

DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE MARKS IN PROCEEDINGS UNDER THE TRADE MARKS ACT, 1963 AND THE TRADE MARKS ACT 1996

In the matter of applications for registration of Trade Mark Nos. 177237, 177238, 177239, 177240, 177242, 177243, 177244 and 177245, and in the matter of Oppositions thereto.

DIESEL SpA

Applicant

(Represented by Tomkins & Co.)

MONTEX HOLDINGS LIMITED


Opponent

(Represented by FRKelly)

The Application

1. On 11 January, 1994 (the “relevant date”), DIESEL SpA, a Societa per Azioni organised and existing under the laws of Italy, of 7 Via dell'Industria, 36060 Molvena, Province of Vicenza, ITALY made application to register the marks as detailed in the table below:

Trade Mark	Number	Class & Goods
DIESEL	177237	16 Printed matter; newspapers, magazines, books and catalogues; photographs; calendars, almanacs, diaries, address books; personal organisers; note-pad holders; pens, pencils; pencil stands, pencil cases; paper-clip boxes; adhesive tape dispensers; patterns for making clothes; all included in Class 16.
	177238	18 Leather and imitations of leather, and goods made of these materials included in Class 18; animal skins, hides, trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.
	177239	24 Textiles and textile goods included in Class 24; bed and table covers.
	177240	25 Clothing, footwear, headgear.

Trade Mark	Number	Class & Goods
 <p>hereinafter referred to as "DIESEL Logo"</p>	177242	16 Printed matter; newspapers, magazines, books and catalogues; photographs; calendars, almanacs, diaries, address books; personal organisers; note-pad holders; pens, pencils; pencil stands, pencil cases; paper-clip boxes; adhesive tape dispensers; patterns for making clothes; all included in Class 16.
	177243	18 Leather and imitations of leather, and goods made of these materials included in Class 18; animal skins, hides, trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.
	177244	24 Textiles and textile goods included in Class 24; bed and table covers.
	177245	25 Clothing, footwear, headgear.

2. The applications were accepted for registration and advertised accordingly in Journal No. 1934 dated 23 January, 2002.

3. Notices of Opposition to the registration of the trade marks pursuant to Section 26 of the Trade Marks Act, 1963 (the "1963 Act") were filed on 21 February 2002 by Montex Holdings Limited (hereinafter referred to as "Montex"), an Irish company, of Mall Road, Monaghan, Ireland. The Applicant filed a counter-statement on 10 May, 2002 and evidence was, in due course, filed by the parties under Rules 37, 38, 39 and 40 of the Trade Marks Rules, 1963 (the "1963 Rules"). Further evidence was taken *viva voce* on oath at the Hearing of the matter from Mr. Patrick McKenna, a director of the Opponent's company, on foot of a summons issued by the Controller pursuant to section 92 of the Patents Act, 1996, as amended.

4. The oppositions became the subject of a hearing before me, acting for the Controller, on 21 May, 2012. The parties were notified on 4 April, 2013 that I had decided to uphold the oppositions in respect of applications Nos. 177240 and 177245 (i.e. both the word mark DIESEL and the DIESEL Logo mark in respect of clothing, footwear and headgear, in Class 25), but to allow the other six applications 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 Applicant in that regard, pursuant to Rule 27(2) of the Trade Mark Rules, 1996 filed on 9 April, 2013.

5. The applications at issue were filed under the Trade Marks Act 1963, under which there was no provision to file a multi-class application. Therefore, there were eight separate applications that resulted in eight corresponding oppositions. For the sake of expediency and efficiency, a single hearing was held in respect of all eight oppositions, and, in keeping with the need to maintain those objectives, this document comprises the written grounds of all eight decisions.

Grounds of Opposition

6. In its Notices of Opposition the Opponent states that it has extensively carried on business in Ireland, under the trade mark DIESEL, as manufacturers and merchants of clothing; and raises objection to the present applications under certain Sections of the 63 Act, which I summarise as follows:

- Section 2 and Section 25 – *the Applicant has no intention to use the trade marks in relation to either all or some of the goods embraced by the applications, (though this ground was not raised in the Notices of Opposition in respect of Application Nos. 177240 and 177245 for goods in Class 25);*
- Section 2 and Section 25 - *the Applicant cannot make any lawful claim to be the proprietor of the DIESEL trade marks in Ireland;*
- Section 17 and Section 18 - *the Applicant's marks are not adopted, or capable of being adopted, to distinguish the goods of the Applicant from the goods of other traders, including goods sold by the Opponent; and*
- Section 19 – *the proposed use of the Trade Marks is calculated to deceive and cause confusion and is otherwise disentitled to protection in a Court of Law*

The Opponent also claimed that the applications ought to be refused by the Controller in the exercise of his discretion.

Counter-Statement

7. In its Counter-Statement the Applicant denies all the grounds of opposition.

Rule 37 Evidence

8. Evidence submitted by the Opponent under Rule 37 of the 1963 Rules consists of a Statutory Declaration and supporting evidence, by way of five exhibits (“EXH 1” to “EXH 5”), dated 19 December 2002, of Michael Heery, Managing Director of Montex. Much of the declaration is

taken up with legal argument, which was repeated at the Hearing. I would summarise the factual content of his evidence as follows:

- (i) Montex and Diesel SpA have a long-running dispute and were involved in a previous opposition (hereinafter referred to as the “Previous Proceedings”), in which Montex applied to register the trade mark DIESEL in Ireland and which Diesel SpA opposed successfully (the decision of the Controller is exhibited at “EXH 1”). The evidence provided by Montex and Diesel SpA in those proceedings and the decisions of the High Court¹ and the Supreme Court² (Exhibits “EXH 2” and “EXH 3” respectively) in relation to that opposition are very relevant to the present opposition. Michael Heery says that the same principles which were applied in the previous opposition are applicable in the present opposition and that the relevant portion of the decision of the High Court and the decision of the Supreme Court should be followed.
- (ii) He states that he was a director of Monaghan Textiles Limited, a company that used the mark DIESEL on jeans since 1979. Montex presented Statutory Declarations in the previous opposition, which the High Court accepted as being “*genuine and bona fide sworn statements to the effect that jeans were sold using the mark to the general public since 1979*”³. When Monaghan Textiles went into receivership in 1988 Montex Holdings Limited purchased the trade mark DIESEL and the accompanying goodwill. Therefore Montex is the owner of the trade mark DIESEL in Ireland. This was accepted as a probability by O’Sullivan J. where in his decision he stated (at page 586 1 I.R. [2000]) “*I further agree with [the Controller] that the evidence in relation to the passing of the title to [Montex] of the mark and its goodwill establishes a probability of ownership and I accept that [Montex] has acquired the interest therein which was first owned by Monaghan Textiles Limited.*”
- (iii) Montex has a wide network of retailers throughout Ireland who sell its goods. In the Previous Proceedings the Supreme Court described the list of retailers furnished by Montex as “*quite an extensive list covering all four provinces in Ireland*” [page 7 of the Decision].
- (iv) Turnover figures for products bearing the DIESEL trade mark of Montex covering the years prior to the filing date of the allocation are as follows:

¹ Decision of O’Sullivan J. dated 14 January, 2000

² Decision of Supreme Court dated 5 April, 2001

³ Montex v. The Controller of Patents, Designs and Trade Marks and Diesel S.p.A. Page 586 1 I.R. [2000]

Year	Turnover IR£	Euro Equivalent
1989	22,411	28,456
1990	18,466	23,447
1991	39,477	50,125
1992	49,973	63,453
1993	53,019	67,320
1994	37,719	47,893
1995	41,377	52,538
TOTAL	IR£262,442	€333,232

- (v) In the High Court Decision in the Previous Proceedings, Diesel SpA was held to have established a sufficient user in the mark DIESEL prior to the filing date of that Application to entitle it to oppose the Application by Montex. In the evidence supplied by Diesel SpA in that opposition only one invoice from 1982, two invoices from 1983 and a series of invoices, all from the same date in 1994 were produced. The only Statutory Declaration provided by Diesel SpA indicated that its goods were sold in, at most, 9 shops in Ireland. The evidence supplied by Montex as to its use of its DIESEL mark is far more extensive and continuous than this. Therefore, it must follow that Montex has established more than sufficient user in the mark DIESEL prior to the filing date of the present application to entitle it to oppose the application.
- (vi) Exhibit “EXH 4” contained a Statutory Declaration of Michael Heery, dated 20 February, 1996 and four accompanying exhibits (“MH1” to MH5”) that were submitted in the Previous Proceedings, which contain the following:
- a. A list of retailers throughout the State who sell DIESEL jeans (exhibit “MH1”).
 - b. Samples of the DIESEL trade mark as applied to the goods of Montex (exhibit “MH2”).
 - c. Invoices in respect of the purchase of raw materials, which are clearly marked to be for DIESEL jeans and which predate the date of first use claimed by the Opponent in the Previous Proceedings (exhibit “MH3”).
 - d. Invoices in respect of sales of DIESEL jeans, dating back to February 1980, which predate Diesel SpA’s alleged first use (exhibit “MH4”).

(vii) The Montex DIESEL mark and the Diesel SpA DIESEL mark have co-existed in Ireland for some time. Exhibit “EXH 5” contains an advertising circular produced by an official Diesel SpA stockist that contains the wording “*BE AWARE – KNOW THE FACTS There are currently 2 different DIESEL Brands on sale in the Irish Market*”.

Rule 38 Evidence

9. Evidence submitted by the Applicant under Rule 38 consists of a Statutory Declaration and supporting evidence, by way of two exhibits (“RR1” and “RR2”), dated 14 October, 2003, of Renzo Rossa, Sole Manager of Diesel SpA, and a Statutory Declaration and supporting evidence, by way of three exhibits (“PSL”, “PSL1” and “PSL2”), dated 26 November, 2003 of Peter Schofield Lawley, Commercial Director of Diesel (London) Limited.

10. Renzo Rossa confirms that there is a long-running dispute between Diesel SpA and Montex, and refers to the previous successful opposition against the Montex DIESEL application of 18 September 1992. He states that, while Michael Heery has sought to attach significance to certain aspects of that opposition, it is important to have regard to all the materials pertaining to the said opposition. In that respect he attached at Exhibit “RR1” a booklet containing copies of the following:
 - a. Notice of Opposition dated 19 September 1994;
 - b. Counter Statement dated 7 October 1994;
 - c. Statutory Declaration of Renzo Rossa dated 22 February 1995;
 - d. Statutory Declaration of Richard Farrell dated 13 June 1995;
 - e. Statutory Declaration of Michael Heery dated 20 February 1996;
 - f. Statutory Declarations of Roisin McKenna, Ann Maguire, Mena Higgins, Margaret Crudden and Luke McAdam dated 21 December 1995;
 - g. Statutory Declaration of Gerry McGirr dated 20 February 1996;
 - h. Statutory Declaration of Martin McCormack dated 20 February 1996;
 - i. Statutory Declaration of Martin Ferris dated 21 February 1996;
 - j. Statutory Declaration of Renzo Rossa dated 9 July 1996;
 - k. Statutory Declaration of Peter Schofield Lawley dated 9 July 1996;
 - l. Statutory Declaration of Tony Forte dated 9 August 1996;
 - m. Decision of the Hearing Officer (Peter Skinner) dated 1 July 1998;

- n. Special Summons dated 27 August 1998;
 - o. Affidavit of Michael Heery sworn on 28 August 1998;
 - p. Affidavit of Peter Skinner sworn on 26 November 1998;
 - q. Decision of the High Court delivered on 14 January 2000⁴; and
 - r. Decision of the Supreme Court delivered on 5 April 2001⁵.
11. Mr. Rossa takes issue with the contents of Mr. Heery's Statutory Declaration submitted under Rule 37. Mr. Rossa claims that Mr. Heery is highly selective in quoting from the decisions of the High Court and the Supreme Court in the Previous Proceedings, and that Mr. Heery has made claims that certain findings were made in the Previous Proceedings, which are not supported by the wording of the decisions of the Courts.
12. Mr. Rossa focuses much attention on the Previous Proceedings, in particular on the allegation that Monaghan Textile Limited's application to register the DIESEL trade mark was lacking in *bona fides* and that Monaghan Textiles Limited (the predecessor in business to Montex) was never at any time able to provide an explanation as to how it came to choose the word DIESEL as a trade mark for clothing. He states that O'Sullivan J commented at length on this in his High Court decision and that, notwithstanding these comments, Mr. Heery's reluctance to divulge how Monaghan Textiles Limited came to use the mark has persisted up to the present day. Mr. Rossa claims that the want of addressing the issue is, once again, manifest in the Statutory Declaration made by Mr. Heery in the present opposition.
13. Mr. Rossa makes it clear that, in his opinion, the matter at hand is not a case of the roles being reversed from those in the Previous Proceedings, as claimed by Mr. Heery. Mr. Rossa claims that Diesel SpA's application cannot be viewed in the same light as that previously brought by Montex. That is because Diesel SpA's creation of the mark DIESEL, and its use and development of that mark, has been completely legitimate and honest from the outset, whereas the basis for such use as relied upon by Montex (both in the context of its previous application and the present opposition) is dubious to say the least, and the High Court was prepared to treat it as such, and for this reason rejected Montex's application for registration. The likelihood of confusion on which Montex now seeks to rely flows from the wrongful appropriation of the mark DIESEL by Monaghan Textiles Limited and its continued use by Montex. Any likelihood

⁴ [2000] 1 IR 577

⁵ [2001] 3 IR 85

of confusion which that creates cannot be regarded as disintitling Diesel SpA's use of the mark DIESEL to protection in a court of law within the meaning of Section 19 of the 1963 Act and therefore cannot justify the rejection of Diesel SpA's application.

14. Mr. Rossa rejects the claims made by Mr. Heery that Diesel SpA has not used the mark DIESEL in Ireland before the filing date of the present application and that any use effected by Diesel SpA was not of sufficient extent and continuity to enable the mark to distinguish the goods of Diesel SpA from the goods of others. He also rejects Mr. Heery's claim that the *bona fides* of Diesel SpA are irrelevant and maintains that this is an important factor which demonstrates why the outcome of the previous opposition brought by Diesel SpA does not govern the present application. Mr. Heery's reference to the decision of the Supreme Court on the inapplicability of a criterion of blameworthiness misses the point that, in these proceedings, it is the conduct of the Opponent and not the Applicant that requires close scrutiny.

15. Mr. Rossa also rejects Mr. Heery's claims of co-existence between the two users of the DIESEL trade mark in Ireland. Montex is fully aware that Diesel SpA takes grave exception to its use of the DIESEL trade mark and this objection is well-known in the trade. The advertising circular produced by an official Diesel SpA stockist did not originate with Diesel SpA and was not authorised by it. In this regard he exhibits at "RR2" a copy of a letter from Mr. Cormac Harten, the proprietor of Empire, dated 17 April, 2003 in which Mr. Harten confirms the following:
 - a. He scripted and produced a leaflet concerning the two different DIESEL brands on sale on the Irish market;
 - b. The leaflet was produced for the purpose of educating both the staff at Empire and its customers of the situation that existed;
 - c. He felt it was necessary to dispel the confusion between the 2 products;
 - d. The leaflet was never distributed or published in any magazine or newspaper and was solely meant to be used as an in-store awareness tool;
 - e. Copies of the leaflet were left at the point-of-sale desk at Empire's Navan, Monaghan and Drogheda stores; and
 - f. At no point did he consult with Diesel SpA or ask their permission to produce the leaflet, which he did on his own volition.

16. For the remainder of Mr. Rossa's Declaration he engages in legal argument concerning certain of the content of Mr. Heery's Statutory Declaration submitted under Rule 37, which I need not repeat here.
17. The Statutory Declaration of Peter Schofield Lawley was sworn solely to attach exhibit "PSL" which is a copy of his Statutory Declaration of 9 July, 1996, the content of which he confirms and adopts as part of his present Statutory Declaration for the purpose of the present opposition proceedings. I would summarise his evidence as follows:
- (i) His company, Diesel (London) Limited, is a subsidiary of Diesel SpA and has, since May 1995, acted as agents and distributors for Diesel SpA in the United Kingdom (UK) and Ireland;
 - (ii) Diesel SpA has sold DIESEL branded products through outlets in Ireland over many years and Diesel SpA has acquired a substantial reputation in the name DIESEL in respect of clothing in Ireland. Prior to May 1995 a company called James Wood Associated Limited (formerly called JWA Limited) acted as distributors for Diesel SpA in the UK and Ireland. His company purchased from JWA the list of accounts/customers which had been supplied with DIESEL products of Diesel SpA;
 - (iii) He was employed by JWA Limited, in the capacity of Sales Manager, for a period of 8 years and is familiar with sales which JWA Limited made during his time with that company. Exhibited at "PSL1" is a table containing summary details of purchases (the costs of which are given in Italian lira), which JWA made from Diesel SpA during the period 1989-1995. Despite no mention of the trade mark DIESEL or Diesel SpA, he confirms the bulk of the lines in the table refer to DIESEL branded clothing of Diesel SpA;
 - (iv) He believes that JWA regularly sold quantities of DIESEL branded clothing to F.X. Kelly & Co. and other well-known retailers in Ireland during the period 1988-1995;
 - (v) He believes that prior to 1988 the distributorship for the UK and Ireland was handled by another UK company, Walker Webster Ltd;
 - (vi) He believes that goods bearing the DIESEL trade mark were sold directly into Ireland by Diesel SpA during the 1980's;
 - (vii) He states goods bearing the trade mark DIESEL of Diesel SpA have been advertised in well-known magazines such as The Face, Arena, ID, For Him and Sky TV Magazine, which he understands also circulate in Ireland. He exhibits at "PSL2" copies of two such advertisements which he states have appeared from time to time in these magazines; and

(viii) He states that Diesel SpA have also advertised their range of clothing bearing the trade mark DIESEL on MTV, a satellite television channel which he believes is received in many parts of Ireland.

Rule 39 Evidence

18. In reply to the Applicant's evidence filed under Rule 38 the Opponent filed a number of Statutory Declarations as follows:

- (i) A second Statutory Declaration of Michael Heery dated 5 October, 2004 and accompanying exhibit "EXH1";
- (ii) A Statutory Declaration of Keith Doyle, proprietor of Miss Money Penny clothes shop of Liffey Street, Dublin dated 5 October, 2004;
- (iii) A Statutory Declaration of David O'Connor, director of Pilot Fashions, Cork dated 5 October, 2004;
- (iv) A Statutory Declaration of Michael Sherlock, resource manager for Batchelors Limited, Dublin dated 5 October, 2004; and
- (v) A Statutory Declaration of Patrick McKenna, director of Montex Holdings Limited, dated 5 October, 2004.

19. In his second Declaration Mr. Heery takes issue with certain of the statements made by Renzo Rossa in his evidence filed under Rule 38, much of it relating to what the High Court and Supreme Court did, or did not, find in respect of the Previous Proceedings between the parties. Addressing the issue of his company's *bona fides* in the use of the DIESEL mark, he states that, in his opinion, it is abundantly clear from the Supreme Court decision, *bona fides* and the discretion in Section 25(2) are not relevant until Section 19 has been considered and discounted as a ground for opposition. He states that Montex did not and does not believe that *bona fides* are in any way relevant to Section 19, though, without prejudice to that, part of the evidence submitted under Rule 39 will consist of a sworn statement in relation to the adoption by Montex of its DIESEL mark.

20. Mr. Heery notes that the Supreme Court never made a decision on the issue of *bona fides* in Section 25(2), and that if it had considered that issue, then it may have differed substantially from the *ultra vires* (Mr. Heery claims it was *ultra vires* because the Supreme Court held that the High Court should not have considered the discretionary issue) findings of the High Court

on that section. He states that if it had been indicated that the Supreme Court considered that Diesel SpA had provided evidence to suggest that there may have been a lack of *bona fides*, evidence as to *bona fides* could have been provided to the court.

21. He rejects the contention by Mr. Rosso that the use by Montex of the mark DIESEL is dubious. Montex and its predecessors first used the mark in 1979, which is some three years prior to the claimed first use of the mark by Diesel SpA, and have used the mark continuously and extensively since then. The fact that the High Court, when considering a Section in contravention of the proper procedures, believed that an issue regarding Montex's *bona fides* had been raised, which Montex believed did not require refutation, has no bearing on the present opposition.
22. Mr. Heery's takes issue with Mr. Rosso's contention that the DIESEL trade marks of both the Applicant and the Opponent have not co-existed in Ireland. Mr. Heery states that, regardless of Mr. Rosso's opinion the evidence shows that co-existence has been a reality for almost 25 years. If Mr. Rosso believed that it had earlier rights in Ireland, whether by virtue of goodwill, reputation or otherwise, which predated Montex's rights, they would no doubt have taken an action for passing-off. They have not done so. It is self-evident from the 25-year co-existence that Diesel SpA is not entitled to the monopoly which would be granted by virtue of a trade mark registration.
23. As regards the leaflet distributed by the outlet "Empire", warning staff and customers of the existence of two different DIESEL brands, Mr. Heery states he has serious doubts whether a mere stockist of these products would take it upon themselves to invest time and money, in issuing circulars relating to one particular brand they stock, without the knowledge and consent of the brand owner. He also states that he believes this leaflet was not distributed for "in store awareness"; it was designed for distribution to the general public, which Mr. Heery claims is admitted by Mr. Harten of Empire and which Mr. Heery states happened on the streets of Dundalk and Navan. Mr. Heery points to the statement in Mr. Harten's letter that "*I felt this was necessary to dispel the confusion between the two products*". The presence of a likelihood of confusion means the mark must be refused registration under Section 19.
24. Mr. Heery states that he is aware of other instances in which the Applicant has sought to distinguish itself from the products of Montex in media directed towards the Irish market. This raises further doubt on the assertions that Mr. Harten acted without the consent or knowledge of

the Applicant. He exhibits at “EXH1” a copy of a publication titled “*Menswear in Ireland*” which was published in January 2004. A full page advertisement appears in the publication with the text “*When you see this sign [picture containing, inter alia, the words DIESEL FOR SUCCESSFUL LIVING and STOCKIST APPROVED BY DIESEL], RELAX ...Because You Are In A Stockist Officially Recognised By Diesel UK. If in doubt or for further information, please call: 020 7833 2255*”. Mr. Heery claims this add could not have been commissioned for any purpose other than to inform consumers that there is more than one DIESEL brand in Ireland and that the store displaying the sign in the advertisement stocks the DIESEL goods of Diesel SpA and not the DIESEL goods of Montex.

25. Mr. Heery notes that the figures for sales in the Statutory Declaration of Peter Schofield Lawley, which are in Italian Lira, do not relate solely to Ireland and therefore must be presumed to be combined figures for the UK and Ireland. No evidence as to the quantity of these goods which might have been distributed in Ireland or the value of same has been provided. The invoices exhibited to Mr. Rosso’s of 1982 and 1983 all feature very small quantities of goods, which Mr. Heery states would be typical of what is referred to as a “test purchase”, in which a company might take a few garments from several lines with which to test the market. It is very significant that only three such invoices for the years 1982 and 1983 are produced, with no further invoices being produced until 1994. Similarly, the invoices exhibited to the Declaration of Richard Farrell consist of 3 invoices from 1989 and two for 1995, again for small quantities of products. This would indicate that some Irish stores made some initial test purchases in 1982/83 and again in 1989, but must not have been a success because no further purchases were by these or other Irish companies until 1994. From this, Mr. Heery states, it can be concluded that the use by the Applicant of its mark in trade in Ireland largely commenced in 1994, the year the current application was filed and some 15 years after the commencement of continuous and extensive use by Montex of its mark in Ireland.

26. In his Statutory Declaration Keith Doyle states that he commenced purchasing products bearing the mark DIESEL in 1993 from Montex and has continued to buy such products since then. Mr. Doyle states he would have been aware of the Italian DIESEL company as he travels extensively throughout Europe buying products for his retail unit and would have been aware if the Italian DIESEL company was active in Ireland. As far as he is concerned the Italian DIESEL brand was not active on the Irish market in 1994 and only appeared some years later.

27. David O'Connor states he has been purchasing jeans and the like, bearing the mark DIESEL from Montex, on a continuous basis since 1991 and it is one of his best-selling brands. He would be more than aware if another brand with the same name was available prior to 1994. He states that in 1994 the only DIESEL brand active and available on the Irish market was the brand produced by Montex. The Italian DIESEL brand only appeared in the last few years and as he specialises in all major brands he would be very aware of such developments.
28. Michael Sherlock states he is responsible for the purchasing of all clothing for Batchelors Limited, a large food production company. His company has been purchasing jeans bearing the mark DIESEL from Montex since 1992 and has continued to purchase them on a regular basis since then. He says and believes that in 1994 he knew of no other brand called "Diesel" available on the Irish market other than the brand produced by Montex.
29. For his part Patrick McKenna declares that he has worked with Montex since its incorporation in 1984 and, before that, he was with the predecessors in title to Montex since 1963. He states that the mark DIESEL was suggested as a suitable name for jeans by Gene McKenna, a colleague of his at Monaghan Textiles Limited, but no relation. Gene McKenna is now deceased. At the time Monaghan Textiles Limited were developing a range of jeans to sell as work wear, aimed at the agricultural and industrial market, Gene McKenna was a supervisor in the cutting room and he (Patrick McKenna) was the factory engineer. They were involved in establishing the fit of the intended jeans and had a general discussion around the type of name which would be acceptable. At that time the factory was adjacent to a petrol station which had a big red and white Diesel sign on display, similar to many such stations around Ireland. As they were trying to develop a tough hardworking image, Gene McKenna felt the name 'DIESEL' would do the job. Patrick McKenna states that they also considered 'Silver Dollar' as a trade mark but the trade mark DIESEL was adopted as it was shorter and sounded more industrial.
30. Having received a copy of the Opponent's evidence under Rule 39, specifically the Statutory Declaration of Patrick McKenna, the Applicant requested that the Controller make a direction, pursuant to Section 92 of the Patents Act 1992, that at the Hearing, evidence be taken *viva voce* from Patrick McKenna and that Mr. McKenna be available for cross-examination in respect of his *viva voce* evidence and the Statutory Declaration made by him on 5 October, 2004. The Applicant claimed that such a direction is essential to a fair adjudication of these oppositions. In the Previous Proceedings the decision of the Controller was affirmed on appeal to the High Court and a subsequent appeal to the Supreme Court by Montex was dismissed. The decision of

O’Sullivan J in the High Court noted that at no time during the filing of evidence in the proceedings before the court did Montex proffer any explanation as to how it came to adopt the name DIESEL, notwithstanding that the omission of such an explanation was specifically adverted to in evidence filed by Diesel SpA in those proceedings. It is only in the course of Rule 39 evidence in the present proceedings that Montex has sought to attribute the origin of the DIESEL mark in the hands of Montex to one of its employees, a Mr. Gene McKenna, who is now deceased. In these circumstances the Applicant argued that it is essential that they be given an opportunity to test the veracity of the version of events which have been advanced.

31. There was a series of communications between the Controller and the parties concerning the above request, the outcome being that the Controller agreed to summon Mr. Patrick McKenna to give evidence and be cross-examined at the Hearing. The Controller also granted permission to the Opponent to file further evidence under Rule 40 of the 1963 Rules.

Rule 40 Evidence

32. Evidence submitted under Rule 40 consisted of a Statutory Declaration dated 15 February, 2008 of Shane Smyth, solicitor, Trade Mark Attorney and managing partner of FRKelly, European Patent Attorneys and Community Trade Mark Attorneys. He states that FRKelly acted as trade mark agents on behalf of Montex in respect of Trade Mark Application No. 147773, filed on 28 September 1992, which was opposed by Diesel SpA. In those proceedings the High Court raised the issue of *bona fides* in the use of the mark by Montex. Mr. Smyth says and believes that during the course of the previous proceedings, FRKelly was of the opinion that the issue of *bona fides* was irrelevant to the matter at hand. The basis of that opinion being as follows:

- a. *Bona fides* are only mentioned in the Trade Marks Act, 1963 in Section 16 (which concerns the saving for use of a person’s name, address or a description of the character of his goods), Section 28(4) (concerning the consideration of expired registrations in the examination of applications) and Section 34 (concerning the removal of a registered trade mark from the register); they are not relevant to an issue to be decided under Section 19.
- b. As regards discretion under Section 25(2), the issue of *bona fides* did not require refutation as no evidence had been provided to suggest that there was any lack of *bona fides* and the onus was on the Opponent to provide such evidence rather than on the Applicant to prove a negative.

- c. The opinion of FRKelly was shared by Counsel acting on behalf of Montex in the High Court and Supreme Court proceedings. Therefore, this issue was not addressed by Montex in the Previous Proceedings.

33. Mr. Smyth says that FRKelly is still of the opinion that *bona fides* are not relevant to a decision under section 19 and therefore the *bona fides* of Montex are not a matter which is relevant to the present opposition. Section 19 requires an examination as to whether there is a likelihood of confusion or deception as regards between the earlier mark and the mark applied for. He notes the concluding words of the High Court decision, “*The Irish cases appear to proceed on the basis that simple confusion or deception is sufficient to exclude registration under Section 19*”.

34. Prior to the Hearing a conference call took place between the legal representatives of the parties and myself wherein I informed the parties that the cross-examination of Mr. McKenna at the Hearing would be conducted in the similar manner to a court case, namely that Mr. McKenna will give his evidence in chief first and will thereafter be cross-examined. I also indicated that I would give Mr. McKenna an opportunity to present some kind of introduction to his evidence, if desired.

The Hearing

35. At the Hearing the Opponent was represented by Mr. Paul Gallagher S.C. instructed by Mr. Shane Smyth and Ms. Niamh Hall, Trade Mark Agents of FRKelly and the Applicant by Mr. John Gordon S.C., with him Mr. Paul Coughlan B.L. and instructed by Mr. Simon Gray, Trade Mark Agent of Tomkins & Co. Both learned Counsel made extensive oral submissions, citing relevant case law and provided me with written outlines of their submissions, all of which I have found most useful in deciding this case. The remarks as to the respective cases presented by Counsel that appear hereafter are not offered as a comprehensive summary of their arguments but merely as indications of what I find to be the main points around which they built their cases. A full listing of the authorities relied upon by both parties at the Hearing is attached at Annex 1.

Oral evidence of Patrick McKenna

36. Mr. Gordon, for the Applicant, prefaced his cross-examination of Mr. McKenna by putting me on notice that it was taking place without prejudice to his contention that the evidence of Mr. McKenna is inadmissible, citing the principle ground of objection as the application of the ruling in *Henderson v. Henderson*⁶, which basically provides that if you had the opportunity to adduce particular evidence in a hearing you cannot then adduce different evidence or that evidence in another hearing with the same parties. In other words the matter is regarded as *res judicata*. He says that as a matter of law Mr. McKenna's evidence is inadmissible and should be disregarded. He returned to this point during his legal submissions to the Hearing and I will deal with it later. Mr. Gordon also objected, in so far as McKenna purports to give evidence of something said by somebody who is dead, that that in itself is hearsay, inadmissible and of no probative value.

37. I would summarised the evidence given by Mr. McKenna as follows:

- a. He first became involved with the predecessor of Montex in 1963, by way of a part-time after-school job. On finishing school in 1976 he got a full-time job with the company. He is currently a director of Montex with a 33% shareholding, having bought the company with two other men in 1988. He was a director of Montex at the time of the Previous Proceedings.
- b. Originally the business was involved with manufacturing shirts, but in 1971 it began manufacturing dresses also. In 1978 they quit making dresses and switched the plant in order to make shirts and jeans. In 1982 the factory switched completely to the manufacture of jeans.
- c. Gene McKenna was the foreman in the cutting room and when the manager (Mr. Harry Doherty) asked for a name for work wear or hardworking jeans. Gene McKenna came up with the name "DIESEL".
- d. A production meeting was held every Monday evening and many people suggested names. It was following one of these production meetings that the mark DIESEL was first used.
- e. Mr. McKenna stated that he had not travelled abroad at the time the name was suggested and that Gene McKenna was not a travelling man.
- f. Despite being a director of Montex (with a 33% stake-holding) at the time of the Previous Proceedings, Mr. McKenna stated that he had very little interest in the litigation as he had a factory, with a lot of people in it, to run. He was aware of the explicit charge of dishonesty

- levelled at Montex by Mr. Rosso in 1985, which Mr. McKenna accepted was a serious matter, but which he claimed only came to his attention when the Controller gave his adjudication on the Montex application for registration filed in 1992. He claims he was not involved in putting the case together or in making the decision to ignore the charge. That decision was made prior to the adjudication of the matter by the Controller and was taken by the company's legal team. He stated that he never read the High Court decision or the Statutory Declarations of Mr. Rosso and Mr. Heery.
- g. Mr. McKenna stated that he discussed the issue of the origins of the DIESEL mark with Mr. Heery after the High Court decision, which was before Mr. Heery came to swear his first Statutory Declaration in the current proceedings. He accepted that Mr. Heery's Declaration was silent on the issue, but that it was only when Mr. Smyth asked him (Mr. McKenna that is) to swear his Declaration, which was drafted by a Mr. Douglas, a solicitor, regarding the provenance of his company's DIESEL mark that he did so. He claimed he could have made such a Declaration at any time from his starting with the company.
 - h. While, as a director of the company, he attended board meetings he stated that he was not involved in the decision to bring these opposition proceedings against the Diesel SpA application and had no legal involvement with it.
 - i. Gene McKenna died in 1988.
 - j. Mr. McKenna stated that he does not know that the Diesel SpA mark is portrayed in red and white, as he has never looked at it, not even to this day. He stated that he never heard of Diesel SpA's jeans until Montex went to register its DIESEL mark in 1992. He was aware of other jean manufacturers in later years but in 1978 he never thought about the jeans of other manufacturers that he would have to compete with.
 - k. In 1978, when the predecessors of Montex began manufacturing jeans, jeans were not considered casual wear; they were made from raw fabric. The fabric was clipped and pressed, but nothing more. It was only in 1983, when the wash plant was set up in Montex, that soft, washed, stone-washed, bleached and sand blasted jeans were manufactured that jeans became accepted as casual wear.
 - l. It was in 1978 that Montex's predecessor began manufacturing jeans, when all the machines the company had for making shirts and dresses were replaced. A new factory floor layout was required and new heavyweight machines purchased in order to make denim, which was his responsibility to oversee.

⁶ (1843) 3 Hare 100

Admissibility of Mr. McKenna's evidence

38. Mr. Gordon claimed that the attempt on the part of Montex at this late stage to proffer, through Mr. McKenna, an explanation as to how it came to adopt and use DIESEL is an abuse of process which is prohibited by the well-established principle known as the rule in *Henderson v. Henderson*⁷. This rule has been recognised and applied by the Supreme Court on a number of occasions. For example, in *Carroll v. Ryan*⁸ Hardiman J (with whom McGuinness and McCracken JJ concurred) summarised the law as follows:

“There is a well established rule of law whereby a litigant may not make the same contention, in legal proceedings, which might have been but was not brought forward in previous litigation. This rule is often traced to the judgment of Wigram V.C. in Henderson and Henderson [1843] 3 HARE 100. The learned Vice-Chancellor spoke as follows:-

"I believe I state the rule of the Court correctly when I say that where a given matter becomes the subject of litigation in, and adjudication by, a court of competent jurisdiction, the Court requires the parties to that litigation to bring forward their whole case and will not (except under special circumstances) permit the same parties to open the same subject of litigation in respect of matter which might have been brought forward, only as part of the subject in contest, but which was not brought forward, only because they have from negligence, inadvertence, or even accident, omitted part of their case. The plea of res judicata applies, except in special cases, not only to points upon which the Court was actually required by the parties to form an opinion and pronounce a judgment, but to every point which properly belonged to the subject of litigation and which the parties exercising reasonable diligence might have brought forward at the time".

A number of decisions affirming this approach were opened to us. Two of these were Irish cases. In Russell v. Waterford and Limerick Railway Company [1885] 16 LR IR 314, Dowse B. said that:-

"Where the cause of action is the same and the plaintiff had an opportunity in the former suit of recovering that which he seeks to recover in the second, the former recovery is a bar to the latter action".

Similarly in Cox v. Dublin City Distillery (No. 2) [1915] 1 IR 345, Palles C.B. held that a party to a previous litigation was bound "not only (by) any defences which they did raise in that suit, but also any defence which they might have raised but did not raise therein". In the judgment of Kelly J. in this case he also referred to Barrow v. Bankside [1996] 1 Lloyds Law Reports 278 and to Johnson v. Gore Wood [2002] WLR 72. The first of these cases speaks in terms of issues that might "sensibly" have been brought forward in previous litigation and also suggests that the rule of what is sometimes referred to as "estoppel by omission" is not in fact based on res judicata in the strict sense but it is an independent rule of public policy. Lord Bingham MR held

⁷ (1843) 3 Hare 100

⁸ [2003] 1 IR 309

that the Court must take the need for efficiency in the conduct of litigation into account.

In *Woodhouse v. Consigna* [2002] 2 AER 737, Brooke L.J. referred to this public interest and continued:

"But at least as important is the general need, in the interests of justice, to protect the respondents to successive applications in such circumstances from oppression. The rationale for the rule in Henderson v. Henderson that, in the absence of special circumstances, parties should bring their whole case before the Court so that all aspects of it may be decided (subject to appeal) once and for all is a rule of public policy based on the desirability, in the general interest as well as that of the parties themselves, that litigation should not drag on forever and that a defendant should not be oppressed by successive suits where one would do...."

This seems quite consistent with what Lord Bingham said in *Johnson v. Gore Wood*, at page 90 when he urged that the Court should arrive at:-

"... a broad, merits based judgment which takes account of the public and private interests involved and also takes account of all of the facts of the case, focussing on the crucial question whether, in all the circumstances, a party is misusing or abusing the process of the Court by seeking to raise before it issues that could have been raised before".

39. Mr. Gondon drew my attention to the English case of *Hormel Foods Corporation v. Antilles Landscape Investments Ltd*⁹ wherein Richard Arnold SC (sitting as a Deputy High Court Judge) held that the rule in *Henderson v. Henderson* precluded the bringing of a second attempt to invalidate a registered trade mark. Here the claimant was the registered owner of the trade mark SPAM which was registered in respect of canned meat. The defendant was the registered owner of the mark SPAMBUSTER, which was registered in respect of computer programming. An application by the claimant to have the defendant's mark declared invalid on the grounds that it was confusingly similar to the claimant's was rejected by the Registrar of Trade Marks. Subsequently the claimant brought separate proceedings before the High Court in which it claimed that the defendant's mark should be declared invalid on the grounds that it was descriptive, generic or devoid of distinctive character, or revoked on the ground that it had become generic through the inaction on the part of the defendant. Richard Arnold QC held that a cause of action estoppel precluded the claimant from pursuing the invalidity claim, but not the claim for revocation which was different in nature¹⁰. However, he went on to find that both claims fell foul of the rule in *Henderson v. Henderson* stating:

⁹ [2005] IP & T 822.

¹⁰ [2005] IP & T 822, 847 (paragraph 97).

“I cannot see that the Claimant has any private interest which justifies it in vexing the Defendant with an attack on the registration of the Defendant's mark for a second time when it could and should have raised these claims in the first set of proceedings. While I acknowledge that there is a public interest in invalid registered trade marks and trade marks which have become liable to revocation being removed from the Register, I do not consider that this public interest justifies such re-litigation either. If it were otherwise, re-litigation of the validity of intellectual property rights would always be possible. After all, the public interest in invalid patents being revoked is, if anything, greater than the public interest in invalid trade marks being removed from the Register. There is no suggestion in the authorities considered above, however, that this justifies parties re-litigating the validity of patents.

By contrast, the Defendant has a legitimate private interest in not being vexed a second time. This is particularly so given that the Claimant is a large and financially substantial concern whereas the Defendant is small and in financial difficulties; but I would reach the same conclusion in the absence of this factor. There is also a public interest in the finality of litigation.

Accordingly, it is my judgment that the claims made in the present proceedings constitute an abuse of process. This extends to the claim for revocation as well as to the claims for a declaration of invalidity, since this claim also could and should have been included. In particular, on the Claimant's pleaded case there was no material change of circumstances between the date of Mr Reynolds' decision (4 February 2002) and the date of the commencement of these proceedings (25 April 2003) which could justify the Claimant applying to revoke the Defendant's Mark now but not before. (The position could be different in a case where, say, a period of non-use had accrued in the interval sufficient to found an attack under section 46(1)(a) or (b) of the 1994 Act.)

Although Henderson v. Henderson abuse of process is generally invoked as a ground for striking out a claim, I see no reason why it should not equally be relied upon as a substantive defence, which is how I interpret Mr Austin as putting the Defendant's case, If I were wrong about that, I would strike out the Claimant's remaining claims on this ground.”¹¹

40. Mr. Gordon went further and contended that *Hormel* was distinguished by the English Court of Appeal in *Special Effects Ltd v. L'Oreal SA*¹² which concerned an attempt by the defendant, which had previously unsuccessfully opposed the registration of a trade mark, to invoke the same grounds for the purpose of challenging its validity after it was sued by the registered owner for infringement. In giving the judgement of the Court Lloyd LJ observed:

“77. *Given the nature of opposition proceedings as being, essentially, preliminary (so as not to lead to a final decision, as discussed above) and given the manner in which they are generally conducted, as they were in the present case, and applying Lord*

¹¹ [2005] IP & T 822, 850-851 (paragraphs 105-108)

¹² [2007] IP & T 617

Bingham's tests in the circumstances of this case, it seems to us that it would be wrong to regard it as an abuse of process for L'Oreal to seek to raise by way of counterclaim the grounds of invalidity on which it relied in the opposition proceedings, or to rely on the prior use which it had alleged in the opposition (and would rely on in support of the claim as regards invalidity) also as the basis of a passing off claim. If, as we have concluded, the legislation does not preclude the same party from seeking a declaration of invalidity, having failed in an opposition, it seems to us that the circumstances would need to be unusual to justify holding that a party who did take advantage of the second opportunity provided by the legislation is abusing the process of the court. We were told that sometimes opposition proceedings are conducted in a manner similar to that of High Court litigation, with Counsel representing the parties and with disclosure and cross-examination. We could imagine the possibility that, if issues had been fought in that way in the Registry on an opposition, it might then be properly regarded as an abuse to fight the same issues again in court.

...

83. *Counsel addressed to us various submissions based on the decision of Mr Arnold Q.C. in Hormel, referred to above. That case was concerned with successive attempts by the same party to obtain a declaration of invalidity as to a trade mark under section 47, first from the Registry and then, based on different grounds, from the court. The judge expressly distinguished a case involving prior opposition proceedings.*

84. *It seems to us that this is a crucial distinction. It does not seem to us to be necessary to decide whether Hormel was right. We can see more scope for arguing that it was, at least, an abuse of process to start two successive proceedings for a declaration of invalidity, one in the Registry and the other in the court. But even if that decision was correct, it does not seem to us to follow that the same applies in the case of prior opposition proceedings. We are therefore not persuaded that the decision in Hormel, if right, requires that the appeal be dismissed, so that it is necessary to decide the correctness of that decision in order to allow this appeal."*

41. Mr. Gordon argued that it was noteworthy that the Court expressly refrained from ruling out altogether abuse of process claims like the one under consideration there. In any event unlike *Hormel* and *Special Effects*, the issue Montex now wishes to reopen is not a ground of attack that it refrained from raising in a previous challenge mounted by it. In the Previous Proceedings it was a ground of attack levelled against Montex and it positively elected not to deal with it on the supposed basis that it did not regard the matter as relevant. This, according to Mr. Gordon, was not an acceptable basis for avoiding an application of the *Henderson v. Henderson* rule.

42. Regarding the issue of the inadmissibility of McKenna's evidence under the *Henderson v. Henderson* rule Mr. Gallagher (for the Opponent) confined his argument to stating that there can be no application of the *Henderson v. Henderson* rule, as the matter before the Hearing Officer

was a completely different issue to that in the previous proceedings. As regards Mr. Gordon's claim that Mr. McKenna's evidence concerning how Gene McKenna came up with the DIESEL mark was mere hearsay, Mr. Coughlan argued that it was not so. He claimed Patrick McKenna's evidence is direct and relates to events that he participated in or to conversations that he personally engaged in. Clearly it is not hearsay.

43. I have given due consideration to the objection to the admission of Mr. McKenna evidence, based on it being mere hearsay, and I have decided that the account he proffers of the genesis of the Montex DIESEL trade mark cannot be considered mere hearsay. His evidence goes to his role and responsibilities within Montex, actions he took in carrying out his responsibilities, and to conversations and meetings he participated in. Therefore, I cannot reject it on the basis it is mere hearsay.
44. As regards the inadmissibility under the *Henderson v. Henderson* rule I have decided that this rule does not apply for two reasons. Firstly, in my opinion, the circumstances in *Henderson v. Henderson*, (or indeed in any of the other authorities put forward by Mr. Gordon in support of his argument on this point) are not repeated here. This is not a case of Montex attempting for a second time to seek a successful outcome to a previous failed litigation (i.e. the registration of its DIESEL mark) and is now replying on evidence that it could have adduced in the Previous Proceedings, but, for whatever reason, chose not to advance such evidence. The Previous Proceedings concerned whether Montex was entitled to register its DIESEL mark, while these proceedings concern whether Diesel SpA can register its DIESEL mark. These are two completely different matters. While certain claims have been repeated and certain evidence reproduced in the current proceedings, the fact remains that the issue at suit is different. In my opinion, the fact that Montex chose not to address how it came to use its DIESEL mark (which proved fatal in the previous proceedings, and for which Montex paid the price) relates to a completely different given matter and cannot debar it from addressing the issue in these proceedings.
45. The second reason for which I find the evidence of Patrick McKenna admissible is the provisions of the relevant legislation. Rule 39 of the Trade Mark Rules, 1963, which concerns evidence in reply by the Opponent, is written in the following terms:

“(1) *Within one month from the receipt by the opponent of a copy of the evidence left with the Controller under Rule 38, the opponent may leave with the Controller*

evidence by way of statutory declaration in reply, and shall deliver to the applicant a copy thereof.

(2) *Evidence left with the Controller under this Rule shall be confined to matters strictly in reply.”*

46. It is clear from the foregoing that the Opponent has an explicit right to respond to matters raised by the Applicant in its evidence under Rule 38, so long as it is strictly in reply to those matters. In the present proceedings the Opponent filed, under Rule 37, the evidence it desired to adduce in support of the opposition, which did not contain any explanation as to the provenance of its DIESEL mark. It is for the Opponent alone to decide what evidence it desires to adduce and, while the Applicant criticised the lack of mention of the genesis of the Opponent’s DIESEL mark in the Opponent’s Rule 37 evidence, there was no requirement that the Opponent mention it. The Applicant, in its evidence filed under Rule 38, made much of the Opponent’s silence on the matter. In so doing, the Applicant provided the basis on which the Opponent could address the matter under Rule 39. Therefore, I am completely satisfied that the Statutory Declaration and oral evidence of Patrick McKenna are admissible by virtue of the rights afforded Opponents under Rule 39.

47. However, if on appeal the Court finds that the *Henderson v. Henderson* rule is applicable, I pray the Court will provide some guidance as to how the explicit rights afforded Opponents under Rule 39 are to be balanced, or not, as the Court may decide, with the *Henderson v. Henderson* rule.

Arguments of the parties on the substantive issue

48. The Opponent expressed a wish not to pursue the grounds of opposition mentioned in the Statement of Grounds other than those relating to the provisions of Sections 2 and 25 (the Applicant cannot make any lawful claim to be the proprietor of the DIESEL trade mark in Ireland) and Section 19 (the applications should be refused as the proposed use is calculated to deceive and cause confusion and is otherwise disentitled to protection in a court of law). Failing those, the Opponent seeks that the applications ought, in the discretion of the Controller, to be refused. Therefore, I will decide this matter on these provisions alone.

Section 2 and Section 25

49. For the purposes of these proceedings the relevant provisions of Sections 2 and 25 of the Act can be considered conjunctively. Section 2 is concerned with the interpretation of the Act and defines a trade mark, except in relation to a certification trade mark, as:

“... a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and means, in relation to a certification trade mark, a mark registered or deemed to have been registered under section 45 of this Act.”; and the relevant section of Section 25 provides:

“25(1). Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it must apply in writing to the Controller in the prescribed manner for registration either in Part A or in Part B of the register.”

50. In essence the grounds of opposition regarding Sections 2 and 25 come down to the question of whether Diesel SpA is the proprietor of the trade mark DIESEL in Ireland for the goods specified in the present applications. Both parties contend that they are the proprietor of the trade mark DIESEL in Ireland in respect of goods in Class 25. I will deal with the proprietorship issue in respect of the other classes first and then return to Class 25.
51. The Opponent has not advanced any evidence to suggest that it is the proprietor of the trade mark DIESEL in Ireland in respect of the goods in Classes 16, 18 and 24. Nor has it claimed to have ever traded in such goods. Nevertheless, Mr. Gallagher argued that these classes are “*typical brand expansion classes*” for clothing companies, who often produce printed materials, bags and textile products bearing their marks.
52. While the grounds of opposition do not involve a direct comparison of the visual, phonetic and conceptual similarities of the marks (as in the case of oppositions under the Trade Marks Act, 1996) Mr. Gallagher presented a detailed analysis of such a comparison, supported by a number of authorities. He maintained that the criteria to be applied, when considering similarity of goods under the Trade Marks Act, 1963 was that outlined in *Jellinek’s Application* (1949)¹³ in which Romer J proposed a threefold test, namely (i) the nature and composition of the goods, (ii) the respective uses of the goods, and (iii) the trade channels through which the goods are bought and sold. I am happy to apply this threefold test, with one caveat, that being that I consider the appropriate trade channels through which clothing is sold as being shops, or the clothing department within a department store, that specialise in clothing. The fact that a consumer may purchase a dress, a pencil case and a bedspread in the same department store

¹³ 63 RPC 59 at 70

cannot lead to a conclusion that these three very different types of goods share the same trade channels.

53. For his part Mr. Gordon argued that there is absolutely no typical brand extension between clothing and the goods for which the Applicant seeks protection in either Class 16 or 18. While being less forceful in his argument regarding Class 24, he maintained that no clear extension exists there either. Furthermore, in his opinion, the DIESEL Logo mark was not similar to the DIESEL word mark that the Opponent claimed proprietorship of. The dominant element of the DIESEL Logo mark is the Indian Brave's head which bestows a significant additional level of distinctiveness and meaning to the words "ONLY-THE-BRAVE" and ensures that those words are even more obvious and prominent than the word DIESEL.
54. As regards the similarity of the respective marks, clearly both DIESEL word marks are identical. There is more to the Applicant's DIESEL Logo mark, but nonetheless I find that the Applicant's DIESEL Logo mark shares some similarity with the Opponent's DIESEL word mark. I do not agree with Mr. Gordon that the words "ONLY-THE-BRAVE" reduce the impact of the DIESEL element to such a degree that would render any similarity insignificant. The presence and the position of the word DIESEL, not once but twice, is such that, whatever way you read the logo, the word DIESEL is the first word you encounter. The word DIESEL is an integral part of the mark and its significance cannot be downplayed. In my opinion, the degree of similarity would be such that consumers would be likely to believe that identical or similar goods bearing the respective marks emanate from a single undertaking or that the two marks are linked economically. The issue now rests on whether the goods are identical or similar.
55. I do not accept Mr. Gallagher's argument that the goods, for which the Applicant seeks protection, fall within what he describes as "*typical brand extension classes*" to clothing, a concept which, in my opinion, is purely subjective. There is no doubt that clothing brand names have been extended to a variety of other goods but the fact that other clothing companies may trade in a diverse range of goods does not mean that, accordingly, the goods must be considered similar. So-called "designer" brand names appear on clothing as well as, *inter alia*, spectacles, glassware, watches and perfume, but none of the latter goods could be considered similar to clothing and nor, in my opinion, can they be described as typical brand extension goods to clothing. The Opponent has not produced any evidence or even claimed that it has used its DIESEL mark on any goods other than clothing throughout its lifetime, which spans over three

decades. The fact that other clothing companies have extended their brand to other goods, unrelated to clothing, cannot form the basis for reserving the Opponent's clothing trade mark for use on other goods, on the off-chance that it may someday decide to expand its business into new areas of trade.

56. Clothing is worn by absolutely everyone and that fact complicates matters when considering users of other everyday products (specifically in this case users of the goods applied for in Classes 16, 18 and 24), as the users will always be the same. I find that the goods in Class 16 (printed matter, stationery and the like) are dissimilar to clothing, footwear and headgear. The basis of the opposition in respect of Class 16 is that clothing companies often produce printed material. They do, as do all companies, irrespective of what goods they trade in. Many companies circulate brochures, catalogues, photographs, diaries, pens, calendars, etc. on which the company logo appears, but this should not be confused with trading in these goods. These goods are circulated in order to advertise the company or to create or maintain brand awareness, or are given as gifts to customers, but this is not trade in these goods *per se*, and no revenue is gained from such activity. Most of such material is not even produced by the companies themselves, but is purchased from companies who actually trade in these goods. Similarly, all clothing companies advertise, but this does not mean that the provision of advertising services is similar to trading in clothing.

57. Mr. Gallagher argued that "patterns for making clothes" are clearly complementary to clothing. However, patterns for making clothes are printed matter and are of a completely different nature and composition to clothing, and they are bought and sold through different trade channels. Also, in my opinion, patterns for making clothes are not complimentary to clothing - they are in direct competition with clothing, as they are traded for the purposes of allowing consumers to make their own clothes, thereby avoiding the need to purchase clothing from traders in that field. Therefore, I find the oppositions to the registration of the trade marks DIESEL and DIESEL Logo for goods in Class 16 (numbers 177237 and 177242 respectively) has failed the three-fold test proposed by Romer J and must be rejected.

58. I find the position regarding the similarity of goods for which protection is sought in Class 18 to be more finely balanced. The Opponent has not suggested that it is the proprietor of the DIESEL trade mark in respect of the goods at issue in Class 18, or that it has ever traded in such goods. Again, the oppositions regarding these goods are based solely on the claimed similarity

between them and clothing, for which the Opponent claims unregistered rights. I am totally satisfied that the following goods: “*leather and imitations of leather, animal skins, hides, trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery*” are dissimilar to clothing. This leaves “*goods made of leather and imitations of leather in class 18*”, which includes, *inter alia*, handbags, purses, wallets, briefcases, dog collars, saddlery and music cases. It is important to note that Class 18 specifically excludes leather clothing, which is covered by Class 25. Nonetheless, certain of the goods particular to Class 18, made of leather or an imitation of leather, may share the same trade channels as clothing (oftentimes bags are stocked by clothing retailers) but their nature, composition and use are not similar to those of clothing. A woman may feel that her outfit is incomplete without a matching handbag but they are not similar goods and the use for which a ladies handbag is made (to carry her miscellaneous items) differs completely from the use of clothing (to cover her body). I accept that some may disagree with my reasoning and I have already indicated that I find the issue to be finely balanced. Nonetheless, on balance, I find the goods in Class 18, for which registration is sought, are not similar to clothing. Accordingly, I must reject the oppositions to the registration of the trade marks DIESEL (No. 177238) and DIESEL Logo (No. 177243) in respect of goods in Class 18.

59. Turning to Class 24 and “*textiles and textile goods included in Class 24; bed and table covers*.”. I repeat again that the Opponent has not claimed that it ever traded in such goods or that it is the rightful proprietor of the trade mark DIESEL in respect of these goods. The opposition is based on the Opponents unregistered rights to the trade mark DIESEL for clothing and the claimed similarity between these goods and clothing. Clearly bed and table covers are dissimilar to clothing, as are textile goods included in Class 24 which covers such goods as flags, towels, curtains and textile shower curtains and the like. So the question of similarity concerns clothing and “*textiles included in Class 24*”. Textiles are the raw material used for a variety of goods including clothing. This does not make textiles similar to clothing just as steel cannot be considered similar to motor cars or barley similar to beer. I am satisfied that the Opponent has no rights to the trade mark DIESEL in respect of goods in Class 24 and nor is there any similarity between clothing and the goods in Class 24 for which the Applicant seeks registration. Therefore I must reject the oppositions to the registration of the Applicant’s marks DIESEL (No. 177239) and DIESEL Logo (No. 177244) in respect of goods in Class 24.

Proprietorship of the trade marks DIESEL and DIESEL Logo for goods in Class 25 – arguments of the parties

60. The Opponent claims its predecessor in title, Monaghan Textiles Limited, used the mark DIESEL on clothing, in particular jeans, since 1979. In the Previous Proceedings in the High Court O’Sullivan J accepted as being “*genuine and bona fide sworn statements to the effect that jeans were sold using the mark to the general public since 1979*”. When Monaghan Textiles Limited went into receivership in 1988, Montex Holdings Limited purchased the trade mark DIESEL and the accompanying goodwill. At the relevant date for these oppositions, the Opponent had a network of retailers throughout Ireland who retailed its clothing under the trade mark DIESEL. As of 1996, when the Declaration in the previous proceedings was sworn, there were 29 of these retailers covering the counties Donegal, Mayo, Offaly, Longford, Meath, Cork, Galway, Cavan, Clare, Tipperary and Dublin. The Supreme Court Decision¹⁴ commented that this list was “*quite an extensive list covering all four provinces in Ireland*”. Mr. Gallagher argued that the Opponent’s network of retailers would have approximated to this as at the relevant date for these oppositions.

61. Mr. Gallagher argued that if the claim to proprietorship of an Applicant is not lawful, the application does not fulfil the definition of a registerable trade mark and must be refused under Sections 2 and 25(1) of the 1963 Act. Therefore the concept of a claim to proprietorship of the trade mark DIESEL is central to the grounds of opposition under these sections. In the Previous Proceedings, before the High Court, O’Sullivan J accepted that “*the test of ownership in a mark is that ownership vests in the first party using it in this jurisdiction*”¹⁵. This was expressly approved and followed by the High Court in *Jaguar Cars v. The Controller of Patents, Designs and Trade Marks*¹⁶. Furthermore O’Sullivan J agreed with the Controller “*that the Applicant [Montex] has established a sufficient user prior to the date of application to entitle it, prima facie, to be registered as owner...*”.

62. Mr. Gallagher drew my attention to the evidence filed under Rules 37 and 39 in support of the oppositions which contained examples of the trade mark DIESEL as applied to the Opponent’s goods dating between 1981 and 1988, invoices for raw materials for DIESEL jeans dating from 1980 and 1981, and sample invoices in respect of sales of goods bearing the trade mark DIESEL

¹⁴ Montex Holdings Limited v. The Controller and Diesel S.p.A. [2002] E.T.M.R. page 266

¹⁵ Montex Holdings Limited v. The Controller and Diesel S.p.A. [2000] E.T.M.R. page 666

¹⁶ [2006] IEHC 103

dating from 1980 to 1994. This evidence is supported by evidence filed by independent traders from the clothing industry in Ireland, namely the resource manager for Batchelors, the owner of “Miss Money Penny” clothes shop and the company Pilot Fashions Limited which operates 2 shops in Cork. Mr. Gallagher claimed that this shows that use by the Opponent of its mark DIESEL as at the relevant date was extensive and continuous and extended throughout the State. As against this, the evidence of the Applicant of its use of the mark in Ireland before the relevant date is negligible and the Applicant cannot base a lawful claim on this to be the proprietor of the trade mark DIESEL in Ireland as at 11 January, 1994.

63. Furthermore, he maintained that the *bona fides* of Montex, the Applicant in the previous opposition, were not at issue on the basis of the law as it stood. This was set out in detail in the Statutory Declaration of Shane Smyth. Notwithstanding this, to resolve the issue with finality, the derivation of the mark has been exhaustively explained in written and oral evidence.
64. For his part Mr. Gordon argued that the Applicant’s position is very straightforward. As the creator of the DIESEL brand it and it alone is the party entitled to obtain registration. The claim to the mark which Montex attempted to mount in the previous proceedings was an entirely illegitimate one and that lack of *bona fides* permeates through the present oppositions. He argues the bulk of the Declarations filed on behalf of Montex in the current proceedings do not comprise evidence at all, but rather legal submissions or attempts to reinterpret what actually happened during the course of the Previous Proceedings so as to downplay the *bona fides* issue. Mr. Gordon provided a vivid illustration of the latter by reference to Mr. Heery’s Rule 39 Declaration (dated 5 October, 2004) which claims “*The High Court raised the issue of bona fides in the use of the mark by my Company*”, a claim which is repeated in virtually identical terms in Shane Smyth’s Rule 40 Statutory Declaration (dated 15 February, 2008) where he states “*The High Court raised the issue of bona fides in the use of the mark by Montex*”; despite the fact that Renzo Rosso first raised the serious charge that Montex “*is not the bona fide proprietor of the trade mark DIESEL in Ireland*” in his Declaration of 22 February, 1995.
65. Both parties have different takes on what the courts decided in the Previous Proceedings, particularly regarding the significance or otherwise of the *bona fides* issue. I am satisfied that the previous application by Montex to register its trade mark DIESEL failed before the Controller on the basis that the application did not meet the requirements of Section 19 of the 1963 Act, specifically that if the mark was used it would be reasonably likely to cause deception or confusion amongst a substantial number of people, and in exercise of the Controller’s

discretion; though no reasons were given by the Hearing Officer for the exercise of that discretion. The opposition by Diesel SpA to Montex's application to register the trade mark DIESEL, grounded on Section 25 (the question of proprietorship), was rejected by the Hearing Officer. The question of *bona fides* of Montex in the use of its DIESEL mark does not appear to have been dealt with by the Hearing Officer, though the charge of a lack of *bona fides* was clearly raised by Diesel SpA during the opposition proceedings. The decision of the Hearing Officer in the Previous Proceedings is, of course, purely academic, as the case was fully reheard before the High Court. In rehearing the case the Court, unlike the Hearing Officer, paid particular attention to the issue of *bona fides* (this may explain the Opponent's claim that the issue of *bona fides* was first raised by the High Court).

66. O'Sullivan J rejected Montex's appeal and refused to allow its application to proceed to registration, firstly on the basis that it was lacking in *bona fides* and, secondly, that it failed to meet the requirements of Section 19. O'Sullivan J considered the issue of lack of *bona fides* under Section 25(2) of the 1963 Act, which provides the basis for the refusal of an application in the exercise of the Controller's discretion.

67. The Supreme Court confirmed the judgement of the High Court in respect of the likelihood of confusion (Section 19), but did not address, let alone hold to be incorrect, the earlier court's findings related to *bona fides* and the discretion of the Controller, as claimed by the Opponent. In the Supreme Court Decision, Geoghegan J held that O'Sullivan J had dealt with the issues in the wrong order, because if there was a mandatory ground upon which registration should be refused (and Section 19 is such a ground) one did not reach the point of considering whether it should be refused on discretionary grounds (i.e. Section 25(2)). Geoghegan J stated: "*...I take the view that the learned High Court Judge was correct in his decision on s.19 and in those circumstances I think it inappropriate to give any consideration to the discretionary issue.*"¹⁷

68. The Supreme Court did not address the fundamental question of the rightful ownership of the trade mark DIESEL for clothing in Ireland, which is by no means a clear-cut issue. The evidence before me shows that Montex was the first to adopt the trade mark DIESEL in Ireland and I accept it did so in around 1979, though significant doubt has been cast upon the legitimacy of the adoption by Montex of the mark. Despite the failure of Montex to address the issue of the provenance of the mark during the Previous Proceedings, Patrick McKenna has provided an

¹⁷ [2001] 3 IR 85,89

explanation of how his company came to adopt the mark. I have already decided that this evidence does not fall foul of the *Henderson v. Henderson* rule and is admissible. Now I must determine its probative value.

69. When giving his oral evidence Mr. McKenna portrayed himself as a simple, unassuming factory manager. I found him to be knowledgeable, quick-thinking, intelligent and extremely assured. I do, however, find certain of Mr. McKenna's evidence to be questionable, to say the least. In particular I find it incredible that he, as a director and one-third owner of Montex, had very little interest in the previous litigation, because in his words "*he had a factory with a lot of people in it to run*". Montex was not a large company and it was spending what must have been a significant amount of money pursuing its trade mark application all the way to the Supreme Court. His contention that he never read the High Court decision and that he attended board meetings, but did not get involved in anything to do with legal proceedings, including the decision to bring these opposition proceedings against the Diesel SpA application, is not credible. Nor is his evidence that he does not know that the Diesel SpA mark is portrayed in red and white, as he has never looked at it, not even to the day he gave his evidence.
70. He provided evidence regarding the state of the jeans business, as it existed in the late 1970's and early 1980's, which I have no reason to doubt. I accept his evidence that the move by Montex to concentrate solely on the production of jeans required the replacement of the then existing machinery and that it was only in 1983, when the wash plant was set up in Montex, that soft, washed, stone-washed, bleached and sand blasted jeans were manufactured. I take this as indicating that Montex made significant investments between the late 1970's and 1983 in its jeans business.
71. As regards how Montex came to adopt its DIESEL mark, he claimed it was suggested by a co-worker who noticed a diesel sign in the garage across the road from the factory (he claims the garage is still there). As Montex was looking for a brand that evoked the qualities of hard-working jeans the word DIESEL fitted the bill. This is not an unsurprising explanation, as the adoption of the word DIESEL would have to be connected, in some way, with the common fuel.
72. The reputation, market penetration or turnover in respect of both parties DIESEL trade marks in the marketplace today is completely irrelevant and must be totally ignored. I must embark on a journey back through time and arrive in Ireland on 11 January, 1994. I have considered at length

the evidence provided by both parties regarding the status of their respective uses of the trade mark DIESEL at, and leading up to, this date. So, what does the evidence suggest?

Decision regarding the issue of proprietorship

73. In considering the issue of proprietorship, from the outset, I must point out that, in these proceedings, there is a notable lack of concrete evidence and exactitude, which did not make my task an easy one. The lack of quality evidence will become apparent as the reader continues through the following pages.

74. The High Court accepted that the Opponent commenced user of its trade mark DIESEL in 1979, which predates the first user, in 1982, by the Applicant of its DIESEL mark in Ireland. Notwithstanding the High Court refused to allow the Montex application to proceed to registration, it did accept that, *prima facie*, Montex was the first user of the trade mark DIESEL for clothing in Ireland. The Applicant claims it had a reputation in Ireland in its DIESEL brand prior to Montex's use, but I find that is not supported by its evidence. Renzo Rosso submitted Exhibit "RR1" as part of his Statutory Declaration of 14 October, 2003, which contained a Statutory Declaration of his of 22 February, 1995 in which he states that Diesel SpA was incorporated in Italy in 1978 and first began to use the trade mark DIESEL for clothing in October of that year. I find it most unlikely that a company incorporated in 1978 and which began producing clothing under a particular brand in October of that same year, would become an instant international success to such an extent that it could claim, that within one year, it had acquired a reputation in Ireland, which a competitor sought to take advantage of, despite never having traded in Ireland before the competitor's user of its mark.

75. Included in Exhibit "RR1" is a list containing details of Diesel SpA's trade mark registrations for DIESEL worldwide, the overwhelming majority of which postdate 1989, ten years after the accepted date of first use by Montex of its trade mark DIESEL in Ireland. I find certain of Renzo Rosso's evidence regarding his company's use of its trade mark DIESEL in various jurisdictions questionable. I have set out in the table below, a small subset of his evidence regarding trade mark application dates and claimed dates of first user in a few territories, which, in my opinion, raises questions about the reliability of Mr. Rosso's evidence in that regard.

Country	Date of first user of DIESEL	Date of first Trade Mark application for DIESEL
Italy	15 October 1978	12 July 1977
Austria	25 October 1978	16 February 1982*
Germany	25 October 1978	16 February 1982*
Denmark	25 October 1978	23 July 1992
Sweden	25 October 1978	1 August 1989
Switzerland	28 February 1979	16 February 1982*
U.S.A.	5 April 1979	2 March 1984
Holland	3 October 1979	16 February 1982*
United Kingdom	8 November 1979	24 October 1979
France	8 November 1979	16 February 1982*

*By virtue of a single International trade mark application based on the Italian application of 12 July 1977.

76. The table above shows the first ten countries for which Diesel SpA claims it used its trade mark DIESEL. The claimed date of first user in all other territories is 1980 or later. Although the High Court accepted that jeans bearing the Montex trade mark DIESEL were made by Montex's predecessor in title in 1979, no specific date has been suggested for the first user by Montex of its DIESEL mark, and, therefore, the countries for which it can be claimed that user by Diesel SpA of its DIESEL mark predates user by Montex are, at most, the ten countries listed above. However, I do not find the evidence submitted by Diesel SpA regarding first user of its mark in most of those countries to be reliable. Specifically, Mr. Rosso is claiming that, on exactly the same day, a mere 10 days after his company's first user anywhere of its DIESEL mark, his company commenced user of its mark in four other countries. Quite frankly, I find the proposition that first user by the Applicant of its trade mark DIESEL in Austria, Germany, Denmark and Sweden on 25 October, 1978 to be improbable.

77. Also, despite Mr. Rosso's claimed dates of first user of the mark, save for Italy and the UK, his company waited more than 2 years, and up to 11 and 14 years in the case of Sweden and Denmark respectively, to seek protection for its mark in the other 8 countries. Oftentimes a company, which intends trading internationally and is seeking to develop a global brand, will pursue trade mark registration of that brand as quickly and as widely as possible. Applications for registration of the trade mark will oftentimes be made in countries where trade has not yet commenced, in order to protect the trade mark for future use, as Diesel SpA did in the case of Italy and the UK. But this typical strategy was not embarked upon for the other 8 countries listed in the table above. I find it unlikely that, in respect of these 8 countries, Diesel SpA

would wait such lengthy periods (up to 14 years) after first use to seek trade mark protection. This casts doubt on the veracity of the claims of first user in these countries made by Diesel SpA, for which no evidence, other than a list containing country names and corresponding dates of first user, was advanced.

78. The Applicant submitted other material to support its claims of reputation in Ireland. As regards sales into Ireland prior to the relevant date, Mr. Rosso produced four invoices, two dated 1982, a third 1983 and the fourth 1994, though the latter postdates the relevant date. The Opponent questioned certain aspects of these invoices, but I am happy to accept them at face-value. Copies of invoices claimed to date from 1989 and 1995 (these two specific years) were exhibited to the Statutory Declaration of Richard Farrell, manager of F.X. Kelly of Dublin, in respect of his company's purchase of DIESEL branded clothing from JWA, though the quality of the reproduction of the 1985 invoices is so poor that I find it impossible to decipher what they relate to, and therefore, I cannot accept them to be what it is claimed they are. The reproductions of the 1995 invoices are far better, but these postdate the relevant date. Overall, I consider the invoices offered in evidence in support of sales by Diesel SpA in the period from 1979 (the year the Opponent's claimed first use of its DIESEL mark) to the relevant date, some 15 years later, as having negligible weight in terms of probative value and they cannot, in any way, be considered as demonstrating a reputation in Ireland based on sales. It is both striking and telling that the Applicant, an large international company, who claims a reputation in Ireland and that it was trading in Ireland for many years prior to it lodging its trade mark application, can come up with nothing more than 3 invoices that are both relevant and legible in support of its claim to a reputation by way of sales, in respect of a 15-year period; while the Opponent, a small Irish company, can produce better quality and larger volumes of invoices to support its claim to a reputation, by way of sales, in Ireland during the same 15-year period.
79. Evidence was sworn by some traders to the effect that they were aware of the Applicant's DIESEL trade mark in Ireland from the mid 1980's and that the Applicant's DIESEL trade mark was the only DIESEL trade mark in Ireland that they were aware of at that time. However, that evidence is matched by evidence given by traders who say the Opponent's DIESEL trade mark was the only DIESEL trade mark in Ireland during the 1980's that they were aware of. This evidence throws no light on the issue of ownership of the DIESEL mark in Ireland; but, significantly, it points to the fact that there were two different DIESEL trade marks in existence in Ireland during the 1980's.

80. Evidence submitted by way of a Statutory Declaration of Peter Schofield Lawley, Commercial Manager of Diesel (London) Limited, dated 9 July 1996, claims that his company acted as agents and distributors for Diesel SpA for the UK and Ireland since May 1995. Prior to that he states that he was employed by JWA who had been distributors of Diesel SpA products in the UK and Ireland since January 1988. He believes that JWA regularly sold quantities of DIESEL branded clothing to F.X. Kelly & Co. during the period 1988-1995 and to “*other well-known retailers in the Republic of Ireland*”, though none of the other “well-known retailers” are mentioned by name. He states that prior to 1988 the distributorship for the UK and Ireland was handled by another UK company, Walker Webster Ltd., though he does not actually claim that Walker Webster Ltd. sold goods bearing the Diesel SpA DIESEL brand into Ireland nor is there any evidence from Diesel SpA or Walker Webster Ltd. to support such a claim. He states that goods bearing the DIESEL trade mark were sold directly into Ireland by Diesel SpA during the 1980’s, though again he fails to mention who these sales were made to, or when they were transacted.
81. Furthermore, he states goods bearing the trade mark DIESEL of Diesel SpA have been advertised in well-known magazines such as The Face, Arena, ID, For Him and Sky TV Magazine, which he understands also circulate in Ireland, though no evidence to support such a claim was provided. He exhibited copies of two “*typical advertisements which have appeared from time to time in such magazines*”. However, these two “advertisements” are not dated and neither contains anything to suggest that they are extracts from a magazine. Not one copy of a magazine, or even one page of a magazine, containing an advertisement for the Applicant’s DIESEL brand was submitted.
82. The Applicant suggests that it was entitled to ownership of the trade mark DIESEL for clothing in Ireland based on international reputation and claimed that the brand gained a reputation in Ireland on the basis of spill-over advertising from the UK. However, no evidence of advertisements in the UK, which may have spilled over to Ireland, was submitted to support such a claim. Though, importantly in my opinion, a claim to reputation based solely on spill-over advertising in the UK is an admission that no direct advertising targeted at the Irish market was undertaken.

83. I am aware from a recent unrelated case (*SKY BUSINESS CENTRES*¹⁸), which I adjudicated on, that SKY TV did not become available to subscribers in Ireland until 1988 and that SKY TV Magazine was not introduced to either the UK or Ireland until the late 1980's, some years after the first use by Montex's of its DIESEL mark in the State. I am not satisfied that any of the other four magazines (The Face, Arena, ID, For Him), claimed to have carried advertisements of Diesel SpA, were in existence before 1980 and, even if they were circulated in Ireland after their launch, in each case their date of first publication would have post-dated the first use by Montex of its DIESEL mark. Peter Schofield Lawley also states that Diesel SpA advertised their range of clothing bearing its trade mark DIESEL on MTV, a satellite television channel which he believes is received in many parts of Ireland. However, I am satisfied that MTV was not available in Europe until about 1987, again well after Montex began user of its trade mark DIESEL.

84. He also supplied a table (exhibited at "PSL1"), purporting to contain data in respect of purchases by JWA of clothing from Diesel SpA for the years 1987-1995. What follows is a representative sample of the contents of the table.

Year	Season	Lines	Boxes	Value (lit)
1987	S/S 87	Modern Basic	9.057	293.197.832
1987	A/W 87/88	Modern Basic	4.778	247.718.299
1988	S/S 88	Modern Basic	10.510	354.391.023
1988	A/W 88/89	Modern Basic	7.713	329.173.151
1989	S/S 89	Modern Basic	11.123	346.824.725
1989	A/W 89/90	Modern Basic	6.613	266.231.350
1989	A/W 89/90	Spare Parts	575	10.942.300
1989	A/W 89/90	Female	257	13.694.200

The remainder of the entries are written in similar terms to the above. There is no mention of DIESEL in the table, nor is there any mention of Ireland. There is nothing to lead me to conclude that any of the goods purchased by JWA, which may or may not have borne the trade mark DIESEL, made their way onto the Irish market.

85. All this casts serious doubt on the veracity of the evidence sworn by Peter Schofield Lawley, most of which is no more than unsubstantiated claims. I am satisfied that nothing he has submitted would lead me to conclude that the Diesel SpA trade mark DIESEL was brought to the attention of Irish consumers either by way of sales, by way of magazine or television

¹⁸ Pat Walsh v. Sky Broadcasting Group [2013] E.T.M.R. 27.

advertisements, or even as a result of spill-over advertising from the UK, to such a degree that it was known, let alone earned a reputation, in Ireland, prior to the adoption by Montex of its trade mark DIESEL.

86. The Applicant claims it had an international reputation in the trade mark DIESEL, which Montex took advantage of, and Renzo Rosso provides details of its worldwide expenditure on advertising for the years 1985 through to 1995. The evidence is very informative and goes to the heart of the question of international reputation. While advertising expenditure exceeded \$15 million in 1995, only \$46,000 was spent worldwide in 1985. From 1985 expenditure rose to \$269,000 in 1986, \$991,000 in 1987, \$2,894,000 in 1988 and continued on an upward curve until 1995. These figures suggest to me that the brand began to gain an international reputation around 1987. However, the figure for 1985 and, more importantly, the lack of any figures pre-1985 paint a completely different picture of the claimed international reputation. I am satisfied that the amount expended on advertising in the years 1978–1984, if any, must have been a far less amount per annum than the 1985 figure. Also, by Renzo Rosso's own evidence, at the end of 1985 Diesel SpA was using its trade mark DIESEL in 22 countries across the globe. The advertising expenditure figure of \$46,000, spread across the 22 countries, amounts to a crude average of \$2,100 per country. In my opinion this total level of expenditure across 22 countries, including the most significant global consumer markets of the USA, Germany, the UK, France, Italy, Japan and Canada, points to a minuscule level of global advertising in 1985 and, at best, points to negligible levels of advertising worldwide in the preceding years. On the basis of these figures, Diesel SpA cannot be held to have had an international reputation that could, in any way, have permeated into Ireland by 1985, let alone six years earlier when Montex began user of its trade mark DIESEL in the State.

87. At the Hearing Mr. Gordon argued that Montex must have come across its DIESEL mark, possibly at a trade fair, and decided to copy it. But the Applicant provides no evidence to support this hypothesis. It has not provided any evidence that it participated in trade fairs in Ireland or in jurisdictions close to Ireland, which Montex may have been expected to attend either before or about the time that Montex began using its DIESEL mark in Ireland. No evidence was submitted to show that Diesel SpA was trading in Ireland, or marketing its brand in Ireland, or directing advertisements of its brand towards Irish consumers, or benefiting from spill-over advertising in the UK or elsewhere, or that Diesel SpA had an international reputation

at the time Montex began using its DIESEL mark. So, the explanation of how Montex came to adopt its trade mark DIESEL might just be true.

88. No other suggestions of how Montex may have come upon the Diesel SpA trade mark DIESEL have been advanced. Nonetheless, I have considered the question of what if someone associated with Montex did actually come across the Diesel SpA mark, let's say in a store in Italy in late 1978, at the time the very first use of the mark was being made in that, or any other country, and thought "*That's a great brand-name for jeans – we'll consider using it*". Would, on returning home to Ireland and being satisfied that there was no such brand on the Irish market or any such trade mark registered or existing here, and then setting about using it, constitute a lack of *bona-fides*? In the circumstances of this case, I think not.
89. There is no doubt that Montex, and its predecessors in business, were manufacturing clothes in Ireland from the 1970's. It commenced manufacturing jeans bearing the trade mark DIESEL in its own factory in 1979. It was not importing clothing manufactured in a so-called "sweat-shop" in Asia and simply applying a DIESEL label to it. Montex undertook what must have been a significant investment in plant and machinery in about 1978 (to switch from manufacturing dresses to shirts and jeans), and later invested further in a new wash-plant facility to enable it produce new types of fashionable jeans (sand-blasted, stone-washed, bleached and the like), which they had on the Irish market by 1983.
90. Trade marks are territorial and, as such, having protection in one country does not mean that that protection automatically extends to any other country. There are limited options available to traders to ensure protection of a trade mark in a given country. One is to register it as a trade mark in that country. Diesel SpA did not do so in Ireland prior to the first use here by Montex of its DIESEL mark. In fact, inexplicably, it waited until 15 years later to attempt to do so. Another option is not to register it, but to rely on the protection afforded unregistered marks based on earlier trade under the mark, in the given country. But, Diesel SpA did not have any earlier trade in Ireland prior to the use by Montex of its trade mark DIESEL. A third option is not to seek registration, but to rely on the protection afforded to extremely well-known trade marks under the Paris Convention. Though, such trade marks would need to have a reputation that would be expected to extend beyond the limited class of consumers of the proprietor's goods and to penetrate the consciousness of the wider public such that a substantial number of people would know and recognise the mark, even if they had never used the proprietor's goods.

In my opinion, there can be no doubt that Diesel SpA did not have such a reputation in Ireland at the time Montex commenced user of its DIESEL mark.

91. Much has been made of Montex's *bona fides* in its adoption of the trade mark DIESEL for clothing. So much so, that in the Previous Proceedings, the High Court refused the application by Montex to register its DIESEL mark for want of *bona fides*. The Court took issue with the fact that Montex did not address the charge of a lack of *bona fides* made by Renzo Rosso in the proceedings before the Controller or the Court, though the Hearing Officer did not consider the issue of *bona fides*, to such an extent that he reached any conclusions on the matter. The Controller refused the application because the mark proposed for registration failed to meet the requirements of Section 19 of the 1963 Act and in the exercise of the Controller's discretion under Section 25(2) of the Act, though in the written grounds of his decision, the Hearing Officer offers no reasons to explain his invocation of that discretion. However, in his sworn affidavit of 26 November, 1998 in the proceedings before the High Court, he explains that he exercised his discretion "*because the Plaintiff had failed to meet the requirements of Section 19 and in particular had failed to establish that there was no likelihood of deception and confusion among a substantial number of persons*".
92. In my reading of their judgements, neither the High Court nor the Supreme Court came to any conclusive decisions regarding the proprietorship of the trade mark DIESEL for clothing in Ireland as between Diesel SpA and Montex. The Courts did not address the issue of proprietorship under Sections 2 and 25(1) of the Act, under which the Diesel SpA opposition before the Controller had failed. In the High Court, O'Sullivan J accepted that Montex had established a sufficient user prior to the date of application to entitle it, *prima facie*, to be registered as the proprietor of the trade mark DIESEL in Ireland, but because he was not satisfied that Montex adopted the mark in a fair fashion, he exercised his discretion to refuse the application. I am unclear as to whether or not this means the learned judge made a finding that, accordingly, Montex was not the proprietor of the mark.
93. At the Hearing Mr. Gordon argued that bad faith in the adoption of a mark by an opponent, who invokes Sections 2 and 25 of the 1963 Act, can justify the dismissal of an opposition. He drew my attention to the decision of the Hearing Officer in *LITTLE CAESARS*¹⁹ (Trade Mark No. 151027), in which an Irish registered company that operated a restaurant called "*Little*

¹⁹ Written Grounds dated November 2001

Caesars”, opposed (pursuant to the 1963 Act) the registration of the mark LITTLE CAESARS in favour of a US corporation which had commenced use of the mark in the USA in 1968 and thereafter used it in a number of countries. In dismissing the opposition the Hearing Officer specifically dealt with the issue of the opponent’s *bona fides* as follows:

“It is clear from the evidence before me the Opponents were the first to use the mark in this jurisdiction and it is well-established in trade mark law that ownership of unregistered marks is decided on the basis of he who first used the mark. On this basis, and in the absence of an established reputation in this country for the Applicants’ mark, the Opponent would be deemed the owner of the mark for this jurisdiction. However, I have some concerns about the manner in which the Opponent came to adopt the mark. The Applicants have built up a very significant business over a long number of years, in the United States primarily and to a lesser extent in the United Kingdom and elsewhere. The extent and character of the reputation in the Applicants’ mark in the United Kingdom is difficult to judge on the basis of the evidence before me. It would have been helpful if the Applicants had given a breakdown in turnover and advertising figures for the UK. I single out the UK market because of the serious charge made by the Applicants that the Opponents must have been aware of the Applicant’s mark and their reputation from the time Mr Samy, a director of the Opponents, worked in the pizza business in London in the mid 1980’s. I would have expected such a charge to be unequivocally rebutted by the Opponents. Mr El Khouly did submit as evidence an affidavit sworn by him on 28 March, 1994 in which he stated he was unaware of the Applicant at the time of setting up his restaurant. However, his co-director Mr Samy made no statement.

In the absence of a clear denial by the Opponents of the allegation made by the Applicant, I am not satisfied that the Opponents adopted the mark LITTLE CAESARS in a bona fide manner and I dismiss the opposition on this ground.”

94. Mr Gordon argued that the circumstances of *LITTLE CAESARS* are very similar to the present case. It concerned a foreign entity which had established a highly distinctive brand internationally and was in dispute with persons in Ireland who adopted an identical brand but were coy about whether they had devised it after encountering the international brand.

95. I agree with Mr. Gordon there are similarities between this case and *LITTLE CAESARS*. However, in my opinion, the specific circumstances of each case are completely different. As regards the *bona fides* issue, in *LITTLE CAESARS*, by the time the Opponent adopted its mark (1992), the Applicant had a long established business having opened its first restaurants in the United States in 1959, in Canada in 1969 and in England in 1985, and that, by 1994, the Applicant had over four thousand restaurants operating worldwide, employing over 27,000 people. Annual sales of the Applicant’s pizzas and like foodstuffs through its chain of restaurants had risen from approximately \$39 million in 1980 to \$1.2 billion in 1994. Also, in

LITTLE CAESARS, the Applicant spent \$248 million in broadcast advertising under the trade mark *LITTLE CAESARS* during the period 1988 to 1995 and the company won numerous awards for its advertising (full details of the awards and examples of the advertisements were exhibited in evidence). As a result of such advertising and through use of the trade mark *LITTLE CAESARS* the Applicant was a bigger company than Burger King and Kentucky Fried Chicken and had featured in the Fortune 400 list.

96. Contrast that to the present case where no evidence of any expenditure on advertising prior to 1985 was submitted, which is, in any event, long after Montex began user of its DIESEL mark. I have examined in great detail the evidence submitted by Diesel SpA in support of its claim to an international reputation, prior to the adoption by Montex of its DIESEL mark, and I reject that evidence as falling well short of what would be required to substantiate such a claim. The issue of a claim of bad faith, based on prior international reputation, is common to both this case and *LITTLE CAESARS*. However, what I am dealing with here is a prime example of where a basic principle, on which the grounds for a particular decision is made in an earlier case (bad faith based on prior international reputation), cannot simply be transferred to a later case, by virtue of the fact the circumstances of the two cases differ so markedly, it requires the later to be decided on its own merits.

97. In my opinion, when a business intends to adopt a trade mark, it behoves that business to undertake a reasonable preliminary enquiry to establish whether or not the mark in question is available for use or is likely to conflict with that of a pre-existing enterprise. If such an enquiry was undertaken, by or on behalf of Montex, at the time that it set about the adoption of its DIESEL mark, I am satisfied that little, or nothing more than an instance of a trade mark application filed by Diesel SpA in Italy in July 1977 and possibly one filed in the UK in October 1979, would have been uncovered (though the UK trade mark application filing could well have post-dated the first use by Montex of its DIESEL mark). It appears to me that a comprehensive and thorough search of global trade mark registries would have been required in order to uncover the Italian application. Clearly, this is in stark contrast to the extensive references the Opponent in *LITTLE CAESARS* would have uncovered with even a cursory search in respect of the trade mark *LITTLE CAESARS*. If somehow Montex had uncovered the instance of the Diesel SpA's trade mark application in Italy, that alone would not have been a barrier to the use of its mark in Ireland. It cannot be the case that an individual trade mark,

registered in a single foreign country, must be held in reserve in Ireland on the off-chance that the proprietor of the foreign mark, just might someday, expand its business into Ireland.

98. As regards the common thread concerning the coyness of the Opponents in both cases; in these proceedings Montex has offered an explanation as to how it came to adopt its DIESEL mark and has also explained why it did not address the issue of *bona fides* in the Previous Proceedings. During those proceedings Montex engaged the very reputable firm of trade mark attorneys FRKelly, which advised it right through to the Supreme Court. Shane Smyth, of FRKelly, has deposed that the advice given by his firm to Montex, in the course of the Previous Proceedings, was that there was no need to address the issue of *bona fides*, as it was irrelevant to the issue to be decided under Section 19. Montex were also advised that, regarding discretion under Section 25(2), the issue of *bona fides* did not require refutation, as no evidence had been provided to suggest that there was any lack of *bona fides*, and that the onus was on Diesel SpA to provide such evidence, rather than on Montex to prove a negative. Shane Smyth states that the opinion of FRKelly was also shared by Counsel, acting on behalf of Montex, before the High Court and the Supreme Court. Clearly, Montex lost its High Court case on the grounds of failing to deal with the *bona fides* issue, but I accept that it was guided by its legal advisers on this matter. Montex could have ignored the advice it received from its legal advisers and dealt with the issue of *bona fides* in court. But, in my opinion, it is not unreasonable that a client who engages a legal team of reputable Trade Mark Attorneys and eminent Senior Counsel, at what must be considerable expense, should then heed the advice given, just as Montex did.

99. In light of all the foregoing I am satisfied that Diesel SpA are not the proprietors of the trade mark DIESEL for clothing in Ireland and therefore, I must refuse their applications for registration of that trade mark in respect of No's. 177240 and 177245 under Section 2 and 25(1) of the 1963 Act.

Section 19 – Deception and Confusion

100. Having refused these two applications on the basis of Sections 2 and 25 of the 1963 Act, I do not have to consider the matter in respect of Section 19. But lest, on appeal, I am found to have erred with regard to the issue of proprietorship, and for completeness, I will consider those two applications under Section 19, which is written in the following terms:

“It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of law, or would be contrary to law or morality, or any scandalous design.”

101. Mr. Gallagher argued it is well established, as regards Section 19, that the onus is on the Applicant to prove there is no likelihood of deception or confusion. He referred to a number of cases in support of his contention, including in *Hack’s Application*²⁰ where the UK High Court held *“The onus is on the Applicant to satisfy the Court that there is no reasonable probability of confusion”* and in *Coca-Cola v. F. Cade & Sons*²¹ where the court held *“It is accepted that the onus lies upon the Applicant who seeks to register a trade mark to show that it is not calculated to deceive”*. Mr. Gallagher also referred to *BALI*²² where the House of Lords held *“It is well settled that the onus of establishing that the proposed mark is not calculated to deceive is upon the Applicant, and in this respect he is in a much less favourable position than if he were a defendant in an action for infringement, or for passing off”* and argued that, if the Applicant fails to prove this, the application must be refused, as set out in the *BASS*²³ case where it was held that Section 11 (the UK equivalent to Section 19) *“is an absolute prohibition that, unless it can be shown that this trade mark is not calculated to deceive, it must be excluded”*.

102. Mr. Gallagher suggested that I should consider the Section 19 issue as a matter of principle, in that Montex were denied registration in the previous opposition, as it was held that there was a likelihood of deception or confusion arising amongst the public in respect of their user of the mark, and that the same principle and logic must apply in the present opposition, which concerns the same marks, but with Diesel SpA as the Applicant. He argued there cannot be a likelihood of confusion or deception when Montex was the Applicant but not when Diesel SpA is the Applicant, particularly as the pre-application use evidenced by Montex in the present opposition is more extensive and longer than Diesel SpA claimed in the earlier opposition. He maintained the Controller’s approach to this issue in the previous opposition was correct, and was confirmed by the High Court and the Supreme Court, and was consistent with the previous Irish case law on this point, which was summarised by O’Sullivan J in the High Court as:

“I was referred, first, to Coca-Cola Company v. F. Cade and Sons Limited (1957) IR: 196, and in particular to the observation of Maguire C.J. at page 215 as follows: ‘If,

²⁰ [1941] 58 RPC 91

²¹ Supreme Court (1957) IR 196

²² [1969] 14 RPC 472

²³ [1932] 4 R. P. C. 88

considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case'. I was also referred to the judgment of Kenny J. in P.J. Carroll and Co. v. Philip Morris Inc. (1970: IR: 115) which clearly proceeded upon the basis that confusion simpliciter, so to speak, was sufficient to exclude registration."

103. As regards what is meant by "*likely to deceive or cause confusion*" Mr. Gallagher argued the test most often quoted is from *Smith Hayden & Co's Application*²⁴, as adapted in *BALI*, namely "*Having regard to the use of the earlier mark, is the court satisfied that the mark applied for, if used in a normal and fair manner in connection with any goods covered by the registration proposed, will not be reasonably likely to cause deception and confusion amongst a substantial number of persons*". This decision has been consistently followed in Ireland, for example, in the decision of the High Court in *Jaguar Cars v. Controller*²⁵.

104. Mr. Gallagher argued that, when considering the issue of deception or confusion, the intention of the Applicant is irrelevant. In the Previous Proceedings the High Court held that Section 19 does not require any element of blameworthiness and therefore blameworthiness (or as it could be known, lack of *bona fides*) are not factors which may be taken into account in an assessment of Section 19. He pointed to the concluding words of the High Court decision on the matter where the Court held: "*The Irish cases appear to proceed on the basis that simple confusion or deception is sufficient to exclude registration under Section 19*"²⁶.

105. Turning to the issue of the relevance of honest concurrent in these proceedings, Mr. Gallagher argued that the Supreme Court held that honest concurrent use is not relevant to the issue of whether a mark must be refused registration pursuant to Section 19. The Court stated at page 21 of its Decision that "*Section 19 is not relevant to honest concurrent user*"²⁷. He claims this is consistent with the fact that the High Court and the Supreme Court in the Previous Proceedings did not consider honest concurrent use in respect of Montex's application and grant it registration on that basis, despite the fact that the Montex application was supported by far greater evidence of user over a longer period than the present application. If honest concurrent

²⁴ [1946] 63 RPC 97

²⁵ [2006] IEHC 103

²⁶ [2000] 1 IR 577

²⁷ [2001] 3 IR 85

use was relevant to Section 19, the High Court and the Supreme Court would have had to grant the registration of Montex's mark in light of Montex's pre-application use. The Court did not take into account Montex's pre-application use to grant it registration on the basis of honest concurrent use and the same must apply to the present application by Diesel SpA. This, he claimed, is also consistent with the approach of the High Court in *Jaguar Cars v. Controller*²⁸ where it was accepted and not in question that the applicant had used the trade mark in Ireland before the filing date but this was not even raised for discussion as an issue. Mr. Gallagher argued that this is an issue on which Irish and English law diverges.

106. Thus, in Mr. Gallagher's opinion, neither of the marks is entitled to registration over the other. Because each party has used its mark prior to the filing date of the application of the other and as confusion or deception is likely, the parties are at an impasse and neither can register its mark. This is a paradigm case of the principle and it could not be correct to grant registration to the Diesel SpA application when the Montex application was refused, when the oppositions are based on the same grounds. In any event, the pre-application use by Diesel SpA by 11 January 1994 was not of sufficient extent and continuity to enable the mark, the subject of the present application, to distinguish the goods of Diesel SpA from the goods of others. This, he argued, is evident in the decision of the Controller in the Previous Proceedings where he held that the evidence of use by Diesel SpA prior to 1992 was limited to relatively few invoices and that they failed to conclusively show that any spill-over advertising was available in Ireland by 1992.

107. Mr. Gordon, on behalf of the Applicant, did not take a contrary stance regarding the tests to be applied in deciding the issue of deception and confusion. However, he argued that there is an obvious absurdity in Montex's reliance on Section 19, as no issue regarding possible confusion could have ever arisen if Montex had refrained from wrongfully adopting the DIESEL mark of Diesel SpA in the first place. He went further and argued that there is a key point of statutory interpretation which should not be overlooked when analysing Montex's "*role reversal*" argument. In the context of the present proceedings Section 19 is concerned with the issue as to whether Diesel SpA's marks DIESEL and DIESEL Logo constitute "*matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of law*". The marks are not such "*matter*" – the "*matter*" which creates the likelihood of deception or confusion is the DIESEL brand wrongfully adopted by Montex.

²⁸ [2006] 1 IR 607

108. He agreed with Mr. Gallagher that a refusal of registration pursuant to Section 19 is not subject to the prerequisite that there must be blameworthiness on the part of the Applicant, as indeed was confirmed by the High Court and the Supreme Court in the Previous Proceedings. However, Mr. Gordon argued the decisions in the Previous Proceedings say nothing about the relevance or otherwise of blameworthiness on the part of the Opponent. He maintained that this is an important consideration because it raises the question as to whether Section 19 can be invoked to achieve an utterly unmeritorious and absurd outcome, namely the blocking of registration at the behest of someone who, by reason of a want of *bona fides* (and specifically the hijacking of another entity's trade mark), claims that there will be confusion as between the goods of the wrongdoer and the goods of the applicant for registration, who also happens to be the originator of the mark. According to Mr. Gordon, this is a perfect example of a party attempting to benefit from its own wrong and, in particular, relying on the possibility of confusion which is of its own making.

109. On this point he referred me to the Australian case of *Arriba Pty Ltd v. Cuisine To Go Pty Ltd*²⁹, wherein the applicant used the image of a mouse cartoon character, along with the name "Arriba", in connection with the sale of Mexican food products. The respondent in that case also used the image of a mouse cartoon character, which was called "Speedy Gonzales", in respect of food products, having been licensed to do so by Warner Brothers Consumer Products. "Speedy Gonzales" was one of the established "Looney Tunes" cartoon characters and was known for exclaiming the words "arriba, arriba"; "arriba" being a Spanish word meaning "above", "up", "on high" or, colloquially, "get on top". The applicant claimed that the use by the respondent of its mouse drawing and the name "Speedy Gonzales" in respect of a range of Mexican food products constituted passing off and sought an interlocutory injunction. The respondent likewise sought an interlocutory injunction against the applicant. In the Federal Court of Australia - General Division, Heery J held that both applications should be rejected, the principal reason as regards the applicant being stated as follows:

"I have come to the conclusion that neither application for an injunction should be allowed. The main factor which influences me in declining an injunction on the application of Arriba Pty Ltd is that I think it has been less than frank in the case it has put to the Court.

If one were to rely on the affidavit of Mr Dunstan, his company's logo was developed independently by the commercial artist in California. No mention at all is made of any

²⁹ (1994) 29 IPR 584

reference at the time to what I find to be the very well established character, Speedy Gonzales. That character, as the evidence shows, is a cartoon mouse in Mexican clothing who frequently appears in a cartoon setting rushing at great speed. A document entitled "Speedy Gonzales Style Guide" exhibited to an affidavit sworn by Ms Helen Thompson on behalf of Warner gives a brief description of the character...

The reader of Mr Dunstan's affidavit could only draw the conclusion that he was saying that his company's Mexican mouse was an original invention. However, Ms Helen Thompson deposes that she has travelled to California on a number of occasions to visit Warner Bros. She is aware that California is the home of the Looney Tunes characters, including Speedy Gonzales. She further deposes:

"Speedy Gonzales is extremely well known and recognised in California. Based on my knowledge of the reputation of Speedy in California and of the licensing activity conducted in respect of the Looney Tunes cartoon characters in the United States of America, including Speedy, and of the exposure of such licensed products in Warner Bros specialty stores located in California shopping areas, the possibility of a commercial artist, or someone living in California not knowing of Speedy and not knowing his characteristics in 1992/93 period, is quite remote."

There is the further remarkable coincidence that in February 1993, that is about the time that the artist was retained in America to draw the logo, Mr Dunstan's company changed its name to Arriba Foods Pty Limited. I find it impossible to conclude that this was anything other than part of a conscious plan to appropriate the existing reputation of the Speedy Gonzales character associated, as it was, with the war cry "arriba, arriba". The matter is put, I think, beyond any doubt by the affidavit of Mr Noel Reid. He deposes to hearing a radio interview on 3AW in September last year when the interviewer asked Mr Dunstan how he obtained the name "Arriba", and he answered, "That is what the little mouse said as he ran across the screen".

I think therefore that I should accept the submission of Mr Samargis on behalf of Warner and Cuisine To Go that there has been a copying of the Speedy Gonzales image with a view to obtaining advantages from the similarities, and that if there has been any confusion that has been created by Arriba Pty Ltd's own conduct.³⁰ [emphasis added by Mr. Gordon]

110. Mr. Gordon also referred me to the twelfth edition of Kerly's *Law of Trade Marks and Trade Names* (the last edition centred upon the UK Trade Marks Act of 1938, which was mirrored in our 1963 Act) as being strongly supportive of the notion that the deceptiveness caused by another should not cause disadvantage to the applicant. Thus in the context of a discussion of Section 11 of the 1938 Act (which was equivalent to section 19 of the 1963 Act) and the GE case³¹ Kerly observes:

"Even, however, if the mark has become deceptive through no fault of the proprietor, it is submitted that registration of a deceptive mark should be refused as a matter of discretion"³²

³⁰ (1994) 29 IPR 584, 587

³¹ General Electric Co. (of USA) v General Electric Co. Ltd [1972] 1 WLR 729

³² Kerly's *Law of Trade Marks and Trade Names* (12th edition, 1986) at paragraph 10-27

This view is immediately qualified by *Kerly* in a footnote which states:

*“Unless that deceptiveness has arisen because of the use of a similar mark by a trade rival, which use will probably be stopped by granting registration so the proprietor can sue.”*³³

111. Also, in support of now absurd it would be to permit the hijacker of a brand to stand in the way of registration by the originator, Mr. Gordon directed me to *C. & A. Modes v. C. & A. (Waterford) Ltd*³⁴ in which the defendant was held to have engaged in passing off by adopting the brand “C&A” notwithstanding that the plaintiff, which was an established UK retailer, did not have any shops in the State. He argued the notion that the defendant in that case would nevertheless have been entitled to rely on this wrongful activity for the purpose of invoking Section 19 of the 1963 Act would simply bring the law into disrepute. In his opinion the critical point about Section 19 is that it is not couched in absolute terms which suggest that the possibility of confusion is fatal to the registration of the mark forming the subject matter of the application. The wording is such as to require a more sophisticated analysis in that one must ascertain whether the mark applied for comprises matter “...*the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of law...*”. He went on to highlight the following passage from the decision of the Supreme Court where Geoghegan J stated:

*“Before 1875 not every proprietor of a trade mark which was likely to cause confusion was necessarily disentitled to protection in a court of equity. The concept of honest concurrent user existed then, as it exists now. The Controller would not be bound to refuse registration where he found on the one hand that there was a likelihood of confusion but on the other hand honest concurrent user. I would interpret section 19 as meaning that the registrar is bound to refuse registration if the mark is likely to deceive or cause confusion and would, prior to 1875 on that account, have been disentitled to protection in a court of equity, and likewise if, for any other reason, such mark would have been disentitled to such protection before 1875. This second aspect of refusal arises out of the words “or otherwise”. But there would appear to be no justification for introducing an element of blameworthy conduct such as passing off.”*³⁵ [emphasis added by Mr. Gordon]

112. Mr. Gordon suggests that the foregoing passage demonstrates precisely why Montex’s argument of “*role reversal*” is misconceived. Diesel SpA’s adoption and use of the mark DIESEL was entirely honest, while Montex’s was not. Indeed, as Geoghegan J expressly acknowledged the relevance of honest concurrent use to the enquiry under Section 19, it is

³³ Footnote 61, page 165

³⁴ [1976] IR 198

³⁵ [2001] 3 IR 85, 95

worth quoting the following passage from the speech of Lord Diplock in *General Electric Co. (of USA) v. General Electric Co. Ltd*³⁶ regarding that concept:

“But the interest of the public in not being deceived about the origin of goods had and has to be accommodated with the vested right of property of traders in trade marks which they have honestly adopted and which by public use have attracted a valuable goodwill. In the early 19th century trade was still largely local; marks which were identical or which closely resembled one another might have been innocently adopted by traders in different localities. In these their respective products were not sold in competition with one another and accordingly no question of deception of the public could then arise. With the rapid improvement in communications, however, in the first half of the 19th century markets expanded; products of two traders who used similar marks upon their goods could thus come to be on sale to the same potential purchasers with the consequent risk of their being misled as to the origin of the goods. Furthermore, it was accepted that as an adjunct of the goodwill of the business the right to use a trade mark might be acquired by more than one successor if the goodwill of the business were divided, as it might be, for instance, where the business had formerly been carried on in partnership or from more than one manufactory or shop. To meet this kind of situation the doctrine of honest concurrent user was evolved. Under this doctrine a trade mark remained entitled to protection in cases where the use of it had not originally been deceptive but a risk of deception had subsequently arisen as a result of events which did not involve any dishonesty or other wrongful conduct upon the part of the proprietor of the mark. If, however, his own wrongful conduct had played a part in making the use of the mark deceptive, the Court of Chancery would not grant him an injunction against infringement. This was but a particular application of the general equitable doctrine that he who seeks equity must come with clean hands.

In cases of honest concurrent user, neither of the owners of the mark could restrict the other from using it, but as against a usurper who infringed it either owner of the mark could obtain an injunction: Dent v. Turpin (1861) 2 J. & H. 139 and Southorn v. Reynolds (1865) 12 L.T. 75.”³⁷ [emphasis added by Mr. Gordon]

113. In concluding his argument under Section 19 Mr. Gordon stated that the position of Diesel SpA is, as it always has been, – Montex is a usurper of DIESEL and not an honest concurrent user. Consequently its user cannot provide a basis under Section 19 for rejecting Diesel SpA’s applications. Notwithstanding that there may be two DIESEL marks in existence in Ireland, the use by Diesel SpA of its mark is honest and, accordingly, the Diesel SpA mark should be allowed to proceed to registration.

114. Mr. Gordon argued the notion that deceptiveness caused by another should not cause disadvantage to the applicant – a notion I fully agree with. On that point he directed me to *Arriba Pty Ltd v. Cuisine To Go Pty Ltd*³⁸ arguing that the principles considered in that case, namely, a party attempting to benefit from its own wrong and, in particular, relying on the

³⁶ [1972] 1 WLR 729

³⁷ [1972] 1 WLR 729, 743

possibility of confusion which is of its own making, was fundamental to this case. While “*Arriba*” was concerned with a copyright issue, I accept that the principles considered in that case should also be considered here.

115. Having done so, I find there are four distinct and important differences between “*Arriba*” and the instant case. Firstly, Cuisine To Go had a right to use the cartoon character “*Speedy Gonzales*” in relation to its restaurant trade in Australia by virtue of a licence agreement with the copyright owners of the character (Warner Brothers Consumer Products). Whereas, in this case, Diesel SpA has not proven that it has a legal right to the trade mark DIESEL for clothing in Ireland. Secondly, the Court held, on the basis of the evidence before it, that Arriba Pty Ltd had copied the “*Speedy Gonzales*” character. Whereas, in this case, Diesel SpA has not provided any evidence that would lead me to conclude that Montex copied the Diesel SpA mark. Thirdly, the court found “*Speedy Gonzales*” to be a “*very well established character*”, which I take to mean it was well known to Australian consumers. However, in these proceedings, I am satisfied the Diesel SpA trade mark DIESEL did not exist in Ireland and was not known to Irish consumers when Montex adopted its DIESEL mark.

116. Fourthly, in “*Arriba*” the Court found that Arriba Pty Ltd was less than frank in the case it put to the Court regarding its adoption of the “*Speedy Gonzales*” character. But, in the present case, there has not been a lack of candour by Montex regarding how it came to adopt its DIESEL mark. I accept fully that its approach in this instance differs from its silence in the Previous Proceeding. But an explanation for the different approach in the earlier case was provided by Montex’s legal team in the form of the Statutory Declaration, sworn by Shane Smyth, Trade Mark Attorney of FRKelly, which set out the rationale behind the then strategy, which was endorsed by Counsel acting for Montex before the courts. Patrick McKenna provided an explanation of the origins of the Montex DIESEL mark in his Statutory Declaration submitted in evidence under Rule 39. Also, most unusually (in that I cannot find any record of it ever having happened previously or since), he was summoned to give oral testimony under cross-examination at the Hearing, which cross-examination was specifically directed at the issue of the origins of the Montex DIESEL mark. He was neither coy nor shy in giving his oral testimony and answered each and every question put to him. Therefore this case and “*Arriba*” do not share common ground in respect of a lack of frankness regarding the adoption of the

³⁸ (1994) 29 IPR 584

respective marks. Overall, in my opinion, the circumstances dealt with in “*Arriba*” are not repeated in these proceedings.

117. Regarding Mr. Gordon’s argument that the circumstances of *C. & A. Modes v. C. & A. (Waterford) Ltd*³⁹ are similar to those of the present proceedings, I have this to say. In that case the Court held the defendants had engaged in passing off by adopting the brand “C&A” notwithstanding that the plaintiff, which was an established UK retailer, did not have shops in the State. The decision of the Court was based on the fact that C. & A. Modes had a reputation and goodwill in the State. The Court was satisfied that such reputation and goodwill was earned through the thousands of Irish consumers who had shopped in its Belfast store. The Court accepted that C. & A. Modes’ employed additional part-time staff in its Belfast store to deal specifically with the large number of customers from Ireland who ventured into Belfast on an excursion train from Dublin each Thursday. The Court was also satisfied that advertising, which appeared in UK daily newspapers, circulated and popular in Ireland, and on television channels that were received here, ensured that C. & A. Modes gained a reputation and goodwill among Irish consumers. Contrast that with the facts in these proceedings. Diesel SpA cannot point to a single sale of one item of clothing to any Irish consumer prior to the adoption by Montex of its DIESEL mark. Diesel SpA have failed to identify a single advertisement that was directed towards Irish consumers or one that Irish consumers may have seen as a result of spill-over from advertising in the UK, prior to the adoption of Montex of its DIESEL mark.

118. There is no doubt that there would be confusion if the Diesel SpA trade mark DIESEL was put on the register. There is already confusion in the marketplace and the registration of one party’s mark over the other would not negate or eliminate that confusion. Various traders have supported both sides in this dispute which confirms that, not alone would there be confusion in the minds of consumers, which Section 19 seeks to avoid; there would be confusion in the minds of traders that operate in the clothing business. The leaflet produced by the proprietor of the Empire clothing shops, which Diesel SpA attempted to distance itself from, confirms this.

119. Finally, turning to the contrary positions adopted by Counsel regarding honest concurrent user. On the one hand Mr. Gallagher is arguing that honest concurrent use is not relevant to Section 19, and on the other, Mr. Gordon maintains that the Diesel SpA mark should be registered because any confusion which might result from the use by Diesel SpA of its DIESEL

³⁹ [1976] IR 198

mark, is permitted confusion, by virtue of its use falling within the definition of “*honest concurrent use*”.

120. As regards the relevance of the consideration of honest concurrent use under Section 19, the Supreme Court stated that “*Section 19 is not relevant to honest concurrent user*”. I do not read this to mean that the Court was suggesting that the Controller should, when considering an application for registration under Section 19, and finding that there would be confusion if the mark applied for was registered, but that that confusion was a result of honest concurrent use, disregard the fact that the confusion resulted from honest concurrent use and refuse the application anyway. In my opinion, the Court was stating that Section 19 should be invoked if the Controller was satisfied that an application for registration would, because of deception, confusion or otherwise, have been disentitled to succeed in an action against a third party (in relation to the specifics of Section 19 the definition of third party must be someone other than another legitimate user of the same mark by virtue of honest concurrent user). So, Section 19 is not concerned with allowing an application to proceed to registration on the basis of honest concurrent use, it is about the refusal of an application on the grounds of deception, confusion or otherwise, were such reasons concern something other than honest concurrent use. This is consistent with the Supreme Court decision wherein Geoghegan J states “*I would interpret section 19 as meaning that the registrar is bound to refuse registration if the mark is likely to deceive or cause confusion and would, prior to 1875 on that account, have been disentitled to protection in a court of equity...*”⁴⁰

121. Honest concurrent use is dealt with under Section 20(2) of the 1963 Act, which is written in the following terms:

“In case of honest concurrent use, or of other special circumstances which in the opinion of the Court or the Controller make it proper so to do, the Court or the Controller (as the case may be) may permit the registration of trade marks that are identical or nearly resemble each other in respect of the same goods or description of goods by more than one proprietor subject to such conditions and limitations, if any, as the Court or the Controller (as the case may be) may think it right to impose.”

That section is a proviso of Section 20(1) and cannot be read disjunctively from that section, which is written as follows:

⁴⁰ [2001] 3 IR 85, 95

“Subject to subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with a trade mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or that so nearly resembles such a trade mark as to be likely to deceive or cause confusion.”

122. Section 20(1) specifically refers to a trade make that is “*already on the register*”. It is unclear from the wording of Sections 20(1) and (2) whether or not honest concurrent use can apply where the earlier trade mark has been used but is not registered, as is the case in these proceedings. It strikes me that it cannot apply for the following reason. In my opinion, the concept of honest concurrent use exists for the purpose of putting the same or similar marks, of two different proprietors, on the same footing and thereby affording them the same legal protections, and henceforth for them to be treated on the basis of equality. If the earlier mark is not registered and the later mark is allowed to proceed to registration, then the later mark would be elevated to a superior legal status than that of the unregistered mark and would be afforded greater protection. In effect the later mark would be granted a monopoly at the expense of the earlier one. In equity, it cannot be fair, nor, in my opinion, was it the intention of the legislators (who specifically refer to a trade mark “*already on the register*”), that an earlier mark could, as a result of a claim to honest concurrent use by the proprietor of a later mark, end up with an inferior legal status to that of the later mark. Therefore, the arguments for the registration of the DIESEL and DIESEL Logo marks in Class 25 on the basis of honest concurrent use must be rejected and, accordingly, the applications must not be allowed to proceed to registration on that basis.

123. Lest, on appeal, I am found to have erred on this point, I will consider the question of whether the Applicant’s mark should be allowed to proceed on the basis of honest concurrent use, on the assumption that such use can be claimed against an unregistered mark. The assessment of honest concurrent use is a discretionary matter for the Controller and, therefore, each case must be decided on its own merits. It is important to point out that a finding by the Controller that it appears to her that the case for honest concurrent use has been made, does not automatically result in the mark applied for becoming registered. The acceptance for publication by the Controller of the mark is on the basis that, *prima facie*, the Applicant has made a case that the application is worthy of registration, on the basis of honest concurrent use. However, following the publication of the acceptance of the mark, an applicant is still required to defend its application in the face of any opposition that may result from the publication of the mark.

124. A number of authorities have dealt with the honest concurrent use issue, the leading authority being the House of Lords decision in *Alexander Pirie & Sons Ltd*⁴¹, where Lord Tomlin identified the factors which may be taken into consideration. These are:

- a. The extent of use of the mark for which registration is sought. Such extent to include the duration of use, quantity and geographical spread within the State;
- b. The degree of confusion likely to arise;
- c. The honesty of the concurrent use;
- d. Whether any instances of confusion have been proven; and
- e. The relative inconvenience if the mark was allowed to proceed to registration.

125. My assessment of the above factors leads me to conclude that the Applicant has failed to prove that its mark warrants registration on the grounds of honest concurrent use. Looking firstly at the extent of use of the mark, which duration the Applicant claims dates from 1982. The period between 1982 and the filing date of 11 January 1994 is a significant duration, but use within that period, consists of less than a handful of sales. Most certainly there was not continuous use. The volume of sales, supported by relevant and legible invoices offered in evidence, point to no more than 3 purchases of products from Diesel SpA by Irish traders from January 1982 to the filing date of 11 January 1994. This volume, spread over the 12-year period, can only be described as minuscule. As regards the geographical spread within the State, at best sales were transacted in a handful of stores located in Dublin and Cork, but nothing elsewhere. There is no doubt in my mind that the Diesel SpA trade mark DIESEL did not reach the level of market penetration or consumer awareness at the date of application to justify a positive finding in respect of (a) above.

126. As regards the degree of confusion likely to arise, logic dictates that where there is triple identity (identical marks, on identical goods, in identical geographical areas of trade) there must be confusion. I accept that the relevant public can, by familiarity brought about by concurrent use, learn that two identical marks are in use, but there would need to be some other factor at play in order to reduce the likelihood of confusion. For instance in *BULER*⁴² the goods were in each case watches but the respective customers were different because of the considerable price divergence, which reduced significantly the risk of confusion. No such differentiating factors

⁴¹ (1933) 50 RPC 147.

⁴² [1975] RPC 275

are at play in the present proceedings. Therefore, I find in respect of factor (b) above that an extremely high degree of confusion is likely to arise.

127. There is no doubt that Diesel SpA's proposed use of its trade mark DIESEL is anything other than honest. So, it scores top marks in consideration of factor (c) above.

128. The Opponent has offered evidence that it claims proves incidents of confusion have actually arisen. It submitted an advertising circular distributed by an official stockist of Diesel SpA (Empire) warning its staff and customers to "*BE AWARE – KNOW THE FACTS. There are currently 2 different DIESEL Brands on sale in the Irish Market*", though no date of production or circulation of the circular was offered by the Opponent. Nonetheless, according to the note penned by Cormac Harten, the proprietor of Empire, (attached as Exhibit "RR2" to the Statutory Declaration of Renzo Rosso dated 14 October, 2003), he produced the circular as he felt it was necessary, and I use his own words, "*to dispel the confusion between the 2 products*". So, this was not a proactive move on his behalf to alert his staff and customers to the possibility of future confusion, it was in response to the actual confusion that existed in the marketplace, which was caused by the existence of the two DIESEL trade marks. So, I am satisfied that there has already been confusion in the marketplace.

129. The final factor concerns the inconvenience if the mark was allowed to proceed to registration. I take this to mean the inconvenience to the proprietor of the earlier mark. Again, where there is triple identity, in my opinion, it is reasonable to assume that significant inconvenience, including loss of business and goodwill, would be visited upon the proprietor of the earlier mark if the later mark were to be allowed to proceed to registration.

130. In light of the foregoing consideration of the factors identified by Lord Tomlin, I am satisfied that, notwithstanding that the proposed use by Diesel SpA of its trade mark DIESEL is honest, the Applicant has failed to justify the registration of its mark on the basis of honest concurrent user. Accordingly, I am not prepared to exercise the discretion of the Controller favourably towards the Applicant by allowing application Nos. 177240 and 177245 to proceed to registration on that basis.

131. I am satisfied that there would be confusion if the Applicant's mark was allowed on the register, such confusion not having been caused by the unlawful purloining by Montex of Diesel SpA's mark. Accordingly I refuse to allow application Nos. 177240 and 177245 to proceed to registration on that basis that they offend against Section 19 of the 1963 Act.

132. In summary, as regards the trade mark DIESEL and DIESEL Logo in respect of Class 25, I would describe this case as thus: Diesel SpA have applied for these trade marks 15 years after the first use by Montex of its trade mark DIESEL. Diesel has claimed that the use by Montex of the trade mark DIESEL is lacking in *bona fides* and, in particular, that Montex stole its trade mark. No evidence was adduced by Diesel SpA that would lead me to conclude that Montex stole Diesel SpA's mark or that Diesel SpA was the proprietor of the trade marks in Ireland at the relevant date. Diesel SpA was unable to point to any sales, advertising or reputation in Ireland or internationally, that could have spilled over into Ireland, prior to the first use by Montex of its mark. Frankly, Diesel SpA has attempted to take the reputation it had in the marketplace in 1994, which was significant and was built up from the late 1980's, and apply it retrospectively to Ireland in the late 1970's and early 1980's. This I cannot allow. I reject the claim by Diesel SpA that Montex stole or hijacked its mark and that any confusion in the marketplace would be as a direct result of Montex's unlawful action. The evidence submitted in this case leaves me in no doubt that Montex did not steal Diesel SpA's mark. Nothing was stolen as there was nothing to steal.

Exercise of the Controller's Discretion

133. The exercise of the Controller's discretion only comes into consideration after all sections of the Act dealing with mandatory grounds for refusal have been decided and where none of these grounds result in the refusal of the application. I have refused to allow the two applications in respect of goods in Class 25 to proceed to registration on the grounds that they fail to meet the requirements of Sections 2, 19 and 25 of the 1963 Act. I have found that the other six applications do not offend against any of the Sections of the 1963 Act cited in the Notices of Opposition. Therefore, the circumstances under which the Controller may exercise discretion applies only to these six applications, which are in respect of goods in Classes 16, 18 and 24. In exercising discretion, the Controller must do so judicially and reasonably. No reasonable case has been made to justify the exercise of that discretion in favour of the Opponent for those applications and therefore, I see no reason to do so.

Dermot Doyle
Acting for the Controller
9 September 2013

Annex 1

Cases referenced on behalf of the Opponent

1	MUNDICOR / MUNDICOLOR T-183/02 and T-184/02
2	SELENIUM-ACE T-312/03
3	LIMONCHELO C-334/05
4	Opposition against CTM Application No. 7021348 DIESEL DIGITAL & logo
5	Jellinek's Application (1946) 63 RPC 59
6	Clark, Smyth & Hall, 3 rd edition para 31.32
7	QS by S. Oliver 1999 RPC 520
8	AL-AJLAN Device Opposition No. 49679
9	THORNPROOF / THORNGUARD Opposition Nos. 42686 and 42794
10	Clark, Smyth & Hall, 3 rd edition para 25.58
11	Montex Holdings Limited v. The Controller and Diesel S.p.A. 2000 E.T.M.R. 658
12	Montex Holdings Limited v. The Controller and Diesel S.p.A. 2001 IESC 29
13	Jaguar Cars Ltd. v. Manufacture des Montres Jaguar SA 2006 IEHC 103
14	DIESEL Opposition No. 147773
15	QUIET MAY Trade Mark 1967 F.S.R. 27
16	Kerly, 12 th edition 4-03
17	Kerly, 10-06
18	Dunn's Trade Mark 7 RPC 311
19	Hack's Application 58 RPC 91
20	BALI Trade Mark 1969 RPC 472
21	Bass, Ratcliff & Gretton Ltd v. Nicholson & Son Ltd 49 RPC 88
22	Smith Hayden & Coy Ltd's Application 63 RPC 97
23	Tierney, page 53
24	Kerly, 10-03
25	GOLDEN WONDER – Dalgety Spillers v. Tayto, Rectification of Trade Mark No. B89809
26	McDowell's Application 44 RPC 335
27	Aristoc Ltd. v. Rysta Ltd. 62 RPC 65
28	PLAYERS Trade Mark 1965 RPC 363
29	GE Trade Mark 1973 RPC 297
30	Pianotist Application 23 RPC 774
31	Kerly, 4-32
32	Garrett's Application 23 RPC 117
33	In re Cheryl Playthings Application 1962 1 W.L.R. 543
34	Kerly, 10-17
35	Javal and Parquet Application 29 RPC 627

Cases referenced on behalf of the Applicant

1	Kerly's Law of Trade Marks and Trade Names (12 th ed., 1986) paragraphs 10.26 – 10.44
2	Jaguar Cars Ltd v. Controller of Patents [2006] 1 IR 607
3	Henderson v. Henderson (1843) 3 Hare 100
4	Carroll v. Ryan [2003] 1 IR 309
5	Hormel Foods Corp. v. Antilles Landscape Investments NV [2005] IP & T 822
6	Special Effects Ltd v. L'Oreal SA [2007] IP & T 617
7	Arriba Pty Ltd. V. Cuisine To Go Pty Ltd (1994) 29 IPR 584
8	LITTLE CEASARS, Patents Office (Mr. Dermot Sheridan) November 2001
9	C&A Modes v. C&A (Waterford) Ltd [1976] IR 198
10	General Electric Co. (of USA) v. General Electric Co. Ltd [1972] 1 WLR 729
11	Dublin County Council v Gilbert Taylor [1988] WJSC-HC 2136