

**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. 246848 and in the matter of an Opposition thereto.

HOLYROOD PUBLICATIONS LIMITED

Applicant

(Represented by Anne Ryan & Co.)

PROFESSIONAL INSURANCE BROKERS ASSOCIATION

Opponent

(Represented by Smyth Solicitors)

The Application

1. On 1 March, 2012, Holyrood Publications Limited, of Units 134-136, Baldoyle Industrial Estate, Dublin 13, Ireland made application (No. 2012/00360) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register “*The BROKER*” as a trade mark in respect of “*Insurances and financial services publications*” in Class 16.
2. The application was accepted for registration and advertised accordingly under No. 246848 in Journal No. 2202 dated 9 May, 2012.
3. Notice of Opposition to the registration of the mark, pursuant to Section 43 of the Act, was filed on 18 July, 2012 by Smyth Solicitors, of 120 Pembroke Road, Ballsbridge, Dublin 4, Ireland on behalf of its client Professional Insurance Brokers Association (hereinafter “PIBA”). The Applicant filed a counter-statement on 24 October, 2012. Evidence was then filed under Rules 20, 21 and 22 of the Trade Mark Rules, 1996 (“the Rules”). Both parties attended a Hearing of the matter on 30 September, 2014.
4. Acting for the Controller, I decided to dismiss the opposition and to allow the application to proceed to registration. The parties were informed of my decision by way of letter dated 17 October, 2014. 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, filed on 17 October, 2014.

Grounds of the Opposition

5. In its Notice of Opposition PIBA identifies itself as a trade association for insurance and mortgage brokers and financial advisers in Ireland and is the publisher of a long-running trade magazine which has reached its 37th edition and which was rebranded *The Broker* in 2011. Three editions – Winter 2011, Spring 2012 and Summer 2012 – have been published under the new name. The Opponent attached copies of the covers of these three editions to its Notice of Opposition.
6. The Opponent states the Applicant informed the Opponent of the application for the trade mark by letter of 8 March 2012, to which the Opponent replied on 27 March, 2012. Copies of both letters were also attached to the Notice of Opposition. The Opponent goes on to state the Applicant is the proprietor of the registered trade mark “Irish Broker Magazine” (registration no. 230006), and uses it on a trade magazine of the same name, which is published at the direction of the Irish Brokers Association (hereinafter “IBA”), a trade association which competes directly with the Opponent.
7. The Opponent then goes on to raise objections to the present application on the grounds that the application was made in bad faith and that the use of the trade mark is liable to be prevented by the law of passing off, should the Applicant publish a trade magazine under the name “*The BROKER*”.
8. In its Notice of Opposition the Opponent contends the object of the Applicant’s application is not for the purposes of trading under the name “*The BROKER*”. The Applicant already publishes a magazine under the title “The Irish Broker” and the Applicant’s objective is to stymie PIBA’s continued, *bona fide* use of the term “The Broker”, as the title of its publication. As such it is a so-called “ghost” mark. The Opponent claims any objective reading of the Applicant’s letter of 8 March, 2012 to PIBA and the contemporaneous, if misguided, registration of “The Broker” as a business name, are evidence of the Applicant’s attempts to block the use of the mark by PIBA. The Applicant has no intention of using the trade mark applied for but merely sees the title, *The Broker*, as being synonymous (and this is not accepted by the Opponent) with its already registered trade mark, *Irish Broker Magazine*. This is not the function or aim of trade mark law or the system of registering trade marks.

9. The Opponent also states it would have grounds for a claim of passing off. The Notice of Opposition concludes with the Opponent noting that the British Independent Brokers Association publishes a magazine called “The Broker” in England and Wales but has not registered the mark with the UK’s Intellectual Property Office.

Counter-Statement

10. In its Counter-Statement the Applicant denies both grounds of opposition. The Applicant points out that Holyrood Publications Limited has applied for the trade mark, not the IBA, as claimed by the Opponent. The “Irish Broker Magazine” is not published at the direction of the IBA, but in association with it. The Applicant is a distinct and separate limited company, wholly owned by Paul Gibson and Linda Coldrick. The Applicant attached to its Counter Statement extracts from sample editions of the Opponent’s “The Professional Insurance Broker” magazine, dated between May 2003 and Autumn 2010 and from the more recent rebranded version of that magazine published under the title “The Broker”.
11. The Applicant states that it is factually incorrect and misleading for PIBA to say it is the publisher of a long-running trade magazine, as it is clear from the very first issue (May 2003) that a separate entity other than PIBA was the publisher of the magazine. Also, the current PIBA magazine is published by Salient Print Management of Naas, Co. Kildare, not PIBA. Also the PIBA magazine was produced under the title “The Professional Irish Broker” for the first 34 issues, that title being in keeping with the full name of PIBA, and under the title “The Broker” for only 3 editions prior to the application for the trade mark “*The BROKER*” by the Applicant. The Applicant states that long before either of the titles associated with the PIBA were published, the titles “The Broker” and “Broker” were synonymous with the title of the Applicant’s “Irish Broker” magazine.
12. The Applicant rebuts the argument presented in the Notice of Opposition that, in applying for the mark, the Applicant is acting in bad faith. I would summarise that rebuttal as follows:
 - (a) The Applicant has every intention of using the mark applied for. If anyone is acting in bad faith it is the Opponent who, by rebranding its trade magazine from “The

Professional Insurance Broker” to “The Broker”, has caused confusion in the insurance market;

- (b) The “Irish Broker” magazine has been in the marketplace since 1984 and it is common case in the industry that the magazine is also known as “The Broker” and/or “Broker” magazine;
- (c) Holyrood Publications are the owners and publishers of the “Irish Broker” and have invested heavily in the development and promotion of that magazine for over 28 years. The registration, in February 2012, of “The Broker” and “The Broker Magazine” as business names and the application central to these proceedings are to protect the Applicant’s interest, investment and goodwill in the “Irish Broker” magazine, which is also commonly known in the insurance industry as “The Broker” and/or “Broker” magazine.

13. The Counter Statement states the Opponent is not entitled to raise a relative ground of refusal under the law of passing off, as the Opponent does not have an earlier right in the use of the mark at issue. The Counter Statement concludes with the Applicant stating that the observations made by the Opponent at the conclusion of its Notice of Opposition (concerning a broker association in the UK that publishes a trade magazine titled The Broker) are irrelevant as the Applicant is only applying for a trade mark in this jurisdiction.

Rule 20 Evidence

14. Mr. Kelly provides background to the competing trade associations PIBA and IBA, which are the two largest and most active trade associations/representative bodies in the broker market in Ireland. Both are not-for-profit organisations whose financial existence depends on subscriptions from members, of which PIBA has close to 900 and IBA more than 400; with about 60 members belonging to both organisations. IBA traditionally represents the larger and more corporate brokers, with a focus primarily on the general insurance market, while PIBA traditionally represents small-to-medium-sized brokers with a focus on the life assurance and pensions business. Attempts have been made to merge the two organisations without success, the last ending in failure in late 2011, just a few months before the application, the subject of these proceedings, was filed. The matter has been the subject of media attention and, at Exhibit “DK3”, Mr. Kelly attaches copies of articles titled “*Green light for merger of main broker*

associations” and “*Bitter row as brokers merger talks break down*” published in the 27 May, 2011 and 22 November, 2011 editions of the Independent newspaper respectively.

15. Mr. Kelly states the differences between who publishes a magazine and who causes a magazine to be published are minor, and a distraction from the Opponent’s grounds of opposition. He says the rebranding of the PIBA magazine was driven by a desire to modernise the trade magazine’s image and to reflect the fact that, despite PIBA’s legal name, its membership is now largely made up of brokers who provide advice and services outside of the limited field of insurance. The rebranding was not informed by the Applicants claimed colloquial title of the *Irish Broker* magazine. He says that editorial control of *The Broker* magazine is at all times retained by PIBA. Because PIBA does not carry out the business of publishing or designing, those functions were outsourced to Salient Print Management Limited. Nonetheless it is accurate to describe *The Broker* as PIBA’s trade magazine and it is acceptable to say that PIBA publishes its own trade magazine, albeit when there is a third-party involved in the process. In claiming it is “*factually incorrect and misleading*” for PIBA to say it is a publisher of the magazine, the Applicant is nit-picking and indulging in pedantry.

16. He claims the Applicant, in taking exception to the Opponent’s opinion that the Applicant’s magazine is published at the direction of IBA, but yet admits the magazine is published in “*conjunction and association with*” IBA, is once again nit-picking and being pedantic. He points to the inclusion on the inside of every front-cover of the Applicant’s *Irish Broker* magazine of the unequivocal words: “*Irish Broker is the monthly journal of the Irish Brokers Association*”. He attaches at Exhibit “DK4” extracts from four publications of *Irish Broker* that display these words.

17. He says that editorial control of *Irish Broker* rests with persons who are members, or directors/owners/management of members, of IBA. He calls into question the claim by the Applicant, in its Counter Statement, that the *Irish Broker* magazine is funded by the Applicant. He says that his long experience and knowledge of the broker industry and of directing the publication of a broker trade magazine, and his perusal of the advertisers in the *Irish Broker* magazine, allows him to say that it would be more accurate for the Applicant to claim the *Irish Broker* is funded by advertising and

financial contributions from companies operating in the insurance, pensions and financial industry. He also says and believes IBA seeks advertising funds for the Irish Broker magazine as part of their annual sponsorship package from companies in the industry who support the broker networks as a distribution channel for their various products. He states, when viewed from all relevant perspectives, it is reasonable and accurate to describe the two trade magazines as publications of the two trade associations – PIBA and IBA.

18. Mr. Kelly attaches at Exhibit “DK5” five pieces of correspondence sent to PIBA relating to the publication of its *The Broker* magazine, dated between December 2011 and January 2013. Two of the items are by way of e-mails to PIBA conveying congratulations on the rebranding of the PIBA magazine. The other three, all dated January 2013, are clearly responses to solicitations from PIBA and are virtually identical in their content, with each saying the sender supports both PIBA and IBA, advertises in both *The Broker* and *The Irish Broker* trade magazines and understands the distinction between the publications.
19. He says the industry views the publications as being from the respective trade associations and that there is no evidence the term “The Broker” was historically associated with one association rather than the other. The term “The Broker” is viewed positively as the rebranded name of the PIBA trade magazine, and if the IBA were to rebrand their magazine as *The BROKER*, this would cause confusion in the industry.
20. Mr. Kelly states the claims by the Applicant, in its letter to the Opponent of 8 March 2012, that confusion had been caused were never substantiated, despite the PIBA specifically calling on the Applicant to identify the sources of the claimed reporting of confusion from “*industry feedback...from CEO level*” and an unattributed quotation. He states that failure to substantiate these claims is fatal to the applicant’s case.
21. As to the samples of articles containing references to “*the Broker*” and “*Broker*”, he says these are all found in the *Irish Broker* publication itself rather than in an independent publication or context in which the intended meaning could not be so easily inferred. Use of the terms “The Broker” and “Broker” by the Applicant in its own magazine does not show the terms had become the popular, stand-alone, unofficial title of the magazine.

22. Mr. Kelly states the application for registration can be attributed to the recent poor relations that exist between the parties and that the Applicant made the application as a direct reaction to the lawful rebranding of PIBA's magazine to *The Broker*. He claims the failure on behalf of the Applicant, in its letter of 8 March 2012, to inform the Opponent that an application to register the term "*The BROKER*" as a trade mark had been lodged by the Applicant on 1 March 2012, was presumably to avoid any opposition to the application, and is further evidence of the bad faith engaged in by the Applicant. Furthermore, the lack of any follow-up by the Applicant to its threat, in the letter of 8 March 2012, to place matters in the hands of its legal team, raises further questions about the *bona fides* of the application.

23. Mr. Kelly replies to the Applicant's claims that matters in the UK are irrelevant to these proceedings by stating that relevant matters relating to the UK's Intellectual Property Office are persuasive and should not be ignored. He concludes his Statutory Declaration by saying the law of passing off protects the mark "The Broker" as it is used in the course of the Opponent's trade and prevents registration.

Rule 21 Evidence

24. Evidence submitted by the Applicant under Rule 21 consists of a Statutory Declaration, dated 13 May, 2013 of Linda Coldrick, company director and shareholder in the Applicant, of Baldoyle, Dublin 13 and a single accompanying exhibit, marked "LC1", containing the application form and a letter to this Office supporting the application at issue, and materials relating to the 2003 application and subsequent registration of the Applicant's trade mark Irish Broker Magazine under No. 230006, in 2005.

25. Ms. Coldrick states she does not intend to repeat and/or resubmit the contents of the Applicant's Counter Statement and/or the associated documents referred to in the Counter Statement, but is relying upon these materials which are already before the Controller. What Ms. Coldrick does say is that "*The BROKER*" meets the definition of a trade mark as set out in the Act. It is a sign capable of being represented graphically that has, at all times since 1984, been capable of distinguishing the trade magazine owned and published by the Applicant from all other magazines, including the trade

magazine which PIBA began issuing in May 2003. The PIBA magazine was originally titled “The Professional Irish Broker”, which name continued to be used up to Issue 35 of winter 2011, when it then appeared for the first time under a new title - “The Broker”.

26. Ms. Coldrick referred to the statement made by Mr. Kelly that the rebranding was “...*part of this ongoing branding initiative involves the promotion of the financial broker brand*” (emphasis added by Ms. Coldrick). She expressed she is at a loss to understand why the Opponent did not rebrand its magazine as “The Financial Broker”, which would have been in keeping with the Applicant’s declared new branding initiative. She says PIBA were aware at all times of the position *vis-à-vis* the trade magazine owned by the Applicant.

27. Ms. Coldrick declares she is also at a loss as to how Diarmuid Kelly can possibly declare anything about the constitution of the editorial board of the Applicant’s magazine as he has never sat on the board. It is wholly incorrect for Mr. Kelly to say editorial control of Irish Broker magazine rests with members/owners/management of members of the IBA, when Paul Gibson, Managing Director and shareholder of Holyrood Publications Limited is the Chairman of the editorial board. In any event this issue has nothing to do with the merits of the application before the Controller.

28. Ms. Coldrick states that, contrary to the claims by the Opponent, the motive behind the application is solely to protect the Applicant’s interest, investment and goodwill in the “Irish Broker” magazine which is also commonly known in the industry as “The Broker” and/or “Broker” magazine. As regards the contents of correspondence between the parties in March 2012, the Applicant reserves its position in respect of same, but these are not matters for the Controller to adjudicate upon.

Rule 22 Evidence

29. Evidence submitted by the Opponent in reply to the Applicant’s Rule 21 evidence consisted of a second Statutory Declaration, dated 9 July 2013, of Diarmuid Kelly and 2 accompanying exhibits “DK1” and “DK2”.

30. The focus of Mr. Kelly’s evidence this time round is the statement made in Linda Coldrick’s Statutory Declaration wherein Ms. Coldrick declares she is at a loss to

understand why the Opponent did not rebrand its trade magazine as “The Financial Broker” in keeping with the Opponent’s brand initiative outlined in the Opponent’s evidence submitted under Rule 20. Mr. Kelly points out the full legal name of the Opponent is Professional Insurance Brokers Association Limited, and attaches at Exhibit “DK1” a printout from the Companies Registration Office attesting to the registration of the company. He also provides, at Exhibit “DK2”, extracts from the Consumer Protection Code 2012, concerning how and in what circumstances the terms “Insurance Broker”, “Broker” and “Financial Broker” can be used.

The Hearing

31. The Opponent was represented by John Kelly BL, instructed by Keith Smyth of Smyth Solicitors and the Applicant by Alison Boydell, Trade Mark Attorney of Anne Ryan & Company. Mr. Kelly argued that nothing turns on the ownership of the magazines at the heart of the matter, or on the application being in the name of Holyrood Publications and not in the name of IBA. There are two organisation – PIBA and IBA, and two publishing companies producing their respective trade magazines.

32. Mr. Kelly pointed out the contents of Exhibit “DK5” is the only independent evidence produced that is directly relevant to these proceedings and this evidence attests to marketplace acceptance of the differences between “The Broker” and “Irish Broker” magazines. All correspondence refers to “The Irish Broker” and not the colloquial term claimed to be used by the Applicant. All references to the Applicant’s magazine being referred to as “The Broker” are only in respect of use by the Applicant of that term. On the relevant date the Opponent had a magazine titled “The Broker” not the Applicant. If the Applicant rebranded its magazine to that title it would cause confusion in the marketplace. The Applicant, in knowing the Opponent already used the term on its magazine, was acting in bad faith when it lodged the application.

33. The main pillar of Mr. Kelly’s argument was that the Applicant has no intention of using the trade mark “*The BROKER*”, and its only motive in applying for the registration is to block the Opponent from continuing to use that term on the Opponent’s trade magazine. Therefore, in Mr. Kelly’s view this was a classic case of a so-called “ghost” application. He directed my attention to the UK Royal Courts of

Justice judgement in *Imperial Group Limited –v- Philip Morris & Company Limited*¹ wherein the Court found that the plaintiff, in wishing to use the word MERIT as a trade mark, and in recognising that the term was laudatory and unregistrable, sought to gain entry in the UK Trade Mark Register with the highly similar mark NERIT, in an attempt to ensure the mark MERIT could not be used by another trader for tobacco products, but would be held in reserve for future use by the plaintiff. The Court found that, while the plaintiff produced and sold some cigarettes bearing the NERIT brand, what use was made of the mark did not constitute *bona fide* use, insofar as the use was not genuine use in the course of trade. The Court found the use of the mark was for an ulterior and independent objective of blocking use by another of the mark MERIT. Mr. Kelly argued the circumstances in the NERIT case were repeated here.

34. He also drew my attention to *Unilever –v- The Controller*² in *SunSmile* where Smyth J. had this to say: “*In my judgment the more correct approach is that expressed by the Controller in PHONENAMES LIMITED -v- 1-1800 FLOWERS INC. of 7 February 2006 wherein (inter alia) he stated: ‘It is well established that person must have a present and definite intention to use a trade mark at the time of applying for its registration, citing in support Batt’s and Ducker’s case and Imperial -V- Philip Morris (NERM) [1982] F.S.R. 72.’ In my judgment this is the correct approach to take to an application for registration of a trade mark. In the course of his opinion in Imperial Group Ltd. -v- Morris [1982] Fleet Street Reports p 72 at p 80 Shaw L.J. stated: ‘Unlike a copyright, a trade mark does not arise from the mere use of a word or words or a formula or a mark; it derives from the use of words or marks in relation to a course of trade in goods giving rise to a goodwill connecting the trader with the goods by reason of the trade mark under which the goods are marketed. It follows that where, in relation to particular goods, there is no such course of trading as to give rise to a goodwill, there is no interest to be protected by a trade mark...’ If there is no real or genuine intention, there is the risk that the purposes of the Act could be defeated, as speculative applications could be made to block off the Register.” Again, Mr. Kelly maintained the circumstances that arose in *SunSmile* are being repeated here.*

¹ *Imperial Group Limited v Philip Morris & Company Limited* [1982] FSR 72

² *Unilever v The Controller* [2006] IEHC 427

35. Mr. Kelly argued the Controller cannot just look at Section 37(2) of the Act and accept, without question, the Applicant's declared intention to use the mark for which registration is sought. The Applicant was acting in an underhanded way in applying to register the mark without notifying the Opponent when the Applicant knew the mark was being used by the Opponent. It is not necessary to prove the Applicant was engaged in anything unlawful, it is sufficient to prove the Applicant acted in bad faith. He argued the test in Ireland is not as arduous as that in the United Kingdom where a degree of fraud may have to be proven.
36. In reply Ms. Boydell argued the Applicant did not act in bad faith. An allegation of bad faith is akin to an allegation of fraud and, as such, should not be made lightly. The bar for proving bad faith must be set fairly high. Other than accusing the Applicant of making a "ghost" application the opponent has not provided any evidence of bad faith or fraud. The Applicant has applied for registration in respect of a very narrow specification of goods, namely "*Insurances and financial services publications*" in Class 16. This is precisely the area of business the Applicant is engaged in and, the act of seeking registration for a mark in respect of this specialised area of publishing cannot, in any reasonable way, be deemed bad faith.
37. Ms. Boydell argued the Applicant has goodwill and a reputation in the names "The Broker" and "Broker", given the evidence of articles dating back as early as 1998. She argued that very few people use the full formal name of publications when referring to them. She gave the Irish Independent as an example of a publication that is colloquially known as the "Independent" or the "Indo". She points to the fact that, in his Statutory Declaration on behalf of the Opponent, Diarmuid Kelly refers to that publication as the "Independent" and does not use its full name the "Irish Independent". She argues that it is usual for Irish people to drop the "Irish" term when referring to that newspaper. Likewise, it would be usual for readers of the "Irish Broker" magazine to drop the "Irish" element of the name, given that it is an Irish publication distributed within the State.
38. Ms Boydell suggested that should a third party publish a competing newspaper under the title "Independent" or the title "Indo", it is highly likely that Independent Newspapers Marketing Limited would consider that party to be attempting to trade off

its goodwill and reputation in its “Irish Independent” and would request that the third party cease to use the title. She also suggested that most reasonable people would consider an application by Independent Newspapers Marketing Limited to register the term “Independent” or “Indo” as trade marks for newspapers as being an act of good faith, as these are the commonly used colloquial titles for the “Irish Independent”. The Applicant did precisely what any other entity would do to protect its property in similar circumstances. It requested that the Opponent stop using the title on the Opponent’s magazine and sought to protect its brand by applying for registration of “*The BROKER*” as a trade mark.

39. The Applicant is Holyrood Publications Limited and it is the Applicant’s “Irish Broker” magazine that is known colloquially as “the Broker” or “Broker Magazine”. The Applicant is simply seeking to secure registration for a mark that is used in the trade to refer to the title of its magazine. While the Applicant is the owner and publisher of the trade magazine, the Applicant was concerned about the future of its publication should merger talks between the PIBA and IBA prove successful. In such circumstances it was clear to the Applicant that only one trade magazine would survive. For this reason the Applicant had to act very sensitively in relation to what it perceived as the Opponent passing off its publication as that of the Applicant and also throughout these opposition proceedings.

40. Ms. Boydell contended the evidence in Exhibit “DK5”, supposedly supporting the Opponent’s claims that its “Broker “ magazine is not confused in the trade with the Applicant’s magazine, post-dates the relevant date and is irrelevant.

41. Mr. Kelly rebutted Ms. Boydell’s argument and emphasised he was not suggesting there was any attempt at fraud, but, nonetheless, the use by the Applicant of a “ghost” application did entail a certain degree of dishonesty. He argued that constantly repeating the claim “The Broker is synonymous with the Applicant’s magazine” does not make it so – there needs to be some level of supporting evidence.

42. He asked that all references to the Independent newspaper be disregarded as they are no more than pure speculation by Ms. Boydell. He concluded by noting there was no suggestion by the Applicant of its intent to use the mark applied for until it was mentioned in Ms. Boydell’s oral submission. The Opponent’s position is that the

Applicant applied for the mark to block the Opponent from using it and not for the reason the Applicant intended to use the mark itself. In the absence of a clear and unequivocal intention to use the mark the application must be deemed to have been applied for in bad faith.

43. Ms. Boydell concluded by stating there was, and still is, a definite intention by the Applicant to use the mark. There is no dishonesty on the part of the Applicant and the charge of applying for the mark in bad faith must be rejected.

Non Substantive Matters

44. The Opponent maintains that nothing turns on ownership of the parties' magazines or that the application is in the name of Holyrood Publications Limited rather than IBA, the Opponent's competitor. This argument is misguided. The Applicant is Holyrood Publications Limited, a long-established publisher who is the sole proprietor of any goodwill and reputation in printed matter generated by that company, including its Irish Broker magazine. All intellectual property rights attaching to its titles rests solely with the Applicant. It is the Applicant who is seeking to protect its assets and is doing so independently of the IBA. The IBA are not a party to these proceedings. All evidence in support of the application emanates from the Applicant alone. The IBA has been totally silent on the matter. Accordingly, I reject the Opponent's attempts to pitch these proceedings as a conflict between IBA and PIBA.

45. The Opponent argued that the lack of any real proof to support the Applicant's claim of confusion in the marketplace is fatal to the Applicant's case. This is not so. The question of bad faith is independent from whether or not there is, or would be, confusion in the marketplace. Confusion is not a factor I need concern myself with when adjudicating on an opposition grounded on bad faith.

46. The Opponent also claimed the failure on the part of the Applicant to mention, in its letter of 8 March 2012, that the Applicant had, a week earlier on 1 March 2012, filed an application to register the term "*The BROKER*" as a trade mark, further demonstrates the Applicant's bad faith. In my opinion, the Applicant had no obligation, moral or otherwise, to notify anyone of the fact it had applied for a trade mark, even in the circumstances where a dispute regarding the application could be anticipated. The failure to notify the Opponent cannot be deemed to demonstrate the

Applicant was acting in bad faith, or with malice intent, when the application was made.

47. Also, I reject the Opponent's argument that the failure on the part of the Applicant to follow up its warning, contained in its letter of 8 March 2012 to the Opponent, of putting the matter in the hands of its legal representatives, should the Opponent not cease using "The Broker" as the title of the Opponent's magazine, points to bad faith. The text and tone of the said letter was industry-standard and did no more than put the Opponent on notice of the possibility of legal proceedings. The Applicant did not follow up but reserved its right to do so. This is not untypical of how these matters are handled and no weight can be put on it so as to find the Applicant was, at the relevant date, lacking in *bona fides*.

48. In its evidence the Opponent argued the British Independent Brokers Association publishes a magazine called "The Broker" in England and Wales but has not registered the mark with the United Kingdom Intellectual Property Office (UKIPO). The Opponent argued that this is relevant to these proceedings and that any matters relating to the UKIPO are not only of relevance to the matter at hand but are also persuasive and should not be ignored. The Opponent appears to be suggesting that because the title of "The Broker" magazine is not registered as a trade mark in the UK, it should not be registered here. In effect the Opponent is asking the Controller to take into account a matter that has not come before the UKIPO, and to make inferences and reach conclusions based on something that has not happened. The Controller is not obliged to take into account any proceedings before the UKIPO, let alone consider the registration or otherwise of a magazine title as a trade mark in the UK that has not even been the subject of an application to the UKIPO. I am at a loss as to understand how this is relevant to the proceedings at hand, and, accordingly, I reject that line of argument.

Bad Faith

49. Turning now to bad faith and the "intention to use" aspect. At the Hearing Mr. Kelly argued the Controller should not just look at Section 37(2) and, having accepted the Applicant made the declaration necessary to give the appearance of validity to an application, use that declaration as the basis to dismiss any opposition grounded on the

lack of an intention to use the mark, which should be determined in accordance with the provisions of Section 8(4)(b) of the Act, which deals with bad faith.

50. I agree with Mr. Kelly on this point. Section 37(2) of the Act requires an applicant for registration of a trade mark to include in its application a statement that the trade mark is being used, by or with the consent of the applicant, in relation to the goods or services specified in the application, or that the applicant has a *bona fide* intention that it should be so used. The Opponents have raised objection under these provisions, claiming that the Applicant did not have a *bona fide* intention to use the trade mark applied for in relation to the goods of the application. Put simply, the Opponent is claiming the Applicant lied in making its statement that it intended to use the trade mark when it filed the present application for registration. However, the fact is that the application contained the statement required by Section 37(2) and no objection can lie against it based on that provision.

51. Nonetheless, this does not mean that, having made the declaration required by Section 37(2), a lack of intention to use a mark cannot form the basis of an opposition. It can - just not under Section 37(2). The appropriate section to deal with a lack of intention to use a mark is Section 8(4)(b), which deals with bad faith and it is that section I will now address.

52. So far as is material, Section 8(4)(b) of the Act provides that:

“A trade mark shall not be registered if or to the extent that-

...

(a) The application for registration is made in bad faith by the Applicant.”

53. There is no legal definition of “*bad faith*”, but it is accepted that it constitutes dishonesty, including dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. In order to determine whether there was bad faith I must consider the Applicant’s intention at the time it filed the application for registration.

54. In its evidence the Opponent pointed to the launch, in winter 2011, of its rebranded (from “The Professional Insurance Broker” to “The Broker”) trade magazine. The magazine had been published under its old title on a quarterly basis from 2003 to

autumn 2011. The evidence shows the rebranding occurred at precisely the same time negotiations to merge the two broker trade organisations (IBA and PIBA) broke down. By Diarmuid Kelly's own admission, at that stage, relations between the two associations were very poor. These proceedings arose from the decision by the Opponent, at a particularly sensitive time, to rebrand its magazine to a very similar title to the one associated with the Applicant (its chief rival and former potential partner in a merger), or worse still, to a title identical to the colloquial title of the magazine associated with its rival. This resulted in the Applicant taking steps to persuade the Opponent to roll-back the rebranding exercise and also, in order to protect what it saw as its intellectual property, applying for registration of "*The BROKER*" as a trade mark.

55. The Applicant argued that if anyone is acting in bad faith it is the Opponent, who began using a magazine title that is the property of the Applicant. The Applicant maintains it had, on the relevant date, and still has, an intention to use the mark as the title of its publication; a title by which its magazine is already known. It is the Opponent's contention that "The Broker" title was not the property of the Applicant and was free to be used by anyone. The Applicant sought the registration purely to block the Opponent using the "The Broker" title and, as such, it was a so-called "ghost" application.

56. While Diarmuid Kelly is quoted in press cuttings (exhibited by him at "DK3") that he "*...was anxious to maintain a civil relationship between the State's two main broker bodies*", it is fair to say there was no love between the parties. Both sides accuse the other of bad faith. However, I need not concern myself with whether or not the Opponent engaged in any behaviour that would be deemed to fall below accepted standards – these proceedings are solely about the actions and motives of the Applicant.

57. In my opinion there is no question the Applicant is attempting to ensure PIBA does not use the mark "The BROKER". However, so long as blocking another's use of the mark is not the sole motive for the making of the application, there is nothing wrong with that. Trade mark registration grants exclusivity to the proprietor of the mark in question, a consequence of which is the blocking of all others from using the mark. Therefore, I must decide if the Applicant is seeking to merely block the Opponent or has the Applicant applied for the registration of "*The BROKER*" in good faith, which

will have the consequential effect of blocking the Opponent, or anyone else, from using the mark.

58. The Applicant's position is that its trade magazine is already referred to as "The Broker" or "Broker" magazine and is simply attempting to protect its interests in these names. At the Hearing Ms. Boydell asks me to consider what would be the case if, hypothetically, someone other than the proprietor of the "Irish Independent" tried to use either the "Independent" or "Indo" as titles for newspapers. Mr. Kelly argued that I should ignore the request as I would be doing no more than engaging in speculation. I am happy to ignore Ms. Boydell arguments on this point and will not attempt to speculate about what might happen in the hypothetical scenario.

59. However, I cannot ignore what I know to be the case, which is that everyone shortens the titles of publications. In everyday parlance "The Evening Herald" becomes "The Herald", the "Irish Independent" becomes "The Independent" or simply "The Indo" and where I live "The Kilkenny People" is simply "The People". Also "The Cork Examiner" was colloquially known as "The Examiner" before the publishers formally changed the title to the latter, which simply reflected how the newspaper was referred to by the public.

60. Mr. Kelly pointed out that there was no evidence of the claimed colloquial usage of the term "The Broker" in respect of the Applicant's "Irish Broker" magazine, other than in a couple of articles that appeared in the magazine itself. This, he argued, indicated that no-one other than a few people, directly associated with the Applicant's magazine, referred to it as "The Broker" or "Broker Magazine". I do not agree. In using the terms "The Broker" or "Broker" the columnists would not have caused any reader to wonder what magazine was being referred to. Clearly, readers would know the magazine being referred to was "Irish Broker" magazine, which they were reading. Furthermore, it is most unusual for a publication to refer to itself in print as anything other than its full official name. The public may drop the "Irish" part of The Irish Independent or Irish Times, but it is seldom, if ever, dropped when these newspapers are referring to their own titles. The fact that Irish Broker magazine contained articles wherein shortened or colloquial versions of its name are used provides a compelling case that "The Broker" and "Broker" aliases are in common use in the industry in relation to the Applicant's magazine.

61. The Applicant's magazine is a monthly publication which was first circulated in 1983, with nearly 500 editions to date. While the Applicant is the proprietor of the "Irish Broker Magazine" trade mark since 2003, it has used "Irish Broker" as the title of its publication for many years. In my opinion, it would be inconceivable and illogical to find that there is not, and never was, use of the terms "Broker" or "The Broker" in respect of the long-standing publication titled "Irish Broker". I am completely satisfied these names would be commonly used in reference to the Applicant's magazine and that such use predated, by many years, use by the Opponent of "The Broker" on its magazine.

62. The Opponent directed me to a number of cases that dealt with bad faith, and having reviewed them I am satisfied the circumstances of those cases are not repeated here. I am satisfied the Applicant has not applied to register "*The BROKER*" for the sole purpose of blocking use of that term by the Opponent. Nor has the Applicant applied for the registration of a trade mark for which it has no intention of using. In my opinion, the Applicant's trade magazine has been referred to and known as "The Broker" in the trade for some time. I find the Applicant has due cause to use the mark and I accept the Applicant had, at the relevant date, a genuine intention to use "*The BROKER*" as a trade mark in respect of the goods for which registration is sought. Therefore, I must conclude the application does not offend against Section 8(4)(b) of the Act and, accordingly, I dismiss the opposition on this ground.

Passing Off

63. Turning to the ground of opposition that the application is liable to be prevented by the law of passing off and would therefore offend against Section 10(4)(a) of the Act, which is written in the following terms:

"A trade mark shall not be registered if, or to the extent that, its use in the State is liable to be prevented—

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade."

64. At the Hearing Mr. Kelly did not advance any arguments in support of this ground of opposition nor did he formally abandon it. That, coupled with the fact there was no evidence adduced in support of the charge, would ordinarily lead me to dismiss the

charge without much ado. However, because of the particular circumstances of this case I feel it is appropriate to adjudicate on the matter.

65. In her submission at the Hearing Ms. Boydell claims in order for the Opponent to bring a successful case for passing off the Applicant must be passing off their goods as those of the Opponent. As the Applicant has yet to use the title "The BROKER" on their publication there is no case to answer.
66. This is not the correct interpretation of the law. Section 10(4)(a) is not concerned with whether passing off has actually taken place, but is directed towards the question as to whether registration should be permitted and so it is concerned with what would be the situation if the mark applied for was used. In *Miss World Ltd*³ Laffoy J quoted from and applied the three part test formulated by Lord Oliver in *Reckitt & Colman Products Limited v . Borden Inc. & Others*⁴ (the so-called "Jif Lemon" case). In his speech (at p. 880) Lord Oliver said:

"The law of passing off can be summarised in one short proposition, no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying "get-up" (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Second, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. Whether the public is aware of the plaintiff's identity as the manufacturer or supplier of the goods or services is immaterial, as long as they are identified with a particular source which is in fact the plaintiff. For example, if the public is accustomed to rely on a particular brand name in purchasing goods of a particular description, it matters not at all that there is little or no public awareness of the identity of the proprietor of the brand name. Third, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

³ *Miss World Ltd. v. Miss Ireland Beauty Pageant Ltd* [2004] 2 IR 394

⁴ [1990] 1 All ER 873

67. I am satisfied the Opponent has failed to pass any of the three tests required in order for me to determine the charge of passing off in its favour. The Opponent had not built up any discernible goodwill in “The Broker” having, at the relevant date, issued at most three editions of its magazine under that title. There is no evidence of any attempt by the Applicant to pass off its magazine as anything other than its own well-established and widely known magazine, albeit using the commonly-used colloquial title. The Opponent’s rebranded title “The Broker” is far closer to the Applicant’s existing title “Irish Broker” than it is to the Opponent’s old title “The Professional Insurance Broker”. Therefore, in my opinion, if any misrepresentation was liable to occur at the relevant date it would most likely be in the opposite direction to that claimed by the Opponent.

68. If, at the relevant date, both parties were to issue their respective magazines under the same “The Broker” title I have no doubt damage would be done, but not to the Opponent. Therefore, the ingredients for the Opponent to succeed under the law of passing off are not present and I must dismiss the opposition under Section 10(4)(a).

Conclusion

69. For these reasons, I have decided to dismiss the opposition and to allow the Applicant’s mark to proceed to registration.

Dermot Doyle

Acting for the Controller

20 February, 2015