

TRADE MARKS ACT, 1996

Decision in Hearing

IN THE MATTER OF a request for protection of International Trade Mark No. 817072 and in the matter of an opposition thereto.

PIRELLI & C. S.p.A.

Holder

ZERO INTERNATIONAL HOLDING GmbH & CO.

KOMMANDITGESELLSCHAFT

Opponent

International registration

1. Pirelli & C. S.p.A. of Via Gaetano Negri, 10, 1-20123 Milano, Italy, is the Holder of International Trade Mark Registration No. 817072 in respect of the trade mark, P ZERO (shown below), which was registered by the International Bureau of the World Intellectual Property Organisation as of 14 October, 2003 in Classes 14, 18, and 25 for the goods listed hereunder:

P ZERO

Class 14: *Silverware, timepieces, jewellery.*

Class 18: *Travel goods, leather products.*

Class 25: *Clothing, shoes, headwear.*

2. The international registration includes a claim to a right of priority on the basis of an application for registration filed in Italy on 13 August, 2003.

Request for extension of protection to the State

3. Ireland is one of the countries designated under the international registration and, by notification dated 12 February, 2004, 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 Regulations 3 and 4, respectively, of

the Trade Marks (Madrid Protocol) Regulations, 2001 (S.I. 346 of 2001), the Trade Marks Act, 1996 (the Act) and the Trade Marks Rules, 1996 (the Rules) apply to the request for protection as they apply 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 for protection and advertised accordingly in Journal No. 1993 on 5 May, 2004.
5. Notice of opposition to the granting of protection to the mark pursuant to Section 43 of the Act was filed on 8 July, 2004 by Zero International Holding GmbH & Co. Kommanditgesellschaft of Hemelinger Str. 16-18, 28205 Bremen, Germany. The Holder filed a counter-statement on 12 October, 2004 and evidence was subsequently filed by the parties under Rules 20, 21 and 22 of the Rules.
6. The matter became the subject of a hearing before me, acting for the Controller, on 26 April, 2007. The parties were notified on 22 May, 2007 that I had decided to uphold the opposition and to refuse the request for protection of the mark. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Opponent pursuant to Rule 27(2) filed on 6 June, 2007.

Scope of the opposition

7. The opposition is based on the Opponent's trade mark ZERO, which is registered as a Community Trade Mark under No. 1051515, the application for registration having been filed on 22 January, 1999 and the mark registered on 2 April, 2004, in respect of the following goods in Classes 3, 14, 18 and 25.

Class 03: *Cosmetic soaps; perfumery, essential oils, cosmetics.*

Class 14: *Jewellery, including fashion jewellery and belt buckles; clocks and watches, watch straps.*

Class 18: *Leather belts, bags, pouches, trunks, travelling bags, cases for credit cards and keys, handbag purses, pocket wallets, leather gloves.*

Class 25: *Clothing including leather clothing, gloves (not included in Class 18), scarves, handkerchiefs, belts (not included in Class 18); footwear; headgear.*

8. On the basis of that registration, the Opponent asserts that there is a likelihood of confusion on the part of the public and that the present request for protection of the Holder's mark is objectionable under Section 10(2)(b) of the Act. Several other grounds of opposition were included in the notice of opposition filed but these were not subsequently substantiated by any evidence or argument and were not pursued by the Opponent's representative at the hearing of the opposition.

The evidence¹

Rule 20

9. Evidence submitted by the Opponent under Rule 20 consisted of a declaration (and Exhibits ZI1 and ZI2), dated 6 April, 2005 of Reinhard Fischer, its General Manager. He says that the Opponent has used its trade mark ZERO extensively in Germany and elsewhere, particularly in relation to clothing and he exhibits some material downloaded from the internet relating to the Opponent and showing the manner of use of the trade mark.

Rule 21

10. Evidence submitted by the Holder under Rule 21 consisted of a declaration (and Exhibits P1 and P2) dated 29 June, 2006 of Pier Giovanni Giannesi, who is described as its Proxy Holder. He says that the Holder is an internationally recognised company engaged through licensing arrangements in the production and sale of a wide range of goods, including clothing, watches, jewellery, travel goods and leather products. It commenced selling products under the trade mark PZERO through its licensees in 2002 (Mr. Giannesi exhibits extracts from the Holder's website showing the use of the mark). The Holder uses the mark

PZERO in conjunction with other words, such as PZERO COLLECTION, PZERO NERO, PZERO ROSSO, PZERO ARIA and PZERO TEMPO. In each case, the mark PZERO is distinguishable from the remaining element and readily discernible as a separate trade mark identifying the Holder's goods. A search of the Irish and Community Trade Mark Registers (results exhibited) discloses numerous marks in Classes 3, 14, 18 and 25 incorporating the word ZERO, which is a common term with regard to the goods for which the Opponent's mark is protected.

Rule 22

11. Evidence submitted by the Opponent under Rule 22 consisted of a further declaration (and Exhibit ZI3) dated 25 August, 2006 of Reinhard Fischer, which does not add anything of significance to the facts already in evidence.

The hearing and arguments of the parties

12. At the hearing the Opponent was represented by Mr. Cliff Kennedy, Trade Mark Agent of MacLachlan & Donaldson and the Holder by Mr. Simon Gray, Trade Mark Agent of Tomkins & Co.

13. Ms. Kennedy argued that there was a likelihood of confusion on the part of the public in view of the identity of the goods and the high degree of similarity of the respective trade marks. In this regard, he noted that the Holder's mark as registered by the International Bureau is P ZERO and not PZERO, as referred to in the Holder's evidence under Rule 21. There is a clear separation between the letter P and the word ZERO such that the latter is clearly identifiable as a separate and distinct element of the trade mark. In Mr. Kennedy's submission, that word is the dominant and distinctive element of the Holder's mark and the fact that it is identical with the Opponent's earlier trade mark means that confusion between the two is inevitable.

14. Mr. Gray responded to the effect that the opening letter P in the Holder's mark renders it visually, aurally and conceptually different from the Opponent's earlier

¹ review of the evidence confined to matters or relevant fact or claimed fact

trade mark. He stressed in particular the established principle that the first part of a word mark has particular significance in terms of its visual and phonetic impact and pointed out that the first syllables of the respective marks in this case are markedly different. The Opponent's mark consists of the ordinary dictionary word ZERO, which has a limited distinctive character and the inclusion in the Holder's mark of the prefix P, which is an integral part of that mark and not severable from the whole, is sufficient to distinguish the Holder's goods, particularly having regard to the fact that the average consumer of the goods at issue is likely to be quite brand-aware and discerning in his selections.

Grounds of decision

15. 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 that are identical with or similar to those 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 facts that, (i) the Opponent's Community Trade Mark No. 1051515 is an earlier trade mark as against the present request for protection and, (ii) the goods for which protection is sought are identical with or similar to those in respect of which the earlier trade mark is protected are not in dispute in this case. The argument turns on the extent of the similarity of the respective trade marks and whether there is a likelihood of confusion.

Similarity of the marks

16. The respective trade marks in this case are the Opponent's ZERO, which is registered in lower case lettering as "zero" and the Holder's P ZERO, which is presented in a specific, slightly stylised bold font, tending to diminish the visual separation of the P and the ZERO but not obliterating it entirely. While those points of detail in the manner of presentation of the respective marks are, no doubt, of some importance to their proprietors in terms of their respective brand images, they are not significant considerations in the comparison of the marks for the purposes of the assessment of the likelihood of confusion on the part of the average consumer. That is because, as the European Court of Justice has noted in

*Sabel BV v Puma AG and Rudolf Dassler Sport (Case C-251/95)*², the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. For this reason, the appreciation of the visual, aural and conceptual similarity of the marks must be based on the overall impressions given by them, rather than on specific points of detail that are likely to go unnoticed by the average consumer.

17. The overall impression given by the Opponent's mark is, quite simply, the word ZERO, an ordinary dictionary word having a clear and unmistakable meaning. The overall impression given by the Holder's mark is of that same word with the letter P before it. The P does not qualify the word ZERO in any meaningful way (unlike, for example, as in SUB-ZERO, GROUND ZERO or YEAR ZERO) and the average consumer is likely, therefore, to perceive the essential connotative identity of the mark by reference to the word ZERO. Nor does the P significantly reduce the visual or aural similarities between the marks because it does not in any way distort or obscure the word ZERO, which is clearly visible and audible as a separate and distinct element of the Holder's mark.
18. The degree of similarity between the marks which results from the inclusion of the word ZERO in the both marks is heightened further, in my opinion, by the fact that that word is the dominant and distinctive component of the Holder's mark. Because the meaning or significance of the P in the Holder's mark is not specified or known, whereas the word ZERO has a clear meaning, it seems to me likely that the latter would dominate the perception of the mark in the mind of the average person. To the extent that the mark conveys a message that may fix itself in the mind of the consumer, that message is created by the word ZERO, which, being the larger of the two elements comprising the mark, is also visually and aurally its dominant element.
19. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Kliijssen Handel BV (Case C-342/97)*, the European Court of Justice indicated that, having determined the degree of visual, aural or conceptual similarity between marks, one should, "where

² paragraph 23 of decision dated 11 November, 1997

*appropriate, evaluate the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed”*³. While the present request for protection covers a range of different goods in different Classes, it may fairly be said that a feature common to all is that brand identity plays an important part in the purchasing decision of the average consumer, who may be expected to pay a premium for goods bearing a desirable brand. The goods in question are normally displayed for sale in retail outlets in which the customer has the opportunity to view and examine them, so that they are not ordered by name by the customer but are selected following a visual inspection. In such circumstances, the visual aspect of the comparison between trade marks becomes more important than the aural comparison. Also, in the case of trade marks consisting of words⁴ that have clear meanings, brand identity is apt to reside in the collection of concepts evoked by the name in question (e.g. PRINCIPLES, NEXT, CITIZEN) and, in such cases, the comparison of the marks on conceptual criteria is of greater importance still.

20. In view of the obvious visual similarity of the marks ZERO and P ZERO and having regard, in particular, to the fact, firstly, that ZERO is the dominant component of the latter mark and, secondly, that there is a close correlation in the conceptual significance of the marks, which is an important consideration in the context of word marks having clear meanings, I find that the marks in this case are very closely similar.

Likelihood of confusion

21. The likelihood of confusion must be assessed globally having regard to all of the relevant factors, including the degree of similarity between the trade marks, the nature of the goods and the circumstances of the trade in them as well as the presumed expectations of the average consumer, 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 instead on the imperfect picture of them that he keeps in his mind. The question must, therefore, be looked at from the perspective of the average consumer of the goods at issue, who is

³ paragraph 27 of decision dated 22 June, 1999

⁴ other than personal names, which are widely used as trade marks for these types of goods

already familiar with the relevant goods sold under the earlier trade mark, ZERO (in the manner in which it is registered) and who is exposed in the course of a typical shopping experience to the like goods bearing the mark P ZERO (in the manner as applied for).

22. In my opinion, such a person could not but be reminded of the Opponent's trade mark upon encountering goods marketed under the sign for which the Holder seeks protection. After all, the word ZERO is the predominant element of that sign and a person familiar with the Opponent's ZERO brand is bound to recall that brand upon seeing the sign used in relation to the same categories of goods. Not only that, but he is also likely to make a connection in his mind between the sign and the earlier trade mark because the sign reproduces the mark in its entirety and the only additional element in the sign – the letter P – does not serve to imbue with a sufficiently different overall identity to that of the mark such that they might be perceived as separate and unrelated. In this regard, I do not accept the argument advanced on behalf of the Holder to the effect that the Opponent's trade mark displays only a low level of distinctiveness in the context of the goods at issue and that consumers would not be surprised to find those goods offered for sale under another trade mark incorporating the word ZERO and, therefore, would not make a connection between the marks on that account alone. In my opinion, the Opponent's mark is a perfectly distinctive and memorable trade mark for the goods in respect of which it is protected. While the digit 0 might appear on certain of those goods, e.g., as part of the number 10 on the face of a watch or in a clothing size, the word ZERO is not at all descriptive or otherwise lacking in distinctiveness as a trade mark for the goods in question.

23. The connection that I believe would be made by the average consumer between the respective trade marks is such as to constitute the kind of confusion that Section 10(2) of the Act seeks to avoid. Allowing for imperfect recollection on the part of the average person, there is a very real danger of direct confusion, whereby the consumer perceives goods bearing the trade mark P ZERO to be one and the same as those that he has previously experienced and identified by the trade mark ZERO. Even in the case of the consumer who perceives the difference between the marks and recalls that the brand he has seen in the past was simply

ZERO and not P ZERO, there is a very real likelihood that he will assume that goods bearing the latter mark constitute a particular line of goods within the ZERO brand range. In either scenario, there is confusion and, for the reasons that I have stated, I think there is a strong likelihood that such confusion will occur. I have decided, therefore, that the request for extension to the State of the protection resulting from the international registration should be refused under Section 10(2)(b) of the Act.

Tim Cleary
Acting for the Controller

22 June, 2007