

TRADE MARKS ACT, 1996

Decision in Hearing

IN THE MATTER OF a request for protection of International Trade Mark No. 789926 and in the matter of an opposition thereto.

PRINCIPE S.P.A.

Holder

PRINCIPLES RETAIL LIMITED

Opponent

International registration

1. Principe SpA, of 166 Via Ducca degli Abruzzi, 1-21100 Varese, Italy, is the Holder of International Trade Mark Registration No. 789926 in respect of the figurative trade mark, PRINCIPE (shown below), which was registered by the International Bureau of the World Intellectual Property Organisation as of 5 June, 2002 in Classes 18, 25 and 42 for the goods and services listed hereunder:



Class 18: *Handbags, suitcases, large bags for travel, vanity cases, wallets; attaché cases, school satchels, umbrellas.*

Class 25: *Dresses made from skins; men's, women's and children's clothing, shirts; ladies' shirts; skirts; jackets; trousers; shorts; undershirts; knitwear; pyjamas; shoes; socks; sleeveless knitwear; blouses; garter belts; panties and underpants; slippers; slippers; footwear in general; hats; sashes; scarves; neckties; waterproof clothing; overcoats; coats; bathing suits; sports outfits; anoraks; ski trousers; belts; furs.*

Class 42: *Research and development service, which consists in the elaboration of technical projects and designs for goods, with particular reference to stylistic design of clothing, footwear,*

leather ware, furnishings and ornaments and household and industrial manufactured goods.

2. The international registration includes a claim to a right of priority on the basis of an application for registration filed in Italy on 24 April, 2002.

Request for extension of protection to the State

3. Ireland is one of the countries designated in the application for international registration and, by notification dated 21 November, 2002, the International Bureau informed the Controller of the request for extension to the State of the protection resulting from the international registration. By virtue of Regulation 3 of the Trade Marks (Madrid Protocol) Regulations, 2001 (S.I. 346 of 2001), the Trade Marks Act, 1996 (the Act) applies to the request for protection as it applies to an application for registration under the Act.
4. The request for protection was subsequently examined in accordance with the provisions of the Act and it was accepted and advertised accordingly in Journal No. 1967 on 30 April, 2003.
5. Notice of opposition to the granting of protection to the mark pursuant to Section 43 of the Act was filed on 23 July, 2003 by Principles Retail Limited of 19-22 Rathbone Place, London W1T 1HY, United Kingdom. The Holder filed a counter-statement on 25 November, 2003 and evidence was subsequently filed by the parties under Rules 20 and 21 of the Trade Marks Rules, 1996 (“the Rules”).
6. The matter became the subject of a hearing before me, acting for the Controller, on 14 December, 2006. The parties were notified on 24 January, 2007 that I had decided to dismiss the opposition and to grant the request for protection of the mark. I now state the grounds of my decision and the materials used in arriving thereat.

Scope of the opposition

7. While the notice of opposition cites eight different grounds of opposition under Sections 6, 8, 10 and 37 of the Act, the evidence filed by the Opponent and the

arguments presented on its behalf at the hearing were directed to one of those grounds only, namely that the trade mark seeking protection is similar to one or more of the Opponent's earlier trade marks¹, which are registered in respect of identical or similar goods and services such that there is a likelihood of confusion on the part of the public. That objection arises under Section 10(2)(b) of the Act.

The evidence²

Rule 20

8. Evidence submitted by the Opponent under Rule 20 consisted of a statutory declaration (and Exhibits PRL1-PRL6), dated 27 July, 2004 of Peter Davies, its managing director. He says that,

- the Opponent was formed in 1984 to cater for professional women looking for smart, stylish clothes of excellent quality at affordable prices,
- the Opponent operates 14 outlets in the State, including 3 stand-alone shops and 11 concessions within department stores,
- the trade mark PRINCIPLES is used on a broad range of women's clothing, both on swing tags and on the clothing labels themselves,
- because of difficulties in accessing records of the Opponent's predecessors in title, the date of commencement of use of the trade mark PRINCIPLES in the State is unknown but it is understood to have been used since at least September, 1987,
- sales of goods under the trade mark in the period September, 1999 – August, 2003 amounted to over €70 millions and substantial promotion and advertising occurs, including through newspaper supplements and advertisements in popular magazines,

¹ see Schedule I

² review of the evidence confined to matters or relevant fact or claimed fact

- the Opponent has a significant presence in the United Kingdom and has also registered the PRINCIPLES trade mark in over 40 countries throughout the world.

Rule 21

9. Evidence submitted by the Holder under Rule 21 consisted of a statutory declaration (and Exhibits EM1–EM3) dated 16 February, 2005 of Elio Maroni, its managing director. He says that,

- the Holder has been trading for a long number of years under the trade mark PP PRINCIPE [and device] and has used the mark in Ireland since at least 1998 in respect of various goods including bags, school satchels, belts, wallets, travelling bags and suitcases,
- turnover in goods sold under the trademark amounted to approximately €475,000 in the period 1998-2003 and approximately €40,000 was spent on advertising those goods in that period,
- the Holder's products are available throughout Ireland and are sold through footwear and leather goods shops and various department stores.

The hearing and arguments of the parties

10. At the hearing the Opponent was represented by Ms. Hazel Tunney, Trade Mark Agent of F.R. Kelly & Co. and the Applicant by Ms. Roseanne Mannion, Trade Mark Agent of Cruickshank & Co.

11. Ms. Tunney argued the case in support of the opposition on the basis of what she claimed were the very close visual and phonetic similarities between the respective words PRINCIPLES and PRINCIPE. While the Holder's mark contains additional figurative elements, the word PRINCIPE dominates it as the consumer will refer to, and recall, the mark by its verbal component. The Opponent's earlier trade mark PRINCIPLES is highly distinctive, having no meaning in the context of the relevant goods and services and has acquired further factual distinctiveness by virtue of the extensive use made of it. In Ms. Tunney's

submission, these factors, taken together with the identity or close similarity of the respective goods and services, created a likelihood of confusion on the part of the public.

12. Ms. Mannion denied that any such likelihood existed by reason of the fact that the goods dealt in by both the Opponent and the Holder (primarily clothing and clothes accessories) are chosen with some care by the average consumer so that a passing similarity between the respective trade marks is not enough, of itself, to lead to confusion. While the verbal component of the Holder's trade mark is somewhat similar to that of the Opponent, the figurative component comprising the mirrored "P" and the device of a crown cannot be disregarded in the overall comparison. The connotative significance of the crown device is reinforced by the fact that PRINCIPE means "prince" in Italian and the trade marks are therefore quite dissimilar on conceptual grounds. Ms. Mannion also referred to the fact that no instances of actual confusion between the trade marks had been identified despite the fact that it appears from the evidence of the parties that the marks co-exist in the marketplace here and elsewhere.

Grounds of decision

13. Section 10(2)(b) of the Act prohibits the registration of a trade mark if, because it is similar to an earlier trade mark and would be registered for goods or services in respect of which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association of the later trade mark with the earlier trade mark. The present request for protection relates to both goods and services and it is convenient for the purposes of this decision to consider each separately because the likelihood of confusion must be determined within the context of the actual marketplace for the goods/services at issue and that is obviously different as between the goods in Classes 18 and 25, on the one hand, and the service in Class 42, on the other. In assessing the likelihood of confusion, I have been guided as always by the key decisions of the European Court of Justice (ECJ) on that question, including those in the cases of *Sabel BV – v- Puma AG and Rudolph Dassler Sport (Case C-251/95)*, *Canon Kabushiki Kaisha –v- Metro-Goldwyn Mayer Inc. (Case C-39/97)* and *Lloyd Schuhfabrik Meyer & Co. GmbH –v- Klijsen Handel BV (Case C-342/97)*. Those decisions

direct that the likelihood of confusion must be appreciated globally, having regard to all of the relevant factors and circumstances, including the degree of similarity between the respective trade marks and that between the respective goods/services in question, the degree of distinctiveness of the earlier trade mark, the nature of the goods/services in question and the circumstances of the trade in those goods/services, as well as the presumed expectations of the average consumer of them, who must be deemed to be reasonably observant and circumspect but who rarely has a chance to make a direct comparison of the trade marks and must rely, rather, on the imperfect picture of them that he keeps in his mind. Furthermore, in assessing the degree of similarity between marks, one must consider the visual, aural and conceptual similarities between them and the relative significance of each of those elements, having regard to the category of goods and the way in which they are marketed. That assessment must be made on the basis of the overall impressions created by the respective marks as the average consumer normally perceives a trade mark as a whole and does not proceed to analyse it in detail.

The goods in Classes 18 and 25

14. The goods in Classes 18 and 25 of the present request for protection fall within the specifications of the Opponent's earlier trade mark, PRINCIPLES registered under Nos. 124391 and 124392. The goods in question are aimed at consumers generally and not at any subset of the population or specialised market so that the average consumer must be taken as being the average person. The registrations Nos. 124391 and 124392 predate the request for protection, having registration dates of 18 September, 1987 and 28 October, 1987, respectively and the Opponent's trade mark PRINCIPLES therefore constitutes "an earlier trade mark" within the meaning of section 11 of the Act as against the Holder's request for protection. Applying the criteria established by the ECJ in the cases referred to above, the question to be decided may be phrased as follows: *what is the likelihood that the average person who is familiar with the Opponent's goods sold under the trade mark PRINCIPLES would mistakenly assume that the like goods marketed under the trade mark seeking protection are the same goods that he already knows as PRINCIPLES (direct confusion) or that they are related to those goods, in the sense that they emanate from the same or an economically linked*

undertaking (indirect confusion)? I have decided that there is no such likelihood for the following reasons.

15. Firstly, I agree with the submissions made on behalf of the Holder to the effect that, on an overall assessment, PRINCIPLES and PRINCIPE [and device] are not confusingly similar trade marks within the context of these particular goods. Of course, it is undeniable that the verbal component of the marks seeking protection looks very similar to the Opponent's trade mark. They contain 10 and 8 letters, respectively and all 8 letters of the Holder's word PRINCIPE are to be found in the earlier mark and the first seven letters of the two words are identically arranged. The shared letter sequence also gives rise to a similarity in the sounds of the two words, although the exact pronunciation of the Holder's mark is uncertain; it may be pronounced either as a two-syllable or three-syllable word and the syllables themselves may be pronounced differently – "*prin*" or "*pran*", "*seep*", "*sip*", "*sip-eh*" or "*sip-ee*" and possibly other pronunciations that do not immediately occur to me. In any event, there is a certain similarity between the two words regardless of how the Holder's mark is pronounced.

16. But the assessment of similarity between the words may not properly be made simply on the basis of a letter-by-letter comparison of them if to do so would be to overlook the dominant and distinctive aspects of the respective marks. The reason for focusing on the latter is because, for confusion to be likely, that which is memorable about the earlier mark must be replicated or at least hinted at sufficiently in the mark seeking protection in order for exposure to the latter to trigger in the mind of the average person a recollection of the former which, in turn, may lead to an association in his mind between the respective goods. To compare the marks in that way, it is necessary to first of all identify the distinctive or memorable feature of the earlier mark and to then examine whether the mark seeking protection consists of or contains a component (in this case, a word) that is liable to cause the average person to recall that feature of the earlier mark. If it does, then the potential exists for confusion although other factors may obviate the likelihood of same. Conversely, if it is unlikely that the mark seeking protection would create any connection with the earlier mark in the mind of the average consumer, then confusion is not possible.

17. In my opinion, the distinctiveness of the Opponent's trade mark PRINCIPLES emanates from the meaning of the word and the concept that it conjures up, which, as Ms. Tunney correctly pointed out at the hearing, has nothing at all to do with clothing, accessories or leather goods. As a trade mark for goods of that nature, PRINCIPLES expresses an unspecific message that is likely to be received and interpreted differently by different consumers but which certainly creates a brand identity that is built on the evocation of a concept. It is that concept, however understood, that the average person is likely to subconsciously identify with the brand. I do not believe that the average person is likely to take any such meaning from the mark seeking protection. At the hearing, Ms. Tunney objected to the Holder's assertion that PRINCIPE means "prince" on the basis that same had not been proven by appropriate evidence and could not be relied upon. Whether or not such an objection is sustainable is neither here nor there, in my opinion. The question is not what the word means but whether its meaning is likely to be understood by the average consumer in this jurisdiction. In the absence of any evidence on that question and not being personally aware of the word as one that has passed into usage in the English language, I think it correct to assume that its meaning would not be understood. For the average consumer here, therefore, the verbal component of the Holder's mark is likely to be perceived simply as a foreign word to which he will not subconsciously attribute any meaning in translation. Neither the word PINCIPE nor the other components of the Holder's mark can therefore be said to be likely to trigger any recollection of, or association with, the concept evoked by the earlier mark and the link between the distinctive aspects of the marks that is necessary for confusion to ensue is therefore not present in this case.

18. The assessment might be different in the case of different goods, say, for example, goods that are normally selected and purchased by the average consumer on the basis of a fleeting glance at the brand name³. In such a scenario, visual similarities between marks become more significant in the overall assessment of likelihood of confusion although, in the case of word marks, I think that the

³ the "chocolate bar" is often referred to

conceptual comparison must generally take priority over the visual as we are apt to subconsciously assimilate the meanings of words even when fleetingly perceived. In the case of goods of the kind covered by the present request for protection, however, it is the case that brand name is a relatively important criterion in the selection process for the average consumer and it must be assumed that, if the consumer looks at the brand name, he will do so carefully and closely enough as to actually perceive it and not simply form a vague impression in his mind of its visual identity. For confusion in practice to occur between the marks at issue here, it would appear that the consumer would have to perceive the trade mark PRINCIPE [and device] on an item only to the extent that he notices the general appearance of a word having a similar look to the word PRINCIPLES, with which he is already familiar, and to then complete his examination of the suitability of the item in question as regards size, style, colour, price, etc. without happening to notice that the item is not, in fact, of the PRINCIPLES brand. Because I do not think that the average person is likely to pay such fleeting attention to brand name when it comes to these types of goods, I do not regard that as a plausible scenario and I think that the likelihood of direct confusion between these marks is really negligible. Indirect confusion by association seems even more unlikely as that requires some causal link to become established in the mind of the consumer as between the two trade marks and, as I have already said, I cannot imagine anyone being reminded of the word and concept PRINCIPLES by anything in the Holder's trade mark.

19. In summary, I find that the differences between the respective trade marks as regards their distinctive features, taken together with the nature of the goods and the likely level of attention that will be paid by the average consumer in the typical purchasing scenario, obviates any likelihood of confusion that may be said to stem from the visual and phonetic similarities between the marks. In reaching that conclusion, I have had due regard to the submissions made on behalf of the Opponent to the effect that its trade mark is highly distinctive in nature and has acquired further factual distinctiveness by virtue of the use made of it. It will be clear, however, that I regard the feature of the Opponent's mark that imbues it with its distinctiveness as one that is not replicated in any way in the mark seeking protection and that, accordingly, the general principle that the likelihood of

confusion is heightened in the case of a highly distinctive earlier mark does not materially affect the overall assessment of likelihood of confusion in this case.

The service in Class 42

20. The service in Class 42 covered by the present request for protection is not the same as any in respect of which any of the Opponent's trade marks is protected. The Holder's service is in the nature of design consultancy, research and development in relation to a range of goods including clothing, footwear, leather ware, furnishings, ornaments and household and industrial manufactured goods. The Opponent's Community Trade Mark No. 1691419 is protected in respect of services in Class 42, which include design of internet web pages and related services but those services cannot be said to be similar to that covered by the Holder's request for protection, as they have different purposes and are aimed at different categories of users.
21. A certain similarity is discernible as between the Holder's Class 42 service and the goods for which the Opponent's trade mark PRINCIPLES is protected under Registrations Nos. 124390-124392 and it may be said that a *prima facie* objection exists under Section 10(2)(b) of the Act on the basis of those earlier registrations. However, the design service in respect of which the Holder seeks protection must be assumed to be directed to a relatively specialist consumer, i.e. individuals and undertakings engaged in the manufacture of the relevant goods, and such persons must be expected to exercise a fair degree of discernment in the selection of service providers. The suggestion that they might be confused into believing that there was a connection between the undertaking offering the service in question in Class 42 under the mark seeking protection and the owner of the PRINCIPLES trade mark used in relation to goods in Classes 14, 18 and 25 by virtue of the visual and aural similarities between the respective marks is, in my opinion, quite fantastical. If anything, the reasons that I have set above as to why there would be no likelihood of confusion arising from the use of the mark seeking protection in relation to the goods covered by the international registration apply *a fortiori* as regards its use in relation to the service in Class 42. I find, therefore, that the objection under Section 10(2)(b) of the Act should also fail insofar as it relates to the service in Class 42.

Tim Cleary
Acting for the Controller

27 February, 2007

SCHEDULE I

Opponent's earlier trade marks cited in Notice of Opposition

Number	Mark	Date	Goods/Services
124389	PRINCIPLES	18/09/1987	Class 3: <i>Soaps, perfumes, anti-perspirants, essential oils, cosmetics, preparations for the hair; shampoos; non-medicated toilet preparations and dentifrices.</i>
124390	PRINCIPLES	18/09/1987	Class 14: <i>Watches, clocks, jewellery and imitation jewellery.</i>
124391	PRINCIPLES	18/09/1987	Class 18: <i>Bags included in Class 18, suitcases, holdalls, purses (not of precious metal or coated therewith), pocket wallets, umbrellas, parasols and walking sticks.</i>
124392	PRINCIPLES	28/10/1987	Class 25: <i>Articles of clothing all included in Class 25.</i>
882977 ⁴	PRINCIPLES SPIRIT FOR MEN	21/07/1998	Class 3: <i>Non-medicated preparations for the application to, conditioning and care of hair, scalp, skin and nails; soaps; perfumes; perfumery; eau de cologne; toilet waters; essential and herbal oils; cosmetics; make-up preparations; non-medicated toilet preparations; hair sprays and hair gels; preparations for use in the bath or shower; bath and shower oils, gels, creams and foams; face and body masks; face and body scrubs; facial washes; skin cleansers and hydrators; skin toners; skin moisturizers; blemish creams and blemish gels; deodorants; preparations for use before shaving and after shaving; shaving soaps; shaving creams; shaving gels; after-shave preparations; pre-shave preparations; talcum powders; toiletries; dentifrices; toothpastes.</i>

⁴ Community Trade Mark

882902 ⁵	PRINCIPPLES SPIRIT FOR WOMEN	21/07/1998	ditto
1301431 ⁶	PRINCIPLES	07/09/1999	<p>Class 3: ditto</p> <p>Class 14: <i>Precious metals and their alloys and goods in precious metals or coated therewith; semi-precious and precious stones; horological and other chronometric instruments; watches, clocks, jewellery and imitation jewellery; parts and fittings for all the aforesaid goods.</i></p> <p>Class 18: <i>Articles of leather and imitations of leather; trunks and travelling bags; travel cases; luggage; suitcases; holdalls; portmanteaux; valises; bags; handbags; shoulder bags; toilet bags; carrier bags; rucksacks; backpacks; bumbags; sports bags; casual bags; briefcases; attaché cases; music cases; satchels; beauty cases; carriers for suits, for shirts and for dresses; tie cases; notecases; notebook holders; document cases and holders; credit card cases and holders; chequebook holders; wallets; purses; umbrellas; parasols; walking sticks; shooting sticks; belts; parts and fittings for all the aforesaid goods.</i></p> <p>Class 25: <i>Articles of clothing; footwear; boots, shoes, slippers, sandals, trainers, socks and hosiery; headgear; hats; caps; berets; scarves; gloves; mittens; belts (being articles of clothing).</i></p>
1691419 ⁷	PRINCIPLES	06/06/2000	<p>Class 38: <i>Providing telecommunications access and connection to computers, to the Internet and to the World Wide Web; telecommunication of information; electronic</i></p>

⁵ Community Trade Mark

⁶ Community Trade Mark application - not yet registered

⁷ Community Trade Mark

			<p><i>mail services; providing user access to the Internet and to the World Wide Web; telecommunication gateway services; providing access to digital audio and/or video; providing on-line access to digital audio and/or video; delivery of digital audio and/or video by telecommunications.</i></p> <p>Class 42: <i>Computer rental; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; creating and maintaining web sites; hosting the web sites of others; installation and maintenance of computer software; leasing access time to a computer database.</i></p>
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