

**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. **263829** and in the matter of an Opposition thereto.

**The Gillette Company LLC**

**Applicant**

(Represented by FRKelly)

**Fontaine Limited**

**Opponent**

(Represented by LK Shields Solicitors)

**The Application**


1. On 9/10/2020 (the relevant date), **The Gillette Company LLC**, of One Gillette Park, Boston, Massachusetts 02127, United States of America (hereinafter “the Applicant”) made application (No. **2020/01783**) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the trade mark “**FREED**” in respect of the following goods, in Class 3: *Shaving preparations, namely, shaving creams, shaving gels, shaving lotions, and shaving foams; after shave splashes, lotions and balms; pre-shave facial washes and scrubs; skin care preparations, namely skin moisturizers; non-medicated skin care preparations; body sprays; cologne; anti-perspirants and deodorants; body wash.* and in Class 8: *Razors and razor blades; dispensers, cassettes, holders, and cartridges, all specifically designed for and containing razor blades.*
2. The application was accepted for registration and advertised accordingly under No. **263829** in Journal No. 2425 dated 25/11/2020.
3. Notice of Opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 24/02/2021 on behalf of Fontaine Limited, a UK company of c/o TMF Group, 8th Floor, 20 Farringdon Street, London, EC4A 4AB, United Kingdom, (hereinafter “the Opponent”) by their Representative LK Shields. The Opposition was against Class 3 only. The Applicant, represented by their Agent FRKelly, filed a counter-statement on 6 May 2021. The Opponent subsequently filed evidence under Rule 20 of the Trade Marks Rules, 1996 (“the Rules”) on 9 February 2022. The Applicant filed evidence under Rule 21 on 4 May 2022. On 2 September 2022, the Opponent filed evidence under Rule 22.

4. Both the Applicant and the Opponent were asked to indicate their choice as to whether to attend at Hearing or to have the matter decided based on their written submissions. Both sides elected not to attend at Hearing and to file written submissions in lieu of this. The Opponent filed their written submissions in lieu of attending a Hearing on 9 February 2023. The Applicant filed their written submissions on 9 February 2023. On 10 March 2023, the Opponent filed a reply, under Rule 25(3) to the Applicant's written submissions.


The parties were notified on 28 June 2024 that I had decided to dismiss the opposition and to allow the mark to proceed to registration. 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).

#### Grounds of the Opposition

5. In its Notice of Opposition of 24 February 2021, the Opponent advised that it was opposing the registration of the Applicant's mark, in respect of all of the goods contained in Class 3 of the Application only. This opposition was based on its ownership of the following eight European Union Trademarks and one International Registration designating Ireland:

EUTM 018280720 

EUTM 011827979 

EUTM 012495396 

EUTM 012495479 

EUTM 012495479 

EUTM 012495495 

EUTM 012495578 



EUTM 012495594 IRIS TUBEREUSE



EUTM 013949573 VIKING and



IR 0557233

All of the above cited marks had an earlier filing date than the Applicant's mark and they each contained goods in their Class 3 specifications.

It was stated by the Opponent that the Applicant's Mark is similar to the Opponent's Marks and is to be registered for goods identical with, and/or similar to, those covered by the Opponent's Marks, such that there exists a likelihood of confusion on the part of the public. This likelihood of confusion includes (but is not limited to) the likelihood of association of the Applicant's Mark with the Opponent's Mark. Registration of the Applicant's Mark would therefore offend against the provisions of Section 10(2) (b) of the Trade Marks Act 1996 (as amended).

6. The Notice of Opposition relates to the following sections of the Act:

- Section 10(2)(b) – *identity or similarity of the goods and services and the identity or similarity of the marks, leading to a likelihood of confusion on the part of the public, including a likelihood of association with the Opponent's trade mark*
- Section 10(3) – *use of mark would take unfair advantage of, or be detrimental to, distinctive character or reputation of the Opponent's trade marks;*
- Section 10(4) – *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; or by virtue of an earlier right, other than those referred to in subsections (1) to (3) and paragraph (a), in particular by virtue of the law of copyright, registered designs or any other law relating to a right to a name, a right of personal portrayal or an industrial property right.*

- It further states that the provisions of Section 12 should not apply in this case; – *the applicant shows to the satisfaction of the Controller that there has been honest concurrent use of the trade mark for which registration is sought.*

### **Counter-Statement**

7. In its Counter Statement of 06 May 2021, the Applicant denied all the grounds of the opposition. Furthermore, the Applicant denied that the marks are similar, and that any likelihood of confusion existed. It was further stated that the Applicant was not aware of the reputation claimed by the Opponent in respect of the earlier mark and requested that the Opponent would provide proof of the claimed use of their mark. The goods on which the Opponent's said Trade Marks are allegedly used and/or registered are not identical or similar goods to those for which the Applicant is applying to register its said Trade Mark. The Trade Mark for which registration is sought complies with the relevant provisions of the Trade Marks Act, 1996 and in particular with the provisions of Section 10 and the Trade Mark is in all respects capable of distinguishing the Applicant's goods from those of other undertakings.

### **Rule 20 Evidence**

8. Evidence submitted by the Opponent under Rule 20 consists of a Statutory Declaration dated 9 February 2022, and supporting evidence, by way of twenty exhibits (marked SJC1 to SJC20), of Sarah Jane Cook, Chief Executive Office of Fontaine Limited, hereinafter referred to as the Opponent. I have examined in detail the Declaration and all the accompanying Exhibits and will refer to their particulars where appropriate to do so.
9. Ms Cook provided evidence of use during the relevant five-year period prior to the Applicant's application date of 9 October 2020. This use was in respect of the Opponent's marks EUTM 018280720 and IR0557233, both in Class 3.  
A brief history of the Opponent's brand stated that it was established in 1760 in England supplying the English Court with fragrances and other scented items. Its operations were subsequently moved to France. Its products are now sold worldwide in 71 countries. Exhibit SJC1. an extract from the Opponent's website, detailed the history of the brand. Exhibit SJC2 showed details of the Opponent's distribution channels including Ireland. Invoice details were also included in this exhibit showing details of sales generated in Ireland for a range of products during the relevant period. Exhibit SJC3 contained a spreadsheet showing sales of products bearing the Opponent's trademarks to two leading Department Stores in Ireland. Exhibits SJC4 to SJC9 inclusive contained copy invoices showing sales of the Opponent's products in a

number of EU countries. Exhibit SJC10 contained photographs of specialised counters in the aforementioned Irish Department Stores showing use of the Opponent's marks. Exhibits SJC11, SJC12 and SJC13 show evidence of the Opponent's marks being used on goods sold in the Benelux countries and France. Exhibit SJC14 shows use of the Opponent's mark on their UK website. Evidence of Social Media use promoting the Opponent's marks through Facebook, Instagram and Twitter, was provided under Exhibits SJC15 to SJC17. Exhibit SLC18 shows examples of EUTM 018280720 being used in relation to the Opponent's products in magazine articles. Exhibit SLC19 shows examples of EUTM 018280720 being used in relation to the Opponent's products in online articles. Finally, Exhibit SLC20 shows examples of EUTM 018280720 being used in relation to the Opponent's products in magazine features and store brochures.

10. In concluding their Rule 20 evidence the Opponent stated their view that the evidence filed by them showed that they had made genuine use of their trademarks in Class 3 goods, namely, perfumes and perfumed toiletries, in a substantial part of the EU, including Ireland. The Applicant's mark was held to be similar to those of the Opponent and the associated Class 3 goods were identical with or highly similar to those contained in the marks of the Opponent. This contravened against the provisions of Section 10(2)(b) of the Act. Due to the reputation of the Opponent's marks, the use of the Applicant's mark would take unfair advantage of the Opponent's mark contrary to the provisions of Section 10(3) of the Act. The use of the Applicant's mark would lead to their goods being passed off or mistaken for goods sold by the Opponent contrary to the provisions of Section 10(4) (a) of the Act. The Opponent is of the view that, because of the reputation acquired by their marks in Ireland, the relevant public would associate these exclusively with the Opponent. For this reason, any use of the Applicant's mark in respect of the associated Class 3 goods would likely result in deception or confusion in the marketplace. The goodwill in the Opponent's marks would suffer hardship if the Applicant's mark was allowed to proceed to registration.

### **Rule 21 Evidence**

11. The Applicant filed evidence under Rule 21 on 4<sup>th</sup> May 2022. This consisted of a Statutory Declaration from Gregor Versondert, Director & Assistant General Counsel of Procter & Gamble International Operations S.A., a Swiss Company of 47, route de Saint-Georges, CH-1213 Petit-Lancy, Switzerland. The Applicant in these proceedings is the Gillette Company. Procter & Gamble is the parent company of Gillette, having acquired it in 2007. Mr Versondert referenced the fact that the Opponent was put on proof of use for the nine earlier marks upon

which the opposition was based. In reply, the Opponent had only provided evidence in respect

of two of the marks listed, EUTM 018280720,



and IR 0557233,



. The Opposition based on all the other earlier cited marks should, therefore, be refused. The Applicant further stated that the Opponent's declaration included historical references to their marks that was not relevant to the Irish market. A claim to expanded use of




the Opponent's brand had not been verified by fact and references to its use in the Benelux and France was not relevant to the Irish market. Furthermore, references to use of UK and EU websites and to use of the Opponent's mark in social media not specifically targeted at the Irish market did not prove genuine use of their marks in Ireland. Mr Versondert, in his Declaration, further contended that the Opponent had failed to provide the requisite evidence to prove genuine use of their cited marks for the Class 3 goods of interest in this case. It was argued that the invoice information provided was insufficient to prove use of the marks in Ireland. The mark name was not included in the sample invoices, and they only showed sales to two stores in Ireland. Evidence of the place, time and nature of claimed use of the relevant goods in Ireland was not provided in the rest of the material filed by the Opponent in support of their case.


## **Rule 22 Evidence**

12. The Opponent filed evidence under Rule 22 on 2<sup>nd</sup> September 2022. This consisted of a Statutory Declaration from their Chief Executive Officer, Sarah Jane Cook. The key elements of Ms Cook's deposition included historic screenshots of the Opponent's website obtained via the "Wayback Machine" filed under Annexure 1. Dating back to 2004, they show Irish stockists of the CREED brand from that time. The Opponent also contended that the evidence previously supplied by them under Rule 20 was sufficient to prove use of their mark in the EU. The Opponent went on to advise that their branded products are supplied to the Irish market via their local distributor which accounts for the invoices not including the brand name. The actual products, however, were stated to include the brand and on their packaging as shown in Annexure 2. The products themselves were held to be luxury items and were only stocked in certain luxury stockists to maintain their exclusivity. Press articles, including from the Irish Times and RTE, were also supplied under Annexure 3 that referenced the brand and its use in Ireland. Annexure 4 contained an article from the publication Evoke highlighting an event at a

Harvey Nichols store in Dundrum Shopping Centre that referenced the Opponent's brand being stocked there. It was stated that this was the case since 2015. In 2019, a "CREED" counter was set up becoming a substantial feature of the store's beauty department. In conclusion, the Opponent held that, based on the evidence provided by them, they had made genuine use of EUTM 018280720 and IR 0557233 (designating Ireland) in Class 3 goods in a substantial part of the EU including Ireland. It was also stated that both marks have a reputation in the EU and Ireland as demonstrated by the evidence submitted by the Opponent.


13. Both parties were asked, under Rule 25(1), on 10<sup>th</sup> October 2022 to advise if they wished to attend at a hearing or file written submissions in lieu of attending. The Applicant replied on 9<sup>th</sup> December 2022 that they would file submissions in lieu of attending at a hearing. The Opponent, on 8<sup>th</sup> December 2022, similarly elected to file written submissions.
14. The Opponent, pursuant to Rule 25(3), filed written submissions on 9<sup>th</sup> February 2023. In these, they summarised the case made previously in their Notice of Opposition and in their submission filed under Rule 20, referenced above. The Opposition was based on the Opponent's EUTM

018280720 for  in Class 3 and International Registration No. 0557233 for

 in Class 3. The Opposition was directed against the Applicant's mark, TM Number 263829 for Class 3 goods only. The Opponent contended that a comparison of the marks of the Applicant and the Opponent revealed them to be similar, when applying the established principles of well-known case law, from a visual, aural and conceptual perspective. The average consumer of the goods in question would have an imperfect recollection and only rarely would have the opportunity of making a direct comparison between them. It was held that the respective marks of the Opponent and of the Applicant, when considered globally and on the overall impression they give, are sufficiently similar for the purposes of Section 10(2)(b) of the Act. The Opposition was directed at the Class 3 goods of the Applicant only. The Opponent argued that a comparison of the Class 3 goods of interest to the Applicant and the Class 3 goods of the Opponent revealed that they shared the same nature, intended purpose, distribution channels and relevant public. Previous decisions of the EU Court of Justice were quoted in support of the Opponent's contention that the Class 3 goods of the Applicant, "*Shaving preparations, namely, shaving creams, shaving gels, shaving lotions, and shaving foams; after shave splashes, lotions and balms; pre-shave facial washes and scrubs; skin care preparations, namely skin moisturizers; non-medicated skin care preparations; body sprays; cologne; anti-*

*perspirants and deodorants; body wash*”, were highly similar to the Class 3 goods contained in the Opponent’s earlier mark namely “Soaps; perfumery, essential oils, cosmetics, hair lotions”  
The Opponent proceeded to reiterate the points made in their Rule 20 evidence in support of



their claim for the reputation of the “  ” brand referred to in the exhibits filed in relation to this. For the reasons previously stated, it was contended that blurring could occur such that the earlier mark’s capacity to identify the goods as being those of the Opponent would be eroded over time. The Opponent further submitted that the high degree of similarity between the marks, the high degree of similarity between the goods in Class 3 and the inherent and enhanced distinctiveness of the Opponent’s marks meant that there exists a likelihood of direct confusion between the Applicant’s mark and those of the Opponent. The previously stated view of the Opponent that their marks have a reputation in the EU and Ireland was reiterated. The Applicant’s would, in the view of the Opponent, take unfair advantage of and is detrimental to the distinctive character and reputation of the Opponent’s mark and should, therefore, be refused registration on the basis of Section 10(3) of the Act. The Opponent concluded their written submissions by claiming that use by the Applicant of their mark would give rise to a claim by the Opponent for passing off under Irish law. The registration of the Applicant’s mark should, therefore, be refused as per Section 10(4) of the Act. For all of the reasons stated, the Opponent concluded that the registration of the Applicant’s mark should be refused pursuant to Sections 10(2)(b), 10(3) and 10(4)(a) of the Act.

15. The Applicant, pursuant to Rule 25(3), filed written submissions on 10<sup>th</sup> February 2023. In these, they addressed each of the areas on which the Opponent argued their case, Sections 10(2)(b), 10(3) and 10(4)(a) of the Act. The principles established by well-known and established EU case law, including *Sabel BV v Puma AG*, Case C-251/95 and *Canon Kabushiki v MGM Inc*, Case C-39/97, were referenced in support of their case. The overall assessment of the marks of the Applicant and Opponent and the impact each sign would make on the average consumer was outlined from the Applicant’s perspective. Emphasis was placed on the beginning consonants “C” and “F” in the marks at issue. As presented, they significantly changed the similarities between them visually, aurally and conceptually. The dominant words in the opposing marks would be perceived very differently by the average consumer. The word “Creed” would either be understood as a set of beliefs or principles while “Freed” means to be liberated or released. In relation to the goods at issue, it was contended that those of the Applicant are not expensive luxury goods while the level of attention of the consumer of the Opponent’s claimed luxury products would be higher. The Applicant stated that, in relation to the onus that had been placed on the Opponent to prove use of their cited marks, evidence had



only been provided in relation to EUTM 018280720 and IR 0557233. The evidence presented in relation to these latter marks was held to be less than was required. It was held to be more akin to evidence of business trade rather than that required to prove genuine use of their marks. The various exhibits filed by the Opponent were stated by the Applicant to be severely lacking in relation to proving reputation and genuine use. The Applicant summarised their case by stating that the respective marks of the Opponent and Applicant are sufficiently different from a visual, phonetic and conceptual perspective to preclude a likelihood of confusion. It was held that the Opponent had failed to prove its earlier “CREED” marks have a reputation in Ireland. It was not proven either that the use of the Applicant’s “FREED” (figurative) trademark would be without due cause or would take unfair advantage of, or be detrimental to, the distinctive character of the marks of the Opponent. The Applicant also argued that the Opponent had failed to prove its earlier “CREED” marks have goodwill in Ireland and that any use of the Applicant’s mark “FREED” (figurative) would not amount to actionable passing off. For all of these reasons, the Applicant requested that the Opposition be rejected in its entirety and that the application be allowed to proceed to registration.

16. The Opponent, pursuant to Rule 25(3)(b), filed written submissions on 10<sup>th</sup> March 2023 in response to the submissions made by the Applicant on 10<sup>th</sup> February 2023. The Opponent argued against the Applicant’s position that the respective trademarks were dissimilar due to the different first letter contained in each of them. A number of caselaw decisions were quoted in support of their view including Case T-388/00 where it was found that “ELS” and “ILS” (figurative) were visually and aurally similar, Case T-585/10 where “PENTEO” and “XENTEO” were found to be visually and aurally similar and Case T-569/11 where figurative marks containing the verbal elements “KiTANA” and “GITANA” were found to be similar. The Opponent proceeded to take issue with the Applicant’s view that the anatomy of the letters C and F, the presence of crossed lines in the Opponent’s marks, the legibility of the letters C and D in the Opponent’s marks, the stylistic presentation of the second letter E in the Applicant’s mark and the pronunciation of the letters C and F all contribute to the dissimilarity between the marks. The Opponent repeated the points previously contained in the statutory declarations and exhibits filed by their Chief Executive Officer, Sarah Jane Cook, on 4<sup>th</sup> February 2022 and 31<sup>st</sup> August 2022 in support of their claim for reputation, genuine use and acquired goodwill. Based on all of the above, it was the view of the Opponent that the Applicant’s mark should not be registered as it falls within the relative grounds for refusal pursuant to Sections 10(2)(b), 10(3) and 10(4)(a) of the Act.

## **17. Decision-**

In the Notice of Opposition dated 24<sup>th</sup> February 2021, the Opponent objected to the registration of the applied for mark on the basis that it was in contravention of the provisions of Section 10(2), 10(3), and 10(4) of the Trade Marks Act 1996.

18. There are four basic requirements that must be met in order for an objection under this section to succeed. They are: (i) there must be “an earlier trade mark”, (ii) the goods or services of the application must be identical with or similar to those in respect of which the earlier trade mark is registered, (iii) the mark applied for must be similar to the earlier trade mark, and (iv) there must be a resultant likelihood of confusion on the part of the relevant consumer.
19. The Opponent’s marks were filed prior to 9<sup>th</sup> October 2020 (the relevant date) and by virtue of Section 11(1)(b) of the Act, are earlier trademarks as against the present application for the purposes of Section 10. Therefore, the first of the conditions is fulfilled.
20. The Opponent’s earlier marks – EUTMs 018280720, 011827979, 012495396, 012495479, 012495495, 012495578, 012495594, 013949573 and IR 0557233- all include Class 3 goods in their specifications. These are similar to the items covered by the Applicant’s Class 3 goods. I find the respective goods at issue to be similar to each other and, therefore, the second condition is met.

## **Comparison of the marks**

21. I have compared the respective marks 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. 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 registration. The Court of Justice of the European Union (CJEU) noted in *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.

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

I find that there are some visual similarities between the Applicant's mark,

**FREED**

and the Opponent's



mark and various variations

thereof. The dominant element of the Opponent's marks is the stylised word, **CREED**, with sword like emblems extending from the letters C and D and forming the figure X under the word. The Applicant's mark is dominated by the word **FREED**, with the second letter **E** being inverted. The Applicant's mark shares a degree of similarity with the Opponent's mark. Though the applied for and cited marks share the letters "REED", the signs are both visually, phonetically, and conceptually dissimilar. The different first letters significantly change the overall impression of each mark such that the visual, phonetic and conceptual differences are apparent. I rate the level of visual similarity between them as low to medium. When the respective marks are spoken, there is some similarity. In my opinion, the marks are more aurally dissimilar than similar. I find the level of aural similarity between the marks to also be low to medium. Conceptually, the marks are quite different. The Opponent's mark consists of the word CREED which means a doctrine, or system of beliefs, for a church or religious group, or personal set of beliefs. The word FREED means being released. The meanings of the marks are completely different, thus leading to different associations for consumers.

22. Having completed my examination of the marks in respect of their visual, aural, and conceptual characteristics, I find that there is an overall low to medium level of similarity between them. Thus, the third condition is met.
23. As I have found there is some similarity between the marks, I must conduct a global assessment of the likelihood of confusion which requires me to take all relevant factors into account, including the similarity between the goods. In the *Canon Kabushiki*<sup>2</sup> case the CJEU found "*a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa*". This is relevant as I have already found the Class 3 goods of the Applicant and the Class 3 goods of the Opponent are similar.

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<sup>2</sup> Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc. Case C-39/97 at p.17

24. I must also consider other factors identified by the CJEU<sup>3</sup> in this area, including the following:

- (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 services 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 as regards the visual, aural, and conceptual similarity of the marks in question, must be based on the overall impression created by them, and the importance attached to each of those elements must take account of the category of goods and the way in which they are marketed and used by the purchasing public.
- (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,


25. The Opponent has provided evidence to support its claims of long-established, extensive, and continuous use of the mark in the European Union. Therefore, I am satisfied the mark is known to European consumers for Class 3 goods and that it 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.

26. The criteria for deciding a likelihood of confusion regarding the goods involved envisages a typical purchasing scenario where goods from the respective parties may be found on the same shelf of a store, or in the same store, or are in competition or are complimentary to each other.

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<sup>3</sup> *Sabel BV –v- Puma AG and Rudolph Dassler Sport* (Case C-251/95) [1998] 1 CMLR 445; and *Lloyd Schuhfabrik Meyer & Co. GmbH –v- Klijsen Handel BV* (Case C-342/97) [1999] 2 CMLR 1343



27. The Opponent's earlier marks, , and various variations thereof, is registered in respect of Class 3 goods. These are similar to the Class 3 goods covered by the Applicant's mark, **FREED**. I must, therefore, make an overall assessment of the likelihood of confusion that may exist between the Opponent's earlier trademarks and the Applicant's mark. The confusion in question may be direct confusion, whereby the Applicant's goods are mistaken for those of the Opponent, or indirect confusion, whereby the Applicant's goods are associated in the mind of the consumer with those of the Opponent and a common commercial origin is inferred.
28. It is not necessary to find that every consumer would be confused. Nor is it sufficient to find that some consumers might be confused in order to refuse registration of a trade mark under Section 10(2)(b). The question is whether it is likely or unlikely that the average person would be confused in the course of the typical scenario wherein they seek the goods at issue.
29. I have already found the respective marks share a level of similarity. I am satisfied, however, that the level of similarity is low enough that it would mean that the overall impression conveyed by the marks is that they are different. I have looked at the question of likelihood of confusion from a practical perspective in the context of the marketplace and I have put myself in the shoes of the average Irish consumer of the goods in question. Having done so, I am satisfied that a consumer, having experienced the relevant goods of the Opponent, and having subsequently encountered the Applicant's mark for similar Class 3 goods, would not be likely to be confused or caused to wonder that the latter goods were from the same commercial origin as the former, or that the goods providers were economically linked.
30. In light of all the above, I find no likelihood of confusion would arise if both marks were used for their respective goods in the Irish marketplace. Accordingly, I find the application does not offend against Section 10(2)(b) and I dismiss the opposition on this ground.

### **Section 10(3)**

31. I now turn to the grounds of opposition centred on Section 10(3) of the Act, which 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 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.*”

32. 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 must have a reputation in the State or the EU; 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.
33. I have already found that there is some level of similarity with the Opponent's mark.
34. The second condition is the Opponent's earlier EUTMs must enjoy a reputation in the EU. The Opponent submitted evidence in support of this. I am satisfied that use by the Opponent of its mark in a number of EU member States is sufficient for me to conclude that, on the relevant date, the mark had the type of reputation worthy of protection under Section 10(3)(b) of the Act.
35. Turning now to due cause. The Opponent has not offered anything to suggest the Applicant does not have due cause to use the mark put forward for registration. On this basis I must conclude the Applicant has due cause to use its mark. Having found the Applicant has due cause to use its mark, I do not have to consider whether or not the Applicant's use of it would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponent's mark.
36. No evidence has been adduced or advanced by the Opponent to support its claims that the Applicant's use of its mark would tarnish the reputation of the Opponent's mark in the marketplace or undermine its capacity to identify exclusively the Opponent's goods. It appears the Opponent's case is based on the fact that it owns an earlier mark of repute for certain goods, and that is enough. These facts are sufficient to allow me to determine the matter under Section 10(2)(b), but more would be needed for me to refuse the Applicant's mark under Section 10(3).
37. I find the level of similarity between the marks is such that I cannot accept the Opponent's claim that use of the Applicant's mark would result in the damage or unfair advantage that Section 10(3) seeks to avoid. I am completely satisfied the parties' marks can coexist in the marketplace without impacting in any way on the Opponent's mark or reputation. Therefore, I dismiss the opposition under that Section also.

38. Finally, having considered all of the evidence and submissions by both sides in this case, I must also reflect on what I regard as being the experience and knowledge of an average Irish consumer of the Class 3 goods at issue. Would the average consumer in this instance be likely to associate goods supplied under the mark “**FREED**” with the company using the



mark “**CREED**” and various variations thereof? In my opinion, that would be unlikely. The prior registration and use of the Opponent’s trademarks does not constitute any grounds for refusal of the application to register the mark at issue. The Applicant’s mark does not infringe the mark of the Opponent. Therefore, I have decided to dismiss the opposition and to allow the Applicant’s “**FREED**” mark to proceed to registration.

John Nolan

Acting for the Controller

11 December 2025