

**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. 250111 and in the matter of an Opposition thereto.

**IRISH WATER**

**Applicant**

**Dr. Eddie O’Gorman**

**Opponent**

**The Application**

1. On 4 December, 2012 (“the relevant date”), BORD GÁIS EIREANN, of Gasworks Road, Cork, Ireland made application (No. 2012/02099) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register IRISH WATER as a trade mark in respect of the following goods and services:

Class 6	Water pipes, water tanks, water valves all being of metal.
Class 9	Water meters, water level indicators, water level gauges, water level detection apparatus, water leakage detection alarms.
Class 11	Apparatus for filtering water, declassifying water, descaling water, apparatus for control of water supply, apparatus for purifying water, softening water, decontaminating water, apparatus for distribution of water, apparatus for supply of water for sanitary purposes, drinking water filters, drinking water supply apparatus, drinking water supply installations, pressurised water reserves, pressurised water tanks, regulation instruments for water supply, water pipes, water apparatus and installations, hot water sterilizers, water purifying units, water filtering units, water distilling units.
Class 16	Printed matter, publications, information leaflets.
Class 32	Water, bottled water, bottled drinking water, aerated water, carbonated water, mineral water, sparkling water, table water.
Class 35	Business, administration and promotional advertising services.
Class 37	Construction services relating to water supply mains and water pipes, cleaning of drains, cleaning of water cylinders, cleaning of water supply pipe work and water supply plumbing, cleaning of water tanks, installation, maintenance and repair of waterways and water installations, repair, maintenance of purifying apparatus and water pollution control equipment, water well drilling.
Class 39	Delivery, distribution and supply of water, public utilities in the nature of supplying water, public utility services in the nature of water distribution, services for the supply of water by pipeline, storage of water and reservoirs, storage of water in tanks, water distribution and supply.
Class 40	De-mineralisation of water, desalination of water, disposal of waste water for industrial processes, purification of industrial waste water, regeneration of water, rental of water filters, rental of water filtration units for commercial use, rental of water purifying apparatus, rental of water treatment equipment, treatment of waste water, treatment of water, waste and/or water treatment services, waste water reprocessing, water pollution control, water purification, water treatment.
Class 41	Educational services in relation to water, water management, water pollution, water safety, providing courses in the field of water management.
Class 42	Analysis of water, digital water marking, water quality control services

2. The application was subsequently assigned to Irish Water, of Colvill House, 24-26 Talbot Street, Dublin 1, Ireland by virtue of a Deed of Assignment dated 17 February, 2014.
3. During the examination of the application the Examiner raised, and subsequently maintained, objections to the application and indicated her intention to refuse the application, following which the Applicant sought a Hearing of the matter. The Applicant was heard and the Hearing Officer accepted the application for all goods and services in Classes 6, 9, 11, 16, 35, 37, 39, 40, 41 and 42, but refused the application in respect of all goods in Class 32. The application was advertised accordingly under number 250111 in Journal No. 2252 dated 9 April, 2014.
4. Notice of Opposition to the registration of the mark, pursuant to Section 43 of the Act, was filed on 2 July, 2014 by Dr. Eddie O’Gorman of Salmon IP, Ormonde House, 10 Ormonde Road, Kilkenny, Ireland. The Applicant filed a counter-statement on 8 July, 2014 and evidence was then filed under Rules 20 and 21 of the Trade Mark Rules, 1996 (“the Rules”). The Applicant attended a Hearing of the matter on 12 January, 2016.
5. 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 and service in Classes 6, 9, 11, 37, 39, 40, 41 and 42. I dismissed the opposition in respect of all goods and services in Classes 16 and 35, and accordingly allowed the application to proceed to registration for *printed matter, publications and information leaflets, and business, administration and promotional advertising services*. The parties were informed of my decision by way of letter dated 16 February, 2016. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Opponent in that regard pursuant to Rule 27(2) of the Rules.

### **Grounds of the Opposition**

6. In his Notice of Opposition the Opponent raises objections to the present application on the grounds that the mark applied for is incapable of distinguishing the goods and services of Irish Water from companies who are or will provide Irish water related services. He states there is no device or logo to satisfy this requirement, so it cannot even be described as a “fig leaf” trade mark. Hence, the mark must be refused under Section 8(1)(a) - the sign is not a trade mark, and Section 8(1)(b) – the sign is devoid of any distinctive character.

7. The Opponent also claims the application offends against Section 8(1)(c) as the mark IRISH WATER is descriptive of the goods and services offered. The mark designates the kind of product (Irish water or simply water) and the geographical origin of the water being Ireland, or Irish.
8. The Opponent notes the Act provides that a trade mark shall not be refused registration by virtue of paragraphs (b), (c) or (d) of subsection (1) of Section 8 if, before the date of application for registration, it has in fact acquired distinctive character as a result of the use made of it. But, in this case, the date of application is 4 December 2012, and at that date the mark was owned by a gas supply company called BORD GÁIS EIREANN, which had nothing to do with water and no services were being offered by them on that date.
9. The Opponent then makes reference to trade mark case law, which I need not refer to here and concluded his Notice of Opposition by claiming the registration of the applied for mark would prohibit other traders from being able to describe their goods and services as Irish water products, which would be an anti-competitive advantage for the Applicant.

### **Counter-Statement**

10. In its Counter Statement the Applicant denies all the grounds of opposition based on Sections 6 and 8 of the Act. The Applicant confirms the mark IRISH WATER has been used in Ireland and has established notoriety and recognition in the mind of the public. As such, the Applicant claims the proviso of Section 8 of the Act can be availed of.
11. The Applicant points out the basis of the opposition filed by the Opponent – objections under Sections 6 and 8 of the Act – were previously raised at examination by the Patents Office. A decision, dated 6 March 2014, on these issues has already been issued by a Hearing Officer of the Patents Office which overturned the objections raised under Sections 6 and 8 of the Act and found that the mark IRISH WATER met the requirements for registration for the goods and services as advertised under Application No. 250111.
12. The Applicant denies that registration of the mark would be anti-competitive or unjust, because no other proprietor could legitimately wish to use the mark IRISH WATER for the goods and services applied for and concludes its Counter Statement by claiming the opposition filed by the Opponent is frivolous and vexatious.

## Rule 20 Evidence

13. In his evidence under Rule 20 Dr. O’Gorman repeats much of what he said in his Notice of Opposition. He then goes on to address the Applicant’s claim of an entitlement to avail of the proviso in Section 8 of the Act regarding distinctiveness acquired through use of the mark. He points out the date of application is 4 December 2012, yet in an extract from the final Oireachtas Report of June 2013 on the setting up of an Irish Water utility company. Paragraph 1.16 of that report is headed “*Branding of New Irish Water Utility*” and states “*Rather than embarking on an expensive branding exercise, the branding should be the quality of the service it delivers. Any costs of branding the new Irish water utility must be kept to a minimum.*” There is a footnote to this paragraph which reads “*Recommendation No. 1.1.4 also refers, i.e. renaming Irish Water as Uisce Éireann. As the utility has not yet been established this renaming proposal is cost-neutral.*”
14. He also provides an extract from the same report, where at page 23 the authors have this to say:

*“The Joint Committee notes that, to date, the new Irish water utility has been referred to as ‘Irish Water’. In regard to this, the Joint Committee recommends, as a matter of principal and in accordance with Irish being the first official language of Ireland, that the new utility should be known as Uisce Éireann. In this context, the Joint Committee notes the Minister for Communications, Energy and Natural Resources agreed with this practice in a reply to a parliamentary question on 29 November 2011:*

*“If, however, there are good reasons to establish a new State agency or commercial entity, I am happy to agree with the Deputy that we should select a suitable name as Gaeilge which would be the brand under which the new company would trade”.*

15. Dr. O’Gorman claims no reputation had been acquired as, by the Irish Government’s own admission, the proposed Irish Water Utility company had not started trading, and it was actually agreed to name the company Uisce Éireann.
16. Dr. O’Gorman then refers to a couple of well-known cases (Baby Dry and Doublemint) and claims the questions at issue in those cases are repeated in the instant case. He then provides extracts from the website of intellectual property firm Tomkins & Co. (agents for the Applicant) regarding the registrability of trade marks and guidance on what are the best trade marks. Regarding the use of geographical names Tomkins & Co. warn as follows:

*Geographical names are also difficult to protect particularly if the geographical area is already renowned for producing the goods/services you intend to offer under the trade mark that includes the geographical name. If that is the case, it is generally argued that no one party should be entitled to claim exclusive rights to the use of the particular geographical name. To register a geographical name as a Trade Mark, it is generally necessary to prove a substantive period of exclusive use of the name in relation to the goods/services of interest. To increase the chances of obtaining trade mark protection for a mark including a geographical name, the name could, for example, be combined with another word so that the combination loses its geographical meaning such as KERRYGOLD®.*

## **Rule 21 Evidence**

17. Evidence submitted by the Applicant under Rule 21 consists of a Statutory Declaration, dated 2 April, 2015 of Paul O'Donoghue, Head of Customer Operations of Irish Water and 22 exhibits marked "1" to "22".
  
18. Having provided details of the application Mr. O'Donoghue then claims the opposition must be treated as having been abandoned as the Opponent did not file his evidence by way of a Statutory Declaration as required under Rule 20(1) of the Rules. He attaches at Exhibit "1" a copy of the "Statutory Declaration" the Opponent forwarded to the Applicant, which indeed is neither signed nor notarised. However, the evidence filed with the Controller was signed and notarised and is in all material respects identical to that which was forwarded to the Applicant, save that the version the Applicant received was not properly endorsed. While this is not ideal, nonetheless the Applicant did file his evidence by way of a Statutory Declaration and I am happy to look on this as nothing more than a copying error that does not, in any way, disadvantage or hinder the Applicant.
  
19. Mr. O'Donoghue states that Irish Water was established as a company by legislation under the Water Services Act, 2013 a copy of which he attaches at Exhibit "2". Part 2, Section 5(1) of that act states:

*"The subsidiary shall be known, in the Irish language, as Uisce Éireann and, in the English language, as Irish Water."*

He states the act also amended the Water Services Act, 2007 as follows:

*The Act of 2007 is amended—*

- (a) in section 6, by the substitution of "water services authority, Bord Gáis Éireann, Irish Water" for "water services authority" in each place that it occurs, and*
- (b) in section 7, by the substitution of "water services authority, Bord Gáis Éireann, Irish Water" for "water services authority".*

He states the adoption of the brand / trade mark IRISH WATER is by way of Government legislation.

20. Mr. O'Donoghue states there have been extensive discussion, debate, promotion and media coverage of Irish water and its activities under the trade mark IRISH WATER over a significant period of time. The trade mark IRISH WATER is now ingrained in the mind of the Irish consumer as a reference to a water utility company and the associated goods and services provided by such a company. It is highly unlikely that any person within Ireland has not heard of Irish Water and the use of the trade mark IRISH WATER. As such the trade mark has acquired a significant level of distinctiveness through use.

21. In support of these claims he attached a number of exhibits. Exhibit "3" contains an article from the website [www.edie.net](http://www.edie.net) dated 17 January 2012 announcing a six-week public consultation on reform of the Irish water sector, with the proposed plans including the establishment of new public utility company "Irish Water". Exhibit "4" comprises the Department of Environment, Community and Local Government "position paper" on the "*Reform of the Water Sector in Ireland*" dated January 2012, including the proposed establishment of a public water utility "Irish Water" and recommendations regarding its model, funding and functions. Attached at Exhibit "5" is an article from the Irish Times newspaper dated 17 April, 2012 in the form of a "Questions & Answers" piece concerning Irish Water, its establishment, water metering and related matters. Exhibit "6" contains several articles from leading Irish publications, dated between 12 October 2012 and 29 January 2013, discussing various aspects of Irish Water. Mr. O'Donoghue claims that in each of these articles IRISH WATER is used in a definitive rather than a descriptive sense. This demonstrates, firstly, the Irish media have a clear understanding that the trade mark IRISH WATER is indicative of a trader of goods and services and, secondly, by reading the numerous articles, the public has also been educated so as to share the same understanding.

22. Mr. O'Donoghue notes these articles contain mention of Irish Water's responsibility for administration services such as "water charges" and "sending bills". They describe Irish Water as "the State's national water company", a "utility" and discuss Irish Water's installation of "water meters". They highlight the very controversial issue of increased water charges which is relevant to every household and business in the country. This would

command the attention of every reader, who would note the name of the utility company in question – Irish Water, which appears many times in the said articles. The articles also refer to the appointment of senior positions at Irish Water, which the general readership would also note with interest.

23. He attaches at Exhibit “7” a notification dated 5 November, 2012 highlighting the discussion of the establishment and future governance of Uisce Éireann by the Oireachtas Joint Committee on the Environment, Culture and the Gaeltacht at its meeting to be held the following day.
24. The evidence Mr. O’Donoghue attaches at Exhibits “8” and “9” contain copies of various media coverage, while Exhibit “10” contains a copy of an information leaflet delivered to every household in the country regarding the impending establishment of Irish Water and the implications for water consumers. It appears all of the material in these 3 exhibits post-dates the relevant date and I will return to these later.
25. Exhibit “11” consists of a copy of an invoice for the printing and packaging of the information leaflet referred to under Exhibit “10”. Exhibit “12” is an invoice from An Post in respect of delivery charges for the 2,000,000 leaflets it distributed. In total nearly €300,000 was expended by the Applicant on this leaflet campaign.
26. Exhibit “13” contains sample media coverage of Irish Water on three specific days - 10 January 2014, 3 June 2014 and 2 December 2014, being representative of the significant volume of ongoing media coverage of Irish Water.
27. Exhibit “14” contains copies of a “Date Reminder” advertisement campaign, dated 20 August 2014, in various print media reminding householders of the extended deadline (first extended to 31<sup>st</sup> October 2014, then extended to 30<sup>th</sup> November 2014) in which to apply for allowances.
28. Exhibit “15” contains copies of sample radio and television advertisements broadcast between 4 October 2014 and 30 November 2014.
29. Exhibit “16” consists of a copy of the Irish Water application pack and application form sent to all households in the country. Mr. O’Donoghue states that up to 10 December 2014 over 940,000 application forms were completed.

30. Mr. O'Donoghue states that up to December 2014, 530,000 water meters were installed in Ireland. For every installation the householder was issued with two booklets. He attaches at Exhibit "17" copies of the two booklets. Exhibit "18" contains a copy of a local media advertisement and a media plan detailing the local media and press in which such advertisements were placed.
31. He gives details of Irish Water's involvement in the Green Schools Project and attaches at Exhibit "19" a copy of a booklet, which features Irish Water, issued in connection with that project.
32. He mentions that between January 2014 and December 2014 there have been 1,513,447 sessions on the Irish Water website and 988,139 users and, over the same period, 505,440 mentions of Irish Water on social media sites (over 90% of which were on Twitter or Facebook).
33. Mr. O'Donoghue states that through the extensive promotion of Irish Water, media coverage and the ongoing activities of Irish Water, there has been a significant level of recognition of the trade mark IRISH WATER by consumers in Ireland. He attaches at exhibit "20" a printout of the results of a survey undertaken for Irish Water by Behaviour and Attitudes showing the "*Prompted level of awareness of Irish Water*" at 59% in August 2012.
34. Mr. O'Donoghue says the application was objected to on absolute grounds under Sections 6 and 8 of the Act at examination stage by the Patents Office. The matter went on to an oral hearing and a Senior Examiner, acting as Hearing Officer, waived the official objections in their entirety in respect of the goods and services for which the trade mark IRISH WATER was published in the Official Journal. He attaches at Exhibit "21" a copy of the written grounds of the Hearing Officer's decision.
35. Mr. O'Donoghue concludes his evidence by stating the Applicant also applied to register the trade mark UISCE ÉIREANN and that that mark was registered for the same goods and services for which Application No. 250111 seeks registration. The term UISCE ÉIREANN is Irish for Irish Water and as Ireland is a dual language jurisdiction, it would be inequitable to refuse registration of an application for the mark IRISH WATER when the identical Irish equivalent, UISCE ÉIREANN, has been accepted. He attaches at Exhibit "22" an extract from the Irish Trade Mark Register for the registered trade mark UISCE ÉIREANN.



36. The Opponent submitted material in reply to the Applicant's evidence, but this was not done by way of a Statutory Declaration and was deemed inadmissible. The Opponent was given ample time to correct the matter and to present the material in the form of a Statutory Declaration but declined to do so.
37. Following the completion of the evidence filing stage the parties were requested to elect either to attend at a hearing or file written submissions in lieu of attending at a hearing. The Applicant elected to attend at a hearing, while the Opponent chose to file written submissions.
38. The Opponent subsequently notified the Office that he had nothing more to add to his opposition and therefore did not file any written submission.
39. Having notified the parties of the date of the Hearing the Opponent argued that it would only be fair for him to be allowed to attend. The Applicant objected to this on the basis the Opponent had fair opportunity to attend the hearing but chose to file written submissions, but thereafter chose not to file any submissions. The Applicant argued the Opponent's lack of response in this matter should not be rewarded by leave to attend the hearing.
40. Having considered the Opponent's request and the Applicant's objections the Controller was satisfied that it was proper for the Opponent to be allowed to attend the Hearing, and that in doing so the Opponent was being afforded one chance, and one chance only, to state his case. However, this became a non-issue as a few days before the Hearing the Opponent informed the Office that he would not now be attending the Hearing.
41. Prior to the Hearing, and in accordance with the Rules, the Applicant advised the Controller that it intended to refer to three specific documents at the Hearing; those being (i) Bunreacht na hÉireann, (ii) The Water Services Act, 2013 and (iii) The Official Languages Act, 2003.

### **The Hearing**

42. At the Hearing the Applicant was represented by Simon Gray, Trade Mark Attorney of Tomkins & Co.
43. Mr. Gray delivered a very comprehensive oral submission that addressed all the relevant issues and contained many arguments. I do not find it necessary to mention or deal with every point Mr. Gray made, but I have given due consideration to each and every one. What I write below addresses what I consider to be the key elements of the case.

44. Mr. Gray began his submissions by claiming the Opponent had failed to substantiate the Opposition in any way. The Opponent failed to file evidence under Rule 22 and having indicated his desire to file written submissions under Rule 25 failed to do so. Furthermore, having sought and been granted leave to attend the Hearing, the Opponent failed to appear before the Hearing Officer. The Opponent's behaviour has resulted in increased work and costs for the Applicant.
45. While I find the Opponent's engagement with the process was haphazard and piecemeal, nonetheless, he met the minimum requirements by setting out clearly the grounds of his opposition and furnishing evidence at Rule 20 stage. The Applicant may have been somewhat disconcerted or even frustrated by the Opponent and his intermittent approach to the proceedings, but these have no bearing on the substantive issue and are matters to be addressed should an application for an award of costs be made.
46. Before turning to the grounds of the opposition I will deal with two arguments raised by Mr. Gray, one being that the Controller has already considered the application on precisely the same grounds as the Opponent has raised and accepted the mark, and the other that the Applicant has successfully registered the mark UISCE ÉIREANN (the Irish language version of IRISH WATER) under No. 250113 for the identical goods and services to those for which registration of IRISH WATER is being sought.
47. Mr. Gray pointed out that during the examination of the application official objections were raised by the Examiner on absolute grounds covering the principal basis of the present opposition. The matter was adjudicated before an oral hearing and the decision of the Hearing Officer was to waive the official objections, raised on absolute grounds, in respect of the goods and services for which the opposed mark has been accepted. He argued that this precedence of the Controller should apply. The Controller has already considered the application on precisely the same grounds raised by the Opponent, albeit in ex-parte proceedings, and found the mark worthy of acceptance. It is unfair to the Applicant to have to defend its application a second time on matters that were already decided by the Controller. To refuse the application on foot of these opposition proceedings and to rule contrary to the Hearing Officer's earlier decision would be unjustifiable and inequitable to the Applicant and is a decision that should not be taken lightly.
48. It is the case that the Controller has already considered whether the application offended against Section 8(1) of the Act and, having done so, then accepted it for publication.

However, these proceedings are not the second time the matter is being decided by the Controller, they are the third. During the examination stage the Examiner refused to accept the mark. It is the practice of the Controller that all decisions by Examiners to refuse applications must be endorsed by a Senior Examiner, and the Applicant be given an opportunity to be heard prior to the confirmation of any refusal. This is what happened with the present application. The Applicant exercised its right to be heard and the hearing was presided over by a Hearing Officer who had no part in the original decision to refuse the application. The Hearing Officer looked at the matter afresh and allowed the application for certain of the goods and services and reached his conclusions for the reasons stated in the written grounds of his decision.

49. The decision of the Hearing Officer in the earlier hearing was taken having heard the Applicant alone. I am not suggesting the Hearing Officer was wrong, lenient or unduly gave the Applicant the benefit of the doubt in reaching his conclusions in the earlier decision. That decision was made on the balance of probability and it may well have been a knife-edge decision for the Hearing Officer who dealt with the case. Also, and again I am not suggesting it was a factor, the Hearing Officer may have decided that the matter was so finely balanced that, on balance, it was best to accept the mark and rely on the safety net that is the opening of a three-month period for third parties to oppose.
50. What is clear, however, is the Hearing Officer did not follow the precedent established by the Examiner's earlier decision, which was endorsed by a Senior Examiner, and was not guided or influenced by it. There would not be any hearings if the Controller was to adopt a practise that all decisions to refuse applications are final and they establish precedents that cannot be ignored or overturned. Hearing Officers must reach their conclusion untrammelled by earlier decisions of the Controller. Therefore I am obliged to consider this matter afresh, without paying any heed to whatever decisions were made heretofore. Also, these opposition proceedings occur at a different point in the process and are initiated by third parties whose evidence and arguments must be taken into account. Therefore, in deciding this matter, I am satisfied that due process is being served and that the decision laid down cannot be considered to be unjustified or inequitable to the Applicant.
51. Turning now to the issue of the registered trade mark UISCE ÉIREANN. Mr. Gray pointed out that, under Article 8 of Bunreacht na hÉireann, Irish is the national language while English is also a recognised language. The Official Languages Act 2003 provides that any

government body may use either of the official languages of the State. The Act specifically refers to the Patents Office as one of the Government bodies covered by this Act. Furthermore, the Water Services Act 2013 at Section 5(1) states: “*This subsidiary shall be known, in the Irish language, as Uisce Éireann and, in the English language, as Irish Water*”. Therefore the terms UISCE ÉIREANN and IRISH WATER are interchangeable.

52. Mr. Gray also directed me to a decision<sup>1</sup> of Hardiman J in the Supreme Court wherein she found as follows:

*“It is not possible (at least in the absence of law of the type envisaged in Article 8.3) to exclude Irish, which is the national language and at the same time the first official language of the State, from any part of the public discourse of the nation or from any official business of the State or from the official business of any of its members. Nor is it possible in these contexts to treat it in a manner which is less favourable than the way in which the second official language is treated. Neither is it possible to prevent those who are capable and desirous of using Irish in making their case or in communicating from so doing or to disadvantage them when so doing in any national or official context.”*

He argued that one official language cannot be given preference over another official language of the State. As such the Patents Office has accepted and registered the mark UISCE ÉIREANN for the identical goods and services for which registration is being sought for the mark IRISH WATER (the English version of the mark as recognised by legislation) and it would be unjust to refuse to register it.

53. In my opinion, this is not a case of one official language being given preference over another. The UISCE ÉIREANN mark was treated in exactly the same fashion by the Controller as the IRISH WATER mark. The marks were treated in full compliance with the legislation and the long-established practices and procedures of the Office. Both marks were examined, initially refused, became the subject of ex-party hearings, were then accepted, published and laid before the public to allow for possible opposition. The fact is that no-one opposed the registration of the Irish language version of the mark, whereas the English version was opposed. The Controller cannot refuse to determine an opposition before him, nor have his hands tied regarding the outcome of an opposition, on the basis that the Irish language version of the mark at issue was registered without opposition. Accordingly, I find this argument is unsustainable and of no assistance regarding the matters at hand.

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<sup>1</sup> Ó’Beoláin v Fahy [2001] 21. R. 279

## Section 6(1)

54. Turning to the specific grounds of opposition, Mr. Gray argued that the basis for opposition raised under Section 6(1) is incorrectly raised and is not applicable to the present application. Section 6(1), which is written in the following terms “*In this Act a ‘trade mark’ means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings*”, sets out three requirements to be established in order to overcome an opposition on this basis. The trade mark IRISH WATER meets these requirements as it is clearly a sign, is by its nature represented graphically and is capable of distinguishing goods and services of one undertaking from those of others.

55. I have no hesitation in expressing my full agreement with Mr. Gray that the mark at issue meets the first two requirements. However, it is not possible to consider whether or not applications fall foul of Section 6(1) without first determining the full scope of that provision. In particular, it must be ascertained whether objections under Section 6(1) must be considered in relation to the goods and services for which the sign is seeking registration, or whether it is to be considered only in relation to the graphical representation of the sign and its capacity to distinguish, in isolation from any consideration of the goods and services applied for.

56. Mr. Gray directed me to a number of cases, which confirm the essential function of a trade mark is to act as a guarantee of origin. He also pointed to Kerlys<sup>2</sup>, but none of the referred to authorities address the role the actual goods or services play, if any, in reaching a determination as regards the correct interpretation of the term “*capable of distinguishing*”.

57. There is little case law on the subject, but what there is suggests that the answer to this fundamental question is that Section 6(1) objections are to be considered in relation to the goods and services for which registration is sought. The UK Courts have considered the correct test for the refusal of applications under the UK equivalent to Section 6(1) where, in *Jeryl Lynn*<sup>3</sup>, Laddie J stated:

*“If a ‘mark’ has no capacity to serve this primary distinguishing function then it would attract objection under section 3(1)(a)<sup>4</sup>. The often quoted example of this would be the word ‘soap’ sought to be registered for ‘soap’. The ‘mark’ applied for is nothing more than the common name for the goods; such a ‘mark’ has no capacity to serve the essential function of a trade mark, no matter how much ‘use’ has been made of it.”*

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<sup>2</sup> Kerly’s Law of Trade Marks and Trade Names 15<sup>th</sup> Edition paragraph 2-101

<sup>3</sup> [2000] ETMR 75

58. That particular case is interesting in that, at first sight, it may appear that an objection to “soap” for “soap” is proper to Sections 8(1)(b) and/or (c) and not Section 8(1)(a), which concerns the failure to meet the definition of a trade mark as set out in Section 6(1). If so, an applicant would have the right to try and overcome the objections by claiming distinctiveness acquired through use. But Laddie J. confirms that in such obvious cases (i.e. “soap” for “soap”) the Applicant should be denied any opportunity to claim distinctiveness acquired through use, no matter how much ‘use’ has been made of the sign. Therefore, no conclusion can be drawn other than that the goods and services applied for must be taken into account when considering the registrability of an application under Section 6(1).

59. In applying this principle to the application at issue I am satisfied that none of the goods or services applied for can reasonably be described as “Irish water”. Therefore, I find that, in relation to the ground of opposition centred on Section 6(1) of the Act, the sign IRISH WATER meets the three requirements of that section in respect of all the goods and services for which the mark was accepted and published. Accordingly, I dismiss the opposition based on this ground.

#### **Sections 8(1)(b)**

60. Mr. Gray based his arguments under Section 8 on the following three factors:

- (i) Objections must be taken in the context of the goods and services for which registration has been sought;
- (ii) The relevant public or average consumer to whom the goods and services are addressed to must be taken into account;
- (iii) The need to keep free a mark for other undertakings must be considered.

61. He argued the Opponent made a blanket claim under this section and did not relate his objection to the actual goods and services. The Opponent refers to water as the good against which to consider the mark IRISH WATER. However, the mark has not been accepted for water itself or any form of beverage in Class 32. In relation to (i) above he referred me to the CJEU’s finding in *EASYBANK*<sup>5</sup> wherein the Court ruled “*The absolute grounds for refusal set out in Article 7(1) of Regulation No 40/94 may be assessed only in relation to the services for which registration of the sign is applied for*”.

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<sup>4</sup> The UK equivalent to Section 8(1)(a) of our Act

<sup>5</sup> Case T-87/00, Bank für Arbeit und Wirtschaft AG v OHIM

62. He also pointed to three CJEU joined cases<sup>6</sup> wherein the Court partially annulled decisions by the Office for Harmonisation in the Internal Market (OHIM) to register 3 marks because of OHIM's incorrect blanket approach to the assessment of whether the marks were contrary to Article 7(1)(b) and (c) of the Trade Mark Directive, without giving adequate consideration to each of the goods and services for which the 3 marks were applied for.
63. These cases were in respect of blanket decisions taken by a competent authority that did not recognise or appreciate that there were some goods within certain classes for which it was not correct to refuse registration. The cases did not concern the approach adopted by an opponent in setting out its grounds for opposition. The Opponent may have adopted a blanket approach to all goods and services but there can be no doubt that he has clearly stated his grounds of opposition. They are clear to me and, in my opinion, the Applicant had no difficulty discerning the basis of the Opponent's case.
64. Mr. Gray argued that it cannot be considered that the average, well-informed and circumspect consumer would be incapable of distinguishing the goods and services in the Classes applied for from those of other undertakings under the mark IRISH WATER. The mark may be considered to have a direct reference to water per se, but the goods and services in these Classes are not beverages, liquids or any form of water product itself. He then walked me through each of the Classes in turn noting the mark IRISH WATER is not a direct reference to any of these goods and services and that the mark has the necessary level of distinctive character to be registered for each of the goods and services listed, and would be seen by the average consumer as having the capacity to act as a trade mark.
65. He then urged me to consider the registrability of the mark IRISH WATER in the context of each specified good and service, pointing out the Court of Justice of the European Union (CJEU) has this to say at paragraph 38 in *BVBA Management, Training en Consultancy v Benelux Merkenbureau*<sup>7</sup>:

*“The Directive must be interpreted as meaning that, when refusing registration of a trade mark, the competent authority is required to state in its decision its conclusion for each of the individual goods and services specified in the application for registration, regardless of the manner in which that application was formulated.”*

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<sup>6</sup> Joined Cases T-355/00, T-356/00 and T-358/00 Daimler Chrysler v OHIM

<sup>7</sup> Case C-239/05

66. On foot of this finding by the CJEU Mr. Gray argued the Opponent had failed to satisfy the basis for opposition raised under Section 8 as he did not relate the opposition filed to the specific goods and services for which the opposed mark was accepted. In all materials filed the Opponent erred in referencing the opposed mark to water and by association beverages; goods for which the present mark was not accepted. He claimed the Opponent is required and expected to provide a detailed reasoning as to why the opposition should be deemed justifiable in respect of each good and service.

67. I disagree. The finding of the Court mentioned above is clearly directed towards competent authorities, who are charged with deciding matters. There is no mention of, and nor can it be inferred that, the Court found that an Opponent who raises opposition under Section 8(1) must address each and every good or service on an individual basis and provide evidence or argument as to why that good or service offends against that particular section of the Act.

68. Furthermore, despite Mr. Gray's urgings that I am obliged to follow the CJEU finding quoted above, I am satisfied that, if the circumstances of a particular case warrant it, I do not have to address each and every good and service individually. This is absolutely clear from the very next line of the same paragraph (38) of that CJEU judgment quoted by Mr. Gray where the Court added the following qualification:

*"However, where the same ground of refusal is given for a category or group of goods or services, the competent authority may use only general reasoning for all of the goods or services concerned."*

69. Mr. Gray argued that another issue to consider in respect of the goods and services applied for is the market sector to which these goods and services are addressed. He argued, in the present case, the goods and services to which the mark will be applied are goods and services that consumers have not previously had to consider as a product or service to be purchased. Going forward, consumers must purchase these goods and services from the Applicant, and this in itself has generated sufficient attention and focus of the consumer on the goods and services under the mark IRISH WATER so that the marketplace for these goods and services is one in which the opposed mark has the necessary notoriety and capacity to distinguish the goods and services of the Applicant from those of other parties.

70. This is an unsustainable argument. It suggests that heretofore there has not been a market in Ireland for the goods and services specified in the application and that consumers must, from



here on, purchase these goods and services only from the Applicant. In my opinion, there already exists, in the State, both suppliers and consumers for each and every good and service mentioned, from the opening “*water pipes*” to the concluding “*water quality control services*”. The fact that the Applicant is a new entrant to the marketplace and that most households in the State will, after the date of application, have their water supplied by the Applicant is irrelevant.

71. Mr. Gray then addressed the Opponent’s claim that there is a need to keep the term IRISH WATER free for others to use and argued why there is no need to keep the mark free for others to use. The respective positions of the parties on the “need to keep free” argument have no direct bearing on my decision and, in my opinion, I need not consider the “need to keep free” argument in its own right. The “need to keep free” is not specified in the Act as a ground upon which to refuse an application. Keeping the mark free for use by others is merely a consequence of refusing the registration of a mark in accordance with the strict provisions of Section 8(1) of the Act and thereby ensuring that an unjustified monopoly is not granted.
72. Mr. Gray then referred to four “additional tests” and three “general guidelines” that, in his opinion, should be considered in the analysis of the application at issue. He provided answers to these tests and opinion on the how the guidelines should be interpreted, though he did not identify the authorities from where these tests and guidelines originated, and therefore I must treat them as nothing other than argument and opinion.
73. Section 8(1)(b) prohibits the registration of marks that are devoid of distinctive character. Unlike sections 8(1)(c) and (d), it does not give any clear definition as to the nature of the objection. It is concerned with the prohibition on registering marks which, while not offending against the specific parameters set out in sections 8(1)(c) and (d), nonetheless still do not fulfil the essential function of a trade mark. That is, they do not identify goods and services of one undertaking from those of another. Therefore Section 8(1)(b) has separate and independent scope from sections 8(1)(c) & (d).
74. The determination of whether a mark is devoid of distinctive character must be conducted with regard to the goods and services at issue and with regard to the relevant class of person to whom the goods and services are directed. While ultimately the assessment must be

conducted on a global basis it can be of assistance to examine the different elements that make up a composite mark.

75. In its totality the term IRISH WATER is readily understood to mean water from Ireland or water found in Ireland, be it from Irish rivers, lakes, reservoirs, coastal regions, underground springs and wells, water courses, as well as water that is sourced, drilled, piped or bottled in Ireland, or precipitation that falls in Ireland.

76. The mark comprises two words, the first of which does not possess a scintilla of distinctiveness. It is inherently nothing more than a geographic indication. In my opinion, the word WATER does not possess any degree of inherent distinctiveness in relation to water related products or services. Nor does the sum of the combined terms IRISH and WATER bestow upon the mark any level of inherent distinctive that is greater than the sum of its two parts.

77. I have assessed each good and service individually and have not identified any within Classes 6, 9, 11, 37, 39, 40, 41 and 42 that could possibly be considered to be non-water related. Some services may, in general terms, be considered to be non-water related, for example, “construction services” in Class 37 and “education services” in Class 41. However, the description of both of these services in the application contains the specific qualification and limitation that the services are “related to water” or “in relation to water” and nothing else. I find the mark is devoid of inherent distinctiveness and cannot act as a badge of origin for the goods and services applied for. It cannot perform the essential function of a trade mark in respect of any of the goods and services which are all (Irish) water related and, therefore, the application must be refused.

78. Having found the mark is not capable of acting as a source indicator for the goods and services for which registration is sought, I need not consider any of the other grounds of opposition. However, for the sake of completeness and, lest on appeal the Court finds I have erred in reaching my determination, I will do so.

**Section 8(1)(c)**

79. The provisions of Section 8(1)(c) are written in the following terms:

*8. (1) The following shall not be registered as trade marks:*

...

*(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services;*

80. At the hearing Mr. Gray argued the mark at issue does not consist exclusively of signs or indications which may serve, in the trade, to designate any of the named characteristics of goods or services. I partially agree as, in my opinion, the mark does not consist exclusively of the quality or quantity of the goods or services, or the value, geographical origin or time of production of the goods or rendering of the services.

81. That leaves the “*intended purpose*” and “*other characteristics of goods or services*”. Mr. Gray argued the implication that the opposed mark related to the intended purpose or the possible content of the goods and services for which registration has been sought is an oversimplification of an analysis of the goods and services, and demonstrates that the opposition has been filed in a “blanket fashion”. The Opponent has tried to limit the goods and services to a specific area, namely in relation to water from Ireland. This, Mr. Gray argued, is too far a stretch of the imagination to try to fit such an interpretation of the mark to the goods and services at issue, and one that would not be made by the average consumer. The mark has no obvious meaning or reference to the goods and services and, at best, could be only considered to have an indirect or elusive reference to such goods. As the mark does not contain an “*exclusive*” or direct reference to the intended purpose of the goods and services he maintained the objection is unjustified.

82. The Opponent did adopt a blanket objection under Section 8(1) and in doing so did not address each and every characteristic for which a registration is prohibited under Section 8(1)(c). However, in my opinion, in citing Section 8(1)(c) the Opponent need only base its opposition on the generality of that Section. In relative grounds based oppositions an opponent must provide evidence of the state of the market and the impact the opposed mark is having, or will have, on the opponent’s earlier rights. The bounds of such oppositions are confined to the materials laid before the Controller. If an opponent omits material that could support its case the Controller is none the wiser.

83. However, in Section 8(1) based oppositions, such as the case at hand, the bounds are not defined by what the parties put before the Controller. The Controller, having afforded the parties an opportunity to file whatever evidence they desire and to make whatever

submissions they wish, is required to know the law and to apply the law. This is as it must be, even in cases where an opponent does not identify the Section 8(1)(c) grounds of opposition with absolute clarity and precision. If an opponent claims the application offends against Section 8(1)(c) the Controller must consider that section in full and, if the Controller is of the view that the application offends against a particular provision of that Section, he cannot allow the application to proceed to registration purely because an opponent did not comprehensively address that particular provision or only made fleeting reference to it.

84. I have already stated that I dismissed the opposition in respect of all goods and services in Classes 16 and 35. I am satisfied the term IRISH WATER does not offend against any provision in Section 8(1) for those goods and services. However, that cannot be said for all the other goods and services listed in Classes 6, 9, 11, 37, 39, 40, 41 and 42.

85. I find there is a common intended purpose to each and every good and service mentioned in Classes 6, 9, 11, 37, 39, 40, 41 and 42 of the application. That purpose is concerned with storing, transporting, distributing, supplying, analysing, measuring, metering, filtering, purifying, cleaning, treating, disposing, maintaining, managing, building infrastructure, educating, renting of equipment in respect of one thing alone – water. The inclusion of the word IRISH does not lessen the intended purpose. It merely conveys a clear message that the water in question is of Irish origin. Therefore, in my opinion, the mark consists exclusively of the intended purpose of the goods and services - the commercialisation of all activities associated with (Irish) water, and therefore it offends against Section 8(1)(c) of the Act.

86. Lest on appeal the Court finds that I have erred in reaching this conclusion regarding the intended purpose of the goods and services, I am satisfied that the application also offends against Section 8(1)(c) as regards the prohibition on marks consisting exclusively of “*other characteristics of goods and services*”. Each good and service shares the same characteristic, that being that they are concerned with or require (Irish) water in order for every one of the goods to be usable and for every one of the services to be rendered. The raw material and subject matter of each and every good and service is (Irish) water, which is the actual mark applied for.

#### **Proviso to Section 8(1)**

87. Having found the application offends against the provisions of Section 8(1) of the Act, I must now consider whether the registration of the mark is justified by virtue of the proviso contained within that Section which is written in the following terms:

*“Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”*

88. In his evidence the Opponent states that at the date of application the mark was owned by a gas supply company called BORD GÁIS ÉIREANN, which at that time had nothing to do with water. This was long before the service was initiated and, hence, there can be no argument for acquired distinctiveness.

89. For his part, Mr. Gray argued that the evidence filed by the Applicant under Rule 21 provide ample support to the contention that the mark IRISH WATER has become distinctive through use and readily recognised in the mind of the average consumer. He directed me to Windsurfing Cheimsee<sup>8</sup> wherein the CJEU identified the following as factors to be considered in assessing whether distinctiveness through use has been acquired:

*“The market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations”.*

90. Mr Gray contended that it is not necessary that all of these requirements be met in order to establish acquired distinctiveness through use but that, on balance, there is sufficient proof of use of a mark such that consumers would have the necessary level of recognition of the trade mark. He then argued that applying some of these factors to the present application must lead to a conclusion that the mark had acquired distinctiveness through use. His analysis of the factors can be summarised as follows:

- (i) Irish Water was established by legislation and as such is the principal provider of the range of goods and services for which registration is sought to businesses and households throughout Ireland. Its market share for these goods and services is extensive.

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<sup>8</sup> Case C-108/97 Windsurfing Chiemsee Produktions v Boots und Segelzubehör Walter Huber

- (ii) There has been extensive use of the mark throughout Ireland with distribution of leaflets and booklets to every household in the country as well as intensive marketing and promotional campaigns.
- (iii) Coverage of the establishment of Irish Water placed the mark to the fore of media attention and consumers were regularly exposed to the mark.
- (iv) There has been significant outlay in the establishment of Irish Water which is sufficient to justify the claim of recognition of the mark in the marketplace.
- (v) 100% of the relevant class of people have been exposed to the mark.
- (vi) There were numerous print, radio and television articles relating to the mark from independent sources which further highlighted the reputation and notoriety of the mark.

91. He admits that certain of the material contained in the evidence post-dates the date of filing of the application, but that I, in making a decision on absolute grounds, must consider all relevant factors regarding the distinctiveness of the mark. He directed me to *Case C-192/03 Alcon*<sup>9</sup>, wherein the CJEU found a Court of First Instance was entitled to use documents that post-date the date of application in order to reach a view on the situation at the date of application. He also directed me to the opinion of Advocate General Ruiz-Jarabo Colmer in Cases C-456 and 457/01 Henkel KGaA, in which the Advocate General opined that documentation with regard to use of a mark which post-date the date of filing should be taken into account and that distinctiveness should be judged both at the time of the application and at the time of registration. Although the proceedings in the latter case related to an application for cancellation of a registered mark Mr. Gray maintained the principle is pertinent to the present proceedings.

92. I disagree fundamentally with this proposition. The First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks provided, at Article 3 Paragraph 3, that a trade mark shall not be refused registration or be declared invalid in accordance with the absolute grounds for refusal mentioned in paragraph 1 (b), (c) or (d) of Article 3, if before the date of application for registration and following the use which has been made of it, it has acquired a distinctive character. The Directive also provides that “Any Member State **may** in addition provide that this provision shall also apply where the distinctive character was acquired after the date of application for registration or

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<sup>9</sup> Alcon Inc v. OHIM (delivered 5 October 2004)

*after the date of registration*” (my emphasis). When transposing the Directive into Irish law, this optional clause was not provided for and no provision was made to take into account any distinctiveness acquired after the date of application (or after the date of registration in invalidity proceedings). Therefore, the proviso in Section 8(1) is abundantly clear and needs no interpretation as to what is required to be established in order for it to be invoked. There are three requirements: (i) the mark must have acquired a degree of distinctiveness, (ii) the distinctiveness must have been acquired prior to the date of application, and (iii) the distinctiveness acquired must have been acquired through use. No matter what degree of distinctiveness, recognition, market penetration, use or notoriety was attained after the date of application it is completely irrelevant for the purposes of considering the proviso in Section 8(1).

93. Mr. Gray argued that the length of use is not relevant, but that the extent of the use and the level of recognition within the marketplace are what must be taken account of. I agree that no specific time restrictions can be imposed as marks can penetrate the consciousness of a significant proportion of the population in a very short time. However, whatever the length of time taken it must be in the period preceding the date of application.

94. Much evidence was presented by the applicant to support its claim of distinctiveness acquired through use. This evidence can be categorised as media coverage, political debate and information dissemination. However, there are a number of fatal flaws in that most of the material post-dates the application date and the evidence shows that the utility Irish Water was not even established at the date of application and none of the evidence is in respect of actual trade.

95. There was no doubt that the preparations for the establishment of a national water utility were well advanced at the date of application. While “Irish Water” was being spoken about as the name of the utility it was by no means certain, at the date of application, that when the legislation would ultimately be passed that that would be the name. In fact there was doubt over whether or not the establishment of Irish Water (as it became) would become a reality. This is clear from the Applicant’s own evidence where, in Exhibit 8 attached to Mr. O’Donoghue’s Statutory Declaration, which contain articles from several Irish media sources that discuss various aspects of Irish Water and the possible repercussions of its establishment. All these articles post-date the relevant date (they are dated from 6th to 12th December, 2012) and they clearly show that after the date of application for the trade mark IRISH WATER, the

Irish Water utility was not yet established and that many were calling for the plans to establish it to be abandoned.

96. Much of the remainder of the Applicant's evidence can be viewed in a similar light. The Applicant attached much weight to the information leaflet it distributed to every household in the country, which Mr. O'Donoghue attached at Exhibit "10". While the leaflet is not dated its opening line is "*Irish Water is the new public water authority that is in the process of being established.*" The leaflet informs the recipient that "*one of the water authority's first tasks will be to install domestic water meters countrywide as soon as possible...*" and that "*[meter] installation work will begin in mid-2013 and that over one million homes will be fitted with meters*". The invoices in respect of printing (by Williams Lee) and distribution (by An Post) of the aforementioned information leaflet are both dated January 2013. In my opinion, it is safe to infer that the leaflet was not delivered to homes in Ireland before the date of application for the mark (4 December, 2012). Even in the unlikely event that it was delivered prior to the date of application, it states clearly that Irish Water was only in the process of being set up.
97. I am completely satisfied that the utility Irish Water was not established at the date of application. At best preparations for its establishment were in train and there was a strong likelihood that the utility would end up being called Irish Water. However, there is not one shred of evidence to point to the Applicant actually trading prior to its establishment, which in reality it did not do until the spring of 2013. At the date of application the Applicant did not have a presence in the marketplace and nor did it have customers. At best, prior to the date of application, the only activity the Applicant's predecessor in title was engaged in was the preparation of information dissemination material.
98. The Applicant argued its mark IRISH WATER had penetrated the consciousness of the general public prior to the date of application. However, the dissemination of information regarding the future role and responsibilities of Irish Water and the significant level of media coverage and political debate which took place prior to the establishment of Irish Water cannot be interpreted as use of the mark IRISH WATER. Furthermore, while the Irish public was aware that water charges were on the way, there were many protests and there was the possibility, however slight, that the initiative might be abandoned. In any event, at the date of application, the only things the average consumer was aware of was that a public water utility (most likely to be called Irish Water) was being established, that if the protests failed, water



meters would be installed and water charges introduced. This does not equate to the average consumer associating all the goods and services mentioned in the application with the Applicant's mark IRISH WATER. In fact, other than providing a public water utility and associated activities, there was nothing to suggest to consumers that the Applicant would be trading in, as distinct from using for its own purposes, most of the goods and services mentioned in the application.

99. As the Applicant was not yet established it could not and did not participate in the media coverage, political discourse or public debates regarding Irish Water. In my opinion, all such coverage was in respect of the public water utility called Irish Water and not the trade mark IRISH WATER.

100. While, and I am being very generous towards the Applicant in saying this, there may have been some preparations for use of the mark prior to the date of application, it is clear the mark was not being used at that date. The proviso in Section 8(1) relates specifically to use of the mark and preparations for use of the mark are not sufficient and cannot justify a conclusion that distinctiveness has been acquired through use. There must have been genuine use prior to the date of application, such use having established a presence in the marketplace for the goods and services at issue. I am satisfied no goods or services were traded by the Applicant under the mark IRISH WATER and no market presence was established prior to the date of application. Therefore, I find the proviso in Section 8 does not apply and the grounds for refusal of the application under Sections 8(1)(b) and (c) must be confirmed.

### **Conclusion**

101. For these reasons, I have decided to partially uphold the opposition and to refuse to allow the Applicant's mark to proceed to registration for the goods and services in Classes 6, 9, 11, 37, 39, 40, 41 and 42. I dismiss the opposition in respect of all goods and services in Classes 16 and 35, and accordingly allow the application to proceed to registration in respect of *printed matter, publications and information leaflets, and business, administration and promotional advertising services.*

Dermot Doyle

Acting for the Controller

8 July, 2016