

**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. **265194** and in the matter of an Opposition thereto.

BLACKWATER DISTILLERY LIMITED

(Represented by FRKelly)

Applicant

Paulaner Brauerei Gruppe GmbH & Co. KGaA

(Represented by Mason Hayes & Curran LLP)

Opponent

The Application

1. On 2 February 2021 (the relevant date), Blackwater Distillery Limited, of Church Road, Ballyduff Upper, Co Waterford, (hereinafter “the Applicant”) made application (No. 2021/00232) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the trade mark “SALVADO RUM” in respect of the following goods in Class 33: *Alcoholic beverages (except for beer); pre-mixed alcoholic beverages, other than beer based; spirits; rum.*
2. The application was accepted for registration and advertised accordingly under No. 265194 in Journal No. 2441 dated 07/07/2021.
3. Notice of Opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 6 October 2021 on behalf of Paulaner Brauerei GmbH., a German Company of Ohlmullerstrase 42, D-81541 Munich, Germany, (hereinafter “the Opponent”) by their Representative Mason Hayes & Curran LLP. The Applicant, represented by their Agent FRKelly, filed a counter-statement on 10 January 2022. The Opponent subsequently filed evidence under Rule 20 of the Trade Marks Rules, 1996 (“the Rules”) on 5 September 2022. The Applicant, as is its right, elected not to file evidence under Rule 21 as per their communication of 24 November 2022.
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. The Applicant decided not to attend at Hearing and not to file any additional submission in lieu of this. The Opponent elected to file written submissions in lieu of attending a Hearing and did so on 12 May 2023. The parties were notified on 22 November 2023 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 6 October 2021, the Opponent stated that it was the proprietor of an earlier trademark, number EUTM 002499218 “SALVATOR”, for goods in Class 32 and services in Class 42. It was claimed that the applied for mark is similar to the Opponent’s earlier mark and would be registered for goods highly similar to those contained in the earlier mark thus causing a likelihood of confusion and a likelihood of association on the part of the public. The Opponent’s earlier mark has a reputation and the use of the applied for mark would take unfair advantage of this.
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; and*
 - Section 8(4)(a) – *its use is prohibited in the State by any enactment or rule of law or by any provision of Community law;*

Counter-Statement

7. In its Counter Statement of 10 January 2022, 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 applied for mark complies with the relevant provisions of the Act and, in particular, with the provisions of Sections 10(2)(b) and Section 10(3).

Rule 20 Evidence

8. Evidence submitted by the Opponent under Rule 20 consists of a Statutory Declaration dated 3 August 2022, and supporting evidence, by way of eight exhibits (marked X1 to X8), of Andreas Steinfatt, Managing Director of Paulaner Brauerei and Martin Brummerhoff, Authorised Representative of Paulaner Brauerei, both 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. Mr Steinfatt provided a brief history of the SALVATOR brand, which was first registered as a German trademark in 1896. The Opponent is the Proprietor of an EUTM, 002499218, “SALVATOR”, filed on 12th December 2001 in Classes 32 & 42 as detailed in Exhibit X1. Details of the material used to promote and advertise the brand on the Opponent’s website and in Wikipedia were contained in Exhibit X2. Images from the Opponent’s Instagram social media page were provided under Exhibit X3. Promotional videos in relation to the Opponent’s brand were referenced in Exhibits X4 & X5. Details of the Opponent’s mark featuring in the Starkbierfest, Strong Beer Festival, in Munich were contained in Exhibit X6. Sales data for beer sold under the Opponent’s brand for the years 2016 to 2021 were contained in Exhibit X7. Additional sales data for the product sold under the Opponent’s brand in other European countries were contained in Exhibit X8.
10. In concluding their Rule 20 evidence the Opponent stated their view that a comparison between the Applicant’s mark, SALVADO RUM, and that of the Opponent, “SALVATOR” revealed close similarities between them. Based on this, it was held that should the Applicant’s mark proceed to registration there would be a grave danger that it would be confused with the Opponent’s mark.

Rule 21 Evidence

11. The Applicant advised on 24th November 2022 that they would not be filing evidence under Rule 21.
12. Both parties were asked on 17th January 2023 to advise if they wished to attend at a hearing or file written submissions in lieu of attending. The Applicant relied on 20th January 2023 that they would not be attending a Hearing or filing submissions in lieu of this. The Opponent, on 13th March 2023, elected to file written submissions in lieu of attending at a hearing.
13. The Opponent, pursuant to Rule 25(3A)(b), filed written submissions on 12th May 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 002499218, “SALVATOR” and was directed against the Applicant’s mark, TM Number 265194. The Opponent contended that a comparison of the marks of the Applicant and the Opponent revealed them to be highly similar, when applying the established principles of well-known case law, from a visual, aural and conceptual perspective. The principle that the average

consumer has an imperfect recollection and only rarely has the opportunity of making a direct comparison was also stated. Furthermore, the average consumer's level of attention is likely to vary according to the category of goods or services in question. In the present case, the average consumer is the general public, adults of legal age that consume alcohol for the same purpose of recreational drinking. It was held that the level of similarity between the marks of the Applicant and Opponent would lead to a grave danger of confusion between them.

The Opponent further contended that a comparison of the Class 33 goods of interest to the Applicant and the Class 32 goods of the Opponent revealed that they shared the same nature, alcohol, purpose, distribution channels and relevant public. Previous decisions of the IPOI and the EU General Court and the guidelines of the EUIPO were quoted in support of the Opponent's contention that the Class 33 goods of the Applicant, "alcoholic beverages (except for beer); pre-mixed alcoholic beverages, other than beer based; spirits; rum", were highly similar to the Class 32 goods contained in the Opponent's earlier mark namely "Beers"

The Opponent proceeded to reiterate the points made in their Rule 20 evidence in support of their claim for the reputation of the "SALVATOR" brand in the European Union and referred to the exhibits filed in relation to this. It was held that this proved that their mark had been put to intensive use in the European Union. 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. For all of these reasons, the Opponent concluded that the registration of the Applicant's mark should be refused.

14. Likelihood of Confusion

I now turn to the ground of opposition relating to Section 10(2)(b) and the issue of the likelihood of confusion in the marketplace. The relevant part of the Act reads as follows:

(2) A trade mark shall not be registered if because –

(a)

(b) it is similar to an earlier trade mark and would be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association of the later trade mark with the earlier trade mark.

15. Therefore, 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.
16. The Opponent’s EUTM 002499218, “SALVATOR”, with a filing date of 12th December 2001, was registered at the European Union Intellectual Property Office (EUIPO) prior to the relevant date and is an earlier trade mark. Therefore, the first of the conditions is fulfilled.
17. The Opponent’s earlier mark – EUTM 002499218, “SALVATOR”, is registered for Class 32 goods “Beers”. These are similar to the items covered by the Applicant’s Class 33 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

18. 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*¹ 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.

A comparison of the Applicant’s mark to the Opponent’s EUTM side-by-side is as shown:

SALVADO RUM

SALVATOR

19. I find that there are some visual similarities between the marks, in that the first word of the Applicant’s mark contains the same first five letters of the Opponent’s single word mark, i.e.”

¹ Paragraph 23 of decision dated 11 November 1997

SALVA”. I find the marks share some degree of similarity. I rate the level of visual similarity between the marks as low to medium.

20. The Opponent’s mark consists entirely of one word and three syllables, ‘SALVATOR”. The Applicant’s mark consists of two words and four syllables, “SALVADO RUM” When the respective marks are spoken, there is some similarity. But the marks differ in that the Opponent’s mark does not contain the sound created in the Applicant’s mark by the suffix “RUM”. Therefore, in my opinion, the marks are more aurally dissimilar than similar. I find the level of aural similarity between the marks to be low to medium.

21. The first word in the Applicant’s mark shares a degree of similarity with the Opponent’s mark. I find, therefore, that there is some conceptual similarity between the marks, the level of which I rate as medium.

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*² 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 33 goods of the Applicant and the Class 32 goods of the Opponent are similar.

24. I must also consider other factors identified by the CJEU³ 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-

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

³ 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

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 32 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.

27. The Opponent's earlier mark "SALVATOR" is registered in respect of Class 32 goods, "beers". These are held to be similar to the Class 33 goods covered by the Applicant's mark, "alcoholic beverages (except for beer); pre-mixed alcoholic beverages, other than beer based; spirits; rum".

I must, therefore, make an overall assessment of the likelihood of confusion that may exist between the Opponent's earlier trade mark and the Applicant's mark, "SALVADO RUM". 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 goods of an alcoholic nature, 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 –

(c) is identical with or similar to an earlier trade mark, and

(d) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the State (or, in the case of a Community trade mark, in the Community) and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark.

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, there must

be a dissimilarity between the respective goods⁴; thirdly, the earlier mark must have a reputation in the State or the EU; fourthly, the use of the later trade mark must be without due cause; and fifthly, 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 the first two conditions have been met – there is some level of similarity with the Opponent’s mark and there is the required dissimilarity or similarity (following the CJEU decision) in respect of some of the goods applied for.
34. The third condition is the Opponent’s earlier EUTM ‘SALVATOR’ must enjoy a reputation in the EU. The Opponent submitted evidence in support of this.
35. 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.
36. 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.
37. 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).
38. 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.

⁴ In the light of the ECJ decision in Case C-292/00 *Davidoff* [2003] ECR I-389, it is now more correct to say that there is not a requirement that the goods be similar (although the provision is equally applicable in the case of similar goods).

39. 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 goods at issue. Would the average consumer in this instance be likely to associate goods supplied under the mark “SALVADO RUM” with the German company using the mark “SALVATOR”? In my opinion, that would be unlikely. The prior registration and use of the Opponent’s trade mark “SALVATOR” 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 “SALVADO RUM” mark to proceed to registration.

John Nolan

Acting for the Controller

09 July 2025