

**DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE MARKS
IN PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

In the matter of applications for registration of Trade Mark Nos. 253794 and 253948 and in the matter of Oppositions thereto.

AUTOKEY AUTOMOTIVE LIMITED

Applicant

(Represented by Robert Emmet Bourke Solicitors)

BARRY LYNCH and A AABOUND LIMITED

Opponent

(Represented by Baynes & Co. Solicitors)

The Applications

1. Autokey Automotive Limited, an Irish company, of Newlands Motor Centre, Newlands Cross, Dublin 22, Ireland made applications under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the following two marks as trade marks in respect of identical services, as listed:

<p>AUTOKEY</p> <p>Application Number 2015/00242</p> <p>Application Date 2/2/2015</p> <p>Registration Number 253948</p>	<p>Class 37: Motor vehicle maintenance and repair; repair and installation services for motor-vehicle locks, keys, windows and doors; installation, maintenance and repair of computer hardware for motor-vehicle keys and locks; vehicle battery charging; vehicle breakdown assistance (repair); vehicle roadside repair services; vehicle service stations (refuelling and maintenance); locksmith services for motor vehicles (repair and installation).</p> <p>Class 39: Vehicle breakdown assistance (towing); collection and delivery of motor vehicle keys and motor vehicle spare parts; vehicle roadside recovery services.</p>
<p>AutoKey</p> <p>Application Number 2015/00465</p> <p>Application Date 7/3/2015</p> <p>Registration Number 253794</p>	<p>Class 40: Key cutting and key duplication services for motor vehicles; locksmith services for motor vehicles (key cutting and duplication).</p> <p>Class 42: Installation, maintenance and repair of computer software for motor-vehicle locks and keys; testing of vehicles; installation, maintenance and repair of computer software for motor vehicles.</p> <p>Class 45: Opening of security locks for motor vehicles; motor vehicle door unlocking services.</p>

2. Application number 2015/00465 was accepted for registration under number 253794 and advertised accordingly in Journal No. 2296 dated 16 December 2015 and application number 2015/00242 was accepted for registration under number 253948 and advertised accordingly in Journal No. 2299 dated 27 January 2016.
3. Notices of Opposition to the registration of the both marks pursuant to Section 43 of the Act were filed on 9 March 2016 in the dual names of Barry Lynch, of Raheny, Dublin 5, Ireland and A AABOUND Limited, of Capel Street, Dublin 1, Ireland. The Applicant filed counter-statements on 13 June 2016 and evidence was, in due course, filed by the parties under Rules 20, 21 and 22 of the Trade Marks Rules, 1996 (“the Rules”). Throughout the course of both proceedings identical evidence and arguments were advanced in respect of both oppositions by the parties involved. Also, at no time did either of the named opponents identify any evidence or argument that was relevant solely to them and not to the other opponent. Accordingly, and in order to avoid unnecessary duplication, I have combined my deliberations and reasoning behind my decisions in respect of both oppositions into these written grounds. Furthermore, for simplicity, as Mr. Lynch is a director of the second named opponent I shall hereafter refer to Mr. Lynch and A AABOUND Limited as “the Opponents”.
4. One Hearing was held in respect of the combined matters. Acting for the Controller, I decided to dismiss the oppositions and to allow the applications to proceed to registration. The parties were informed of my decision by way of letter dated 11 December, 2017. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Opponent in that regard pursuant to Rule 27(2) of the Trade Mark Rules 1996.

Grounds of the Opposition

5. In their Notices of Opposition, the Opponents raise objection to the two applications under various Sections of the Act, which I shall summarise as follows:
 - Section 8(1)(b) – *the marks are devoid of distinctive character;*
 - Section 8(1)(c) – *the marks consist exclusively of signs or indications which relate to characteristics of the services;*
 - Section 8(1)(d) – *the marks consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;*

- Section 8(4)(b) – *the applications were made in bad faith.*

In respect of the grounds based on Section 8(1) the Opponents claim the Applicant's trade marks have not in fact acquired distinctiveness as a result of the use made of them.

6. As regards their bad faith grounds, the Opponents claim the Applicant has behaved in a manner which has fallen short of the acceptable commercial standards observed by reasonable and experienced traders in the motor locksmith industry. The Opponents detail the history of disputes between the parties concerning websites and domain names. Threats of legal proceedings were made on numerous occasions from May 2012 by the Applicant to the Opponents regarding the use of certain domain names. The threats continued without follow-up through to September 2015, at which point High Court proceedings were finally initiated. The Opponents claim the Applicant acted in bad faith by not following up its threatened legal action for three years, and that it acquiesced in respect of the Opponents' use of certain website domain names. The Opponents claim the Applicant's recent (2015) acquisition of five named websites which (the Opponents claim) are copycats of some of the Opponents' websites, also constitutes bad faith. The Opponents also claim the application for the trade marks at issue represents another part of the Applicant's concerted campaign to put unfair commercial pressure on the Opponents.

Counter Statement

7. In its Counter Statement the Applicant denies all the claims made in the Notices of Opposition. The Applicant agrees with certain statements made by the Opponents but calls on the Opponents to provide proof of others. The Applicant admits that High Court proceedings were initiated in order to enforce its rights in its trade marks, but states the High Court case is of no relevance to these proceedings. The Applicant claims the Notices of Opposition represent a further attempt in a concerted campaign by the Opponents to interfere in the Applicant's business and to ride on its coat-tails and take unfair advantage of the time, money and effort expended by the Applicant since 2008 in developing its AUTOKEY mark. The Applicant concludes its Counter Statement by claiming the Oppositions are frivolous and vexatious and they should be dismissed and an award of costs made in the Applicant's favour.

Rule 20 Evidence

8. Evidence submitted by the Opponents under Rule 20 in support of both oppositions consists of a Statutory Declaration, dated 7 September 2016, of Barry Lynch, and a booklet labelled “BL” which consists of evidence set out under 18 “Tabs”.
9. In his Statutory Declaration Mr. Lynch confirms the four grounds of opposition as outlined in the Notices of Opposition and addresses in detail the bad faith grounds. He says he has traded as a locksmith since approximately 2000, first as a sole trader in his own name, and subsequently through the Second Opponent, which was incorporated on 3 October 2003. He provides at “Tab 1” a copy of the Companies Registration Office printout detailing that incorporation. He states the Second Opponent trades as Dyno Lock and/or Dyno Locks & Alarms, which provides all manner of locksmith services and that the ‘Dyno’ brand is now owned by British Gas.
10. Mr. Lynch states that in addition to business obtained by the Opponents in the usual manner through referrals and goodwill, they use multiple websites to channel business back to one administrative location in Dublin 1. The Opponents have registered approximately 235 websites, of which approximately 35 are currently in use. He provides a list of the websites the Opponents use at “Tab 2”.
11. Mr. Lynch states the websites operate on a principle of search engine optimisation to provide the Opponents’ websites with the highest possible ranking on search engines. One method through which this is done is the use of meta elements known as keywords. He provides a copy of a document produced by Google explaining the principles of optimisation at “Tab 3” of the booklet. He explains that certain of the Opponents’ websites use the keywords ‘Autokey’, ‘auto key’, ‘autokeys’ and ‘auto keys’ to maximise their search engine ranking as these are terms commonly used in searches for car key replacement services. He says the Applicant has adopted a similar marketing strategy and that the parties have been in dispute over the following websites:

www.autokey.ie, owned by Jason Coogan (director of the Applicant) as of March 2008

www.autokeys.ie, owned by Barry Lynch as of February 2009

www.autokeydirect.com, owned by Barry Lynch as of December 2013

www.autokeydirect.ie, owned by Jason Coogan as of February 2015

www.autokeydublin.ie, owned by the Applicant as of February 2015

www.autokeycork.ie, owned by the Applicant as of February 2015

www.auto-keys.ie, owned by the Applicant as of February 2015

12. Mr. Lynch provides evidence by way of correspondence between his solicitor and IE Domain Registry Limited confirming the ownership of the above listed and other websites at “Tab 4”. He then focuses on the differences in terms of style and visual appearance of the parties’ respective websites (printouts of which he attaches at “Tab 5” and “Tab 6”). Notwithstanding these differences, he says Jason Coogan’s solicitors wrote to him on 15 May 2012 threatening proceedings for misrepresentation, imitative trading and passing-off due to his use of the website www.autokeys.ie. He encloses a copy of the letter at “Tab 7”. He then goes on to provide details of the follow-up correspondence issued up to August 2015, which widened the scope of the complaint to include the website www.autokeydirect.com, and enclosed copies at “Tab 8” to “Tab 17”. In September 2015 the Applicant issued High Court proceedings against the Opponents and he encloses at “Tab 18” a copy of the Plenary Summons.
13. Mr. Lynch repeats the claims made in the Notices of Opposition that the actions of the Applicant, in issuing threats of legal action and subsequently following up on the threat nearly three and a half years later, constitutes bad faith in the filing of the trade mark applications at issue. He adds the acquisition, from February 2015 to May 2015, by the Applicant or its Director Jason Coogan of six ‘copycat’ domain names (e.g. www.dynolock.ie) similar to those owned by the Opponents, is further evidence of the Applicant’s bad faith. Furthermore, Mr. Lynch states that he understands the Applicant and/or Jason Coogan have acquired copycat domain names similar to those used by many of the Applicant’s competitors as a business tactic.
14. Mr. Lynch states all the foregoing represents a concerted campaign by the Applicant to put unfair commercial pressure on the Opponents. He concludes his Statutory Declaration by denying the oppositions are frivolous and vexatious.

Rule 21 Evidence

15. Evidence submitted by the Applicant under Rule 21 consists of a Statutory Declaration, dated 8 December 2016, of Jason Coogan, a Director of the Applicant, of Saggart, Co. Dublin, and a booklet labelled “JC001” which consists of evidence set out under 20 “Tabs”, the relevant elements of which I summarise below.

16. Mr. Coogan states that he is a Director of the Applicant since its incorporation on 2 April 2012. He says he formerly traded under the trade mark AUTOKEY or close variants thereof, incorporating the dominant element AUTOKEY since June 2008, in respect of automotive locksmith and related services, including a call-out and emergency service. Copies of Companies Registration Office documents supporting these statements are enclosed at “Tab 1” and “Tab 2”. He says he assigned his interest in the AUTOKEY marks to the Applicant in February 2014.
17. Mr. Coogan states that in 2015 the Applicant ceased selling and maintaining motor vehicles and concentrated on automotive locksmith services thereafter. While from the outset the Applicant has had national and international customers, prior to the date of application for the disputed mark, it provided call-out services exclusively in Leinster. Since the application, the Applicant has twelve agents around the country in addition to its Dublin premises, and is currently opening a second Dublin premises in Swords.
18. Mr. Coogan states that the Patents Office (“the Office”) raised objections to the Applicant’s application when it was examined in May 2015, under Sections 8(1)(b) and 8(1)(c) of the Act, as in the view of the Office the mark was devoid of any distinctive character and consisted exclusively of a sign that designates the kind and intended purpose of the services covered by the application. The Office informed the Applicant that the objections raised could be waived if it can be demonstrated that before the date of application, the mark had in fact acquired a distinctive character as a result of the use made by it. He says that in November 2015 the Applicant submitted evidence that demonstrated to the satisfaction of the Office the mark had acquired distinctiveness through use and the Office waived its objections and subsequently published its acceptance of the mark in December 2015. He provides, at “Tab 3” of his evidence booklet, copies of the correspondence and evidence filed in support of the application, which he is adopting and relying upon in these proceedings.
19. Mr. Coogan provides details (at Tabs 4,5 and 6) of the Applicant’s trading history under the Autokey mark at its current and previous locations, including photographs of signage, van livery, staff uniforms, stationery, packaging, advertising and marketing materials and on the Applicant’s website. He says the Applicant is accredited by several bodies for its work in the automotive locksmith repair sector and was the first Irish company to be accredited by both the Automobile Association and the Society of the Irish Motor Industry.

20. Mr. Coogan says the Applicant has been appointed to provide fraudulent claims investigative services by An Garda Síochána and leading car insurers and is the sole Irish expert witness on car transponder keys and fraudulent car theft insurance claims and has trained Irish and UK specialist police and armed forces units in respect of investigative techniques in relation to car keys and emergency entry and use of vehicles. He attached at Tab 7 material attesting to the Applicant's involvement in a UK training event and examples of testimonial letters at Tab 7.
21. Mr. Coogan provides details of the Applicant's website dating back to the registration of the autokey.ie domain name in March 2008. Since then the website has undergone a number of upgrades, but since early 2012 all pages of the website show the Applicant's Autokey trade mark. He provides at Tabs 8 and 9 extracts from the various iterations of the website dating from July 2011, which mention the disputed marks, and website traffic statistics for periods between 2012 and 2015, respectively.
22. He provides, at Tab 10, details of radio and television advertising, and event sponsorship. He says that in the region of €9,000 was spent on uniforms and €5,000 on van livery. He estimates that between 2010 and 2012 the Applicant spent over €25,000 on keyword advertising with Google AdWords. He also mentions the Applicant's presence on the social media sites Facebook, Twitter and LinkedIn. He says overall expenditure on advertising activities (including those relating to car sales) between the first use of the Autokey trade mark in 2008 and 2015 surpassed €150,000.
23. Mr. Coogan then addresses the Opponent's claims that the marks at issue lack distinctiveness. In summary, he says that the Applicant's use of the term Autokey has always been in respect of its brand and never as a noun. The Applicant, and all other traders operating in the same space, including the Opponent, consistently use the terms "car keys" and "vehicle keys" when referring to keys for motor vehicles. He attaches at Tab 13 extracts from the Applicant's website as they appeared on dates between 2009 and 2014. At Tab 14 he attaches extracts from two of the Opponents' websites (www.locksmiths.ie and www.dynolocks.ie). He says none of the websites refer to car or vehicle keys as auto keys.
24. He says the Opponents' other websites (www.autokeys.ie and www.autokeysdirect.com), extracts from which he attaches at Tab 15, contained only one instance of "auto keys" being

used as a noun prior to the relevant date for these proceedings. But that since the Applicant began corresponding with the Opponents, in order to protect its trade mark, the Opponents began to use the term on their websites more frequently.

25. Mr. Coogan states that in all his years as an automotive locksmith, expert witness or trainer he has never heard the term Autokey used to describe car keys. He says there is no dictionary definition of the term Autokey, save in respect of the field of cryptography.

26. Turning to the claim that the application was made in bad faith, which Mr. Coogan says it is misconceived, ill-founded, vexatious and calculated to seek to deprive the Applicant of its legitimate trade mark rights. He states the evidence is indisputable and shows the Applicant and its predecessor have used the AUTOKEY mark to designate and promote a real and substantive business since 2008.

27. Mr. Coogan says he is not aware and never has been aware of any business name or company registrations held by the Opponents under the Autokey, Autokeys or Autokey Direct marks. He is not aware of any actual trading activity operated by the Opponents under these brands. He says the Opponents have typically provided automotive locksmith services under the Locksmiths.ie and or Dyno Locks (or similar) brands at all times up to the application date. He attaches at Tab 16 images of the Opponents' trading premises and says the brands Autokeys, Auto Keys, Autokeydirect or Autokey Direct were never used on these premises. He says all locksmith services provided by the Opponents, including those resulting from use of the websites www.autokeys.ie and www.autokeydirect.ie have always been provided by Locksmiths.ie branded premises or at the roadside by a van emblazoned with the Locksmiths.ie brand.

28. Mr. Coogan highlights use by the Opponents of websites and website content which he claims give rise to concerns that the Applicant's business:

- i. Would be considered one and the same business as the Opponents;
- ii. Would be considered a subsidiary of the Opponents' business entities;
- iii. Would be considered a joint venture in partnership with the Opponents' businesses;
- iv. Might be taken to be a licenced or approved supplier of the Opponents' business;
- v. That the general public would be liable to be confused and find it difficult to procure services from their preferred supplier; and
- vi. That all the above was calculated as likely to happen on the part of the Opponents.

29. Mr. Coogan addresses the issue of the parties being in dispute over certain websites (mentioned above at paragraph 11), saying that such matters are not proper to the proceedings before the Controller, but can be raised under the ICANN Uniform Domain Name Disputes Resolution Policy. He says that when faced with the actions of the Opponents the steps taken to register the domains were reasonable efforts to protect the legitimate interests of the Autokey business, its employees and its customers.

Rule 22 Evidence

30. Evidence filed under Rule 22 consists of a second Statutory Declaration, dated 22 May 2017 of Barry Lynch and a booklet of supporting documents labelled “BL”. Mr. Lynch highlights what he considers to be inconsistencies in the Applicant’s evidence regarding the establishment and trading history of the Applicant. He also states that the Applicant’s evidence confirms the Applicant constantly redesigned its website and that the practise significantly reduces the claimed distinctiveness of the Applicant’s branding.

31. Mr. Lynch disputes the Applicant’s claim that the mark at issue has acquired distinctiveness through the use made of it as the term Autokey is not a commonly used term in the English language. He says that while he accepts that “car keys” is the more common term used to describe a traditional physical device for opening a lock on a car door and to start an engine, the term is increasingly used to refer to the electronic keyless entry systems that are now commonplace in automobiles. In support of his argument Mr. Lynch provides a list of over 30 websites from around the world that contain the term autokey, two of which are Irish (the first merely brings the visitor to a single page containing contact details of a particular individual and the second informs the visitor that a new website is coming soon).

32. He states that due to the differences between the websites operated on behalf of the Applicant and the Second-Opponent in terms of font, style, get-up, colouring, livery, content and the range of services provided that it is impossible for a potential customer to believe that the Second-Opponent’s business could be in any way associated with the Applicant’s business. He states that to the extent that there is any confusion between the respective parties’ businesses, which he denies, such confusion would only arise due to the fact that the average customer for a replacement car key does not care about the branding of the precise product as long as it fulfils its purpose in opening and starting the automobile in question.

33. Mr. Lynch says it is difficult to see any legitimate interest the Applicant could seek to protect by acquiring copycat domain names similar to those used by the Opponents. He says the acquisition of the domains names is part of a concerted campaign to put unfair commercial pressure on the Opponents. In this regard, he believes the Applicant has behaved in a manner which has fallen short of the acceptable commercial standards observed by reasonable and experienced traders in the car key replacement industry.

Written Submissions and The Hearing

34. The Applicant elected to file written submissions in lieu of attending at the Hearing, while the Opponent elected to be heard. The Applicant lodged written submissions formulated by Robert Bourke, of the Robert Emmet Bourke & Co., while at the Hearing the Opponents were represented by Mr. Barry Mansfield BL, instructed by Fiachra Baynes, of Baynes & Co. Solicitors.

35. Firstly, I shall address the issue of bad faith. In his written submissions Mr. Bourke notes there is no legal definition of the concept of ‘bad faith’ and accordingly it is necessary to examine the jurisprudence from the relevant courts to ascertain what the term means. He says courts have taken a view that, in trade mark applications, it relates to the motives of the Applicant. To illustrate what the Opponent must prove he directed me to a number of decisions which give an insight into what may be deemed bad faith and what factors need to be considered. At the Hearing Mr. Mansfield also pointed me to decisions, some of which were already cited by Mr. Bourke. The key relevant decision is that of Barrett J. in *Marie Claire Netherlands BV v The Controller of Patents, Designs and Trade Marks, Marie Claire SA and Brandwell (Irl) Limited*, wherein he summarised his review of the relevant case law and suggests the following principles can usefully be borne in mind when determining whether an application for registration has been made in bad faith by an applicant and thus that the trade mark in respect of which that application has been made cannot, under s.8(4) of the Act of 1996, be registered:

- (1) bad faith includes dishonesty;
- (2) bad faith includes dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced people in a particular area;
- (3) a relevant factor when determining whether there was bad faith is whether there has been a failure by the person against whom a charge was levelled to address that charge;
- (4) awareness that a party has been using an identical/similar mark for an identical/similar product in at least one EU Member State is not per se conclusive as to bad faith;

- (5) consideration must be given to an applicant's intention at the time of filing an application for registration; intention to prevent a party from marketing a product may be an element of bad faith;
- (6) a key issue arising is whether a mark is being used for its essential purpose, being to aid consumers in distinguishing products;
- (7) the fact that a third party has long used a sign for an identical or similar product capable of being confused with the mark applied for and that such sign enjoys some level of legal protection is a relevant factor when determining whether an applicant acted in bad faith;
- (8) a person is presumed to have acted in good faith unless the contrary is proven;
- (9) an allegation of bad faith is a serious charge that must be proven with cogent evidence on the balance of probabilities;
- (10) it is not enough when seeking to establish bad faith to prove facts which are also consistent with good faith;
- (11) where a party cannot maintain a relative ground of objection to registration, bad faith involves some breach of legal or moral obligation by the applicant towards the third party;
- (12) bad faith may exist where an applicant has sought or obtained registration of a trade mark for use as an instrument of extortion;
- (13) bad faith is not pertinent in a situation where there is a bona fide conflict between the trade mark rights, or perceived rights, of different traders;
- (14) it is not bad faith for a third party to seek, inter alia, a trade mark where third parties are using similar marks and/or are using them in relation to similar goods or services;
- (15) the fact that one party is aware of and has previously clashed with another is not the same as saying a trade mark application by one of those parties is made in bad faith;
- (16) seeking to protect one's commercial interests where one considers that one's activities do not impinge on the core activities of another is not bad faith;
- (17) bad faith is the opposite of good faith; it generally involves but is not limited to actual or constructive fraud; it may merely involve a design to mislead or deceive or some other sinister motive;
- (18) in determining whether there is bad faith, a knowledge of third party use, an intention to prevent a third party marketing a product and the lack of an intention to use a trade mark, as well as the extent of the reputation enjoyed by the third party's sign at the time of the application are all relevant.

36. At the Hearing Mr. Mansfield was quick to confirm the Opponents were not casting the actions of the Applicant as dishonest, but are claiming the Applicant's behaviour fell short of the standards of acceptable commercial behaviour observed by reasonable and experienced people in the automotive locksmith trade. He argued the Applicant's ongoing threats of legal action against the Opponents, which the Applicant made for years before eventually initiating proceedings, and the acquisition by the Applicant of websites similar to those of the Opponents and the timing of these acquisitions - during the course of these opposition proceedings - are behaviours that fall short of acceptable commercial behaviour. While the Applicant acquired the websites after the date of application of the contested mark Mr.

Mansfield pointed out that in *Red Bull*¹ the Court considered evidence of events that took place after the date of application (the relevant date for opposition proceedings) because the later evidence casts light backwards on the position as at the application date. Mr. Mansfield argued the evidence in this case does just that. Also, throughout its evidence the Opponents maintain the application is a further attempt at a concerted campaign by the Applicant to put unfair commercial pressure on the Opponents, which I take to be a charge of bad faith directed at the Applicant.

37. In his submission Mr. Bourke provides comment on each piece of the Opponents' evidence and, regarding the charge of bad faith, I would summarise his commentary as follows:

- i. The Courts are clear that a claim of bad faith is a serious charge that must be particularised. However, the Opponents have failed to do so and no evidence whatsoever has been adduced that points to bad faith.
- ii. Bad faith is not pertinent in a situation where there is a bona fide conflict between the trade mark or perceived rights of different traders, nor is seeking a trade mark registration where third parties are using similar marks and/or using them in relation to similar goods and services.
- iii. The fact that one party is aware of or has previously clashed with another is not the same as saying a trade mark application by one of those parties is made in bad faith.
- iv. The issue of litigation has no bearing on the trade mark applied for, nor on the claim to bad faith.

38. These proceedings are only concerned with whether or not the Applicant has acted in bad faith, not the Opponents. But the Opponents have laid bad faith charges against the Applicant which include alleging the Applicant is using copycat domain names similar to those used by the Opponents. This is a rather curious charge as the evidence produced by the Opponents themselves show the Opponents have employed on a grand scale the precise methods of attracting business which are now being identified as behaviour evidencing bad faith on the part of the Applicant.

39. In this regard, in his submission Mr. Bourke provides his insight into the operation of the Opponents' businesses. He writes as follows:

“To date the Opponents’ activities show that a deliberate practice has been engaged in whereby domain names have been registered and dummy websites created by them,

¹ *Red Bull v Sun Mark Ltd. and Sea Air & Land Forwarding Ltd.* [2012] EWHC 1929 (Ch)

which use the Applicant's trade mark and/or trade marks identical or highly similar thereto. Neither of the Opponents' offending websites www.autokeydirect.com and www.autokeys.ie have any related registered business name or company name behind them, nor are there any AUTOKEY DIRECT or AUTOKEYS premises, employees, contractors, vans or equipment in actual existence, save what appears visually on said websites – or which at one time appeared. Said websites are used by the Opponents solely as online funnels for web traffic intended for the Applicant's services which are heavily promoted under its trade mark. Potential customers of the Applicant are lured to the Opponents' dummy websites through the use of highly similar trade marks, domain names, meta-tags and key-words and, once there, the Opponents use alternative businesses to provide the requisite automotive locksmith and related call-out services to the public. The offending websites are used as the means by which business is procured, which is then performed by unidentified alternative entities and not by any entity called AUTOKEY DIRECT or AUTOKEYS."

40. I am satisfied the above is an accurate description of how the Opponents operate and therefore, if there was any merit in the charges against the Applicant, it would certainly be a case of the kettle calling the pot black. The Opponents have registered scores of websites to attract business, which was clearly a successful strategy that at times must have secured business from unsuspecting customers of the Opponents' competitors, including the Applicant. In seeking the domain names, the Applicant was, in my opinion, doing nothing more than attempting to protect its legitimate intellectual property rights. This is not bad faith. Nor is threatening legal action, which in this case is also nothing other than the Applicant seeking to protect its rights. The timing of the Applicant's threatened legal action and registering domain names is of no relevance to these proceedings. They simply took place at a time when, it appears to me, the Applicant had finally had enough of the Opponents' behaviour and the impact it was having on its business, and set out to do something about it. The Applicant's actions do not in any way constitute bad faith in the filing of the application for the trade mark at issue on the relevant date. Accordingly, I have no hesitation in dismissing the allegation of bad faith as unsupported and unfounded, and I reject the opposition on this ground.

41. Turning now to the grounds of opposition centred on Sections 8(1)(b), (c) and (d) which are written in the following terms:

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

(a) ...;

(b) trade marks which are devoid of any distinctive character;

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value,

geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services;
(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

Section 8(1)(d)

42. I feel it is best to deal with the prohibition under Sections 8(1)(b), (c) and (d) in reverse order. Section 8(1)(d) deals with trade marks that consist exclusively of matter that is currently used in the everyday course of business in the trade in question; in this case the motor trade.

43. The Opponents argue the term Autokey has become customary in the motor locksmith trade in Ireland, but provides little by way of evidence to support its claims. Other than use by the Applicant and by the Opponents on their copycat websites, the only other mention of use in Ireland was limited to two websites, one of which contains nothing other than a “site under construction” page and the other contains bare contact details for a named individual. Bearing in mind all the traders engaged in the Irish motor trade, the vast number of consumers, the level of advertising and media coverage, in my opinion, this evidence does not demonstrate the term is in common usage in the trade in Ireland. While Sections 8(1)(b) and (c) allow for some subjectivity as to what may constitute a finding of a lack of distinctive character or what may be deemed descriptive, Section 8(1)(d) must be dealt with objectivity, based solely on evidence and facts regarding the current practice in the trade. It is not concerned with whether or not the mark could become customary in the trade at some point in the future – it must, at the application date, have already become customary. The evidence submitted by the Opponent fails to substantiate the claim that the term Autokey had in fact entered the common parlance of the Irish motor trade at the relevant date. Accordingly, I must reject the opposition on this ground.

Section 8(1)(c)

44. Turning now to Section 8(1)(c). There is ample case-law that provides guidance to decision makers in determining the scope of the provisions of Article 3(1)(c) of First Council Directive 89/104 and Article 7(1)(c) of Council Regulation 40/94 (the Community Trade Mark Regulation), which correspond to section 8(1)(c) of the Act. These authorities identify the principles to be followed when attempting to determine the registrability of a mark under Section 8(1)(c) as:

- i. Signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark (*Wm Wrigley Jr & Company v OHIM, C-191/01P (Doublemint), paragraph 30*);
- ii. Article 7(1)(c) (Section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all (*Doublemint, paragraph 31*);
- iii. It is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes (*Doublemint, paragraph 32*);
- iv. It is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word ‘exclusively’ in subsection 8(1)(c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question (*Koninklijke KPN Nederland NV v Benelux Merkenbureau, C-363/99 (Postkantoor), paragraph 57*);
- v. An otherwise descriptive combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word trade mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark (*Postkantoor, paragraph 99*);
- vi. In conducting the assessment of whether a trade mark is descriptive of the goods or services for which registration is sought “... *it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, who are reasonably well informed and reasonably observant and circumspect, in the territory in respect of which registration is applied...*” (*Matratzen Concord AG v Hukla Germany SA, C-421/04*);
- vii. Where there is a relationship between the sign and the goods or services in question, it must be sufficiently direct and specific in order “*to enable the public concerned immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics.*” (*Ford Motor Co v OHIM, T-67/07*);

viii. The first impression test was confirmed by the General Court in its decision in *Sykes Enterprises v OHIM (Real People Real Solutions [2002] ECT II-5179)*, wherein it stated "*...a sign which fulfils functions other than that of a trade mark is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin.*"

45. It is clear from the aforementioned case law that I must determine whether the mark at issue, if used in a nominal and fair manner, will be viewed by the average consumer as a means of directly designating an essential characteristic of the services for which registration is sought.

46. In his written submissions Mr. Bourke argues the onus is on the Opponents to prove the mark applied for is devoid of distinctive character or is descriptive or generic. In support of this he referred me to the Controller's decision in *MILKBEARS*² wherein the Hearing Officer said:

"...as a matter of general principle, the onus lies on the party bringing an objection to the registration of another's trade mark to establish, by evidence or argument, a prima facie case in support of each of its grounds of objection and, if it fails to do so in respect of any particular ground, then the onus does not pass to the Applicant to prove otherwise and the objection on that ground is liable to be dismissed summarily. It is the case, however, that certain grounds of objection are, by their nature, more apt to be sustained by argument rather than by evidence and I think it would be wrong to hold that an absence of evidence in support of a given ground of objection must necessarily lead to it being dismissed. Where, for example, the facts that must be taken into account in determining a particular ground of objection are matters of common knowledge of which the Controller may be expected to take judicial notice, then it would not be sensible to ignore the objection and hold against the Opponent simply because he had not gone to the trouble of adducing actual evidence to prove those facts...

...even in the case of an objection that may proceed in the absence of specific evidence, care must be taken to ensure that only matters that are plainly in the public domain are taken into account and any tendency to give the benefit of the doubt to an Opponent must be strictly avoided.

47. He states no evidence was filed in these proceedings to prove the Opponents' claims and the opposition should be dismissed summarily. I do not agree. There are some grounds of

² Decision of 6 June 2006

opposition that must be proven with cogent evidence, while others are best decided by argument. Such is the case in respect of Section 8(1)(c) based oppositions. I have dealt with this issue before in IRISH WATER³ wherein I stated the following:

“In Section 8(1) based oppositions, such as the case at hand, the bounds are not defined by what the parties put before the Controller. The Controller, having afforded the parties an opportunity to file whatever evidence they desire and to make whatever submissions they wish, is required to know the law and to apply the law. This is as it must be, even in cases where an opponent does not identify the Section 8(1)(c) grounds of opposition with absolute clarity and precision. If an opponent claims the application offends against Section 8(1)(c) the Controller must consider that section in full and, if the Controller is of the view that the application offends against a particular provision of that Section, he cannot allow the application to proceed to registration purely because an opponent did not comprehensively address that particular provision or only made fleeting reference to it.

48. Therefore, I am satisfied that, irrespective of the low level of evidence adduced in support of the opposition under Section 8(1)(c), I can apportion weight to the relevance and persuasiveness of the legal argument advanced by the Opponent. At the Hearing Mr. Mansfield maintained the mark contains of two words, the joining together of which does not bestow upon them any degree of novelty, inventiveness or distinctiveness. They are nothing other than the sum of the two parts. As such, and in accordance with numerous decisions of the Court of Justice of the European Union specifically BABY DRY⁴, Biomild⁵, Companyline⁶ and Photos.Com⁷ he maintained the registration must be refused.

49. In his written submissions Mr. Bourke argues there is no dictionary definition of the term “autokey”, save in the field of cryptography, where the term describes a cipher for encryption. He also argues it is telling that not one piece of evidence was adduced that contained a reference to the keys of a motor vehicle being referred to as “auto keys”. Furthermore, he maintains the mark must be viewed as a compound and should not be split into the two separate words, auto and key. He claims the mark is distinctive and says there is ample case law as to what must be considered when deciding if a trade mark is devoid of distinctiveness and offers the following supporting extract from SAT.2⁸ where at paragraphs 40-41 the Court found:

³ Decision of 8 July 2017

⁴ Procter & Gamble Company v OHIM (Case C-383/99 P)

⁵ Campina Melkunie BV v Benelux-Merkenbureau (Case C-265/00)

⁶ DKV Deutsche Krankenversicherung AG v OHIM (Case C-104/00 P)

⁷ Getty Images (US), Inc. v OHIM (Case T-338/11)

⁸ SAT.1 SatellitenFernsehen GmbH v OHIM (Case C-329/02 P)

“Although the way in which the [mark at issue] is made up is not unusual, in particular as regards the perception which the average consumer may have of services falling within the [sector] ... and does not reflect a particularly high degree of inventiveness, those facts are not sufficient to establish that such a word is devoid of distinctive character within the meaning of Article 7(1)(b) of the regulation.

Registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings.”

50. Having taken due notice of all the guidance in the cited authorities and the arguments of the parties, in my opinion, the mark is descriptive of the motor locksmith service being provided under it. In reaching this conclusion, I am mindful that I have already decided the term is not in common parlance in the trade. I am also cognisant that as far as the evidence shows the term “auto key(s)” is not used in the State to describe the keys of motor vehicles. Furthermore, motor vehicles have been around in Ireland for well over a hundred years and, in my opinion, if the industry and the public have used the term “car keys” and no other since day-one, it is highly unlikely at some future point the term will be replaced by “auto keys” or that the latter will be used as a substitute for the former. However, these are not the only tests the application must pass and therefore they are not sufficient to allow me to conclude that Autokey is not descriptive.

51. The assessment in this case is best and most suitably carried out by determining whether a consumer who seeks the services of a motor locksmith, on encountering the Applicant’s trade mark Autokey, would immediately perceive the mark to be descriptive of the service the consumer is seeking. Whether the term has not been in use, is not currently in use or is unlikely to be used at a future date to describe the keys of a motor vehicle is unimportant. What matters is whether the average consumer of the services in question would, of his or her own accord, perceive a link between the mark and the services offered under it. The term includes the word “key” which is self-explanatory with regards to locksmith services. In the context of the service being provided, the prefix “auto” would immediately be understood to be a reference to motor vehicles, even by consumers who would never use the term “auto” to describe their own motor vehicle. I find consumers would immediately make a direct link between the mark and the services. Therefore, I am satisfied the Autokey marks consist exclusively of signs or indications which may serve in trade to designate the kind and

intended purposes of the services. Accordingly, the mark is liable to be refused under Section 8(1)(c) of the Act.

Section 8(1)(b)

52. I must mention that while the two marks are somewhat different in font and colour these differences are unlikely to be appreciated by the average consumer. There is also a difference between the opening letter A of each mark in that in no. 253948 the A is depicted in such a way that the spaces appear to represent lines running down the centre of a road; though this is only perceivable on very close inspection. In my opinion it does not bestow upon the mark the necessary inherent distinctiveness and no mention of it was raised by the Applicant in its evidence or argument in support of the mark being inherently distinctive on that basis.

53. While Sections 8(1)(c) and (d) give clear definition as to the nature of the objection, Section 8(1)(b) is concerned with the prohibition on registering marks which, while not offending against the specific parameters set out in sections 8(1)(c) and (d), nonetheless still do not fulfil the essential function of a trade mark, which is to identify the goods or services offered under the mark as originating from one undertaking as opposed to another. However, once a mark is found to be descriptive and offensive to Section 8(1)(c) it must follow that it is also devoid of distinctive character and offends against 8(1)(b), because a purely descriptive mark is incapable of performing the essential function of a trade mark. Accordingly, the mark is liable to be refused under Section 8(1)(b) of the Act.

54. However, there is an important proviso in Section 8 which allows a mark, that falls foul of Sections 8(1)(b), (c) or (d), or any combinations of these, to be registered if before the date of application for registration it has in fact acquired a distinctive character because of the use made of it.

55. At the Hearing Mr. Mansfield argues the mark had not acquired distinctive through the use made of it and that it is nothing other than a descriptive mark. On the other hand, in his written submissions, Mr. Bourke points to the substantial and continuous use of the mark since 2008 by the Applicant and its predecessor in title, and argues the mark has passed the

test for acquired distinctiveness as set out in *Windsurfing Chiemsee*⁹, which the Court (at paragraph 51) identified thus:

“In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.”

37. Mr. Bourke argues the use of the mark since 2008 is sufficient to invoke the proviso under Section 8(1) and to enable it to pass the test outlined by me in *IRISH WATER*¹⁰, where at paragraph 93 I said:

“The proviso in Section 8(1) is abundantly clear and needs no interpretation as to what is required to be established in order for it to be invoked. There are three requirements: (i) the mark must have acquired a degree of distinctiveness, (ii) the distinctiveness must have been acquired prior to the date of application, and (iii) the distinctiveness acquired must have been acquired through use. No matter what degree of distinctiveness, recognition, market penetration, use or notoriety was attained after the date of application it is completely irrelevant for the purposes of considering the proviso in Section 8(1).”

38. Mr. Bourke maintains there was genuine use of the mark prior to the date of application and that such use had, by the date of application, established a presence for the Applicant in the marketplace for the services at issue. He also argues the Controller has accepted this already having considered the question of acquired distinctiveness during the examination of the application. It is the case the Examiner raised objections to the application based on subsections 8(1)(b) and (c), but was persuaded to waive those objections on foot of the evidence furnished by the Applicant which proved to the satisfaction of the Examiner the mark had in fact acquired the necessary distinctiveness through the use made of it. However, I am not bound by any decisions taken during the examination of an application, and I must look at the case afresh. A determination as to whether a trade mark has acquired distinctiveness through use is a somewhat subjective decision based on a multitude of factors which, when assessed by different people, may result in a different outcome. There is no specific threshold that must be passed, but the Court in *Windsurfing Chiemsee* did offer specific guidance as to what the evidence must show, where at paragraph 54 it said:

⁹ *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots- und Segelzubehör Walter Huber and Franz Attenberger* (joined cases C-108/97 and C-109/97)

¹⁰ Decision of 8 July 2017

“In determining whether a trade mark has acquired distinctive character following the use which has been made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings;

If the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied;”

39. In essence what must be proven is the mark has gained secondary meaning in the sense that as well as being a descriptive term it has also become synonymous with the Applicant and is readily recognised as the Applicant’s brand in respect of the specific services offered under it.

40. The Applicant claims its services were recognised and approved by the Automobile Association (in 2009) and the Society of the Irish Motor Industry (in 2012). The Applicant also claims that An Garda Síochána and leading car insurers use the Applicant’s services to provide fraudulent claims investigative services and says it is the sole Irish expert witness on car transponder keys and fraudulent car theft insurance claims. Furthermore, it claims to have trained Irish and UK specialist police and armed forces units in respect of investigative techniques in relation to car keys and emergency entry and use of vehicles. The Applicant claims all these services are provided under the Autokey trade mark, though there is little by way of evidence to support these claims.

41. However, the Applicant furnished a range of evidence during the examination of the application to convince the Examiner that the mark had acquired distinctiveness through use. That evidence is relied upon again in these proceedings. In addition to that the Applicant also provides a significant amount of other evidence to support its case.

42. All the evidence that was submitted paints a picture of a well-established and reputable brand that has been in existence since 2008. From that year the Applicant has invested heavily in premises, a fleet of vehicles that provides mobile services, uniforms, stationery and other materials, all of which are emblazoned with the AUTOKEY trade mark. The evidence shows the Applicant has advertised its services widely across many platforms including radio, television, the print media, business directories and online, and expended thousands of Euro doing so. The Applicant has supported charities and sponsored sporting events and individual rally and motor-cycle racers under the Autokey brand. The Applicant

presented numerous invoices for the delivery of its services as well as for services provided to it, all bearing the Autokey name.

43. The number of operators in the specialist motor locksmith trade in Ireland is not large. As of the date of application the Applicant employed twelve full-time staff and three independent contractors, and it is clear from this and the other evidence submitted in support of the application that the Applicant, operating under its Autokey trade mark, became a significant player in the industry. I am totally satisfied the trade mark Autokey has been put to genuine use by the Applicant to such an extent that it had acquired a secondary meaning as a badge of origin. It was readily identified as the Applicant's trade mark prior to the date of application and I find Autokey has, by virtue of the use made of it, acquired a distinctiveness that requires me to invoke the proviso under Section 8(1).

44. For these reasons, I have decided to dismiss the oppositions and to allow the applications to proceed to registration.

Dermot Doyle

Acting for the Controller

24 July, 2018