

**In The Matter Of A Trade Mark Application By
First Principal Financial Planning Pte Ltd**

And

**Opposition Thereto By
Principal Financial Group, Inc**

*Before Principal Assistant Registrar P Arul Selvamalar
13 & 17 May 2004*

Trade Marks – Opposition to registration – Likelihood of deception or confusion – Whether the Opponents had a reputation in their marks - section 15

Trade Marks – Opposition to registration – Whether the Application mark nearly resembles the Opponents' registered trade marks - section 23

Trade Marks – Opposition to registration – Bona fide claim to proprietorship of the mark – whether the applicants are the rightful proprietor of the mark - section 12(1)

Trade Marks – Opposition to registration – whether the applicants had a bona fide intention to use the mark applied for – whether the Registrar may exercise her discretion under section 12(2)

Trade Marks – Opposition to registration – Distinctiveness - whether the mark which was a company name is represented in a special or particular manner – sections 10

The Applicants, First Principal Financial Planning Pte Ltd, applied to register a circular device mark with the words FIRST PRINCIPAL FINANCIAL PLANNING PTE LTD below it (“the Applicants’ Mark”) on 19 November 1998 for “Accident insurance underwriting; administration of financial affairs; arranging of insurance; financial advice; financial consultancy; financial evaluation [insurance, banking, real estate]; financial information; financial management; financial sponsorship; financial services; health insurance underwriting; insurance claims assessment; insurance plans (administration of); insurance research; insurance brokerage; insurance consultancy; insurance information; insurance underwriting; investment portfolio management; life insurance underwriting; medical insurance; pension services; travel insurance; all included in class 36”. The Opponents, Principal Financial Group Inc, filed an opposition on the basis that the Applicants’ Mark is not distinctive, that the Applicants are not the bona fide proprietors of the mark, that the mark is likely to deceive or cause confusion and that the mark nearly resembles their mark under sections 10, 11, 12, 15 and 23 and 24 of the Trade Marks Act [Cap 332, 1992 Rev Ed]. The Opponents are an American multinational company with an international reputation in providing insurance and investment services. They are also proprietors of the mark, “The Principal Financial Group” with a triangular device (“the Opponents’ Mark”) in Classes 16, 35, 36 and 42, all registered in Singapore as of 19 January 1998.

Held, disallowing registration,

1. The opposition under section 15 succeeded because it was found that the Opponents possessed an international reputation in the Opponents’ Mark before 1998 and that there would be confusion among the Singaporean public if the Applicants’ Mark proceeded to registration. Although there was little evidence to show that the Opponents’ services were available to the Singaporean public before 1998, the Opponents had extensive international media coverage and impressive global advertising figures. In light of the Tiffany case which held that there need not be use of the foreign mark in Singapore for Singaporeans to have knowledge, cognizance and awareness of the foreign mark, it was found that Singaporeans would have knowledge, cognizance and awareness of the Opponents’ Mark because of its international reputation. Marks are remembered by general impressions and without perfect recollection. Hence, the average consumer is less likely to remember the geometric shapes in the marks in question rather than the words Principal and Financial which appear in both marks. The average consumer will remember the word, “Principal”, which is the significant feature in both marks and therefore confusion would result.
2. The opposition under section 23 succeeded as the Opponents had prior registrations for the mark The Principal Financial Group in class 36 and the marks were found to be confusingly similar for the same reasons given with respect to the comparison of marks under section 15.

3. The opposition under the second limb of section 12 (1) succeeded. While the Applicants did not say that they were no longer interested in the Applicants' mark, they did state that their change of name to "First Principal Financial Pte Ltd" was prompted by their desire to be pioneers in the industry and the fact that there was a surge in the number of companies wanting to use the word, "Planning", as part of their company names. The Applicants also applied for the registration of the mark, "First Principal Financial", on 26 September 2002. On these facts, it was inferred that the Applicants had no intention to use the Applicants' Mark and that they will be identifying their services under their new mark, "First Principal Financial".
4. The opposition under first limb of section 12 (1) failed. Although the marks are similar the only inference that may be drawn is not that the Applicants had copied the Opponents' mark. The word, "Principal", is not an invented word and it is not so novel to use this word for financial services that the inference should irresistibly be drawn.
5. The opposition under section 10 failed. The Applicants' Mark consisting of their company name was represented in a special or particular manner as there is an additional circular device.

Per Curiam

The Applicants submitted that there was honest concurrent use of their mark with the Opponents mark, at the hearing of the opposition and that the Registrar should also consider section 25 of the Trade Marks Act. However they had not pleaded section 25 in their Counter Statement. The Registrar will not consider grounds that are not pleaded in the Notice of Opposition or Counter Statement even if it forms part of the submissions of the hearing.

Provisions of Legislations discussed:

- Trade Marks Act (Cap 332, 1992 Rev. Ed.) sections 10, 11, 12, 15, 23, 24, and 25.

Cases referred to:

- Celine S A TM [1985] RPC 381
- Jellinek's TM [1946] 63 RPC
- Smith Hayden & Co's Application (1946) 63 RPC 97
- Kellogg Co v Pacific Food Products Sdn Bhd [1999] 2 SLR 651
- The Pianotist Co's Application (1906) 23 RPC 774
- The European Limited v The Economist Newspapers Limited [1996] FSR 431
- Harrods Application [1935] 52 RPC 65
- Coca-Cola Canada v Pepsi Cola Canada [1942] 59 RPC 127
- The Polo/Lauren Company L P v United States Polo Association [2002] 1 SLR 326
- Jet Aviation (S) Pte Ltd v Jet Maintenance Pte Ltd [1998] 3 SLR 287
- Riviera Leisurewear Pty Ltd v J Hepworth & Sons [1987] 9 IPR 305
- Amway Corp'n & Anor v Eurway International Limited [1974] RPC 82
- Euromarket Designs Inc v Peters and Crate & Barrel Ltd [2001] FSR 20 288
- Alex Pirie & Sons [1933] RPC 147
- Rawhide TM [1962] RPC 133
- Tiffany & Co v Fabriques de Tabac Reunies SA [1999] 3 SLR 147
- The Pianotist Co's Application (1906) 23 RPC 774
- Bali TM [1996] RPC 472
- Edward Hack's Application (1941) 58 RPC 92
- Application by S T Dupont (UK Patent Office, unreported)
- Application by Tony Knight (UK Patent Office, unreported)
- Re Wong Seng & Son Bhd's Application and Salamander AG's Opposition [1993] AIPR 252
- De Cordova v Vick (1951) 68 RPC 103
- Swiss Miss TM [1997] RPC 219
- Shell & Co (Aust) Ltd v Rohin & Haas [1949] 78 CLR 601
- R H Macy & Co Inc v Trade Accents [1992] 1 SLR 581
- The Seven Up Co v O. T. Ltd & Anor [1947] 75 C.L.R 203
- GYNOMIN TM (1961) RPC 408
- Thunderbird Products Corporation v Thunderbird Marine Products Pty Ltd [1974] 131 C.C.R. 592
- Application by Team Lotus Ventures Ltd (UK Patent Office, unreported)
- Gromax Plasticulture Ltd v Low Nonwovens Ltd [1999] RPC 367
- In the Matter of an Application by Fanfold Ltd [1928] R.P.C. 325

- Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd [1991] SLR 133
- Newsweek Inc v British Broadcasting Corporation [1979] RPC 441

Representation:

- Ms Theresa O'Connor (Infinitus Law Corporation) for the Applicants
- Mr P Sivakumar and Zechariah Chan (P Sivakumar & Co) for the Opponents