

**TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL  
REGISTRATION NO. 651606 AND THE REQUEST BY  
KARL CONZELMANN GMBH & CO. TO PROTECT A TRADE MARK  
IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER  
NO. 70004 BY PRIMARK HOLDINGS AND PRIMARK STORES LIMITED**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL  
REGISTRATION NO. 651606 AND THE REQUEST BY  
5 KARL CONZELMANN GMBH & CO. TO PROTECT A TRADE MARK  
IN CLASS 25**

**AND**

**10 IN THE MATTER OF OPPOSITION THERETO UNDER  
NO. 70004 BY PRIMARK HOLDINGS AND PRIMARK STORES LIMITED.**

**DECISION**

15 On 6 June 1996 Karl Conzelmann GmbH & Co, on the basis of a registration held in Germany, requested protection in the United Kingdom of the trade mark depicted below under the provisions of the Madrid Protocol.

20 

25 The international registration is numbered 651606 and protection was sought in Class 25 for the following goods:

Clothing; but not including footwear or any goods similar to these excluded goods.

30 The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration were published in accordance with Article 10.

35 On 18 June 1997 Primark Holdings and Primark Stores Limited filed notice of opposition to the conferring of protection on this international registration. By way of background, they state that the opponents jointly and separately conduct a business, in the United Kingdom under the name Primark Stores Limited, and in the Republic of Ireland under the name of Primark and Prima. This they say is on a very large scale and is in the procurement,  
40 manufacture and sale of a wide variety of retail trade goods. They state that the retail trade is conducted extensively throughout the United Kingdom and Republic of Ireland and that they have suppliers and manufacturers in many countries of the world who supply and/or manufacture, to the opponent's specifications, goods upon which their principal trade marks PRIMARK and PRIMA are affixed. However, following an Interlocutory Hearing before one  
45 of the Registrar's Hearing Officers, the only ground of opposition being pursued is under Section 5(2)(b) of the Act. The opponent states that they are the registered proprietors in the United Kingdom of the trade marks found at appendix 1 to this decision and that the trade

mark for which protection is sought offends against the provisions of Section 5(2)(b) of the UK Trade Marks Act 1994 in that it so nearly resembles the opponents trade marks as to be likely to deceive or cause confusion.

5 The holders of the international registration filed a counter statement denying this ground stating that when their trade mark, in it's entirety, is compared with the opponents' trade marks it is different both visually and aurally. They also point to the fact that in registration No 1307335 for the term PRIMARK PRIMA the opponents have disclaimed exclusive use of the word PRIMA.

10 Both sides ask for an award of costs.

15 No evidence was filed by either side but the matter came to be heard on 28 June 2000. The opponent was represented by Ms Fiona Clarke of Counsel instructed by Maguire Boss, their trade mark attorneys. The holders of the international registration did not attend the hearing nor were they represented, but they requested that the submissions made in their counterstatement be taken into account by the Hearing Officer.

### 20 **Decision**

As stated earlier the only ground of opposition being pursued by the opponent is that under Section 5(2)(b) of the Act. This reads:

25 **5.-(2)** A trade mark shall not be registered if because -

(a) .....

30 (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for 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 with the earlier trade mark.

35 An earlier right is defined in Section 6 the relevant parts of which state:

**6. (1)** In this Act an "earlier trade mark" means -

40 (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks

In considering the matter I take account of the guidance provided by the European Court of Justice in *Sabel v. Puma AG* (1998 RPC 199 at 224), *Canon v. MGM* (1999 ETMR 1) and *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BV* (1999 ETMR 690 at 698).

5 It is clear from these cases that:

- (i) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- 10 (ii) the matter must be judged through the eyes of the average consumer, of the goods/services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them kept in his mind.
- 15 (iii) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- 20 (iv) the visual, aural and conceptual similarities of the marks must be based upon the overall impressions created by the marks bearing in mind their distinctive and dominant components;
- 25 (v) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;
- (vi) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it.

30 As there was no evidence filed by either the holders or the opponents I approach the matter on the basis of notional and fair use of both trade marks; *REACTOR* [2000] RPC 285.

35 At the hearing Ms Clarke concentrated her submissions on the similarity of the opponents' registrations for the trade marks PRIMARK (solus), namely registration no's 1027943 and 1063605 and also registration no 1307335 for the trade mark PRIMARK PRIMA. These registrations and the international registration in suit cover clothing in Class 25 and it has not been disputed by either party that identical goods are involved. The matter therefore falls to be determined by a comparison of the respective marks taking into account any other relevant factors.

40 First of all I deal with the opponents' registration no 1307335. For ease of reference the trade mark covered by this registration, along with the trade mark in suit, are reproduced below:

45 **Opponents mark**

PRIMARK PRIMA

**Mark in suit**

PRIMA N!NA

As was pointed out by the holders of the international registration in their counterstatement, the opponents have disclaimed their right to the exclusive use of the word PRIMA the disclaimer is as follows:

5 Registration of this mark shall give no right to the exclusive use of the word "PRIMA".

10 In PACO/PACO LIFE IN COLOUR [2000] RPC 451, the Registrar's Principal Hearing Officer determined that a disclaimer is an admission by the proprietor that the disclaimed component is not, by itself, distinctive of his goods and/or services and that its presence in another party's trade mark cannot give rise to the likelihood of confusion.

At the hearing Miss Clarke sought to persuade me that the Hearing Officer's reasoning on the issue of disclaimers in that decision was wrong. This was because, in her view:

- 15 (i) the Act made it clear that disclaimers had no effect for the purposes of infringement (Section 10) but does not say that it has no effect for the purposes of relative grounds for refusal (Section 5) but that omission mirrors the position under the Trade Marks Act 1938 (as amended);
- 20 (ii) that was upheld by the Appointed Person in FOUNTAIN [1999] RPC 490 which was referred to by the Principal Hearing Officer in PACO/PACOLIFE IN COLOUR;
- 25 (iii) the Trade Marks Act 1938 (as amended) gave wider rights under Section 12 than in an action for infringement and there is no indication that any different considerations apply in considering the comparable provisions of the Trade Marks Act 1994;
- 30 (iv) the decision in PACO/PACO LIFE IN COLOUR case flew in the face of that of the European Court of Justice - SABEL BV v PUMA AG [1998] RPC 199 and LLOYD SCHUFABRIK MEYER GmbH v KLIJSEN HANDEL BV [1999] EMR 690 which required the Tribunal to look at the respective trade marks as wholes with no dissection because that was how customers saw (and perceived) them in line with the thinking in GRANADA [1979] RPC 303;
- 35 (v) the different considerations applying between the deliberations in Section 5, which assumes normal and fair use of the respective trade marks across the whole range of the specification, and Section 10, which was based upon actual use which is alleged to infringe the earlier trade mark militated against the
- 40 blanket approach to ignoring any disclaimed matter.

45 As I did not have the benefit of counter submissions I do not intend to seek to replace Ms Clarke's submissions for the reasoned views of the Hearing Officer in PACO/PACO LIFE IN COLOUR. That being so I approach the comparison on the basis that where the only component of a mark which could be regarded as creating a similarity with another mark is the subject of a disclaimer that component cannot be taken into account when determining the likelihood of confusion.

On the basis of the above I compare the holders' trade mark PRIMA N!NA with the term PRIMARK in the opponents' trade mark. I have no evidence before me as to how the N!NA element in the international holders' trade mark is promoted and/or pronounced. It could be that it is pronounced "N exclamation mark NA". But, I think this unlikely. It is more likely to be pronounced "NEENA" and it is on that basis that the comparison is made. It is apparent that the first word, PRIMA, in the holders' trade mark is wholly contained in the opponents' trade mark. But the former is completely lost in the second. Taking these points together with the factors set down by the European Court and listed above I reach the view that there is no overall visual or aural similarity between the two marks. Therefore, even if goods bearing them were sold side by side (and I bear in mind that the goods the subject of these trade marks would be primarily selected by the eye), I think the differences are such that there is no likelihood of confusion. The ground of opposition under Section 5(2) on the basis of the opponents' PRIMARK PRIMA trade mark is not made out.

In their counterstatement the holders of the international registration made observations about the state of the register incorporating the word PRIMA. However, since no evidence was filed I have no information as to how these marks got onto the register, whether they are in use or how they might be perceived in the market place, I have not therefore taken these observations into account in reaching my decision.

Given my findings above it is not necessary for me to go on to consider the other registrations relied upon by the opponent as it is, I think, clear that if I do not consider there exists a likelihood of confusion between the trade mark in suit and the PRIMARK element of the trade mark PRIMARK PRIMA, I am bound to find that I reach the same decision in comparing the opponents' PRIMARK (solus) trade marks with the trade mark in suit. The opposition under Section 5(2) therefore fails in its entirety.

As the holders of the international registration have been successful they are entitled to a contribution towards their costs. I order the opponents to pay the holders of the international registration the sum of £100. This sum is to be paid within seven days of the expiry of the appeal period, or in the event of an unsuccessful appeal, within seven days of this decision becoming final.

**Dated this 3 day of August 2000.**

**M KNIGHT  
For the Registrar  
the Comptroller General**

Appendix 1

<u>No</u>	<u>Mark</u>	<u>Class</u>
5	1027943 PRIMARK	25
	1063605 PRIMARK	25
10	1063607 	25
15		
20	1041481 	25
25	1064603 PRIMARK SHEERFIT	25
	1135280 PRIMARK FASHION SENSE	25
30	1307335 PRIMARK PRIMA	25
	1257973 PRIMARK FANTONI	25