

O-212-08

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION
No. 884290 AND A REQUEST BY SHOFU, INC
TO PROTECT IN CLASSES 5 & 10 THE TRADE MARK
HY-BOND RESIGLASS**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 71418 BY HERAEUS KULZER GMBH**

BACKGROUND

1) On 16 February 2006, Shofu, Inc. (hereinafter the applicant) on the basis of a German registration and claiming a Priority date of 29 August 2005 requested protection in the United Kingdom under the terms of the Madrid Protocol for the trade mark **HY-BOND RESIGLASS** in respect of the following goods:

Class 5: Chemical products for medical and technical dental purposes, included in this class; material for stopping teeth and dental wax; material for producing artificial teeth and dentures; dental cements; adhesives for composites, adhesive agents, dental restoration material; dental materials, included in this class; porcelain and ceramics as well as plastic and ceramic facing materials for teeth and dentures.

Class 10: Dental instruments and apparatus; artificial teeth and dentures; dental crowns and bridges.

2) The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration were published in accordance with Article 10 in Trade Marks Journal No.6644 on 4 August 2006.

3) On 2 November 2006, Heraeus Kulzer GmbH filed notice of opposition to the conferral of protection on this international registration. The grounds of opposition are in summary.

a) The opponent is the proprietor of the following registration:

Trade Mark	No.	Designation Date/IC Priority Date	Conferral of Protection Date	Goods
iBond	M795010	27.11.2002 18.6.2002	19.09.2004	5 - Chemical products for dental purposes and for dental engineering purposes; dental adhesives and adhesion promoters.

b) Objection is said to arise under sections 5(2)(b), 5(3) and 5(4)(a) of the Act against all the goods of the international registration.

4) On 21 February 2007, the applicant filed a counterstatement in which they deny the grounds on which the opposition is based, I note that paragraph 2 states:

“2. The applicant acknowledges that the goods covered by its mark as applied for are similar, and in some cases identical to goods covered by the opponent’s mark”

5) Only the opponent filed evidence in these proceeding. Both sides ask for an award of costs. The matter came to be heard on 4 June 2008 when the opponent was represented by Mr Stacey of Messrs Baron & Warren.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 8 August 2007, by James Maxwell Stacey. Mr Stacey is the opponent's Trade Mark Attorney. He confirms that the information in his statement comes from either materials provided by the intellectual property department of Heraeus Holding GmbH (the opponent's parent company) or from his own research.

7) Mr Stacey explains that the opponent is one of the leading suppliers of dental products to the dental profession, a market leading position which extends to the United Kingdom. He states that the trade mark iBond is used in relation to dental adhesives used by the dental profession, the product being launched in the United Kingdom on 1 January 2003; exhibit JMS1 consists of a product launch notice dated 4 December 2002 issued to Surgery Dealers in which the iBond trade mark appears and which I note contains, *inter alia*, the following text:

“We are delighted to announce that on 1st January 2003, Heraeus Kulzer will launch iBond in the UK.

iBond is the first true one-component self-etching bonding system. Etching, priming, bonding and desensitizing steps are done all in one.”

8) Exhibit JMS2 consists of a product flier and price list in which the iBond trade mark appears, which Mr Stacey explains was issued for the 2nd quarter of 2005 (and which contains a date to that effect).

9) Exhibits JMS3 and JMS4 consist of literature published by the opponent and issued to the dental profession. Whilst dated September and November 2006 which is after the material date in the proceedings (a point Mr Stacey accepts), these materials demonstrate the nature of the iBond product. Mr Stacey notes from exhibit JMS3, that in November 2003 the iBond product “received a 4.5 (out of 5) @ 92% rating” in Vol. 20, No 9 from The Dental Advisor which, he says, is a prestigious publication based in the United States. He go on to say that well received product testing reports are used within the United Kingdom as a marketing tool to emphasise the quality of the product. Exhibit JMS5 consists of an extract from The Dental Advisor's website, Mr Stacey noting that: (i) back issues can be purchased, (ii) that subscriptions and orders for back issues can be placed by customers in the United Kingdom, and (iii) that the publication maintains its independence by not accepting advertisements.

10) Exhibits JMS6 and JMS7 consist of pages taken from the September 2005 edition of The Official Journal of the Dental Laboratories Association (hereafter DLA) and an extract from their website respectively. I note that the DLA describe themselves as:

“The Dental Laboratories Association Ltd (DLA) is a professional body for dental laboratory owners in the UK. Currently the Association has around 1000 members, over 50 of whom are affiliates. It is estimated that members of

the DLA are responsible for over 80% of the dental laboratory services in the UK.”

11) Mr Stacey notes that page 18 of the publication at JMS6 includes a reference to the opponent’s subsidiary in the United Kingdom, and that page 67 includes a reference to a 3M ESPE dental product (Sinfony composite) based on a 2003 product evaluation also by The Dental Advisor publication. Given the reputation of such evaluations, such references amount, he says, to powerful marketing tools.

12) Exhibits JMS8 and JMS9 consist of further examples of positive product evaluations by The Dental Advisor publication. Exhibit JMS8 consists of a product flier issued on or before 1 November 2005 by The Dental Directory who describe themselves as:

“...the UK’s largest full service dental dealer.”

13) I note the exhibit contains a reference to a product called Gradia Direct which is accompanied by an evaluation by The Dental Advisor publication from February 2004. Exhibit JMS9 consists of a newsletter from Dentsply who are also a supplier to the dental industry and which dates from the 2nd quarter of 2007. This contains a reference to a product called Xeno III which is again accompanied by an evaluation from The Dental Advisor publication from October 2006.

14) Mr Stacey comments that iBond branded products have been the subject of an evaluation by The Prep Panel who he explains are a group of some thirty general dental practitioners from around the United Kingdom led by Professor Trevor Burke who is now Professor of Primary Dental Care at the University of Birmingham’s School of Dentistry. He states that the group is paid by dental product manufacturers to test and evaluate dental products, adding that the group publishes its findings (good or bad) subject to the manufacturer having the opportunity to respond to the reports prior to publishing. Exhibit JMS10 consists of extracts taken from www.preppanel.com which includes the report for the evaluation of the iBond products undertaken in June 2004. The summary of the Prep Panels finding were as follows:

“**Summary:** The positive reception of this new material is indicated by the high scores achieved throughout the evaluation as well as a higher overall score for ease of use when compared to the pre-evaluation dentine bonding systems. Six evaluators stated that they would purchase iBond and indicates the favourable reception of iBond in this competitive area.”

15) Exhibit JMS11 consists of extracts from the newsletter of Clinical Research Associates (hereafter CRA) from December 2004. CRA are, explains Mr Stacey, a dental research organisation based in the United States who evaluate dental products and distribute their findings worldwide. Mr Stacey notes that the ibond product is categorised as being:

“...from the top 10 concepts CRA evaluators stated they “cannot live without” during 04.”

16) He also notes that back copies of the newsletter and subscriptions can be purchased/taken out by United Kingdom residents. Exhibit JMS12 includes a partial library list for the British Dental Association, who are the professional association and trade union for dentists in the United Kingdom. He notes that the partial library list includes a reference to the CRA newsletter and that a further extract refers to a dental practitioner in the United Kingdom who served as a clinical evaluator for CRA; he concludes that one can infer from this information that the CRA and its newsletter will be known to practitioners in the United Kingdom.

17) Exhibit JMS13 consists of extracts taken from the opponent's surgery price list for 2004 in which the iBond trade mark features. He provides turnover in the years 2003-2006 as follows, no explanation is given regarding the term "TE":

Year	Amount
2003	14TE
2004	5TE
2005	8TE
2006	5TE

18) Mr Stacey explains that the iBond product is available from dental suppliers over the telephone, by facsimile or via the internet. Exhibit JMS14 consists of extracts taken from the brochures of Kent Express and Claudius Ash said to date from October and December 2005 in which the iBond trade mark appears.

19) Exhibit JMS15 consists of an extract from the monthly publication The Dentist from December 2006 which is distributed to dentists in the National Health Service and in private practice. Mr Stacey notes the following comments:

“Philip Wray and his colleagues at Wellum House Dental Health Centre in Andover have been using Heraeus Kulzer iBond in their practice since its introduction in 2003.”

20) And:

“ iBond is already the UK's second most popular self-etch dental adhesive and its sustained growth rate suggests that it is poised to become the number one choice, and possibly the second fastest selling of all dental adhesives. This is a remarkable achievement in a short period of time. Usage of iBond has accounted for almost all of the recent growth in self-etch systems...”

21) Ordinarily, I would not include submissions in my summary of evidence. However, as Mr Stacey accepts the position taken by the applicant in their counter-statement in relation to the word BOND, on this occasion its inclusion is, I think, merited. Mr Stacey says:

“It will be noted from the various materials on file that BOND is a common term for such adhesives..”

22) That concludes my summary of the evidence filed insofar as I consider it necessary.

DECISION

23) I turn first to the objection based on section 5(2)(b) of the Act, which reads as follows:

“5.-(2) A trade mark shall not be registered if because -

(a)

(b) it is similar to an earlier mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

24) An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

25) In these proceedings the opponent is relying on one trade mark i.e. registration No.M795010 which has a date of designation in the United Kingdom of 27 November 2002 and which claimed Priority from 18 June 2002 from a German registration; it clearly qualifies as an earlier trade mark under the above provisions. I also note that Conferral of Protection was achieved on 19 September 2004. Given that the application in suit was published for opposition purposes on 4 August 2006, the opponent’s registration is not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

26) In reaching a decision I take into account the well established guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, , *Matratzen Concord GmbH v. OHIM* [2004] ECr I-3657, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* [2005] ECr I-8551 and *OHIM v. Shaker di L. Laudato & C. Sas* [2007] ECR I-4259.

27) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive

character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

28) I am willing to accept the contention, in this case, that articles in magazines originally published in the USA find their way into the highly specialised magazines which relate specifically to the dental practitioner market. At the hearing Mr Stacey stated that the term “TE” shown in relation to turnover referred to “thousand Euros”. If I accept this explanation it means that the opponent enjoyed an average per annum turnover in the three years prior to the application of 9,000 Euros, approximately £6,000 PA. I was also referred to the quote shown in my evidence summary above at paragraph 19 which states that the opponent’s product was, by the end of 2006, the second most popular dental etch product in the UK and would probably become the number one choice. Given that the sales figures were falling from an initial 14,000 Euros in 2003 to 5,000 Euros in 2006 this suggests that the market is receding for such products if declining sales still result in the product growing in popularity. I am willing to accept that the opponent’s mark had, at the relevant date, a degree of reputation. However, I do not accept the contention that the opponent has shown that this reputation was such that it deserves enhanced protection.

29) I have to consider whether the opponent’s mark has a particularly distinctive character arising from the inherent characteristics of the mark. In my opinion, the opponent’s mark “iBond” is, just, inherently distinctive for dental adhesives etc, although it clearly alludes to the nature of the product and verges on the descriptive. It has a very low level of distinctiveness which will be a factor in my decision.

30) I have to determine who is the average consumer of the goods in question. It was accepted by both parties that the average consumers are dental technicians and other professionals working in the field as dentists, dental technicians and dental nurses. However, I should not assume that because of this they will all be sophisticated consumers, I must take into account the doctrine of imperfect recollection.

31) I shall first consider the respective trade marks of both parties which are as follows:

Applicant's Mark	Opponent's Mark
HY-BOND RESIGLASS	i-Bond

32) Visually there are several differences between the marks. The applicant's mark starts with the letters "HY" whereas the opponent's mark begins with the letter "i". Both then have a hyphen and the word "Bond". The applicant's mark then has the word "Resiglass". The applicant's mark is significantly longer than the opponent's mark.

33) Aurally the marks differ with regard to the first syllable, have identical second syllables, with the applicant's mark then having an additional three syllables. I do not believe that the applicant's mark will be so abbreviated in its first syllable that the term "HY" will be pronounced "I". Conceptually the marks have only slight differences. They both allude to the nature of the product and do precisely "what it says on the tin". When used on dental adhesives the statement that "I bond" borders on the descriptive, in much the same manner as "Hy or high bond". The last part of the applicant's mark would be seen as an indication of what it is made from. The opponent contended that the word "Bond" in each mark was descriptive and so the marks would be reduced to "hy" and "i". This it was claimed would increase the potential for confusion. I do not accept the premise that the average consumer would reduce the marks to such an extent.

34) I was referred to the potential for confusion if the goods were ordered via the telephone. I accept that such goods could be ordered using the telephone, although they could also be ordered via the Internet, by written post or e-mail or face to face with a representative of the company. To my mind, and the evidence bears this out, when placing an order the clients will usually be expected to provide a reference number rather than simply using the name of the product. Telephone ordering is also only one method used in purchasing the product so even if the name was used instead of a reference number it would only be in regard to a small percentage of overall sales.

35) Clearly there is a degree of similarity in the marks as the word "bond" appears in both. However, as this is very descriptive of an adhesive I do not place much weight upon this. To my mind the differences in the marks far outweigh any similarities.

36) Turning to the specifications of both parties these are as follows:

Applicant's specification	Opponent's specification
<p>Class 5: Chemical products for medical and technical dental purposes, included in this class; material for stopping teeth and dental wax; material for producing artificial teeth and dentures; dental cements; adhesives for composites, adhesive agents, dental restoration material; dental materials, included in this class; porcelain and ceramics as well as plastic and ceramic facing materials for teeth and dentures.</p>	<p>5 - Chemical products for dental purposes and for dental engineering purposes; dental adhesives and adhesion promoters.</p>
<p>Class 10: Dental instruments and apparatus; artificial teeth and dentures; dental crowns and bridges.</p>	

37) There is clear overlap in the class 5 goods such that they must be regarded as identical. The applicant's class 10 goods are complementary to the opponent's class 5 goods and so there is a degree of similarity albeit quite low.

38) The opponent's strongest case is in relation to the class 5 goods as these are identical. Taking account of all of the above when considering the marks globally, I believe that there is not a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2)(b) therefore fails.

39) I next turn to the ground of opposition under Section 5(4)(a) which reads:

“5. (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

40) The opponent claims that it has reputation and goodwill under its registered mark. Earlier in this decision I accepted this point.

41) In deciding whether the mark in question “HY-BOND RESIGLASS” offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.'

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

'To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

42) The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. The relevant date may therefore be either the date of the application for the mark in suit (although not later), or the date at which the acts first complained of commenced – as per the comments in *Cadbury Schweppes Pty Limited v. The Pub Squash Co Pty Ltd* [1981] RPC 429. The applicant did not file any evidence of use. Therefore, the relevant date is 16 February 2006.

43) In *South Cone Inc. v. Jack Bessant, Dominic Greensmith, Kenwyn House, Gary Stringer (a partnership)* [2002] RPC 19 Pumrey J. in considering an appeal from a decision of the Registrar to reject an opposition under Section 5(4)(a) said:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd’s Application (OVAX)* [1946] 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus, the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date....”

44) This cannot be interpreted in a prescriptive fashion. There will be occasions when the evidence does not fall within the above parameters but still establishes goodwill for passing off purposes - see the decision of Professor Annand, sitting as the Appointed Person, in *Loaded* (BL 0/191/02).

45) Earlier in this decision I found that use of the applicant's mark, actual or on a fair and notional basis would not result in confusion with the opponent's mark. Accordingly, it seems to me that the necessary misrepresentation required by the tort of passing off will not occur. The opposition under Section 5(4)(a) of the Act must fail.

46) Lastly, I turn to consider the ground of opposition under Section 5(3) which, in its original form, reads:

"5-(3) A trade mark which -

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

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

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

47) By virtue of regulation 7 of the Trade Mark (Proof of Use, etc) Regulations 2004, Section 5(3)(b) has now been repealed. The equivalent provision in Section 10 of the Act dealing with infringement has also been amended. As the explanatory note indicates:

"These amendments implement the decision of the European Court of Justice in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* of 9th January 2003 (C-292/00) which was confirmed by its decision in *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* of 23rd October 2003 (C-408/01). Those decisions determined that Article 5(2) of the Directive, which on the face of it, grants a right to the proprietor of a trade mark to prevent third parties from using an identical or similar trade mark in relation to goods or services which are *not similar* where the earlier trade mark has a reputation and use of that sign takes unfair advantage or is detrimental to the distinctive character of that earlier trade mark, also applies to goods or services which are similar or identical to those for which the earlier trade mark is registered."

48) It is on the basis that the goods are similar that the opponent relies upon under this ground of opposition.

49) The scope of Section 5(3) has been considered in a number of cases notably *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] RPC 767, *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42, *C.A. Sheimer (M) Sdn Bhd's TM Application (Visa)* [2000] RPC 484, *Valucci Designs Ltd v IPC Magazines (Loaded)* O/455/00, *Mastercard International Inc and Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch), *Electrocoin Automatics Limited and Coinworld Limited and others* [2005]

FSR 7, *Davidoff & Cie SA v Gofkid Ltd (Davidoff)* [2003] ETMR 42, *Adidas-Salomon Ag v Fitnessworld Trading Ltd* [2003] ECR I-12537, *Spa Monopole Compagnie Fermiere de Spa SA/NV v OHIM* [2005] ECR I-1825 and *esure Insurance Ltd v Direct Line Insurance plc* [2008] RPC 6.

50) Once the matter of reputation is settled any opponent must then show how the earlier trade mark would be affected by the registration of the later trade mark. Both tests require very high hurdles to be cleared. The onus is upon an opponent to prove that his earlier trade mark enjoys a significant reputation or public recognition and he needs to furnish the evidence to support his claim. The evidence provided has been summarised at paragraph 27 above. It is clearly insufficient to clear the considerable first hurdle required by *Chevy*.

51) For the record, I should state that even if I was able to conclude that the opponent had a sufficient reputation there is no evidence to suggest that unfair advantage is likely to be taken by the applicant or that there will be any detriment caused to the opponent or their trade mark (*Viagra v Viagrene* [2001] FSR 3). Consequently the ground fails.

52) As the opponent was unsuccessful the applicant is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of £2,000. This sum 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 23rd day of July 2008

**George W Salthouse
For the Registrar,
the Comptroller-General**