. Indeed, the legal community has been debating the concept of

what constitutes 'a prestigious mark' for decades. The same remark applies to the notion of 'damaging the image and prestige of [...] and 'the negative effect on the perception of the quality of the Pantene Pro-V/Pro-V trademark'. In addition, it is unclear whether the 1 005 people who answered the questionnaire remain representative of the initial sample. As a result, the Board does not attach any probative value to this opinion poll.

- 41 The written statement signed by Helen Davies on 21 April 2008 (Attachment O) – (confidential) proves that the opponent has spent considerable amounts in the promotion of hair products (shampoos, hairsprays and conditioners) sold under the trade mark 'Pantene Pro-V'. It also proves that the opponent has achieved considerable sales of the same hair products sold under the same trade mark. The witness states that this figure also relates to the mark 'PRO-V' on a stand-alone basis. This affirmation is however not supported by the evidence which shows use of the word elements 'PRO-V' always in conjunction with 'PANTENE'.
- 42 In the present case the Board, in view of the sales and advertising expenditure, has no doubt that the earlier mark 'Pantene Pro-V' has acquired reputation in the European Union in relation to hair products within the meaning of Article 8(5) CTMR.
- 43 However, this conclusion cannot be extended to the earlier mark represented by the word elements 'Pro-V' alone. The use of the earlier mark 'PANTENE PRO-V' cannot as such be a conclusive indication of the reputation of the earlier mark 'PRO-V' as the word element 'PANTENE' forms an important distinctive element of the earlier mark 'PANTENE PRO-V' for which reputation is proven.

*Comparison of the signs*

- 44 Under Article 8(5) CTMR the signs in dispute must present a certain degree of similarity allowing relevant consumers to establish a link between them even though they do not confuse them (see judgment of 27 November 2008, C-252/07, 'Intel', para. 30).
- 45 In view of the finding regarding the reputation of the earlier signs, the marks to be compared are the following:

Pro V	PANTENE PRO-V
<i>Contested mark</i>	<i>Earlier mark</i>

- 46 Visually and phonetically, both marks coincide in the element 'PRO' and 'V'. The omission of the hyphen is irrelevant since it will remain unnoticed by the relevant consumer. The omission by the contested mark of the term 'PANTENE' constitutes a differentiating element which however cannot exclude any similarity between the marks.

- 47 In view of these considerations it can be concluded that the signs are sufficiently similar to satisfy the requirements of Article 8(5) CTMR.

*Unfair advantage of the distinctive character or the repute of the earlier trade mark*

- 48 The concept of taking unfair advantage of the distinctive character or the repute of the earlier mark is intended to encompass instances where there is clear exploitation and free-riding on the coattails of a famous mark or an attempt to trade upon its reputation (see judgment of 25 May 2005, T-67/04, 'Spa-Finders', para. 51).
- 49 In other words, this concerns the risk that the image of the mark with a reputation or the characteristics which it projects are transferred to the goods covered by the mark applied for, with the result that the marketing of those goods is made easier by that association with the earlier mark with a reputation (see judgment of 22 March 2007, T-215/03, 'Vips', para. 40). The unfair advantage for the third party arises in the substantial savings on investment in promotion and publicity for its own goods, since it benefits from that already undertaken by the earlier reputed mark.
- 50 The assessment of this injury entails a global assessment of all the relevant facts of the case, among which the degree of inherent distinctiveness and reputation of the earlier mark, the degree of similarity between the signs, and the degree of connection between the goods and services concerned are of particular importance. The stronger the earlier mark's distinctive character and reputation the easier it will be to accept that unfair advantage has or would be taken or detriment has or would be caused (see judgment of 14 September 1999, C-375/97, 'Chevy', para. 30). The closer the similarity between the marks the greater the risk that unfair advantage will be taken. The greater the proximity between the goods and the circumstances in which they are marketed, the greater the risk that the public in question will make a link between the mark and the sign in question. It is clear from case-law that the more immediately and strongly the mark is brought to mind by the sign, the greater the likelihood that the current or future use of the sign is taking, or will take, unfair advantage of the distinctive character or the repute of the mark or is, or will be, detrimental to it (see, to that effect, judgment of 27 November 2008, C-252/07, 'Intel', paras 67 to 69; judgment of 18 June 2009, C-487/07, 'L'Oréal', paras 41 and 43).
- 51 Pursuant to Article 76(1) CTMR, the burden lies with the opponent to establish the condition of unfair advantage. However, it follows from the conditional wording of Article 8(5) CTMR ('would take unfair advantage of') that the opponent is not required to demonstrate actual and present injury to its mark.
- 52 The proprietor of the earlier mark must, however, prove that there is a serious risk that such an injury will occur in the future (see judgment of 27 November 2008, C-252/07, 'Intel', para. 38). The risk shall be certain and not hypothetical (see judgment of 25 May 2005, T-67/04, 'Spa-Finders', para. 40).

- 53 In this regard, the opponent must put forward a coherent line of arguments demonstrating how the concurrent use of the contested sign would profit from the reputation of the earlier mark. This requirement reflects also the principle of procedural fairness since it allows the responding party to know exactly what arguments have been put forward and to respond accordingly.
- 54 In addition, the opponent shall also prove the intrinsic or acquired qualities associated with its trade mark and from which the younger mark will or could benefit (image, prestige, high quality, trustworthiness, reliability, style, etc.) (see judgment of 22 March 2007, T-215/03, 'Vips', para. 58).
- 55 In the present case, the opponent alleges that its mark is associated with an image of 'glamour'. However, it has not adduced any evidence to support this assertion.
- 56 In support of its claim, the opponent submits that the earlier mark 'Pantene Pro-V' is a famous mark in the European Union in relation to hair products and that as a result the registration of the contested mark would allow the applicant to save 'on investment in promotion and publicity for its own goods since it will be able to free ride [...]'.
- 57 It should be recalled that reputation alone is not sufficient. As it appears from the case-law cited above the opponent must adduce evidence and develop a line of argument to demonstrate 'unfair advantage'. In this regard, the Board notes that the opponent has not provided any reasons explaining why it would be advantageous for a mark relating to kitchen utensils to be associated with a mark known for hair care products.
- 58 In view of the foregoing the Board is not in a position to draw any conclusions as to this first injury contemplated by Article 8(5) CTMR.
- 59 However, even if the Board were to conclude differently, this would not change the outcome of the present case.
- 60 Defining the relevant consumer, the Court of Justice found that unfair advantage, taken by the later mark, has to be assessed by reference to average consumers of the goods or services for which the later mark is applied for (see judgment of 27 November 2008, C-252/07, 'Intel', paras 35 to 36). In the case at hand, the goods are every day items addressed both to the general public and to professionals.
- 61 In the present case, the earlier mark is inherently distinctive, enjoys reputation in the relevant territory and the signs present a certain similarity. However, the proximity between the sectors concerned by the products at hand is inexistent. Indeed, it is unlikely that the characteristics associated with a mark used in connection with hair care products could be of any profit to the distribution and sale of goods such as, 'vegetable shredders' and 'food processors for granting, juicing, grinding and pureeing'. These goods are so dissimilar that the later mark is unlikely to bring the earlier mark to the mind of the relevant public (see judgment of 27 November 2008, C-252/07, 'Intel', para. 49).

- 62 As a result, the relevant consumer will not establish a link between the marks so that use of the contested mark would take unfair advantage of the repute of the earlier trade mark.

*Detriment to the distinctive character of the earlier mark*

- 63 Detriment to the distinctive character of the earlier mark by use without due cause of the mark applied for can occur where the earlier mark is no longer capable of arousing an immediate association with the goods for which it is registered and used (see judgment of 25 May 2005, T-67/04, 'Spa-Finders', para. 43). That risk thus refers to the 'dilution' or 'gradual whittling away' of the earlier mark through the dispersion of its identity and its hold upon the public mind (see judgment of 27 November 2008, C-252/07, 'Intel', para. 29).
- 64 Proof that use of the later mark is or would be detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future (see judgment of 27 November 2008, C-252/07, 'Intel', para. 77).
- 65 Such a conclusion may be established, in particular, on the basis of logical deductions made from an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case (see judgment of 25 May 2005, T-67/04, 'Spa-Finders', paras 40 and 44; judgment of 16 April 2008, T-181/05, 'Citi', para. 77).
- 66 In this regard, the opponent alleges that the registration of an identical trade mark for 'PRO V' will necessarily result in the dilution of its own marks. This rather terse argument is not sufficient to successfully plead an infringement of Article 8(5) CTMR.
- 67 Indeed, the fact that the earlier mark has a huge reputation for certain specific types of goods or services, that those goods or services and the goods or services for which the later mark is registered are dissimilar or dissimilar to a substantial degree, that the earlier mark is unique in respect of any goods or services and that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark to mind, is not sufficient to establish the existence of a detriment within the meaning of Article 8(5) CTMR. In particular, the existence of a link between the competing marks does not dispense the proprietor of the earlier trade mark of proving that there is a serious likelihood that such an injury will occur in the future (see judgments of 16 December 2010, T-345/08 and T-357/08, 'Botolist / Botocyl', para. 84).
- 68 In other words, the opponent cannot discharge its burden of proof by merely making an abstract reference to notions mentioned in the text of Article 8(5) CTMR. On the contrary, the opponent has to provide specific indications in respect of the younger mark and indicate and enumerate, how and

why use of the younger mark could or would prejudice the distinctive character of its mark.

- 69 In this regard, it should be recalled that Article 76(1) CTMR restricts the Board's examination to the facts, evidence and arguments presented by the party to the proceedings. When the opponent has not established or explained in any way why the younger trade mark could offend the earlier mark in terms of detriment, then it is neither for the Board to construe or invent hypothetical situations where that could be conceivable, nor for the applicant to rebut arguments that have not been alleged.
- 70 Having regard to the foregoing, the Board can only conclude that the opponent has not adduced any evidence or put forward any relevant argument to demonstrate that use of the contested mark would cause a dilution of the earlier mark through the dispersion of its identity and its hold upon the public mind.

*Detriment to the repute of the earlier mark*

- 71 The risk of that detriment can, *inter alia*, occur where those goods or services have a characteristic or a quality which may have a negative influence on the image of an earlier mark with a reputation on account of its being identical or similar to the mark applied for (see judgment of 22 March 2007, T-215/03, 'Vips', para. 39).
- 72 Defining the relevant consumer, the Court of Justice found that a detriment to the earlier mark must be assessed by reference to average consumers of the goods and services for which the earlier mark is registered (see judgment of 27 November 2008, C-252/07, 'Intel', paras 35 to 36).
- 73 Accordingly, detriment to the earlier mark must be assessed by reference to the average European consumers of bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps; perfumery, essential oils, cosmetics, hair lotions, dentifrices, preparations for the cleaning, care and beautification of the skin, scalp and hair preparations for the care, treatment and beautification of the hair of adults, who are deemed to be reasonably well informed and reasonably observant and circumspect (see judgment of 2 February 2011, T-437/09, 'Oyster cosmetics').
- 74 Again, it is important to reiterate that pursuant to Article 76(1) CTMR the burden lies with the opponent to establish the condition of detriment to the repute of its mark.
- 75 In relation to this third injury the opponent has alleged that its mark would be negatively affected by the use of a similar sign in relation goods such as 'vegetable shredders' and 'food processors for granting, juicing, grinding and pureeing' since the image of luxury which it submits is associated with its marks could be tarnished by the use of an identical mark with the aforementioned goods used in a kitchen.

76 This statement is merely a standard generalization and is insufficient to allow the Board to assess the issue of detriment to the repute of the earlier mark. In addition, the opponent has not proven that its mark conveys an image of 'luxury'. Finally, the opponent should have explained how its reputation in the field of hair care and beauty products might be damaged by the applicant's use of a similar mark in relation to kitchen utensils.

77 The Board also notes that 'vegetable shredders' and 'food processors for granting, juicing, grinding and pureeing' covered by the contested trade mark do not convey any negative image. Consequently, such use will not negatively affect the consumer's perception of the qualities and have possible adverse effects on the goods covered by the earlier mark. This would be different if, for example, the contested sign were to be used in relation to chemicals, or household cleaning products.

*Conclusion regarding Article 8(5) CTMR*

78 In light of the foregoing, the Board confirms the decision of the Opposition Division rejecting the opposition based on Article 8(5) CTMR.

79 The appeal based on this ground is, therefore, dismissed.

**Costs**

80 In view of the mixed results of this appeal, the Board, in accordance with Article 85(2) CTMR, decides that each party shall bear its own fees and costs incurred in the proceedings before the Office.

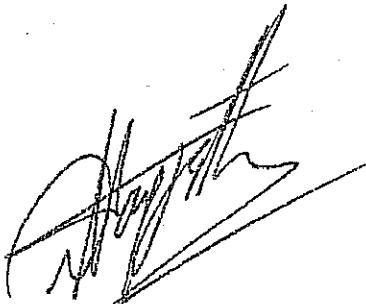
**Order**

On those grounds,

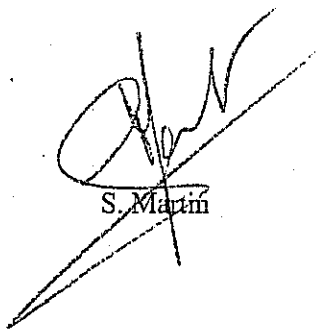
**THE BOARD**

hereby:

- 1. Annuls the contested decision in so far as it rejected the opposition in relation to 'drying apparatus, hair dryers, brushes and brush heads';**
- 2. Rejects the CTM application for these goods;**
- 3. Orders the parties to bear their own costs and expenses as incurred in the proceedings before the Office.**



Th. M. Margellos

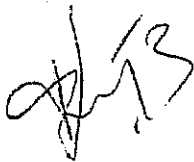


S. Martín



C. Bartos

Registrar:



P. López Fernández de Corres