

TRADE MARKS ACT, 1996

Decision in Hearing

IN THE MATTER OF an application for registration of Trade Mark No. 218845 and in the matter of an Opposition thereto.

MICHAEL A. CONWAY

Applicant

MOUNT JULIET ESTATES

Opponent

The application

1. On 24 July, 2000, Michael A. Conway, an Irish citizen, of 29 Beechwood, Castletroy, Limerick made application (No. 2000/02764) under Section 37 of the Trade Marks Act, 1996 ("the Act") to register the words "THE MOUNT JULIET WEIR" as a Trade Mark in Class 29 in respect of "*meat, fish, poultry, game, preserved, dried and cooked fruits and vegetables, jams, fruit sauces, eggs, milk and milk products, edible oils and fats*".
2. The application was accepted for registration and advertised accordingly under No. 218845 in Journal No. 1920 on 11 July, 2001.
3. Notice of Opposition to the registration of the mark was filed under Section 43 of the Act on 10 October, 2001 by Mount Juliet Estates, an Irish company, of Mount Juliet, Thomastown, Co. Kilkenny. The Applicant filed a counter-statement under Rule 19 of the Trade Marks Rules, 1996 ("the Rules") on 14 January 2002 and the Opponent filed evidence in support of the opposition under Rule 20 on 4 October, 2002.
4. The matter became the subject of a Hearing before me, acting for the Controller, on 22 May, 2006. The parties were notified on 2 June, 2006 that I had decided to uphold the opposition and to refuse registration of the mark. I now state the grounds of my decision and the materials used in arriving thereat.

Notice of Opposition

5. In its Notice of Opposition the Opponent said that it had carried on business for many years “*under the MOUNT JULIET Trade Mark*”. It referred to its proprietorship of the trade mark registrations listed in Appendix I and then raised objection to the present application under the following Sections of the Act:

- Section 10(2) – *likelihood of confusion on the part of the public,*
- Section 10(3) – *use of mark would take unfair advantage of, or be detrimental to, distinctive character or reputation of Opponent’s mark,*
- Section 6(1) – *mark not capable of distinguishing the Applicant’s goods*
- Section 8(4)(a) – *use of mark prohibited by enactment or rule of law protecting unregistered trade mark, in particular, the law of passing of,*
- Section 8(4)(b) – *application for registration made in bad faith,*
- Sections 37(2) – *Applicant does not use or intend to use mark in relation to goods covered by application.*

Counter-Statement

6. In a letter dated 14 January, 2002, which was taken to be the Applicant’s Counter-Statement, the Applicant asserted that his application was valid, that it was not designed to conflict with the Opponent’s registrations, that it was to be registered in a “*free class (29)*”, i.e., not in any of the Classes in which the Opponent’s marks are registered.

The evidence

Rule 20

7. Evidence submitted by the Opponent under Rule 20 consisted of a Statutory Declaration (and Exhibits EXH1-EXH8), dated 24 September, 2002, of Dymphna Kelly, its Financial Controller. The salient points of that Declaration are as follows:

- the Mount Juliet estate occupies some 1,500 acres and, since 1989, has been operated as a hotel and country resort offering guests a range of outdoor activities including bicycling, walking, horse-riding, clay shooting, archery, fishing and golf,

- the hotel has two main restaurants, one of which offers “*classic fine dining*”, and has won awards including “AA Hotel of the Year” (1999), RAC Gold Ribbon (1999/2000) and RAC 4-star status (2001),
- two large rivers run through the estate, which hosted the Worldwide Trout Open in 1999,
- part of the River Nore within the estate is known as the “Weir Pond” which has an eel weir that was built in 1762,
- the estate includes a championship golf course designed by Jack Nicklaus which was opened in 1991 and has attracted a number of prestigious events,
- the Opponent’s turnover and advertising expenditure for the period 1997-2001 were approximately €37 million and €2 million, respectively,
- the Opponent markets a range of goods bearing “*the MOUNT JULIET Mark*” including golf paraphernalia, men’s and ladies’ clothing and luggage.

Correspondence with Applicant re. filing of evidence

8. Following the filing by the Opponent of evidence under Rule 20, the attention of the Applicant was directed to Rule 21 and he was informed that evidence under that Rule should be filed by 8 January, 2003. On 29 January, 2003, the Applicant wrote to the Office requesting an extension of time “*in which to submit the Counter Statement*” and enclosed with that letter a document headed “COUNTER STATEMENT” in which he reiterates his earlier contentions with regard to the validity of his application and offers a rebuttal of certain of the claims made by Ms. Kelly in her Statutory Declaration filed under Rule 20. On 8 April, 2003, the Applicant filed a Statutory Declaration made by him and dated 10 January, 2003 in which he avers that secretarial and other difficulties delayed the submission of his counter-statement and that, as a result he required “*an extension of time in which to submit the counter statement provided for under rule 21*”. In response, the Office granted an extension of time for the filing of evidence under Rule 21

and, following a subsequent request, also granted a further extension to 9 October, 2003. At that point, the Opponent wrote to the Office expressing concern at the delay in the filing of the Applicant's evidence.

9. On 9 October, 2003, the Applicant informed the Office that the evidence that he had presented to date represented his full evidence. The Office subsequently wrote to the Opponent, enclosing a copy of the Applicant's "COUNTER STATEMENT" filed on 29 January, 2003, which did not appear to have been copied to the Opponent by the Applicant, and inviting the Opponent to file evidence under Rule 22. In response, the Opponent objected to the admissibility of the latter document as evidence under Rule 21 on the basis that it was not in the form of a Statutory Declaration. The Office accepted that submission and, on 8 January, 2004, wrote to the Applicant noting that no admissible evidence had been filed under Rule 21 and that the question of the filing of evidence by the Opponent under Rule 22 did not therefore arise. In the circumstances, it was proposed to determine the opposition on the basis of the admissible documents, namely, the Notice of Opposition, the Counter-Statement dated 12 January, 2002 and the Opponent's evidence under Rule 20. The Official letter, which was copied to the Opponent, stated that a hearing would be appointed in due course, at which time the parties would have the opportunity to make oral submissions in support of their cases.

The hearing

10. At the hearing the Opponent was represented by Niamh Hall, Trade Mark Agent of F.R. Kelly & Co. and the Applicant appeared in person. Ms. Hall stated that the Opponent intended to pursue the opposition on all of the grounds mentioned in the Notice of Opposition except for that under Section 37(2) concerning the Applicant's intention to use the mark. As regards the other grounds, Ms. Hall contended that the Opponent enjoyed registered and unregistered rights in its "*MOUNT JULIET Mark*", including in relation to the provision of food and beverages, and that the use by the Applicant of the trade mark THE MOUNT JULIET WEIR in relation to the goods of the application was bound to lead to confusion as to the commercial origin of those goods, having regard to the fact that the distinguishing feature of both marks is the name "Mount Juliet". She

asserted that the use of the mark propounded for registration would take unfair advantage of the Opponent's mark and could be detrimental to it. Finally, she asserted that the application for registration must have been made in bad faith by the Applicant in an attempt to trade off the Opponent's reputation and pointed to the fact that the Applicant had offered no explanation of how he came to adopt a trade mark incorporating the Opponent's name.

11. In response, the Applicant denied that his application for registration was motivated by any improper intention on his part and stated that the several trade mark applications that he has filed¹ were all made in pursuit of legitimate business plans that he intends to pursue in the future. He rejected the Opponent's claims to have an entitlement to prevent the use of the present mark in relation to goods in Class 29 on the basis that the Opponent has failed to register its trade mark in that class and, by so doing, has disclosed a lack of interest in the relevant goods. As to how he came to adopt the trade mark THE MOUNT JULIET WEIR, he stated, quite simply, that the greater part of the weir in question is on his property at Thomastown, Co. Kilkenny and it therefore seemed a suitable name under which to market his goods. In support of this latter statement, the Applicant showed photographs and maps which he said would establish his proprietorship of the weir. This was all objected to by Ms. Hall on behalf of the Opponent on the basis that it constituted evidence that could, and should, have been formally filed under Rule 21 and which should not be sprung on the Opponent by surprise at the hearing. She also rejected a suggestion that appeared to be made by the Applicant to the effect that the name "Mount Juliet" is used by persons in the locality to designate an area that extends beyond the Mount Juliet estate itself, i.e., an area other than the Opponent's property. In response to questions that I put to him, the Applicant stated that he had not put in evidence as to his proprietorship of property adjacent to the Opponent and including part of the weir referred to in the trade mark because he had not thought it necessary to do so and that the fact was well known to the Opponent. He also informed me that the postal address of the residence on the property in question is "Station Road, Thomastown".

¹ The fact of the Applicant having made a number of trade mark applications was referred to in Ms. Kelly's Statutory declaration under Rule 20 in which it was suggested that the Applicant was attempting to trade in trade marks which he, himself, had no intention to use.

Decision

12. Of the grounds of opposition cited in the Notice of Opposition, those raised under Sections 6(1) and 37(2) of the Act have not been supported by any evidence or argument and may be dismissed accordingly as unsubstantiated. There remain, therefore, only the alleged *mala fides* on the part of the Applicant and the alleged conflict between the mark propounded for registration and the Opponent's claimed earlier rights, viz., the objections grounded on Sections 8(4)(a), 8(4)(b), 10(2) and 10(3). I deal with each in turn below, leaving Section 8(4)(a) till last for reasons that will become apparent.

Section 8(4)(b) – was the application for registration made in bad faith by the Applicant?

13. Section 8(4)(b) of the Act provides that a trade mark shall not be registered if, or to the extent that, the application for registration is made in bad faith by the applicant. In previous decisions², I have held that, unless there is an obvious appearance of bad faith on the part of an applicant from the circumstances of an application, it is for an opponent alleging bad faith to adduce some concrete evidence in support of that charge, failing which the onus does not pass to the applicant to disprove it. In this case, the Opponent has advanced its objection on this ground on the basis of the former contention, i.e., that the application is *prima facie* wanting in *bona fides*, rather than on the basis of evidence of, for example, any misuse of the mark by the Applicant in the course of trade. The Applicant has denied that there is any appearance of bad faith in the making of the application and has indicated that he saw no need to offer evidence in response to it, although he offered an explanation for his adoption of the mark at the hearing.

14. In my opinion, this is a case in which there is a sufficient appearance of bad faith in the making of the application for registration such that, the charge of bad faith having been raised, the onus falls on the Applicant to disprove it. I say that

² Decision dated 21 February, 2005 in respect of Trade Mark No. 213120 (1999/01340) *AFFEX* in Class 5 in the name of Fujisawa Deutschland GmbH and opposition thereto by Wyeth; decision dated 29 August, 2005 in respect of Trade Mark No. 216722 (2000/00717) *ZIMOCLONE* in Class 5 in the name of McDermott Laboratories Limited, t/a Gerard Laboratories and opposition thereto by May & Baker Limited.

because of the occurrence in the mark put forward for registration of the name "Mount Juliet". As far as I am aware (and there is no suggestion to the contrary on the part of the Applicant), that name has no meaning in this jurisdiction other than as the name of the property owned by the Opponent. Its incorporation in a trade mark put forward for registration by a person other than the Opponent must, therefore, raise the question of why the name is being so used, if not to create an association with the Opponent's property and the commercial activity undertaken by the Opponent there. It seems improbable, for example, that the name would be chosen independently by the Applicant and without any thought for the fact that it is the name under which the Opponent operates a substantial business. In the absence, therefore, of evidence of a legitimate reason for the use by the Applicant of the name Mount Juliet as part of his trade mark, I would conclude that the application for registration must be motivated by a dishonest intention and that it should be refused as having been made in bad faith.

15. That brings me to the question of the explanation offered by the Applicant at the hearing and the Opponent's objection against the admissibility of that explanation. In that regard, it must be observed that the Rules provide a clear framework within which the evidence of the parties to proceedings before the Controller is to be presented. That evidence is to be given by Statutory Declaration³ and any such Statutory Declaration may, in the event of an appeal, be used in lieu of evidence on affidavit and, if so used, shall have all the incidents and consequences of evidence on affidavit⁴. The purposes of these requirements are clear in that they serve, firstly, to ensure that any and all matters of fact that may be relevant to the case in dispute are fully disclosed prior to the hearing and, secondly, that persons giving evidence do so under pain of the statutory penalties prescribed for making false statements. A departure from the normal procedure may only be allowed in exceptional circumstances and, even then, may only occur within the scope of the relevant statutory provisions, e.g., a request for leave to adduce further evidence under Rule 23 or a request for the Controller to exercise his discretion under Section 92(1) of the Patents Act, 1992 to take evidence *viva voce*.

³ Rules 20-23

⁴ Section 92(2) of the Patents Act, 1992

16. In the present case, the Applicant did not file any evidence in accordance with the relevant statutory provisions and did not signal to the Controller or to the Opponent any intention to seek to remedy that deficiency by offering evidence *viva voce* at the hearing. While that may have been because the Applicant was not fully seized of the significance of the provisions with regard to the filing of evidence and the importance of adhering thereto, nevertheless, it leads me to the conclusion that it would be very wrong to regard the explanation for the adoption of the mark offered at the hearing as constituting admissible evidence. I have decided, therefore, to disregard it in its entirety. That being the case, there is no evidence before me to explain the adoption by the Applicant of a trade mark that contains the name of a commercial property not owned by him. The appearance of bad faith that arises from his adoption of that mark is therefore not dispelled and I am left to conclude that the application for registration was made in bad faith and must be refused under Section 8(4)(b) of the Act.

17. If I am wrong in this and it is found that I should have taken account of the explanation given by the Applicant for his adoption of the mark, then I record for the sake of completeness that that explanation would not change my decision on this aspect of the opposition. The question of whether or not an application for registration is made in bad faith must be judged objectively and measured against the behaviour that would be expected of any responsible person acting in a fair and honest manner. So, for example, Lindsay J observed in the English High Court in *Gromax Plasticulture Ltd. -v- Don & Low Nonwovens Ltd.* [1999] RPC 367 that, in addition to dishonesty, bad faith includes “*dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined*”. Even taking at face value the Applicant’s statement to the effect that this particular weir, which he calls “the Mount Juliet weir”, lies mainly within his property, that does not make his adoption of the *trade mark* THE MOUNT JULIET WEIR any less objectionable. The “Mount Juliet” element of that trade mark names the Opponent’s business and property and the fact that the Applicant may own a piece of real estate that spans both his property and that of the Opponent does not give him any licence to adopt the Opponent’s name for use in a trade mark for his goods. A resident of St. James’ Street, Dublin could not, in good faith, adopt the

trade mark THE GUINNESS BREWERY STREET and nor can the Applicant adopt for use in the course of trade a name that identifies another commercial undertaking in such an obvious manner simply because the undertaking in question is his neighbour. In my opinion, the likely inconvenience (to put it at its mildest) to the Opponent of the proposed use by the Applicant of the mark in question would be obvious to any reasonable person and I could not regard the explanation given by the Applicant as constituting valid grounds on which to ignore that inconvenience and proceed to seek to register the mark regardless. So, even allowing for the Applicant's explanation, I would still regard the application for registration as objectionable under Section 8(4)(b) of the Act.

Section 10(2) – is there a likelihood of confusion on the part of the public?

18. The relevant part of Section 10(2) of the Act, insofar as the present application is concerned, reads as follows:

“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.”

19. For this ground of opposition, the Opponent relies on the trade mark registrations listed in Appendix I, all of which constitute “earlier trade marks” as against the present application within the meaning of the Act. Nor is there any doubt but that the trade mark propounded for registration by the Applicant is similar to those earlier trade marks. While the Opponent's mark contains a significant figurative element, the name MOUNT JULIET is still the primary identifier within it as that is the only name by which the mark may be expressed in speech and it is also the element of the trade mark that is unique to the Opponent. The use of the name MOUNT JULIET in the Applicant's mark, albeit as part of the term THE MOUNT JULIET WEIR, means that the primary distinctive element of the

Opponent's mark is reproduced in the Applicant's and the two must, therefore, be regarded as similar.

Similarity of goods/services

20. The other criteria to be met in order for the objection to registration under Section 10(2) to apply are that the respective goods/services are similar and that there is a consequential likelihood of confusion on the part of the public. As to the first of these, the Opponent's case is that "*catering services, restaurant services, bar and lounge services, hosting and nourishing guests and hotel services*", for which its earlier trade mark is protected, should be regarded as similar to the goods of the application because both the goods and services in question are acquired for the purposes of meetings the physical need for food and nourishment and the provision of the services necessarily involves the supply of the goods. At the hearing, the Applicant did not directly deny that assertion but insisted that the goods for which he seeks protection are in a separate class to the services of the Opponent's registrations and must, therefore, be treated as separate and distinct from those services.

21. In considering this aspect of the matter, I have had regard in particular to the remarks of the European Court of Justice (ECJ) in the case of *Canon Kabushiki Kaisha -v- Metro-Goldwyn Mayer Inc.* (Case C-39/97). In that case, the ECJ considered the criteria to be taken into account when assessing the similarity of the goods or services covered by two marks. Among the factors influencing its decision in that regard, it considered the tenth recital of the preamble to Council Directive 89/104/EEC to the effect that "*it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion*". Having regard to that sentiment, the ECJ held that *the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion*". In my opinion, that finding supports the principle that, when comparing goods and services for the purposes of Section 10 of the Act, it is correct to look not only at the "traditional" criteria such as the respective uses, consumers and trade channels of the goods/services, but also to consider the

perception of the average consumer and the question of whether the respective goods and services would be perceived as so different as to obviate the possibility of confusion notwithstanding the use in relation to each of similar trade marks.

22. Looked at in that light, I think that there is merit in the Opponent's argument on the point and that the goods of the present application should be regarded as being at least somewhat similar to the services mentioned above in respect of which the Opponent's earlier trade mark is protected. In particular, I think that it is fair to have regard to the average consumer's familiarity with the practice of brand extension whereby trade marks established in relation to certain goods/services may be extended to other goods/services, which, while not directly similar to those in respect of which the marks have become known, represent a good "fit" for optimising the brand value of the mark for its proprietor. In the case of restaurant services, on the one hand, and foodstuffs, on the other, I think that the average person would perceive an obvious potential for brand extension from one to the other and that, in the context of an assessment of the likelihood of confusion, it would be unrealistic to say that the respective services and goods are entirely dissimilar. For that reason, I find that certain of the services covered by the Opponent's earlier trade marks are similar, if only slightly so, to the goods of the present application and that it is in order to assess whether there is a resultant likelihood of confusion.

Likelihood of confusion

23. The criteria to be considered in making that assessment are well established and have been stated comprehensively at paragraphs 17-27 of the decision of the ECJ in the case of *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* (Case C-342/97). In summary, it may be said that the likelihood of confusion must be appreciated globally, having regard to the degree of similarity between the respective marks and the respective goods/services, the distinctiveness of the earlier mark and the likely perceptions of the average consumer, who is to be regarded as reasonably observant and circumspect but who will rarely have the opportunity to make a direct comparison between the marks and must rely on the imperfect picture of them that he keeps in his mind.

24. In the present case, the Opponent's mark is highly distinctive in that it bears no relation to the services for which it is protected or, indeed, to any goods or services. By its nature, it evokes the concept of a particular place, even to persons not familiar with the fact that a place called Mount Juliet actually exists, and the effect of this is that consumers exposed to the mark would perceive that the services provided under it emanate from or have their origin in that particular place. The Applicant's mark also expresses the concept of a particular physical location, a weir, that is in or upon the same place named in the Opponent's mark. Conceptually, therefore, each mark must be understood as designating essentially the same piece of physical property from whence the products marketed under each would be assumed by the average consumer to emanate.

25. So, notwithstanding the relatively low level of similarity between the respective goods and services, the distinctiveness of the earlier mark and the virtual identity of the concepts evoked by the respective marks combine to create a likelihood of confusion on the part of the average person. Indeed, it is difficult to imagine what the average consumer might infer from the sale of foodstuffs such as those covered by the application under the trade mark THE MOUNT JULIET WEIR other than that the goods in question must be connected with the proprietor of the name and trade mark MOUNT JULIET. The goods under consideration are in no way specialised and their selection and purchase is not the subject of such careful consideration on the part of the average consumer that the likelihood of confusion arising from the similarity of the respective marks might be reduced or eliminated in practice. In the purchase of these items, consumers do not normally look beyond the trade mark or brand name to identify the origin of the different goods on offer and the impression that would be created in the mind of the average consumer by the trade mark THE MOUNT JULIET WEIR is that the product so marked is of and from Mount Juliet, i.e., the place identified by the Opponent's earlier trade mark. As a consequence, confusion on the part of the public is inevitable and the application for registration must also be refused under Section 10(2)(b) of the Act.

Section 10(3) – will the Applicant's use of the mark take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponent's mark?

26. Section 10(3) of the Act provides as follows:

"A trade mark which –

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

(b) 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.

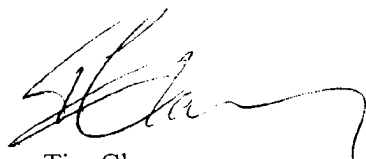
27. The effect of this provision is to give a broader degree of protection to trade marks that have an established reputation than would otherwise be the case and the first thing that must be considered in determining the objection under this Section is whether the evidence shows that the earlier trade marks cited by the Opponent have the requisite reputation. That evidence consists of the Statutory Declaration of Dymphna Kelly which I have summarised very briefly in paragraph 7 above. As I pointed out to the Opponent's representative at the hearing, that Declaration suffers from the fundamental defect that the deponent does not at any stage properly define what she means by the term "the **MOUNT JULIET** Mark", which she uses throughout the Declaration, i.e., whether she means the Opponent's registered trade marks shown in Appendix I or simply the unregistered trade mark "Mount Juliet". At paragraph 10 of her Statutory Declaration, Ms. Kelly states that "*the famous **MOUNT JULIET** Mark is used for the provision of food services and indeed is protected in relation to "hotel and catering services, restaurant, bar and lounge services, health farm services and nourishing of guests"*", from which it may be assumed that she is referring in that instance to the Opponent's registered trade marks. However, the general thrust of Ms. Kelly's Statutory Declaration is to the effect that the Opponent operates a hotel on the Mount Juliet estate and I am not at all persuaded that the figures given with regard to turnover and advertising for that business may be ascribed to the Opponent's registered trade marks, *per se*, as opposed, simply, to the name Mount Juliet itself. Indeed, the registered trade mark appears on only two of the several

pages of documents exhibited by Ms. Kelly. Looked at in its totality, the Opponent's evidence is, in my opinion, entirely insufficient to prove that the registered trade mark MOUNT JULIET (and device), which is the "earlier trade mark" for the purpose of its objection under Section 10(3), enjoys the kind of reputation that is required to ground an objection to registration under Section 10(3) of the Act. For that reason, I have decided to dismiss the opposition under that Section.

Section 8(4)(a) – is the use of the mark prohibited by law?

28. Section 8(4)(a) of the Act provides that a trade mark shall not be registered if or to the extent that its use is prohibited in the State by an enactment or rule of law or by any provision of Community law. In its Notice of Opposition, the Opponent raised objection under this Section on the basis that the use of the mark propounded for registration "*is prohibited in the State by rule of law protecting an unregistered Trade Mark and in particular, an action for passing off*". An objection of that nature is normally, and properly, raised under Section 10(4)(a) of the Act which specifically prohibits the registration of marks whose use is "*liable to be prevented by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade*". It seems to me that the Opponent's objection, based as it is on its claimed entitlement to prevent the use of the Applicant's mark by means of an action for passing off, has been grounded on the wrong Section of the Act. That is particularly so when one looks at the difference in the purpose and effect of Sections 8(4)(a) and 10(4)(a), respectively, and at the actual wording of the Opponent's objection as expressed in the Notice of Opposition. The former Section excludes from registration marks whose use is ***prohibited*** by rule of law whereas the latter is concerned with marks whose use is ***liable to be prevented*** by virtue of any rule of law protecting an unregistered trade mark or sign. The difference, as I see it, is that the use of a given mark must be specifically and expressly prohibited by statute or other rule of law in order to fall within Section 8(4)(a) and that Section is not concerned with potential infringement of third party rights that might arise from such use, which is the specific subject matter of Section 10(4)(a).

29. Having raised its objection under Section 8(4)(a) and having supported that objection by stating that the use of the Applicant's mark is "*prohibited in the State by rule of law*", it is not open to the Opponent to seek to transform its objection into one under Section 10(4)(a) and based on its claimed rights to prevent passing off notwithstanding the reference to passing off in the Notice of Opposition. Of course, no evidence has been given of any enactment or rule of law that specifically **prohibits** the use of the trade mark THE MOUNT JULIET WEIR and so the objection under Section 8(4)(a) cannot succeed. Given that no objection under Section 10(4)(a) was raised in the Notice of Opposition, I do not propose to consider whether the present application is open to challenge under that Section.




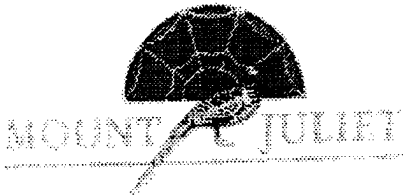

Tim Cleary

Acting for the Controller

5 July, 2006

APPENDIX I

Trade Mark Registrations cited in Notice of Opposition

Mark	No.	Date	Classes
	152476	6 August, 1991	18, 25, 28
	207178	23 September, 1997	41, 42
	909358 ⁵	18 August, 1998	18, 25, 28, 41, 42

⁵ Community Trade Mark