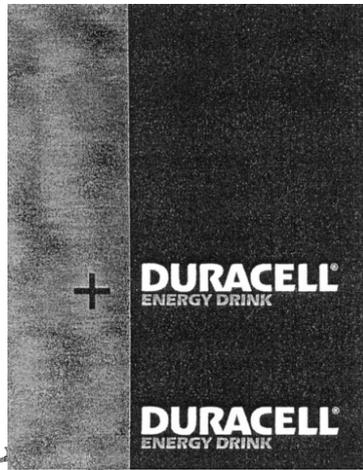


O-310-09

TRADE MARKS ACT 1994

IN THE MATTER OF THE REQUEST FOR PROTECTION IN THE UNITED  
KINGDOM OF INTERNATIONAL REGISTRATION NO 948728:



IN THE NAME OF EL NIÑO AS

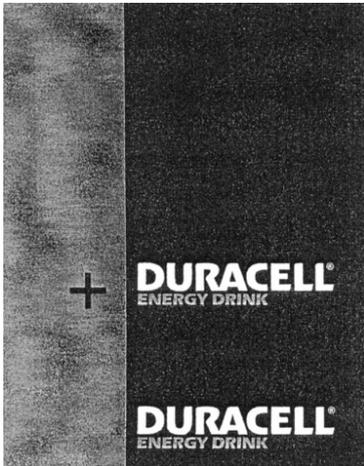
IN CLASSES 5, 32 AND 33

AND

THE OPPOSITION THERETO BY  
DURACELL BATTERIES BVBA  
UNDER NO 71743

**Trade Marks Act 1994**

**in the matter of the request for protection in the United Kingdom of international registration no 948728:**



**in the name of El Niño as  
in classes 5, 32 and 33**

**and**

**the opposition thereto by  
Duracell Batteries BVBA  
under no 71743**

1) El Niño as (EN) has requested the granting of protection of the above international registration in the United Kingdom with effect from 22 August 2007. The international registration is for the following goods:

*beverages for medical purposes in particular containing lecithin, vitamins and other tonic substances, food products and other dietetic products adapted for medical use, nutritional supplements (tonic and excitant) for medical purposes, lithia water for medical purposes, isotonic beverages and seltzer-water for medical purposes, waters containing lithium for medical purposes, energy drinks for medical purposes;*

*isotonic beverages, energy drinks, natural or artificial mineral waters; sparkling beverages and other non-alcoholic beverages, fruit and vegetable drinks and juices, non-alcoholic aperitifs, lemonades, unfermented grape must, cider (non-alcoholic), non-alcoholic cocktails, lithia water, almond milk (beverage), cider (non-alcoholic), musts, (soft drinks), whey drinks, soft drinks, fruit essences without alcohol, non alcoholic fruit nectars, orgeat (soft drinks), fruit juices, hopped beer wort, tomato juice (beverage), seltzer-water (mineral water), sirups*

*for making beverages, syrups for grenadine, malt beverages, malt beer, beers, light beers and double beers, table waters, sorbets (beverages), sorbets (sweetened fruit beverages), sparkling waters containing natural mineral substances and natural mineral ingredients, waters containing lithium, water (beverages), table waters, ginger beer, vegetable juices (beverages), soda-waters;*

*alcoholic essences, alcoholic fruit essences, alcoholic extracts, aniseed liqueur, aperitifs, arrack, arrack (liqueur), brandy, curacao (liqueur from oranges), digesters (liqueurs and eaux-de-vie), digesters (bitter liqueurs), essences for spirits, alcohol extracts, gin, alcoholic beverages made out of morello cherries, pear must (with alcohol), cider (with alcohol), alcoholic cocktails, spirits, liqueurs aniseed, liqueurs, piquette, hydromel, mint liqueurs, distilled beverages (eaux-de-vie), rum, spirits from rice, sake, rice wines, alcoholic fruit extracts, whiskey, alcoholic beverages (except beers).*

The international registration enjoys an international priority date of 26 March 2007, nothing turns upon this as the earlier rights upon which Duracell Batteries BVBA (DB) all predate 26 March 2007<sup>i</sup>. DB has opposed the granting of protection to the international registration under sections 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act). DB's grounds of opposition rest on reputation and goodwill, which the evidence shows rest squarely on use in relation to batteries. The distance between batteries and the goods of the international registration means that it will be difficult to establish misrepresentation and/or damage in relation to the grounds of passing-off under section 5(4)(a) of the Act<sup>ii</sup>. In relation to section 5(3) of the Act there is nothing in the nature of the goods of the international registration that suggests that use of the trade mark would lead to tarnishing of DB's trade mark<sup>iii</sup>. The evidence does not tackle the issue of whether use of the international registration would change the economic behaviour of the average consumer of DB's goods<sup>iv</sup>. Consequently, I will only consider the head of damage of unfair advantage under section 5(3) of the Act and relate this to one trade mark, United Kingdom registration no 1346820. If DB does not succeed under this head of damage it will not succeed under any of the others. Registration no 1346820 is for the trade mark DURACELL and includes, inter alia, batteries in its specification; the application for registration of this trade mark was filed on 8 June 1988 and the registration process was completed on 31 August 1990. In its counterstatement EN admits that DB has a reputation in the United Kingdom in respect of batteries and does not require proof of use in relation to these goods.

2) DB claims that EN must have chosen the DURACELL name and get-up with the intention of trading off the significant goodwill which has been generated in the name and get-up. DB considers that EN will take an unfair advantage by trading off its reputation. EN, in response to DB, claims that it is a prominent drinks manufacturer. It denies all of the grounds of opposition.

3) Only DB filed evidence. DB filed written submissions in lieu of attending a hearing. EN has not filed any evidence, nor has it made any written submissions.

4) Section 5(3) of the Act:

“(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, 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 (EC) 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.”

5) A number of judgments of the European Court of Justice (ECJ) are relevant to my considerations:

*Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* Case C-408/01:

“31. The answer to Question 2(a) must therefore be that the protection conferred by Article 5(2) of the Directive is not conditional on a finding of a degree of similarity between the mark with a reputation and the sign such that there exists a likelihood of confusion between them on the part of the relevant section of the public. It is sufficient for the degree of similarity between the mark with a reputation and the sign to have the effect that the relevant section of the public establishes a link between the sign and the mark.”

*Intel Corporation Inc v CPM United Kingdom Ltd* Case C-252/07:

“50. Accordingly, the nature of the goods or services for which the conflicting marks are registered must be taken into consideration for the purposes of assessing whether there is a link between those marks.

51 It must also be pointed out that certain marks may have acquired such a reputation that it goes beyond the relevant public as regards the goods or services for which those marks were registered.

52 In such a case, it is possible that the relevant section of the public as regards the goods or services for which the later mark is registered will make a connection between the conflicting marks, even though that public is wholly distinct from the relevant section of the public as regards goods or services for which the earlier mark was registered.

53 For the purposes of assessing where there is a link between the conflicting marks, it may therefore be necessary to take into account the strength of the earlier mark's reputation in order to determine whether that reputation extends beyond the public targeted by that mark.

54 Likewise, the stronger the distinctive character of the earlier mark, whether inherent or acquired through the use which has been made of it, the more likely it is that, confronted with a later identical or similar mark, the relevant public will call that earlier mark to mind.

55 Accordingly, for the purposes of assessing whether there is a link between the conflicting marks, the degree of the earlier mark's distinctive character must be taken into consideration.

56 In that regard, in so far as the ability of a trade mark to identify the goods or services for which it is registered and used as coming from the proprietor of that mark and, therefore, its distinctive character are all the stronger if that mark is unique – that is to say, as regards a word mark such as INTEL, if the word of which it consists has not been used by anyone for any goods or services other than by the proprietor of the mark for the goods and services it markets – it must be ascertained whether the earlier mark is unique or essentially unique.

57 Finally, a link between the conflicting marks is necessarily established when there is a likelihood of confusion, that is to say, when the relevant public believes or might believe that the goods or services marketed under the earlier mark and those marketed under the later mark come from the same undertaking or from economically-linked undertakings (see to that effect, inter alia, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 17, and Case C-533/06 *O2 Holdings and O2 (UK)* [2008] ECR I-0000, paragraph 59). .....

.....60 As regards the circumstance referred to in point (d) of that question, the fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark would call the earlier mark to mind is tantamount to the existence of such a link.....

.....80 The fact that:

– the earlier mark has a huge reputation for certain specific types of goods or services, and

- those goods or services and the goods or services for which the later mark is registered are dissimilar or dissimilar to a substantial degree, and
- the earlier mark is unique in respect of any goods or services, and
- 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 that the use of the later mark takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark, within the meaning of Article 4(4)(a) of the Directive.”

*L’Oreal SA and others v Bellure NV and others* Case C-487/07

“41 As regards the concept of ‘taking unfair advantage of the distinctive character or the repute of the trade mark’, also referred to as ‘parasitism’ or ‘free-riding’, that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation.

42 Just one of those three types of injury suffices for Article 5(2) of Directive 89/104 to apply (see, to that effect, *Intel Corporation*, paragraph 28).

43 It follows that an advantage taken by a third party of the distinctive character or the repute of the mark may be unfair, even if the use of the identical or similar sign is not detrimental either to the distinctive character or to the repute of the mark or, more generally, to its proprietor.

44 In order to determine whether the use of a sign takes unfair advantage of the distinctive character or the repute of the mark, it is necessary to undertake a global assessment, taking into account all factors relevant to the circumstances of the case, which include the strength of the mark’s reputation and the degree of distinctive character of the mark, the degree of similarity between the marks at issue and the nature and degree of proximity of the goods or services concerned. As regards the strength of the reputation and the degree of distinctive character of the mark, the Court has already held that, the stronger that mark’s distinctive character and reputation are, the easier it will be to accept that detriment has been caused to it. It is also clear from the 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 them (see, to that effect, *Intel Corporation*, paragraphs 67 to 69).....

.....48 In the general assessment which the referring court will have to undertake in order to determine whether, in those circumstances, it can be held that unfair advantage is being taken of the distinctive character or the repute of the mark, that court will, in particular, have to take account of the fact that the use of packaging and bottles similar to those of the fragrances that are being imitated is intended to take advantage, for promotional purposes, of the distinctive character and the repute of the marks under which those fragrances are marketed.

49 In that regard, where a third party attempts, through the use of a sign similar to a mark with a reputation, to ride on the coat-tails of that mark in order to benefit from its power of attraction, its reputation and its prestige, and to exploit, without paying any financial compensation and without being required to make efforts of his own in that regard, the marketing effort expended by the proprietor of that mark in order to create and maintain the image of that mark, the advantage resulting from such use must be considered to be an advantage that has been unfairly taken of the distinctive character or the repute of that mark.

50 In the light of the above, the answer to the fifth question is that Article 5(2) of Directive 89/104 must be interpreted as meaning that the taking of unfair advantage of the distinctive character or the repute of a mark, within the meaning of that provision, does not require that there be a likelihood of confusion or a likelihood of detriment to the distinctive character or the repute of the mark or, more generally, to its proprietor. The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of the mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image."

6) In considering the issues before me, the nature of the reputation that DB has established may be relevant. In *Hollywood SAS v Souza Cruz SA* [2002] ETMR 64 the Third Board of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) stated:

“67 Therefore the trade mark is not only a sign affixed to a product to indicate its business origin, but is also a vehicle for communicating a message to the public, and itself represents financial value. This message is incorporated into the trade mark through use, essentially for advertising purposes, which enables the trade mark to assume the message itself, whether informatively or symbolically. The message may refer to the product's qualities, or indeed to intangible values such as luxury, lifestyle, exclusivity, adventure, youth, etc. It may result from the qualities of the product or service for which it is used, but also from its proprietor's reputation or other elements, such as the particular presentation of the product or service or on the exclusivity of sales networks.

68 In the light of these aspects, the idea that the appellant's trade mark conveys a message of health, dynamism and youth cannot be ruled out as a matter of principle, provided that evidence of this is adduced. However, in order to be protected within the meaning of Article 8(5) CTMR, this image must have acquired a level of reputation. The Opposition Division considered that the opponent had submitted adequate evidence of the existence of the trade mark's reputation, but that it had not proved the existence of an image association with the trade mark possessing this reputation. Therefore the evidence to be adduced must focus specifically on the existence of this image association with the trade mark which possesses the reputation.”

7) Ms Milena Leone has given evidence for DB. Ms Leone is brand manager for Procter & Gamble Group International Operations, which is part of the Procter & Gamble Group of Companies, as is DB. Her duties include the management of the “disposable part” of the DURACELL business in western European countries. The DURACELL brand was first launched by Duracell Inc in the United States in 1964. It has been available in the United Kingdom since 1965. The DURACELL brand is applied to a broad range of products, including alkaline batteries, rechargeable batteries and chargers. The products are sold through a variety of outlets, including Tesco, Sainsburys, Asda, Morrisons, Currys, B&Q and WH Smith. She estimates that 90% of all United Kingdom retail outlets were selling DURACELL branded products at the date of her witness statement, 27 February 2009. Ms Leone states that in the three fiscal years from July 2005 to June 2008 DB spent more than £170 million in promoting the DURACELL brand by means of television and print advertising and in-store promotions. Taking into account the turnover figures given below and the evidence of Ms Williams (see below) it would appear that this figure does not relate solely to the United Kingdom. Ms Leone exhibits examples of press advertising that appeared during this period. The contents of the advertisements indicates that they are designed for the trade rather than the end customer. In several of the advertisements one of the rabbits or a part of one of the rabbits who appear in the television advertisement (see below) appear. Ms Leone exhibits examples of television advertisements that were broadcast in the United Kingdom during the period 2002 to 2007. The

premise of the advertisements is that DURACELL batteries have a long life. In all three advertisements rabbits powered by batteries can be seen; one group of rabbits is powered by DURACELL batteries the others by zinc carbon batteries. In two of the advertisements the rabbits are climbing a mountain. The rabbits powered by zinc carbon batteries can be seen falling from the mountain as their power fails. In the first of these advertisements the voice-over says:

“The bigger the challenge the more you need DURACELL. Down go the zinc carbon batteries, victims of exhaustion, down they go. Up he goes. When endurance matters we can all count on DURACELL. DURACELL lasts longer, much longer.”

In the third advertisement the rabbits are playing a game of football. The rabbits powered with ordinary batteries cannot last the period of extra time, while the DURACELL powered rabbits are seen as being in the peak of condition still. The voice-over says:

“In extra time at the cup final it's DURACELL versus ordinary batteries. One (a goal is scored). Oh two (another goal is scored). (The defensive wall of the rabbits powered by ordinary batteries collapse) That's three. Extra power for extra time. DURACELL batteries last longer much longer.”

The annual turnover for goods sold under the DURACELL brand in the financial years 2007/08 was £85 million. DURACELL enjoys a 50% value share of the market in the United Kingdom for general purpose batteries. Ms Leone exhibits a sample of the packaging used in the United Kingdom during the period from 2002 to 2007. The rabbit who appears in the television advertisement appears on the packaging.

8) Ms Gemma Maria Williams has also given evidence for DB. Ms Williams is a trade mark assistant employed by D Young & Co, who are acting for DB in this case. Parts of the evidence rehearse and reinforce what Ms Leone has stated in her evidence. The contents of exhibits GMW4, GMW5 and GMW6 are confidential to the registrar, EN and EN's legal representatives and are not to be disclosed to third parties. A redacted version of this decision will be published on the Intellectual Property Office's website. **THIS PART OF THE DECISION REDACTED** The evidence of GMW4, 5 and 6 has the major flaw that it relates to allocation of funds ie an intention to place advertising. It does not indicate what advertising actually took place.

9) Screen shots of advertisements for DURACELL batteries are exhibited at GMW7. These include screen shots from the advertisements considered in paragraph 7. The advertisements contrast DURACELL powered rabbits with rabbits powered by ordinary batteries. The screen shots include the wording:

“DURACELL PLUS lasts longer, much longer than zinc carbon batteries”

or

“DURACELL PLUS lasts longer, much longer than ordinary zinc carbon batteries”.

Exhibited at GMW8 are examples of television and radio advertising. The television advertisements show the mountain climbing rabbits of paragraph 7. The radio advertisements have the following script:

(Sound of drumming in background.)

“Feeling a bit peaky? Need a push to get you going? Not the DURACELL bunny, here he comes fit as a fiddle, full of beans and ready to show the word exactly what he’s made of. DURACELL just keeps banging away Compared to ordinary zinc carbon batteries DURACELL lasts longer, much longer.”

(Sound of alarm clock and then sound of drumming in background.)

“He’s up and he’s drumming up a storm. It’s another action packed day in the life of the DURACELL bunny. I bet you wish you had a bit of that famous long lasting DURACELL oomph. Come on! Shake a leg! DURACELL will keep banging away until the cows come home. Compared to ordinary zinc carbon batteries DURACELL lasts longer, much longer.

(Sound of drumming in background.)

“Looking forward to getting home? Feeling a bit droopy? Need a pick-me up to keep you going? (Sound of kiss) Well, not a power packed DURACELL bunny. Oh no! He’s still got plenty of life left in him. DURACELL just keeps banging away. Know what I mean? Compared to ordinary zinc carbon batteries DURACELL lasts longer, much longer.

(Sound of drumming in background.)

“Enjoying your lunch? That’s nice. Alright for some. If you were the DURACELL bunny you wouldn’t need to stop for lunch. You’d have everything to keep you going and going and going, right there in your backpack. DURACELL just keeps banging away. Compared to ordinary zinc carbon batteries DURACELL lasts longer, much longer.”

10) Exhibited at GMW9 are pages downloaded from uktvadverts.com on 24 February 2009. These show a search using the term DURACELL found five advertisements for DURACELL batteries, broadcast in November 2008, November 2007, 2000, July 1997 and 1999. Ms Williams states that the

advertisements listed do not represent all of the advertisements broadcast but are indicative of those that were broadcast.

11) Exhibited at GMW10 are the results of a survey conducted for Procter & Gamble by Nunwood Consulting. The Court of Appeal in *esure Insurance Limited v Direct Line Insurance Plc* [2008] EWCA Civ 842 considered the myriad problems that arise from surveys. In this case DB has not supplied the necessary information to show that it has complied with the basic criteria set out in the head note to *Imperial Group plc & Another v. Philip Morris Limited & Another* [1984] RPC 293:

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

Consequently, I can give no weight to the details of the survey that have been furnished.

12) Exhibited at GMW11 are pages downloaded from channel4.com on 24 February 2009. These relate to a poll of Channel 4 viewers, *Sunday Times* readers and purchasers of Heinz beans to choose the hundred greatest television advertisements. The DURACELL rabbit advertisement – “Goes on and on and on.” – appears at number 32.

13) Exhibited at GMW12 is a copy of an article published on 28 August 2003 in *Marketing* about the biggest brands in the United Kingdom. DURACELL alkaline appears at number 48, between Birds Eye fish fingers and Kenco.

14) Exhibited at GMW13 is a copy of an article dated 29 October 2004 from *The Express*. The article relates to strong sales of DURACELL batteries.

15) Exhibited at GMW14 is a copy of an article dated 29 January 2005 from *The Daily Telegraph*. The article relates to the purchase by Procter & Gamble of Gillette, the then owner of DURACELL batteries. The article refers to the creation of the world’s largest household goods empire, the goods of which range from DURACELL batteries to Pampers nappies and Pringles snacks.

16) Exhibited at GMW15 is a copy of an article dated 30 January 2005 from *The Business*. This article also relates to the purchase by Procter & Gamble of Gillette, in the article reference is made to the DURACELL brand.

17) Exhibited at GMW16 is a copy of an article dated 26 September 2006 from the *Daily Mail*. This relates to rumours about Procter & Gamble taking over SSL International. Procter & Gamble is described as “[t]he Crest toothpaste and Duracell batteries group”.

18) Exhibited at GMW17 is a copy of an article dated 17 March 2007 from the *Liverpool Daily Echo*. The article begins:

“STUART BARLOW could be the footballer with the Duracell battery. He just keeps going on and on....”

19) Exhibited at GMW18 is a copy of an article dated 1 September 2007 from *The Grocer*. The article includes a quotation from the brand manager of DURACELL about sales growth.

20) The dominant and distinctive component of the international registration is the word DURACELL. This dominant and distinctive component is identical to DB’s trade mark. The respective trade marks are similar to a high degree.

21) In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings<sup>v</sup>. DURACELL is an invented word. I do not consider that the average consumer of batteries, which is the public at large, will see anything allusive or descriptive in the trade mark. The distinctive character of DURACELL is high.

22) EN has accepted the reputation of the DURACELL trade mark in relation to batteries. It is necessary, however, to decide the extent and nature of that reputation. There are flaws in the evidence of DB, for instance adducing schematics of proposed promotional expenditure rather than evidence showing actual promotional expenditure. There is also a discrepancy between the figure for promotion given by Ms Leone and the figures shown in the schematics. However, there is no denial that DURACELL enjoys a 50% value share of the general purpose battery market in the United Kingdom and that its products are stocked in the major retailers. Batteries are bought by virtually everyone and so the vast majority of the public will have seen DURACELL batteries. In my experience supermarket displays for batteries include a variety of brands, so even if one is purchasing another brand one is likely to have seen the DURACELL brand. DURACELL has an enormous reputation and will be known

to an enormous swathe of the public at large. The promotion of DURACELL has revolved around claims to the longevity and endurance of the product, as can be seen from the scripts for the advertisements. DB has promoted DURACELL to equal endurance and longevity, this is the reputation that it has created. Evidence of this can be seen in the article from the *Liverpool Daily Echo* where DURACELL, in relation to a footballer, is used as a metaphor for longevity and endurance. The writer has a presumption that the reader will understand the metaphor.

23) The distinctiveness and reputation of DURACELL is such that it will be called to mind by the average consumer of the goods of the international registration; indeed, it would be called to mind by any average consumer. Consequently, there is a link as per *Intel Corporation Inc v CPM United Kingdom Ltd*. The link is reinforced by the presence of the words ENERGY DRINK which bring to mind the endurance and longevity of DB's reputation and the energy which the DURACELL rabbits display.

24) The reputation of DURACELL is such that it will go beyond the relevant public for batteries, it is a universal reputation.

25) The get-up of EN's trade mark is similar to that of DB's batteries. EN gives no reason for having chosen the trade mark the subject of the international registration. I cannot conceive that it did not know of DB's trade mark and its reputation. The presence of "ENERGY DRINK" in the specification makes a clear link with the nature of the reputation of DB's batteries, despite the distance between the goods of the international registration and batteries. EN is not just copying DB's trade mark, it is also attempting to appropriate the reputation that is built on longevity and endurance. EN's trade mark will benefit from the years of promotion that DB has undertaken. The average consumer will connect the endurance and longevity of DB's goods with goods that will increase endurance and/or have longevity. It might be argued that this use by EN in the context of the goods of the international registration is a form of parody but that parody is based on DB's reputation, assumes the average consumer's knowledge of that reputation and, therefore, is still taking advantage of that reputation. (This case is not on a par with *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International and Another CCT42/04* [2005] ZACC 7; 2006 (1) SA 144 (CC); 2005 (8) BCLR 743 (CC) (27 May 2005); there is no issue of political parody and that case relates to infringement rather than an application for the grant of protection.)

26) EN wishes to ride on the coat tails of DB's trade mark "in order to benefit from its power of attraction, its reputation and its prestige, and to exploit, without paying any financial compensation and without being required to make efforts of his own in that regard, the marketing effort expended by the proprietor". In *L'Oreal SA and others v Bellure NV and others* the ECJ went on to say that "the advantage resulting from such use must be considered to be an advantage that

has been unfairly taken of the distinctive character or the repute of that mark". EN has put forward no argument as how or why it has due cause to use the international registration.

**27) I find that use of the trade mark the subject of the international registration would take unfair advantage of the repute of DB's trade mark and is without due cause. The request for protection in the United Kingdom is refused.**

REDACTED VERSION

## Costs

28) DB having been successful is entitled to a contribution towards its costs. I award costs on the following basis:

Opposition fee:	£200
Preparing a statement and considering the statement of EN:	£400
Preparing evidence:	£500
Written submissions:	£200
Total:	£1,300

I order El Niño as to pay Duracell Batteries BVBA the sum of £1,300. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

**Dated this 6<sup>th</sup> day of October 2009**

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

<sup>i</sup> See sections 35 and 6 of the Trade Marks Act 1994.

<sup>ii</sup> In *Harrods v Harrodian School* [1996] RPC 697 Millett LJ stated:

“The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration.”

In *Stringfellow v McCain Foods (GB) Ltd* [1984] RPC 501 Slade LJ stated:

“even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than a minimal loss is in my opinion a heavy one.”

In *Lego Systems A/S v Lego M Lemelstricht Ltd* [1983] FSR 155 survey evidence was supplied to show that the gap between the respective goods had been bridged.

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<sup>iii</sup> In *L'Oreal SA and others v Bellure NV and others* Case C-487/07 the European Court of Justice commented on tarnishing in the following manner:

“40 As regards detriment to the repute of the mark, also referred to as ‘tarnishment’ or ‘degradation’, such detriment is caused when the goods or services for which the identical or similar sign is used by the third party may be perceived by the public in such a way that the trade mark’s power of attraction is reduced. The likelihood of such detriment may arise in particular from the fact that the goods or services offered by the third party possess a characteristic or a quality which is liable to have a negative impact on the image of the mark.”

This confirms the opinion of Advocate General Jacobs in *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* C-408/01:

“38. In contrast, the concept of detriment to the repute of a trade mark, often referred to as degradation or tarnishment of the mark, describes the situation where - as it was put in the well-known *Claeryn / Klarein* decision of the Benelux Court of Justice - the goods for which the infringing sign is used appeal to the public's senses in such a way that the trade mark's power of attraction is affected. That case concerned the identically pronounced marks *Claeryn'* for a Dutch gin and *Klarein'* for a liquid detergent. Since it was found that the similarity between the two marks might cause consumers to think of detergent when drinking *Claeryn'* gin, the *Klarein'* mark was held to infringe the *Claeryn'* mark.”

<sup>iv</sup> In *Intel Corporation Inc v CPM United Kingdom Ltd* Case C-252/07 the ECJ stated:

“77 It follows that proof that the 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.”

Even though this case is effectively a *quia timet* action DB needs some form of evidence of me to conclude that there would be a change in the economic behaviour of the purchasers of its goods. There is nothing in the evidence that would allow me to reach such a conclusion.

<sup>v</sup> *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.