

O-410-12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2574857
BY
FRANK PUBLIC RELATIONS LIMITED
TO REGISTER THE TRADE MARK**

PRADVERTISING

IN CLASS 35

AND

**THE OPPOSITION THERETO
UNDER NO 102150
BY
PRADA S.A.**

Background and pleadings

1. Frank Public Relations Limited (“the applicant”) applied for the mark PRADVERTISING on 11 March 2011. The application was published in the *Trade Marks Journal* on 8 April 2011, following which it was opposed by Prada S.A. (“the opponent”). The application is for the following services in class 35:

Public relations; marketing; advertising; consultancy, advisory, analysis, report preparation and information services relating to the aforesaid services.

2. The opposition is brought under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under sections 5(2)(b) and 5(3), the opponent relies upon all the services of its two registered trade marks, 2260362 and 2399128:

(i) 2260362

PRADA

PRADA

PRADA

PRADA

(The colours red and white are claimed as an element of the third mark in the series of four marks.)

Date of filing: 5 February 2001; date of completion of registration procedure: 11 January 2002.

Registered in respect of the following class 35 services:

Advertising; business management; business administration; office functions; the bringing together, for the benefit of others, of a variety of goods, enabling customers conveniently to view and to purchase those goods in a department store; the bringing together, for the benefit of others, of a variety of goods, enabling customers conveniently to view and to purchase those goods in a drugstore, retail pharmacy or retail chemist store; the bringing together, for the benefit of others, of a variety of goods, enabling customers conveniently to view and to purchase those goods in a retail opticians or in a retail optical products store; the bringing together, for the benefit of others, of a variety of goods, enabling customers conveniently to view and to purchase those goods in a retail

electrical store; the bringing together, for the benefit of others, of a variety of goods, enabling customers conveniently to view and to purchase those goods in a retail car showroom or showcentre, a retail boat showroom or showcentre, a retail caravan showroom or showcentre, a retail truck showroom or showcentre, a retail bicycle shop, showroom or showcentre or in a retail sports equipment and apparatus store; the bringing together, for the benefit of others, of a variety of goods, enabling customers conveniently to view and to purchase those goods in a retail jewellery store or a retail horological store or a retail gift store; the bringing together, for the benefit of others, of a variety of goods, enabling customers conveniently to view and to purchase those goods in a retail bookstore or a retail stationery store; the bringing together, for the benefit of others, of a variety of goods, enabling customers conveniently to view and to purchase those goods in a retail leather goods store or a retail luggage store; the bringing together, for the benefit of others, of a variety of goods, enabling customers conveniently to view and to purchase those goods in a retail furniture store, a retail hardware store, a retail homewares store or a retail giftware store; the bringing together, for the benefit of others, of a variety of goods, enabling customers conveniently to view and to purchase those goods in a retail cookware store; the bringing together, for the benefit of others, of a variety of goods, enabling customers conveniently to view and to purchase those goods in a retail soft furnishings store; the bringing together, for the benefit of others, of a variety of goods, enabling customers conveniently to view and to purchase those goods in a retail clothes store, a retail footwear store, a retail sportswear store or a retail lingerie store; the bringing together, for the benefit of others, of a variety of goods, enabling customers conveniently to view and to purchase those goods in a retail toy store; the bringing together, for the benefit of others, of a variety of goods, enabling customers conveniently to view and to purchase those goods in a retail tobacconist store; the bringing together, for the benefit of others, of a variety of goods, enabling customers conveniently to view and to purchase those goods from a general merchandise catalogue by mail order, or from a wholesale outlet or from a wholesale catalogue by mail order, or by means of telecommunications, general merchandise Internet websites and/or general merchandise computer networks.

(ii) 2399128

PRADA

Date of filing: 11 August 2005; date of completion of registration procedure: 22 September 2006.

Registered in respect of the following class 35 services:

The bringing together, for the benefit of others, of a variety of clothing, shoes, bags, leather goods and fashion accessories, perfumery and cosmetics, glasses, watches, sunglasses, jewellery, furniture, bed and table covers, sporting goods, telephones, mobile phones, games and playthings, enabling customers to conveniently view and to purchase those goods from a general merchandise catalogue by mail order or from the wholesale catalogue by mail order or by means of telecommunications, general merchandise internet websites and/or general merchandise computer networks.

4. Of these two earlier marks, 2260362 completed its registration procedure more than five years before the date on which the application was published in the *Trade Marks Journal*. It therefore falls within the proof of use provisions in section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004). The opponent claims that it has used the mark on all the services for which it is registered. In its notice of defence, the applicant requested that the opponent provide proof of this claim. The other mark, 2399128, had been registered for less than five years at the date on which the application was published and is therefore not subject to the proof of use provisions. It must be considered on the basis of notional and fair use across the breadth of the services for which it is registered.

5. Sections 5(2)(b) and 5(3) state that:

“(2) A trade mark shall not be registered if because –
....

(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.”

(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

The opponent claims that there is a likelihood of confusion under section 5(2)(b) because it says that PRADA is contained within PRADVERTISING; although it also says that the first four letters of PRADA are the same as the first four letters of PRADVERTISING, which is the more accurate of the two statements. The opponent claims that the services of the two parties are identical or similar and that, in combination with the similarities between the marks, there would be a likelihood of confusion. The opponents also claim a reputation in the marks which it says it has used in the UK, since at least January 2000,

“...in relation to retail stores and fashion items including clothing, shoes, bags and glasses. The Opponents specialise in luxury goods for men and women and are synonymous with high quality goods and services...Indeed, the Opponents and their mark PRADA have become well known in the world of fashion and are often referred to in a range of publications.”

6. This claim to a reputation in high-end goods forms the basis for the opponent's section 5(3) ground, which it states to be:

“Any use of a mark similar to PRADA, such The Mark [sic] covered by The Application, will be associated with The Opponents and their substantial reputation in PRADA which would lead to a promotion of The Mark covered by The Application beyond that which would have been achieved through advertising alone. The Applicant would effectively be riding on the coat-tails of The Opponents. Further, or in the alternative, any use of The Mark covered by The Application in a damaging way or on services that are substandard could be detrimental to The Opponents' reputation in The Earlier Marks. The damage caused could take on a variety of forms, such as the tarnishment of The Earlier Marks and/or a possible affect [sic] on the economic behaviour of The Opponents' customers which could result in a reduction in business and/or damage to their substantial reputation. Furthermore, there could be dilution of the distinctiveness of The Earlier Marks. Therefore, the use of The Mark covered by The Application without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of The Earlier Marks and therefore registration of The Application would be contrary to Section 5(3) of the TMA”.

7. Section 5(4)(a) states:

“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.”

The opponent states that its use in the UK since at least January 2000 in relation to retail stores and fashion items including clothing, shoes, bags and glasses means that it has built up goodwill and unregistered trade mark rights in the mark PRADA which are of more than mere local significance to the extent that the law of passing-off would entitle the opponents to prohibit the use of the application.

8. The applicant filed a counterstatement in which, in addition to its proof of use request, it accepted that advertising services, of earlier mark 2260362, are similar to its own services. It denies that the remaining services, or that the services of earlier mark 2399128, are similar. It also denies that the marks are similar. The applicant says that the mark is a conjoined word combining PR and ADVERTISING to create an invented thirteen letter word which is entirely different to the opponent’s marks and that, therefore, there is no likelihood of confusion. In relation to section 5(3), the applicant states that its mark does not take advantage of, or cause detriment to, the distinctive character or repute of the opponent’s marks. It denies that the marks are similar and therefore denies that use of its mark would be a misrepresentation under section 5(4)(a). With regard to its own history, the applicant states that it is a PR agency founded in London in 2000 and is one of the largest PR firms in the UK. It says it is currently Marketing’s PR Agency of the Year, an award it also received in 2004 and 2005, making it the only agency to have won the prestigious award three times. It has won other PR/marketing industry awards in 2004, 2005, 2006, 2008 and 2010.

9. The opponent filed evidence, following which the applicant filed written submissions. The opponent’s written submissions in lieu of a hearing contained no content over and above a repetition of the statement of case attached to its notice of opposition. Neither side wished to be heard, choosing instead for this decision to be made on the basis of the papers filed.

Evidence

10. The opponent’s evidence comes from Murielle Vincenti, who has been the opponent’s Intellectual Property Director since 2007, and was its Intellectual Property Manager between 1998 and 2007. She states that, unless otherwise stated, the information in her witness statement comes from her own personal knowledge or from the opponent’s documents and records to which she has access.

11. Ms Vincenti gives some historical information about the opponent, not all of which is necessary to describe for the purposes of this decision. In summary, in the last thirty years, the opponent has become known (through its guiding force, Miuccia Prada) for creative use of materials in simple, sleek modern fashion

designs under the label PRADA which, Ms Vincenti states, has become a premium status symbol. Miuccia Prada has regularly won designer and fashion industry awards, mostly in the USA, since the early 1990s. She is also noted for her patronage and fostering of visual art. In 2006, the film “The Devil Wears Prada” grossed over US\$300 million. Ms Vincenti exhibits¹ a Wikipedia entry relating to the film in which the writer, under the heading ‘Costuming’, refers to the use of clothing from various fashion houses (Chanel, Dolce & Gabbana and Calvin Klein) and that the main character, played by actress Meryl Streep, was dressed in “generous helpings of Prada”. Ms Vincenti states that “today”, Prada is a global concern, selling luxury goods such as clothing, jewellery, luggage and cosmetics. It has more than 250 stores and 40 franchises in 60 to 70 countries. She also refers to PRADA being used on cars made by Hyundai and mobile phones (made by LG). In 2010, the global goods sales figure was €353,038,000. The opponent has also sponsored an international yachting team and has an art foundation called Prada Foundation.

12. Turning to the opponent’s use of its marks in the UK, Ms Vincenti states that PRADA has been used in the UK for many years. The stores Browns and Joseph have stocked PRADA goods since at least 1981 and the opponent opened its first UK retail PRADA store in 2000. At the time of Ms Vincenti’s statement (27 February 2012), there were Prada stores at the following addresses:

- 16-18 Old Bond Street, London W1S 4PS
- 43 Sloane Street, London SW1 9LU
- The Village, Westfield London Shopping Centre, Ariel Way, London W12 7SL
- Heathrow Airport, Terminal 5
- 50 Pingle Drive, Bicester, Oxfordshire
- House of Fraser, 11-45 Buchanan Street, Glasgow G1 3HL.

Photographs of some of the stores are shown at exhibit MV02. They are not identified as to which photograph belongs to which store, but they all feature PRADA as the main signage outside the shop, in the typeface shown in its earlier marks.

13. Ms Vincenti states that PRADA goods are sold by Harrods and Selfridges, and “other well known stores such as Matches”. It also sells its goods via its website (exhibit MV03). Figures are given for the number of items sold in the UK during 2005 to 2011 which are not broken down but “include” bags, shoes, clothing and accessories. 2008 was the opponent’s best year in terms of volume of items sold, with a figure of 97,393. In 2010, the year prior to the filing of the application, the figure was 42,607. Ms Vincenti gives sales figures for the UK, excluding VAT:

¹ Exhibit MV01.

Year	Net sales (£)
2004	23,335,104
2005	24,467,063
2006	26,353,848
2007	28,117,834
2008	33,772,952
2009	40,853,872
2010	46,479,668

14. Ms Vincenti explains that PRADA clothing and accessories enjoy a large amount of publicity in the UK, in magazines, newspapers and online, particularly in fashion magazines. She lists several famous publications, such as national newspapers, Elle, Esquire, Grazia, Vogue and Vanity Fair. Some examples are shown in exhibit MV04. Some are fashion articles showing PRADA goods; some are pictures of celebrities which refer to the fact that they are wearing PRADA clothes or using PRADA accessories, such as bags. The prices shown in the publication extracts in exhibit MV04 (most of which are from 2010 or 2011) show, for example, £820 for a tote bag, £360 for a cotton shirt and £1495 for a weekend bag. Ms Vincenti states that PRADA's high profile is increased and maintained by pictures of celebrities wearing PRADA goods.

15. In relation to advertising, Ms Vincenti says:

“23. Prada engages in substantial advertising of their goods and services in the UK. The value, in Euros, spent on advertising in the UK in 2011 is EUR 2,273,609.”

There is a similar statement about global advertising of its goods and services in paragraph 11 of her witness statement. Exhibit MV06 shows three copies of advertisements featuring PRADA, all from 2011, in 10 Magazine and BecauseLondon.com. Ms Vincenti states:

“25. As can be seen from the foregoing, public relation, marketing, advertising and the analysis of these is very important to Prada.”

Apart from the reference to sponsoring an Italian international yachting team, these are the only references to advertising which appear in the opponent's evidence.

Decision

Proof of use of 2260362

16. Section 6(A) Act states:

- “(1) This section applies where—
- (a) an application for registration of a trade mark has been published,
 - (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
 - (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.
- (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
- (3) The use conditions are met if—
- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
 - (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.
- (4) For these purposes—
- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
 - (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
- (5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.
- (6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be

treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects—

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

17. The opponent has made a statement that it has used its earlier mark 2260362 on all the services for which the mark is registered. Although the applicant has not made any submissions about the opponent’s evidence in relation to proof of use (which it requested in its counterstatement), the onus is nevertheless on the opponent to prove genuine use of its mark, in relation to all the services for which it is registered, because section 100 of the Act states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

The relevant period during which genuine use of the mark must be shown is the five year period ending on the date of publication of the application, namely 9 April 2006 to 8 April 2011.

18. I will confine my assessment to the opponent’s *advertising; business management; business administration; office functions*. This is because (i) the opponent’s best case lies with these services, particularly *advertising*, and (ii) the remainder of the services are retail services and the other earlier mark, which is not subject to proof of use, also covers retail services. In relation to retail services, therefore, the opponent can rely upon the earlier mark which is not subject to proof of use. Although the list of retail services is more extensive in the mark which is subject to proof of use, as will be seen, it will not make a material difference when I come to comparing the parties’ services.

19. Ms Anna Carboni, sitting as the appointed person in, *PASTICCERIA E CONFETTERIA SANT AMBROEUS S.R.L. v G&D RESTAURANT ASSOCIATES LIMITED* [2010] RPC 28, summarised a set of principles from the following leading Court of Justice of the European Union (“CJEU”) cases on the issue of genuine use: *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01, [2003] ETMR 85; *La Mer Technology Inc v Laboratoires Goemar SA*, Case C-259/02, [2004] FSR 38; and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C-495/07, [2009] ETMR:

“(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

20. An assessment as to whether there has been use of the mark on *advertising; business management; business administration* and *office functions* which amounts to real commercial exploitation of the mark on the market for these services means that there must have been exploitation that is aimed at maintaining or creating an outlet for the services or a share in that market. That assessment must include consideration as to the nature of the opponent's services and the characteristics of the market concerned. Taking advertising services firstly, these are services for creating publicity. The essential function of a trade mark is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin. So the opponent's trade mark registration for advertising services must guarantee that the advertising services come from the opponent, not from another provider of advertising services. Paragraph 15 of my summary of the opponent's evidence shows that the only evidence pertaining to advertising is the opponent's advertising of its own business. That the opponent's goods and services are advertised does not show that it is involved in the advertising as an advertising agency. It is advertising its own goods. The opponent must demonstrate that it provides advertising services to others. The Collins English Dictionary (2000 edition) definition of 'services' is "work performed for remuneration". The opponent's advertising of its own business may serve to guarantee that its goods or retail services come from the opponent and no other undertaking, but it does not serve to create or maintain a market share in advertising services. It does not advertise for others but promotes its own goods as every other retail business promotes its own goods. It has not made genuine use of its trade mark in relation to advertising services in the relevant period.

21. The opponent cannot rely upon *business management; business administration* and *office functions* in this opposition because there is no evidence at all² in relation to these services. In summary, the opponent cannot rely upon *advertising; business management; business administration* and *office functions* of earlier mark 2260362 in these proceedings because there is no evidence to substantiate the claim that the trade marks have been used in relation to any of these services. As said earlier, the remainder of the services, which are all retail services, will not improve its position compared to the retail services of earlier mark 2399128, for which it does not have to prove use. My assessment of the grounds under section 5(2)(b) and 5(3) will be made on this basis.

² In *Laboratoire De La Mer Trade Marks* [2002] FSR 51, Jacob J said: "9 In the present cases, use was not proved well. Those concerned with proof of use should read their proposed evidence with a critical eye – to ensure that use is actually proved – and for the goods or services of the mark in question. All the t's should be crossed and all the i's dotted."

22. The leading authorities which guide me in relation to section 5(2)(b) of the Act are from the CJEU: *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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 he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) 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; *Sabel BV v Puma AG*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

Distinctiveness of the earlier mark

23. I should consider the distinctive character of the opponent's mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion³ (distinctiveness only has a bearing upon likelihood of confusion and not upon similarity of marks). The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public⁴. The opponent's evidence of use indicates that it is known for luxury fashion. I am aware of it, as a member of the general public, as a well known expensive (as opposed to chain store) fashion brand. Being known for fashion goods is not quite the same thing as laying direct claim to an enhanced level of distinctive character in relation to retail services, although retail of the goods is a service which is closely allied to the goods themselves⁵. PRADA is not a dictionary word and is not reminiscent of any dictionary word commonly known to the average consumer. Although it is the surname of the opponent's Italian founding family, it would not be recognised in the UK as a surname. Insofar as its reputation in the goods extends to the retail of the goods, the opponent is entitled to claim an enhanced level of distinctive character in its mark; however, it is already possessed of a high degree of inherent distinctiveness.

³ *Sabel BV v Puma AG* [1998] RPC 199.

⁴ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.


⁵ See, by analogy, the decision of the General Court in *Oakley, Inc v OHIM*, Case T-116/06.

Average consumer and the purchasing process

24. The average consumer is reasonably well informed and reasonably circumspect and observant, but his level of attention is likely to vary according to the category of goods or services. For the opponent's services, which are the retail of a variety of consumer goods, the general public is the average consumer who will make purchasing choices primarily visually, although I do not ignore the potential for aural use of the mark during the process. The average consumer for the applicant's services will be corporate or business customers who seek the services of a publicity agency to market or advertise their business or deal with their public relations. Public relations and marketing services might also be sought by an individual or, for example, a pop group. There will be a predominantly visual aspect to the selection of such services, for instance through a website or brochure detailing the services on offer, but there may also be an aural aspect, such as word of mouth recommendation within a particular industry. Levels of attention for the opponent's goods will vary according to price, and personal taste, but the level of attention for the applicant's services will be relatively high because they are important to the success of the business which makes the purchase.

Comparison of trade marks

25. The marks to be compared are:

Opponent's mark	Applicant's mark
	PRADVERTISING

26. The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details. Each party's mark is comprised of a single word. The opponent's mark does not lend itself to division and so it is the dominant and distinctive element of the opponent's mark. The applicant's mark is also a single word, but it clearly includes PR and ADVERTISING, both of which are descriptive of the services which it provides (recognition of the two elements does not artificially dismember the application). The distinctiveness of the applicant's mark lies in the combination of the two elements.

27. The opponent's mark is presented in a stylised typeface, but it is not heavily stylised and so the comparison will be made on the basis that the parties' marks

are both plain word marks. PRADA is a five letter mark and PRADVERTISING is thirteen letters long. The considerable difference in the length of the marks is one factor which contributes to the degree of visual difference between them. Against this is the fact that the first four letters are the same; however, on an overall visual analysis, this fact is somewhat lost because of the quantity of the remaining letters of the applicant's mark. Similarity between marks can arise because of similar beginnings, but it is no more than a rule of thumb which must be weighed as one of several factors. Visually, there is some similarity between the marks, but it is of a low degree.

28. The substantial difference between the marks in the number of syllables creates a significant point of difference aurally. The construction of the opponent's mark will be pronounced, in the UK, with a long middle 'a' sound, as in PRARDA. The recognition of the two elements of the applicant's mark will cause it to be pronounced as P-R-ADVERTISING. Even if it would, conversely, be seen as all one word, the construction of the applicant's mark, with the obvious word ADVERTISING contained within it, will be pronounced with a short 'a'. The second 'a' sound in the opponent's mark is entirely absent from the applicant's mark. The marks are aurally dissimilar.

29. PRADA, for the average consumer in the United Kingdom, does not have a concept: it is an invented word. PRADVERTISING is also an invented word, but contains, for the average consumer of its services, the abbreviation for public relations, PR, and the word ADVERTISING. Its concept is PR and advertising. Since there is no shared concept between the marks, they are not conceptually similar.

30. Overall, taking into account the varying levels of similarity (particularly lack of similarity) between the marks, the level of similarity is very low.

Comparison of services

31. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

'Complementary' was defined by the General Court ("GC") in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking...”.

Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

32. In *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 Jacob J held that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

Jacob J also said, in *Treat*:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade”.

33. Specifications should not be given an unnaturally narrow meaning, as per *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, although in the context of a non-use issue, the court considered interpretation of specifications:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use”.

34. The applicant’s services are *public relations; marketing; advertising; consultancy, advisory, analysis, report preparation and information services relating to the aforesaid services*. They are to be compared to the opponent’s

services, which are *the bringing together, for the benefit of others, of a variety of clothing, shoes, bags, leather goods and fashion accessories, perfumery and cosmetics, glasses, watches, sunglasses, jewellery, furniture, bed and table covers, sporting goods, telephones, mobile phones, games and playthings, enabling customers to conveniently view and to purchase those goods from a general merchandise catalogue by mail order or from the wholesale catalogue by mail order or by means of telecommunications, general merchandise internet websites and/or general merchandise computer networks.*

35. Neither side has made any submissions as to why the parties' respective services are similar or not similar. The silence from the opponent may perhaps be explained by its reliance upon the earlier mark for *advertising*, services which I have found it cannot rely upon because it failed to satisfy the proof of use provisions. The nature of the opponent's retail services is the sale of goods. This is not the same as advertising, marketing, PR or any of the other services in the application. The purpose of the respective services are not the same and the consumers are not the same. They do not operate from shared channels of trade. They are not important or indispensable in relation to each other so they are not complementary in such a way that the consumer would believe that they emanate from the same undertaking, and they are not in competition. Advertising companies do not rely upon or compete with retail stores. Retail stores advertise their own goods, but they do not provide advertising services to other undertakings. There is no coincidence between the parties' services within the parameters of the case law cited above. They are not similar.

Likelihood of confusion

36. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified. This includes keeping in mind the whole mark comparison and the principle of interdependency, whereby a lesser degree of similarity between the services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). In this case, not only have I found that the marks are similar only to a very low level, I have found that retail services are not similar to any of the applicant's services. In this respect, it would have made no difference if I had considered the longer retail services list in earlier mark 2260362.

37. The CJEU said in *Waterford Wedgwood plc v OHIM Case C-398/07*:

"35 It must be noted that the Court of First Instance, in paragraphs 30 to 35 of the judgment under appeal, carried out a detailed assessment of the similarity of the goods in question on the basis of the factors mentioned in paragraph 23 of the judgment in *Canon*. However, it cannot be alleged that the Court of First Instance did not take into account the distinctiveness of the earlier trade mark when carrying out that

assessment, since the strong reputation of that trade mark relied on by Waterford Wedgwood can only offset a low degree of similarity of goods for the purpose of assessing the likelihood of confusion, and cannot make up for the total absence of similarity. Since the Court of First Instance found, in paragraph 35 of the judgment under appeal, that the goods in question were not similar, one of the conditions necessary in order to establish a likelihood of confusion was lacking (see, to that effect, *Canon*, paragraph 22) and therefore, the Court of First Instance was right to hold that there was no such likelihood.”

38. Consequently, because there is no similarity between the parties’ services, there is no likelihood of confusion. However, for the sake of completeness, I observe that I would also not have found a likelihood of confusion even if the opponent had been able to rely upon its *advertising services* in 2260362 because the differences between the marks, and the high level of attention of the average consumer for advertising, are too great to lead to a likelihood of confusion.

39. The opponent’s section 5(4)(a) ground does not get it any further than its section 5(2) ground, because it is founded on the same mark, for retail stores and fashion items including clothing, shoes, bags and glasses, as the section 5(2)(b) ground. The differences between the marks, and the gap between the respective fields of activity, would not give rise to misrepresentation. **The section 5(2)(b) and 5(4)(a) grounds both fail.**

Section 5(3)

40. It is a pre-requisite of this section of the Act that the earlier mark has the necessary reputation at the relevant date, as per *General Motors Corporation v Yplon SA* [1999] E.T.M.R. 950. However, even if I were to find that the opponent has a reputation in PRADA for retail services, and I note that the applicant in its written submissions says that “PRADA is a world renowned fashion house specialising in luxury goods for men and women”, proving that there is a sufficient reputation is only the first step in the conditions necessary for success under section 5(3) of the Act. The opponent must also establish that there would be a link between the marks, as per the CJEU’s judgment in *Intel Corporation Inc. v CPM United Kingdom Limited*, Case C-252/07⁶.

6. “1. Article 4(4)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that whether there is a link, within the meaning of Case C-408/01 *Adidas-Salomon and Adidas Benelux*, between the earlier mark with a reputation and the later mark must be assessed globally, taking into account all factors relevant to the circumstances of the case.

2. The fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of such a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the conflicting marks.”

41. Owing to the differences between the trade marks and the nature of the business of the opponent, no link would be created and so the ground under section 5(3) of the Act must fail. **The section 5(3) ground fails.**

Outcome

42. The opposition fails. The application is to be registered.

Costs

43. The applicant has been successful and is entitled to an award of costs on the following basis⁷:

Considering the opposition and filing the counterstatement	£300
Considering the opponent's evidence and filing submissions	£500
Total:	£800

44. I order Prada S.A. to pay Frank Public Relations Limited the sum of £800. This sum is 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 22nd day of October 2012

Judi Pike
For the Registrar,
the Comptroller-General

⁷ As per the scale in Tribunal Practice Notice 4/2007.