

O-213-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2396544 IN THE NAME OF
PATRICK MELLY TO REGISTER THE TRADE MARK FINE GAEL IN
CLASS 35**

AND

**OPPOSITION THERETO UNDER NO. 93974 IN THE NAME OF
FINE GAEL**

Trade Marks Act 1994

**IN THE MATTER OF application No. 2396544
in the name of Patrick Melly
to register the trade mark Fine Gael in Class 35**

And

**Opposition thereto under No. 93974
in the name of Fine Gael**

BACKGROUND

1. On 11 July 2005, Patrick Melly made an application to register the trade mark FINE GAEL in Class 35 in relation to the following specification of services:

Class 35 Business administration, office functions.

2. On 9 December 2005, Fine Gael filed notice of opposition to the application, the grounds of opposition in summary being as follows:

- 1. Under Section 3(6)** because the application was made in bad faith.
- 2. Under Section 3(3)(b)** because it would deceive the public as to the services being offered under the mark.
- 3, Under Section 5(4)(a)** by virtue of the law of passing off.
- 4. Under Section 56** the opponents' long-standing and extensive use of the FINE GAEL name has accorded it the status as a well known, unregistered mark in the UK.

3. The applicant filed a counterstatement in which he accepts that FINE GAEL was established in 1933 as a political party, but denies the grounds on which the opposition is made.

4. Only the opponents filed evidence in these proceedings, which, insofar as it may be relevant I have summarised below. Neither side took up the offer of an oral hearing, the opponents instead electing to rely on written submissions in lieu of a hearing. After a careful study of the evidence and submissions, I now go on to give my decision.

Opponents' evidence in chief

5. This consists of a Witness Statement dated 5 July 2006, from Tom Curran, General Secretary of Fine Gael, a post he has occupied for seven years, having previously been Chief Executive Officer of a national rural youth organisation called Macra na feirme.

6. Mr Curran states that Fine Gael was established as an independent party in 1933 as a successor to the Cumamm na nGaedhael party which is the party that had been in power since 1922 following independence. Exhibit TC1 consists of a copy of a publication entitled "Past, Present, Future", which provides an overview of the commencement and development of the Fine Gael party, its leaders and representatives.

7. Exhibit TC2 consist of a document entitled "Distribution of Seats & Share of the First Preference Vote 1918 – 2002. Mr Curran refers to the column marked "FG" stating that this refers to the percentage of seats held by Fine Gael over the period. He states that he understands the current party membership to stand at approximately 36,000. Mr Curran says that the party has used the FINE GAEL name continuously since its establishment. He refers to Exhibit TC3, which consists of copies of a publication entitled "Eire Ireland 1922-1997 A Salute to the Founders of a Free and Independent Ireland" and "Fine Gael 1923-1987" which he says illustrates the developments over the time.

8. Mr Curran asserts that as a result of the FINE GAEL political party's activities since being established the name has become extremely well known and enjoys a substantial reputation and goodwill, in particular in the UK which has been culturally and inextricably linked to the Republic of Ireland for a number of centuries. He further states that the recognition of FINE GAEL in Northern Ireland will be undoubted given its close geographic and political history, and the significant percentage of Irish living in the UK will confirm wide recognition of this name throughout the country.

9. Mr Curran says that the party has used the FINE GAEL name in respect of a range of services of the kind provided by a political party, and he believes that the general public would be aware of the activities and issues that form the crux of a party's political agenda. Exhibit TC4 consists of copies of election materials used in 1954, 1977 and 1981, which Mr Curran says illustrate the political ideals and objectives of the party over this period, referring to issues such as taxation, employment, emigration, community services, agricultural and sports issues, with more recent activities being set out in the publications entitled "Fine Gael – Securing your future (1977)" and "Fine Gael – visible justice (2002)" shown as Exhibit TC5. Mr Curran notes that over time the issues have extended to cover topics such as drugs, and criminal issues such as sex offenders. Exhibit TC6 consists of a publication entitled "21 Century Fine Gael", Mr Curran referring to the appendices that details the percentage of seats secured by FINE GAEL over the period 1922 – 2002 against a share of the preference votes.

10. The remainder of Mr Curran's Statement consists of submissions on the relative merits of these proceedings. As Exhibit TC7 he shows the details of two applications made by the applicant in these proceedings, to register SINN FEIN and FIANNA FAEL,

both being the names of well known political parties in Ireland. He also refers to Exhibit TC8 which consists of a letter from the applicant's representatives, Mr Curran stating that it is clear from the spirit and purport that the applicant is trying to obtain financial or commercial advantage from the opponents. Exhibit TC9 consists of details of companies, Fiene Gael Limited, Fianna Fail Limited and Sinn Fein Limited, Mr Melly being noted as a Director. Exhibit TC10 consists of the details of CTM applications made by Mr Melly, to register FIANNA FAIL and FINE GAEL.

11. That completes my summary of the evidence insofar as it may be relevant to these proceedings.

Decision

12. Turning first to the ground under Section 5(4)(a) of the Act. That section reads as follows:

“5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom 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, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark”.

13. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] R.P.C. 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

(1) that the opponents' goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponents; and

(3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicant's misrepresentation.”

14. To the above I add the comments of Pumfrey J in the *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* case, in which he said:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472).

Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

15. The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. The relevant date may therefore be either the date of the application for the mark in suit (although not later), or the date at which the acts first complained of commenced, as per the comments in *Cadbury Schweppes Pty Ltd v The Pub Squash Co Pty Ltd* [1981] RPC 429.

16. The starting point is to ascertain whether the opponents have goodwill in the name FINE GAEL. In *IRC v Muller and Co's Margarine* [1901] AC 217 at 223, Lord Macnaughton explained what is meant by “goodwill” in the following terms:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

17. The applicant accepts that FINE GAEL is the name of a political party established in 1933. However, the act of creating a name does not, of itself, bring the inventor any rights. In the decision in *Harrods Limited v Harrodian School Limited* [1996] RPC 697, Millett LJ at paragraph 791 stated:

“It is well settled that (unless registered as a trade mark) no one has a monopoly in his brand name or get up, however familiar these may be. Passing off is a wrongful invasion of a right of property vested in the plaintiff; but the property

which is protected by an action for passing off is not the plaintiff's proprietary right in the name or get up which the defendant has misappropriated but the goodwill and reputation of his business which is likely to be harmed by the defendant's misrepresentation."

18. Being a political party means that the opponents are not a commercial organisation in the normal sense of the word. They do not trade in goods or provide services in return for payment. Consequently, they offer no tangible benefits from which they could be said to create an attractive force that brings them custom. The position of a political party in a passing off action was considered in *Keane v McGiven* [1982] F.S.R. 119 CA. In that case, Ackner LJ stated:

"The property which is said to be injured in that situation is not the name or the description of the goods but the right to the goodwill of the business which results from the particular commercial activity. Therefore the courts do not in general interfere to protect a non-trader. I hasten to add that of course the word "trade" is widely interpreted and includes persons engaged in a professional, artistic or literary occupation.

Thus the action lies where there is a real possibility of damage to some business or trading activity. Therefore the plaintiff must establish that in some sense he is carrying on a business with which the trade or public will be led to associate the defendant's activities.

In this case, as Mr. Kean very frankly accepted at the outset of his carefully set out submissions, we are not concerned with goods or with a business; nor was Mr. Kean able to say in the course of his submissions that there were any commercial activities carried on by what I refer to as his party. Of course his party may wish from time to time itself to enter into contracts for the hire of a hall or other facilities necessary for the operation of a political party, but that is not involving itself in a commercial activity in the sense which I have indicated. Such being the case, although Mr. Kean understandably drew our attention to a number of authorities which dealt with circumstances in which confusion can arise--circumstances in which despite the narrowness of the locality the remedy can still operate--he was unable to draw our attention to any situation where the remedy of bringing a passing off action has operated in a situation where there was no trade in the widest meaning of that word; no commercial activity carried on.

Accordingly, in my judgment, there is no basis in this case for a claim based upon the tort of passing off. The situation is simply that a non-commercial activity--a political party--is seeking to use the same name, the same initials, as a very small other such party with, so we are told, somewhat similar values and ideals. It does not provide a situation, in my judgment, in which there is any basis for contending that a tort has occurred, and in those circumstances in my judgment the learned judge was perfectly right to refuse an injunction."

19. The courts have nevertheless been prepared to protect the goodwill of a charity: See *British Legion v British Legion Club (Street) Limited* [1931] 48 RPC 555 at 562. In that case there was conclusive evidence that the plaintiffs had made extensive use of the name, and that it was widely known as a charitable organisation of some standing. In the *British Diabetic Association v The Diabetic Society* [1996] F.S.R. 1, Walker J stated:

“I conclude, therefore, that the scope of a passing off action is wide enough to include deception of the public by one fund-raising charity in a way that tends to appropriate and so damage another fund-raising charity’s goodwill—that is the other charity’s attractive force’ (see Lord McNaughton in *IRC v Muller and Co’s Margarine* [1901] AC 217, 223) in obtaining financial support from the public.”

20. Whilst I have little doubt that there is some awareness of the name FINE GAEL in the UK, and in Northern Ireland in particular, I have nothing on which to say that they are well known, but even if they were, being known is not the same as possessing goodwill. I have no evidence that relates to the circulation of any of their publications within the UK, that shows them to have conducted fundraising activities within the UK, or that establishes the party has a single, UK based member, fee paying or otherwise. In short, I do not see how they can be said to have any goodwill within the UK, and the ground under Section 5(4)(a) must inevitably fail.

21. Turning next to the ground under Section 3(6) of the Act. That section reads as follows:

“3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

22. In *Gromax Plasticulture Ltd v. Don & Low Nonwovens Ltd* [1999] RPC 367, Lindsay J. considered the meaning of “bad faith” in Section 3(6) of the Act and stated (at page 379):

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances.”

23. In *Harrison v. Teton Valley Trading Co* [2005] FSR 10, the Court of Appeal confirmed that bad faith is to be judged according to the combined test set out by the House of Lords in *Twinsectra v Yardley* [2002] 2 AC 164. Paragraphs 25 and 26 of the Court of Appeal decision are of particular assistance and read as follows:

“25. Lord Hutton went on to conclude that the true test for dishonesty was the combined test. He said:

“36. Therefore I consider that your Lordships should state that dishonesty requires knowledge by the defendant that what he was doing would be regarded as dishonest by honest people, although he should not escape a finding of dishonesty because he sets his own standards of honesty and does not regard as dishonest what he knows would offend the normally accepted standards of honest conduct.”

26. For my part, I would accept the reasoning of Lord Hutton as applying to considerations of bad faith. The words “bad faith” suggest a mental state. Clearly when considering the question of whether an application to register is made in bad faith all the circumstances will be relevant. However the court must decide whether the knowledge of the applicant was such that his decision to apply for registration would be regarded as in bad faith by persons adopting proper standards.”

24. Thus, in considering the actions of the registered proprietor, the test is a combination of the subjective and objective. Furthermore, it is clear that bad faith in addition to dishonesty, may include business dealings which fall short of the standards of acceptable commercial behaviour i.e. unacceptable or reckless behaviour in a particular business context and on a particular set of facts.

25. I am reminded of the comments of Nicholls LJ in the Privy Council judgment *Royal Brunei Airlines Sdn Bhd v. Tan* [1995] 2 AC 378, when he described dishonesty as “...to be equated with conscious impropriety”. This was in the context of accessory liability in the misapplication of trust assets to the detriment of a beneficiary. However, I think the same general principles would apply in trade mark law in the context of the current proceedings. He added:

“In most situations there is little difficulty in identifying how an honest person would behave. Honest people do not intentionally deceive others to their detriment. Honest people do not knowingly take others’ property The individual is expected to attain the standard which would be observed by an honest person in those circumstances. It is impossible to be more specific. Knox J captured the flavour of this, in a case with a commercial setting, when he referred to a person who is “guilty of commercially unacceptable conduct in the particular context involved”: see *Cowan de Groot Properties Ltd v. Eagle Trust Plc* [1992] 4 All ER 700 at 761. Acting in reckless disregard of others’ rights or possible rights can be a tell-tale sign of dishonesty. An honest person would have regard to the circumstances known to him, including the nature and importance of the proposed transaction, the nature and importance of his role, the ordinary course of business, the degree of doubt Ultimately, in most cases, an honest person should have little difficulty in knowing whether a proposed transaction, or his

participation in it, would offend the normally accepted standards of honest conduct.”

26. In the Privy Council judgment in *Barlow Clowes International Ltd v. Eurotrust International Ltd* [2005] UKPC 37, their Lordships took the opportunity to clarify the speculation that *Twinsectra* had changed the law. The judgment confirmed the House of Lords’ test for dishonesty that had been applied in *Twinsectra*, i.e. the combined test, and clarified their Lordships’ statement of that test by making it clear that an enquiry into a defendant’s views as regards normal standards of honesty is not part of the test.

27. The applicant does not deny that he is aware of the longstanding use of FINE GAEL by the opponents as the name for a political party in Ireland, but does that make the act of applying to register it as a trade mark in the UK an act of bad faith? In the *Daawat* trade mark case [2003] RPC 11, the appointed person held as follows:

93 As noted in para.14 of the principal hearing officer's decision in the present case, the First Cancellation Division in its Decision in the BE NATURAL case (October 25, 2000) adopted the view of UK Trade Marks Registry that a finding of bad faith could properly be made:

"Where the applicant was aware that someone else intends to use and/or register the mark, particularly where the applicant has a relationship, for example as employee or agent, with that other person, or where the applicant has copied a mark being used abroad with the intention of pre-empting the proprietor who intends to trade in the United Kingdom."

28. This is a situation where the name exists, and is focussed on a different jurisdiction where its sole purpose is as the banner for a political party. The name has been in existence since 1933, ample time for any exploitation, and/or registration as a trade mark, yet there is no evidence that they have, or ever intended to use it in any commercial sense within Ireland, let alone the UK. There is no evidence of the opponents having used the name in the UK, or any of their publications having reached these shores, nor any claim to having a single UK member. If the name has had any exposure within the UK it can only be through events such as media news reports.

29. Given his admitted awareness of the FINE GAEL name, the letter shown as Exhibit TC8 more than suggests that the applicant is looking to make some financial gain through its registration. However, in seeking registration of FINE GAEL as a trade mark with the apparent intention of using it in connection with a trade in the services of business and office functions, the applicant is not ultimately depriving the opponents of their name, or the right to use it in the furtherance of their political aims. Nor is there any evidence that he will be hindering or pre-empting the opponents intentions in respect of the name. The opponents may well carry on business and office related activities in the running of the party but that is not what they are known, or use the name for. In all of the circumstances I do not see how I can find that the application is an act of bad faith and this ground is dismissed.

30. Turning next to the ground under Section 56 of the Act protecting well known marks. That section reads as follows:

“56.(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark are to a mark which is well-known in the United Kingdom as being the mark of a person who-

(a) is a national of a Convention country, or

(b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country, whether or not that person carries on business, or has any goodwill, in the United Kingdom. References to the proprietor of such a mark shall be construed accordingly.”

31. This provision has to be read in conjunction with the following sections of the Act:

6.(1) In this Act an ‘earlier trade mark’ means –

...

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

and

55.(1) In this Act –

(a) ‘the Paris Convention’ means the Paris Convention for the Protection of Industrial Property of March 20th 1883, as revised or amended from time to time,

(aa) ‘the WTO agreement’ means the Agreement establishing the World Trade Organisation signed at Marrakesh on 15th April 1994, and

(b) a ‘Convention country’ means a country, other than the United Kingdom, which is a party to that Convention.

32. The opponents are both nationals of, and resident in a convention country.

33. The first question I shall address is whether the name FINE GAEL is actually a trade mark. Summarising the points made by Richard Arnold QC sitting as the Appointed person in the *Le Mans* case (BL O-012-05), all that Section 1(1) of the 1994 Act and

Article 2 of the Directive require of a trade mark is that it be capable of distinguishing goods or services of one undertaking from those of other undertakings. The European Court of Justice have indicated that Article 2 requires no more than the sign be generally capable of distinguishing without reference to any particular goods or services, whereas Article 3(1)(b) (corresponding to section 3(1)(b) of the 1994 Act) requires that the mark be capable of distinguishing the particular goods or services in question. For the purposes of Article 3(1)(b), it is sufficient that the sign should be regarded by a significant proportion of the average consumers in such a way that does, in fact serve to distinguish the goods or services of one undertaking from those of other undertakings. There is no additional requirement that the average consumer should appreciate that the sign is a trade mark (although if it is shown that consumers do appreciate that the sign is a trade mark that will obviously be relevant to the assessment of distinctive character). The position can be no different when considering relative grounds of objection to registration.

34. Mr Arnold QC went on to refer to the *PACO/PACO LIFE IN COLOUR* trade marks [2000] RPC 451. In that case the Registrar's hearing officer Mr James held that (a) a trade mark could only be well known in respect of the goods or services in respect of which it has been used, and (b) accordingly PACO RABANNE was not a well-known trade mark for clothing even though it had a reputation in relation to perfume. Mr Arnold went on to say:

“Conclusion (a) is a commonsense proposition of law which counsel for the opponent in the present case accepted.

In reaching conclusion (b) Mr James referred to paragraph 31 of the Opinion of Advocate General Jacobs in Case C-375/97 *General Motors Corp v Yplon SA* [1999] ECR I-5421. Although it is primarily concerned with Articles 4(4)(a) and 5(2) of the Directive, I think it is worth quoting the relevant section of the Opinion in full:

“30. Both in the proceedings before the Court, and in general debate on the issue, attention has focused on the relationship between ‘marks with a reputation’ in Article 4(4)(a) and Article 5(2) of the Directive and well-known marks in the sense used in Article 6*bis* of the Paris Convention for the Protection of Industrial Property. Well-known marks in that sense are referred to in Article 4(2)(d) of the Directive.

31. General Motors, the Belgian and Netherlands Governments and the Commission submit that the condition in the Directive that a mark should have a ‘reputation’ is a less stringent requirement than the requirement of being well known. That also appears to be the view taken in the 1995 WIPO Memorandum on well-known marks.

32. In order to understand the relationship between the two terms, it is useful to consider the terms and purpose of the protection afforded to well-

known marks under the Paris Convention and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs). Article 6*bis* of the Paris Convention provides that well-known marks are to be protected against the registration or use of a ‘reproduction, an imitation, or a translation, liable to create confusion’ in respect of identical or similar goods. That protection is extended by Article 16(3) of TRIPs to goods or services which are not similar to those in respect of which the mark is registered, provided that use of the mark would ‘indicate a connection between those goods or services and the owners of the registered trade mark and provided that the interests of the owner of the registered trade mark are likely to be damaged by such use’. The purpose of the protection afforded to well-known marks under those provisions appears to have been to provide special protection for well-known marks against exploitation in countries where they are not yet registered.

33. The protection of well-known marks under the Paris Convention and TRIPs is accordingly an exceptional type of protection afforded ever to unregistered marks. It would not be surprising therefore if the requirement of being well-known imposed a relatively high standard for a mark to benefit from such exceptional protection. There is no such consideration in the case of marks with a reputation. Indeed as I shall suggest later, there is no need to impose such a high standard to satisfy the requirements of marks with a reputation in Article 5(2) of the Directive.

34. The view is supported by at least some language versions of the Directive. In the German text, for example, the marks referred to in Article 6*bis* of the Paris Convention are described as ‘notorisch bekannt’, whereas the marks referred to in Article 4(4)(a) and Article 5(2) are described simply as ‘bekannt’. The two terms in Dutch are similarly ‘algemeen bekend’ and ‘bekend’ respectively.

35. The French, Spanish, and Italian texts, however, are slightly less clear since they employ respectively the terms ‘notoirement connues’, ‘notoriamente conocidas’, and ‘notoriamente conosciuti’ in relation to marks referred to in Article 6*bis* of the Paris Convention, and the terms ‘jouit d’une renommée’, ‘goce de renombre’, and ‘gode di notorietà’ in Article 4(4)(a) and Article 5(2) of the Directive.

36. There is also ambiguity in the English version. The term ‘well known’ in Article 6*bis* of the Paris Convention has a quantitative connotation (the *Concise Oxford Dictionary* defines ‘well known’ as ‘known to many’) whereas the term ‘reputation’ in Article 4(4)(a) and Article 5(2) might arguably involve qualitative criteria. The *Concise Oxford Dictionary* defines reputation as ‘(1) what is generally said or believed about a person’s or thing’s character or standing...; (2) the state of being well thought of; distinction; respectability;... (3) credit, fame, or notoriety’.

Indeed it has been suggested that there is a discrepancy between the German text compared with the English and French texts on the grounds that the 'reputation' of a trade mark is not a quantitative concept but simply the independent attractiveness of a mark which gives it an advertising value.

37. Whether a mark with a reputation is a quantitative or qualitative concept, or both, it is possible to conclude in my view that, although the concept of a well-known mark is itself not clearly defines, a mark with a 'reputation' need not be as well known as a well-known mark.””

The Advocate General refers in one of his footnotes to Mostert. Mostert at 8- 17 suggests the following criteria derived from a number of sources for assessing whether a mark is well-known:

- (i) the degree of recognition of the mark;
- (ii) the extent to which the mark is used and the duration of the use;
- (iii) the extent and duration of advertising and publicity accorded to the mark;
- (iv) the extent to which the mark is recognised, used, advertised, registered and enforced geographically or, if applicable, other relevant factors that may determine the mark's geographical reach locally, regionally and worldwide;
- (v) the degree of inherent or acquired distinctiveness of the mark;
- (vi) the degree of exclusivity of the mark and the nature and extent of use of the same or a similar mark by third parties;
- (vii) the nature of the goods or services and the channels of trade for the goods or services which bear the mark;
- (viii) the degree to which the reputation of the mark symbolises quality goods;
- (ix) the extent of the commercial value attributed to the mark.

59. In September 1999 the Assembly of the Paris Union for the Protection of Intellectual Property and the General Assembly of the World Intellectual Property Organisation (WIPO) adopted a Joint Recommendation concerning Provision on the Protection of Well-Known Marks. Article 2 of the Joint Recommendation provides:

(1)(a) In determining whether a mark is a well-known mark, the competent authority shall take into account any circumstances from which it may be inferred that the mark is well known.

(b) In particular, the competent authority shall consider information submitted to it with respect to factors from which it may be inferred that the mark is, or I not, well known, including, but not limited to, information concerning the following:

1. the degree of knowledge or recognition of the mark in the relevant sector of the public;
2. the duration, extent and geographical area of any use of the mark;
3. the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
4. the duration and geographical area of any registration, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark;
5. the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well known by competent authorities;
6. the value associated with the mark.

(c) The above factors, which are guidelines to assist the competent authority to determine whether the mark is a well-known mark, are not pre-conditions for reaching the determination. Rather, the determination in each case will depend upon the particular circumstances of that case. In some cases all of the factors may be relevant. In other cases some of the factors may be relevant. In still other cases none of the factors may be relevant, and the decision may be based on additional factors that are not listed in subparagraph (b), above. Such additional factors may be relevant, alone, or in combination with one or more of the factor listed in subparagraph (b), above.

(2)(a) Relevant sectors of the public shall include, but shall not necessarily be limited to:

- (i) actual and/or potential consumers of the type of goods and/or services to which the mark applies;
- (ii) persons involved in channels of distribution of the type of goods and/or services to which the mark applies;
- (iii) business circles dealing with the type of goods and/or services to which the mark applies.

(b) Where a mark is determined to be well known in at least one relevant sector of the public in a Member State, the mark shall be considered by the Member State to be a well-known mark.

(c) Where a mark is determined to be known in at least one relevant sector of the public in a Member State, the mark may be considered by the Member State to be a well-known mark.

(d) A Member State may determine that a mark is a well-known mark, even if the mark is not well-known or, if the Member State applies subparagraph (c), known, in any relevant sector of the public of the Member State.

(3)(a) A Member State shall not require, as a condition for determining whether a mark is a well-known mark:

(i) that the mark has been in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, the Member State;

(ii) that the mark is well known in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, any jurisdiction other than the Member State; or

(iii) that the mark is well known by the public at large in the Member State (b) Notwithstanding subparagraph (a)(ii), a Member State may, for the purpose of applying paragraph (2)(d), require that the mark be well known in one or more jurisdictions other than the Member State.”

60. Two points of interest emerge from Article 2 of the Joint Recommendation. The first is that the list of six criteria contained in Article 2(1)(b) is not inflexible, but provides as it were a basic framework for assessment. The second is that *prima facie* the relevant sector of the public consists of consumers of and traders in the goods or services for which the mark is said to be well known.”

35. Setting aside the fact that the opponents’ sign FINE GAEL is not known in respect of any goods or services, does it nonetheless fulfil the other criteria listed as contributing to the finding that it is well-known? I have no doubt that FINE GAEL is very well known in Ireland, but as to the awareness in the UK, I do not know. The most I can say is that it will be known by some, and probably some who would fall within the relevant consumer group for the goods and services covered by the application. The name has had long use in Ireland, and has no doubt been promoted in events such as election campaigns, but in respect of the UK the opponents encounter the same problem of there being no evidence of any use or promotion. Perhaps most surprisingly, there is no evidence of the name having been protected through registration in any jurisdiction, but perhaps this reflects the fact that it is not used in any sort of commercial trade. Whilst there are proceedings ongoing and no doubt pending, there is no track record of successful enforcement of any rights in FINE GAEL, but this may again be a reflection of the fact that as the name of a political party, it is not regarded as having any attractive force for use by others. What is more difficult to gauge is the value associated with the mark. It is no doubt extremely valuable to the political party as the banner under which they present their policies, but commercially this is an unknown quantity. Taking account of all of these factors, I do

not see how I could possibly reach the conclusion that FINE GAEL could be granted protection as a well known trade mark and the ground under Section 56 is also dismissed.

36. This leaves the objection under Section 3(3)(b). That section reads as follows:

“3. - (3) A trade mark shall not be registered if it is-

(a) contrary to public policy or to accepted principles of morality, or

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

37. The opponents’ assertion is that registration of the mark would offend this section of the Act because it is “...of such a nature as to deceive the public as to the kind of services being offered under it...in that it will incorrectly suggest that such services are of a political nature, having that particular characteristics and ideology of **the** Irish political party, or being affiliated with it..” In Ireland the FINE GAEL name will undoubtedly bring to mind the opponents’ political party, and whilst to some in the UK the name might also form a similar sort of association, that is an unknown quantity. As far as I am aware, political parties do not offer services of the type listed. I therefore do not see why there should be any deception in the mind of the consumer of such services. The ground under Section 3(3)(b) is also dismissed.

38. The opposition having failed, the applicant is entitled to a contribution towards his costs. I therefore order that the opponents pay the applicant the sum of £500 towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 31st day of July 2007

**Mike Foley
for the Registrar
the Comptroller-General**