

**In The Matter of a Trade Mark Application No. T02/14847F by
First Principal Financial Pte Ltd**

And

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

*Before Principal Assistant Registrar Mr. Louis Chan Ken Yu
19 & 21 October 2005*

Trade Marks – Opposition to registration – Distinctiveness – whether the Application Mark satisfies the definition of a trade mark under Section 2(1) and the requirements under Section 7(1) of the Trade Marks Act. [Cap.332, 2005 Ed.]

Trade Marks – Opposition to registration – whether the application to register is made in bad faith – Section 7(6) of the Trade Marks Act [Cap.332, 2005 Ed]

Trade Marks – Opposition to registration - Likelihood of confusion – whether the Application Mark is identical with or 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 – Section 8(1) and 8(2) of the Trade Marks Act [Cap.332, 2005 Ed]

Trade Marks – Opposition to registration – Honest Concurrent Use – factors to be considered – Likelihood of confusion - Section 9 of the Trade Marks Act [Cap.332, 2005 Ed]

The Applicants are a Singapore company who applied for registration on 26 September 2002 for the mark, “FirstPrincipal Financial (series of 2)” (“the Applicants’ Mark”), in respect of insurance and related services in Class 36. The first mark is in black and white, while their second mark is in colour, with the words “First Principal” and the words “financial” at the bottom. The Applicants were first incorporated under the name First Guardian Life Planning Pte Ltd and were registered as a Life Insurance Brokerage Firm by the Life Insurance Association of Singapore. When MAS, decided to allow independent financial advisors to offer investments products and advice, the Applicants changed their name to First Principal Financial Planning Pte Ltd and they retained the word “First” to reflect pioneer venture into independent financial advice services and that the word “Principal” was used as they acted as the principal not as an agent with clients.

The Opponents are an American company who own registrations for the mark, “thePrincipal with a triangle device” and the words, “Financial Group”, and Chinese versions of the mark, in classes 16, 35, 36 and 42. For the purposes of the opposition, the Hearing Officer relied upon T98/00491H “thePrincipal Financial Group and triangle device” (“the Opponents’ Mark”), since the Applicants’ Mark that is being opposed is also in Class 36.

The Opponents were originally known as The Bankers Life Association but they changed their name to Principal Financial Group in 1985. They have a reputation in Singapore in providing group, life and health insurance and investments services, and have invested in Singapore stocks and bonds. The Opponents are, however, not authorized to offer insurance services in Singapore, and such insurance services are arrange through MIA and a company authorized to offer such services in Singapore.

The Opponents argued that the Applicants’ Mark should not be registered as it is confusingly similar to the Opponents’ Mark under section 8 (1) and (2) of the Trade Marks Act (Cap. 332, 2005 Ed.) (“the Act”) and would be contrary to the law of passing off under section 8(7)(a) of the Act as well. Further, they alleged that the application was filed in bad faith under section 7(6) and that the Applicants’ Mark was not distinctive under section 7(1) and thus did not satisfy section 2(1) of the Act.

Held, disallowing the registration

1. The opposition under Section 8(2) succeeds. The Opponents’ Mark would be remembered by the word, PRINCIPAL, as it is the distinctive feature. The words, THE PRINCIPAL FINANCIAL GROUP, is superimposed on a triangle device and as such, the word, “PRINCIPAL”, stands out prominently in the mark. The average consumer is unlikely to remember the triangle device as it is a mere geometric shape. The Applicants’ advertisements contains use of the words, “FIRST PRINCIPAL”, with the word

“PRINCIPAL” in bold font, while the word “FIRST” was in a thinner font, emphasising the word “PRINCIPAL” as well. The common denominator in all these evidences relates to the word, “PRINCIPAL”, and not to the other descriptive words, “FIRST” or “FINANCIAL”. Thus, there is a similarity of the two marks as an average consumer is likely to remember the word, “PRINCIPAL”, which is the significant feature of both marks. As the Opponents’ specifications are wide and would cover all of the services claimed under the Applicants’ mark, the services provided by both parties are identical. As the Opponents’ Mark contain the word “Group” and when read together may suggest that the Applicants’ Mark is one of the other marks in the group, this will cause a likelihood of confusion on the part of the public.

2. The opposition under Section 8(1) fails. Under Section 8(1) of the Act, the requirement of identity of marks should be interpreted strictly as the identity of marks and identity of goods leads to a presumption of confusion. The Opponents’ mark “the Principal Financial Group and triangle device” and the Applicants’ mark which is “FirstPrincipal Financial” is in black and white, while their second mark is in colour, with the words “First Principal” and the words “financial” at the bottom are not identical and they do not contain differences so insignificant that they may go unnoticed by an average consumer.
3. The plea of honest concurrent use under Section 9 fails. Honest concurrent use was a relevant factor to be considered in the global consideration of whether there was a likelihood of confusion between the two marks. CODAS Trade Mark [2001] 14 RPC 240. However, the Applicants’ evidence does not lead to the conclusion that there is no likelihood of confusion under Section 8(2)(b) because there is insufficient evidence of use of the Applicants’ Mark in respect of the services claimed.
4. The question of distinctiveness under this section is to be determined by reference to the mark under consideration only and not by comparing the mark with other marks. It is only under section 8 that such relative grounds for refusal may be considered. Since the Applicants’ Mark is capable of distinguishing their goods, the opposition under section 7(1) fails.
5. The plea of bad faith under Section 7(6) fails as there is insufficient evidence on the facts to make an inference of bad faith.

Provision of legislation discussed:

- Trade Marks Act 1998 [Cap.332, Rev Ed.] Sections, 7(1)(a), 7(6), 8(1), 8(2)(a) and 8(2)(b).

Cases Referred to:

- First Principal Financial Planning Pte Ltd v Principal Financial Group, Inc [2004] SGIPOS 11
- Reebok International Ltd v Royal Corp [1998] 1 SLR 921
- Fedelitas Shipping Co Ltd v V/O Exportchleb [1966] 1 QB 630 at 640
- King v Hoare (1844) 13 M & W 494, 504; 153 ER 206
- In The Matter of Application Number 81256 for a Declaration of Invalidity of Trade Mark Number 2148699 in the name of Timeshare Council (UK Trade Marks Registry, unreported)
- Staiger (UK trade Marks Registry, unreported)
- Pan-West (Pte) Ltd v Grand Bigwin Pte Ltd [2003] SGHC 250
- SA Societe LTJ Diffusion v SA Sadas 2003 FSR 608
- Akitebolaget Volvo v Heritage [2000] FSR 253
- In the Matter of a Trade Mark Application by Trend Promoters (Malaysian) Sdn Bhd and Opposition Thereto by Simmons Company
- In the Matter of a Registration No. 2053772 of the Trade Mark: EASTERN NATIONAL in the name of FirstGroup plc (unreported)
- The European Limited v The Economist Newspaper Limited [1996] FSR 431
- Newsweek Inc v British Broadcasting Corporation [1979] RPC 441
- Richemont International SA v Goldlion Enterprise (Singapore) Pte Ltd [2005] SGHC 208
- Re Wong Seng & Son Bhd’s v Salamander AG’s [1993] AIPR 252
- De Cordova v Vick [1951] 68 RPC 103
- Torremar [2003] RPC 89
- The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2005] 4 SLR 816; [2005] SGHC 175
- CODAS Trade Mark [2001] 14 RPC 240
- Road Tech Computer Systems Ltd v Union Software (U.K.) Ltd [1996] FSR 805
- ESP Easterners Strong Pills (UK Registry, unreported)
- Pro Sport (UK Registry, unreported)
- Val D’siere (UK Registry, unreported)
- Tiffany & Co. v Fabriques de Tabac Reunies SA [1999] 3 SLR 147

- RH Macy & Co Inc v Trade Accents [1992] 1 SLR 581
- The Seven Up Co v O.T.LTD & ANOR 75 C.L.R. 203
- “GYNOMIN” Trade mark (1961) RPC 408
- Thunderbirds Products Corporation v Thunderbird Marine Products Pty Ltd
- McDonald’s Corp v Future Enterprises Pte Ltd [2005] 1 SLR 177
- Royal Enfield TM [2002] RPC 24

Representation:

- Ms Teresa O’Connor (Infinitus Law Corporation) for the Applicants
- Mr. Sivakumar (M/s Joseph Lopez & Co) for the Opponents