

**DECISION OF THE CONTROLLER of INTELLECTUAL PROPERTY IN
PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

In the matter of an application for registration of Trade Mark No. 263496 and in the matter of an Opposition thereto.

Gareth Welton

Applicant

Pearse Hegarty

Opponent

The Application

1. On 08 August 2020 Gareth Welton. of Newtown Carbury, Baylough, Athlone, Co. Westmeath (hereinafter “the Applicant”) made application (No. TM 2020/01387) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the mark “**Recharge**” as a Trade Mark in respect of various goods and services in Classes 2, 9 and 35.
2. The application was accepted for registration and advertised accordingly under No. 263496 in Journal No. 2421 dated 30 September 2020.
3. Notice of Opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 13 November 2020 by Pearse Hegarty, 33 Oliver Plunkett Street, Mullingar, Co. Westmeath (hereinafter “the Opponent”). The Applicant filed a counter-statement on 01 February 2021.
4. The Opponent, on 06 May 2021, filed by means of a Statutory Declaration under Rule 20, a response including an exhibit, reference “PH1”, in support of their Opposition case. The Applicant, on 1st October 2021, filed by means of a Statutory Declaration under Rule 21, material in support of his case, including an exhibit, reference “GW1”.
5. The Opponent, on 01 December 2021, filed by means of a Statutory Declaration under Rule 22, a response including exhibits, reference “PH1”, “PH2”, “PH3” & “PH4”, in response to the evidence filed previously by the Applicant under Rule 21.
6. The parties were asked by Official letter on 16 December 2021 to advise whether they wished to attend at hearing or file written submissions in lieu of such attendance pursuant to Rule 25(1) & (2). The Opponent elected to file written submissions and did so on 07 April

2022. As the Applicant did not elect a preference they were deemed, in accordance with Rule 25(2A), to have concluded their presentation of evidence and arguments.

7. Acting for the Controller, I decided to dismiss the opposition and to allow the application to proceed to registration. The parties were notified of my decision by letter dated 09 June 2022. I now state the grounds of my decision and the materials used in arriving thereat, in response to a request by the Applicant in that regard pursuant to Rule 27(2) of the Rules.
8. In his Notice of Opposition, the Opponent based his case on his ownership of two shops in the same county as the Applicant. He stated that his shops trade under the name Recharge-IT and he sells products in Class 2 and deals in services in Class 35. He further stated that he was in business for eleven years.

Counter-Statement

9. In his Counter-Statement, the Applicant stated that he had been in business since 2004. His business name changed to “Recharge” in October 2007 and it primarily sells printer ink and toner, office stationery and supplies and other electronic equipment. The Applicant went on to state that the Opponent, a former employee of his, opened a store 650 metres from the Applicant’s location in Athlone, Co. Westmeath in August 2020. The Applicant is separately pursuing a civil case against the Opponent in which he is claiming “passing off”.

Rule 20 Evidence

10. Evidence submitted by the Opponent under Rule 20 consisted of a Statutory Declaration and a supporting exhibit labelled “PH1” dated 06 May 2021. This consisted of copies of printouts showing company name searches, purchase agreements, website and Facebook pages and a copy of an Equity Civil Bill in relation to proceedings between the Opponent and Applicant.

Rule 21 Evidence

11. The Applicant filed evidence under Rule 21 consisting of a Statutory Declaration and a supporting exhibit labelled “GW1” dated 1st October 2021. This outlined details of his involvement with a franchise business called “Recharge” since 2007. The company was dissolved in 2010 but the shareholders decided to continue to trade under the mark “Recharge”. This mark was subsequently removed from the Register due to the non-payment

of the renewal fee. In his evidence, the Applicant also included statements from the owners of ten businesses using the “Recharge” brand in various locations throughout Ireland in which they confirmed that they had no objection to the Applicant applying for the mark “Recharge”.

Rule 22 Evidence

12. The Opponent filed evidence under Rule 22 consisting of a Statutory Declaration and supporting exhibits labelled “PH1”, “PH2”, “PH3” & “PH4” dated 30th November 2021. The exhibits included an extract from the IPOI website containing details of TM 240781, a figurative mark “re:charge+”, which was previously registered to another company. This mark was removed from our Register on 28th January 2019 due to non-payment of the renewal fee. Notice of removal was published in Official Journal No. 2379 dated 20/02/2019. The Opponent, in his Rule 22 evidence, stated that the previous proprietor of the mark had gone into liquidation. The Liquidator confirmed that the mark wasn’t renewed because no authority was provided to do so. The Opponent went on to reference the statements provided by the Applicant under Rule 21 from the owners of businesses using the “Recharge” brand in various locations throughout Ireland. His view was that this was proof that the Applicant’s mark contravened Section 6 of the Trademarks Act in that it was not capable of distinguishing the goods or services of one undertaking from those of other undertakings. The Opponent disputed the Applicant’s contention that he, the Opponent, had previously agreed to join with others to maintain the trademark for existing users following the dissolution of the original mark owners.
13. Both parties were asked on 16th December 2021 to advise if they wished to attend at a hearing or file written submissions in lieu of attending. The Opponent elected to file written submissions in lieu of attending at a hearing. The Applicant did not elect to do either and so was advised that, in accordance with Rule 25(2A), the matter would be referred to the Controller for consideration and decision.
14. The Opponent filed written submissions on 6th April 2022 in lieu of attending at a Hearing. The submissions summarised the key aspects of the case from the Opponents perspective. This included background details on his business interests and those of the Applicant and matters relating to the history and evolution of the brand “Recharge” and associated businesses. The Opponent outlined details of a breakdown in relations between him and the

Applicant which resulted in the latter initiating Circuit Court proceedings in November 2020 seeking to prevent the Opponent trading in Athlone under the name “Recharge IT”.

The Opponent contended that, as the name “Recharge” was a registered business name for a significant number of businesses throughout the country, the Applicant’s trademark of the same name was not capable of distinguishing the goods or services of the Applicant’s business from the other outlets operating as “Recharge” in Ireland. It was, therefore, in his opinion, in contravention of Section 6 of the Trademarks Act 1996. He further contended that, based on the number of businesses trading under the same name, the mark “Recharge” was in contravention of Section 8 of the Act in that it was devoid of distinctive character.

The Applicant had expressed a desire to register the mark “in order to protect his own business and in order to protect the remaining Recharge stores from any other business seeking to set up a business using this name in the same location as pre-existing businesses are already located” The Opponent contended that this would have the practical effect of preventing all the other Recharge outlets from trading under the name Recharge and using the Recharge+ logo.

The Opponent went on to allege that the Applicant made his trademark application in bad faith contrary to Section 8(4)(e) of the 1996 Act. This was based on his view that the applicant was aware of the other businesses trading under the same name and branding, that the application was made to support separate court proceedings against the Opponent, the outcome of which were yet to be determined and to prevent the Opponent’s company from continuing to operate its Athlone Recharge IT branch.

The Opponent included nine exhibits in his submission, referenced Exhibit A to I. These contained images of the Applicant’s storefront and website, company reports, a copy of a purchase agreement, extracts from the IPOI and CRO Registers and a copy of a Liquidators letter to the IPOI stating the reasons why the original trademark registration, No 240781 for “re:charge+” was not renewed.

Decision

15. The Opponent’s central argument against the Applicant’s mark is based on his contention that the latter’s motivation for applying for it was to damage the former’s business. He stated that he owned two shops in the same county as the Applicant. His shops trade under the name Recharge-IT and he sells products in Class 2 and deals in services in Class 35. In his

evidence, he referred to an earlier figurative mark “re:charge+”, TM 240781, which was previously registered to another company. This mark was removed from our Register on 28th January 2019 due to non-payment of the renewal fee. It should be noted that it was, therefore, legitimately available to be applied for.

The Applicant stated that he had been in business since 2004. His business name changed to “Recharge” in October 2007. This then operated as part of a franchise business called “Recharge”. The company was dissolved in 2010 but the shareholders decided to continue to trade under the mark “Recharge”. and it primarily sells printer ink and toner, office stationery and supplies and other electronic equipment. The company was dissolved in 2010 but the shareholders decided to continue to trade under the mark “Recharge”.

16. Several conflicting positions have been advanced by both parties relating to a disputed version of events and history between them. The submissions filed in support of their respective cases does not, in my opinion, contain sufficient evidence to convince me that the Office erred in its original decision to Accept the mark for publication.

17. Though not contained in the Notice of Opposition, the Opponent did contend in their evidence filed under Rule 22 that the Applicant’s trademark of the same name was not capable of distinguishing the goods or services of the Applicant’s business from the other outlets operating as “Recharge” in Ireland. It was, therefore, in his opinion, in contravention of Section 6 of the Trademarks Act 1996. I, therefore, take this opportunity to clarify that a trademark is how a business identifies its goods or services and distinguishes them from the goods or services supplied by other businesses. A business name is the name under which a venture operates, and a company name is a legal entity in its own right. This differs significantly conceptually and legally from a trademark as outlined above. The Opponent further contended that, based on the number of businesses trading under the same name, the mark “Recharge” was in contravention of Section 8 of the Act and that it was devoid of distinctive character. It is, of course, possible, and it happens in many cases in the marketplace, for various businesses to trade in the same products or services without this leading to a finding that the trademarks under which they are traded are lacking in distinctiveness.

18. In my opinion, on the application date of 8 August 2020, the mark as applied for by the Applicant was legitimately available. Following a full review of the case, I cannot find any reason or barriers to registration.

19. For all the reasons stated above, I have decided that the mark should proceed to registration.

John Nolan
Acting for the Controller

28th February 2023