

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

In the matter of an application for registration of Trade Mark No. 258398 and in the matter of an Opposition thereto.

Mr Ciaran Sherry
Volkswagen AG

Applicant
Opponent

The Application

1. On 30 November 2017 Ciaran Sherry of Quay Road, Ballina, Co. Mayo (hereinafter “the Applicant”) made application (No. TM 2017/02571) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the mark “**VoltsWagon**” as a Trade Mark in respect of “electric vehicle charging units” in Class 9.
2. The application was accepted for registration and advertised accordingly under No. 258398 in Journal No. 2355 dated 21 March 2018.
3. Notice of Opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 19 June 2018 by Volkswagen AG, Berliner Ring, Wolfsburg 28440, Germany (hereinafter “the Opponent”). The Applicant filed a counter-statement on 23 August 2018.
4. The Opponent, on 30 May 2019, filed by means of a Statutory Declaration under Rule 20, a response including thirteen exhibits, reference “VW1” to “VW13”, in support of their Opposition case. The Applicant, on 11th June 2021, filed by means of a Statutory Declaration under Rule 21, material in support of his case, including twelve exhibits, reference “VOLTS1” to “VOLTS12”.
5. The parties were asked by Official letter on 16 December 2021 to advise whether they wished to attend at hearing or file written submissions in lieu of such attendance pursuant to Rule 25(1) & (2).
6. The Applicant elected to file written submissions and did so on 14 April 2022. The Opponent also elected to file written submissions and did so on 19 April 2022

7. Acting for the Controller, I decided to uphold the opposition and refuse to allow the application to proceed to registration. The parties were notified of my decision by letter dated 16 August 2022. I now state the grounds of my decision and the materials used in arriving thereat, in response to a request by the Applicant in that regard pursuant to Rule 27(2) of the Rules.
8. In the Notice of Opposition dated 19 June 2018, the Opponent contended that the applied for mark is of such a nature as to deceive the public and protection of the mark would offend against Sect 8(3) of the Trademarks Act 1996. It was also contended that use of the mark in the State is prohibited by the enactment and rule of law and by any provision of Community law under Sect 8(4)(a) of the Act. The Opponent also stated that they are the owners of an earlier EUTM 014920953 “**Volkswagen**”. The applied for mark is similar to the Opponents earlier mark and is seeking to be registered for Class 9 goods included in the earlier EUTM thus offending against the provisions Sect 10(2)(a) of the Trade Marks Act 1996. The Opponent’s earlier mark has a reputation in the State and the use of the applied for mark would take unfair advantage of this thus offending against Sect 10(3) of the Act. Furthermore, its use in the State would offend against Sect 10(4)(a) of the Act. The Opponent also claimed that registration of the Mark should be refused as the Applicant has failed to use or have a bona fide intention to use their mark in relation to the goods applied for. This contravenes Sections 37(2) and 42(3) of the Act.

Counter-Statement

9. In his Counter-Statement dated 23 August 2018, the Applicant admitted that he is aware of the trading activities of the Opponent, but he does not admit the extent or nature of such activities or the validity or otherwise of the Opponent’s EUTM. The Applicant emphatically denied each of the grounds on which the Opponent’s case is based as outlined in their Notice of Opposition. Furthermore, the applicant stated that registration of their mark would not offend against any of the provisions of the Trade Marks act 1996, including Sections 8 and 10 of that Act as instanced in the Notice of Opposition.

Rule 20 Evidence

10. Evidence submitted by the Opponent under Rule 20 consisted of a Statutory Declaration signed by Dieter Messnarz, Head of Trademarks, Licensing and Central Service for Volkswagen AG, and thirteen supporting exhibits labelled “VW1” to “VW13” dated 09 May

2019. This consisted of newspaper articles, an extract from the company Annual Report 2017, report from the European Automobile Manufacturers Association, all of which illustrated the size and market share of the Opponent's company. Details of the mark on which the Opposition is based together with printouts showing details of other company trademarks worldwide were also provided. A company magazine article from April 2017 referred to the history of the Volkswagen company in the field of e-mobility. Details of a decision from the World Intellectual Property Office (WIPO), D2004-0498, in which the latter found in favour of the Opponent in a domain name dispute "in view of the fact that Volkswagen is a famous trademark". Other exhibits showed evidence of a decision from the Latvian Patent Office stating that "Volkswagen is one of the most popular car trademarks in the world" and a decision from the German Supreme Court that stated, "the wordmarks "VOLKSWAGEN" have a high distinctiveness due to the paramount reputation". Reference was made to the Company's active profile in sports sponsorship including professional rugby in Ireland and professional European football. The Opponent pointed out that the Applicant had acknowledged in their counter-statement that they knew of their company's trademark when applying for the opposed mark and the registration should be refused.

Rule 21 Evidence

11. The Applicant filed evidence under Rule 21 consisting of a Statutory Declaration and a supporting exhibit labelled "VOLTS1" to "VOLTS12" dated 28th May 2021. This included a statement that the Applicant has been using their mark in Ireland in relation to electric vehicle charging units since 2016. Details of the turnover achieved under the mark for the period 2018 to February 2020 together with details of the amount spent on promoting these goods under the mark for 2018 and 2019 was also provided. The Applicant further stated that their mark name resulted from the conjunction of two words, Volts and Wagon, and alluded to something that would give a vehicle electrical power with a car charger. The exhibits filed in support of the application included photographs of one of the chargers and a company vehicle including the "VoltsWagon" branding, an illustration of the company uniform with branding included, photographs of completion certificate books, an extract containing social media comments from customers recommending the Applicant's goods, copies of Completion Certificates for existing installations from 2018, a copy of an advertisement for the chargers, a photograph of the outside of a factory where the chargers are manufactured, an article from "Advertiser Motoring" from 2019 in connection with electric motoring featuring VoltsWagon car chargers, an advertisement featuring the

chargers, a newspaper article featuring the dispute between the Applicant and the Opponent and a copy of an article detailing the sponsorship by the Applicant of a sports person participating in the Galway U16 County Camogie Championship. The Applicant concluded by stating that his mark is not deceiving the public and that he has not experienced any instances of confusion between the car chargers sold under his mark and the cars sold by the Opponent.

Rule 22 Evidence

12. The Opponent elected not to file evidence under Rule 22.

13. Both parties were asked on 16th December 2021 to advise if they wished to attend at a hearing or file written submissions in lieu of attending. The Opponent and Applicant both elected to file written submissions in lieu of attending at a hearing.

14. The Applicant filed written submissions on 14th April 2022. The submissions summarised the key aspects of the case from the Applicant's perspective. This included their view that a comparison of the applied for mark and the mark of the Opponent revealed significant visual, phonetic, and conceptual differences between them. Based on this, they concluded that the level of similarity between the marks was low. The Applicant went on to claim that a comparison of the respective Class 9 goods in both of the marks revealed them to be dissimilar. A global assessment of the respective marks would, therefore, lead to the conclusion that confusion would not be likely to occur.

The Applicant disputed the Opponent's argument that the latter's mark has a reputation in Ireland and the EU and stated that this had not been proven.

The Applicant's submission concluded by stating that he had no intention to attempt to deceive the public. He went on to say that "his only intention is to assist in bringing easy access to electric car owners of their charging units".

The Opponent filed written submissions on 14th April 2022. These submissions contained the key aspects of the case from the Opponent's perspective. They summarised the case made previously in their Notice of Opposition and in their submission filed under Rule 20.

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. The Opponent further contended that a comparison of the Class 9 goods of interest to both parties revealed particular similarity or overlap between them.

The Opponent went on to conclude that, given the strong similarities between the respective marks, the similarities in the nature of the respective Class 9 goods, and that the end users and the distribution channels to the marketplace are the same, a strong likelihood of confusion existed. This situation when considered with the judgement of the Court of Justice Sabel BV vs Puma AG case makes it quite clear that there is indeed a high risk of likelihood of confusion.

The Opponent's objection under Section 10(3) of the Act was based on the reputation of their mark in the European Union as outlined by the Statutory Declaration with accompanying exhibits filed on their behalf on 30th May 2019. They stated, in support of their claim, that a substantial number of people throughout the EU would know and recognise their mark. The reputation earned by it is indeed substantial and can support a claim under Section 10(3).

The Opponent argued that they had provided sufficient evidence to indicate that they would succeed in an action in the courts to establish that they had an earlier right, particularly relating to their company name, under Section 10(4) of the Act. They stated that the long use of the Opponents' company name and well-established Volkswagen brand, is clear indication that there is a good likelihood of establishing misrepresentation in the course of trade, and an action for passing off would therefore likely succeed.

The Opponent then proceeded to take issue with some of the claims made in the Statutory Declaration of the Applicant. This included an assertion that no evidence was provided to support the contention that a website was used to promote the Applicant's charging product in 2016, the evidence of sales of the Applicant's products and the amount spent on the promotion of these related to a period post the date of Opposition, June 2018, and so wasn't relevant, The Opponent also referred to inconsistencies in the evidence provided as to the origin of the name of the applied for mark. Additional supportive evidence provided by the Applicant such as a photograph of a car charger, a factory where the chargers were said to be manufactured, signage used on vehicles and premises, illustration of a company uniform, could not be dated or shown to have been used prior to the Opposition date. References to the SEAI grant for the installation of electric vehicle battery charger units could only have been applicable from the commencement of that system in 2018. The Opponent similarly contended that supporting items such as Completion Certificates, product advertisement and press articles could not be dated and did not show proof of use of the Applicant's mark

before the Opposition being filed. The Opponent went on to deny that the Applicant could claim a defence of trademark parody as this option wasn't open to them at the time the Opposition was filed. In summary, the Opponent reiterated their previously enunciated case that the basic requirements for an objection under Section 10 of the Act to succeed had been met. A likelihood of confusion had been shown when applying the well-established legal principles found in well-known case law.

Decision

15. In the Notice of Opposition dated 19 June 2018, the Opponent contended that the applied for mark is of such a nature as to deceive the public and protection of the mark would offend against Sect 8(3) of the Trademarks Act 1996. It was also contended that use of the mark in the State is prohibited by the enactment and rule of law and by any provision of Community law under Sect 8(4)(a) of the Act. No evidence was subsequently filed in support of the Sect 8 objections. There is nothing contained within the mark applied for that could be described as deceptive. The mark of itself does not offend against Section 8(3)(b) of the Act and, therefore, the opposition must be rejected in respect of that ground.
16. No evidence was offered in support of the ground that use of the mark is prohibited in the State by an enactment or rule of law or by any provision of Community law. The mark does not offend against Section 8(4)(a) of the Act, and, therefore, I must reject the opposition on that ground also.
17. Turning to Section 10(2)(b), it is evident that four basic requirements must be met in order for an objection under it to succeed. They are (i) there must be "an earlier trademark", (ii) the mark applied for must be similar to that earlier trade mark, (iii) the goods of the application must be identical with or similar to those in respect of which the earlier trade mark is protected, and (iv) there must be a resultant likelihood of confusion on the part of the public.
18. The first of these conditions is clearly fulfilled in this case. The Opponent's mark was filed, at the European Union Intellectual Property Office (EUIPO), prior to 30th November 2017 (the relevant date) and by virtue of Section 11(1)(b) of the Act, is an earlier trademark as against the present application for the purposes of Section 10.

Comparison of the marks

19. I have compared the respective marks of the parties on the criteria of visual, aural, and conceptual similarity and have made 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 would, in my opinion, make on the average consumer of the goods for which the Applicant is seeking protection. The European Court of Justice has noted (*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.
20. There is visual, aural, and conceptual similarity between the marks. Visually, the Applicant's mark consists of a word mark "**VoltsWagon**". In my opinion the Opponent's word mark "**Volkswagen**" shares a high level of visual similarity with the Applicant's mark. I would, therefore, assess the level of visual similarity as being high.
21. The first syllable of the Opponent's mark, "Volks" shares a high aural similarity with the first syllable of the Applicant's mark, "Volts". Similarly, the second syllables of both marks, "wagen" and "Wagon" respectively share a high aural similarity. When compared as a whole, "Volkswagen" and "VoltsWagon" a high level of similarity.
22. The assessment of a mark from a conceptual perspective cannot be carried out in complete isolation from the goods or services covered by the mark. which reinforces the shared conceptual meaning between of the marks. Therefore, I find there is a high conceptual similarity between the marks at issue.
23. Having compared the marks from a visual, aural, and conceptual view I am satisfied that, overall, they share a high level of similarity.
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Comparison of the goods

24. The Applicant is seeking protection of his mark for “*electric vehicle charging units*” in Class 9. Therefore, the goods for which the Applicant is seeking protection are similar or identical to those contained in Class 9 of the Opponent’s earlier mark. In particular, these include “*voltage regulators for vehicles*”, “*electric batteries and parts therefor*”, “*electric accumulators and parts therefor*” “*chargers for electrical batteries*” and “*apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity*”.

Likelihood of confusion

25. The CJEU guidance to decision-makers, can be summarised as follows: *Imagine a typical purchasing scenario involving the average person who already knows the product sold under the earlier trade mark and ask yourself whether it is likely that he will select and purchase a product bearing the mark put forward for registration in the mistaken belief that it is the product he knows by the earlier mark (direct confusion) or that it is related to that product (indirect confusion by association).* The confusion in question may be direct confusion, whereby the Applicant’s product is mistaken for that of the Opponent, or indirect confusion, whereby the Applicant’s product is associated in the mind of the consumer with that of the Opponent and a common commercial origin is inferred. It is not necessary to find that every consumer would be confused and nor is it sufficient to find that some consumers might be confused in order to refuse registration of a trademark under the section. The question is whether it is likely or unlikely that the average person would be confused during the typical purchasing scenario.

26. In Case No C-251/95, Sabel BV –v- Puma AG and Rudolph Dassler Sport, the CJEU declared that the more distinctive a trademark is, whether inherently or by virtue of the use that has been made of it, the greater will be the likelihood of confusion arising from the subsequent use by another undertaking of a similar mark in relation to similar goods. The Opponent’s marks may be regarded as having a high degree of inherent distinctiveness. They have the capacity to identify the goods for which they are registered as being those of a particular undertaking and thus to distinguish those goods from those of other undertakings. The Opponent is long established, recognised easily and well known in the State. It has acquired substantial additional distinctiveness through use and promotion.

27. There is no doubt that most of the public of the State were aware of the Volkswagen brand prior to the relevant date, particularly for motor vehicles and their parts. The Applicant has claimed no confusion has ever arisen in view of the high level of awareness of the Opponent's marks. I consider it unlikely that no future likelihood of confusion would occur.

28. In my opinion, there is a real likelihood that a consumer, who has used the Opponent's goods or who has an awareness of them, as many would, would, when encountering the Applicant's mark, be liable to be confused or be led to believe that the Applicant's mark is associated with those of the Opponent. I find; therefore, the mark offends against Section 10(2)(b) of the Act and the application must be refused.

Section 10(3)

29. There are a number of conditions which must be fulfilled in order for an opposition to succeed under Section 10 (3) of the Act, which is written in the following terms:

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

30. Firstly, there must be identity or similarity of the marks at issue; secondly, there must be similarity between the respective goods; thirdly, the earlier mark (or marks, as in this case) must have a reputation in the State; 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 mark

31. I have already found that the first two conditions have been met – there is a high level of similarity with the Opponent's mark, there is the required similarity in respect of all the goods applied for. The evidence provided by the Opponent shows that its mark enjoys extensive market share, has intensive geographical penetration, is well known and that significant investment in it has been undertaken. Considering the foregoing, it is fair to say the Opponent's mark enjoys a reputation in the State. To be viewed as a well-known trade mark its reputation would be expected to extend beyond the limited class of consumers of the Opponent's goods and to penetrate the consciousness of the wider public such that a substantial number of people would know and recognise the mark even if they had never

used the Opponent's goods. In my opinion, the Opponent's Volkswagen mark had on the relevant date, reached that level of recognition.

32. The Applicant claimed in his evidence, filed by way of a statutory declaration under Rule 21, that his mark name resulted from the conjunction of two words, Volts and Wagon, and alluded to something that would give a vehicle electrical power with a car charger. That may well be the case but it doesn't overcome the prohibition on marks being registered that are identical with or similar to an earlier trade mark if 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. I therefore find that the Applicant does not have due cause to seek registration for the disputed mark.

33. I must now consider whether the disputed mark would take unfair advantage of, or be detrimental to, the Opponent's earlier marks. To find in favour of the Opponent on this ground I do not have to find that the Applicant's actions were both unfair and detrimental - it is sufficient that only one of the conditions be met. Looking firstly at detriment, it is, in my opinion, unlikely that "blurring" might occur, whereby the Volkswagen mark's capacity to identify the goods marketed under it as being those of the Opponent would be eroded over time by the use of a similar mark in relation to goods that have another commercial origin.

As regards unfair advantage, in my opinion, the Applicant must have been aware of the Opponent's mark, and the similarity between it and his. In deciding on the name for his mark, the Applicant created the possibility of taking advantage of the reputation of the Opponent's earlier renowned mark by coat-tailing on the high level of public awareness of it, in order to promote interest in the Applicant's own goods. The advantage gained is by way of savings on investment in marketing and advertising of its goods because the Applicant could benefit, in an unfair manner, from the power of attraction of the Opponent's mark and the high level of investment by the Opponent in it. Therefore, the application offends against Section 10(3) of the Act and must be refused.

Section 10(4)(a)

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

“A trade mark shall not be registered if, or to the extent that, its use in the State is liable to be prevented –

(a) 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,”

35. In my opinion, the proper application of Section 10(4)(a) insofar as the question of passing off is concerned requires a determination by the Controller as to whether the fundamental ingredients of an action for passing off would be present if the mark for which registration is requested were used in the State by the Applicant. A decision one way or the other on that question does not amount to a finding of fact as to whether there is or has been passing off as that is clearly a matter for the Court to decide in any given case.

36. In order to succeed in its opposition under this Section, the Opponent must establish that the use by the Applicant of the disputed mark in relation to the goods covered by the application would, as of the relevant date, have constituted a misrepresentation that those goods were the goods of the Opponent and that such misrepresentation is calculated to damage the business, goodwill or reputation of the Opponent (in the sense that this is a reasonably foreseeable consequence) and that actual damage will be caused or will probably be caused. I have already found that the Opponent’s Volkswagen mark is entitled to protection as a well-known trademark and that it had a reputation as referred to in Section 10(3). However, I am satisfied that when the Applicant applied for the mark, he may not have been aware of the Opponent’s trade in the same goods as those applied for. There is no evidence that points to the Applicant attempting to pass off or misrepresent his goods as those of the Opponent’s or of him setting out with an intention to damage the Opponent’s business. While I have found that the Applicant was attempting to take unfair advantage of the Opponent’s mark, on balance, I find that the Applicant was not seeking to pass off his goods as those of the Opponent and therefore I reject the opposition in respect of Section 10(4) of the Act.

37. The Opponent also claimed that registration of the Mark should be refused as the Applicant has failed to use or have a bona fide intention to use their mark in relation to the goods applied for. This contravenes Sections 37(2) and 42(3) of the Act.

38. After full consideration of the submissions filed, I could find no evidence to support this contention and so I reject the opposition in respect of Sections 37(2) and 42(3) of the Act.

39. For the reasons outlined above, I have decided to uphold the opposition and to refuse to allow the mark to proceed to registration based on Sections 10(2)(b) and Section 10(3) of the Trade Marks Act 1996.

John Nolan

Acting for the Controller

29th June 2023