

**DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE
MARKS IN PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

In the matter of an application for registration of Trade Mark No. 260159 and in the matter of an Opposition thereto.

Sidereus Limited

Applicant

Alan Carroll and David Carroll

Opponents

The Application

1. On 20 September 2018, Sidereus Limited, of Borris Road, Bagenalstown, Ireland made application under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the sign NEWGRANGE as a trade mark in respect of “*Watches; Chronographs [watches]; Wrist watches; Dress watches*” in Class 14. The application was accepted for registration and advertised under No. 260159 in Journal No. 2378 dated 6 February 2019.
2. Notice of Opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 12 February 2019 by Alan Carroll and David Carroll of Bluebell Industrial Estate, Walkinstown, Dublin, Ireland (hereinafter “the Opponents”). The Applicant filed a counter-statement on 22 February 2019 and evidence was, in due course, filed by the parties under Rules 20, 21 and 22 of the Trade Marks Rules, 1996 (“the Rules”). Both parties elected to attend a hearing in the matter which, due to Covid-19 restrictions was held remotely on 9 December 2020.
3. Acting for the Controller, I decided to dismiss the opposition and to allow the application to proceed to registration. In so deciding, I have considered carefully all the materials and arguments advanced by both parties and relevant caselaw and precedents. I will refer to these materials as and when appropriate and necessary below.
4. The parties were informed of my decision by way of letter dated 7 January 2021. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Opponent in that regard pursuant to Rule 27(2) of the Trade Mark Rules 1996, filed on 29 January 2021. Due to an administrative oversight, caused in part by staff

working remotely, that request was not furnished to the Opposition Section of this office. I apologise for the resulting delay in furnishing these Written Grounds and the inconvenience caused to both parties.

Grounds of the Opposition

5. In its Notice of Opposition, the Opponents refer to their proprietorship of Trade Mark Registration No. 253243 in respect of a series of two marks (depicted below), which is registered as of 10 October 2012 for *cutlery; forks; knives; spoons in Class 8; Handbags, shoulder bags, purses, wallets, clutches, belts, briefcases, umbrellas, parasols, in Class 18; glassware, candles and candle ware, picture frames and tableware in Class 21; and scarves and headwear; clothing in Class 25.*



6. They then raise objection to the present application under various Sections of the Act, which I summarise as follows:
- Sections 8(1)(b) & (c) – *the mark is devoid of distinctive character,*
 - Section 10(2)(b) – *likelihood of confusion on the part of the public, and likelihood of association with the Opponent’s trade mark,*
 - Section 10(3)(a) & (b) – *use of mark would take unfair advantage of, or be detrimental to the distinctive character or reputation of the Opponents’ mark,*
 - Section 10(4)(a) - *use of mark is liable to be prevented by virtue of a rule of law protecting an unregistered trade mark or other sign,*
 - Section 11(1)(c) – *the Opponent’s mark is an earlier mark that is entitled to protection under the Paris Convention as a well-known trade mark,*
 - Section 37(2) – *the Applicant does not use or intend to use mark in relation to goods covered by the application.*

Counter-Statement

7. In his Counter-Statement, the proprietor of Sidereus Limited (hereinafter “the Applicant”)
- Mr Bryan Leech, outlines that, in advance of seeking registration for the opposed mark, he exercised due diligence by conducting a thorough search of the Irish Trade Mark

Register for trade marks of a similar name and for the class of goods for which he was seeking registration of the opposed mark. He provides the results from that exercise, which he claims, show there are no marks on the Register for the word-only mark NEWGRANGE, nor are there any marks on the Register for marks that contain the word NEWGRANGE for any goods in Class 14.

8. The Counter Statement then goes on to provide the rationale for seeking to register NEWGRANGE as a mark and explains the mark's link to the origins of horology and the marking of time in Ireland at the Neolithic site at Newgrange in County Meath.
9. Mr Leech also makes reference to the intended limited edition nature of the watches that will be available under the opposed mark, that they will be of premium quality, that they will predominantly be made-to-order and not available in a retail environment. However, these characteristics have no bearing on the application as filed and I must ignore them.
10. Mr Leech acknowledges the Opponents are the rightful proprietors of Trade Mark No. 253243 in respect of the Newgrange Living device, and that the respective marks of the parties are similar to the extent that both contain the word NEWGRANGE. But the Applicant claims the Opponent's mark contains other elements and is registered for goods which are not identical with, or similar to, the Applicant's goods. On this basis the Applicant denies there exists any likelihood of confusion on the part of the public.
11. Mr Leech goes on to deny all the other grounds of opposition.

Rule 20 Evidence

12. Evidence submitted by the Opponents under Rule 20 consists of a Statutory Declaration, dated 24 April 2019, of Alan Carroll of Blackrock, Co. Dublin, and 7 accompanying exhibits labelled Newgrange 1 to Newgrange 7.
13. Mr Carroll states the Opponents are joint-owners of Trade Mark No. 253243, and that the Opponents are directors in the company Kirkwood Enterprises Limited, which has used the mark NEWGRANGE since 2009 in relation to glassware, candles and candle ware, picture frames, clocks, cutlery and tableware.

14. He states the company has continuously used the mark NEWGRANGE for 10 years in most cities and towns in Ireland and provides approximate annual turnover figures under the mark for the years 2013 to 2017, which range from a low of €2.35 million to a high of €3.43 million. He attaches at “Exhibit Newgrange 2” sample invoices issue to customers in Ireland and Northern Ireland in respect of goods sold under the Newgrange Living brand.
15. Mr. Carroll states his company has traditionally concentrated its marketing and promotional activities through trade shows. He provides figures in respect of annual expenditure on advertising and marketing for the years 2014 – 2017, which average approximately €96,000. He provides at “Exhibit Newgrange 3” the NEWGRANGE LIVING Autumn 2016 catalogue and various references to his company’s mark on the internet, as well as photographs of a stand at a trade show bearing the NEWGRANGE LIVING device mark.
16. At “Exhibit NEWGRANGE 4” Mr Carroll shows the homepage of his company’s website, which contains the NEWGRANGE LIVING device mark.
17. At “Exhibit NEWGRANGE 5” Mr Carroll attached an undated printout from the ebay website in respect of the sale of an item labelled “Newgrange Living Gemstone Clock”. However, the item appears to have been offered for sale by “brianm5983”, not the Opponents.
18. Mr. Carroll makes reference to matters concerning the Opponents’ application to register its NEWGRANGE LIVING device mark in 2012 and provides copies of the application form and correspondence between the Opponents and this office at “Exhibit Newgrange 6”. However, the particulars and associated materials surrounding the Opponents’ application for the mark upon which this opposition is based have no relevance to the matter at hand and must be ignored.
19. He states, in his experience, that when consumers order his company’s products, they generally refer to them by the name NEWGRANGE and not “NEWGRANGE living”. In that regard he states his company has built up a substantial and enviable reputation under its mark NEWGRANGE and that it intends to sell watches under the mark NEWGRANGE and already sells clocks. He states his belief that if a third party sold

watches under the name NEWGRANGE confusion would occur which could damage the Opponents' business and goodwill.

20. Mr. Carroll states that the goods for which the Opponents' mark stands registered are similar to the Applicant's goods. He says glassware and watches are frequently sold side-by-side by the same companies. In support of this he attaches, at "Exhibit Newgrange 7", an extract from the Tipperary Crystal website referring to both glassware and watches, and an extract from a website showing that Newbridge Silverware, who are well known for their cutlery, also sell watches. He says the Opponents' registration also covers clothing, and watches are frequently worn to compliment clothing. Thus, he states, that while the goods are not identical, they are frequently sold by the same companies.

Rule 21 Evidence

21. Evidence submitted by the Applicant under Rule 21 consists of a Statutory Declaration dated 15 August 2019, of Bryan Leech, proprietor of the Applicant, and ten accompanying exhibits labelled "Sidereus 1" to "Sidereus 10". Mr Leech provides details of the design, engineering, manufacture, components, presentation, and price of watches sold by the Applicant. He described the watches are premium, bespoke, limited-edition timepieces, with an entry-level price of €2,800.

22. He states that work on the watches began in late 2014 and that Sidereus was established in 2018. The launch of the inaugural collection took place in March 2019 at the Sidereus showroom in County Carlow. He says the Applicant does not sell any other companies' products under the Sidereus name.

23. Mr Leech repeats much of the content of the Counter Statement. He expands on the design of the features of Sidereus watches and their specific connection with the Neolithic site at Newgrange. He provides extensive background material in respect of the history of the Newgrange site, its links with time-keeping and its fame.

24. He then seeks to clarify specific elements of the Opponent's Notice of Opposition and evidence. He acknowledges the Opponent's earlier registration for the two word "NEWGRANGE living" and device mark, and notes that this is the mark exhibited by the Opponents in their evidence. He stated the references throughout Mr Carroll's Statutory

Declaration to the Opponents' "NEWGRANGE" mark presents a distorted view of the Opponents' registered mark.

25. He then provides details of how he intends to use his NEWGRANGE mark in the marketplace and the trade channels through which goods bearing the mark will be sold. He makes reference to other small independent watch producers that sell directly to consumers, but none of this is of assistance to me in deciding the matter at hand.

26. The material exhibited by Mr Leech includes documentation relating to the incorporation and registration of Sidereus Limited, extracts from brochures depicting watches bearing the Applicant's NEWGRANGE mark, extracts from the Sidereus website, and an invoice for the sale of a NEWGRANGE watch, though this is dated after the relevant date.

Rule 22 Evidence

27. Evidence submitted by the Opponents under Rule 22 consists of a second Statutory Declaration of Alan Carroll, dated 14 February 2020, in which he describes much of Mr Leech's evidence as very interesting but largely irrelevant to the issues in the proceedings. He says the nebulous connection between the Applicant's watches and the history of Newgrange in County Meath would not be known to the majority of Irish consumers. He rejects, as unjustified, the explanation provided by the Applicant for its adoption of the name NEWGRANGE.

28. Mr Carroll returns to the examination by this Office of the Opponents' application to register its NEWGRANGE living device mark. But I must confine myself to the matter at hand, which is concerned with the Opponents' mark and the goods for which it stands registered, and not the particulars of the original application the Opponents filed. Suffice it to say that, if the Opponents were not satisfied with the outcome of the examination of its application, then sufficient time and latitude would have been afforded to them to seek to persuade this Office to reach a different determination.

The Hearing

29. At the Hearing the Opponents were represented by Peter McLachlan, Trade Mark Attorney of McLachlan and Donaldson, while Mr Bryan Leech represented the Applicant. For his part Mr McLachlan focused his arguments on the grounds of opposition relating to

the likelihood of confusion (Section 10(2)(b) of the Act) and the detriment to the reputation of the Opponent's earlier mark (Section 10(3) of the Act).

30. Starting with a comparison of the marks he argued the word NEWGRANGE dominates the Opponents' mark and that consumers would refer to the mark as NEWGRANGE. The "living" element is an add-on and merely suggests that the goods sold under the mark would enhance the living of the consumer. He argued the marks are visually, aurally and conceptually highly similar.
31. Mr Leech rejected this argument and maintained consumers would refer to the Opponents' mark as it appears on the Trade Mark Register and would not ignore the "living" element. This, Mr Leech argued, has been confirmed by research he undertook of stockists of the Opponent's goods, and by the evidence submitted by the Opponents themselves which shows, save for one instance, that the use of the Opponents' mark is in the form in which it is registered.
32. Turning to a comparison of the respective goods, Mr MacLachlan argued they are all luxury items sold through the same trade channels. He referred to the evidence submitted showing the goods being offered for sale side-by-side under the Newbridge Silverware and Tipperary Crystal brands.
33. In reply, Mr Leech emphasised that the Opponents have no rights whatsoever in the mark NEWGRANGE in respect of watches or any other goods in Class 14. Further, he argued, the opposed application predates any evidence referencing NEWGRANGE in relation to watches in the exhibits submitted by the Opponents, or any claimed use of the "NEWGRANGE living" device mark in respect of watches.

Decision

34. The Opponents offered no evidence or argument in respect of the grounds of opposition that claim the Applicant's mark is devoid of distinctive character; that the Applicant's mark is liable to be prevented by virtue of a rule of law protecting an unregistered trade mark or other sign; and that the Opponent's mark is a mark that is entitled to protection under the Paris Convention as well-known trade mark. In these circumstances, I must dismiss the Opposition on these grounds. I must also dismiss the opposition based on the claim that the Applicant does not use or intend to use its mark in relation to goods covered

by application, as this is not a valid ground. That confines my decision to the grounds relating to Sections 10(2)(b) and 10(3), which I shall deal with in turn.

Section 10(2)(b) – *likelihood of confusion and association*

35. The relevant part of Section 10(2) of the Act, insofar as the present application is concerned, reads as follows:

(2) A trade mark shall not be registered if because –

(a)

(b) it is similar to an earlier trade mark and would 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 of the later trade mark with the earlier trade mark.

36. The four basic requirements that must be met in order for an objection under this section to succeed are that (i) there must be “an earlier trade mark”, (ii) the goods of the application must be identical with or similar to those in respect of which the earlier trade mark is registered, (iii) the mark applied for must be similar to the earlier trade mark, and (iv) there must be a resultant likelihood of confusion on the part of the public.

37. The first of these conditions is clearly fulfilled. The Opponents’ mark was registered as of 10 October 2012 and by virtue of Section 11(1)(b) of the Act, is an earlier trade mark for the purposes of Section 10.

38. Not surprisingly, there was disagreement between the parties regarding the comparison of their respective goods, which are shown in the table below:

Applicant’s Goods	Opponents’ Goods
Class 14: Watches; Chronographs [watches]; Wrist watches; Dress watches.	Class 8: Cutlery; forks; knives; spoons. Class 18: Handbags, shoulder bags, purses, wallets, clutches, belts, briefcases, umbrellas, parasols.

	<p>Class 21: Glassware, candles and candle ware, picture frames and tableware.</p> <p>Class 25: Scarves and headwear; clothing.</p>
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39. Mr. MacLachlan argued the goods are similar as they are sold in the same trade channels, are frequently offered for sale under the same brand, and are all luxury goods. He pointed out that, oftentimes, glassware and watches are sold side-by-side. Furthermore, he argued that it is the policy of this Office to treat goods in Class 14 as being related to goods in Classes 18 and 21.
40. On the latter point Mr MacLachlan is partially correct, in that the Office considers Classes 14 and 21 to be “conflicting classes”, but that is not the case with Classes 14 and 18. When two classes conflict it means there are certain goods or services within both classes that can be considered identical, similar, functionally comparable or complementary. This does not mean that all goods and services in one of the classes conflict with all goods and services in the “conflicting class”. Furthermore, it is the case that certain goods or services that are in the same class may not be considered identical or even similar to one another. Therefore, when considering this opposition under Section 10(2)(b) I must concern myself with the actual goods themselves, not the generality of the classes involved.
41. The Opponents argued that the respective parties’ goods share a common characteristic in that they are all luxury goods. I disagree. While certain brands of handbags and glassware are aimed at more discerning or wealthier consumers and can demand premium prices because they are considered to be at the top-end of the respective markets or “designer” products, there is no evidence to suggest consumers view the Opponents’ goods as either designer or luxury items. In my opinion the evidence shows the Opponents’ goods are non-exclusive, everyday household items sold at average prices to average consumers.
42. The Opponents’ only evidence to support its claim of identity or similarity between the parties’ goods relates to the sale of a “Newgrange Living Gemstone Clock” on ebay. But I cannot tell, from the printout exhibited, the date on which the advertisement was placed, nor do the Opponents provide any information regarding the date of production or date of original sale of the item. The advertisement was placed by the seller “brianm5983” and states there are two such items available. However, the price is quoted in pounds sterling,

as are the postal changes, and delivery is indicated as being by Royal Mail. Accordingly, it is reasonable to infer the seller is based in the United Kingdom and has no connection with the Opponents. The Opponents may be the original source of the item offered for sale on ebay, but no evidence was advanced to allow me to conclude the Opponents have sold clocks under their trade mark NEWGRANGE Living to consumers in Ireland. Furthermore, I cannot find any mention of clocks, let alone watches, in the brochures, invoices, advertisements or any other materials exhibited by the Opponents. For all I can tell, the item offered for sale by “brianm5983” may have been a sample of a product that the Opponents were contemplating selling, but which never found its way to the market proper.

43. The Opponents also rely on the fact that Newbridge Silverware and Tipperary Crystal sell clocks/watches, jewellery and silverware; and clocks/watches, jewellery and glassware respectively. But this does not mean all these goods are identical or even similar. Nor does it mean I can ignore the evidence which the Opponents have provided in respect of the goods they sell, none of which relates to watches. Furthermore, the Opponents have indicated they intend to sell watches under their mark at some point in the future, which merely reinforces the point that they do not, and did not at the relevant date, sell watches.
44. The Opponents' have been in business for many years and there is no evidence of them having sold or offered watches to Irish consumers. It is the case that some businesses offer a wide variety of unrelated goods for sale under a common brand, including as the Opponents' have pointed out, for goods in Classes 14 and 21. But, this does not mean that traders of goods bearing a mark registered for goods in Class 21, who do not have their mark registered for goods in Class 14 are entitled, by virtue of their Class 21 registration, to block other traders from offering goods in Class 14 under a similar mark, on the off-chance that they might someday wish to expand their portfolio to include goods in Class 14. This being so, it comes as no surprise to me that Tipperary Crystal and Newbridge Silverware have each registered their marks in both Class 14 and Class 21.
45. The Opponents' Class 21 goods includes glassware. Some watches and clocks have glass or crystal surrounds, but they are not considered to be glassware which is proper to Class 21. These goods belong in Class 14 with all other watches and clocks. Furthermore, watches are not in competition with glassware, nor are the goods complementary.

Therefore, the Opponents' glassware cannot be considered identical or similar to the Applicant's watches.

46. The Opponents' mark is also registered in respect of goods in Classes 8, 18 and 25. Generally, goods in these classes are not considered to be in conflict with goods in Class 14. In these proceedings, I am satisfied that none of the goods in these three classes for which the Opponents' mark is registered are identical or similar to the Applicant's goods. Therefore, overall, I find the Opponents' goods are totally dissimilar to the Applicant's goods.

Comparison of the marks

47. I have compared the respective marks of the parties on the criteria of visual, aural and conceptual similarity and have attempted to make an overall assessment of the extent to which they should be regarded as similar or different. It is important to stress that this is an assessment of the overall impression the marks make on me, having put myself in the shoes of the average consumer of the goods for which the Applicant is seeking protection. Notwithstanding the detailed comparisons I make below I am mindful that the European Court of Justice has noted (*Sabel BV v Puma AG and Rudolf Dassler Sport Case C-251/95*)¹ that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. For this reason, the appreciation of the visual, aural and conceptual similarity of the marks must be based on the overall impressions given by them, rather than on specific points of detail that are likely to go unnoticed by the average consumer.

48. I find there is aural and visual similarity between the respective marks by virtue of the shared element NEWGRANGE. The Opponents' mark contains the Applicant's mark in its entirety, as well as the word "living" and a figurative element. The Applicant argued these elements are an integral part of the Opponents' mark, have always been used by the Opponents, and that consumers and stockists always refer to the Opponents' mark in its totality. On the other hand, the Opponents argue consumers refer to their mark as NEWGRANGE and that that word dominates their mark.

¹ Paragraph 23 of decision dated 11 November, 1997

49. In my opinion, in order for one component of a complex mark to dominate the mark, that component must stand way above all other components to such a degree that it renders the other components insignificant or negligible. The Opponents' mark is a complex mark, in that there is more to it than the word NEWGRANGE. The figurative element and the word "living" are not insignificant or negligible. In my opinion, they are more likely to be noticed than to be ignored. So, while I find the NEWGRANGE element does not dominate the Opponents' mark, it is without doubt the most important and prominent element.
50. This being the case, I find the marks share a greater than average degree of aural similarity. The level of visual similarity between the marks is less because there are non-verbal components (the logo, colours, background, the different typefaces, and presentation of the word elements) in the Opponents' mark which are not present in the Applicant's mark. I find the marks share an average degree of visual similarity.
51. Conceptually, both marks convey an obvious common message, that being a connection to the Neolithic site at Newgrange in Co. Meath. No other concept is possible. The additional elements in the Opponents' mark do not alter that message in any meaningful way. Therefore, I find the marks share an extremely high degree of conceptual similarity. To sum up the results of my assessment of the verbal, visual and conceptual comparison of the respective marks, I find the marks share a high level of overall similarity.

Likelihood of confusion

52. The question is whether the dissimilarity between the goods combined with the similarity between the marks is sufficient to come within the meaning of Section 10(2)(b) of the Act? The criteria against which that assessment should be made have been enunciated in a number of decisions of the Court of Justice of the European Union² (CJEU) in this area and they include the following:
- a. the more distinctive the earlier mark, the greater will be the likelihood of confusion;

² Sabel BV –v- Puma AG and Rudolph Dassler Sport (Case C-251/95) [1998] 1 CMLR 445; Canon Kabushiki Kaisha –v- Metro-Goldwyn-Mayer Inc. (Case C-39/97) [1999] 1 CMLR 77; Lloyd Schuhfabrik Meyer & Co. GmbH –v- Klijsen Handel BV (Case C-342/97) [1999] 2 CMLR 1343

- b. in determining the distinctive character of the earlier mark, it is necessary to make an overall assessment of its capacity to identify the goods for which it is registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings;
- c. in making that assessment, account should be taken of the inherent characteristics of the mark; the market share held by it; how intensive, geographically widespread and long-standing the use of the mark has been; the amount invested in its promotion; the proportion of the relevant public which, because of the mark, identifies the goods as originating from a particular undertaking; and statements from chambers of commerce and industry and other trade and professional associations;
- d. a global appreciation of the likelihood of confusion must, as regards the visual, aural and conceptual similarity of the marks in question, be based on the overall impression created by them, and the importance to be attached to each of those elements must take account of the relevant category of goods and the way in which they are marketed;
- e. the assessment must be made from the perspective of the average consumer who is deemed to be reasonably well-informed, observant and circumspect but who rarely has the chance to make a direct comparison of the marks and must rely on the imperfect picture that he has of them in his mind;
- f. the likelihood of confusion must be appreciated globally, taking into account all of the factors relevant to the circumstances of the case; and
- g. a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa.

Capacity to distinguish the goods.

53. I am satisfied the Opponents' NEWGRANGE living device mark is distinctive and has the capacity to identify the goods for which it is registered as being those of a particular undertaking and thus to distinguish those goods from the goods of other undertakings.

Additional distinctiveness acquired through use

54. In my opinion, the evidence submitted to support a claim of additional distinctiveness acquired through use in Ireland is patchy, in that it points to use of the Opponents' mark across a narrow subset of the goods for which it is registered. Neither the brochures, invoices, advertisements nor pictures of trade stands submitted in evidence contain any mention of any of the goods in Classes 18 or 25. The invoices submitted in evidence demonstrate sales of Angels of Lir (glass figure ornaments), drinks glasses, flutes and goblets, glass bowls, and candle-holders. Therefore, any additional distinctiveness earned through the use of the mark is confined to these goods.

Overall impression created by the marks

55. The wording in the respective marks is similar and the concept is extremely similar. I think the overall impression created by the marks in question is that they are very similar.

The average consumer

56. The Opponents trade in giftware, glassware, cutlery and other household goods. These are everyday items. The evidence shows the Opponents' goods retail at average prices and are targeted towards the general public. Therefore the average consumer in this case is the public at large.

57. Mr. Leech maintains his goods are luxury timepieces which, because of their unique design, precision engineering and quality components, can command premium prices and are therefore only within the reach of more discerning and wealthier consumers. Accordingly, they are not targeted at the average consumer. However, at the relevant date the Applicant had not yet produced or sold a watch under its mark (the first watch was launched 6 months after the relevant date). Therefore, all I have to go on it that the Applicant applied to register its mark in respect of watches, which by default must include all manner of watches across all possible price ranges and consumer classes. Accordingly, for the purposes of these proceedings, I must view the average consumer of the Applicant's goods as being the general watch-purchasing public.

Likelihood of confusion

58. On the one hand I have found the marks share a high level of overall similarity, but on the other, that the goods are dissimilar. The issue rests on whether it is likely that a consumer,

who must be assumed to be already familiar with the goods sold under the Opponents' earlier trade mark, being exposed in a typical purchasing scenario to the goods bearing the mark applied for, is likely to be confused? Would the consumer seriously entertain the thought that the goods being purchased are connected in some way with the goods that he knows under the Opponents' mark? In answering these questions I am mindful of the fact that a lesser degree of similarity between the goods can be offset by a greater level of similarity between the marks. Notwithstanding that, I am satisfied it is unlikely that consumers would believe the respective parties are linked economically in some way. Because of the minor, though not insignificant, differences between the marks, the highly different goods and the fact that the parties are not in competition with one another, I think these questions must be answered in the negative. Therefore, I find there is no likelihood of confusion arising and I dismiss the opposition under Section 10(2)(b).

Section 10(3) – take unfair advantage of, or be detrimental to, the Opponent's mark

59. Section 10(3) of the Act provides as follows:

“A trade mark which 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 State (or, in the case of an EU trade mark, in the European Union) and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark.”

60. The purpose and effect of that provision is to afford an extra level of protection to marks that have a reputation over and above that which is given to standard trade marks. As is evident from the wording of the Section, there are a number of conditions that must be fulfilled in order for it to apply. Firstly, there must be identity or similarity of the marks at issue; secondly, the earlier mark must have a reputation in the State; thirdly, the use of the later trade mark must be without due cause; and fourthly, that use of the later mark must take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier marks.

61. I have already found that there is a high level of similarity between the marks. As regards the second condition, the onus is on the Opponent to prove its mark has the type of

reputation that Section 10(3) seeks to protect. In *General Motors v Yplon SA*³ the Court of Justice of the European Union (CJEU) held that an earlier mark enjoys sufficient reputation if it is known, by a significant part of the public concerned, by the products which it covers. It added that in examining whether the condition is fulfilled, all the relevant factors of the case must be considered, 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.

62. In their evidence the Opponents submitted copies of invoices to support their claims of extensive use of their mark in Ireland. But close inspection of these invoices reveal they are made out to only 3 customers in Ireland - one in each of Mullingar, Wexford and Boyle. The invoices are dated between 2009 and 2013 and demonstrate long-established use of the Opponents' mark. But they do not demonstrate the kind of intensity and widespread geographical use required to establish the kind of reputation required to succeed under Section 10(3) of the Act. By their own admission the Opponents concentrate their brand marketing and promotional activities through trade shows, and that they rely heavily on their website to generate new business. In my opinion, these two methods confirm the Opponents do not specifically aim their brand advertising at the general public, whom I have already found to be the average consumer for the purpose of these proceedings. The general public may come upon the Opponents' website, but this would be pure happenstance. Furthermore, by their nature and purpose, trade shows are not frequently attended by the general public.

63. The Opponents provided details of their annual turnover. While the figures are not insignificant in themselves, they do not provide an indication as to what level of market-share they represented in respect of the goods sold by the Opponents, which are many and varied. It appears to me that hundreds of millions of euro are spent on an annual basis in Ireland on the goods covered by the Opponents' earlier mark, which leads me to conclude the Opponents have a very small share of the overall market. Accordingly, I find the Opponents' marketing activities and turnover figures do not support a claim of their mark having an enhanced reputation.

³ *General Motors v Yplon SA* [1999] ETMR 950

64. Furthermore, it is well established that the reputation which Section 10(3) seeks to protect is that of an extremely well-known trade mark that would be defined as such under the Paris Convention. There is no evidence to suggest the Opponents' mark has, by virtue of marketing, promotion or use, become known to a significant part of the public concerned or gained the required reputation. Such a reputation is expected to extend beyond the limited class of consumers of the Opponent's goods and to penetrate the consciousness of the wider public such that a substantial number of people would know and recognise the mark even if they had never used the Opponent's goods. In my opinion the Opponents reputation does not come near that level and I must dismiss the opposition under Section 10(3).
65. Lest an appeal is lodged on foot of this finding, and for completeness, I will consider the other two conditions. Due cause only becomes a consideration if the first two conditions are fulfilled, which in this case they are not. Therefore, the Applicant does not have to defend its application by proving it has due cause to use the contested mark.
66. Turning finally to detriment. Damage to a mark's distinctive character occurs where the mark is no longer capable of creating an immediate connection with the goods for which it is used. Detriment to the reputation of a mark arises where the use of a third party's mark appeals to the public in such a way that it diminishes the power of attraction of the earlier mark.
67. No evidence has been adduced and no convincing argument had been advanced to support a claim that the Applicant's use of its mark would take unfair advantage, or tarnish the distinctive character or reputation, of the Opponents' mark. Exploitation of a reputable mark occurs when a third party seeks to attach itself to the renowned mark and uses it as a vehicle to ignite consumers' interest in its own, albeit different, products. The third party can gain an advantage by saving on promotion and publicity by benefiting from the marketing endeavours undertaken by the proprietor of the earlier mark which has helped that mark to become famous. Such an advantage would result from parasitic behaviour, but there is no evidence of such behaviour in this case.
68. The Opponents also need to prove that use by the Applicant of its mark would be detrimental to the distinctive character of their earlier mark. In *Intel Corp Inc v CPM*

*United Kingdom Ltd*⁴ the CJEU found that proof of such “requires evidence of a change in the economic behaviour of the average consumer of the goods 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.” I am satisfied the change described has not occurred, and will not occur, if the Applicant’s mark is used in a normal and fair manner. I find the Opponents have failed to prove the threshold has been met to justify the refusal of the disputed mark. Therefore, I dismiss the opposition on this ground also.

69. For the reasons outlined above, I have decided to dismiss the opposition in its entirety and to allow the Applicant’s mark to proceed to registration.

Dermot Doyle

Acting for the Controller

14 July, 2021

⁴ Intel Corp Inc v CPM United Kingdom Ltd [2009] ETMR 13