

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

In the matter of an application for registration of Trade Mark No. 258476 and in the matter of an Opposition thereto.

McGREGOR SPORTS AND ENTERTAINMENT LIMITED
(Represented by FRKelly)

Applicant

McGregor IP B.V.
(Represented by Tomkins & Co)

Opponent

The Application

1. On 7 July 2016 (the relevant date), McGREGOR SPORTS AND ENTERTAINMENT LIMITED, of Charter House, 5 Pembroke Row, Dublin 2, (hereinafter “the Applicant”) made application (No. 2016/01428) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the trade mark “CONOR McGREGOR” in respect of the following goods and services in Class 3: *Aftershave; Toiletries; Shaving oils; Shaving gels; Shaving foam; Perfume; Cosmetics.* Class 9: *Computer and video games; DVD's; Videos; Protective clothing; Compact discs; Teaching apparatus and instruments.* Class 16: *Books; Printed publications; Calendars; Diaries; Stationery.* Class 25: *Clothing; Footwear; Headgear.* Class 28: *Games and playthings; Gymnastic and sporting articles.* Class 41: *Gymnasium services; Provision of health club services; Health and fitness training; Education; Provision of training; Entertainment; Sporting and cultural activities; Gymnastic instruction.* Class 43 *Restaurant and café services; Provision of food and drink; Takeaway food services; Hotel services; Temporary accommodation* and Class 44 *Barber shops; Hairdressing services; Healthcare services; Physiotherapy; Beauty salons; Medical clinic services.*
2. The application was accepted for registration and advertised accordingly under No. 258476 in Journal No. 2356 dated 04/04/2018.
3. Notice of Opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 24 June 2018 on behalf of McGregor IP B.V., a Dutch Company of Schipholboulevard 373 NL-1118 BJ SCHIPHOL (hereinafter “the Opponent”) by their Agent Tomkins & Co. The Applicant, represented by their Agent FRKelly, filed a counter-statement on 28 September 2018. The Opponent subsequently filed evidence under Rule 20 of the Trade Marks Rules, 1996 (“the Rules”). The Applicant, as is its right, elected not to file evidence under Rule 21.

4. Both the Applicant and the Opponent elected to file written submissions in lieu of attending a Hearing. The parties were notified that I had decided to dismiss the opposition and to allow the mark to proceed to registration. I now state the grounds of my decision, and the materials used in arriving thereat, in response to a request by the Opponent in that regard pursuant to Rule 27(2).

Grounds of the Opposition

5. In its Notice of Opposition of 27th June 2018, the Opponent states it has for many years carried out business as a retailer of, inter alia, clothing, footwear, headgear and accessories, and related goods and services. It then refers to its proprietorship of European Union Trade Marks -EUTM 002927549 “McGREGOR”, with a filing date of 8th November 2002, covering goods in Classes 3, 18 and 25. The Opponent further clarified that the Opposition was directed against the Applicant’s Class 3 and Class 25 goods only.
6. The Notice of Opposition relates to the following sections of the Act:
 - Section 10(2)(b) – *identity or similarity of the goods and services and the identity or similarity of the marks, leading to a likelihood of confusion on the part of the public, including a likelihood of association with the Opponent’s trade mark*
 - Section 10(3) – *use of mark would take unfair advantage of, or be detrimental to, distinctive character or reputation of the Opponent’s trade marks; and*
 - Section 10(4)(a) – *use of the mark in the State is liable to be prevented by virtue of the law of passing off.*
 - Section 8(4)(a) – *its use is prohibited in the State by any enactment or rule of law or by any provision of Community law;*
 - Section 37(2) – *The application shall state that the trade mark is being used, by or with the consent of the applicant, in relation to the goods or services specified in the application, or that the applicant has a bona fide intention that it should be so used.*
 - Section 42(3) – *If the applicant fails to satisfy the Controller that the requirements for registration have been met, or to amend the application so as to meet them or fails to respond before the end of the specified period, the Controller shall refuse to accept the application.*

Counter-Statement

7. In its Counter Statement of 28th September 2018. the Applicant denies all the grounds of opposition. Furthermore, the Applicant denies the marks are identical or similar, and that the goods in respect for which the Applicant seeks registration are identical or similar to those of the Opponent. He further states that the Opponent has not established any reputation in Ireland in connection with the provision or sale of the cited goods under their earlier trademark. The Applicant's mark is inherently capable of distinguishing its said goods from other undertakings and the Applicant has used or is proposing to use the applied for mark in connection with these goods. The mark complies with the relevant provisions of the Act and, in particular, with the provisions of Sections 8, 10 and 37.

Rule 20 Evidence

8. Evidence submitted by the Opponent under Rule 20 consists of a Statutory Declaration dated 23rd December 2020, and supporting evidence, by way of thirteen exhibits (marked LRO1 to LRO13), of Ludovicus Rudolf Onnink, Managing Director of the Opponent. I have examined in detail the Declaration and all the accompanying Exhibits and will refer to their particulars where appropriate to do so.
9. Mr Onnink provides a brief history of the McGREGOR brand, a forerunner of which was introduced in the USA in the 1920's. Exhibit LRO1 contained a selection of images from a McGREGOR brochure from 1938. Exhibit LRO2 outlined details of the evolution of the McGREGOR brand including its introduction to Europe in the 1960s and various business milestones that occurred subsequently. The Opponent was established in the Netherlands on 27th September 2017, and it acquired the complete McGREGOR trademark portfolio on 15th October 2017. Despite many trading obstacles, including bankruptcies and changes of ownership that occurred, the McGREGOR trademark has been used continuously over a long period of time. Details of sales to Irish customers were outlined in Exhibits LRO3 and LRO4. A further Exhibit, LRO5, contained details of a selection of invoices received and sent for goods bearing the Opponent's mark illustrating use of the mark throughout the European Union. Illustrations of the Opponent's catalogues, leaflets and flyers were included in Exhibit LRO6, while photos of various branded McGregor shops located in the Netherlands, Belgium and France were included in Exhibit LRO7. Examples of third-party retailers and websites selling McGREGOR products between 2013 and 2016 were included in Exhibit LRO8. Examples of use of the McGREGOR Trade Mark in the period between 2013 and 2016 and a brand manual for the years 2015-2017 along with examples of social media postings were included in Exhibit

LRO9. Examples of online advertisements and extracts from Irish media relating to the McGREGOR Trade Mark were contained in Exhibit LRO10 while a list of Trade Marks containing the element McGREGOR currently registered and in force were included in Exhibit LRO11. Details of earlier EU Registrations from which the Opponent's EUTM No. 002927549 claims seniority were included in Exhibit LRO12. Copies of the decisions of the EUIPO Cancellation Division and of the subsequent Board of Appeal whereby the Opponent's EUTM No. 002927549 was confirmed as being validly in force for all of the Class 25 goods for which it was registered were included in Exhibit LRO13. The Opponent concluded their Rule 20 evidence by referring to a number of oppositions filed by his company against EU and Irish applications owned by the Applicant. Reference was made to a successful outcome for the Opponent citing their EUTM No. 002927549 against the Applicant's EUTM 016233009.

Rule 21 Evidence

10. The Applicant advised on 13th December 2021 that they would not be filing evidence under Rule 21 but would rely on submissions to be filed at a later stage in the proceedings.
11. Both parties were asked on 19th January 2022 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.
12. The Opponent filed written submissions on 17th May 2022. In these, they summarised the case made previously in their Notice of Opposition and in their submission filed under Rule 20 and referenced above. The Opposition was based on the Opponent's EUTM 002927549, McGREGOR and was directed against Classes 3 and 25 of the Applicant's mark, TM Number 258476. 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 25 goods of interest to both parties revealed them to be identical while the Class 3 goods contained in the Applicant's mark are related and should be considered strongly similar to Class 25 goods. This is based on their contention that a link between clothing and perfumery has been found in a number of decided cases. This was held to be a feature of the fashion industry where most companies operating in this sector were said to offer clothing related goods along with fragrances, cosmetics, and related goods. Examples of other fashion brands operating in this way were provided.

The Opponent contended that a comparison of the marks of the Applicant and the Opponent revealed them to be highly similar given that the earlier Mark is wholly contained in the contested Application. The Opponent further contended that the inclusion of the additional element “CONOR” in the Applicant’s mark was insufficient to differentiate the marks in eyes of the average consumer as the name Conor was held to have a low degree of distinctiveness, due to the fact that it is one of the most common male first names in Ireland. It was the view of the Opponent that the surname alone would be perceived as the short version of the full name, thus identifying the same origin. The surname McGregor was stated to be one of the rarest among the Irish population as evidenced derived from the genealogy portal “Forebears” and Phonebook.ie. Based on this, the Opponent stated that the most dominant and distinctive element of the Applicant’s Mark is identical with the earlier Registration and the Marks at issue must be considered highly similar.

The Opponent proceeded to reiterate the points made in their Rule 20 evidence, filed by way of Statutory Declaration on 23 December 2020, in support of their claim for the reputation of the MCGREGOR brand in Ireland and the exhibits filed in relation to this. The Opponent also referred to previous proceedings between the present parties before the EUIPO where it was held that there was a likelihood of confusion between their earlier mark, MCGREGOR, and the Applicant’s later filed CONOR MCGREGOR mark. In continuing their submission, the Opponent referenced the fact that the Applicant had shown a clear tendency to file repeated applications where the dominant element is the name MCGREGOR combined with, what they held to be, an additional wholly descriptive and non-distinctive element. The Opponent went on to state their view that it is entirely possible that when the average consumer encounters the Applicant’s clothing and cosmetic goods sold under a Mark in which the element MCGREGOR is accompanied by a term that is not distinctive enough to have any relevant impact on the perception of the sign, the consumers will assume that those goods originate from the Opponent. Furthermore, it is their view that the relevant consumer will perceive the Applicant’s later Marks incorporating the MCGREGOR name as a sub-brand, or a variation of the earlier MCGREGOR Trade Mark. The Opponent went on to conclude that, considering the similarities between the respective marks, the similarities in the nature of the goods, a likelihood of confusion existed. This was said to be clear from well-known and established case law on the matter.

The Opponent’s objection under Section 10(3) of the Act was supported by restating some of the points made previously concerning their case based on Section 10(2). This was in relation to their contention that the respective marks and the goods associated with them were highly similar. The reputation of the earlier mark was evidenced by the submissions filed with the Rule 20 exhibits and summarised in paragraph 9 above. The Opponent submitted that the use of the

contested Mark is without due cause. They further submitted that use of the Mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier Mark. The Opponent's mark, MCGREGOR, has an established reputation and is the key brand in their overall business. In their opinion, the purchasing public would make a clear association between the respective Marks which would allow the Applicant to take unfair advantage of the reputation of the Opponent's mark. This would clearly weaken the immediate association between the Opponent's MCGREGOR trade mark and the goods for which it is registered thus leading to potential losses and/or diversion of sales. Goods offered under the highly similar later mark could potentially have a very serious negative effect on the earlier mark. The earlier mark's ability to attract and keep customers could be negatively impacted. As such, an unfair advantage taken by a third party of the reputation of an earlier mark must be prohibited under Section 10(3) of the Act.

Regarding the objection taken under Section 10(4), the opponent must show goodwill or reputation attached to the goods supplied in the mind of the purchasing public, a misrepresentation by the owner of the later mark to the public that would lead them to believe that the goods or services offered are supplied by the owner of the earlier mark and the owner of the earlier mark must demonstrate that he suffers or is likely to suffer loss as a result of this misrepresentation. The Opponent argued that the evidence submitted by them under Rule 20 has clearly shown that at the date of filing of the contested Mark, the Opponent enjoyed substantial goodwill and reputation in the sign MCGREGOR. They further stated that the existence of goodwill in Ireland has also arisen by its trading activities throughout the EU. Due to the highly similar nature of the marks and of the goods offered under them, as argued by the Opponent, it was contended that a substantial proportion of the public is likely to be deceived into believing that the goods of the Applicant are those of the Opponent. This would constitute a misrepresentation. Based on this and on the reputation enjoyed by the Opponent in their mark, there is a likelihood that damage to the business of the Opponent will occur. The Opponent concluded their arguments by stating that the Applicant's Mark should be refused registration in relation to the contested goods in Class 3 and 25 for the reasons advanced by them in their submissions in relation to this case. No evidence or arguments were put forward in support of their opposition based on Sections 8, 37 and 43 of the Act.

13. The Applicant filed written submissions on 18th May 2022. The submissions summarised the key aspects of the case from the Applicant's perspective. In their view, the only ground to be considered and determined is Section 10(2)(b) of the Act, as the Opponent has not proved a reputation in the mark or a passing off position in the State. A restatement of the well-established principles that provide guidance on how the necessary assessment concerning

finding a likelihood of confusion was outlined. This included a listing of the well-known decisions of the European Court of Justice in relation to this. The Applicant went on to conduct a comparison of the applied for mark, TM 258476, and the earlier mark of the Opponent, EUTM 002927549. It was argued that the marks differed conceptually in that the applied for mark is a full name, CONOR MCGREGOR, while the Opponent's mark is a surname only, MCGREGOR. While consumers normally perceive a trademark as a whole, the overall impressions created by them must be assessed bearing in mind their distinctive and dominant components. The word CONOR at the beginning of the Applicant's mark should be given considerable weight in determining the likelihood of confusion as consumers pay more attention to the beginnings of marks. The Applicant further stated that the average consumer resident in the State when confronted with the applied for mark would readily and without hesitation associate it with the well-known personality to whom the name belongs and no other. It is their submission, therefore, that the average consumer would immediately identify this as a badge of origin of goods from the individual or a company of the individual, such as the Applicant. This is due to the fact that the mark consists of his full name which is very well known throughout the State.

The Applicant concluded his submission by referring to the evidence filed by the Opponent in their Rule 20 submission. This was said to relate to activities that have nothing to do with the State. That piece of the evidence that did relate to the Opponent's activities in Ireland was said to contain figures that are insignificant with regard to the size of the Irish market. It was further held to be the case that the evidence filed does not support the claim of reputation or anything near it or a passing off position. Arising from their submission, the Applicant stated that, having regard to the nature of the Trade Marks at issue, the criteria that must be considered when assessing a likelihood of confusion, the differences between the respective marks, the average consumer and all relevant circumstances, the Opposition should be dismissed in its entirety.

14. The Opponent, pursuant to Rule 25(3A)(b), filed written submissions on 22nd June 2022 in reply to the written submissions filed by the Applicant. In this, they took issue with the Applicant's assertion that the only ground which must be considered in adjudicating the present Opposition is that set out in Section 10(2)(b) of the Act. The Applicant's position, based on the assertion that the Opponent had not provided evidence of a reputation in the State and that it had not established a "passing off position", was held to be baseless by the Opponent. It was contended by the latter that the exhibits filed with the Statutory Declaration clearly demonstrated the substantial presence that the MCGREGOR brand has in Ireland. It showed their products to be available in some of the most well-known retailers in Ireland. This showed that the Opponent's Mark was recognised by a significant proportion of the public concerned by

the goods offered under it. The sponsorship agreements entered by the Opponent with some of the most well-known sports championships in the world, such as the motor racing Formula 1 championship and the Monte Carlo Rally, were held to be of particular relevance. Established case law was quoted to support their position that advertising is an important factor to consider when assessing whether a trade mark had established a reputation within the meaning of Section 10(3). The Applicant's assertion that the evidence of use outside the State of the Opponent's mark was not of relevance was disputed. The Opponent argued that it had shown that a significant proportion of the public had been exposed to their Mark through advertising available in the State. Based on the above, it was stated that the contested mark should be refused for goods claimed in Classes 3 and 25 as it clearly offends against Sections 10(2)(b), 10(3) and 10(4)(a) of the Trade Marks Act, 1996.

The Opponent went on to argue that the Applicant's interpretation of Case C-591/12 (*Bimbo SA v OHIM*) in support of their contention that considerable weight must be given to the name CONOR as it was placed at the beginning of their mark was wrong. The Court, in this instance, recognised that the overall impression conveyed by a composite mark may be dominated by one of its components. It went on to uphold the General Court earlier decision that there was a likelihood of confusion between the wordmark BIMBO DOUGHNUTS and the earlier registered Spanish wordmark, DOGHNUTS. From this, the Opponent argued that the presence of a first name in one of the conflicting signs will not suffice to safely distinguish the signs in the minds of the consumers. This was held to be particularly so in the present case where the first name, Conor, is exceptionally common in the State but the surname McGregor is quite unusual. Because of this, it was argued that the Irish public will associate the later Mark with the Opponent's earlier registration. It was also held that case law, as quoted, confirms this view. The Opponent took issue with the Applicant's position that the average consumer in this case would "*readily and without hesitation*" associate the Applicant's Mark with the well-known personality to whom the name belongs, thus leading to no likelihood of confusion. They felt that this couldn't be substantiated without the submission of supporting evidence. They stated that the burden of proof lies with the Applicant when relying on an argument such as this. The lack of evidence must, in their view, result in this attempted defence to be rejected entirely. Furthermore, any connection between the Applicant and third parties that might influence the outcome of the case must be thoroughly explained and supported by evidence in order to be taken into consideration during the decision-making process. European case law has found that probative value can be attributed in matters such as this only if it supported by other evidence. The Applicant's case should therefore be dismissed.

15. The Applicant, pursuant to Rule 25(3A)(b), filed written submissions on 23rd June 2022 in reply to the written submissions filed by the Opponent. In this submission, the Applicant disputed the Opponent's contention that the Class 3 goods covered by the applied for mark are similar to the Class 25 goods contained in the Opponent's earlier mark. They further stated that the differences in the respective marks outweighed the significance of the identity of the Class 25 goods contained in both of them. A comparison of the marks themselves in their entirety reveals that they are differentiated by the presence of the name CONOR at the beginning of the applied for mark. The Opponent, whose mark consists of a surname only, cannot prevent a third party, with that or any forename, from using or registering that surname with their forename. That would grant an unfair monopoly that is more far reaching than is entitled. The Applicant took issue with the Opponent's argument regarding the effect of the presence of forenames in a trademark name. It was held that this argument was contradictory in that it would mean that, in some cases the presence of a forename is sufficient to distinguish a trademark while in others it is not.

The Applicant further contended that the Opponent had failed to prove a reputation in the State. The evidence provided by the Opponent in support of their claim for reputation was outside the State.

In referring to previous proceedings before the EUIPO, the Applicant referred to the fact that the Hearing Officer was not bound by any such decisions.

The submission in respect of Section 10(2) concluded that there was no likelihood of confusion when the respective Marks were compared in their entirety, as they must be.

Referring to the Opponent's case under Section 10(3), the Applicant reiterated their case that the marks were not confusingly similar, and the Opponent had not proven that their earlier mark enjoyed a reputation in the State. The Applicant's mark consists of the name of the individual who is the major shareholder of the Applicant company and is seeking to use its name in respect of goods supplied by the company under and by reference to his name.

Turning to the objection raised under Section 10(4), the Applicant asserted that, as the Opponent had not proved by way of evidence that it had built up the required goodwill in their mark in the State, the ground under Section 10(4) must fail.

In conclusion, the Applicant argued that as the grounds under Section 10(2)(b), 10(3) and 10(4)(a) had not been substantiated or founded the Opposition in its entirety should be rejected.

16. Likelihood of Confusion

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

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

(a)

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

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

17. Therefore, there are four basic requirements that must be met in order for an objection under this section to succeed. They are: (i) there must be “an earlier trade mark”, (ii) the goods or services of the application must be identical with or similar to those in respect of which the earlier trade mark is registered, (iii) the mark applied for must be similar to the earlier trade mark, and (iv) there must be a resultant likelihood of confusion on the part of the relevant consumer.
18. The Opponent’s EUTM 002927549 “McGREGOR”, with a filing date of 8th November 2002, was registered at the European Union Intellectual Property Office (EUIPO) prior to the relevant date and is an earlier trade mark. Therefore, the first of the conditions is fulfilled.
19. The Opponent’s earlier mark – EUTM 002927549 “McGREGOR, is registered for Class 25 goods “Clothing, footwear with the exception of golf shoes, headgear”, this includes the items covered by the Applicant’s Class 25 goods. I find the respective Class 25 goods at issue are identical with or similar to each other and, therefore, the second condition is met. I note, however, that the Opponent, in their Grounds of Opposition, stated that their earlier EUTM covered goods in Classes 3, 18 and 25. They further clarified that the Opposition was directed against the Applicant’s Class 3 and Class 25 goods only. I note that the cited EUTM is registered only for the Class 25 goods “Clothing, footwear with the exception of golf shoes, headgear.”

Comparison of the marks

20. I have compared the respective marks on the criteria of visual, aural, and conceptual similarity and have attempted to make an overall assessment of the extent to which they should be regarded as similar or different. This is an assessment of the overall impression the marks make on me, having put myself in the shoes of the average consumer of the goods for which the Applicant is seeking registration. The Court of Justice of the European Union (CJEU) noted in *Sabel BV v Puma AG and Rudolf Dassler Sport Case C-251/95*¹ that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. For this reason, the appreciation of the visual, aural, and conceptual similarity of the marks must be based on the overall impressions given by them, rather than on specific points of detail that are likely to go unnoticed by the average consumer.

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

CONOR McGREGOR

McGREGOR

22. I find that there are some visual similarities between the marks, in that each contains the name McGREGOR. The Applicant's mark is pre-fixed with the additional name CONOR I find the marks are visually similar. I rate the level of visual similarity between the marks as medium.

23. The Opponent's mark consists entirely of one syllable, the surname 'McGREGOR'. The Applicant's mark contains this surname, but it additionally includes the forename "CONOR". When the respective marks are spoken, there is some similarity. But the marks differ in that the Opponent's mark does not contain the sound created in the Applicant's mark by the prefix "CONOR". Therefore, in my opinion, the marks are more aurally dissimilar than similar. I find the level of aural similarity between the marks to be low to medium.

24. Both the Applicant's and Opponent's mark include the surname McGREGOR, with the Applicant's including the additional forename "CONOR". I find there is some conceptual similarity between the marks, the level of which I rate as medium.

25. Having completed my examination of the marks in respect of their visual, aural, and conceptual characteristics, I find that there is an overall medium level of similarity between them. Thus, the third condition is met.

26. As I have found there is some similarity between the marks, I must conduct a global assessment of the likelihood of confusion which requires me to take all relevant factors into account,

¹ Paragraph 23 of decision dated 11 November 1997

including the similarity between the goods. In the *Canon Kabushiki*² case the CJEU found “a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa”. This is relevant as I have already found the Class 25 goods at issue are either identical or similar.

27. I must also consider other factors identified by the CJEU³ in this area, including the following:

- (a) the more distinctive the earlier mark, the greater will be the likelihood of confusion.
- (b) in determining the distinctive character of the earlier mark, it is necessary to make an overall assessment of its capacity to identify the goods for which it is registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings.
- (c) in making that assessment, account should be taken of the inherent characteristics of the mark; the market share held by it; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested in its promotion; the proportion of the relevant public which, because of the mark, identifies the services as originating from a particular undertaking; and statements from chambers of commerce and industry and other trade and professional associations.
- (d) a global appreciation of the likelihood of confusion as regards the visual, aural, and conceptual similarity of the marks in question, must be based on the overall impression created by them, and the importance attached to each of those elements must take account of the category of goods and the way in which they are marketed and used by the purchasing public.
- (e) the assessment must be made from the perspective of the average consumer who is deemed to be reasonably well-informed, observant, and circumspect but who rarely has the chance to make a direct comparison of the marks and must rely on the imperfect picture that he has of them in his mind,

28. The Opponent has provided evidence to support its claims of long-established, extensive, and continuous use of the mark in Ireland. Therefore, I am satisfied the mark is known to Irish consumers for Class 25 goods and that it has the capacity to identify the goods for which it is registered as being those of a particular undertaking, and thus to distinguish those goods from those of other undertakings.

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

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

29. The criteria for deciding a likelihood of confusion in terms of goods envisages a typical purchasing scenario where goods from the respective parties may be found on the same shelf of a store, or in the same store, or are in competition or are complimentary to each other.
30. Consumers only purchase the goods at issue on an infrequent basis. Therefore, in my opinion, consumers would pay significant attention when making the decision as to which goods to buy.
31. The Opponent's earlier mark "McGREGOR" is registered in respect of the Class 25 goods covered by the opposed application and, therefore, I must make an overall assessment of the likelihood of confusion that may exist between the Opponent's earlier trade mark and the Applicant's mark, "Conor McGREGOR". The confusion in question may be direct confusion, whereby the Applicant's goods are mistaken for those of the Opponent, or indirect confusion, whereby the Applicant's goods are associated in the mind of the consumer with those of the Opponent and a common commercial origin is inferred.
32. It is not necessary to find that every consumer would be confused. Nor is it sufficient to find that some consumers might be confused in order to refuse registration of a trade mark under Section 10(2)(b). The question is whether it is likely or unlikely that the average person would be confused in the course of the typical scenario wherein they seek the goods at issue.
33. I have already found the respective marks share a level of similarity. I am satisfied, however, that the level of similarity is low enough that it would mean that the overall impression conveyed by the marks is that they are different. I have looked at the question of likelihood of confusion from a practical perspective in the context of the marketplace and I have put myself in the shoes of the average Irish consumer of the goods in question. Having done so, I am satisfied that a consumer, having experienced the relevant goods of the Opponent, and having subsequently encountered the Applicant's mark for the same goods, would not be likely to be confused or caused to wonder that the latter goods were from the same commercial origin as the former, or that the goods providers were economically linked.
34. In light of all the above, I find no likelihood of confusion would arise if both marks were used for their respective goods in the Irish marketplace. Accordingly, I find the application does not offend against Section 10(2)(b) and I dismiss the opposition on this ground.

Section 10(3)

35. I now turn to the grounds of opposition centred on Section 10(3) of the Act, which provides as follows:

“A trade mark which –

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

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

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

36. The purpose and effect of that provision is to afford an extra level of protection to marks that have a reputation over and above that which is given to other trade marks. As is evident from the wording of the Section, there are a number of conditions that must be fulfilled in order for it to apply. Firstly, there must be identity or similarity of the marks at issue; secondly, there must be a dissimilarity between the respective goods⁴; thirdly, the earlier mark must have a reputation in the State or the EU; fourthly, the use of the later trade mark must be without due cause; and fifthly, that use must take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier marks.

37. I have already found that the first two conditions have been met – there is some level of similarity with the Opponent’s mark and there is the required dissimilarity or similarity (following the CJEU decision) in respect of some of the goods applied for.

38. The third condition is the Opponent’s earlier EUTM ‘McGREGOR’ must enjoy a reputation in the EU. The Opponent submitted evidence in support of this.

39. I am satisfied that use by the Opponent of its mark in a number of EU member States is sufficient for me to conclude that, on the relevant date, the mark had the type of reputation worthy of protection under Section 10(3)(b) of the Act.

40. Turning now to due cause. The Opponent has not offered anything to suggest the Applicant does not have due cause to use the mark put forward for registration. On this basis I must conclude

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

the Applicant has due cause to use its mark. Having found the Applicant has due cause to use its mark, I do not have to consider whether or not the Applicant's use of it would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponent's mark.

41. No evidence or argument has been adduced or advanced by the Opponent to support its claims that the Applicant's use of its mark would tarnish the reputation of the Opponent's mark in the marketplace or undermine its capacity to identify exclusively the Opponent's goods. It appears the Opponent's case is based on the fact that it owns an earlier mark of repute for certain goods, and that that is enough. These facts are sufficient to allow me to determine the matter under Section 10(2)(b), but more would be needed for me to refuse the Applicant's mark under Section 10(3).
42. I find the level of similarity between the marks is such that I cannot accept the Opponent's claim that use of the Applicant's mark would result in the damage or unfair advantage that Section 10(3) seeks to avoid. I am completely satisfied the parties' marks can coexist in the marketplace without impacting in any way on the Opponent's mark or reputation. Therefore, I dismiss the opposition under that Section also.

Section 10(4)(a) - use of mark is liable to be prevented by virtue of any rule of law.

43. 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 – 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,”

44. Whether use of a mark should be prevented under the law of passing off is a matter for the Court to decide in a given case and, in so deciding, the Court is performing a different function to that performed by the Controller when considering an application for registration. Section 10(4)(a) is not concerned with whether passing off has actually taken place but with whether registration should be refused. It requires a determination by the Controller as to whether the fundamental ingredients of an action for passing off would exist if the disputed mark was used in the State by the Applicant.

45. No evidence or argument in respect of passing off was advanced by the Opponent. Other than raising it as a ground of opposition in its Notice of Opposition the Opponent never mentions passing off. Again, it appears the Opponent's case in respect of passing off rests solely on the fact that it owns an earlier mark of repute "McGREGOR" for certain goods. But again, that is not a sufficient basis on which I can refuse the Applicant's mark under Section 10(4)(a).

46. In any event, I have already found that the parties' marks are different. In light of these findings, I am satisfied that the use by the Applicant of its mark for the relevant goods would in no way constitute a misrepresentation that these goods were those of the Opponent. Furthermore, I am satisfied that such use would not damage the Opponent's business in any way. Accordingly, I dismiss the opposition on this ground also.

47. When considering this case as a whole, I am also mindful of the decision in ECJ Case C-404/02 *Nichols plc v Registrar of Trade Marks*. The ECJ decision contained a number of key points of relevance to the present case as follows:

- Surnames are to be examined exactly the same way as any other prospective trademarks. Stricter general criteria of assessment based on a predetermined number of persons with the same name, above which that name may be regarded as devoid of distinctive character, the prevalence or otherwise of the use of surnames in the relevant trade cannot be applied to such trademarks.
- The registration of a surname as a trade mark cannot be refused in order to ensure that no advantage is afforded to the first applicant who wants to use that name.
- [Article 6\(1\)\(a\)](#) of Directive 89/104 permits a person to make honest use of his name if it is identical or similar to a registered mark.

48. Finally, having considered all of the evidence and submissions by both sides in this case, I must also reflect on my own experience and knowledge as an average Irish consumer of the goods at issue. While doing this, I must also consider what the name Conor McGREGOR means in Ireland and how well known the sports personality of that name is in this country. Would the average consumer in this instance be likely to associate goods supplied under the mark Conor McGREGOR with the Dutch company trading under the name McGREGOR? In my opinion, that would be very unlikely. The prior registration and use of the Opponent's trade mark McGREGOR does not constitute any grounds for refusal of the application to register the mark at issue. The Applicant's mark does not infringe the mark of the Opponent. Therefore, I have decided to dismiss the opposition and to allow the Applicant's Conor McGREGOR mark to proceed to registration.

John Nolan

Acting for the Controller

25 September 2023