

**DECISION OF THE CONTROLLER of INTELLECTUAL PROPERTY IN
PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

In the matter of an application for registration of Trade Mark No. **263638** and in the matter of an Opposition thereto.


The ViberStore Group Limited

Applicant



Viber Media S.à r.l.

Opponent

The Application

1. On 4 August 2020 The ViberStore Group Limited of 16 Oak Road Business Park, Dublin 12 (hereinafter “the Applicant”) made application (No. TM 2020/01339) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the mark “” as a Trade Mark in respect of “Presentation of goods on communications media, for retail purposes; Presentation of goods and services” ” in Class 35.
2. The application was accepted for registration and advertised accordingly under No. 263638 in Journal No. 2423 dated 28 October 2020.
3. Notice of Opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 22 January 2021 by Viber Media S.à r.l., 2, rue du Fossé/ L-1536 Luxembourg (hereinafter “the Opponent”). The Applicant filed a counter-statement on 9 March 2021.
4. The Opponent, on 31 August 2021, filed by means of a Statutory Declaration under Rule 20, a response in support of their Opposition case. The Applicant, on 9 March 2022, filed by means of a Statutory Declaration under Rule 21, material in support of his case, including four exhibits, reference “A” to “D”.
5. The parties were asked by Official letter on 12 July 2022 to advise whether they wished to attend at hearing or file written submissions in lieu of such attendance pursuant to Rule 25(1) & (2).

6. The Applicant failed to elect to attend at Hearing or to file written submissions in lieu before the date allowed for this, 12 September 2022. The Opponent elected to file written submissions and did so on 24 October 2022.
7. Acting for the Controller, I reviewed the material provided by both sides in support of their respective cases. Following on from this, I decided to uphold the opposition and refuse to allow the application to proceed to registration. The parties were notified of my decision by letter dated 25 May 2023. 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 Rules.
8. In the Notice of Opposition dated 22 January 2021, the Opponent objected to the registration of the applied for mark on the basis that it was in contravention of the provisions of Section 10(2), 10(3), 10(4) and 37(2) of the Trade Marks Act 1996. In support of its position in relation to its Section 10 objections, the Opponent relied on its proprietorship of the earlier marks as listed here:

Registration Number	Mark	Class	Registration Date
IR No. 1172898 designating Ireland		38	24/01/2013
IR No. 1172898 Designating EU		38	24/01/2013
IR No. 1080874 Designating EU	VIBER	38	01/02/2011
IR No. 1283134 Designating EU	VIBERWINK	9	03/12/2015

The applied for mark was said to be similar to the Opponents earlier marks and is seeking to be registered for Class 35 services. These were said to be similar and complimentary to those for which the Opponent's Trade Marks are protected to the extent that there exists a likelihood of confusion on the part of the public which includes the likelihood of association.

The Opponent also claimed that registration of the Mark should be refused as the Applicant has failed to use or have a bona fide intention to use their mark in relation to the goods applied for. This contravenes Sections 37(2) of the Act.

9. In a Counter-Statement dated 9 March 2021, the Applicant emphatically denied each of the grounds on which the Opponent's case is based as outlined in their Notice of Opposition. The existence of a likelihood of confusion between the respective marks was disputed with reference to the well-known criteria for assessing this. Furthermore, the applicant stated that registration of their mark would not offend against any of the provisions of the Trade Marks Act 1996, including Sections 10 and 37 of that Act as instanced in the Notice of Opposition.

Rule 20 Evidence

10. Evidence submitted by the Opponent under Rule 20 consisted of a Statutory Declaration signed by Toshihiko Otsuka, Class A Manager, of Viber Media S.a.r.l dated 27 July 2021. This consisted of a listing of the earlier trademarks on which the Opposition is based, as outlined in the Notice of Opposition referenced above, a summary of the principal communication services covered by the marks through the company's app, references to some leading Irish businesses and organisations who advertise through the app, details of the number of Irish registered users and the income generated through the use of the Viber App in Ireland in the years 2016 to 2020 and links to various Irish news publications containing articles about "Viber" in Ireland.

Rule 21 Evidence

11. The Applicant filed evidence under Rule 21 consisting of a Statutory Declaration signed by Brian Egan, Director of the Viberstore Group Limited and supporting exhibits labelled "A" to "D" dated 2nd March 2022. Mr Egan stated that his company had operated under the "Viberstore" brand since 2011. It operated from a physical premises in Dublin and through a website as a retailer of new, used and repaired mobile phones. Documentation under label "A" was supplied in support of this. Details of the company's turnover were provided for the years 2017 to 2020 and documentation under label "B" was supplied in support of this. Supporting documentation detailing the advertising spend for the period 2014 to 2022 on their brand was supplied under label "C". Details of the company's charitable donations in support of their brand were provided under label "D". Mr Egan concluded his submission by

stating that, in his view, there was no likelihood of confusion between his applied for mark and those cited by the Opponent.

Rule 22 Evidence

12. The Opponent's authorised representative, Toshihiko Otsuka, filed evidence by Statutory Declaration under Rule 22 on 24th May 2022. In this, he stated that the Applicant's evidence in relation to the registration of his company name or business name did not give rise to a proprietary right. Furthermore, the registration of a domain name does not create a legal monopoly. The Opponent went on to state that the claimed use of the Applicant's mark was subsequent to its incorporation date of 7th June 2016. This was, therefore, after the registration dates of the Opponent's cited marks. The Class 35 services for which the Applicant intended to use their mark were held by the Opponent to be vague and not reflective of the claimed use. The Opponent's declaration concluded by comparing the applied for mark with those of his company. He contended that the marks coincided in respect of the word "Viber" which were presented in the same letter design. This would result in a likelihood of confusion in the marketplace and would dilute the reputation and goodwill generated under the "Viber" marks.
13. Both parties were asked on 12th July 2022 to advise if they wished to attend at a hearing or file written submissions in lieu of attending. On 12th September 2022, the Opponent elected to file written submissions in lieu of attending at a hearing and did so on 24th October 2022. The Applicant didn't indicate a preference
14. The Opponent's submissions contained the key aspects of the case from their perspective. This contained a summary of the case made previously in their Notice of Opposition and in their submission filed under Rule 20. The Opponent contended that a comparison of the marks of the Applicant and the Opponent revealed them to be highly similar leading to consumer confusion. This was clear when applying the established principles of well-known EU case law. References to the leading and often referred to cases were included in the submission including Sabel BV vs Puma AG, Case C-251/95, Canon Kabushiki Kaisha vs Metro-Goldwyn-Mayer Inc, Case C-39/97 and others. It was the Opponent's view that their marks as cited are visually highly similar to the Applicant's "ViberStore" mark. The term "Viber" was held to be the dominant and distinctive element of the marks at issue. The inclusion of the descriptive and non-distinctive term "Store" in the Applicant's mark did not

act as a distinguishing element between them. The distinctive term “Viber” was a fanciful term invented by the Opponent and had no English dictionary meaning.

The Opponent further contended that the Class 35 services for which the Applicant was seeking protection, “Presentation of goods on communications media, for retail purposes; Presentation of goods and services.”, was slightly vague. In their view, the Applicant was seeking to secure rights for retail related services as reflected by their actual use of “ViberStore” in the Irish marketplace. It was held that, while these services and the Class 38 services for which the Opponent had protection were not identical they were similar and complementary to each other. In addition, it was held that the Opponent’s Class 9 goods, “Computer application software for mobile devices, namely, software for taking and manipulating digital photographs or videos and for sharing content via messaging apps”, were similar to the Applicant’s Class 35 services.

The Opponent went on to argue that the average consumer of the goods and services contained in the cited and applied for marks was the general public. Aural as well as visual considerations applied in this case and the average consumer could be considered to pay an average degree of attention when selecting the goods or services involved. Due to the similarity between the marks and the respective goods and services, the average consumer would believe that the latter originated from the same or a linked undertaking. This contravened the terms of Section 10(2) of the Act and so the Applicant’s mark should be refused.

The Opponent’s objection under Section 10(3) of the Act was based on the reputation of their mark in Ireland as outlined by the Statutory Declaration with accompanying exhibits filed by Toshihiko Otsuka, Class A Manager, of Viber Media S.a.r.l on 27 July 2021. They stated, in support of their claim, that the “Viber” app has been freely available in Ireland since December 2010 and that there was in excess of 1.8 million registered users in Ireland on 1st January 2020 i.e. 7 months before the Applicant’s filing date for their mark of 4th August 2020. The reputation earned by it is indeed substantial and can support a claim under Section 10(3).

The Opponent argued that the evidence filed by them was sufficient to support their claim that the Applicant’s mark offended against Section 10(4) of the Act for passing off when assessed in relation to the cited marks. Established case law identified three elements for assessment when considering this, whether goodwill existed, risk of confusion between the

marks and whether damage to the Opponent's goodwill by virtue of any such confusion has been established. It was argued that evidence of the goodwill contained in Mr Otsuka's Statutory Declaration proved the goodwill inherent in the Opponent's marks. Due to the similarities between the marks of the respective parties, there was a real risk that consumers would be confused into thinking that the Applicant's services are the Opponent's services. It followed from this that where goodwill is established, and misrepresentation is likely to occur then damage will follow.

The Opponent then proceeded to take issue with some of the claims made in the Statutory Declaration of the Applicant. Registration of a Company or Business name does not give rise to a proprietary right. Equally, registration of a domain name does not create a legal monopoly nor give the registrant any trade mark rights. Furthermore, based on the date of incorporation of the Applicant's company of 7th June 2016, the claimed use of the Applicant's mark is subsequent to the filing dates of the Opponent's marks as submitted previously.

In summary, the Opponent held that their earlier marks are highly similar to the Applicant's mark "ViberStore" and cover similar and complementary services, thus inevitably causing confusion. The Opponent's "Viber" marks are well known and have a reputation in Ireland. The Applicant was attempting to take unfair advantage of that reputation, and this would amount to actionable passing off.

Decision


15. In the Notice of Opposition dated 22 January 2021, the Opponent objected to the registration of the applied for mark on the basis that it was in contravention of the provisions of Section 10(2), 10(3), 10(4) and 37(2) of the Trade Marks Act 1996.
16. Turning to Section 10(2)(b), it is evident that four basic requirements must be met in order for an objection under it to succeed. They are (i) there must be "an earlier trademark", (ii) the mark applied for must be similar to that earlier trade mark, (iii) the goods of the application must be identical with or similar to those in respect of which the earlier trade mark is protected, and (iv) there must be a resultant likelihood of confusion on the part of the public.

17. The first of these conditions is clearly fulfilled in this case. The Opponent's marks were filed prior to 4th August 2020 (the relevant date) and by virtue of Section 11(1)(b) of the Act, are earlier trademarks as against the present application for the purposes of Section 10.

Comparison of the marks

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

19. There is visual, aural, and conceptual similarity between the marks. Visually, the Applicant's

mark, , in my opinion, shares a high level of visual similarity with the earlier marks cited by the Opponent and listed in page 2 above. I would, therefore, assess the level of visual similarity as being high.

20. The dominant element of the Opponent's marks, "Viber" shares a high aural similarity with the first word of the Applicant's mark, "Viber". When compared as a whole, the applied for and cited marks share a high level of aural similarity.

21. The assessment of a mark from a conceptual perspective cannot be carried out in complete isolation from the goods or services covered by the mark. which reinforces the shared conceptual meaning between of the marks. Therefore, I find there is a high conceptual similarity between the marks at issue.

22. Having compared the marks from a visual, aural, and conceptual view I am satisfied that, overall, they share a high level of similarity.

Comparison of the goods and services

23. The Applicant is seeking protection of his mark for “Presentation of goods on communications media, for retail purposes; Presentation of goods and services” in Class 35. Having considered the evidence filed by the Applicant under Rule 21, I am of the opinion that the Applicant’s principal area of interest, as it applies to the present case, is in retail related services. This is reflected by their actual use of “ViberStore” in the Irish marketplace. These services and the Class 38 services for which the Opponent has protection, are not identical but are similar and complementary to each other. In addition, the Opponent’s Class 9 goods, “Computer application software for mobile devices, namely, software for taking and manipulating digital photographs or videos and for sharing content via messaging apps”, are similar to the Applicant’s Class 35 services.

Likelihood of confusion

24. The CJEU guidance to decision-makers, can be summarised as follows: *Imagine a typical purchasing scenario involving the average person who already knows the product sold under the earlier trade mark and ask yourself whether it is likely that he will select and purchase a product bearing the mark put forward for registration in the mistaken belief that it is the product he knows by the earlier mark (direct confusion) or that it is related to that product (indirect confusion by association).* The confusion in question may be direct confusion, whereby the Applicant’s product is mistaken for that of the Opponent, or indirect confusion, whereby the Applicant’s product is associated in the mind of the consumer with that of the Opponent and a common commercial origin is inferred. It is not necessary to find that every consumer would be confused and nor is it sufficient to find that some consumers might be confused in order to refuse registration of a trademark under the section. The question is whether it is likely or unlikely that the average person would be confused during the typical purchasing scenario.

25. In Case No C-251/95, Sabel BV –v- Puma AG and Rudolph Dassler Sport, the CJEU declared that the more distinctive a trademark is, whether inherently or by virtue of the use that has been made of it, the greater will be the likelihood of confusion arising from the subsequent use by another undertaking of a similar mark in relation to similar goods. The Opponent’s marks may be regarded as having a high degree of inherent distinctiveness. They have the capacity to

identify the goods and services for which they are registered as being those of a particular undertaking and thus to distinguish those goods from those of other undertakings.

26. In my opinion, there is a real likelihood that a consumer, who has used the Opponent's goods or services or who has an awareness of them, would, when encountering the Applicant's mark, be liable to be confused or be led to believe that the Applicant's mark is associated with those of the Opponent. I find; therefore, the mark offends against Section 10(2)(b) of the Act and the application must be refused.

Section 10(3)

27. There are a number of conditions which must be fulfilled in order for an opposition to succeed under Section 10 (3) of the Act, which is written in the following terms:

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

28. Firstly, there must be identity or similarity of the marks at issue; secondly, there must be similarity between the respective goods; thirdly, the earlier mark (or marks, as in this case) must have a reputation in the State; fourthly, the use of the later trade mark must be without due cause; and fifthly, that use must take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark

I have already found that the first two conditions have been met – there is a high level of similarity with the Opponent's marks, there is the required similarity in respect of the services applied for. The evidence provided by the Opponent illustrated the reputation of their mark in Ireland. They stated, in support of their claim, that the “Viber” app has been freely available in Ireland since December 2010 and that there was in excess of 1.8 million registered users in Ireland on 1st January 2020 i.e. 7 months before the Applicant's filing date for their mark of 4th August 2020. Considering the foregoing, it is fair to say the Opponent's mark enjoys a reputation in the State support a claim under Section 10(3).

29. I must now consider whether the disputed mark would take unfair advantage of, or be detrimental to, the Opponent's earlier marks. To find in favour of the Opponent on this ground I do not have to find that the Applicant's actions were both unfair and detrimental - it is sufficient that only one of the conditions be met. As regards unfair advantage, in my opinion, the Applicant must have been aware of the Opponent's mark, and the similarity between it and his. In deciding on the name for his mark, the Applicant created the possibility of taking advantage of the reputation of the Opponent's earlier mark by coattailing on the high level of public awareness of it, in order to promote interest in the Applicant's own services. The advantage gained is by way of savings on investment in marketing and advertising of its goods because the Applicant could benefit, in an unfair manner, from the power of attraction of the Opponent's mark and the level of investment by the Opponent in it. Therefore, the application offends against Section 10(3) of the Act and must be refused.

Section 10(4)(a)

30. The final ground of opposition that falls to be considered is under Section 10(4) of the Act, the relevant part of which reads as follows:

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

(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,"

31. In my opinion, the proper application of Section 10(4)(a) insofar as the question of passing off is concerned requires a determination by the Controller as to whether the fundamental ingredients of an action for passing off would be present if the mark for which registration is requested were used in the State by the Applicant. A decision one way or the other on that question does not amount to a finding of fact as to whether there is or has been passing off as that is clearly a matter for the Court to decide in any given case.

32. In order to succeed in its opposition under this Section, the Opponent must establish that the use by the Applicant of the disputed mark in relation to the services covered by the application would, as of the relevant date, have constituted a misrepresentation that those services were the services of the Opponent and that such misrepresentation is calculated to

damage the business, goodwill or reputation of the Opponent (in the sense that this is a reasonably foreseeable consequence) and that actual damage will be caused or will probably be caused. I have already found that the Opponent's marks had a reputation as referred to in Section 10(3). However, there is no evidence that points to the Applicant attempting to pass off or misrepresent his services as those of the Opponent's or of him setting out with an intention to damage the Opponent's business. While I have found that the Applicant was attempting to take unfair advantage of the Opponent's mark, on balance, I find that the Applicant was not seeking to pass off his services as those of the Opponent and therefore I reject the opposition in respect of Section 10(4) of the Act.

33. The Opponent also claimed that registration of the Mark should be refused as the Applicant has failed to use or have a bona fide intention to use their mark in relation to the services applied for. This contravenes Sections 37(2) of the Act.

34. After full consideration of the submissions filed, I could find no evidence to support this contention and so I reject the opposition in respect of Sections 37(2).

35. For the reasons outlined above, I have decided to uphold the opposition and to refuse to allow the mark to proceed to registration based on Sections 10(2)(b) and Section 10(3) of the Trade Marks Act 1996.

John Nolan
Acting for the Controller

10th April 2025