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

In the matter of Trademark Application No. **260590** and an opposition to its registration.

Applicant: 151 Products Limited

Opponent: Neil Moynihan

Application and background

1. On 14 July 2017, 151 Products Limited of The Old School House, 39 Bengal Street, Manchester M4 6AF, United Kingdom ("the Applicant") filed Application No. TM 2017/01549 under Section 37 of the Trade Marks Act, 1996 ("the Act") to register **ELBOW GREASE** for the following goods:
   Class 3: "Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; drain cleaner; preparations for unblocking drains and sinks; toilet cleaners; toilet cleaning gel; cleaning foam; cleaning mousse; degreasers; floor wipes, degreaser wipes and car polishing wipes incorporating cleaning preparations".
   Class 5: "Disinfectants; sanitary preparations; antibacterial wipes; sanitizing wipes; disinfectant sprays".
   Class 21: "Articles for cleaning purposes; scouring pads; brushes; car brushes; wheel brushes; sponges; cleaning sponges; scouring sponges".

2. The application was accepted for publication on the basis of honest concurrent use with Irish Trade Mark No. 150207 and advertised under No. 260590 in Journal No. 2383 dated 17 April 2019.

3. On 4 July 2019, Neil Moynihan of Rochestown, Cork, Ireland ("the Opponent") filed a Notice of Opposition under Section 43 of the Act. The Applicant filed a counterstatement on 3 October 2019.

4. On 1 November 2019, the Applicant requested, under Section 43A(1) of the Act, proof of use of the Opponent's earlier mark, **TM 150207**, during the five years preceding the filing date of the opposed application. On 4 November 2019, the

Office advised that Section 43A did not apply because the application had been filed on 14 July 2017, before that section took effect on 14 January 2019.

5. On 29 June 2020, the Opponent filed evidence supporting the opposition by statutory declaration under Rule 20, with nine exhibits labelled "NM1" to "NM9". On 20 July 2021, the Applicant filed evidence supporting the application by statutory declaration under Rule 21, with four exhibits labelled "1" to "4".

6. On 22 July 2022, the Opponent filed a statutory declaration under Rule 22 responding to the Applicant's Rule 21 evidence, with two exhibits labelled "NM1" and "NM2".

7. By official letter dated 21 September 2022, the parties were asked whether they wished to attend a hearing or file written submissions instead, pursuant to Rule 25(1) and (2).

8. Both parties elected to attend and were present at the hearing over which I presided on 9 October 2024.

9. Acting for the Controller, I considered the parties' evidence and arguments at the hearing and decided to dismiss the opposition and allow the application to proceed to registration. The parties were notified by letter dated 8 November 2024. At the Opponent's request, I now give the grounds for that decision under Rule 27(2) of the Rules.

Grounds of opposition

10. In the Notice of Opposition dated 4 July 2019, the Opponent alleged that registration would contravene Sections 10(2), 10(3), 37 and 42 of the Act. The objections under Section 10 relied on the Opponent's ownership of the earlier mark, TM 150207.

Parties' submissions

11. **Applicant's evidence.** The Applicant's evidence describes use of ELBOW GREASE in Ireland since 2001, including the commencement of use, sales, distribution channels, promotional activities and commercial scale.

12. The Applicant claims that the parties' marks coexisted for sixteen years before the application was filed. Its cleaning and disinfectant products are sold in Ireland through independent retailers and wholesalers. The evidence includes sales figures for 2010–2018 and sample invoices to Irish companies showing wholesale prices to retailers and wholesalers. An extensive list of companies selling ELBOW GREASE products demonstrates widespread use. The Applicant also provided examples of sales to named Irish companies during 2010–2018, independent retailer promotional material and third-party references to the products.

13. The Applicant submits that its use has been extensive, bona fide and longstanding, and that many years of concurrent trading in Ireland without evidence of actual confusion strongly support registration.

14. The Applicant further submits that its use since 2001 for the goods described above has established a market presence, reputation and goodwill among average Irish consumers. It argues that, as confirmed by the Opponent's evidence, that use has not adversely affected the Opponent's activities and, given both parties' established market presence, there is no logical basis for expecting an adverse effect in future. The Applicant maintains that its conduct has been honest and commercially motivated and satisfies Section 12(1).

15. **Opponent's submissions.** The Opponent argues that the identical marks and overlapping goods make a likelihood of confusion unavoidable, and that registration would encroach on the protection afforded by the earlier registration. The Opponent also contends that the Applicant has not established honest concurrent use for all goods claimed in Classes 3, 5 and 21, that registration would contravene Sections 37 and 42 of the Act, and that the requirements of Section 12(1) are not satisfied for all goods applied for.

Honest concurrent use

16. During examination, the Applicant sought acceptance on the basis of honest concurrent use with the earlier mark. The principal issue is whether the Opponent's earlier registration requires refusal or whether the circumstances justify registration on the basis of honest concurrent use. This requires consideration of all relevant circumstances: the place, time, extent and nature of use, coexistence in the marketplace, the likelihood of confusion and the public interest in permitting concurrent registrations.

17. The IPOI's guidance identifies the following criteria for assessing honest concurrent use.

- **The extent of use in duration, area and volume**

The Applicant must demonstrate honest concurrent use before the filing date of its application.

- **The degree of confusion likely between the trade marks**

Confusion is more likely where the mark is highly distinctive for the goods or services. The greater the likelihood of public confusion, the weaker the Applicant's case.

- **Whether actual confusion has occurred**

The absence of actual confusion strengthens the Applicant's case for honest concurrent use.

- **The honesty or otherwise of the concurrent use**

Use may be honest even where the owner of the earlier mark objects to the application.

- **The relative inconvenience to the parties if the Applicant's mark is registered**

The Controller weighs the relative inconvenience to each party when deciding whether registration on the basis of honest concurrent use is appropriate.

- **Fresh consideration in opposition proceedings**

Acceptance indicates that the mark appears to the Controller to be worthy of registration. In contested opposition proceedings, however, the Controller must assess the matter afresh and is not bound by decisions made during *ex-officio* examination.

Findings

18. I have assessed the opposition afresh, considering all evidence and submissions from both parties rather than treating acceptance during examination as binding.

19. The marks are identical, and the specifications overlap in certain goods, particularly in Class 3. Ordinarily, identical marks used for identical or similar goods would weigh heavily in favour of a likelihood of confusion. This case, however, also requires consideration of the evidence of longstanding concurrent use.

20. The evidence establishes use of ELBOW GREASE in Ireland over a lengthy period and on a substantial commercial scale. I am satisfied that the Applicant's adoption and use were honest. No evidence supports a finding of bad faith or an intention to appropriate the goodwill of the Opponent's business.

21. I am also satisfied that the Applicant's use has been open, continuous and commercially significant. The evidence of its place, time, extent and nature establishes a compelling case of genuine concurrent trading.

22. The parties traded under ELBOW GREASE for their respective goods in Ireland for approximately sixteen years before the application was filed. The Applicant's sales material covers 2010–2018, while the claimed sixteen-year period of pre-filing coexistence runs from 2001 to the filing date, 14 July 2017.

23. The absence of evidence of actual confusion is relevant, although not decisive on its own. Despite the lengthy period of concurrent use, there is no evidence before me of meaningful or sustained consumer confusion. I attach considerable weight to that absence: had significant confusion occurred, some evidence could reasonably have been expected to emerge during approximately sixteen years of coexistence.

24. Taking the evidence, I am satisfied that the public has been able to distinguish the commercial origins of the parties' goods despite the identity of the marks.

25. On my assessment of the opposition, I find that registration on the basis of honest concurrent use is justified by the evidence. That evidence also supported acceptance of the application during examination.

Conclusion and decision

26. I have considered the Opponent's arguments concerning the identical marks and similar goods. Each case must be assessed on its own facts. Here, substantial, honest and longstanding concurrent use, together with the absence of evidence of actual confusion during approximately sixteen years of coexistence, persuades me that registration is warranted.

27. I am satisfied that registration of Trade Mark Application No. 260590 will not give rise to a likelihood of confusion sufficient to justify refusal. Having considered all submissions from both parties, I find that the Opponent has not established grounds sufficient to prevent registration.

28. For these reasons, I dismiss the opposition and allow Trade Mark Application No. 260590, ELBOW GREASE, to proceed to registration for the goods applied for in Classes 3, 5 and 21.

John Nolan
Acting for the Controller
Intellectual Property Office of Ireland

6th November 2026