

TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITION No. 45152

IN THE NAME OF POLO LAUREN COMPANY LP

TO APPLICATION No. 2029454

IN THE NAME OF THE ROYAL COUNTY OF BERKSHIRE POLO CLUB

DECISION

The Application

The Royal County of Berkshire Polo Club Ltd (“the Applicant”) applied on 4th August 1995 to register the following sign as a trade mark for use in relation to “perfumery, aftershave, preparations for hair, shampoo, soaps, essential oils, cosmetics, hair lotion, deodorants, eau de toilette, body sprays, bath oils, bubble bath, shower gel” in Class 3:



The Opposition

On 20th August 1996 the Polo Lauren Company LP (“the Opponent”) filed notice of opposition to the application for registration. In summary, the Opponent contended that registration should be refused: (i) on the basis that the application contemplated unauthorised use of the relevant mark within the area of protection afforded to the Opponent’s “earlier trade marks” by Section 5(2) of the Trade Marks Act 1994; (ii) under Section 5(3) of the Act on the basis that use of the relevant mark as contemplated by the application would take unfair advantage of or be detrimental to the distinctive character or repute of the Opponent’s earlier trade marks; (iii) under Section 5(4) of the Act on the basis that use of the relevant mark as contemplated by the application would be actionable in passing off; (iv) in the exercise of the Registrar’s discretion. Five “earlier trade marks” were cited by the Opponent in support of its objections under Sections 5(2) and 5(3) of the Act. I need only refer to two of them for the purposes of this decision:

Mark	Date	Number	Goods
POLO	18.07.1945	638708	Perfumery, toilet preparations (not medicated), cosmetic preparations, dentifrices, depilatory preparations, soaps, toilet articles (not included in other classes), but not including powder boxes and not including any goods of the same description as powder boxes.
POLO	01.04.1947	657863	Bath salts, talcum powder, face powder, face cream, scalp stimulating, preparations, lotions for use after shaving, all being non-medicated toilet preparations; and lipstick, brilliantine, hair lotions, shampoos, dentifrices, soaps and perfumes.

The Opponent's Evidence

The Opponent filed no evidence under Rule 13(3) of the Trade Marks Rules 1994. At an interim hearing on 29th July 1997 it was allowed, in the exercise of the Registrar's discretion under Rule 13(4), to proceed with the opposition in the absence of such evidence on the basis that the opposition would thereafter be confined to the only objection that it could put forward on the strength of submissions without evidence under Section 5 of the Act i.e. the objection it had raised under Section 5(2) of the Act.

The Applicant's Evidence

The Applicant's evidence in answer to the opposition consisted of a statutory declaration of Michael Amooore, its general manager, and a statutory declaration of Andrew Donlan, a technical assistant employed by Messrs. Bailey Walsh & Co.

Mr. Amooore gave evidence to the effect: (i) that the Applicant operates an established, successful and well-known polo club with extensive facilities at Winkfield in Berkshire; (ii) that "all our products licensed or sold throughout the world display the club's full name or ROYAL BERKSHIRE POLO CLUB and therefore clearly distinguish the origin of the products and in no way rely on the alleged success of the POLO brand names used by [the Opponent]"; (iii) that the word POLO is wholly descriptive of the game that the Applicant's club was set up to play and that game "is in my view far more famous than the Polo mark of Polo/Lauren Companies". However, he did not identify any of the products which were said to have been "licensed or sold throughout the world" and

he provided no information as to the nature and extent of the Applicant's involvement in the marketing of such products in the United Kingdom.

Mr. Donlan's statutory declaration set out, forensically and at length, his reasons for thinking that "it would be unfairly prejudicial for a club whose sole purpose is the playing of the game of POLO to be prevented from registering a mark incorporating their name because of the presence of the word POLO on the register". His statutory declaration appears to contain no evidence of any fact of direct relevance to the Opponent's objection under Section 5(2).

The Opponent's Evidence in Reply

The Opponent filed three statutory declarations under Rule 13(7) of the Trade Marks Rules 1994 (as amended with effect from 27th April 1998). That Rule allows an opponent to file evidence "confined to matters strictly in reply to the applicant's evidence".

Jacqueline Armitage (retail buyer for James Beatties Plc of Wolverhampton) and Karen Wells (cosmetics and perfumeries group buyer for Allders Department Stores Ltd of Croydon) made statutory declarations in virtually identical terms. In unison they declared as follows:

"4. I was surprised to learn that the Applicants had filed the above trade mark application in the United Kingdom for the Applicants' Mark in respect of a range of perfumery and toiletry products since I believe that in view of the

substantial reputation and goodwill of the Opponents in the Opponents' Mark there is a strong likelihood of confusion between the Applicants' Mark and the Opponents' Mark in relation to such goods. My reasons for this view are as follows: firstly, as discussed above, I am aware of the substantial reputation and goodwill of the Opponents in the Opponents' Mark in the United Kingdom in relation to, among other things, perfumery and toiletry products. Secondly, I am not aware of any other producer of perfumery or toiletries who employs the theme of or references to the game of polo in relation to perfumery and toiletry products in the United Kingdom. However, I believe that the prominent use of the words POLO CLUB clearly refer to the game of polo.

5. Indeed, I believe that, if I had seen perfumery and toiletry products on sale in the UK under the Applicants' Mark, I would have been confused between that mark and the Opponents' Mark in the sense that I may have believed that that mark was a variant of the Opponents' Mark and the goods sold under that mark were a new range of perfumery and toiletries sold under the Opponents' Mark.

6. Moreover, I confirm that in my opinion if the Applicants were to sell perfumery and toiletry products under the Applicants' Mark in the UK, there would be a strong likelihood of confusion on the part of the general public in the UK with the Opponents' Mark. I believe that such confusion could take the form either of a mistaken belief that the goods sold under that mark by the Applicants were those of the Opponents or alternatively that the Applicants' Mark was a variant of the Opponents' Mark and the Applicants' products were a new range of products produced by the Opponents."

These and the preceding paragraphs of their statutory declarations contain synchronised statements expressed in what appear to me to be closely prescribed terms. Such statements invite scepticism of the kind expressed by Lord Esher MR in Re Christiansen's TM (1885) 3 RPC 54 (CA) at 60:

“Now, to my mind, when you have evidence given upon affidavit, and you find a dozen people, or twenty people, all swearing to exactly the same stereotyped affidavit, if I am called upon to act upon their evidence, it immediately makes me suspect that the affidavits are then not their own views of things and that they have adopted the view of somebody who has drawn the whole lot of the affidavits, and they adopt that view as a whole and say ‘I think that affidavit right’ and they put their names to the bottom.”

The declarations are also not confined to matters strictly in reply to the Applicant’s evidence.

James Kelley, the Managing Director of Prestige & Collections Ltd, gave evidence in a statutory declaration dated 4th September 1998 to the effect: (i) that the Opponent is the proprietor of a substantial goodwill and reputation built up and acquired by extensive marketing of perfumery and toiletries under its POLO trade marks in the United Kingdom; (ii) that “it is quite legitimate for the Opponents to seek to protect their rights, in the POLO marks and the word POLO and to prevent what I believe would be inevitable confusion on the part of the general public between the POLO marks and the Applicant’s mark if the Applicants were to seek to use or register their mark in relation to perfumery or toiletry products”; (iii) that “it is clear from the backs to the boxes for the Opponents’ products ... that the Opponents do indeed use the mark POLO (word) on its own in relation to perfumery and toiletry products”. Mr. Kelley’s evidence was not confined to matters strictly in reply to the applicant’s evidence. It was directed to matters upon which the Opponent had previously filed no evidence in support of its opposition under Rule 13(3).

The Applicant's Additional Evidence

The Applicant obtained leave under Rule 13(8) of the Trade Marks Rules 1994 (as amended) to file additional evidence in the form of a statutory declaration made by Bryan Morrison, its Managing Director, on 12th October 1999. He explained: (i) that the number 10 in the mark put forward for registration refers to the highest handicap which a polo player can have; (ii) that the Applicant had sold a total of 12 sample products of perfume or after shave under that mark over a period of three or four days in 1990; (iii) that by 1996 the turnover generated by the Applicant's business exceeded £1 million and "approximately 25% currently comprises merchandising revenue"; (iv) that leather goods and clothing (such as jeans, T-shirts and sweatshirts) accounted for most of the merchandising revenue; (v) that sales of clothing, watches, belts and leather goods in Japan generated £250,000 in royalties in 1996; (vi) that he has never experienced any confusion between the Applicant's and the Opponent's trade marks. Mr. Morrison speaks of "products licensed or sold throughout the world". To a noticeable degree he does so without specifically quantifying the Applicant's merchandising activities in the United Kingdom.

The Hearing Officer's Decision

The opposition proceeded to a hearing before Dr. W.J. Trott, acting on behalf of the Registrar of Trade Marks, on 21st October 1999. The objection to registration under Section 5(3) of the Act was formally withdrawn at the hearing. It was not suggested on behalf of the Opponent that registration could be refused in the exercise of the Registrar's discretion. The opposition was contested under Section 5(2) of the Act and also

(notwithstanding the Registrar's interim ruling on 29th July 1997) under Section 5(4) of the Act. In his decision issued on 17th December 1999 the Hearing Officer held that the application for registration was objectionable on both bases. He therefore rejected the application and ordered the Applicant to pay the Opponent £835 as a contribution towards its costs of the opposition.

The Hearing Officer's reasons for concluding that there would be a likelihood of confusion if the mark put forward for registration was used in relation to the goods of interest to the Applicant were as follows: the goods in question are identical to those for which the Opponent's earlier trade marks are registered; the Opponent has successfully adopted the luxury and upmarket image of the game of polo to associate with its range of toiletries; the benefit of a significant goodwill and public reputation accrues to it by reason of its use of the word POLO as a trade mark for such products; most consumers would gravitate to the word POLO as the most recognisable characteristic of the Applicant's mark; they are all the more likely to do so because the word POLO appears in capital letters whereas the depiction of ROYAL BERKSHIRE in cursive script submerges the significance of those words in the mark as a whole; the distinctiveness of the word POLO as used in the Applicant's mark is liable to lead the public to believe that its goods and the Opponent's goods come from the same undertaking or connected undertakings; additionally the general public has been educated to the possibility of dual branding and there is a real risk that a significant number of people will believe that the Applicant's mark represents a further example of that established trade practice.

The Appeal

In January 2000 the Applicant gave notice of appeal to an Appointed Person under Section 76 of the 1994 Act. It contended, in substance, that the Hearing Officer had misdirected himself as to the meaning and significance that people would give to the word POLO in the context of the mark put forward for registration and that the mark should be allowed to proceed to registration on the basis that use of the word POLO in that context would not give rise to a likelihood of confusion. The Opponent maintained that the Hearing Officer was right to refuse registration. It accepted at the hearing before me that the objection under Section 5(4) added nothing worth pursuing to the objection under Section 5(2) and that the earlier trade marks identified above were the ones which mattered for the purpose of its objection under Section 5(2). The appeal thus falls to be determined under Section 5(2), with reference to those earlier trade marks.

Section 5(2) of the 1994 Act

Section 5(2) of the 1994 Act (implementing Article 4(1)(b) of Council Directive No. 89/104/EEC of 21st December 1988) provides as follows:

“A trade mark shall not be registered if because –

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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.”

Objections under Section 5(2) are conceptually indistinguishable from actions under Section 10(2) of the Act (Article 5(1)(b) of the Directive). They serve to ensure that trade marks whose use could successfully be challenged before the courts are not registered: Case C-39/97 Canon Kabushiki Kaisha v. Metro-Goldwyn Mayer Inc. [1998] ECR I-5507, paragraph 21.

It was noted in the Opinion delivered by Advocate General Jacobs on 27th January 2000 in Case C-425/98 Marca Mode CV v. Adidas AG [2000] ETMR 561 that the objection set out above is differently expressed in different language versions of the Directive, with the English version referring to a “likelihood” of confusion, the Dutch version referring to the “possibility” of confusion and most other versions referring to the notion of a “risk” or “danger” of confusion. Nevertheless, for the reasons given in his Opinion, the Advocate General maintained that the objection could not succeed in the absence of a genuine and properly substantiated likelihood of confusion. That view of the matter was accepted by the European Court of Justice in paragraphs 33 et seq. of its Judgment delivered on 22nd June 2000.

I think it is clear from the case law of the European Court of Justice that an objection under Section 5(2) of the Act raises a single composite question: are there similarities (in terms of marks and goods or services) which would combine to create a likelihood of confusion if the “earlier trade mark” and the sign subsequently presented for

registration were used concurrently in relation to the goods or services for which they are respectively registered and proposed to be registered?

The question falls to be answered in accordance with the detailed guidance provided by paragraphs 17 to 27 of the Judgment of the European Court of Justice in Case C-342/97 Lloyd Schuhfabrik Meyer GmbH v. Klijsen Handel BV [1999] ETMR 690. Those paragraphs confirm that an objection under Section 5(2) should be assessed with due regard to the commercial realities of the market place, bearing in mind that distinctiveness, resemblance and proximity of trading are matters of fact and degree which must be given such weight and priority as they deserve as part of the overall assessment.

There can be no objection under Section 5(2) where it does not appear that the public could believe that the goods or services supplied under the marks in contention come from the same undertaking or, as the case may be, from economically-linked undertakings: Canon paragraph 30. A belief in the existence of a licensing or joint venture arrangement would seem to satisfy this requirement: Case C-9/93 IHT Internationale Heiztechnik GmbH v. Ideal Standard GmbH [1994] ECR I-2789 paragraphs 34 and 37 to 39; Case C-63/97 Bayerische Motorenwerke AG (BMW) v. Ronald Karel Deenik [1999] ECR I-905 paragraph 51. However, the mere association which the public might make between two trade marks as a result of their analogous semantic content is not in itself a sufficient ground for concluding that there is a likelihood of confusion, even if the earlier trade mark has a particularly distinctive character (either *per se* or because of the reputation it enjoys in the market place): Case

C-251/95 Sabel BV v. Puma AG [1997] ECR I-6191, paragraph 27; Case C-425/98 Marca Mode CV v Adidas AG 22nd June 2000, paragraphs 37 to 41.

If the earlier trade mark cited against an application has been registered, it will (as it would in proceedings for infringement) benefit from the stipulation in Section 72 of the 1994 Act that “*In all legal proceedings relating to a registered trade mark the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it*”. I understand this to imply that the earlier trade mark should be taken, prima facie, to have possessed a distinctive character (so as to be free of objection under Section 3(1) of the Act) when it was registered.

It may actually possess a highly distinctive character, either *per se* or because of the degree of recognition it enjoys in the market place. If so, it may be afforded broader protection than marks with a less distinctive character (as re-affirmed by the European Court of Justice in Lloyd Schuhfabrik paragraph 20). However, the less use it has had in connection with the goods for which it is registered, the less distinctiveness it is likely to have acquired, and, therefore, the more the protection claimed for it will be limited to its inherent distinctiveness: Premier Brands UK Ltd v. Typhoon Europe Ltd [2000] I.P.&T. 218 at 230 per Neuberger J. Moreover, use of a mark does not prove that it is distinctive and increased use, of itself, does not do so either: the use and increased use must be in a distinctive sense to have any materiality: Bach Flower Remedies Trade Marks [1999] I.P.&T. 146 (CA), paragraph 49 of the Judgment of Morritt LJ. And the more descriptive and less distinctive the major feature of a mark, the less the likelihood of confusion may

be: The European Ltd v. The Economist Newspaper Ltd [1998] FSR 283 (CA) at 290 per Millett LJ.

Article 13 of the Directive provides (with emphasis added) that:-

“Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect only of some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only.

Although the words I have emphasised do not appear to have found their way into the text of the 1994 Act, they are binding upon the Registrar of Trade Marks as the person whose task it is to implement Article 13 on behalf of the State in Registry proceedings in the United Kingdom. Article 13 serves to confirm that no grounds for refusal of registration should exist in respect of any of the goods or services for which a trade mark is to be registered. It envisages that the coverage of an application for a trade mark will (so far as possible) be restricted to the extent necessary to confine it to goods or services for which the trade mark in question is fully registrable.

This makes it necessary, in order to determine an objection under Section 5(2) in the required manner, to assess the extent (if any) to which normal and fair use of the opposed mark as a trade mark for goods or services of the kind specified would capture the distinctiveness of the earlier trade mark cited against it and give rise to the required likelihood of confusion. The assessment must be made from the perspective of “the average consumer” of the category of goods or services in question. For the purposes of

the required global appreciation of the likelihood of confusion, the average consumer is “deemed to be reasonably well-informed and reasonably observant and circumspect”. It goes without saying that the relevant perspective is that of the average consumer who does not know that there is a question as to the existence or otherwise of a likelihood of confusion.

Decision

The Registrar’s interim ruling on 29th July 1997 appears to have been overtaken by events during the later stages of the proceedings in the Registry. The Opponent’s evidence was not confined to matters strictly in reply to the Applicant’s evidence. It was nevertheless put before the Registrar without objection (indeed the Applicant responded to it in late evidence of its own). All of the evidence that was before the Hearing Officer is now before me. I therefore intend to take account of it so far as it has probative value.

The evidence indicates that the Opponent’s earlier trade marks enjoyed a high degree of recognition and popularity among purchasers of toiletries at the date of the application for registration (4th August 1995). The evidence also suggests that the Opponent was at that date unique among suppliers of toiletries in marketing its products under and by reference to the word POLO. It had a long history of using the word POLO with graphics linking it to the game of the same name. I think it is clear that in August 1995 the average consumer would naturally have expected POLO brand toiletries to come directly or indirectly from one and the same undertaking (i.e. the Opponent).

The Applicant's mark had not, in any real sense, been used before 4th August 1995 as a trade mark for goods of the kind specified in the present applications for registration. So far as I can see, it has not subsequently been used as a trade mark for such goods to an extent that could realistically be taken to shed light backwards on the registrability or unregistrability of the mark in August 1995.

The statutory declarations contain predictably divergent opinions and assertions as to the likelihood or otherwise of confusion ensuing from the use of the Applicant's mark. The witnesses are entitled to their views, but their views appear to me to lack probative value in relation to the issue I have to determine and I attach no weight to them.

When considering whether the use of the Applicant's mark was liable to cause confusion at the relevant date it is necessary to beware of approaching that question with knowledge that there is a question, when the real task is to determine what impression the use of that mark would make upon people in the ordinary course of trade in goods of the kind specified in the application for registration: see Marengo v. Daily Sketch and Sunday Graphic Ltd (1948) 65 RPC 242 (HL) at 250 per Lord Simonds.

Approaching the matter in that way, I am satisfied that the use of the word POLO as part of the Applicant's mark does not capture the distinctiveness of the Opponent's earlier trade marks. I do not think that people exposed to the use of the Applicant's mark would notice that it contained the word POLO without also noticing that it contained the words ROYAL BERKSHIRE and CLUB. The message of the mark comes from the

words in combination and that is not something that I would expect people to overlook or ignore in the ordinary way of things.

The Applicant's mark would naturally be understood to represent that the ROYAL BERKSHIRE POLO CLUB was directly or indirectly responsible for the goods to which it was applied. The presence of the numeral 10 in the Applicant's mark adds to the individuality of the mark (whether or not it is appreciated that 10 is the highest handicap a polo player can have). Abbreviations and approximations would, in my view, be likely to centre on the words ROYAL BERKSHIRE because they contribute more than the other words to the identification of the club named in the mark.

The word POLO functions adjectivally in the context of the Applicant's mark whereas the Opponent's earlier trade mark registrations envisage use of the word POLO in a manner that would, most likely, be perceived as a noun. Adjectival use of a word is distinguishable from use of the same word as a noun and the resulting differences of perception may be sufficient to preclude a likelihood of confusion cf The European Ltd v. The Economist Newspaper Ltd [1998] FSR 283 (CA) at 293 per Hobhouse LJ. I think that is the case here. In my view the semantic content of the marks in issue is (and was at the relevant date) insufficiently similar or analagous to give rise to the mistaken belief that POLO brand toiletries and ROYAL BERKSHIRE POLO CLUB toiletries come from the same undertaking or economically-linked undertakings.

For the reasons I have given, the Applicant's appeal is allowed. The Hearing Officer's decision and his order as to costs are set aside. The application for registration is

remitted to the Registrar for further processing in accordance with this decision and I direct the Opponent to pay the Applicant £950 as a contribution towards its costs of the opposition in the Trade Marks Registry and on appeal.

Geoffrey Hobbs QC

7th September 2000

Denise McFarland instructed by Messrs Bailey Walsh & Co appeared as counsel on behalf of the Applicant.

John Hornby of Messrs Clifford Chance, appeared as solicitor advocate on behalf of the Opponent.

Mike Knight, Principal Hearing Officer, appeared on behalf of the Registrar.