

## 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 the registration of Trade Mark No. 251574 and in the matter of an Opposition thereto.

**Brian Murphy**

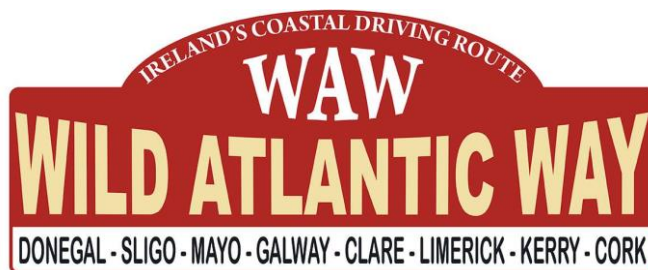
**Applicant**

**Fáilte Ireland**

**Opponents**

### **The Application**

1. On 16 September 2014 Brian Murphy of Kilcoole, Wicklow, Ireland (hereinafter “the Applicant”), made application (No. 2014/01768) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register



as a trade mark in respect of “Printed calendars; Calendars; Tear-off calendars; Books; Reference books; Travel guide books; Gift stationery; Postcards and picture postcards; Greeting cards; Bookmarks; Posters; Journals.” in Class 16.

2. The application was accepted and published in Journal No. 2270 on 17 December 2014. Notice of Opposition to the registration of the mark, pursuant to Section 43 of the Act, was filed on 12 March 2015 by Fáilte Ireland, of Áras Fáilte, Amien Street, Dublin (hereinafter “the Opponent”).
3. The Applicant filed a counter-statement on 3 June 2015 and evidence was then filed under Rules 20, 21 and 22 of the Trade Mark Rules, 1996 (“the Rules”). Both parties attended a hearing on the matter on 28 June 2018.
4. Acting for the Controller, I decided to uphold the opposition and to refuse to allow the application to proceed to registration in respect of all goods. The parties were informed of my decision by way of letter dated 25 June 2018. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Opponent, pursuant to Rule 27(2) of the Rules.

## Grounds of the Opposition

5. In its Notice of Opposition, the Opponent identifies itself as the proprietor of European Union Trade Mark (EUTM) No. 011762374 (depicted below) in respect of a range of goods and services including “printed matter; paper, cardboard and goods made from these materials; calendars; books; greeting cards and related products” in Class 16.



6. The Opponent then raises objections to the application under a number of provisions of Sections 8 and 10 of the Act, which I summarise as follows:

Section 8(3)(b) – *the mark is of a nature to deceive the public.*

Section 8(4)(a) – *use of the mark is prohibited by law.*

Section 10(2)(b) – *a likelihood of confusion on the part of the public, and the likelihood of association with the Opponent’s earlier mark.*

Section 10(3) – *use of the mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponent’s earlier mark.*

Section 10(4)(a) – *use of the applied for mark is prohibited by virtue of the law of passing off.*

Sections 37(2) and (42)(3) – *the Applicant has failed to satisfy the requirements for registration in that he does not use, nor have a bona fide intention of using, the mark.*

## Counter Statement

7. In his Counter Statement, Mr. Murphy accepts the Opponent is the proprietor of EUTM No. 011762374 but states the Opponent does not have a trade mark for the words “Wild Atlantic Way”. He says the mark applied for is in no way visually similar either by design or colour to the Opponent’s EUTM. He maintains the descriptive term “Wild Atlantic Way” should not be reserved for the sole use of one operator, as it is in widespread use, and is descriptive of the geographical origin of any product bearing the term. He says several products have been on sale to the public under the Applicant’s mark since the end of 2014

and he attaches photographs of a selection of these products, all of which show the Applicant's mark.

8. Mr. Murphy goes on to deny his mark offends against any of the Sections of the Act mentioned in the Notice of Opposition. I would summarise his denials as follows:

*Section 8(3)(b) – the mark applied for is not capable of deceiving the public as it is in no way similar in design or colour to the Opponent's mark. He used his mark to differentiate his products from those of the Opponent and all other traders.*

*Section 8(4)(a) – the Opponent does not have a trade mark for the words "Wild Atlantic Way".*

*Section 10(2)(b) – the respective marks are dissimilar and could not be confused.*

*Section 10(3) – the Opponent does not trade in a range of products similar to those for which registration is sought, therefore no unfair advantage can be taken.*

*Section 10(4)(a) – the Opponent does not produce a range of products similar to those for which registration is sought, so passing off does not arise.*

*Sections 37(2) and (42(3) – the Applicant is currently using the mark in respect of a wide range of products.*

### **Rule 20 Evidence**

9. Evidence filed by the Opponent under Rule 20 consists of a Statutory Declaration, dated 2 June 2016, of Fiona Monaghan, Head of Operations of the Wild Atlantic Way project of the Opponent and eight exhibits labelled "FM1" to "FM8". Ms. Monaghan provides details of her company's ownership of EUTM No. 011762374 which is the mark relied on in the Notice of Opposition and the Opponent's EUTM application No. 013474044 (WILD ATLANTIC WAY simpliciter), which the Applicant in these proceedings has opposed. She says the opposition proceedings in respect of the Opponent's EUTM No. 013474044 have been suspended pending the outcome in the instant case.
10. Ms. Monaghan then goes on to provide details of the development of the WILD ATLANTIC WAY brand by the Opponent. She explains the Opponent needed to respond to the significant decline in international bed-nights and revenue in the west of Ireland that occurred between 2007 and 2010. The Opponent set out to identify and brand a defined coastal tourist route that would stretch for 2,500 kilometres along Ireland's western seaboard and that would become recognised internationally as one of the world's great

tourist routes. Initially the Opponent coined the brand WILD ATLANTIC DRIVE, but this was changed to WILD ATLANTIC WAY as the route was equally navigable by foot, bike, car, bus or by boat along the coast.

11. Ms. Monaghan states the Opponent employed a consultancy team, led by Colliers International, to develop the brand and also engaged specialists from The Paul Hogarth Company to explore, map and photograph the many routes, attractions and settlements along the western seaboard. This work culminated in the development of the Wild Atlantic Way Route Identification Report (attached at exhibit “FM2”), which highlights the scale of the work undertaken and the importance of the initiative to the Opponent, the Irish tourism industry and the wider Irish economy. The route was launched in 2012 with the Connemara pilot segment with the aid of €1.8 million of government funding. Ms. Monaghan attaches at exhibit “FM3” a printout of the Fáilte Ireland website page announcing the launch.
12. Ms. Monaghan says the route and places of interest along it have been branded through directional signage, production of maps, a website and an app, all of which heavily feature the Opponent’s trade mark WILD ATLANTIC WAY. She says tourism revenue in the Wild Atlantic Way programme is worth €2 billion to the economy and she provides extracts from various publications and reports which highlight the economic success of the initiative at exhibit “FM4”.
13. Ms. Monaghan provides (at exhibit “FM5”) a copy of the Wild Atlantic Way Trade Manual, which is a publication directed at tourism organisers and contains everything one needs to know about the Wild Atlantic Way and the various attractions on the route. She attaches at exhibit “FM6” the Wild Atlantic Way Operational Programme 2015-2109 which contains the plans for the route into the future.
14. Ms. Monaghan states the Wild Atlantic Way has been heavily promoted abroad and not just by the Opponent. She encloses at exhibit “FM7” print-outs from the US website of Aer Lingus and from the Irish American website Irish Central which both publicise the route to potential US tourists to Ireland.
15. She deposes that all the evidence points to the WILD ATLANTIC WAY trade mark as having accrued a very high profile and reputation in Irish tourism and is identified wholly

and unmistakably with the Opponent. She says the Opponent supported the initiative with total funding to the tune of over €15 million to the end of December 2015.

16. Ms. Monaghan's final exhibit ("FM8") contains the results of a search carried out on the website of Ordnance Survey Ireland – the State body charged with the function of creating and maintaining the definite mapping records of the State – which returns an "*Apologies, no results were found*" in respect of a search for Wild Atlantic Way. This, she states, proves that there is no such place as Wild Atlantic Way and that the term is the creation and intellectual property of the Opponent.
17. The remainder of Ms. Monaghan's declaration addresses certain of the Applicant's claims in its Counter Statement, which I need not repeat here.

#### **Rule 21 Evidence**

18. Evidence submitted by the Applicant under Rule 21 consists of a Statutory Declaration dated 23 March 2017, of Brian Murphy, of Blackrock, County Dublin and four accompanying exhibits marked "1" to "4".
19. Mr. Murphy takes issue with certain statements made by Fiona Monaghan in her Statutory Declaration. He says the Wild Atlantic Way mark is not identified wholly and unmistakably with the Opponent. While there is no specific place called the Wild Atlantic Way, it is identified with a specific area in Ireland, namely the western seaboard and Atlantic coast. He provides at Exhibit 1 a printout from Wikipedia which describes the Wild Atlantic Way as "*a tourism trail along the Irish Atlantic coast*". He states he typed in the term Wild Atlantic Way into the Ordnance Survey search system and it returned two links directing him to maps relating to areas on the Wild Atlantic Way, which he attaches at Exhibit 2.
20. Mr. Murphy says the Opponent has not been involved in the development or distribution of the products for which they are claiming a trade mark under Class 16 of the Nice Classification, whereas the Applicant has several products in the marketplace under this Class dating back to early 2014. He attaches samples of these products consisting of key-rings, playing cards, calendars, post-cards, fridge magnets, tourist guides, bookmarks and drinks coasters, all of which contain the term Wild Atlantic Way, and nearly all of which do so in the form of the trade mark applied for.

21. Mr. Murphy states his company's product range was initiated after discussions with the Opponent about using EUTM No. 011762374 on the products. He says the Opponent told his company that it was free to use the words Wild Atlantic Way on its products but not the Opponent's actual EUTM.
22. He says a simple online search of the term Wild Atlantic Way will reveal a great many books, maps and guides on the subject and he attached at Exhibit 3 examples of the search results. He says there are also books and guides on the Wild Atlantic Way in most book and gift shops, and he attaches at Exhibit 4 a photograph of a "Discovering Ireland" bookshop display containing a book titled "Ireland's Wild Atlantic Way".
23. He states the parties' respective marks are in no way similar. He asserts the Opponent's mark is identified with the actual route and not with actual retail products. He states his company have never used the Opponent's mark and that use of the words Wild Atlantic Way alone does not constitute use of the Opponent's mark, as the Opponent's mark is a figurative mark.
24. Mr. Murphy states the roles of the Opponent and the Applicant are different. The Opponent's role is to maintain and promote the route and it is the role of companies like the Applicant to provide quality products for the visitors to purchase with the help and support of Fáilte Ireland. To support his view, he quotes the following passage from the Opponent's website:
- "Fáilte Ireland is the National Tourism Development Authority. Our role is to support the tourism industry and work to sustain Ireland as a high-quality and competitive tourism destination. We provide a range of practical business supports to help tourism businesses better manage and market their products and services."*
25. Mr. Murphy concludes by stating his company's trade mark does not infringe the Opponent's mark in any way in the marketplace given the Opponent does not operate in the production, wholesale, or distribution of tourism products for sale in retail stores. His company is not claiming exclusive rights to the words Wild Atlantic Way, but rather the non-exclusive right to use the term as part of a figurative trade mark to be used on his company's products.

## **Rule 22 Evidence**

26. Evidence filed by the Opponent under Rule 22 consists of a second Statutory Declaration, dated 20 October 2017, of Fiona Monaghan and two exhibits marked “Rule22FM1” and “Rule22FM2”.
27. Ms. Monaghan states she stands over her attestations in her first declaration. She agrees with Mr. Murphy that there is no specific place called the Wild Atlantic Way, precisely because the Opponent coined the name for a tourist trail, not a place. She says the Applicant’s evidence regarding the two references on the Ordnance Survey of Ireland website supports that fact.
28. She says she is surprised by the Applicant’s comments in relation to the Opponent’s use of the WILD ATLANTIC WAY trade marks for goods in Class 16, as she states the Opponent made numerous attempts to reach an amicable agreement with the Applicant and that the Applicant was fully aware of the Opponent’s planned introduction of official merchandise under its WILD ATLANTIC WAY trade marks. The attempts included a meeting between representatives of both parties and she attaches at Exhibit “Rule22FM1” a copy of an e-mail from Brian Murphy thanking two of her colleagues for a meeting and offering to assist in any way with the promotion of the Opponent’s brands.
29. Ms. Monaghan attaches at Exhibit “Rule22FM2” a copy of an e-mail exchange between the parties, wherein the Opponent draws Mr. Murphy’s attention to the publication of a call for tender document issued by the Opponent in respect of brand marketing and licencing consultation and inviting the Applicant to register an interest in same. The Opponent was under no obligation to do this but did so to ensure the Applicant was kept informed of any developments in relation to the Opponent’s use of its WILD ATLANTIC WAY trade marks, particularly from a merchandising perspective.
30. Ms. Monaghan points out that despite Mr. Murphy’s claim the Applicant was given permission to use the words Wild Atlantic Way on the Applicant’s products, she confirms the Applicant has never been able to provide the name of the individual who allegedly granted this permission, nor does the Opponent have any record of any such request being referred to the person responsible for dealing with such matters. She says the Opponent is meticulous about maintaining records in respect of granting consent to ensure any issues, like the present proceedings with the Applicant, do not arise.

31. Ms. Monaghan confirms the Opponent has granted permission to numerous third parties to use the trade mark in relation to all manner of goods. But the Applicant cannot take this to mean it is also entitled to use it, as there are conditions attached to the authorised use of the brand by licencing or any other means, which the Applicant is not privy to.
32. The remainder of Ms. Monaghan's declaration confirms the Opponent's role goes beyond tourism promotion, and it has a fundamental right to protect its business interests and its intellectual property rights against unauthorised use.

### **The Hearing**

33. At the Hearing, the Opponent was represented by Mr. Paul Coughlan BL, instructed by Ms. Judy McCullough, Trade Mark Attorney of Tomkins & Co. and the Applicant by Mr. Brian Murphy.
34. Mr. Coughlan opened his submissions by confirming the Opponent's basic ground of opposition was in respect of Section 10(2)(b) of the Act. Though Mr. Coughlan did not formally abandon the other grounds of opposition, he did not offer any argument in support of them. Also, the thrust of the Opponent's evidence was in respect of Section 10(2)(b). In those circumstances, I have considered this matter solely on the provisions of Section 10(2)(b).
35. It is well-established case law that the provisions of Section 10(2)(b) require a comparison of the respective marks and the respective goods or services to be carried out. The marks must be compared in respect of their visual, aural and conceptual similarity. The goods must be compared in respect of their type, purpose, intended use, the channels through which they are sold and the usual purchasing scenario, while always keeping in the mind the typical consumer of the goods or services in question.
36. In that regard Mr. Coughlan argued the goods were identical and the marks were not only highly similar overall, but identical in respect of their dominant and distinctive elements, namely, the words Wild Atlantic Way. While the mark at issue contains a figurative element that is not present in the Opponent's mark the disputed mark is not sending out a different signal, in that while the figurative element is subsidiary to the verbal element, it is in harmony with and supports the words Wild Atlantic Way.



37. Mr. Coughlan argued the letters W-A-W do not constitute a word and that it is immediately apparent they are the initials of what comes below – just like in wave the Opponent’s earlier mark. The other words are pushed out to the margins and those that are on top (Ireland’s Coastal Driving Route) are no more than a commentary. The list of counties is not capable of providing distinctiveness and is no more than a geography lesson. He argued everything other than the words Wild Atlantic way are subsidiary, or background content and cannot overcome the fact that the dominant element of the mark is the words Wild Atlantic Way.
38. He argued that visually, aurally and conceptually there is a high degree of similarity between the respective marks. Considering this, and the fact the goods are identical, there must be a likelihood or confusion arising, and the application must be refused.
39. For his part Mr. Murphy argued the marks are not similar as there are significant differences in the colour, background and concept. The Applicant’s mark is designed to reflect the shape of a typical motor rally plate, and the words “Ireland’s Coastal Driving Route” have been incorporated to enforce that concept. The inclusion of the county names further emphasises the driving route concept.
40. Mr. Murphy argued the letters WAW are simply the lead letters of the words Wide Atlantic Way and are not included to look like the wave element in the Opponent’s mark.
41. Mr. Murphy confirmed the Applicant had many interactions with the Opponent regarding use of the term on the Applicant’s products, but that a licence to use the Opponent’s mark was not granted to the Applicant. Notwithstanding, he maintained the words Wild Atlantic Way are in the public domain and are used freely by many businesses. In light of this, and that the words represent a geographical route along Ireland’s western seaboard, he maintained that no one should be granted a monopoly and the words should remain available to be used freely by all.
42. In his evidence and at the Hearing Mr. Murphy argued the term Wild Atlantic Way mark is not synonymous with the Opponent as it has been used by many others in the tourism trade for many years. This has not led to confusion in the marketplace but merely confirms consumers do not and never will associate the mark exclusively with a particular entity.

43. Mr. Coughlan argued the Opponent does not deny the mark has been used by others and, as stated in evidence, it is very happy to allow others to use its mark. But the Opponent is adamant that all use must be authorised by the Opponent and done in strict accordance with the terms and conditions laid down by the Opponent, which ensures the brand's essential characteristics, its identity and quality are maintained and controlled.
44. It is clear from both party's evidence that the parties were in communication regarding use of the Opponent's mark but, for reasons unspecified, no formal agreement was reached. It is also clear that the Applicant, having made preparations to launch products under the Wild Atlantic Way brand, but having failed to secure permission to use the Opponent's brand, nonetheless proceeded to launch the products, perhaps believing that once it used a different version of the brand it was perfectly legitimate to do so.
45. Mr. Coughlan suggested the issue of permission to use the mark was a matter for another day. He argued the Applicant is on a crusade to undermine the Opponent's legal right to own and protect its intellectual property. He claimed the Applicant has not in any way addressed any of the legal issues regarding the registration of the Applicant's mark.

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

46. The relevant part of Section 10(2) of the Act, insofar as the present application is concerned, is written in the following terms:

*(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.*

47. The principles to be applied in determining an objection under Section 10(2)(b) of the Act are not in dispute. They have been set out in detail in several decisions of the Court of Justice of the European Union (CJEU)<sup>1</sup> and their applicability in an Irish context has been

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<sup>1</sup> including Case No. C-251/95, Sabel BV v Puma AG and Rudolf Dassler Sport, Case No. C-39/97, Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc. and Case No. C-342/97, Lloyd Schufabrik Meyer & Co. GmbH v Klijsen Handel BV

affirmed by the High Court (Finlay Geoghegan J) in *Cofresco Frischaltheprodukte GmbH & Co. KG –v- The Controller of Patents, Designs and Trade Marks and Reynolds Metals Company*<sup>2</sup>. In summary, the principles are:

- (i) the likelihood of confusion must be appreciated globally, having regard to all the relevant factors, including the degree of similarity between the marks and between the goods, the likelihood that the public will make an association between the earlier mark and the mark seeking registration, and the distinctiveness of the earlier mark;
- (ii) the similarity between the marks must be determined by reference to the degree of visual, aural and conceptual similarity between them and the importance to be attached to each of these elements must be assessed by reference to the category of goods and the circumstances in which they are marketed;
- (iii) the assessment must be made from the perspective of the average consumer of the goods in question, who must be deemed to be reasonably observant and circumspect but who rarely has the chance to make a direct comparison of the marks and must rely instead on the imperfect picture of them that he keeps in his mind;
- (iv) the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components, because the average consumer normally perceives a mark as a whole and does not analyse its various details;
- (v) the higher the distinctiveness of the earlier mark, whether inherent or acquired through use, the greater the protection granted to it, and vice versa.

48. There are four basic requirements which must be met for an objection under Section 10(2)(b) to succeed. The first of these conditions is there must be an earlier mark. The mark relied upon by the Opponent was filed with the European Union Intellectual Property Office prior to the date of application of the disputed mark and is therefore an earlier trade mark.

49. The second requirement is there must be identity or similarity between the goods. The Applicant seeks registration for its mark in respect of “Printed calendars; Calendars; Tear-off calendars; Books; Reference books; Travel guide books; Gift stationery; Postcards and

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<sup>2</sup> Unreported decision dated 14 June, 2007

picture postcards; Greeting cards; Bookmarks; Posters; Journals;” in Class 16. The Opponent’s earlier mark is registered for goods which includes “Printed matter; paper, cardboard and goods made from these materials; calendars; books; greeting cards and related products” in Class 16. Clearly all the goods for which the Applicant seeks registration are either identical or highly similarity to the goods for which the Opponent’s earlier mark is registered.

### **Similarity of the marks**

50. Turning now to the third requirement: the mark applied for must be similar to the earlier mark. I have compared the respective marks on the criteria of visual, aural and conceptual similarity and have made an overall assessment of the extent to which they should be regarded as similar or different. I stress 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 seeks registration. I must also be mindful that the CJEU has noted in *Sabel*<sup>3</sup> that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

51. Visually and aurally it is immediately apparent that there is similarity between the marks, as both contain the words “Wild Atlantic Way”. These words form the central plank of both marks and I consider them to be the dominant element of each. All other elements of both marks play a subservient role. In the case of the Opponent’s mark, the wave element is depicted as two joined W’s in a way that, in my opinion, is intended to create a link with the letters W-A-W, these being the lead letters of the words Wild Atlantic Way. The actual letters W-A-W are present in the Applicant’s mark, and little cerebral effort is required to understand their presence or meaning.

52. The Applicant’s mark contains two verbal elements that are not present in the Opponent’s earlier mark. The first is the phrase “Ireland’s Coastal Driving Route” which is depicted in much smaller font than the primary and dominant element “Wild Atlantic Way” or the secondary element “WAW”. This phrase does no more that explain that the Wild Atlantic Way is a tourist route along the coast of Ireland. It adds nothing by way of distinctiveness, nor does it serve to put any distance between the respective marks in terms of the meaning or the concept behind each. The other verbal element is also depicted in a smaller font than

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<sup>3</sup> *Sabel BV v Puma AG and Rudolf Dassler Sport Case C-251/95*

the dominant element and comprises a list of counties along Ireland's western seaboard. This list of counties merely names the countries along the Wild Atlantic Way and as such it complements the words Wild Atlantic Way but does not bestow any degree of distinctiveness upon the Applicant's mark.

53. Mr. Murphy made much of the difference in the shapes of the represent marks, in particular what he described as the motor rally plate design of the Applicant's mark. In my opinion, nothing rests on the background or shape of the Applicant's mark. Whether or not the background is a particular shape or copies a format commonly used in motor rallying circles is not significant to override the obvious similarity between the marks.

54. I find the marks share a very high degree of similarity, with the dominant and distinctive visual and aural elements being identical. The concept behind both marks is also centred on the words "Wild Atlantic Way" which conveys a clear and precise message that is easily understood. I find the marks are highly similar from a conceptual perspective.

#### **Likelihood of confusion**

55. The basic ingredients of an objection under Section 10(2)(b) of the Act are present because the marks and the goods in Class 16 are highly similar. It now rests on whether, consequently, there is a likelihood of confusion on the part of the purchasing public.

56. The kind of confusion that Section 10(2)(b) seeks to avoid is concerned solely with the commercial origin of goods or services (in this case only goods), whereby the average consumer, being familiar with goods sold under the earlier mark and, because of the similarity in the respective marks, attributes to the goods offered under the disputed mark the qualities and characteristics that he associates through experience with the goods offered under the earlier mark. The question is whether the average person, who knows of goods sold under the Opponent's trade mark and who then encounters the Applicant's identical goods offered under the disputed trade mark, would assume that the latter goods were connected to the former in the sense that they were both put on the market by the same undertaking or by commercially related undertakings.

57. The criteria against which the question should be answered has been established in several decisions of the CJEU<sup>4</sup> in this area and include the following:

- i. A lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa;
- ii. The more distinctive the earlier mark, the greater will be the likelihood of confusion;
- iii. 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;
- iv. 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 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;
- v. 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 category of goods and the way in which they are marketed;
- vi. 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;
- vii. The likelihood of confusion must be appreciated globally, taking into account all the factors relevant to the circumstances of the case.

58. In applying those criteria to the facts of the present case, I have reached the following conclusions:

- (a) The overall impression created by the marks in question is that they are very similar.
- (b) The respective goods in Class 16 are identical or highly similar.

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<sup>4</sup> 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

- (c) The Opponent's mark has a high level of inherent distinctiveness in respect of goods in Class 16 and it has the capacity to identify these goods as being those of a particular undertaking and thus to distinguish them from goods offered by other undertakings.
- (d) The average consumer, in this case the general public, had been exposed to the Opponent's mark by virtue of the extensive advertising of the mark.
- (e) The Opponent's mark is well known and is readily recognised as the Opponent's throughout the State.
- (f) The Opponent has invested significantly in the promotion of its WILD ATLANTIC WAY brand.
- (g) The Opponent's mark has acquired substantial additional distinctiveness through the use made of it by the Opponent or by others with the Opponent's consent.

59. Therefore, it is clear to me that, if a consumer was familiar with the Opponent's trade mark WILD ATLANTIC WAY in respect of goods in Class 16 and encountered the Applicant's mark in respect of identical or highly similar goods, they would be likely to believe the goods emanate from the Opponent or from an undertaking that was economically linked to the Opponent, in that for example, both parties were under the same ownership or the mark was being used with the consent of the Opponent. This is precisely the scenario that would inevitably lead to the type of confusion that Section 10(2)(b) seeks to avoid.

60. Having considered all the evidence and arguments put forward by both sides, and having carried out the assessment required to determine oppositions under Section 10(2)(b) of the Act, I find that use by the Applicant of the mark applied for would be likely to lead to confusion as to the origin of the goods bearing that mark, in light of the Opponent's highly similar earlier mark, which is registered for identical goods in Class 16.

61. Accordingly, I find the application offends against Section 10(2)(b) of the Act and I refuse to allow it to proceed to registration.

Dermot Doyle

Acting for the Controller

17 December 2018