

O/1120/25

**TRADE MARKS ACT 1994**

**IN THE MATTER OF UK APPLICATION NO. 3974393  
IN THE NAME OF NATALIA BUZZETTI  
IN RESPECT OF THE TRADE MARK**



**IN CLASSES 3, 18 & 25**

**AND**

**THE OPPOSITION THERETO UNDER NO. 446002  
BY THE POLO/LAUREN COMPANY L.P.**

## Background and pleadings

1. Natalia Buzzetti (“the applicant”) applied to register the trade mark no. 3974393 for the mark shown on the cover page of this decision in the UK on 1 November 2023. It was accepted and published in the Trade Marks Journal on 24 November 2023 in respect of the following goods:

*Class 3: Household fragrances; saddle soap; toiletries; body cleaning and beauty care preparations; perfumery and fragrances; cosmetics.*

*Class 18: Saddle trees; saddlery, whips and apparel for animals; saddlery; fastenings for saddles; harness for animals; bridles [harnessing]; bridles [harness]; spur straps; horse collars; cribbing straps for horses; rain sheets for horses; horse blankets; saddle blankets; straps of leather [saddlery]; harness straps; equine leg wraps; harness for horses; jockey sticks; bits for animals [harness]; ear bonnets for horses; reins; reins [harness]; training leads for horses; riding saddles; saddlecloths for horses; stirrups; luggage, bags, wallets and other carriers; luggage; carry-on bags; travel luggage; vanity cases, not fitted; bags; shoulder bags; cross-body bags; gym bags; saddlebags; saddlebags; bags for sports; travel baggage; weekend bags; shoe bags; purses; duffel bags; holdalls for sports clothing; shoulder belts [straps] of leather; bumbags; pocket wallets; haversacks; general purpose sport trolley bags; leather suitcases; small suitcases; daypacks; rucksacks; sports packs.*

*Class 25: Clothing; waterproof clothing; roll necks [clothing]; casualwear; ladies' clothing; weather resistant outer clothing; golf clothing, other than gloves; girls' clothing; menswear; outer clothing for boys; boys' clothing; woollen clothing; clothing of leather; clothing for gymnastics; clothing for horse-riding [other than riding hats]; sportswear; leather dresses; imitation leather dresses; leisure suits; gym suits; bermuda shorts; bikinis; blue jeans; bomber jackets; leotards; stockings; socks; slipper socks; non-slip socks; antiperspirant socks; ankle socks; sports socks; breeches for wear; swimming trunks; golf trousers; chemisettes; shirts; open-necked shirts; turtleneck shirts; mock turtleneck shirts; short sleeve shirts; button down shirts; collared shirts; tennis shirts; casual shirts; sports shirts with short sleeves; moisture-wicking sports shirts;*

*tank tops; vest tops; sports singlets; windproof clothing; clothing for men, women and children; down coats; coats of denim; waist belts; belts [clothing]; short sets [clothing]; desert boots; sweat shirts; hooded sweatshirts; foulards [clothing articles]; casual jackets; riding jackets; safari jackets; sweat jackets; shirt-jacs; polar fleece jackets; down jackets; rainproof jackets; denim jackets; knit jackets; sports jackets; sleeveless jackets; jackets being sports clothing; gilets; wind vests; quilted vests; blousons; golf skirts; gloves [clothing]; riding gloves; winter gloves; mackintoshes; denim jeans; jerseys [clothing]; jodhpurs; leggings [leg warmers]; leggings [trousers]; trunks; shorts; casual trousers; sports pants; crew neck sweaters; long sleeve pullovers; hooded pullovers; neck scarves [mufflers]; printed t-shirts; playsuits [clothing]; running suits; jogging sets [clothing]; footwear; riding shoes; leisure shoes; boots for sports; plastic slippers; flip-flops; espadrilles; sandals; training shoes; golf footwear; sports shoes; casual footwear; sneakers; half-boots; boots; headgear; berets; peaked caps; golf caps.*

2. On 23 February 2024, The Polo/Lauren Company L.P. (“the opponent”) opposed the trade mark on the basis of section 3(6) of the Trade Marks Act 1994 (“the Act”). It argues that the mark filed by the applicant strays from the “approved mark” as outlined in a settlement agreement between the parties and is liable to cause confusion with the opponent’s prior marks. As such, it is argued this has been filed in a manner which attempts to undermine the purpose of the same. It is further argued that the mark filed was in deliberate breach of the agreement, with the applicant seeking to benefit from the opponent’s reputation when selling goods under the mark. It is therefore submitted that the application has been filed in bad faith and should be refused registration.

3. The applicant filed a counterstatement admitting to the existence of the settlement agreement and admitting this states that the applicant will not file applications that are identical or similar to, or liable to be confused with the opponent’s polo player logos, and that the agreement states never to amend the approved mark by adding verbal and/or figurative elements which would make it similar and/or liable to be confused with the opponent’s mark. However, the applicant denies that she has added verbal or figurative elements to the approved mark and denies that the differences between the approved mark and the mark filed are sufficient to create a likelihood of confusion.

The applicant denies that the application was filed in a manner which attempts to undermine the settlement agreement, denies that the application is in deliberate breach of the settlement agreement, and denies that she is seeking to benefit from the opponent's reputation. The applicant therefore denies that mark has been filed in bad faith.

4. Both sides filed evidence in these proceedings, and the applicant also filed written submissions during the evidence rounds. The evidence will be summarised to the extent that it is considered necessary. Both sides filed written submissions in lieu of a hearing, which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

5. The opponent is represented in these proceedings by K&L Gates LLP. The applicant is represented by Elkington and Fife LLP.

6. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

## **Evidence**

7. The opponent filed its evidence in the form of a witness statement in the name of Alice Pang, Senior Director and Assistance Secretary at the opponent. This goes to the previous and ongoing disputes and settlement between the parties, as well as to the filing pattern of the applicant. The statement introduces five exhibits, those being Exhibit A to Exhibit E. It is dated 18 July 2024. I note at this stage that Exhibit B comprises a settlement agreement between the parties. This is subject to a confidentiality order, preventing the full details of the same from being disclosed to the public. However, some clauses of the agreement are included within Ms Pang's witness statement, the details of which are not subject to the order given.

8. The applicant filed her evidence in the form of a witness statement in the name of Raffaello Nemni, its leading legal counsel. This goes to the negotiations and settlement between the parties and the interpretation of the agreement provided.

## Legislation

9. Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

10. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240] as follows:

“(i) [...]

(ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (Lindt, para 35).

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation [...], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 (“*Malaysia Dairy*”), para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 (“*Sky CJEU*”), para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the [...] law of trade marks, namely the establishment and functioning of [...] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which

enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (Lindt, para 45; [Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO) (C-104/18) EU:C:2019:724 (“Koton”)], para 45). (v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (Koton, para 46; Sky CJEU, para 75). (vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case ([Hasbro Inc v EUIPO, Kreativni Dogaaji d.o.o. (intervening) (Case T-663/19) EU:T:2021:211 (“Hasbro”)], paras 39 and 40; Koton, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (Hasbro, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (Lindt, para 37). (ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (Sky CJEU, para 76; [AS v Deutsches Patent-und Markenamt (C-541/18) EU:C:2019:725], para 22). (x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (Sky CJEU, para 77). (xi)

Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (Sky CJEU, para 77). (xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (Sky CJEU, para 78). (xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (Sky CJEU, para 81)

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, Hasbro, para 72). (xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a bona fide intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (Sky CJEU, paras 86 and 87).”

11. According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are: (a) What, in concrete terms, was the objective that the applicant has been accused of pursuing? (b) Was that an objective for the

purposes of which the contested application could not be properly filed? and (c) Was it established that the contested application was filed in pursuit of that objective?

12. It is necessary to ascertain what the proprietor knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

13. An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch).

14. The relevant date for considering whether an application was filed in bad faith is the date the application was filed. In this instance, that is 1 November 2023.

15. I make my consideration with reference to the three questions set out in *Alexander Trade Mark* below.

What, in concrete terms, was the objective that the applicant has been accused of pursuing?

16. It is my view that the opponent has accused the applicant of the following objectives in filing her mark:

- Filing an application which knowingly undermines a settlement agreement; and
- Filing an application in deliberate breach of a settlement agreement, whilst also seeking to benefit from the opponent's reputation when selling goods under the applied for mark.

Are those objectives for the purposes of which the contested application could not be properly filed?

17. I consider firstly whether the filing of an application for the purpose of undermining a settlement agreement is an objective under which an application cannot be properly filed. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin considered the question of what amounts to bad faith. He stated:

“152. In seeking to identify the relevant principles, it is necessary to have in mind two fundamental aspects of trade mark law to which I have already referred: first, it is concerned with the use of marks in trade to denote the origin of goods and services. Secondly, the aim of the trade mark regime is to contribute to a system of undistorted competition in which businesses are able to attract and retain customers by the quality of their goods and services, and for that purpose are able to have registered signs which enable consumers to distinguish the goods and services of one undertaking from those of another. Such a system must also provide an incentive and protection for the investment by a brand owner in the quality and other beneficial aspects of its goods and services, and so allow it to develop a goodwill in its business relating to their sale and supply.

153. Against this background, the essence of the objection that an application to register a mark was made in bad faith may be understood: it is that the motive or intention of the applicant was to engage in conduct that departed from accepted principles of ethical behaviour or honest commercial practices having regard to the purposes of the trade mark system which I have described. Whether the conduct was undertaken with that motive or intention and did indeed depart from such ethical behaviour or honest commercial practices must be assessed having regard to all the objective circumstances of the case: see, for example, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*"), paras 46 and 47 [...].”

18. With consideration to the above, it 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 of 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 be properly filed.

19. With 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.<sup>1</sup>

Was it established that the contested application was filed in pursuit of that objective?

20. I therefore move on to consider whether the objectives set out above have in this case been established. This firstly, requires a closer examination of the terms under the settlement agreement as provided at confidential Exhibit B to the witness statement of Ms Pang.

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:<sup>2</sup>

“ [REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]

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<sup>1</sup> See *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07

<sup>2</sup> [REDACTED]

[Redacted]

22. [Redacted]

23. [Redacted]

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

[Redacted]

[Redacted]

D. In addition, Mrs BUZZETTI undertakes:



[REDACTED]


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 [...];

[REDACTED]

25 [REDACTED]

26. The approved mark [REDACTED] 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:

Approved mark	Applied for mark
	

27. There does not appear to be any dispute between the parties that the applicant has made changes to the approved mark, by way of a change to the layout of the text displayed beneath the figurative element. This moves the word "POLO" up to the first line of text and puts "EQUIPMENT & APPAREL" together on the line below. This condenses the text, which in turn removes the third line entirely. I further note there has been a slight change to the proportions of the mark, with the figurative element appearing more prominent against the smaller text in the application filed. Finally, I note there appears to be either an additional, or at least a more prominent peaked hat on the head of the horse rider featured in the applied for mark, when compared to the figure in the earlier mark . I note that where the opponent has provided the approved mark separately at Exhibit D to Ms Pang's witness statement, this does clearly show the peaked hat as featured in the application. However, where the approved mark is referred to again in the opponent's final submissions, the peaked hat is not included. In any case, I note the peaked hat does not appear to be the focus of either party's submissions.

28. In its final written submissions, the opponent sets out:

"On 16 April 2018 the Applicant and the Opponent entered into a settlement agreement (the "Agreement") under which the Applicant agreed "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 (including as shown below)."

29. In respect of the changes made to the mark, the opponent goes on to argue:

"14. At paragraphs 6 and 7 of the Applicant's Submissions it is claimed that "[t]he Applicant has not added any verbal or figurative elements to the Approved Mark. The only differences relate to changes in the positions of the verbal elements from their positions ... " and "[t]he figurative element of the Approved Mark is essentially identical to the figurative element of the mark the subject of the Application". The Opponent submits that re-arranging the verbal elements within the mark, as presented in a stylised manner in conjunction with the

silhouette of a horse making up the entirely stylised figurative mark as a whole, creates a different overall impression and significantly impacts the overall visual impact of the mark.

[...]

16. The Applicant's Submissions unfortunately fail to account for the fact that this joining of words has created a figurative change to the overall impression of the mark. In the agreed version, the words 'U.S. GRAND' feature in a large font on one line. On the line underneath it states "Polo Equipment and Apparel". This form was agreed to avoid confusion between the parties as it does not place emphasis on the word 'Polo' and instead makes clear to consumers that the brand is 'U.S. GRAND' and the brand sells 'Polo Equipment and Apparel'. In the Application however, the word 'Polo' is added in enlarged font to the focal point of the trade mark text, instead reading to the average consumer as 'U.S. GRANDPOLO', followed by a smaller 'Equipment and Apparel' underneath. This changes the emphasis of the mark onto considering the brand name of the mark to be 'U.S. GRANDPOLO' and increasing likelihood of confusion due to the prominence of the word 'POLO' being part of the brand and not simply the type of equipment being sold.”

30. Both in the opponent’s pleadings and at paragraph 12 of her statement, it is stated or implied that consent was required from the opponent to make any changes to the approved mark, with Ms Pang stating:

“To the extent of my knowledge, the Applicant did not request or receive any consent from the Opponent before filing the Application, as was required by the terms of the Agreement.”

31. Seemingly in response to this statement from Ms Pang, the applicant’s final submission set out:

“In the Applicant's submission, the Opponent's interpretation of the Agreement is wrong. If the Applicant can never amend the approved trade mark, there would have been no reason to include clause (c) of paragraph D of the contract,

which provides the limits within which the opponent can adopt a trade mark other than the approved trade mark. The clause reads explicitly, "Never amend said trademark by adding verbal and/or figurative elements that could make it similar and/or liable to be confused with the Opponent's Polo Player design"

32. Further, in respect of the changes made, the applicant submits:

"The Applicant did not add any verbal part or graphic element to the approved trade mark. The limitation established in clause (c) of paragraph D of the Agreement precludes the addition of verbal and/or figurative elements to the approved trade mark. The Applicant did not breach any clause of the agreement, and therefore, the Applicant filed the Application in good faith."

33. Before I go any further, I consider at this stage my interpretation of the restrictions imposed on the applicant as set out within the terms of the settlement agreement. I consider the principles that should be followed when interpreting a contract, as were neatly reiterated in *I-Smart v Currentbody and Kaiyan* [2024] EWHC 2889 (IPEC) as below:

"29. A summary of the principles of contractual interpretation was recently given by Lord Hamblen, with whom Lords Hodge, Kitchin and Sales agreed, in *Sara & Hossein Asset Holdings Ltd v Blacks Outdoor Retail Ltd* [2023] UKSC 2:

'[29] The relevant general principles are authoritatively explained by Lord Hodge JSC in his judgment in *Wood v Capita Insurance Services Ltd* [2017] AC 1173 at paras 10-15. So far as relevant to the present case, they may be summarised as follows:

(1) The contract must be interpreted objectively by asking what a reasonable person, with all the background knowledge which would reasonably have been available to the parties when they entered into the contract, would have understood the language of the contract to mean.

(2) The court must consider the contract as a whole and, depending on the nature, formality and quality of its drafting, give more or less

weight to elements of the wider context in reaching its view as to its objective meaning.

(3) Interpretation is a unitary exercise which involves an iterative process by which each suggested interpretation is checked against the provisions of the contract and its implications and consequences are investigated."

34. Whilst I note the general statements in Ms Pang's witness statement and in the opponent's pleadings relating to the requirement for the applicant to seek consent from the opponent before changing the approved mark, I note the opponent has not pointed to the specific wording in the agreement that it considers restricts the applicant in this way. [REDACTED]

35. However, with consideration to the case law on the proper interpretation of contracts above, it is my view that this needs to be interpreted in the context of D as a whole, and particularly in this instance with reference to [REDACTED] (c) of the same. These clearly set out that [REDACTED] and importantly, that this approved mark may never be amended in a way that makes it more similar to the PRL Polo Player design as set out within the agreement. I agree with the applicant's submission that if [REDACTED] intended to entirely restrict the applicant from filing ANY other trade marks [REDACTED], clause (c) would be rendered largely irrelevant; [REDACTED]. It is my view that in the context of the dispute and from the evidence with which I have been provided, a reasonable person would read that D. allows Ms Buzzetti to adopt and file the approved trade mark as set out in Enclosure A if she wishes, but prevents her from making changes to this mark by way of adding verbal and/or figurative elements that make it more similar and/or liable to be confused

with the PRL Polo Player design.<sup>3</sup> Further, I do not consider that the agreement as a whole restricts the applicant from filing *any* applications that are not identical to the approved mark without the consent of the opponent, in specific classes or otherwise.

36. With this in mind, one problem I find with the opponent's case is that it is largely irrelevant whether a) the applicant sort its consent prior to filing a slightly different mark, or b) whether any changes the applicant has made to the approved mark have an impact on the marks overall impression, unless those changes bring the earlier mark closer to the PRL Polo Player design.

37. Whilst I have considered the opponent's submissions and the statements from Ms Pang in evidence explaining why the opponent agreed to the form of the text in the approved mark, [REDACTED]

[REDACTED] it is not clear whether this was ever expressed to the applicant in those terms. [REDACTED]

[REDACTED] The relevance of this is that it does not appear that an alteration was made to the original text as a result of any negotiations, which was then subsequently undone by the applicant when filing the new mark, in a way that may be considered to undermine the intentions of the agreement or otherwise.

38. I do agree with the opponent that moving the word "POLO" to the first line of text in the applied for mark does have the effect of making GRANDPOLO appear more of a badge of origin and less of a descriptive element referencing the goods for sale under the same. However, whether the word POLO is used within the mark in a more descriptive sense, or whether it appears as part of a more distinctive brand name does not alter the fact that the variations both convey to the consumer the concept of polo. As such this does not alter whether the consumer will in turn consider the horse rider shown in the image as any more or less likely to be a polo player. I therefore do not consider the changes make the mark any more similar or liable to be confused with

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<sup>3</sup>

[REDACTED]

the opponent's PRL Polo Player design set out, and this is before considering whether the moving of the word constitutes the adding of "verbal and/or figurative elements" to the approved mark, of which I am also not convinced. Further, I note for completeness that as there is no obvious hat worn by the figure in the PRL Polo Player design, whilst I do consider the apparent addition of the same in the applied for mark to be the addition of a figurative element, I do not consider it to be an amendment that makes it more similar or more liable to be confused with the opponent's PRL Polo Player design.

39. I note at this stage, that I have considered the opponent's comments that the applicant's behaviour in filing the mark is not an isolated incident. In her statement, Ms Pang identifies a variety of other marks filed by the applicant in Italy, France, Greece, Poland and Turkey. However, I note all of the marks referenced by Ms Pang comprise the horse and horse rider device as featured in the contested/approved mark, with variations in wording shown underneath. In my view, nothing about these filings individually or collectively appears more similar to, or more liable to cause confusion with the opponent's PRL Polo Player design than the approved mark. Whilst this evidence therefore establishes that the applicant has filed a variety of marks in a number of jurisdictions, it does not establish a pattern of behaviour that I consider to be consistent with the applicant acting in bad faith. Further, whilst I note and have considered Ms Pang's reference to the filing and withdrawing of 4 further applications for marks in France, Spain and Germany, and Ms Pang's statement that it is clear from the applicant's "extensive" applications that she understands the rights held by the opponent "in the Logo and similar marks and the brand recognition placed by consumers of the Opponent on its 'POLO' brand", it is not clear why the filing of these applications would show this to be the case. Whilst I also note the evidence filed at the opponent's Exhibit E, showing the applicant's use of the mark (after the relevant date<sup>4</sup>), which does often place more emphasis on the word POLO, again I find this to be of little relevance considering the lack of particular relevance of the word POLO [REDACTED] [REDACTED] to the opponent's pleaded case.

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<sup>4</sup> I note that evidence dated after the relevant date may still be of assistance to the opponent where it points to the applicant's intention at the relevant date.

40. 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.

41. However, in case I am wrong to consider the second pleaded objective only from the starting point of a deliberate breach of the settlement agreement, I will also consider briefly whether the opponent has established that the mark was filed for the purpose of benefitting from the opponent's reputation when selling goods under the mark.

42. I note firstly, that the applicant does not deny the opponent holds a reputation. The reputation pleaded by the opponent is not particularly specific, and I take this to be a reputation for the PRL Polo Player design as set out within the agreement. I take the applicant's lack of denial of this to be an acceptance of the reputation to this extent. I do not consider that the evidence filed in these proceedings shows the opponent holds a reputation that extends outside of this mark in this instance. Whilst I note the references in the witness statement of Ms Pang to the "POLO" brand, and the very limited use of POLO (which I note postdates the relevant date) as shown at Exhibit A, this is not enough to evidence an established a reputation for the mark POLO in the UK.

43. However, beyond the establishment of a reputation for its PRL Polo Player design, there is no evidence that the applicant has filed the mark for the purposes of benefitting from that reputation. It is clearly shown in the evidence that the parties came to a previous agreement allowing the applicant to use and file a similar mark, in respect of which it seems the parties agree there would not be an undue benefit for the applicant from the reputation of the opponent. It is not, in my view, established how the filing of this similar mark, which appears to be no more similar to that for which the opponent has established a reputation than the approved mark, would be for the purpose of the applicant benefitting from the opponent's reputation. I therefore do not consider the opponent to have established that the mark was filed in accordance with this objective.

44. Finally, I consider for completeness the following argument put forward within the opponent's final submissions:

“As no indication of an alternative source or reasoning behind making alterations to the mark has been provided, it suggests that the Applicant had no other reason to file a new mark than to take advantage of the Opponent's reputation and goodwill.”

45. Had the opponent made out a prima facie case based on its pleaded objectives, I accept the burden would be on the applicant to provide a plausible explanation and evidence sufficient to rebut the same. However, it is my view that the opponent has not done this, and I therefore do not consider that the lack of explanation as to why the applicant has changed the arrangement of the wording from the approved mark to be of consequence.

46. Therefore, even if I should consider this element of the opponent's pleadings alone, the opposition still fails based on section 3(6) of the Act.

## **Conclusion**

47. The opposition has failed in its entirety, and subject to any successful appeal, the application will therefore proceed to registration for all of the goods filed.

## **COSTS**

48. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £1350 as a contribution towards the cost of the proceedings, in accordance with Tribunal Practice Notice 1/2023. The sum is calculated as follows:<sup>5</sup>

Considering the TM7 and preparing and filing the TM8: £300

Considering and filing evidence: £700

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<sup>5</sup> Whilst I note a case management conference took place during the proceedings following the opponent's request for confidentiality, this took place at the request of the applicant and the opponent's request for confidentiality was partially maintained. In the circumstances, I find it appropriate for the parties to bear their own costs in respect of the same.

Preparing and filing written submissions: £350

Total: £1350

49.I therefore order The Polo/Lauren Company L.P. to pay Natalia Buzzetti the sum of £1350. The above sum should be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 27<sup>th</sup> day of November 2025**

**R. Le Breton**

**For the Registrar**