



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

Trade Marks Department

B206b

Notification to the applicant/holder of a decision

Alicante, 15/12/2010

BARKHOFF REIMANNVOSSIUS
Grosjeanstr. 2
D-81925 München
ALEMANIA

Your reference: **449-92**
Number of the opposition: **B 001494502**
Trade mark number: **007237481**
Name of the applicant/holder: **WS-INVENTION trade GmbH**

Please see the attached decision which ends the opposition proceedings referred to above.
It was delivered on **15/12/2010**.

GÖTZOVÁ, Silvie

Enclosures (excluding the cover letter): 16 pages.

Sent to fax number: 004989904755455

Please note that the decisions of the Opposition Division will not be signed by the responsible officials, but will only indicate their full name and carry a printed seal of the Office according to Rule 55(1) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 207/2009 on the Community trade mark (codified version of Council Regulation (EC) No 40/94).



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

DECISION
of 15/12/2010
RULING ON OPPOSITION No B 1 494 502

Opponent: The Procter & Gamble Company
One Procter & Gamble Plaza
Cincinnati, Ohio 45202-3315
United States of America

Representative: Elizaburu, S.L.P.
Miguel Angel, 21
28010 Madrid
Spain

Trade marks: 1. PRO-V
3. PANTENE PRO-V

Well-known marks: 2. PRO-V
4. PANTENE PRO-V

a g a i n s t

Applicant: WS-Invention Trade GmbH
Ricoweg 7
2351 Wr. Neudorf
Austria

Representative: Barkhoff Reimann Vossius
Grosjeanstr. 2
81925 München
Germany

Contested trade mark: Pro V

I. FACTS AND PROCEDURE

On 17/09/2008 the applicant filed the contested trade mark No 7 237 481 to register the trade mark shown on the cover page for goods in classes 7, 8, 11 and 21.

The opposition is directed against all of the goods covered by the contested trade mark.

The opposition is based on the following earlier rights:

1. Community trade mark registration No 273 292 shown on the cover page, filed on 06/05/1996, registered on 09/02/1999 and duly renewed until 06/05/2016 for goods in class 3,
2. Well-known mark in the territory of the European Union for goods in class 3,
3. Community trade mark registration No 58 719 shown on the cover page, filed on 01/04/1996, registered on 30/04/1998 and duly renewed until 01/04/2016 for goods in class 3,
4. Well-known mark in the territory of the European Union for goods in class 3.

The opposition is based on all or part of the goods covered by the earlier marks.

The grounds of the opposition are those laid down in Article 8(1)(b) and 8(5) of the Community Trade Mark Regulation (CTMR).

The opponent argues that there is a likelihood of confusion because of the identity of the marks and because the goods covered by them are similar. It bases the opposition on well-known marks as well. The opponent also claims that its earlier registered marks have a reputation and that the contested trade mark will cause detriment to the distinctiveness and reputation of them.

The opponent evolves its arguments about the existence of a likelihood of confusion. It also submits evidence about the reputation of its marks. In its opinion, the use of the contested trade mark would result in the misappropriation of the distinctive character and repute of the earlier marks and would be detrimental to the brand. It finds that the application covers a sector standing in opposition to that covered by the earlier marks. Therefore, the opponent's mark would suffer "*dilution by tarnishment*", particularly if the products sold under the contested mark were of low quality. Furthermore, the owner of the opposed mark would wrongly benefit from the reputation of the opponent's marks, most notably in relation to similar goods.

In reply the applicant argues that the earlier signs contain generic terms that the opponent intends to monopolise. It states that the element "PRO-V" does not have an exclusive character, being used in various sectors of the market, and files evidence to support this claim. In addition, "PRO-V" is descriptive since it highlights certain functions and properties of the products at issue. The applicant finds that the reputation and well-known character of the earlier marks are not proven either. It argues that the opponent's mark No 273 292 ("PRO-V") is not used in an isolated way, but in conjunction with the element "PANTENE". It also claims that the opposition should be rejected under Article 8(1)b CTMR since the goods of the contested trade mark are very different from those protected by the opponent's earlier marks.

In its final submissions, the opponent reiterates its previous arguments and attaches its national trade mark registrations with the designation "PRO-V" to illustrate the distinctiveness of this element.

II. DECISION

1. Preliminary remarks

For reasons of procedural economy, the Office finds it expedient to start the examination with the Community trade mark registration No 273 292. This is because it is almost identical with the application and covers more goods than the other earlier marks.

2. Likelihood of Confusion – Article 8(1)b CTMR

a) Comparison of the goods

In assessing the similarity of the goods concerned, all the relevant factors relating to these goods should be taken into account. These factors include, inter alia, their nature, their purpose of use and their method of use and whether they are in competition with each other or are complementary (see Judgment of 29 September 1998, Case C-39/97, *Canon*, ECR I-5507).

Further factors include the purpose of the goods, whether or not they may be expected to be manufactured, marketed or provided by the same undertaking, or by economically linked undertakings, as well as their distribution channels and sales outlets.

The goods on which the opposition is based are the following:

Class 3: Preparations for the cleaning, care and beautification of the skin, scalp and hair.

The contested goods are the following:

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.*

Contested goods in class 7:

The *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* are aimed at kitchen and household use other than personal care and beautification purposes. In comparison with that, the earlier right covers skin and hair care products. The origin, nature, method of use and manufacturers of the said goods are different. These goods are distributed by different types of retailers or, at least, in different sections of large retailing stores. They are neither complementary nor in competition. Therefore, the goods in conflict are considered to be dissimilar.

Contested goods in class 8:

The contested *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* are hand-operated kitchen utensils and hand-operated implements used as tools in miscellaneous professions (cf. Nice Classification, 9th Edition, Explanatory Notes), while the specification of the earlier right covers skin and hair care products. The origin, nature, method of use and producers of the goods under comparison are different. Furthermore, they do not share the trade channels, being distributed by different types of retailers or in different sections of large retailing stores. These goods are neither complementary nor in competition. Therefore, they are found to be dissimilar.

Contested goods in class 11:

The *apparatus for lighting, cooking, refrigerating, drying and ventilating; refrigeration installations; wine coolers (cabinets); baking, roasting, grilling and toasting apparatus; electric grilling apparatus; electric hot plates; machines for making ices* are articles used in the kitchen or in other household or professional environments for specific purposes, other than personal care. In comparison with that, the earlier right covers skin and hair care preparations. The nature, method of use and manufacturers of the goods in conflict are different. Their distribution channels do not coincide and they are neither complementary nor in competition. Thus, the goods at issue are dissimilar.

The contested *foot massage tubs; hair dryers* belong to the field of personal care, while the earlier right covers *preparations for the cleaning, care and beautification of the skin, scalp and hair* in class 3. Although all these goods are aimed at personal care, they have a different nature and method of use and they are normally not

produced by the same (group of) undertakings and are sold in different stores or at least in different sections of shared sales outlets. The mere coincidence in the very general purpose of personal care is not enough to conclude that these goods are similar. Consequently, the goods in conflict are found to be dissimilar.

Contested goods in class 21:

The contested *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* are aimed at kitchen and household use other than personal care and beautification. In comparison with that, the earlier right covers skin and hair care products. The nature, method of use and manufacturers of the goods at issue are different and they do not share trade channels. Furthermore, they are neither complementary nor in competition with each other. The goods in conflict are therefore found to be dissimilar.

The broad category of *household utensils and containers* of the application includes those articles for use in the bathroom. Although the earlier right covers skin and hair care products that are usually used in the said place, the goods in conflict have a different nature and method of use and they are normally not produced by the same or related undertakings. They are also sold in different stores or at least in different sections of shared sales outlets. Consequently, the goods in conflict are found to be dissimilar.

The applicant's *brushes and brush heads* include hair brushes and thus may be complementary to the goods related to hair care in class 3 of the earlier mark. However, the nature and method of use of these goods is different and they are generally not fabricated by the same or related companies. They are not in competition either. Therefore, the goods in conflict are considered to be dissimilar.

Consequently, all the goods of the contested trade mark are dissimilar to the goods covered by the earlier trade mark.

b) Conclusion

Article 8(1)(b) CTMR states that "the trade mark applied for shall not be registered: if because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark" (emphasis added).

According to Article 8(1)(b) CTMR, the similarity of the goods is a condition for a finding of likelihood of confusion. Since the goods are clearly dissimilar, one of the necessary conditions contained in Article 8(1)(b) CTMR is not fulfilled, and the opposition must be rejected.

This finding would still be valid even if the earlier trade mark were to be considered as enjoying a high degree of distinctiveness. Given that the dissimilarity of the goods

cannot be overcome by the high distinctive character of the earlier trade mark the evidence submitted by the opponent in this respect does not alter the outcome reached above.

The opponent has also based its opposition on other earlier marks.

However, the earlier Community trade mark registration No 58 719 covers a narrower scope of goods, being only aimed at the hair care of adults, and is less similar to the application due to its further verbal element ("PANTENE"). Therefore, the outcome cannot be different for the said trade mark registration. Furthermore, the opposition is also based on the well-known trade marks "PRO-V" and "PANTENE PRO-V". The former covers the same goods under an identical sign as the earlier Community trade mark registration No 273 292 and the latter is less similar to the application and covers less goods under an identical sign as the earlier Community trade mark registration No 58 719. Consequently, the outcome cannot be different with respect to the earlier well-known marks.

Therefore the Office proceeds with the examination of Article 8(5) CTMR.

3. Reputation – Article 8(5) CTMR

According to Article 8(5) CTMR upon opposition by the proprietor of an earlier trade mark within the meaning of Article 8(2) CTMR, the contested trade mark shall not be registered where it is identical with, or similar to, the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where, in the case of an earlier Community trade mark, the trade mark has a reputation in the Community and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

It follows from the above that the grounds of refusal of Article 8(5) CTMR are only applicable when the following conditions are met:

- a) The signs in conflict must be either identical or similar.
- b) The opponent's trade mark must have a reputation. The reputation must also be prior to the contested trade mark; it must exist in the territory concerned and in connection to the goods and/or services on the basis of which the opposition was entered.
- c) Encroachment upon reputation: the 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 mark.

The above mentioned requirements are cumulative and therefore the absence of any of them leads to the rejection of the opposition under Article 8(5) CTMR. It should be noted, however, that the fulfilment of all the above mentioned conditions may not be sufficient. Indeed, the opposition may still fail if the applicant establishes a due cause for the use of the contested trade mark.

In the present case, the applicant did not claim to have a due cause for using the contested mark. Thus, in the absence of any indications to the contrary, it must be assumed that no due cause exists.

a) Comparison of the signs

The signs to be compared are the following:

1) PRO-V Community trade mark No 273 292	Pro V
2) PANTENE PRO-V Community trade mark No 58 719	
Earlier trade marks	Contested trade mark

The relevant territory is the European Union.

A visual comparison of the signs shows that both are word marks. The earlier mark No 1 is the word combination "PRO-V" and the earlier mark No 2 consists of the text "PANTENE PRO-V". The contested mark is the title case word combination "Pro V".

The first earlier mark and the contested mark coincide in all the letters and differ in the hyphen which is present only in the earlier mark. Therefore there is a high degree of visual similarity between these marks.

The second earlier mark and the contested mark coincide in the letters "PRO V" and differ in the word "PANTENE" as well as in the hyphen contained in the earlier right. Bearing in mind the foregoing the Office considers that there is some degree of visual similarity.

Aurally, irrespective of the different pronunciation rules in the different languages of the European Union, the first earlier mark and the contested marks will be pronounced identically in the syllables /PRO-V/. Therefore these marks are aurally identical.

The pronunciation of the second earlier mark and the contested mark will coincide in the sequence of syllables /PRO-V/ and will differ in the word "PANTENE" included in the earlier mark. There is therefore some degree of phonetic similarity between these signs.

Conceptually, the word "PANTENE" contained in the second earlier mark has no meaning in any of the relevant languages. As to the letter "V" contained in all the marks, it may be perceived either as a letter or as the roman numeral denoting the number 5. As to the word "PRO" contained in all the marks, it is a Latin word which means "*for, in favour of*" and is also used to denominate an argument or consideration in favour of something (see, e.g., Oxford English Dictionary Online). It is understood as such in some of the relevant languages, e.g. German, English, Czech, Italian and Spanish.

Signs are conceptually identical or similar when the signs are perceived as having the same or a similar semantic content. Consequently the signs are conceptually similar to the extent that they both include the element "PRO".

It follows from the above that there is a high degree of visual similarity and an aural identity between the Community trade mark No 273 292 "PRO-V" and the application "Pro V", and conceptually they are similar to the extent of the common element "PRO".

As to the Community trade mark No 58 719 "PANTENE PRO-V", it has some degree of visual, aural and conceptual similarity with the application "Pro V".

b) Reputation of the earlier trade marks

According to the opponent the earlier trade mark has a reputation in the European Union.

Reputation implies a knowledge threshold which is only reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by it. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public.

The contested CTM application was filed on 17/09/2008. Therefore, the opponent was required to prove that the trade mark on which the opposition is based acquired reputation in the European Union prior to 17/09/2008. The evidence must furthermore show that reputation was acquired in respect of the goods, in connection with which reputation has been claimed by the opponent, namely the following:

Community trade mark No 273 292, "PRO-V":

Class 3: Preparations for the cleaning, care and beautification of the skin, scalp and hair.

Community trade mark No 58 719, "PANTENE PRO-V":

Class 3: Preparations for the care, treatment and beautification of the hair of adults.

In order to determine the level of reputation of the marks, all the relevant facts of the case must be taken into consideration, including, in particular, 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.

On 09/07/2009 the opponent filed the following evidence:

1. An article from the Talkingretail.com website of 23/01/2008, mentioning the "Product of the Year 2008" award assigned to two PANTENE PRO-V articles of the opponent for hair treatment and styling.
2. An article from the website CEW.org stating that the CEW Foundation honoured PANTENE PRO-V at the annual Beauty of Giving Luncheon held in New York on 11 December 2007.
3. An article from *Advertising Age* of 26/06/2006 listing the opponent's company amongst the "100 Leading National Advertisers" in the United States. In the

article it is mentioned that the opponent spent in advertising for the brand PANTENE 205,725 US Dollars in 2004 and 194,316 US Dollars in 2005.

4. An article dated 2008 from the website beautypackaging.com which names the opponent as the "Company of the Year", with a picture of "PANTENE PRO-V" product packaging. The mark "PANTENE" is referred to as the No 1 hair care brand in the world, sold in about 100 countries and approaching 3 billion US Dollars in annual sales. It informs that "PANTENE PRO-V" comprises more than 150 stock-keeping units (SKUs) and continues its geographic extension.
5. An article from the website www.adage.com in 2006, which ranks PANTENE at No 84 in 2004 and at No 82 in 2005 for the media spending amongst the "Top 200 Megabrands" in the United States and showing the product packaging PANTENE PRO-V.
6. A report by the company AC Nielsen, entitled "Reaching the Billion Dollar Mark: A Review of Today's Global Brands", which mentions the opponent's mark "PANTENE" and includes growth rates for 1999 to 2001. The study is conducted in 30 countries worldwide including 14 EU countries.
7. An article from Cosmetics Design-europe.com dated 24/08/2004, dealing with the United Kingdom brand "PANTENE PRO-V", describing the PRO-V complex.
8. An article from the Product Development and Management Association website in 2008, referring to the acquisition of "PANTENE PRO-V" in 1985 and its worldwide expansion.
9. Market surveys dated 10-11/09/2007 conducted in Southampton among 59 women and in London among 60 women. The age of the interviewed women was between 18 and 65+ years. In the document there is no information on the agency which carried out these market surveys. The surveys are intended to show the consumers' awareness of the mark "PRO V". The interviewees were asked if they recognize the opponent's product and where they would expect to buy it. About half of the interviewed people recognized the products as being marketed under the mark "PRO V" or "PANTENE" and expected to buy those products in supermarkets or chemists.
10. Several copies of frames of the opponent's television commercials ("Winter Rescue" and "Always Smooth") for the "PANTENE PRO-V" products. On one of those frames the date 06/03/2007 is indicated.
11. A series of tables, being internal documents originating from the opponent itself and containing the following figures:
 - sales of the opponent's products PANTENE in France, ranging from 7,466.3 million to 11,870.2 million euros in 2005, 2006 and 2007
 - Various market shares of PANTENE for the period 05/2006 - 06/2007 in the United Kingdom, Germany, Spain, Italy and France
 - figures of advertising expenditures for the opponent's PANTENE trade mark for the years 2006-2007 in several Western Europe countries, with a total amount of approximately 15,900,000 Euros in Germany, 14,190,000 Spain,

2,900,000 France, 17,900,000 United Kingdom, 14,500,000 Italy, 3,800,000 Portugal, 1,000,000 Belgium, 1,500,000 Austria, etc.

12. A copy of a flyer written in Italian and dated 2006, showing the products of the opponent under the mark "PANTENE PRO-V", to be used in stores in Italy in the same year.
13. PANTENE Megabrand Western Europe Business Development from 2006 – 2007, containing data about the market share of the trade mark.
14. A witness statement dated 21/04/2008, signed by Helen Davies, on behalf of Procter & Gamble International Operations (a fully owned subsidiary of the Procter and Gamble Company) set in Geneva, Switzerland. In the statement it is asserted that the opponent's marks "PANTENE PRO-V" and "PRO-V" are reputed in the European Union as a result of important marketing efforts, including advertising investments. The amount invested in advertising to promote the marks in the countries of Western Europe was of 76,626,000 Euros from June 2006 to June 2007. Furthermore, it is affirmed that the value of sales of the products bearing the marks of the opponent during the same period amounted to 343,789,209 Euros.
15. Four pages containing data of 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.
16. Research 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.
17. 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 trademarks for hair care preparations in the Hungarian market and is in second place among the best-selling brands for hair care preparations in the Hungarian market.
18. A copy of an article published on the website www.alimarket.es, dated 01/12/2000 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%)
19. Copies containing samples of the bottles of shampoos and conditioners on which appear the marks "PANTENE PRO-V" and "PRO V". These bottles are labelled in the following languages: Spanish, Portuguese, French and German.

The opponent claimed the earlier marks "PANTENE PRO-V" and "PRO-V" to have a reputation.

On the basis of the evidence listed above the Office finds that the opponent has proven the reputation of the earlier mark "PANTENE PRO-V", however not the reputation of the earlier mark "PRO-V".

The Office finds that the evidence submitted by the opponent does not demonstrate that the earlier Community trade mark No 273 292 "PRO-V" acquired a reputation through its use. Despite showing use of the mark "PRO-V", the evidence provides little information on the perception of this trade mark on a stand-alone basis by the relevant public. As a result the evidence does not show that this trade mark is known by a significant part of the relevant public. The samples of the market surveys regarding "PRO-V" as such are not numerous enough to be representative from a statistical point of view. Under these circumstances the Office concludes that the opponent failed to prove that its trade mark "PRO-V" in itself has a reputation, without the element "PANTENE".

The Office points out that the use of the earlier mark "PANTENE PRO-V" as a whole cannot as such be a conclusive indication for 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. The Office notes, in this respect, that numerous references in the documents provided as proof of reputation use the word "PANTENE" on a stand-alone basis to refer to the goods marketed under the earlier mark. The same is not true as regards the word element "PRO-V". Removing the word element "PANTENE" would alter the distinctive character of the earlier mark "PANTENE PRO-V", and it can not be concluded that the element "PRO-V" independently would enjoy reputation as this has not been proven and the Office cannot deduce it from the evidence submitted.

As seen above, reputation of the earlier trade mark is a requirement for the opposition to be successful under Article 8(5) CTMR. Since it has not been established that the earlier trade mark "PRO-V" has a reputation, one of the necessary conditions contained in Article 8(5) CTMR is not fulfilled, and the opposition must be rejected as far as based on the earlier trade mark "PRO-V".

As to the other earlier Community trade mark No 58 719 "PANTENE PRO-V", on the basis of the above the Office concludes that the said earlier trade mark has a reputation in the European Union in connection with *preparations for the care, treatment and beautification of the hair of adults*.

It is clear from the evidence that the earlier trade mark "PANTENE PRO-V" has been subject to a long standing and intensive use and that it is generally known in the relevant market, where it enjoys a consolidated position among the leading brands, as has been attested by independent and diverse sources. The sales figures, marketing expenditure and market share shown by the evidence as well as the various references in the press to its success, are all circumstances that unequivocally show that the mark "PANTENE PRO-V" enjoys a high degree of recognition among the relevant public.

c) Encroachment upon reputation

As seen above, the reputation of the earlier mark "PRO-V" has not been proven. Therefore, the trade mark examined under this section is the other earlier mark "PANTENE PRO-V".

Use of the mark applied for will fall under Article 8(5) CTMR when one or more of the following situations occur:

- it takes unfair advantage of the distinctive character or the repute of the earlier mark
- it is detrimental to the repute of the earlier mark, and
- it is detrimental to the distinctive character of the earlier mark

Although in opposition proceedings detriment or unfair advantage may be only potential, a mere possibility is not sufficient for Article 8(5) CTMR to be applicable. While the proprietor of the earlier mark is not required to demonstrate actual and present harm to its mark, it must however "adduce prima facie evidence of a future risk, which is not hypothetical, of unfair advantage or detriment" (See Judgment of 25 May 2005, Case T-67/04, *Spa Monopole, compagnie fermière de Spa SA/NV, / OHIM (SPA-FINDERS/SPA)*, ECR II-1825, paragraph 40).

It follows that the opponent must establish that detriment or unfair advantage is probable, in the sense that it is foreseeable in the ordinary course of events. For that purpose the opponent should file evidence or at least put forward a coherent line of argument, showing what the detriment or unfair advantage would consist of and how it would occur, which could lead to the *prima facie* conclusion that such an event is indeed likely in the ordinary course of events.

In the present case the opponent specifically claims that its earlier marks are reputed worldwide, including the European Community. It argues that the consumers will associate any product bearing the term "PRO V / PRO-V" with the product line of the opponent. The opponent further argues that the application and the earlier mark "PRO-V" are virtually identical. The use of the contested mark, in the opponent's opinion, would result in the misappropriation of the distinctive character and repute of the earlier mark and would be detrimental to the opponent and its brand. The opponent's brand would suffer a "dilution by tarnishment", particularly if the goods sold under the application were of low quality. The distinctive character of the earlier trade marks would be adversely affected by a "dilution of blurring". The applicant would likewise wrongly benefit from the reputation of the earlier mark, most notably in relation to the goods that are similar. The opponent refers to the previous application for registration of the same applicant under the same sign, covering less goods. The present application broadened the scope of goods and encroaches on the earlier mark not only lexically, but also in terms of the goods covered.

In other words the opponent claims that the use of the contested trade mark would take unfair advantage and be detrimental to the repute of the earlier trade marks, including "PANTENE PRO-V", that is under examination in this section.

Before examining the opponent's claims, the Office finds it useful to note that the opposition is directed against 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.

As seen above, the earlier trade mark "PANTENE PRO-V" was found to have a reputation in connection with the following goods:

Class 3: Preparations for the care, treatment and beautification of the hair of adults.

Detriment to the distinctive character of the earlier mark (also referred to as 'dilution', 'whittling away' or 'blurring') is caused when that mark's ability to identify the goods or services for which it is registered and used as coming from the proprietor of that mark is weakened, since use of the later mark leads to dispersion of the identity of the earlier mark – See Judgment of 27 November 2008, Case C-252/07, *Intel*, ECR I-8823, paragraph 29.

In support of its claims, the opponent has filed hundreds of pages of evidence, including articles about awards won by its products, product samples, tables presenting sales figures and advertising expenditures, surveys about its marks and a market research.

However, apart from claiming reputation and arguing that consumers will establish a link between the trade marks, the opponent did not provide any facts, arguments or evidence which could support the conclusion that the use of the contested trade mark "Pro V" would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark "PANTENE PRO-V".

In this respect the Office notes that Article 8(5) CTMR is not intended to prevent the registration of all marks identical with or similar to a mark with reputation. According to the established case law, "once the condition as to the existence of reputation is fulfilled, the examination has to proceed with the condition that the earlier mark must be detrimentally affected without due cause" – see Judgment of 14 September 1999, Case C-375/97, *General Motors*, (CHEVY), ECR I-5421, paragraph 30.

It follows that the relevant public must make a connection, or recognise a link between the earlier reputed mark "PANTENE PRO-V" and the application "Pro V", which results from the similarity of the marks.

In the present case, the trade mark "PANTENE PRO-V" is reputed for hair care preparations, while the application "Pro V" covers, among others, hair dryers in class 11 and brushes and brush heads in class 21, including hair brushes. Despite some points of contact between the said goods, it cannot be established from the evidence that the public will recognise a link between the marks in conflict. This is because no reputation has been proven for "PRO-V" on a stand-alone basis and the reputed mark as a whole, "PANTENE PRO-V", shows only some degree of similarity to the contested mark "Pro V".

It should also be noted that whilst consumers may or are likely to establish a link between the two trade marks, in the sense, for example, that the application "Pro V" would bring the earlier trade mark "PANTENE PRO-V" to the minds of consumers, it does not follow automatically that the former will take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark - see to this respect Judgment of 27 November 2008, Case C-252/07, *Intel*, ECR I-8823, paragraph 71.

As mentioned above, the opponent should have filed evidence or at least put forward a coherent line of argument, showing what the detriment or unfair advantage would consist of and how it would occur between the marks "PANTENE PRO-V" and "Pro V", which could lead to the prima facie conclusion that such an event is indeed likely in the ordinary course of events.

In this case, there is no evidence as regards how the consumers may make a link between the earlier reputed mark "PANTENE PRO-V" on e.g. shampoos and the trade mark applied for "Pro V" on brushes, brush heads and hair-dryers. It could also have been shown that the purchase of the contested goods may be more attractive because "PANTENE PRO-V" has established a reputation for particularly high quality hair care preparations, which may stimulate the sales of the applicant's products to an extent which is disproportionately high in comparison with the promotional investments of the applicant ("free-riding" or "riding on the coat-tails of a famous mark").

This is confirmed by Rule 19(2)(c) CTMIR, according to which, if the opposition is based on a mark with reputation within the meaning of Article 8(5) CTMR, the opponent must provide evidence showing that the mark has a reputation, as well as evidence or arguments showing that 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.

Furthermore, the opponent does not define 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.

According to Article 76(1) CTMR, in proceedings before it the Office shall examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.

Given that the opponent was unable to provide any good reason from which it could be concluded that the use of the contested sign "Pro V" would take unfair advantage

of, or be detrimental to, the distinctive character or the repute of the earlier trade mark "PANTENE PRO-V", one of the necessary requirements set out above is not met.

Consequently, the opposition is to be rejected as not well founded under Article 8(5) CTMR.

III. COSTS

According to Article 85(1) CTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party.

Since the opponent is the losing party, it must bear the costs incurred by the applicant in the course of these proceedings.

According to Rule 94(3) and (7)(d)(ii) of Community Trade Mark Implementing Regulation (CTMIR), the costs to be paid to the applicant are the costs of representation which are to be fixed on the basis of the maximum rate set therein.

THE OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET

(TRADE MARKS AND DESIGNS)

DECIDES TO:

1. Reject opposition number B 1 494 502 in its entirety.
2. Order the opponent to bear the costs, which are fixed as follows:

Costs of representation	EUR 300

Total amount	EUR 300



The Opposition Division

Judit NÉMETH

Silvie GÖTZOVÁ

Sabine STAMM

Under Article 59 CTMR any party adversely affected by this decision has a right to appeal against this decision. Under Article 60 CTMR notice of appeal must be filed in writing at the Office within two months from the date of notification of this decision and within four months from the same date a written statement of the grounds of appeal must be filed. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 800 has been paid.

The amount determined in the fixation of the costs may only be reviewed by a decision of the Opposition Division on request. Under Rule 94(4) CTMIR such a request must be filed within one month from the date of notification of this fixation of costs and shall be deemed to be filed only when the review fee of EUR 100 (Article 2(30) of the Community Trade Mark Fees Regulation (CTMFR)) has been paid.