

**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. 240755 and in the matter of an Opposition thereto.

**T.M.R. Restaurants Limited**

**Applicant**

**Société Anonyme Des Bains De Mer Et Du Cercle Des Etrangers**

**Opponent**

**The Application**

1. On 7 January, 2009, T.M.R. Restaurants Limited, an Irish company, of 11-13 Glaslough Street, Monaghan, County Monaghan, Ireland made application (No. 2009/00015) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the sign below as a trade mark in respect of *“Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats”* in Class 29 and *“Services for providing food and drink”* in Class 43.




2. The application was accepted for registration and advertised accordingly under No. 240755 in Journal No. 2122 dated 15 April, 2009.
3. Notice of Opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 3 July, 2009 by Societe Anonyme Des Bains De Mer Et Du Cercle Des Etrangers, of Place du Casino, MC-98000, Monaco. The Applicant filed a counter-statement on 16 September, 2009 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 filed written submissions in lieu of attending a hearing in the matter and both parties filed submissions in reply to the other party’s written submissions.

4. Acting for the Controller, I decided to dismiss the opposition and to allow the application to proceed to registration. The parties were informed of my decision by way of letter dated 7 February, 2013. I now state the grounds of my decision and the materials used in arriving there at in response to a request by the Opponent in that regard pursuant to Rule 27(2) of the Trade Mark Rules 1996, filed on 15 February, 2013.

### **Grounds of the Opposition**

5. In its Notice of Opposition the Opponent refers to its proprietorship of Community Trade Mark Registration No. 007300064, MONTE-CARLO (the “MONTE-CARLO mark”), which is registered as of 9 October, 2008 in Class 41 in respect of “*Arranging and conducting of colloquiums, seminars, conferences and receptions.*” and in Class 43 in respect of “*Bar services, restaurants, food and drink catering; hotels providing seminar rooms and reception rooms, hotel reservations; on-line reservations on an Internet portal for commercial services relating to hotels, restaurants, seminar and reception rooms.*”



and International Trade Mark No. 000948341,  (the MONTE CARLO logo mark”), designating the European Union, with a registration date of 21 August, 2007, in respect of goods and services, detailed at Annex 1, in 42 of the 45 classes of the Nice Classification; and then raises objection to the present application under various Sections of the Act, which I shall summarise as follows:

- Section 8(1)(c) – *mark consists exclusively of signs or indications which may designate characteristics of the goods,*
- Section 8(1)(d) – *mark consists of signs or indications that have become customary in the trade,*
- Section 8(3)(b) – *mark of such a nature as to deceive,*
- Section 8(4)(a) – *use of mark prohibited by enactment or rule of law,*
- Section 8(4)(b) – *application for registration made in bad faith,*
- Section 10(2)(b) – *likelihood of confusion on the part of the public, and likelihood of association with the Opponent’s trade marks*
- Section 10(3) – *use of mark would take unfair advantage of, or be detrimental to, distinctive character or reputation of the Opponent’s mark,*

- Section 10(4)(a) - *use of mark is liable to be prevented by virtue of any rule of law protecting an unregistered trade mark or other sign,*
- Section 11(1)(c) – *the Opponent’s marks are earlier marks that are entitled to protection under the Paris Convention as well-known trade marks,*
- Section 37(2) – *Applicant does not use or intend to use mark in relation to goods covered by application.*
- Section 42(2) – *Applicant has not met the requirements for registration*

### **Counter-Statement**

6. In its Counter-Statement the Applicant denies all the grounds of opposition and only accepts that the Opponent is the proprietor of the two trade marks on which the opposition is based, though does not admit the validity of these registrations and does not admit the Opponent has used the marks in relation to any goods and services in Ireland.

### **Rule 20 Evidence**

7. Evidence submitted by the Opponent under Rule 20 consisted of a Statutory Declaration, dated 18 August, 2010, of Bernard Lambert, CEO of Societe Bains De Mer et Du Cercle Des Etrangers, of Place du Casino, MC-9800, Monaco and accompanying exhibits (Exhibits 1 to 6). He states that his company has been operating a casino under the name “Casino de Monte-Carlo” for over 140 years and was granted a monopoly to operate gambling premises for the State of Monaco. The resort MONTE CARLO, which his company operates, comprises casinos, hotels and restaurants and now employs over 3,000 staff. His company has built up a significant reputation for the resort, which is renowned globally. His company’s website ([www.montecarloresort.com](http://www.montecarloresort.com)) provides details of and information on the products and services on offer and potential clients can make online reservations from anywhere in the world.
8. Exhibits 1 and 2 contained details of the cited earlier marks and a list of world-wide trade mark registrations and applications incorporating the trade mark MONTE CARLO respectively. The history of the Monte Carlo resort is detailed in Exhibit 3. Exhibit 4 contains annual sales figures for catering and hotel services sold under the MONTE-CARLO trade mark for the five trading periods 2004-2005 to 2008-2009, which show average sales of over €150 million per annum. While there is no figure for Irish based clients, an estimate was given that 700 nights were reserved at the resort by Irish persons

during that 5-year period. A list, containing very sparse address details (many entries limited to a single word, for example, ‘Cork’) was submitted in support of this estimation, though all entries are clearly not in respect of clients in the State, as some addresses refer to Aberdeen, Edinburgh, Leeds and other United Kingdom locations.

9. Exhibit 5 contained copies of advertisements and promotional materials issued by the deponent’s company, though there are no accompanying figures detailing expenditure on these activities. Nor is there anything to suggest that the exhibited material was targeted towards Irish consumers. Exhibit 6 contains a print-out of website content detailing the special packages offered by the company for the 2010 Monaco Grand Prix. The remainder of the Statutory Declaration was concerned with opinion and argument regarding the identity of, or similarity between, the respective marks and the goods and services covered by those marks.

#### **Rule 21 Evidence**

10. Evidence submitted by the Applicant under Rule 21 consisted of a Statutory Declaration dated 24 May, 2011, of Thomas Neeson, proprietor of T.M.R. Restaurants and five accompanying exhibits (“TN1” to “TN5”). He states that “THE MONTE CARLO” business name was first adopted in 1970 when “The Monte Carlo Food Bar” was opened by his father. “Exhibit TN1” is a copy of a newspaper article dated 17 July, 1970 attesting to this. The business name “THE MONTE CARLO” was not registered until 2002 (“Exhibit TN2” provided details of the registration) and then in November 2007 the trade mark, the subject of these proceedings, was adopted and has been used continuously since in relation to a food outlet.
11. Mr. Neeson provides details of turnover figures between 2002 and 2009, which show an average turnover of over €900,000 per annum. He states that almost €45,000 has been expended on advertising over the preceding four years and attaches, at “Exhibit TN3”, copies of various publications and a billboard notice containing the trade mark. “Exhibit TN4” contains a printout of the Applicant’s company’s website ([www.montecarlo.ie](http://www.montecarlo.ie)), as well as sample packaging bearing the mark and details of the promotional tee-shirts worn by the company’s employees. “Exhibit TN5” contains details of various other registered Irish and Community Trade Marks that contain the words MONTE CARLO, some of which, he claims, predate the Opponent’s marks. Addressing the Opponent’s evidence Mr.

Neeson states that no evidence of use of the Opponent's trade marks in Ireland was submitted other than a statement that the number of nights reserved by Irish people was approximately 700 per annum. Thus, he claims, if 100 Irish people were to stay for one week at the Opponent's resorts it would amount to approximately 0.002 per cent of the population of the Republic of Ireland.

12. Mr. Neeson states that he is not attempting to trade on the Opponent's reputation and goodwill in its trade marks as he does not believe the Opponent has a reputation and goodwill in its trade marks in Ireland. Also, he states that he adopted and used the trade mark THE MONTE CARLO many years prior to the registration of the Opponent's trade marks, and that such use has never resulted in any confusion between his mark and those of the Opponent.

#### **Rule 22 Evidence**

13. Evidence submitted by the Opponent under Rule 22 consisted of a second Statutory Declaration of Bernard Lambert, dated 9 August, 2011 in which he takes issue with the evidence submitted by the Applicant, claiming that it is, by and large, entirely unrelated to the matter at hand. In essence Mr. Lambert argues that none of the Applicant's evidence actually demonstrates use of the Applicant's mark in relation to the goods and services covered by the application.
14. He states the newspaper article in "Exhibit TN1" refers to "THE MONTE CARLO FOOD BAR / THE MONTE CARLO CARRY OUT FOOD BAR" and not the mark applied for. The registration, in 2002, of the business name THE MONTE CARLO ("Exhibit TN2") is not sufficient to prove use of the mark applied for. The turnover figures are devoid of documentary evidence and should be considered inadmissible. If not deemed inadmissible any turnover and expenditure on advertising, post-dating his company's registration of its marks, are irrelevant.
15. Mr. Lambert states that much of the advertising and promotional materials (Exhibit TN3) are not dated or that those that are dated post-date the registration of his company's marks. He argues that the evidence submitted in Exhibit TN4 should be disregarded in its entirety as it is either not what it claims to be, is undated, or simply shows the Applicant's mark on plain white paper. He adds that the material submitted by the Applicant at Exhibit TN5,

concerning other registrations containing the term MONTE CARLO, are irrelevant to these proceedings.

16. No further evidence was filed and the parties were, in due course, invited to elect whether to attend a hearing or to file written submissions in lieu of attending at a hearing. Both parties elected to file written submissions and did so, with both subsequently filing further written submissions in reply.

### **Written Submissions**

17. In general, the written submissions from the Opponent expanded upon evidence already filed and did not include any additional material of significance. Legal arguments made in support of the opposition contained references to the usual case-law cited by an opponent when dealing with each ground of opposition. While certain of the grounds of opposition listed in the Notice of Opposition were based on Sections 8(1)(c), 8(1)(d), 8(3)(b), 8(4)(a), 8(4)(b), 37(2) and 42(3) of the Act, these were not particularised and no evidence was filed in relation to them. However, the Opponent returned to the grounds relating to Section 8 of the Act in its written submissions, thereby indicating its intention to maintain them.
18. For its part the Applicant's written submission also expanded upon evidence already filed, but did not add anything of material significance to that evidence. The Applicant questioned the Opponent's return to grounds of opposition which were not previously particularised or supported by evidence, but, nonetheless, addressed them.

### **Decision**

#### **Section 11(1)(c) – *the Opponent's marks are earlier marks***

19. Section 11 of the Act is not a valid ground on which an opposition can be based or on which it can succeed. Its purpose is purely to define what constitutes an earlier mark. If a mark on which an opposition is based falls within the definition of an earlier mark as defined by this section then the matters to be considered in opposition proceedings in relation to the earlier mark are those provided for in Section 10 of the Act (i.e. the relative grounds for refusal of an application).

**Section 37(2) – Applicant is not using, or has no intention to use, the mark**

20. Section 37(2) of the Act requires an applicant for registration of a trade mark to include in the application a statement that the trade mark is being used, by or with the consent of the applicant, in relation to the goods or services specified in the application, or that the applicant has a *bona fide* intention that it should be so used. The Opponent has raised objection under these provisions, claiming that the Applicant did not have a *bona fide* intention to use the trade mark applied for in relation to all of the goods and services of the application. That is simply not a credible basis on which to advance what is, in essence, a claim that the Applicant lied in making its statement of intended use of its trade mark when it filed the present application for registration. The fact is that the application contained the statement required by Section 37(2) and no objection can lie against it based on that provision. The Opponent can challenge the veracity of that statement but, if it does so, it is effectively alleging bad faith against the Applicant and it falls under the strict requirements to particularise and prove that charge. It has not done so and, accordingly, I dismiss the opposition on these grounds also.

**Section 42(2) – the requirements for registration have not been met**

21. Section 42(3) provides that the Controller shall refuse an application if the applicant fails to satisfy her that the requirements for registration have been met. This is a rather misguided basis on which to ground an opposition. The Controller, in publishing her acceptance of the application for registration, signalled clearly that, *prima facie*, the Applicant fully met the requirements for registration. Therefore, no claim of failure to meet the requirements for registration can possibly succeed. Accordingly, without further ado, I dismiss the opposition on this ground also.

**Section 8(1)(c) - the mark is descriptive**

22. This section of the Act prohibits the registration of marks that “*consist exclusively of signs or indications which may serve, in trade, to designate*” certain characteristics of the relevant goods or services. The most important element of the provision is the word “*exclusively*”, which relates to the actual content of the trade mark in question and not its propensity to designate characteristics of the goods or services for which registration is sought. It does not matter if the several components making up the mark can have meanings other than a descriptive meaning in respect of the relevant goods or services, provided that each of the components has such a descriptive meaning and there is nothing

more in the mark that is not descriptive; in such a case, the mark must be said to consist exclusively of descriptive signs or indications. The aim of the provision is the protection of the public interest, namely, that descriptive signs or indications relating to the categories of goods or services, in respect of which registration is applied for, may be freely used by all.

23. In the present case the mark consists of a number of elements, some of which cannot, under any interpretation, be considered descriptive. In my opinion the words THE MONTE CARLO, the fanciful figurative element of the fish, dressed in chef's hat holding a frying pan, and the blue circle background cannot be considered to fall within the scope of signs and designations that must remain open to be used by all traders of the goods and services for which protection is sought. I find the mark is not exclusively descriptive and does not offend against Section 8(1)(c), and, therefore, I must dismiss the opposition on that ground.

**Section 8(1)(d) – *the mark has become customary in the trade***

24. The prohibition on the registration under Section 8(1)(d) of the Act also deals with exclusivity; but this time in relation to signs or indications which have become customary in the current language or in the bona fide and established practices of the trade. While the words “Traditional Fish & Chips” are customary in the trade the words “THE MONTE CARLO”, the figurative element of the fish using a frying pan and the blue circle background cannot be considered to be so. Therefore, the mark does not consist exclusively of signs or indications that have become customary or common in the trade and so, does not offend against Section 8(1)(d) of the Act. Accordingly, I must dismiss the opposition on this ground also.

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

25. Turning now to the prohibition on the registration of a mark if it is of such a nature to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service. While no evidence was offered to support this ground of opposition, in its written submissions the Opponent argued on two fronts: (i) that the mark was apt to lead members of the public to believe that the goods and services offered under the mark are linked to the Opponent and accordingly, have a quality which is equal to the quality and luxury standard of the goods and services provided by the Opponent under its earlier



marks and (ii) that the public may assume that the fish & chips and other foodstuffs and services provided by the Applicant emanate from the Opponent, thereby being deceiving as to their origin.

26. Section 8(3)(b), which is an absolute ground for refusal of an application, is concerned with deceit that is inherent in the mark itself, viewed in isolation from any other mark. It does not concern itself with confusion because of the existence of earlier marks, which is a relative ground for refusal and it provided for under Section 10 of the Act. The prohibition on registration contained in Section 8 is confined to marks that, directly and by their nature, declare a falsehood as to the qualities or characteristics that the consumer may expect of the marked goods or services. I am satisfied, therefore, that the Act has clearly decoupled the concepts of deception and confusion, and that deception within the meaning of Section 8(3)(b), including deception as to geographical origin, is not to be equated with, or connected to, confusion as to commercial origin within the meaning of Section 10(2), which I will address later.

27. The two arguments on which the Opponent has based its opposition under Section 8(3) relate to the Opponent's business and its earlier marks, which as I have already said are arguments proper to Section 10 of the Act. As no evidence or arguments have been advanced that the mark, for which the Applicant seeks registration, is inherently deceptive, the opposition under Section 8(3)(b) must therefore be dismissed.

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

28. No evidence was offered in support of the ground that use of the mark is prohibited in the State by an enactment or rule of law or by any provision of Community law as provided for under Section 8(4)(a), the classic example of such laws being use of the Red Cross emblem under the Red Cross Act, 1938. In its written submissions the Opponent argues that its marks benefit from the special protection afforded to well-known marks under the Paris Convention as provided for under Section 61 of the Act, and on that basis the mark applied for offends against Section 8(4)(a) of the Act. This is not a sustainable argument as the provisions of Section 61 do not cross-over with, or in any way relate to those of Section 8(4)(a). Section 8(4)(a) excludes from registration marks whose use is specifically and expressly **prohibited** by statute or other rule of law, whereas Section 61 is concerned with potential infringement of third party rights that might arise from such use and is the

specific subject matter of Section 10(4)(a) of the Act dealing with the law of passing off, which I shall deal with later. Therefore, I must reject the opposition on this ground also.

**Section 8(4)(b) - *bad faith***

29. The charge that the Applicant applied for the mark in bad faith was not particularised and no evidence was adduced to support it. It is for an Opponent who makes a charge of bad faith to prove, on the balance of probabilities, that the Applicant has behaved dishonestly or in a manner which falls short of the acceptable commercial standards observed by reasonable and experienced traders in the particular area of business. No such proof has been forthcoming. It appears to me that the claim of bad faith was made by the Opponent on the basis that the Applicant has applied for a trade mark which the Opponent believes to be similar to its marks, of which the Applicant must have been aware of. This of itself does not constitute an act of bad faith. I find the charge of bad faith in the making of the application has not been laid out, let alone proven, and, therefore, the opposition must fail on this ground.

30. Having dealt with all the absolute grounds of opposition I must take this opportunity to express my concern about the all-too-common practice that has become part of what I regard as the “kitchen-sink” approach to oppositions, whereby opponents cite a multitude of sections of the legislation as grounds of opposition, including those that the opponent knows cannot succeed, though which requires applicants to undergo unnecessary work and expense to address. Typically no evidence is adduced or arguments advanced to substantiate these grounds of opposition. For example, over the years, all oppositions before me that are based on Section 8(4)(a) have been dismissed because opponents have always failed to identify the actual law that expressly prohibits the mark under attack. Other examples include the frequent citing of Sections 37(2) and 42(3) regarding the use of or the intention to use the mark, and the failure to satisfy the Controller that the requirements for registration have been met, respectively; neither of which can ever succeed in its own right. The charge of “bad faith” appears regularly without being properly particularised or supported by evidence. I raise these points by way of encouraging opponents and, in particular, their legal representatives, to refrain from adopting the “kitchen-sink” approach, so that the cost and time taken to bring opposition proceedings to a conclusion are minimised. Failure to do so may lead to the necessity to

take into account the approach adopted by opponents when ultimately assessing the award of costs, irrespective of which party is successful.

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

31. 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.*

32. As is evident from the wording of Section 10(2), the four basic requirements that must be met in order for an objection under it 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 protected, (iii) the mark applied for must be similar to that earlier trade mark, and, (iv) there must be a resultant likelihood of confusion on the part of the public.

33. The first two of these conditions are clearly fulfilled in this case. The Opponent’s marks were registered as of 9 October, 2008 (Community Trade Mark Registration No. 007300064, MONTE-CARLO) and 21 August, 2007 (International Trade Mark No. 000948341, MONTE CARLO logo) and by virtue of Section 11(1)(b) of the Act, are earlier trade marks as against the present application for the purposes of Section 10. The goods and services of the application for registration are identical to the goods and services for which the Opponent’s earlier trade marks stand protected, as the specifications of goods of the Applicant’s mark and the Opponent’s MONTE-CARLO mark share “*Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats*” in Class 29 and the specifications of services of the Applicant’s mark and

the Opponent's MONTE CARLO logo mark share "*Services for providing food and drink*" in Class 43.

### **Comparison of the marks**

34. 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*)<sup>1</sup> 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.

35. As the Opponent's two earlier marks on which the opposition is based are different I have carried out two separate comparisons. Looking first at the Opponent's MONTE CARLO mark and the Applicant's mark, I find there is aural and visual similarity, which is confined to the words MONTE CARLO (I regard the fact that the term is hyphenated when used in the Opponent's mark as inconsequential). As these two words form the entirety of the Opponent's mark they are both the dominant and distinctive elements of that mark. The Opponent has argued that the MONTE CARLO element of the Applicant's mark is the dominant and distinctive element of that mark, but I do not agree.

36. I have opined in the past that the test I use as regards the identification of the dominant element of any mark is that "*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 Applicant's mark is a complex mark, there being much more to it than the words MONTE CARLO. These additional elements, in particular the fanciful "frying fish" and the blue circle background,

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<sup>1</sup> Paragraph 23 of decision dated 11 November, 1997

are significant, instantly noticeable and prominent to the extent that, in my opinion, the words MONTE CARLO cannot be said to dominate the mark.

37. With both marks sharing a common element, in such a way that the Opponent's mark is incorporated in its entirety in the Applicant's mark, it must be considered that there is some level of similarity. While MONTE-CARLO is not identical to THE MONTE CARLO, the presence of the definite article does little to dilute the level of similarity in any meaningful way. As regards quantifying the level of similarity I find the mark applied for shares a medium level of aural similarity and a low level of visual similarity with the Opponent's MONTE-CARLO mark.
38. Notwithstanding the shared verbal and visual elements, in my opinion, conceptually the marks share very little, if any, real similarity. Use of place-names is commonplace across all manner of food outlets (Italian, French, Chinese, Indian, etc.) in Ireland and consumers do not take it to mean that the goods and services being provided by those establishments are linked to enterprises in, or originate exclusively or directly from, the place whose name features in the restaurant's name. At best these establishments serve food cooked in a style associated with the place-name. In the present case the Applicant runs, what appears to be a very successful fast-food outlet or fish and chip shop, known colloquially as a "chipper". In Ireland the place-names used in the chipper business are predominantly Italian in nature, but not exclusively so, and reflect the strong association between that business and the Italian families that operate in it. Geographic names like Roma, Milano or Napoli are used even though one is highly unlikely to be able to order a single of chips, a spice burger and a battered sausage in restaurants in any of those cities.
39. So, in my opinion, the conceptual message that is clearly conveyed to Irish consumers, when they encounter the Applicant's mark, is that this is the trade mark of a chipper. It does not transmit any message that the undertaking that is using it is claiming a real link to the city of Monte Carlo. The inclusion of the geographic place-name Monte Carlo by the Applicant is wholly consistent with the normal practices of the trade, and will be viewed as such by Irish consumers.
40. The Opponent's mark consists exclusively of the name of the city Monte Carlo, which can only convey one message – a clear connection with that location. Therefore, overall, based

on the medium level of aural similarity, the low level of visual similarity and the conceptual dissimilarity, I find the marks to be dissimilar.

41. I turn now to the comparison between the mark applied for and the Opponent's MONTE CARLO logo mark. Again the shared element are the words MONTE CARLO though this time there are five other words in the Opponent's mark. These additional words are French, which may be understood by Irish consumers who have had an elementary exposure to that language, and if not understood would certainly be recognised as French. Many Irish consumers without any exposure to the French language would still understand the words to be French. The presence of these words is significant and leads me to conclude that there is a low level of aural similarity between the marks. Visually the marks are more dissimilar than similar and I would assess the level of visual similarity as very low.

42. I have already considered the conceptual meaning of the Applicant's mark. The message transmitted by the Opponent's MONTE CARLO logo mark to Irish consumers is that it is something to do with some French society in Monte Carlo, though those with exposure to French would understand the mark to depict a Monte Carlo based company of sea-bathing. Either way the concept is far removed from that of a chipper, and therefore, I am satisfied that there is no meaningful level of conceptual similarity between those two marks.

43. To sum up the results of my assessment of the verbal, visual and conceptual comparison of the respective marks, I find that, overall, the Applicant's mark and the Opponent's MONTE CARLO logo mark share a low level of aural and visual similarity, but no conceptual similarity. Overall, I find that the two marks are different.

### **Likelihood of confusion**

44. The question is whether that similarity 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 European Court of Justice<sup>2</sup> in this area and they include the following:

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<sup>2</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

- a. the more distinctive the earlier mark, the greater will be the likelihood of confusion,
- 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 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 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.
- g. a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa.

**Inherent distinctiveness of the earlier mark**

45. The Opponent's MONTE CARLO logo 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 those of other undertakings. In my opinion, the Opponent's MONTE-CARLO mark is less distinctive; being no more than the name of a European city in which many undertakings provide the services for which the mark is protected. Nonetheless, despite lacking a high level of inherent distinctiveness, when used in Ireland, it would have the capacity to function as a trade mark.

#### **Additional distinctiveness acquired through use**

46. In my opinion the evidence submitted to support a claim of additional distinctiveness acquired through use in Ireland is extremely weak. What was submitted in this regard is confined to a claim that approximately 700 nights were booked in the Opponent's hotels by Irish-based clients in the period 2004-2009, that claim been supported by an exhibit containing the clients' "Irish" addresses. I am inclined to give little value or weight to this evidence for a number of reasons. Firstly, most of the addresses are limited to a place-name, some of which are not even within the State (e.g. Leeds, Edinburgh). Secondly, it is impossible to extrapolate the actual number of Irish clients as the list is in respect of the number of nights booked, not the number of clients. Even taking a very generous view that these bookings all emanated from Irish clients and that each booking was for 1 night, a total of 700 individual bookings over a period of 5 years is an extremely low level of exposure to the Opponent's business by Irish consumers. In any event these are bookings for accommodation, which is not a service for which the Applicant is seeking protection for its mark. Thirdly, no inferences can be drawn that, because a client has booked a room in one of the Opponent's hotels, that the client making the booking or staying at the hotel was aware of the Opponent's trade marks. For example, if an Irish person booked or stayed in a room in the Opponent's Hôtel de Paris Monte-Carlo, would that person understand that the hotel was owned by the proprietor of the trade mark MONTE-CARLO, or would it be the case that the client would simply form the view that she was booking or staying in a room in the Hôtel de Paris, which is, as the name suggests, located in Monte Carlo; therefore recognising Monte Carlo as a geographical location and not as a trade mark at all. In my opinion, the latter is much more likely. Therefore, I am completely satisfied that the Opponent's marks have not acquired a level of additional distinctiveness, for the goods and services at issue, through use in the State, which would increase the likelihood of confusion.



### **Overall impression created by the marks**

47. The wording in the marks is different, the concept is different and, in my opinion, the figurative elements of the Applicant's mark are clearly distinctive components that reinforce significantly that difference. While the "Traditional Fish & Chips" element of the Applicant's mark is not distinctive (in respect of the goods and services for which protection is sought) it is informative and conveys a specific message to the consumer that will be readily understood and, therefore, is something that I cannot ignore. I think the overall impression created by the marks in question is that they are very different.

### **The average consumer**

48. The Opponent is the proprietor of a registered Community Trade Mark (the MONTE-CARLO mark). It stands protected and is entitled to a monopoly in Ireland, even though the mark may never be actually used in Ireland. So who is the average consumer? Is it an Irish-based person who may encounter the Applicant's mark in Monaghan, having already encountered the Opponent's marks in Monaco, or is it a non-Irish consumer who is very familiar with the Opponent's marks and, while visiting Ireland, chances upon the Applicant's mark? The answer is, that for the purposes of these proceedings, the average consumer must be considered to be an Irish-based as this State is the only territory in which both marks may be encountered.

49. While I have already found that the goods and services covered by the respective marks are similar, in reality, there is a world of difference between the level of quality of the goods and services as delivered by the Applicant and the Opponent. On the one hand there is the kind and standard of goods and services provided by a traditional fish and chip shop and, on the other, the type and quality of goods and services provided by a luxury 5-star resort. In this case, the term "average consumer" is very apt to describe users of the Applicant's goods and services (them being the average person on the street), who is looking for cheap fast-food. The "average consumer" of the Opponent's goods and services must be considered somewhat above average and would be far more discerning, and be demanding of exceptional levels of quality, outstanding service, luxury and extraordinary attention to detail. Looked at from that perspective, it is clear that Applicant and Opponent are at opposite ends of the spectrum in their delivery of food and restaurant services and appeal to very different consumers.

50. The Opponent is engaged in the luxury resort business in one of the most exclusive locations in the world and is the proprietor of trade marks incorporating the term MONTE CARLO, being the name of that exclusive location. The Irish public is very familiar with this term and would immediately understand it to be the geographical place-name of the city within the principality of Monaco. The city's reputation for being a playground for the rich-and-famous extends to Ireland and it is readily identified and associated with casinos, luxury hotels and restaurants, a world-famous grand prix and rally, and with the ruling Grimaldi family, especially the late Princess Grace.

51. However, while I have already stated that the Opponent's marks could, if used in Ireland, perform the function of a trade mark, no evidence (e.g. sales figures, marketing or advertising targeted at Irish consumers, statements or testimonials from Irish clients) has been submitted to suggest that the Opponent's marks have been used in Ireland. In fact the Opponent has admitted that its marks are not used in the State and, therefore I am satisfied that the average Irish consumer would not recognise the term Monte Carlo as the Opponent's trade mark.

**Likelihood of confusion**

52. On the one hand we have a chipper, selling traditional fish and chips and the like, and on the other, an undertaking running luxury resorts, comprising casinos and high-quality hotels, restaurants and spas; both of whom are using the term MONTE CARLO in their trade marks. The respective undertakings are not, in any way, competing with one another. The issue rests on whether it is likely that a consumer, who must be assumed to be already familiar with the goods and services sold under the Opponent's earlier trade marks, being exposed in a typical purchasing scenario to the goods or services bearing the mark applied for, is likely to be confused. Would he seriously entertain the thought that the goods or services he is purchasing are connected in some way with those goods or services that he has known previously under the Opponent's marks? Or on encountering the Applicant's mark would he be likely to attempt to order Caviar, Foie Gras, Filet Mignon and Crème Brûlée, to be washed down with a bottle of 2005 Chambertin Grand Cru, as he might have done when in one of the Opponent's establishments? In my opinion, there is no possibility that consumers would believe that the respective parties are linked economically in any way. Because of the differences in the respective marks, the different types of consumer of the respective marks, the extremely different purchasing

scenarios under which the consumer is likely to encounter them and the fact that the parties are not in competition with one another, I think that these questions must be answered in the negative.

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

53. 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 a Community trade mark, in the Community) 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.”*

54. 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 other 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(s) must have a reputation in the State (or in this case in the Community); thirdly, the use of the later trade mark must be without due cause; and fourthly, that use must take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier marks.

55. I have already found that there is a low level of similarity with the Opponent’s marks, but that the overall impression is that the marks are different. Also, I have found that the Opponent’s marks do not have a reputation in the State; but that is not a prerequisite for the purposes of Section 10(3), under which a reputation within the European Community (EU) is sufficient in respect of a Community Trade Mark (CTM). The plain meaning of Section 10(3) of the Act suggests that a CTM, which may not even be used in Ireland, and which may have a reputation in only one Member State of the Community, could be unfairly taken advantage of, or suffer detriment, when a similar mark is used in this State, despite the fact that consumers here may have no knowledge of the earlier mark or its reputation.

56. The onus is on the Opponent to prove its marks have the type reputation that Section 10(3) seeks to protect, but there is nothing in the evidence submitted by the Opponent by way of proof that consumers in the EU actually recognise Monte Carlo as a trade mark of repute, as distinct from the location of the Opponent's businesses. 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. 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 Opponent's reputation comes nowhere near that level and I must dismiss the opposition under Section 10(3).

57. Lest an appeal is lodged on foot of this finding, and for completeness, I will consider the other two conditions. In relation to due cause, the Applicant has established, since 1970, a brand under the Monte Carlo name in relation to food and related services. In my opinion, incorporating that brand into a new logo and seeking protection for it as a registered trade mark does not constitute an unusual or surprising course of action for such an undertaking, and, therefore, I am satisfied that the Applicant has due cause to use the mark.

58. No evidence or convincing argument had been adduced or advanced as to how the Applicant's use of its mark might take unfair advantage of or tarnish the reputation of the Opponent's marks. The Opponent claims that the applicant "*... seeks to confer on its business an up-market tone and to suggest that its goods and services are of the highest quality. In this way, the applicant is 'riding on the coat tails' of the Opponent's reputation for high quality. Furthermore, the Opponent has no connection or control over the goods and services of the Applicant. Hence, if these goods and services do not live up to the suggestion being made by the Applicant's mark of luxury and superior quality and the public are confused into believing that the parties are in fact linked economically in some way, then that will obviously reflect poorly on the Opponent and its businesses and cause obvious disadvantage and detriment to its goodwill and reputation. The Opponent is powerless to ensure that the business of the Applicant reaches the expectation created in the mind of a consumer on seeing the words 'MONTE CARLO' in use in that trade.*" These claims are unsubstantiated and fanciful to say the least. No evidence has been

advanced to suggest that the Applicant is seeking to do anything other than operate a fast-food outlet, in the similar manner to any other comparative Irish fast-food outlet.

59. The Opponent admits in its written submissions that “...*Monaco has no particular reputation from a gastronomic perspective with the fish and chips industry or indeed, with any of the other goods specified in the Application. The dish of fish & chips does not emanate from the Opponent’s resort or the Monaco area*”. This admission reinforces my opinion that the businesses of the parties are so far removed from each another that use of the Applicant’s mark would not result in the damage or unfair advantage that Section 10(3) seeks to avoid. Therefore, the opposition under that Section must fail on this account also.

**Section 10(4)(a) - use of mark is liable to be prevented by virtue of any rule of law**

60. The final ground of opposition that falls to be considered is under Section 10(4) of the Act, the relevant part of which reads as follows:

*“A trade mark shall not be registered if, or to the extent that, its use in the State is liable to be prevented – by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade,”*

61. I am satisfied that the determination of the objection under this Section requires consideration of whether, on 7 January, 2009 (the relevant date), the Opponent would have been able to establish the basic elements required to be shown to ground an action for passing-off if the Applicant had used the mark propounded for registration as a trade mark for any goods or services covered by the application. Adopting the test as enunciated by Lord Oliver in the House of Lords<sup>3</sup>, and expressing it in the terms of this case, the questions to be considered may be put in the following terms:

- (i) Did the Opponent have a goodwill or reputation attached to goods or services which it supplied in the mind of the purchasing public with the name MONTE CARLO?

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<sup>3</sup>In *Reckitt & Colman Products Ltd. v Borden Inc . & Ors.* [1990] RPC 406

(ii) If so, would the sale by the Applicant under the mark applied for of any goods or services covered by the application for registration have constituted a misrepresentation leading or likely to lead the public to believe that those goods were the goods of the Opponent?

(iii) If so, would the Opponent have suffered damage by reason of that erroneous belief?

62. In order to succeed in its opposition under this Section, the Opponent must establish that the use by the Applicant of the said mark in relation to the goods and services covered by the application would, as of the relevant date, have constituted a misrepresentation that those goods or services were the goods or services of the Opponent and that such misrepresentation would have caused damage to the Opponent.

63. The Opponent has admitted that it does not use its marks in Ireland but argues that the circumstances of the C&A Modes<sup>4</sup> case are repeated here, whereby the Supreme Court held that the Plaintiff, though not trading in the State, possessed a protectable goodwill in the State, by virtue of Irish citizens shopping at the Plaintiff's store in Belfast and on that basis the Plaintiff's mark was well-known. I do not accept that argument and I am totally satisfied that the Opponent does not have a reputation within the Irish consciousness that would require me to view the circumstances of these proceedings in the same light as those of C&A Modes. In the cited case the parties were in competition with one another, which is not repeated here, the average consumer was the same - again not repeated here, and the marks were similar – also not repeated here.

64. In the absence, as I have found, of any likelihood of confusion or association between the respective marks, I cannot see how there could be any misrepresentation as to the provenance of the Applicant's goods or services by virtue of the use of the said trade mark and nor is it conceivable that the Opponent could suffer loss or damage if the Applicant's mark were used in a normal and fair manner as a trade mark for those goods and services. The basic ingredients of an action for passing off have not been established and I do not believe, therefore, that the use by the Applicant of the mark propounded for registration would have been liable to be prevented by the law of passing off and I dismiss the opposition under Section 10(4) accordingly.

65. For these reasons, I have decided to dismiss the opposition and to allow the Applicant's mark to proceed to registration.

Dermot Doyle


Acting for the Controller

9 May, 2013

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<sup>4</sup> C&A Modes Limited v. C&A (Waterford) Limited [1978] F.S.R. 126

## ANNEX 1

<b>International Trade Mark No. 948341</b>	
Class 1	Chemicals used in industry, science, photography, agriculture, horticulture, silviculture; unprocessed artificial resins, unprocessed plastics; soil fertilizers; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.
Class 2	Paints, varnishes, lacquers; preservatives against rust and wood deterioration; dyestuffs; mordants; unprocessed natural resins; metal in foil and powder form for painters, decorators, printers and artists.
Class 3	Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.
Class 4	Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including petrol) and illuminants; candles and wicks for lighting purposes.
Class 5	Pharmaceutical and veterinary products; hygienic products for medicine; dietetic substances for medical use, food for babies; plasters, materials for dressings; materials for filling teeth and making dental impressions; disinfectants; products for destroying vermin; fungicides, herbicides.
Class 6	Common metals and their alloys; building materials of metal; transportable buildings of metal; materials of metal for railway tracks; non-electrical metal cables and wires; metal ironmongery and locksmithing articles; pipes of metal; strong boxes; goods of common metals not included in other classes; ores.
Class 7	Machines and machine tools; engines (excluding those for land vehicles); couplings and transmission components (excluding those for land vehicles); agricultural implements other than hand operated; egg incubators.
Class 8	Hand tools and implements (hand-operated); cutlery, forks and spoons; side arms, other than firearms; razors.
Class 9	Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), emergency (life-saving) and teaching apparatus and instruments; apparatus and instruments for conducting, distributing, converting, storing, regulating or controlling electric current; apparatus for recording, transmitting and reproducing sound or images; magnetic recording media, sound recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing and computer equipment; fire extinguishers.



Class 11	Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.
Class 12	Vehicles; apparatus for locomotion by land, air or water.
Class 13	Firearms; ammunition and projectiles; explosives; fireworks.
Class 14	Precious metals and their alloys and goods made of or coated with these materials not included in other classes; jewellery, bijouterie, precious stones; horological and chronometric instruments.
Class 15	Musical instruments.
Class 16	Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' supplies; paintbrushes; typewriters and office articles (except furniture); instructional or teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks.
Class 17	Rubber, gutta-percha, gum, asbestos, mica and goods made thereof not included in other classes; products made of semi-processed plastics; sealing, packing and insulating material; non-metallic flexible pipes.
Class 18	Leather and imitations thereof, goods made of these materials not included in other classes; animal skins, hides; trunks and suitcases; umbrellas, parasols and walking sticks; whips and saddlery.
Class 19	Nonmetallic building materials; nonmetallic rigid pipes for building; asphalt, pitch and bitumen; nonmetallic transportable buildings; nonmetallic monuments.
Class 20	Furniture, mirrors, frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum, substitutes for all these materials, or of plastics.
Class 21	Household or kitchen utensils and containers; combs and sponges; brushes (except paintbrushes); brush-making materials; cleaning equipment; steel wool; unworked or semi-worked glass (except for building glass); glassware, porcelain and earthenware not included in other classes.
Class 22	Ropes, strings, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except rubber or plastic materials); raw fibrous textiles.
Class 23	Yarns and threads, for textile use.
Class 24	Textiles and textile goods not included in other classes; bed and table covers.
Class 25	Clothing, footwear, headwear.
Class 26	Lace and embroidery, ribbons and braids; buttons, hooks and eyelets, pins and needles; artificial flowers.
Class 27	Carpets, mats, rugs, linoleum and other floor coverings; wall hangings (non-textile).

Class 28	Games, toys; gymnastics and sports goods not included in other classes; decorations for Christmas trees.
Class 29	Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruit and vegetables; jellies, jams, compotes; eggs, milk and dairy products; edible oils and fats.
Class 30	Coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes; flours and cereal preparations, bread, pastry and confectionery, edible ice; honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces (condiments); spices; ice for refreshment.
Class 31	Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; natural seeds, plants and flowers; animal feed, malt.
Class 32	Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages.
Class 33	Alcoholic beverages (excluding beer).
Class 34	Smokers' articles; matches.
Class 35	Advertising; business management; commercial administration; office functions.
Class 36	Insurance; financial affairs; monetary affairs; real estate business.
Class 37	Construction; repairs; installation services.
Class 38	Telecommunications.
Class 39	Transport; packing and storage of goods; travel arrangement.
Class 40	Treatment of materials.
Class 41	Education; training; entertainment; sports and cultural activities.
Class 42	Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software.
Class 43	Provision of food and drink in restaurants; temporary accommodation.