

## TRADE MARKS ACT, 1963

### Decision in Hearing under Section 26

IN THE MATTER OF an application for registration of Trade Mark No. 147222 and in the matter of an Opposition thereto.

SICURI CORPORATION

Applicant

PRIMARK HOLDINGS

PRIMARK STORES LIMITED

Opponents

1. On 19 February, 1992, SICURI CORPORATION, a corporation organised and existing under the laws of the State of Nevada, United States of America, of 5380 S. Valley View Blvd., Suite D., Las Vegas, Nevada, 89118, United States of America, Manufacturers and Merchants, made application (No. 92/0929) to register



as a Trade Mark in Part A of the Register in Class 28 in respect of the following specification of goods:

“Sporting goods, including golf, and tennis equipment  
and accessories therefor.”

2. The Application was subsequently advertised as accepted for registration in Part A of the Register under No. 147222 in Journal No. 1720 on 3 November, 1993.
3. Notice of Opposition to the registration of the mark pursuant to Section 26 of the Act was filed on 1 June, 1994 by PRIMARK HOLDINGS of 47 Mary Street,

Dublin 1 and PRIMARK STORES LIMITED of 68 Knightsbridge, London SW1X 7LR, England. The Applicant filed a counter-statement on 22 August, 1994 and evidence was, in due course, filed by the parties under Rules 37 and 38 of the Trade Mark Rules, 1963.

4. The Opposition became the subject of a Hearing before me, acting for the Controller, on 1 October, 2002. The parties were notified on 19 May, 2003 that I had decided to dismiss the opposition and accept the mark for registration. I now state the grounds of my decision and the materials used in arriving thereat.
  
5. In their Notice of Opposition the Opponents stated as follows:
  - (i) The first and second-named Opponents (hereinafter jointly referred to as the Opponents) are engaged in trade in a wide range of goods, including sports clothing and toys.
  - (ii) The first-named Opponent is the proprietor in the Republic of Ireland of the Trade Marks PRIMARK and PRIMARK PRIMA which are registered in accordance with the particulars set out in the schedule hereto.
  - (iii) The Trade Marks PRIMARK and PRIMARK PRIMA have been substantially and extensively used by the first-named Opponent in the Republic of Ireland and by the second-named Opponent in the United Kingdom. As a result of such use, the Trade Marks PRIMARK and PRIMARK PRIMA are extremely well known throughout the Republic of Ireland and the United Kingdom.
  - (iv) Use by the Applicant of the said mark would lead to the Applicant's goods being passed off as, or mistaken for, the Opponents' goods..
  - (v) The said mark would be disentitled to protection in a Court of Justice and registration thereof would offend against the provisions of Section 19 of the Trade Marks Act, 1963.
  - (vi) Registration of the said mark would contravene the provisions of Section 20 of the Trade Marks Act, 1963.
  - (vii) The Applicant is not the proprietor of the said mark and did not have at the date of application a present and definite intention of using the said mark

in the Republic of Ireland as required by Section 25 of the Trade Marks Act, 1963.

- (viii) The said mark is not a Trade Mark within the definition contained in Section 2 of the Trade Marks Act, 1963 and is not intended to be used as a Trade Mark.
- (ix) The said Mark is not qualified for registration under either of Sections 17 or 18 of the Trade Marks Act, 1963.
- (x) Registration of the said mark would be contrary to the provisions of the EC Harmonisation Directive (Council Directive 89/104/EEC).
- (xi) The Opponents accordingly request that registration of the said mark be refused in the exercise of the Controller's discretion. An award of costs in the Opponents' favour is also requested.

SCHEDULE HEREINBEFORE REFERRED TO

<b>Trade Mark</b>	<b>Registration No.</b>	<b>Journal No.</b>	<b>Class</b>
PRIMARK	83739	1293	25
PRIMARK	83740	1293	24
PRIMARK	95963	1403	20
PRIMARK	112464	1490	21
PRIMARK (script)	85244	1308	24
PRIMARK (script)	85245	1308	25
PRIMARK (script)	95964	1403	20
PRIMARK SHEERFIT	90324	1370	25
PRIMARK and device	103793	1442	25
PRIMARK PRIMA	128786	1612	25
PRIMARK			
FASHION SENSE	140295	1693	25
PRIMARK	140291	1693	22
PRIMARK	140292	1693	24
PRIMARK	140293	1693	27
PRIMARK	140294	1693	24
PRIMARK	137042	1679	08
PRIMARK	137043	1679	09

PRIMARK	137044	1679	11
PRIMARK	137045	1679	12
PRIMARK	137046	1679	26
PRIMARK	137047	1679	28
PRIMARK	137048	1679	30
PRIMARK	137049	1679	31

6. In its Counter-Statement the Applicant stated as follows:

- (i) We have for many years carried on our present business as Manufacturers and Merchants of, *inter alia*, “sporting goods, including golf, and tennis equipment and accessories therefor” (hereinafter called “the said goods”).
- (ii) The Trade Mark which we are applying to register is not liable to be confused with the Opponents’ Trade Marks so as to be calculated to deceive.
- (iii) The Trade Mark which we are applying to register is not liable to be confused with the Opponents’ Trade Marks. The Applicant’s mark is a novel and stylised representation of the word “PRIMA”, which word is sufficiently different and distinct to avoid any probability of deception and confusion even if used for the same goods.
- (iv) Even if the goods for which the Opponents’ Trade Marks are used are the same description of goods in relation to which we use our Trade Mark yet having regard to the goods not being the same goods but different goods and having regard to the differences between our Trade Mark and the Opponents’, there is no probability of confusion or deception arising between the said Trade Marks or of the goods of the Applicant being passed off as or mistaken for the goods of the Applicant (*sic*).
- (v) If the Opponents have used their Trade Marks in connection with sporting goods manufactured and sold by them (which we do not admit), such use is of small extent only and the Opponents have not established any reputation in connection with the manufacture or sale of the said goods under their Trade Marks.
- (vi) The Trade Mark which we are applying to register is inherently and in fact adapted to distinguish our said goods.

- (vii) At the date of our said application, the Trade Mark which we are applying to register was used or proposed to be used by us so as to indicate a connection in the course of trade between the said goods and ourselves as Proprietor of the said Trade Mark.
- (viii) The grounds of Opposition set out in the Notice of Opposition are hereby denied as if the said grounds were set out and traversed *ad seriatum*.
- (ix) We admit the following allegation in the Notice of Opposition:-
  - that PRIMARK HOLDINGS (formerly known as PRIMARK LIMITED) are the Registered Proprietors of the Trade Marks as set out in the Notice of Opposition dated June 1, 1994.

7. Evidence submitted by the Opponents under Rule 37 consisted of a Statutory Declaration (and Exhibits PBP1- PBP14) of Patrick Brendan Prior, Fellow of the Institute of Chartered Accountants, of "Coolmaine", Grove Road, Malahide, Co. Dublin. In his Declaration Mr. Prior states that he is a director of Primark Holdings, Primark Stores Limited and Primark (Northern Ireland) Limited and that these three Primark companies are the parent companies of subsidiaries incorporated in the Republic of Ireland that are concerned with the manufacture and retail of products on which the PRIMARK and PRIMARK PRIMA trade marks are affixed. The three Primark companies and their subsidiaries are wholly-owned subsidiaries of Associated British Foods Plc, a large British public company.

Mr. Prior states that he has been associated with the Primark companies and their predecessor, Pennys Limited, for over 30 years and his duties have included matters relating to the companies' trade marks. The Primark companies operate for retailing purposes in England, Wales, Scotland, Northern Ireland and the Republic of Ireland from very large stores and sell millions of articles of clothing, footwear, textiles, household hardware and general goods. All the stores trade by reference to the trade mark and name "PRIMARK" and a list of the locations of the stores, including 34 in the State, is exhibited. Mr. Prior gives details of total sales of the Primark companies in the United Kingdom and Ireland for the period 1974-1992 including almost €1.5 billion worth of sales in this jurisdiction. He avers that every article sold from the Primark stores bears the PRIMARK trade

mark either on a label or price tag or other form of marking. He also states that the trade mark PRIMA has been used in conjunction with PRIMARK since 1987 and that sales of goods under the mark PRIMARK PRIMA in the Republic of Ireland during the period 1989-1992 amounted to approximately €700 million.

Mr. Prior also gives evidence of advertising and promotion undertaken by reference to the trade marks PRIMARK and, since 1987, PRIMA. Such advertising has been through the media of the press, trade papers, radio and television and the total spend for the period 1974-1992 amounts to more than €30 million. Mr. Prior exhibits copies of advertisements which, he states, have appeared in papers circulating in the Republic of Ireland. (It may be noted in passing that, of the 8 advertisements exhibited, 7 carry the names of retail outlets in Britain or Northern Ireland; the other is from the Evening Herald of 29 September, 1988 and relates to the opening of a store called “PRIMA” at the Phibsboro Shopping Centre in Dublin.)

Mr. Prior goes on to say that goods sold under the PRIMARK and PRIMA brands are placed in bags bearing those marks and he exhibits two samples of PRIMA bags. He also states that the Primark companies trade with not less than 1,600 other companies and that all of the stationery and cheques issued from the Primark companies bear the PRIMARK trade mark, and samples are exhibited. In addition, when a customer purchases goods from one of the Primark stores, the till receipt issued to that person bears the mark PRIMARK or PRIMA thereon – samples dated June, 1995 and marked “PRIMA DUNLAOIRE” are exhibited. Mr. Prior also exhibits copies of sew-in labels and samples of swing tickets that are applied to the Primark companies’ goods; the samples include a number bearing the mark PRIMA combined with other words including COLLECTION, BASICS, CASUALS and SPORT. He also states that PRIMA retailing outlets have the PRIMA name on the fascia and on display cards that are placed on the counters throughout the stores. The goods sold by Primark companies are made by their suppliers in accordance with Primark specifications, including detailed instructions as to the manner in which the trade marks are to be applied to them. Mr. Prior exhibits a part of the form of instructions given to manufacturers in this regard.

Mr. Prior refers also to the facility available to customers of the Primark companies whereby goods purchased in one outlet may be exchanged or returned in another outlet. He says that the operation of this policy has given rise to instances of confusion when persons sought to exchange goods that they thought to have originated from a Primark company but which transpired to be from other traders using similar marks.

Referring to the counter-statement filed in these proceedings, Mr. Prior questions the Applicant's claim to have used the trade mark PRIMA in relation to sporting goods. He states that enquiries made through "Life Style", a company related to the Primark Companies and involved in sports retailing, failed to disclose any instances of the use of the mark by the Applicant. As to the Applicant's denial that there is any potential for confusion between its mark and those of the Opponents owing to the fact that the goods in which they trade are different, Mr. Prior states that it is common for manufacturers and retailers of sports clothing to also sell sports equipment under the same mark and he cites the examples of SLAZENGER, DUNLOP, ADIDAS and UMBRO. This, he maintains, establishes a clear connection between sports clothing and sports equipment in the minds of the public. He then exhibits samples of the sports and leisure wear sold by the Primark companies and bearing the marks PRIMARK and PRIMA. On the basis of the substantial reputation that the Primark companies enjoy in their marks, Mr. Prior contends that registration of the present mark in the name of the Applicant would lead to confusion and would damage that reputation.

Finally, Mr. Prior refers to the fact that the word "prima", meaning first or leading, is laudatory in nature and he asserts that it does not qualify for registration under the provisions of the Trade Marks Act, 1963, as an inherently distinctive trade mark. Nor does he accept that the presentation of the word in a special form of writing in the application for registration bestows any distinctiveness on it as a trade mark.

8. Evidence submitted by the Applicant under Rule 38 consisted of a Statutory Declaration (and Exhibits NB1-NB4) of John N. Baldwin, President of NEVADA

BOB'S PRO SHOP, INC., a corporation organised and existing under the laws of the State of Nevada, United States of America, of 4043 S. Eastern, Las Vegas, Nevada 89119, United States of America. In his Declaration, Mr. Baldwin states that the present Applicant, SICURI CORPORATION, assigned its entire right, title and interest in and to the mark that is the subject of the present application to his company on 1 April, 1995. He states that his company holds a registration for the mark in the United Kingdom dated 17 June, 1987 under No. 1313241 and he exhibits copies of the Certificate of Registration and of a Renewal Certificate, the latter dated 2 June, 1994. Both documents refer to SICURI CORPORATION and it is noted that the specification of goods covered by the registration in question comprises specific items of golf and tennis equipment, including clubs, racquets, balls, bags, etc., all included in Class 28. Mr. Baldwin states that, since 1981, his company or its predecessor has advertised extensively in the magazine "Golf Digest" which, he states, circulates in Ireland, specifically in Dublin. Most of the goods sold by his company are sold through its own retail outlets rather than through other channels.

Mr. Baldwin then outlines the history of the use of the PRIMA mark in relation to sports goods in this jurisdiction since 1985. He states that a U.K. company, MGB Sports, distributed PRIMA sports goods in the U. K. and Ireland during the period 1985-1989 and that approximately €45,000 worth of sale were made in Ireland during that period. He exhibits sample labels, advertisements and other material showing the manner in which the trade mark was used. He then states that a company called Nevada Bob (U.K.) Limited, which I presume to be related to Mr. Baldwin's company, opened its first store in the United Kingdom in February, 1990 and sells an extensive range of PRIMA products, including golf clubs, bags and gloves. Nevada Bob (U.K.) Limited purchased the residual stock of PRIMA products held by MGB Sports during mid-1989, the approximate value of which was €330,000 and which Mr. Baldwin states have since been sold through U.K. and Irish stores, although a breakdown of these sales is not given. Another company, Swanna Limited, trading as Nevada Bob Dublin opened on 14 July, 1994 and Mr. Baldwin states that sales of PRIMA products in Ireland are estimated at €65,000-€130,000 per month.



With regard to advertising and promotion, Mr. Baldwin states that PRIMA products were advertised during 1990/91 in “Golf World” and “Golf Monthly”, both of which publications circulated in Ireland, and that goods bearing the mark are advertised in various other specialist golf publications and in Irish newspapers and on Irish radio. He exhibits samples of a number of specialist golf publications from 1990 and 1991 in which advertisements referring to the mark appear. The majority of these advertisements are for “Nevada Bob’s” and the PRIMA mark is shown along with several other well-known golf equipment brands; in the case of at least one of the advertisements, PRIMA golf equipment is the specific subject matter but an English company called PeterCo Limited is given as the contact point and described as the exclusive distributor for the U.K. and Europe.

Referring to the Statutory Declaration of Patrick Brendan Prior filed as Opponents’ evidence under Rule 37, Mr. Baldwin remarks that his company also sells into the markets serviced by the Primark companies, viz. the United Kingdom and Ireland, and that, despite this, there have been no instances of confusion between his company’s trade mark and those of the Opponents. He states that this is not surprising given that the goods on which his company’s trade mark is used are specialist golf equipment and accessories, which are different from those in which the Opponents trade. As to the fact that enquiries through “Life Style” stores did not disclose use by the Applicant of its mark, Mr. Baldwin comments that his company does not sell through Life Style stores or other general stores but through its own retail outlets. He also refers to the fact that the Primark companies only retail their products under their own-brand PRIMARK label through their own retail outlets and claims that this precludes the possibility of confusion between his company’s goods and those of the Opponents as the respective goods are never offered for sale through the same outlets. Mr. Baldwin also disputes the Opponents’ claim to trade in sports clothing and footwear and states that the articles of clothing exhibited with the Opponents’ Rule 37 evidence would be categorised as leisure wear rather than sports wear.

As to the Opponents’ claim that the word “PRIMA”, being laudatory is not eligible for registration as a trade mark, Mr. Baldwin points out that there are a number of PRIMA marks on the Register, including the Opponents’ registration in

Class 25, which post-dates the application that is the subject of these proceedings. He also refers again to the registration of his company's mark in the United Kingdom where he assumes the Opponents also hold registrations of their marks and, on the basis of this assumption, he asserts that the respective registrations of the Applicant and the Opponents appear to co-exist on the U.K. Register.

9. At the Hearing the Opponents were represented by Mr. Cliff Kennedy of MacLachlan & Donaldson, Trade Mark Agents. The Applicant was not represented, its Agents, FR Kelly & Co, having informed the Office that they had not been given instructions by their client to attend.
10. At the Hearing Mr. Kennedy made arguments in support of the opposition under Sections 2 and 25, Sections 17 and 18, Section 19 and Section 20 of the Act. His submissions may be summarised as follows:

*Sections 2 and 25*

None of the evidence filed by the Applicant shows any proof of use of the mark or intention to use it *by the Applicant*. Rather the evidence suggests that the mark has been and is used by another entity, Nevada Bob's.

*Sections 17 and 18*

The word "Prima" is not invented; it is to be found in the dictionary and, given that it means first or leading, it can be said to have a direct reference to the character or quality of the goods of the application.

*Section 19*

Having regard to the extensive use of the Opponents' marks PRIMARK, PRIMARK PRIMA and PRIMA, the use by the Applicant of the mark PRIMA would be likely to cause confusion.

*Section 20*

The similarities between the trade marks of the Opponents and the mark propounded for registration, together with the similarities between the goods covered by the Opponents' existing registration and those of the present

application (specifically sports clothing), are such that registration of the Applicant's mark would be likely to deceive or cause confusion.

11. I look first at the objections based on Sections 2 and 25 of the Act. The relevant parts of these two Sections are as follows:

Section 2

' "trade mark" means ..... a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark .....';

Section 25

"(1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it must apply in writing to the Controller in the prescribed manner for registration either in Part A or Part B of the register."

The Opponents' contention that the present application does not meet the requirements of these Sections is based on the fact that the application is in the name of an entity called Sicuri Corporation whereas the evidence filed in support of the application shows use of the mark in relation to the goods by a different entity, Nevada Bob's. This matter is addressed in the Applicant's evidence under Rule 38, being the Statutory Declaration of John N. Baldwin in which the deponent states that Sicuri Corporation assigned its rights in the mark to his company, Nevada Bob's Pro Shop Inc., on 1 April, 1995. There is no evidence before me to suggest that, at the time of filing of the present application on 19 February, 1992, the Applicant for registration was not the proprietor of the mark or did not use or propose to use the mark for the purpose of indicating a connection between it and the goods of the application. The fact that the sample advertisements of PRIMA golf equipment exhibited with the Applicant's evidence do not refer to the Applicant by name does not, of itself, cast any doubt on the Applicant's proprietorship of the mark. There is nothing whatever unusual in the

advertisement by a retailer or distributor of goods branded with a manufacturer's trade mark and to infer from such advertisements that the retailer or distributor has a proprietary interest in the relevant trade mark would be preposterous. In the absence of any credible evidence that the Applicant was not, at the date of filing of the application, the proprietor of the mark, I assume that this was in fact the case and I dismiss the opposition under Sections 2 and 25 of the Act.

12. As to the Opponents' objections to the registration of the mark under Sections 17 and 18, the Applicant has correctly pointed out that several marks consisting of or containing the word "PRIMA" have been registered under the Trade Marks Act, 1963. These include the Opponents' registration in Class 25, which post-dates the present application by more than 2 years. While the word "prima" is not invented, it is not an English word and is not commonly used in the English language except as part of composite words or phrases such as "prima donna", "prima ballerina", "prima facie", etc. In my view, it is a word that does not have a **direct** reference to the character or quality of the goods of this application and it is both adapted to distinguish and capable of distinguishing such goods. On this basis, I dismiss the opposition under Sections 17 and 18 of the Act.

13. Turning to Section 19 of the Act, this reads as follows:

"It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of law, or would be contrary to law or morality, or any scandalous design."

The established test for an objection under Section 19 is that set down in the *Smith Hayden & Coy Ltd.* application (1946) [RPC 97], as adapted by Lord Upjohn in the *Bali* case (1969) [RPC 472]. In the present case, this would be applied as follows:

*Having regard to the user of the Opponent's marks, is the Hearing Officer satisfied that the mark applied for, if used in a normal and fair manner in connection with any goods covered by the registration proposed, will not*

*be reasonably likely to cause deception and confusion amongst a substantial number of persons.*

The first matter to be considered, therefore, is the use that has been made of the Opponents' marks, both PRIMARK and PRIMA. In this regard, the Opponents have submitted evidence of use of their marks on a massive scale for a prolonged period dating back some 18 years prior to the date of filing of the present application. Sales of goods bearing the marks have been huge both in value and number and these sales have occurred at retail outlets throughout the State. As a consumer, I am very familiar with the Opponents' PRIMARK trade mark which I believe has, through long and extensive use, become one of the better known brands in use in the field of clothing and footwear retailing. The PRIMA trade mark, used on its own by the Opponents, is perhaps less well known but evidence of significant use of this mark has also been submitted by the Opponents and has not been challenged by the Applicant. In the circumstances, I am satisfied that the Opponents' marks, PRIMARK and PRIMA have been used to a sufficient extent to ground an objection under Section 19.

The Opponents' use of their marks having been established, the onus of proof under Section 19 shifts to the Applicant who is required to show that, notwithstanding that use by the Opponents, use by the Applicant of its mark would not be likely to deceive or cause confusion. The Applicant's arguments in this regard, as set out in its evidence under Rule 38, are (i) that, despite the fact that it has sold goods bearing its mark into the same markets that are serviced by the Opponents, no instance of actual confusion between the respective goods has arisen, (ii) that the differences between the goods in which it trades and those sold by the Opponents are such as to preclude any possibility of confusion between them and (iii) that confusion cannot arise in practice because the Opponents sell goods under their own-brand PRIMARK label only through their own stores and the Applicant's goods would never be offered for sale through those same outlets.

14. The consideration of the opposition under Section 19 (and, indeed, Section 20) requires a comparison both of the respective marks of the parties and of the goods

to which those marks are applied. If those comparisons lead to the conclusion that the use or registration of the Applicant's mark is likely to deceive or cause confusion, then the application must be refused.

#### Comparison of the marks

Looking firstly at the marks of the parties, the Applicant's mark is as shown on page 1 above and I will refer to it as "PRIMA (stylised)": the Opponents' marks are PRIMARK, PRIMARK PRIMA and PRIMA. The use of a stylised form of writing in the Applicant's mark bestows some distinctiveness on it but I regard the degree of distinctiveness thereby achieved as low relative to the overall impression made by the mark, which is essentially the word "prima".

Comparing this, firstly, with the Opponents' PRIMARK, it is evident that the marks, while not identical, are visually and phonetically similar and, as the Opponents have pointed out, the Applicant's mark is contained in full within that of the Opponents. However, when the marks are compared from a connotative aspect, clear differences between them emerge. The Opponents' mark is an invented word whereas the Applicant's is not. In so far as potential consumers may ascribe a meaning to the Opponents' mark, I would suggest that they would be likely to regard it as a contrived conjunction of two words, the second being "mark"; so, for example, it might be taken to signify "prime mark", "primary mark" or even "premium mark". In my view, any interpretation of the meaning of the Opponents' mark is apt to focus on the word "mark" and, to this extent, I regard the impression made in the mind of the consumer by the invented word "primark" to be quite different to that made by the word "prima". Taken together with the admittedly slight, though not insignificant, visual and phonetic dissimilarities between the marks, I consider that this conceptual difference between them is significant in the determination of whether they are confusingly similar.

Turning then to the Opponents' PRIMARK PRIMA and comparing it with the Applicant's PRIMA (stylised), it seems to me that the visual and phonetic difference between these two marks are greater than in the comparison considered in the previous paragraph. Here we have a single word, "ordinary"

sounding mark on the one hand and a two-word mark that displays a degree of assonance on the other. Of course, the connotative differences previously alluded to are not as significant in this case, owing to the inclusion of the same word (“prima”) in both marks; nevertheless, my earlier observations as to the connotative significance of the word “primark” are equally applicable to the consideration of its effect as one of the components of the Opponent’s two-word mark under consideration here. On balance, I think that the Applicant’s PRIMA (stylised) is sufficiently different to the Opponents’ PRIMARK PRIMA in both its look and its sound as to more than compensate for any conceptual similarity that may arise from the inclusion in both of the word “prima”.

Looking, lastly, at the Opponents’ mark PRIMA, it is evident that this is phonetically and conceptually identical with the Applicant’s PRIMA (stylised) and that the only difference between the marks is a visual one arising from the stylised presentation of the Applicant’s mark. As I have already stated, I regard the effect of this stylisation as minimal in the context of the Applicant’s mark as a whole and I think that it is fair to say that the two marks under consideration here might be described as being one step short of identical.

#### Comparison of the goods

The determination of the similarity or otherwise of the marks is not the end of the matter as it is entirely possible for two very similar, or even identical, marks to co-exist without causing confusion if the goods to which they are applied are sufficiently different. In the present instance, the Opponents’ marks are registered for, and have been used in relation to, a wide range of goods including clothing, footwear, textiles, household hardware and general goods. The application for registration is in respect of sporting goods, including golf and tennis equipment and accessories therefor. On the face of it, there would not appear to be any obvious similarity between such goods and those in which the Opponents trade. The evidence submitted in support of the application for registration shows use of the Applicant’s mark in relation to golf clubs, golf bags, golf gloves and the like and the specialised nature of these goods sets them apart from those of the Opponents. However, the Opponents have argued that the application for registration is not limited only to golf equipment but covers the far

more general term of “sporting goods and accessories therefor”. Mr. Kennedy pointed out at the hearing that the Applicant had not offered to amend the specification of goods covered by the application so as to preclude the possibility of confusion between its mark and those of the Opponents and he asserted that I must take into account the entire range of goods that may be included in those cited in the application when considering whether to accept the mark for registration. In this latter regard, the Opponents have argued that clothes may be described as a sports accessory and that, in relation to golf in particular, the clothing worn is much the same type of clothing as is sold by the Opponents under their marks. Because of what they claim to be a common practice among manufacturers of sports clothing to also sell sports equipment under the same marks, the Opponents argue that use by the Applicant of the mark PRIMA on sports equipment or clothing is likely to lead to confusion because of the Opponents’ existing user of, and reputation in, their marks in relation to clothing, particularly casual clothing and leisure wear.

Before a comparison of the goods in this case can be undertaken, it is clear that the question of what precisely is included in the goods of the application and, specifically, whether clothing is included in them must be decided. In this regard, it may well be argued as to whether the reference to “accessories therefor” in the Applicant’s specification of goods is related to and governed by the immediately preceding words, “golf and tennis equipment” or by the more general term “sporting goods” that appears at the start of the specification. I am inclined to think that the proper reading of the specification, in this regard, is that it is limited to golf and tennis accessories such as tees, balls, pitch mark repairers, etc. but, in any event, I do not think that anything hangs on the question. The explanatory notes of the International Classification of Goods and Services for the Purposes of the Registration of Marks (the Nice Classification) make it clear that Class 28 does not include sports clothing. The Applicant has presented its application for registration in respect of goods in Class 28 and the meaning of the word “accessories” must be construed accordingly and cannot be taken to include clothing. It is notable that golf gloves are classified in Class 28 rather than in Class 25, which covers clothing generally including sports clothing. Of course, golf gloves are not worn as an item of clothing *per se* but as an aid to the playing



of the sport or, in other words, an “accessory”. The specification of goods of this application cannot, therefore, be construed to include clothing *per se* and registration of the mark would not grant protection of it in relation to clothing of any kind, including sports clothing.

In considering whether the respective goods of an applicant and an opponent are the same goods or the same description of goods in the context of opposition proceedings such as these under the Trade Marks Act, 1963, regard is had to the test for comparing goods as set down in *Jellinek* (1946) [63 RPC 69], which requires a comparison of (i) the nature and composition of the goods, (ii) the uses of the goods, and (iii) the trade channels through which the goods are sold. Applying that test to the present case, I am satisfied that sporting goods are fundamentally different in their nature, purpose and commercial origin from the clothing, footwear, textiles and general household goods sold by the Opponents. The relevant goods are not mutually competitive in the marketplace and are not normally offered for sale side by side within the same stores. They are, in the words of the Act, different descriptions of goods.

15. Having made a comparison of both the respective marks and the respective goods of the parties and applying my findings to the consideration of the opposition under Section 19, I am satisfied that, having regard to (i) the differences between the Opponents’ marks PRIMARK and PRIMARK PRIMA and the Applicant’s mark PRIMA (stylised) and, (ii) the differences between the goods to which those marks are applied, there is no appreciable likelihood of confusion such as would constitute an obstacle to registration. With regard to the Opponents’ mark PRIMA, I have already referred to the high degree of similarity between this and the Applicant’s mark; nevertheless, I regard the differences between the respective goods as decisive and sufficient to reduce to a negligible level the likelihood of confusion arising. I am strengthened in my belief on this point by the fact that, despite there having been use of both the Opponents’ and the Applicant’s marks within the same markets for some considerable time, no evidence of actual confusion between them has been presented. I think it highly unlikely that persons encountering the Applicant’s mark applied to sporting goods will associate those goods or that mark with the Opponents, whose reputation under

their “own-brand” PRIMARK label will not, I believe, be compromised in any way thereby. For these reasons, I dismiss the opposition under Section 19.

16. In relation to Section 20, the relevant part of that Section reads as follows:

“(1) ..... no trade mark shall be registered in respect of any goods or description of goods that is identical with a trade mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or that so nearly resembles such a trade mark as to be likely to deceive or cause confusion.”

The Opponents’ registrations did not, at the date of filing of the present application, include a registration in respect of the mark PRIMA; their registration of this mark under No. 164995 in Class 25 in respect of articles of clothing and footwear is dated 15 June, 1994 and so post-dates the present application. Among the several registrations held by the Opponents at the relevant time, the following are of most relevance to these proceedings:

<b>Registration No.</b>	<b>Filing Date</b>	<b>Mark</b>	<b>Class</b>	<b>Goods</b>
128786	15/04/87	PRIMARK PRIMA	25	Articles of clothing included in Class 25, boots, shoes and slippers
137047	23/05/88	PRIMARK	28	Toys, games (other than playing cards) and playthings; sporting articles (other than clothing), swimming pools and paddling pools all being transportable, Christmas tree decorations (other than candles or lamps)

Registration No. 128786, which is subject to a disclaimer of exclusive rights in the word “prima”, is limited to Class 25 and does not extend to any items of sporting goods included in Class 28. Registration No. 137047 in Class 28 is in respect of the mark PRIMARK, which I have already found to be quite different from the Applicant’s mark. For these reasons and those that I have already

outlined in relation to the opposition under Section 19, I do not consider that either of these registrations (or any of the others held by the Opponents) stands as an obstacle to registration of the Applicant's mark. Accordingly, I dismiss the opposition under Section 20.

17. As the application falls to be determined in accordance with the Trade Marks Act, 1963, the Opponent's assertion in their Notice of Opposition that registration of the mark would be contrary to Council Directive No. 89/104 EEC to approximate the laws of the Member States relating to trade marks is rejected. The Directive is only binding to the extent that it is given effect in national legislation and this has been done in Ireland by the enactment of the Trade Marks Act, 1996, but that Act does not govern the determination of registrability in this case.

18. The Opposition has failed on all grounds and I find no reason to exercise adversely to the Applicant the discretion conferred on the Controller under Section 25(2) of the Act.

Tim Cleary  
Acting for the Controller

June, 2003