BL O/0422/26

TRADE MARKS ACT 1994
IN THE MATTER OF UK APPLICATION NO 3974393 IN THE NAME OF NATALIA BUZZETTI

AND IN THE MATTER OF OPPOSITION THERETO UNDER NO 446002 BY THE POLO/LAUREN COMPANY LP

DECISION

Introduction

1. This is an appeal by Polo/Lauren Company LP ("***the opponent***") against the Decision of R. Le Breton, acting on behalf of the Registrar of Trade Marks, dated 27 November 2025 (O-1120-25)("***the Decision***"). In the Decision the opposition was dismissed in its entirety and the Trade Mark Application No 3974393 ("***the application***") in the name of Natalia Buzzetti ("***the applicant***") was accepted for registration subject to any appeal.

2. The application was filed on 1 November 2023 for the mark shown below.

The application was made with respect to various goods in classes 3, 18 and 25.

3. On 23 February 2024, the opponent filed an opposition. The sole ground of opposition was section 3(6) of the Trade Marks Act 1994 ("***the 1994 Act***") relying upon a previous settlement agreement between the parties dated 16 April 2018 ("***the Settlement Agreement***")[1]. Two broad points were relied upon by the opponent. First that the application constituted a breach of the Settlement Agreement; and second that

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[1] By order made on behalf of the Registrar dated 22 October 2024 the Settlement Agreement which was contained in Exhibit B to the witness statement of Alice Pang dated 18 July 2024 was not to be made available for public inspection. However, *'[i]t was also noted that the terms of the settlement set out at paragraph 5 of Ms Pang's witness statement may be discussed and disclosed in any final decision issued.'* At the hearing of the appeal, I directed that for the avoidance of any doubt that the confidentiality order made by the Registrar should be continued.

the application was an attempt to undermine the purpose of the Settlement Agreement.

4. In the Counterstatement the applicant admitted the existence of the Settlement Agreement but denied all the contentions put forward by the opponent to support its case that the application was made in bad faith.

5. Both parties filed evidence. Both sides filed written submissions in lieu of a hearing. Neither side requested a hearing and therefore the Hearing Officer made the Decision on the basis of the materials before them.

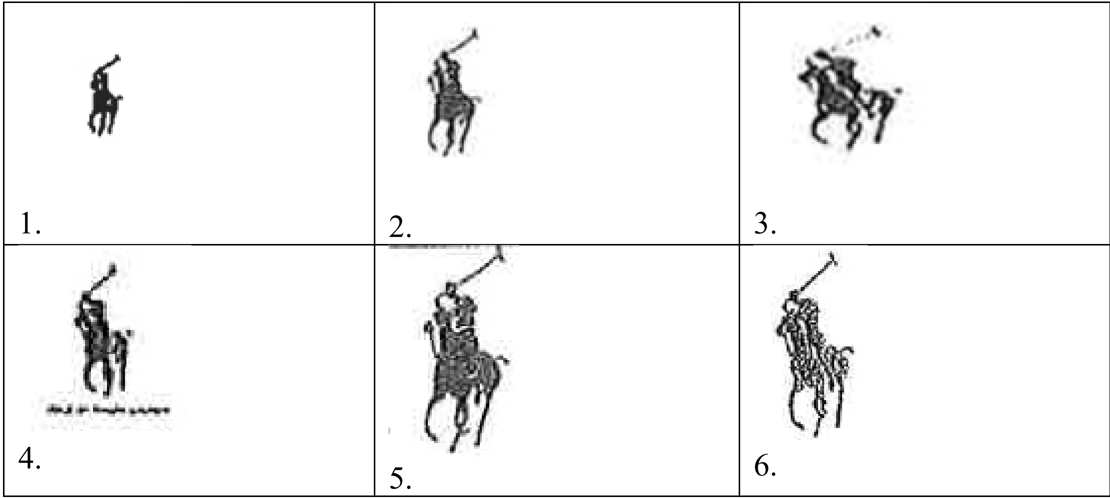
6. As noted above the opposition was dismissed in its entirety.

The Settlement Agreement

7. The Settlement Agreement is the crux of the dispute between the parties. I therefore set out the paragraphs in the Decision in which the Hearing Officer described the Settlement Agreement. The footnotes are as per the Decision.

> 21. The agreement provided is relatively short, spanning 5 pages in total and including both the English and Italian version of the same. The agreement states:[2]
>
> " 1. PRL is worldwide known to be the owner of many famous brand (sic) among which are RALPH LAUREN and the Polo player design
>
>
>
> 2. The Polo Player Trademark has been protected in all the most important countries of the world […]"
>
> 22. The agreement then goes on to set out (as a "mere example") some of the registrations in Italy owned by the opponent. It provides images of the following marks:

[2] The "Polo player design" hereinafter referred to as the PRL Polo Player design within this decision.



23. Registration numbers are provided for each of the marks above, and I note mark number 6 is an EU trade mark application. The agreement then sets out the EU trade marks as applied for by the applicant, and which appear to have been the catalyst for the dispute and settlement between the parties. These are as follows:

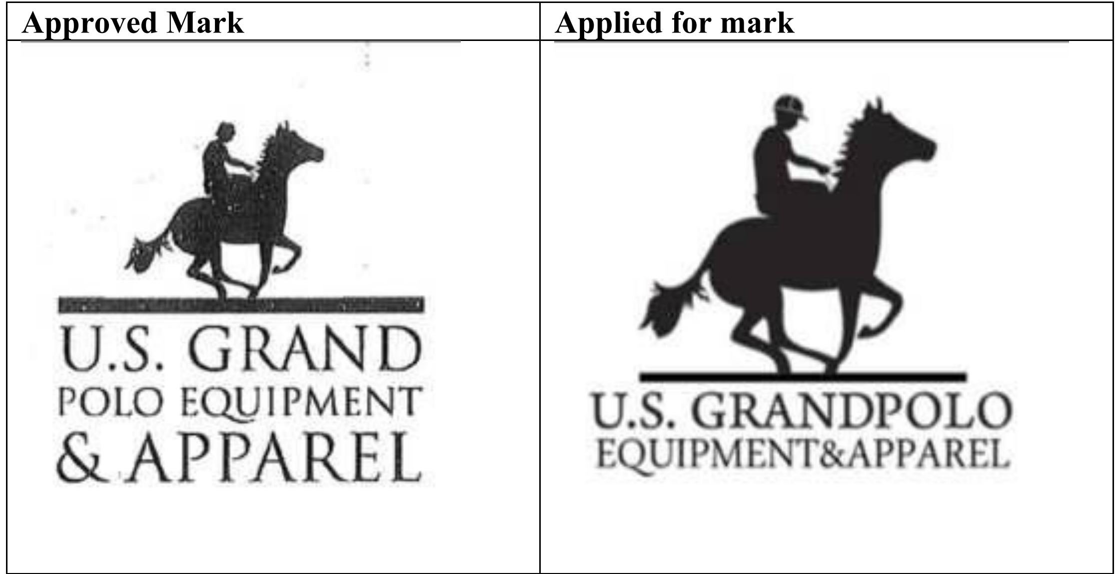
24. The agreement then goes on to set out (amongst other things) as follows:

> "Now therefore, the parties agree as follows:
> A. […]
> B. Mrs BUZZETTI, recognises [the opponent's] prior rights on the [PRL Polo Player design] registered/used alone or in combination with other figurative and/or verbal elements;
> C. MRS BUZZETTI undertakes
> a) […]
> b) Not to file/use any more trade marks identical and/or similar and/or liable to be confused with the PRL Polo Player design […];
> c) […]
> d) […]
> D. In addition, Mrs BUZZETTI undertakes:

a) To adopt, if deemed appropriate, the new trademark represented in the Enclosure A;
b) Said new trademark is the one that will be filed/used for products of classes 16, 18 and 25 or for similar ones;
c) Never to amend said trademark by adding verbal and/or figurative elements that could make it similar and/or liable to be confused with the PRL Polo Player design […];
d) Never to adopt trade dress for the products countersigned by the trademark shown in Enclosure A similar and/or liable to be confused with PRL one."[3]

25. The agreement goes on to confirm that it will be executed in both English and Italian, but that English will be the prevailing language in case of a dispute. It states that the applicable law for any dispute arising out of or in connection with the agreement is Italian law in the case that the applicant is the defendant. The agreement itself is dated 16 April 2018, prior to the relevant date in these proceedings.

26. The approved mark as provided in "Enclosure A" to the agreement and also as provided within the opponent's final written submission (where it is not subject to a confidentiality order), as well as the applied for mark in this instance, are set out below:



The appeal

8. The opponent appealed. It relied upon three overarching grounds of appeal which can be summarised as follows:

(1) The Hearing Officer failed to consider both of the points relied upon in support of the section 3(6) ground. It was maintained that the Hearing Officer

[3] I do not consider that the agreement or evidence makes it clear what is meant by "PRL one."

neglected to address the issue as to whether the application was an attempt by the applicant to undermine the purpose of the Settlement Agreement.

(2) To the extent that the Hearing Officer did consider the issue that the application was an attempt to undermine the purpose of the Settlement Agreement the Hearing Officer erred by:

(i) Addressing both grounds under the section 3(6) ground together as the one issue rather than separately.

(ii) Failing to consider or properly consider the purpose of the Settlement Agreement.

(iii) Discounting the relevance of the applicant's trade mark registrations to the assessment of one of the purposes of the Settlement Agreement namely being to approve the specific form of wording to be used in the Approved Mark.

(iv) Failing to give proper consideration to the impact of the differences between the Approved Mark and the application.

(3) In considering whether or not the application constituted a breach of the Settlement Agreement the Hearing Officer erred in (i) only considering breach of one clause of the Settlement Agreement namely clause D(b); (ii) their construction of clause D(b); and (iii) to the extent that the Hearing Officer considered breach of clauses C(b) and D(c) erred in their construction.

9. There was no appeal against the findings in paragraphs [41] to [43] of the Decision with respect to the allegation that the application was filed for the purposes of befitting from the opponent's reputation. It was confirmed in the skeleton of argument filed on behalf of the opponent that that this '*was not an independent allegation of bad faith and is not in any event pursued on appeal.*'

10. No Respondent's Notice was filed on behalf of the applicant.

11. At the hearing of the appeal the opponent was represented by Ms Charlotte Blythe instructed by K&L Gates LLP and the applicant was represented by Mr Chris McLeod of Elkington and Fife LLP.

<u>The Standard of Review</u>

12. Ms Blythe on behalf of the opponent helpfully summarised the applicable principles of law applicable to the standard of appeal by reference to <u>Axogen v. Aviv Scientific</u> [2022] EWHC 95 (Ch), <u>Lifestyle Equities v. Amazon</u> [2024] UKSC 8 and <u>Iconix v. Dream Pairs</u> [2025] UKSC 25 as being '*in order to interfere with Decision, the Appointed Person must be satisfied that there was a distinct or material error of principle or that the Hearing Officer was wrong*'.

13. However, it was also emphasised on behalf of the opponent that unlike most appeals from decisions of the Registrar, the present appeal was concerned with the construction of a contract, the Settlement Agreement, and that was a matter that had to

be kept in mind. I agree. This is because as recently confirmed by the Supreme Court in Providence Building Services Ltd v. Hexagon Housing Association Ltd [2026] UKSC 1 at [2] '*[t] he correct interpretation of a contract is a question of law*'.

14. It was not, in my view rightly, suggested on behalf of the applicant that the applicable principles put forward on behalf of the opponent were incorrect.

15. In reaching my decision I have kept these principles firmly in mind.

Decision

16. As noted above many of the issues relied upon on this appeal relate to the construction of the Settlement Agreement. In this connection it is accepted on this appeal that the Hearing Officer's summary of the principles of contractual interpretation at paragraph [33] of the Decision is correct.

17. Further it was not suggested by either of the parties on this appeal (or it would appear below) that Italian law differs from English law in any material respect for the purposes of the interpretation of the Settlement Agreement. In addition, as noted in footnote 4 of the Decision the Hearing Officer stated as follows:

> I do note that the agreement sets out it should be interpreted under Italian law. However, in the absence of any objective opinion or evidence regarding whether any aspect of Italian law would have an impact on its interpretation and with consideration to the fact that UK case law on similarity and likelihood of confusion is derived from assimilated EU law (the relevance of which is confirmed at paragraph 6 of this decision), I intend to consider this in accordance with the principles set out in EU case law on similarity and confusion, as applicable to both UK and Italy accordingly.

Ground 1

18. The first ground of appeal concerns whether the Hearing Officer considered the issue as to whether the application was an attempt by the applicant to undermine the purpose of the Settlement Agreement.

19. As the opponent correctly noted in their skeleton of argument this issue was identified by the Hearing Officer in paragraphs [2] and [16] of the Decision as one that had been raised for consideration.

20. Moreover, the Hearing Officer held:

(1) At paragraph [18] *'that is my view that filing an application for the purpose of knowingly undermining the terms of a settlement agreement previously reached between parties may be conduct that departs from the accepted principles of ethical behaviour or honest commercial practices. Where two parties have previously come together to contractually agree to terms for future coexistence,*

which may allow both to continue to trade within the aims pf the trade mark system, it is my view that filing an application for the purpose of intentionally undermining those agreed terms may be an objective within which an application cannot properly be filed .'

(2) At paragraph [19] '*[w]ith respect to the second pleaded objective, that being filing an application for the purposes of knowingly breaching the terms of the agreement, whilst seeking to benefit from another parties reputation, it is again clear this is an objective under which an application cannot be properly filed, both for the reasons set out above, in addition to the well-established principle that filing an application with the sole aim of taking advantage of third party rights, to gain an unfair competitive advantage by doing so, is an objective under which a trade mark cannot be properly filed.*'

Those findings are not challenged by either party to the present appeal.

21. It is also accepted by the opponent that having conducted an analysis of the Settlement Agreement the Hearing Officer concluded at paragraph [40] of the Decision that:

> As I do not consider the filing of the contested mark to either undermine or knowingly breach the terms of the settlement agreement provided, it is my view that the opponent has not established that the applicant's mark has been filed in pursuit of its pleaded objectives. I therefore dismiss the opposition based on section 3(6) of the Act.

22. However, what the opponent submits is that in the findings set out between paragraphs [27] and [39] of the Decision '*Nowhere in these paragraphs does the Hearing Officer attempt to identify the purpose of the Settlement Agreement and therefore plainly the Hearing Officer cannot possibly have considered whether that purpose has been undermined . . .* '.

23. It seems to me that there is force in the position put forward by the opponent. It would appear from those paragraphs that the Hearing Officer solely focussed their analysis on the issue of whether there had been a breach or breaches of the Settlement Agreement. That, on the Hearing Officer's own analysis, does not necessarily answer the question of whether or not the filing of the application was for the purpose of knowingly undermining the purpose of the Settlement Agreement.

24. It therefore seems to me that the opponent is correct that the issue of whether or not the filing of the application was for the purpose of knowingly undermining the purpose of the Settlement Agreement was not determined by the Hearing Officer. I am reinforced in my view by the fact that at the hearing before me the applicant's representative could not point to any paragraph in the Decision that expressly deals with the issue of the purpose of the Settlement of the Agreement.

25. I therefore allow Ground 1 of the Appeal.

26. It was contended on behalf of the opponent that if I was to uphold Ground 1 of the appeal then the appropriate course was to remit the issue for determination by the Registrar. It seems to me that this is correct given that there is no first instance decision on this issue.

Ground 2

27. As Ground 2 was contingent on Ground 1of the appeal and given that I have upheld that Ground of Appeal and have remitted the issue to the Registrar for determination this ground falls away and I say no more about it.

Ground 3

28. Ground 3 falls into two parts. First whether the Hearing Officer only addressed breach of the clause D(b) of the Settlement Agreement and failed to consider breaches of clauses C(b) and D(c). Second that to the extent that the Hearing Officer considered breach of those clauses they erred in their analysis.

29. The first point to make with respect to this ground is, that although the Statement of Grounds in support of the opposition contained quotations from various clauses of the Settlement Agreement, the specific clause from which the quotations were derived were not identified and the specific clauses which were said to have been breached by the applicant were likewise not identified. That was not helpful.

30. The Statement of Grounds that the Hearing Officer was presented with stated as follows:

> Section 3(6) of the Act states that a trade mark shall be excluded from registration when the application has been made in bad faith.
>
> In the case at hand, Mrs Buzzetti (the "**Applicant**") has provided undertakings in a prior settlement agreement with the Opponent dated 16 April 2018 (to be disclosed at a later date) "*not to file/use any more trade marks identical/or similar and/or liable to be confused with*" the Opponent's various Polo player logos and "*never to amend"* the Approved Mark (shown below) *"by adding verbal and/or figurative elements that could make it similar and/or liable to be confused with*" the Opponent's prior trade mark rights for various Polo player logos (shown below)(sic).

The Approved Mark
The Application

The logo which is the subject of the Application, unlike the previous trade mark approved by the Opponent, separates the POLO word element from the EQUIPMENT word element. In doing so the overall impression of the mark has changed and now suggests that the Applicant's goods and/or services originate from the brand U.S. GRANDPOLO as opposed to U.S. GRAND. Accordingly, the Application is "*liable to be confused with*" the Opponent's prior logos and constitutes a breach of the agreement between the Applicant and the Opponent. The Opponent has filed the Application with full knowledge of the Opponent's rights, which the Opponent has acknowledged in the settlement agreement, and in a manner which attempts to undermine the purpose of the settlement agreement. The Applicant was fully aware of her obligations under the settlement agreement with the Opponent to refrain from using variations of the Approved Mark. In spite of this, the Application was applied for without the authority or consent of the Applicant in what can only be characterised as a deliberate breach of the settlement agreement, with the Applicant seeking to benefit from the Opponent's reputation in order to sell her own goods and services to unsuspecting consumers. Such conduct falls short of acceptable honest commercial practices and should result in the Application being refused, considering the history between the Applicant and the Opponent.

> The Opponent therefore submits that, in filing the Application, the Applicant has done so in bad faith.

31. The Hearing Officer's findings in relation to this issue largely focussed on the question of whether the applicant required the consent of the opponent to make the application.

32. That is not altogether surprising given (1) the content of the statements of case of the parties; (2) the content of the evidence and written submissions that were put before the Hearing Officer; and (3) that the specific allegations of breach were not identified in the Statement of Grounds by reference to particular clauses of the Settlement Agreement.

33. As the Hearing Officer stated in paragraph [34] of the Decision '*I note that the opponent has not pointed to the specific wording in the [Settlement Agreement] that it considers restricts the applicant in this way.'* The Hearing Officer went on to find that in their view '*only D(b) is capable of calling into question whether the applicant is restricted to only ever file the approved (at least in particular classes), or whether was an onus on the applicant to seek consent before filing any mark that differs to the approved mark in the classes set out*'.

34. At paragraph [35] of the Decision the Hearing Officer found that clause D(b) should be interpreted in the context of clause D as a whole and proceeded to analyse the clause on that basis. That is not consistent with the statement of the law set out in paragraph [33] of the Decision that makes clear that the decision taker must take into consideration of the contract as a whole and that interpretation involves an iterative process by which each suggested interpretation is checked against the provisions of the contract.

35. It is true that at the end of paragraph [35] the Hearing Officer refers to considering the Settlement Agreement as a whole, however no reasoning whatsoever is given for the finding made on that basis. This is surprising. However, it is possible that this was attributable to the Hearing Office not engaging in any analysis with regard to the purpose of the Settlement Agreement.

36. With respect to clauses C(b) and D(c) it is not entirely clear from the Decision whether and to what extent the Hearing Officer considered breach of *each* of these clauses. It is correct that paragraph [38] could be said to touch on these issues but as pointed out on this appeal the reasoning is truncated and does not seem to differentiate between the analysis of the wording of the two clauses. It also seems to me that there *may* be some force in the opponent's point that it is unclear whether the Hearing Officer was making the appropriate comparison for the assessment of similarity or confusion as required under the clauses of the Settlement Agreement.

37. In the circumstances I uphold Ground 3 of the Appeal.

Conclusion

38. For the reasons set out above the appeal is allowed. I have considered carefully the appropriate course. As I have already indicated above the issues raised by Grounds 1 and 2 should, as submitted by the opponent, be remitted for decision by the Registrar. It was also submitted before me by the opponent that the issue of breach of clauses C(b) and D(c) likewise need to be remitted to the Registrar, and I agree based on my findings above.

39. Although not the subject of a request by the opponent it seems to me that the other aspect of the third Ground of Appeal, i.e. the issue of breach of Clause D(b), is to a greater or lesser extent inextricably bound with the other issues which the opponent has submitted, and which I have agreed, should be remitted for decision by the Registrar. Accordingly, in my view the appropriate course is to set aside the Decision and remit the entirety of these opposition proceedings to be determined on behalf of the Registrar by a different Hearing Officer in accordance with the 1994 Act and the Trade Mark Rules 2008.

40. That leaves the question of costs. In my view the appropriate course is for the costs of the proceedings to date (including the costs of this appeal) be reserved to the Registrar on the basis that the question of how and by whom they are to be paid will be determined at the conclusion of the opposition in accordance with the usual practice.

EMMA HIMSWORTH KC

Appointed Person

15 May 2026