

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

In the matter of an application for registration of Trade Mark No. 248621 and in the matter of an Opposition thereto.

RONAN BYRNE

Applicant


COFRESCO FRISCHHALTEPRODUKTE & CO. KG

Opponent

(Represented by Tomkins & Co.)

The Application

1. On 18 February, 2013 Ronan Byrne (the “Applicant”), of 25 Carysfort Downs, Blackrock, County Dublin made application (No. 2013/00287) under Section 37 of the Trade Marks Act,

1996 (“the Act”) to register  (hereafter “*handi:pak* logo”) in respect of “*Plastic bags for refuse/rubbish/household waste; absorbent sheets of paper or plastic for foodstuff packaging; films for wrapping foodstuffs*” in Class 16. The application was accepted for registration and advertised accordingly under No. 248621 in Journal No. 2229 dated 22 May, 2013.

2. A Notice of Opposition to the registration of the marks pursuant to Section 43 of the Act was filed on 18 July, 2013 by Cofresco Frischhalteprodukte & Co. KG (hereinafter “Cofresco”), of Ringstrasse 99, Minden, Germany. The Applicant filed a counter-statement on 30 July, 2013 and evidence was, in due course, filed by the parties under Rules 20, 21 and 22 of the Trade Marks Rules, 1996 (“the Rules”).

3. The Opponent filed written submissions in lieu of attending a hearing in the matter, while the Applicant attended the Hearing. Acting for the Controller, I decided to dismiss the opposition and to allow the application to proceed to registration. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Opponent in that regard pursuant to Rule 27(2) of the Trade Mark Rules 1996.

Grounds of the Opposition

4. In its Notice of Opposition the Opponent refers to its proprietorship of Community Trade



Mark (CTM) No. 006111975 (hereinafter “**handy bag** logo”) with an effective registration date of 9 July, 2007 in respect of the following goods:

Class 6	Aluminium foil; plastic-coated aluminium foil; metal foil materials for packaging; grill pans; baking and roasting tins of aluminium foil; inserts of aluminium foil for baking tins and pans; closing clips of metal. Metal foil materials for packaging. Closing clips of metal.
Class 7	Vacuum cleaner bags (included in class 7); papers and nonwovens for vacuum cleaner bags, being starter material for the manufacture of vacuum cleaner bags (included in class 7); filters for vacuum cleaners, namely air, pollen and motor filters, included in class 7.
Class 16	Packaging material of paper, cardboard and/or plastic in the form of foils, tubes, sheets, rolls, bags, boxes and containers for household and kitchen use for storing, baking, roasting, cooking, keeping fresh and freezing; bags for ice cubes; labels; implements for writing on films; baking and roasting tins of paper; baking parchment; rubbish bags of paper and/or plastic; waste sacks of paper and/or plastic; gloves.
Class 17	Microwave foil.
Class 21	Household or kitchen utensils and containers (not of precious metals or coated therewith); freezer tins and boxes; plastic tableware; plastic drinks vessels; closing clips of plastic; cake moulds, baking and roasting tins; grill pans; cooker hoods; splash-guard covers; foil dispensers; bottle warmers, included in class 21; plastic containers and casings filled with fluid (gel) for cooling or heating drinks and keeping drinks hot and/or cold.

The Opponent then raises objection to the present application under Sections 8, 10, 37 and 42 of the Act, which I shall summarise as follows:

- Section 8(1)(c) – *the mark consists exclusively of signs or indications which may designate characteristics of the goods;*
- Section 8(1)(d) – *the mark consists exclusively of signs or indications which have become customary in the trade;*
- Section 8(3)(b) – *the mark is of such a nature as to deceive the public;*
- Section 8(4)(a) – *use of mark is prohibited by enactment or rule of law;*
- Section 10(2)(b) – *likelihood of confusion on the part of the public, and likelihood of association with the Opponent’s HANDY BAG earlier mark;*
- Section 10(3) – *use of mark would take unfair advantage of, or be detrimental to, distinctive character or reputation of the Opponent’s mark;*

- Section 10(4)(a) – *use of the mark is liable to be prevented by virtue of the law of passing off*;
- Sections 37(2) and 42(3) – *the Applicant is not using the mark applied for, nor does he have a bona fide intention to use the mark.*

Counter-Statement

5. In his Counter-Statement the Applicant provides details of his recent employment as Sales Director in Ireland for a subsidiary of a multinational company (Georgia Pacific) that distributed grocery products, including those in Class 16 for which the application was made. The multinational company had a subsidiary named Handi-Pak Distributors Limited, which was incorporated on 31 July, 1979 and registered in Ireland, under Company No. 70344. Mr. Byrne states that a “*handi-pak* Greaseproof Roll” was sold by his company into Dunnes Stores shops nationwide and can today be found on the shelves of that supermarket chain. He encloses a sample of that product.
6. Mr. Byrne states he has worked in the Irish grocery business for 30 years and was not aware of the existence in Germany of the name **handy bag**, until he received the Notice of Opposition. He is aware that Cofresco is represented in Ireland by a company called Bunzl Irish Merchants, who distribute “Glad” branded products owned by Cofresco, but there is no mention of “handy bag” branded products on the list of products to be found on the Bunzl Irish Merchants website.
7. He denies all the grounds of opposition and only admits the Opponent is the registered proprietor of the mark cited in the Notice of Opposition. In particular he questions how Cofresco feels qualified to claim he is not using the mark nor has a *bona fide* intention of using the mark. He provides details of some of the activities he has embarked upon in preparation for putting the mark to use and states he is awaiting the Controller’s decision, confirming that he can use the mark, before progressing any further.

Rule 20 Evidence

8. Evidence submitted by the Opponent under Rule 20 consists of a Statutory Declaration, dated 4 July, 2014 of Pieter Van Halewijn, President of Cofresco, and nine exhibits labelled “PVH1” to “PVH9”. Also submitted was a supplementary Statutory Declaration of Pieter Van Halewijn dated 31 July, 2014.

9. In his first Statutory Declaration Mr. Van Halewijn attaches at Exhibit “PVH1” details of his company’s registration of its earlier CTM No. 006111975 and a Certified Copy of its registration. He states his company is Europe’s leading brand manufacturer of home solutions for the fresh keeping and storage of food as well as household waste disposal. His company has its headquarters in Minden, Germany and operates four European subsidiaries in Spain, Poland, Russia and Germany. In total around 300 staff are employed across the five companies. His company claims the top position in 15 of the 25 European countries in which its products are distributed. His company’s products can be found in 70 million European households with more than 3.5 billion uses per year. He attaches at Exhibit “PVH2” extracts from his company’s website which mentions Ireland under the heading “ALBAL/HANDY BAG”, which he claims shows the use of his company’s earlier mark **handy bag** logo in Ireland.
10. Mr. Van Halewijn states that Irish people predominantly holiday in the countries where the earlier mark is in use, namely France, Spain and Portugal and would have exposure to and knowledge of the earlier mark having encountered the mark while shopping locally on such holidays. He attaches at Exhibit “PVH3” details of turnover for goods sold under the “handy bag logo” trade mark in Spain in the years 2008-2012. These show that 40,849,572 units were sold which generated turnover of €51,408,383.72. At Exhibit “PVH4” he attaches invoices, in Spanish, from the Spanish subsidiary to retailers in various Spanish cities.
11. Mr. Van Halewijn states the **handy bag** logo brand is also well known in France having been sold there since 1984. He attaches at Exhibit “PVH5” market research analysis, conducted by Nielsen, showing the market share of **handy bag** logo branded goods at the end of 2012 as 14.7%. He avers that, as a result of significant advertisement and promotion, the brand is known by 96% of French people. He attaches at Exhibit “PVH6” a report supporting this claim. Further evidence is attached at Exhibits “PVH7” and “PVH8” which relate to brand recognition and reputation in France. The final Exhibit “PVH9” contains samples of money-off offers made by the Opponent for the **handy bag** logo refuse bag in France since 2004.
12. In his supplementary Statutory Declaration, Mr. Van Halewijn states that, following further investigation into the use of the **handy bag** logo trade mark in Ireland, it has come to light that no **handy bag** logo products have ever been sold in Ireland, as of yet, but that it is anticipated that use will occur in the near future. He explains that at the time of executing his original declaration he honestly believed that use of the trade mark **handy bag** logo had taken

place in Ireland, his belief having been formed as a result of statements indicating such use which are on his company's website. He corrects the assertions made regarding use of his company's earlier mark in Ireland and withdraws the associated supporting evidence (Exhibit "PVH2").

Rule 21 Evidence

13. Evidence submitted by the Applicant under Rule 21 consists of a Statutory Declaration dated 26 August, 2014 and two accompanying but unmarked exhibits, of Ronan Byrne. He repeats what he said in his Counter Statement regarding his employment history and the use by Georgia Pacific and its subsidiary of the *handi-pak* logo trade mark in Ireland, such use having never been challenged by the Opponent.
14. Mr. Byrne states in his opinion the respective logos are significantly and sufficiently different. He presents the two marks side-by-side to support his claim. He says **handy** is not a proprietary name and exhibits photographs of other products, including goods in Class 16, bearing the word as part of their name. The photographs show the original *handi-pak* trade mark in use on greaseproof roll, the Handy Andies mark on tissues, the Keep It Handy mark on freezer bags and on ice cube bags, and Killeen Handy Multi-Use Bags. He points out that the first part of his mark is *handi* not **handy**. He also attaches a picture of the Opponent's GLAD trade mark on products and claims this is the brand used by the Opponent in Ireland not **handy bag**.
15. He expresses his annoyance that the Opponent spent 18 months objecting to the application on grounds that sales of its (non-existent) product in Ireland would be negatively impacted. He states all the Opponent had to do was to contact its distributor in Ireland to establish what products bearing the Opponent's earlier **handy bag** mark were sold in Ireland.
16. The remainder of his declaration contains argument as to why the opposition has no validity.

Rule 22 Evidence

17. Evidence filed under Rule 22 consists of a third Statutory Declaration of Pieter Van Halewijn and four supporting exhibits labelled "PVH10" to "PVH13". He takes a close look at the marks identified by the Applicant as examples of other marks containing the word handy. He notes the trade mark HANDY ANDIES has been removed from the Register (an extract of which he exhibits at "PVH10") and is no longer in force. Therefore, the claim by the

Applicant that the word handy is not proprietary is untrue. In relation to KEEP IT HANDY he notes that the exhibit shows use of this mark restricted to the goods “freezer bags” in Class 16. He says it is evident that consumers would see the “Killeen” part of Killeen Handy Multi-Use Bags as the mark and the other words are purely descriptive of the goods.

18. Mr. Van Haleswijn states the Opponent tried to settle the present dispute with the Applicant to restrict its use and registration of the trade mark *handi·pak* logo to the goods “greaseproof paper” in Class 16, but the Applicant never responded to any of the correspondence offering a settlement.
19. He refutes the assertions made by the Applicant that the disputed mark has been in use in Ireland for many years without challenge from the Opponent. The mark has been used solely for “greaseproof paper”, whereas now the Applicant has applied to obtain rights for a broad range of goods (a summary of the application is attached at Exhibit “PVH12) for which the Opponent’s mark is already registered. Irrespective of whether his company’s earlier mark is used in Ireland or not, the protection afforded his company’s earlier Community Trade Mark extends to Ireland. The mark is widely used in many Member States, and is entitled to prevent all third parties from using similar marks in the course of trade. He attaches at Exhibit “PVH11” the relevant article of Council Regulation (EC) No. 207/2009.
20. Mr. Van Haleswijn concluded his evidence by attaching at Exhibit “PVH13” a decision of the Office for Harmonization in the Internal Market (OHIM) to partially refuse to register, on the basis of a likelihood of confusion, the term HANDI-VAC on foot of an opposition based on the Opponent’s earlier **handy bag** logo mark.

Written submissions and submissions at the Hearing

21. In its written submissions lodged in lieu of attending at the Hearing the Opponent confined its arguments to those centred on its objection under Section 10(2)(b). As no evidence was adduced or arguments made specifically to support any of the other grounds of opposition I must take it the Opponent has abandoned all other grounds. Therefore, it is with Section 10(2)(b) alone that I need concern myself.
22. In its submissions the Opponent compared the respective marks in terms of their visual, aural and conceptual characteristics and of the respective goods. As a result of its analysis the Opponent concluded that the marks are highly similar and the goods are identical. In light of

this the Opponent argues there must be a likelihood of confusion. The Opponent directed me to a second decision of the OHIM wherein the mark “Handy” was deemed to be confusingly similar to “händi”.

23. Mr. Byrne attended the Hearing and argued the marks were different but conceded the goods were identical, but that the level of similarity between the marks and goods would not be such as to cause confusion. Proof of this is that the *handi-pak* logo has existed in Ireland for more than a decade without any confusion or objection from the Opponent.

24. Mr. Byrne argued the Opponents objection is flawed, vexatious, potentially anti-competitive and to be a defensive commercial ploy; not specifically to defend their brand **handy bag** logo which does not, never has and may never exist in Ireland, but more so to defend their existing business in Ireland, within Class 16, under their GLAD brand. The Opponent has used its trade mark GLAD on Class 16 products in Ireland for over 30 years. He argued that, contrary to the Opponent’s stated intention that it would use its mark in Ireland at some point in the future, it is commercially highly improbable the Opponent would rebrand its products with the **handy bag** logo mark and abandon such a well-known and successful brand that GLAD clearly is. He argues that, even if the Opponent did introduce goods under its **handy bag** logo brand, the public could perceive it to be from the stable of the Applicant’s previous employer Handi-pak Distributors Limited.

Section 10(2) – likelihood of confusion

25. Both parties undertook an assessment of the application and what they perceive to be the relevant factors and, unsurprisingly, reached contrary conclusions as regards the registrability of the disputed mark.

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

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

(a)

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

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

27. As is evident from the wording of Section 10(2), the four basic requirements that must be met in order for an objection under it to succeed are that, (i) there must be “an earlier trade mark”, (ii) the goods/services of the application must be identical with or similar to those in respect of which the earlier trade mark is protected, (iii) the mark applied for must be similar to the earlier trade mark and, (iv) there must be a resultant likelihood of confusion on the part of the public.
28. The first two requirements are met. The Opponent’s mark was filed at the OHIM on 9 July, 2007 and by virtue of Section 11(1)(b) of the Act, is an earlier trade mark as against the present application for the purposes of Section 10. The Applicant’s “*Plastic bags for refuse/rubbish/household waste; absorbent sheets of paper or plastic for foodstuff packaging; films for wrapping foodstuffs*” are clearly goods either identical with or similar to the Opponent’s “*Packaging material of paper, cardboard and/or plastic for household and kitchen use for storing, keeping fresh and freezing; bags for ice cubes; rubbish bags of paper and/or plastic; waste sacks of paper and/or plastic*”.
29. The principles of interpretation to be applied in determining an objection under Section 10(2)(b) of the Act are not in dispute. They have been set out in detail in several decisions of the European Court of Justice (CJEU)¹ and their applicability in an Irish context has been affirmed by the High Court (Finlay Geoghegan J) in *Cofresco Frischaltheprodukte GmbH & Co. KG –v- The Controller of Patents, Designs and Trade Marks and Reynolds Metals Company*². In summary, the relevant principles are:
- (i) the likelihood of confusion must be appreciated globally, having regard to all of the relevant factors, including the degree of similarity between the marks and between the goods, the likelihood that the public will make an association between the earlier mark and the mark seeking registration, and the distinctiveness of the earlier mark;
 - (ii) the similarity between the marks must be determined by reference to the degree of visual, aural and conceptual similarity between them and the importance to be attached to each of these elements must be assessed by reference to the category of goods and the circumstances in which they are marketed;

¹ including Case No. C-251/95, *Sabel BV v Puma AG and Rudolf Dassler Sport*, Case No. C-39/97, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* and Case No. C-342/97, *Lloyd Schufabrik Meyer & Co. GmbH v Klijsen Handel BV*

- (iii) the assessment must be made from the perspective of the average consumer of the goods in question, who must be deemed to be reasonably observant and circumspect but who rarely has the chance to make a direct comparison of the marks and must rely, instead, on the imperfect picture of them that he keeps in his mind;
- (iv) the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components, because the average consumer normally perceives a mark as a whole and does not analyse its various details;
- (v) the higher the distinctiveness of the earlier mark, whether inherent or acquired through use, the greater the protection granted to it, and vice versa.

Similarity of the marks

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

31. While both marks contain elements other than words, these elements do not contribute to the concept behind the respective marks. It is the word elements that transmit the message behind each. While the disputed mark contains the elements *handi* and *pak*, which are not dictionary words, they would be instinctively recognised as representing the words handy and pack. Therefore, conceptually the marks are identical in that they both evoke the image of a bag or

² unreported decision dated 14 June, 2007

pack that is easy to handle or of the act of packing something without much effort. Both words can be verbs or nouns, but either way the words fundamentally mean the same thing.

32. Visually the marks share the same four opening letters “h-a-n-d” but nothing else. The disputed mark consists of the words *handi* and *pak* which are not dictionary words and would be readily recognised as such. The words are side-by-side and joined together in script, but within the joining there is a dot, which acts as a separator of the two words. All of the letters are in lower case, in a narrow font and in italics. Both words are presented in white lettering against a blue background, with a darker shade of blue framing the *handi* element than the *pak* element. The entire of the mark is in the shape of a parallelogram with rounded corners.
33. The Opponent’s mark consists of two words, **handy** and **bag**, presented one above the other. The words are encircled in what I would describe as a free-hand drawing of a circle where the start and finish of the circle overlap. The circle is red or pink and is reminiscent of the method one might use to highlight an item on a list so that it stands out. The Opponent submits that the words are in blue, but I disagree. In my opinion the words are depicted in black, but nothing rests on this. The letters are all in lower case, presented in a vertical and wide character set and are in bold. Visually the marks are far more dissimilar than they are similar. I would assess the overall level of visual similarity to be very low.
34. Aurally both the Applicant’s and Opponent’s marks must be considered to contain two parts: *handi* and *pak*, and **handy** and **bag** respectively. The words *handi* and **handy** are aurally identical. The Opponent argued that as *pak* and **bag** contain only one syllable, because each ends with an “a” followed by a consonant and as the words share a similar cadence they share a high degree of similarity. I disagree. One does not break single syllable words into letters when speaking or drag out their pronunciation. *Pak* does not become “pah-ah-ack” and neither does bag become “ba-ah-guh”. They are single syllable words with only one pronunciation - pac and bag. In my opinion these elements are aurally dissimilar, but overall the marks share a more than medium degree of aural similarity.
35. Having completed an aural, visual and conceptual comparison of the marks I am satisfied the marks are similar to an average degree. However, my assessment was conducted using a very formulaic method of comparing the respective marks in terms of their aural, visual and conceptual similarity. This three-pronged assessment is not a standalone process to be

conducted in isolation from all other considerations, though most parties in Opposition proceedings invariably focus on the three comparisons and use them alone to reach their conclusions regarding the degree of similarity between the respective marks. While this is a long-established practice it fails to focus on the most important and overriding consideration to be taken into account which is the “overall impression” of the respective marks.

36. The “overall impression” test comes from a number of decisions of the Court of Justice of the European Union where in *Sabel* (Case C-251/95 *Sabel BV v. Puma AG*, at paragraph 23) the Court ruled that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. Also, in that case the court ruled the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks (*my emphasis*) bearing in mind their distinctive and dominant components.
37. I must apply all these established principles and assess the respective marks as a whole, viewed through the eyes of the average consumer of the goods in question, without dissecting them. I cannot do so without looking at them side-by-side.



38. While the CJEU found in *Lloyd Schuhfabrik Meyer*³ the average consumer rarely has the chance to make a direct comparison between marks and must instead rely upon the imperfect picture of them he has kept in his mind, it also found the average consumer must be deemed to be reasonably well informed, circumspect and observant. This does not mean the average consumer is prone to recall a completely different version of a mark he encountered previously. It means he may not be able to recall with certainty or precision the exact make-up of the earlier mark, but in deploying his normal level of observance and caution, he will remember with a reasonable degree of accuracy the general construction of the earlier mark. Bearing in mind the perception of the average consumer and looking at the marks in their totality, and notwithstanding my earlier findings in terms of aural, visual and conceptual

³ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* (Case C-342/97)

similarity, it strikes me the overall impression created by the marks is that they are very different. I cannot see how the average consumer would, on encountering the Applicant's mark (shown on the left above), even on the basis of imperfect recollection, be likely to recall the Opponent's mark (shown on the right above).

Likelihood of confusion

39. The criteria against which the question should be answered has been enunciated in a number of decisions of the European Court of Justice⁴ in this area and include the following:

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

⁴ Sabel BV –v- Puma AG and Rudolph Dassler Sport (Case C-251/95) [1998] 1 CMLR 445; Canon Kabushiki Kaisha –v- Metro-Goldwyn-Mayer Inc. (Case C-39/97) [1999] 1 CMLR 77; Lloyd Schuhfabrik Meyer & Co. GmbH –v- Klijsen Handel BV (Case C-342/97) [1999] 2 CMLR 1343

40. In applying those criteria to the facts of the present case, I have reached the following conclusions:

- (a) The Opponent's mark possesses a very low level of inherent distinctiveness in respect of the goods at issue in Class 16 namely, products for packing and storing food, and refuse sacks. The word elements of the mark are purely descriptive of the purpose and function of bags used for everyday household convenience. Any trader in bags used for house convenience purposes would be entitled to describe their products as "handy bags". It is the red/pink circle, which is not present in the disputed mark, that provides the Opponent's mark with some semblance of distinctiveness.
- (b) The Applicant's mark has a slightly higher degree of inherent distinctiveness than that of the Opponent. The words *handi* and *pak* are not ordinary dictionary words and would be recognised as such. They are clearly substitutes for the words handy and pack, but nonetheless, consumers will notice and remember the words because of their unusual presentation and incorrect spelling.
- (c) The Opponent's mark has earned a reputation through its long-established use in some European countries but it is not used or known in the State. There is no evidence of any marketing or advertising directed at Irish consumers or in the English language. Nonetheless, the Opponent's Community Trade Mark stands protected and is entitled to a monopoly in Ireland.
- (d) The goods are everyday products purchased by the general public. They are low-cost items, the vast majority of which are purchased in supermarkets, where they are placed on shelves for consumers to select, without the need to seek assistance or to ask for the product or brand by name.
- (e) Conceptually the marks are identical. Aurally they are somewhat similar but visually they are very different. The overall impression created by the marks in question is that they are very different.
- (f) The goods covered by the Application are identical to the goods of the Opponent's registration, which means the low level of similarity between the marks could be offset by the much higher degree of similarity between the goods, and in theory could allow for a finding that a likelihood of confusion exists.

41. The basic ingredients of an objection under Section 10(2)(b) of the Act – *earlier trade mark, (to some extent) similar marks and identical goods* – are all present in this case and the issue

now rests on whether, as a consequence, there is a likelihood of confusion on the part of the public.

42. In determining the degree of similarity between marks much focus is put on the aural similarity, but in my opinion, the most important comparison concerns the overall impression of the marks. I find that all too often far more emphasis than is warranted is put on the assessment of the degree of aural similarity between marks. There are many low-cost goods that are rarely or never the subject of aural advertisements (i.e. radio and television ads) and for which the brand-owners, when marketing, rely on paper or in-store advertising. Consumers of goods of that nature rarely hear the brand name or have reason to speak it themselves. Their recall is mostly based on the visual image of the mark they keep in their mind, imperfect as it may be.
43. Opponents typically argue that a shop assistant might be confused between two marks if a consumer asks for a particular branded product. But that is not the appropriate test. There are a multitude of goods that consumers rarely if ever have to ask for. The appropriate aural test concerns what the consumer hears and how they react to it. It is whether the consumer, who is familiar with goods marketed under the Opponent's earlier mark and, on hearing of goods being marketed under the Applicant's later mark, is likely to believe the latter goods are associated with the proprietor of the goods with which he is familiar. In making that call the consumer will be considering either purchasing the latter goods, believing them to be of the standard he has come to expect of goods bearing the earlier mark, or avoiding the goods based on a previous bad experience of the goods sold under the earlier mark. It is about the consumer's impression, not about what the shop assistant to whom the consumer speaks might think, hear, or think they hear.
44. The kind of confusion Section 10(2)(b) seeks to avoid is concerned solely with the commercial origin of goods, whereby the average consumer, being familiar with goods sold under the earlier mark and, because of the similarity in the respective marks, attributes to the goods offered under the disputed mark the qualities and characteristics that he associates through experience with the goods offered under the earlier mark.

45. Correctly stated, the question of confusion concerns whether the average person, who knows



of goods sold under this mark

and who encounters this mark



on similar goods, would assume that the latter goods were connected with the former in the sense that they were both put on the market by the same undertaking or by commercially related undertakings.

46. In doing so I must consider the average consumer. But who is that? Is it an Irish-based person who may encounter the Applicant's mark in Ireland, having already encountered the Opponent's mark while on holiday in Europe (the Opponent argued such a scenario is likely to occur), or is it a European consumer who is very familiar with the Opponent's marks and, while visiting Ireland, chances upon the Applicant's mark? Is it both or someone else entirely? I consider the average consumer in this case to be a notional or hypothetical person who purchases the goods in question in accordance with the typical timeframe and purchasing scenario for such goods.

47. In light of all the foregoing I am required to make an overall assessment of the likelihood of confusion that may exist. The confusion in question may be direct confusion, whereby the Applicant's services are mistaken for those of the Opponent, or indirect confusion, whereby the Applicant's goods are associated in the mind of the consumer with that of the Opponent and a common commercial origin is inferred. I must look at the question of likelihood of confusion from a practical perspective in the context of the marketplace and put myself in the shoes of the average consumer. Bearing in mind the nature and low-cost of the goods, the channels in which they are traded, the methods employed by consumers when purchasing the goods, I am satisfied that the visual characteristic of the marks is what the average consumer will pay most, if not all, attention to.

48. Having considered all the facts of the case I have reached the conclusion that there is no likelihood of confusion. The overall impression of the marks is that they are very different. I am conscious of the principle that a lesser degree of similarity between the marks can be offset by the greater degree of similarity, or in this case identity, between the goods. However, given that the overall impression is of two very different marks I find the gap required to find a likelihood of confusion would arise has not been bridged.

49. Section 10(2)(b) is not solely concerned with confusion. It also prohibits applications being put on the Register if there is a likelihood of association between the marks. Both marks are connected by the word handy. But this word is commonly used to describe a characteristic of household convenience goods, which are the goods at issue in these proceedings. There are dozens of Community Trade Marks that contain the word handy. It is very likely that use of the word or a variation of the word as part of one trade mark may lead a consumer to recall or be reminded of other trade marks that also contain the word. But calling to mind is not the test of a likelihood of association. To fall foul of Section 10(2)(b) on the grounds of the marks being associated with one another the consumer, on encountering the later mark, must be likely to believe the goods bearing that mark are economically associated with the proprietor of goods sold under the earlier mark. In my opinion it is not likely that a consumer would form such a belief.

50. In light of all the foregoing I am satisfied the average consumer would not be likely to be confused as to the origin of goods bearing the trade mark *handi·pak* logo or to believe that such goods were produced by an undertaking associated with the proprietor of the trade mark **handy bag** logo.

51. Therefore, I reject the opposition based on Section 10(2)(b) of the Act. Therefore, I have decided to dismiss the opposition and to allow the disputed mark to proceed to registration.

Dermot Doyle

Acting for the Controller

26 August, 2015