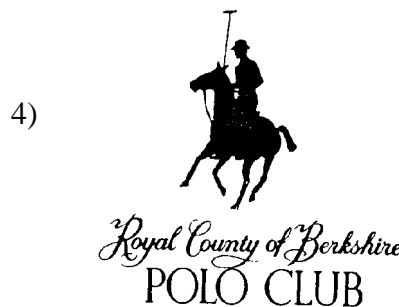
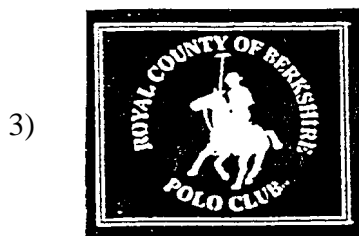
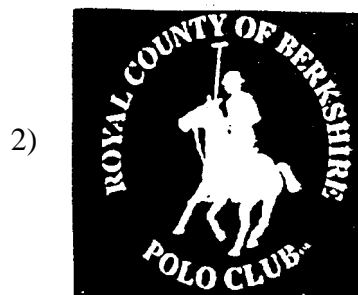
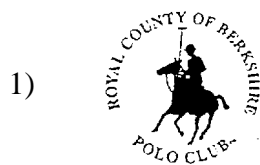


TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO. 2132617
BY ROYAL COUNTY OF BERKSHIRE POLO CLUB LIMITED
TO REGISTER A TRADE MARK
IN CLASS 3

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 47418
BY THE POLO / LAUREN COMPANY, L. P.

BACKGROUND

1) On 13 May 1997, Royal County of Berkshire Polo Club Ltd, of North Street, Winkfield, Windsor, Berkshire, SL4 4TH, applied under the Trade Marks Act 1994 for registration of a series of four trade mark shown below:



2) In respect of the following

Class 3: “Perfumery, aftershave, preparations for hair, shampoo, soaps, essential oils, cosmetics, hair lotion, deodorants, eau de toilette, body sprays, bath oils, bubble bath, shower gel, antiperspirants, cosmetic kits, eau de cologne, make-up, shaving preparations, toiletries.”

3) On the 28 August 1997 The Polo / Lauren Company L.P. of 650 Madison Avenue, New York, NY, 10022, USA filed notice of opposition to the application. The grounds of opposition are in summary:

a) The opponent is the proprietor of three trade marks consisting of or including the word POLO and / or the device of a polo player on horseback detailed at annex A. They claim to have significant goodwill and reputation in these marks.

b) The application is said to offend against sections 3(6), 5(2)(b) & 5(4)(a) of the Trade Marks Act 1994:

4) The applicants subsequently filed a counterstatement denying the above grounds.

5) Both sides ask for an award of costs. Both sides filed evidence in these proceedings and the matter came to be heard on 25 April 2001, when the applicant was represented by Ms McFarland of Counsel instructed by Messrs Bailey Walsh & Co whilst the opponent was represented by Mr Hornby of Messrs Clifford Chance.

OPPONENT'S EVIDENCE

6) The opponent filed three declarations. The first declaration, dated 19 August 1998, is by James Roderick Kelley the Managing Director of Prestige & Collections Ltd. This company is a subsidiary of L'Oreal of Paris which has, since 1985, been the UK distributor of the POLO range of products which are manufactured under licence by L'Oreal.

7) At exhibit JRK1, Mr Kelley provides copies of the various marks used on toiletries and fragrances in the UK. These consist of the POLO HORSEMAN device (657864), an amended version of this mark consisting of a slight variation to the representation of the horseman known as "THE NEW POLO DEVICE", POLO RALPH LAUREN CREST (1484052), RL POLO SPORT RALPH LAUREN WATER BASICS (2007609), POLO. (657863) and POLO (638708). These are referred to collectively as "the POLO marks" in his statement. Full details of these marks are at annex A.

8) At exhibit JRK2 are copies of packaging from a variety of toiletries showing the "New" polo horseman with the words "POLO Ralph Lauren". Mr Kelley states that this mark has been used in the UK. He also states that:

"I believe that the trade mark POLO has been used in the UK since my company assumed distributorship in 1985, but so massive has been the use through my company that I have not made further enquiries into any prior use of the POLO trade marks. The products which have been sold in the UK under the trade mark since 1985 include eau de toilette, aftershave, aftershave balm, shaving foam, deodorants and shaver gel."

9) Mr Kelley provides sales for goods in Class 3 under the POLO marks by his company and also promotional figures for goods under the POLO marks in the UK.

Year	Sales £	Promotion £
1992	2.4 million	695,000
1993	2.6 million	835,000
1994	2.8 million	784,000
1995	2.5 million	512,000
1996	2.4 million	476,000

10) Mr Kelley states that the principle medium for advertising has been the press, national, regional and fashion and other magazines. At exhibit JRK3 he provides copies of various examples of advertisements. Both the advertisements at JRK3 and packaging at JRK2 show that the opponent frequently uses the words “Polo”, “Ralph Lauren” and the “horseman” device in combination. Sometimes the words are underneath the device, other times the device is between the words. There are also instances where the device is used solus, similarly so is the word “Polo”. The most common strap line in the examples of advertising is the “horseman” device followed by the words “Polo by Ralph Lauren”. These advertisements cover the period 1985 - 1998. Mr Kelley states that the product is sold throughout the UK.

11) Mr Kelley states that the polo marks are closely associated with luxury and have an upmarket image. He further claims that the opponent’s marks are distinctive in respect of toiletries in the UK. He states:

“Such is the overall association between the opponent’s goods sold under the image of the polo player design, that I consider that any polo club wishing to use its name as a trade mark on a range of products must avoid using their name in respect of toiletry products because of the confusion which is likely to be caused with the opponent’s products which have for so long monopolised the polo marks and, in particular, the mark polo (word) and image of polo players.”

12) The second, dated 28 July 1998 by Karen Tereza Wells, the Cosmetics and Perfumeries Group Buyer for Alders Department Stores Ltd, a post she has held for three years.

13) Ms Wells states that she has been familiar with the opponent’s polo horseman device and POLO word mark for five years. She also states that in her opinion the opponent has gained a reputation in the UK for their POLO marks in relation to perfumery and toiletry products. She states that she is “not aware of any other producer of perfumery and toiletries who employs the theme of or references to the game of polo in relation to perfumery and toiletry products in the UK”. Ms Wells also gives her views on whether the marks are confusable.

14) The third declaration, dated 10 August 1998, is by Jacqueline Ann Armitage, the retail buyer for James Beatties PLC, a position she has held for eleven years. She states that she has been familiar with the opponent’s polo horseman device and POLO word mark for five years. Using words identical to those of Ms Wells she also refers to the opponent’s reputation, the issue of others using polo related themes and also the issue of confusion.

APPLICANT’S EVIDENCE

15) The applicant filed a declaration dated 12 March 1999 by Paul Beric Dyson, a partner in the firm of trade mark agents representing the applicant.

16) Mr Dyson offers his opinions on the differences between the marks of the applicant and the opponent. He draws a number of distinctions between the images of polo players, stating that in the opponent’s registered device mark the horse is seen side on, is galloping and that the player has his stick backwards across his shoulder. By contrast his client’s marks shows the horse between a side and frontal position, being reined in rather than galloping and the

rider has his stick aloft. Mr Dyson also points out that the words Royal County of Berkshire Polo Club appear either around or below the image in his client's marks.

17) Mr Dyson also claims that there are other marks which have the word POLO or the image of a polo player included in them on the register. At exhibit PDB3 he provides details of four such trade marks on the UK register and seven awaiting a Community Registration. Mr Dyson points out that the opponent consented to the use of the words "polo" and a device of a polo player in Trade Mark registration number 1558682 by the Beverley Hills Polo Club. This registration he states undermines the claims to exclusivity in the word polo and polo players made by the opponent.

OPPONENT'S EVIDENCE IN REPLY.

18) Mr Kelley filed a second declaration, dated 2 December 1999. He states that the applicant's marks draw attention to the word POLO by depicting it and the word CLUB in larger typeface than the other words, and / or portraying the words polo club in isolation to the other words. He also states that although there may be minor differences between the logo devices the overall impression conveyed is the same. Mr Kelley again states that he is not aware of any other company in the UK selling perfumery or toiletry products under a mark containing the word POLO or design of a polo player.

19) Regarding the other registrations Mr Kelley states that these have either been opposed, registered by consent, or are considered by the opponent not to conflict with their marks and / or products.

20) Finally Mr Kelley states that the opponent's consent to Trade Mark registration number 1558682 is their prerogative and should in no way prejudice their ability to oppose the marks in suit.

21) That concludes my review of the evidence. I now turn to the decision.

DECISION

22) At the hearing Mr Hornby on behalf of the opponent withdrew the grounds of opposition under Section 3(6) regarding opposition number 47418.

23) Both parties commended to me the decisions of Mr Geoffrey Hobbs QC, acting as the Appointed Person, in the matter of opposition number 45152 dated 7 September 2000, and that of Mr Allan James, Principal Hearing Officer, in the matter of oppositions 47378 and 47140 dated 21 November 2000. As the instant case is an amalgam of these previous cases, both parties (understandably) cherry picked their way through these cases invoking aspects on their behalf and attempting to persuade me on other parts that the marks or issues were different to the instant case. I agree with both sides that both previous decisions deserve respect and I adopt some of the reasoning, but I must reach my own decision.

24) I turn first to the ground of opposition under Section 5(4)(a) which Mr Hornby submitted was his strongest case. It reads:

(4) *A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -*

(a) *by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade*

(b) *.....*

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.

(5) *Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.*

25) The only potential “earlier right” which the opponent has identified arises under the common law of passing off. I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the WILD CHILD case (1998 14 RPC 455). In that decision Mr Hobbs stated that:

“The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art.4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the Applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England 4th Edition Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd - v - Borden Inc [1990] RPC 341 and Even Warnik BV - v - J. Townend & Sons (Hull) Ltd [1979] AC 731 is (with footnotes omitted) as follows:

‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

26) The opponent has two polo player devices. The version registered under trade mark number 657864 and the unregistered version referred to as the “new” polo horseman device. Clearly the new device is closer to the device in the applicant’s mark and is the main basis of the opposition. Use of this “new” device has been provided by the opponent. At exhibit JRK3 copies of a number of advertisements were provided. The advertisements were dated between 1985 - 1998, although the dates were hand written the applicant did not challenge this evidence. Whilst the words POLO, Ralph Lauren and the horseman device were used in a variety of ways the following is perhaps the most typical usage:



27) The opponent also provided examples of packaging at exhibit JRK2. These were not dated but the evidence of Ms Wells and Ms Armitage assists as they both exhibit the “new” and registered polo player devices and state that they have been familiar with the devices for five and thirteen years respectively. The packaging also uses the words POLO, Ralph Lauren and the horseman device in a variety of ways, the most typical being:



28) Given the above it is reasonable to conclude that the opponent’s goods were identified by the words “POLO”, “RALPH LAUREN” and the “new horseman / polo player device” both individually and collectively by the relevant date of 13 May 1997.

29) Whilst the applicant accepted that the opponent enjoyed a high degree of recognition and therefore goodwill and reputation Ms McFarland contended:




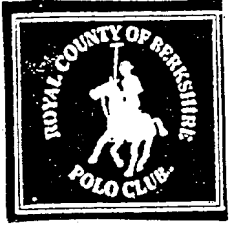


“We say that there comes a point when the degree of fame and repute is something which can actually tip over a plateau and start to be of less benefit to the opponent in the sense that where a mark has become so well-known and has a particular following, then they have achieved a degree of education of the purchasing public which means that the public becomes particularly well aware of what to look for, particularly conscious of the elements of the marks and names which are promoted so there is a particular degree of distinctiveness which will assist in preventing degrees of confusion and misassociation that might otherwise occur. In other words, imperfect recollection on the part of the members of the public who know, recognise and wish to purchase the Ralph Lauren product is very high. The degree of mistake they are making

imperfectly recalling becomes less the more famous the mark.”

30) This contention is not one I can accept as it appears to me to invite the proposition that the more famous a mark becomes the less protection it is afforded, which is the reverse of the approach advocated by the European Court of Justice [ECJ] in *Sabel Bv v Puma AG* [1998 RPC 199], with regard to registered trade marks.

31) Having established that the opponent does indeed have goodwill in the UK in goods in Class 3 under the word “Polo”, “Ralph Lauren” and also the device of a polo player I must now consider the second aspect of misrepresentation.

32) In order to assist in the comparison of marks I have reproduced below the applicant’s series of four trade marks and also the typical use of the opponent’s device in advertising and packaging.

Applicant’s marks	Opponent’s mark
<p>a</p> 	<p>Advertising</p> 
<p>b</p> 	
<p>c</p> 	<p>Packaging</p> 
<p>d</p> 	

33) Although the applicant applied for a series of four marks I believe that there are significant

differences between the fourth mark in the series and the first three. I therefore propose to deal with the issue of misrepresentation in two parts. Dealing with the first three marks in the series as one and then separately, the fourth mark.

34) Clearly the second mark in the applicant's series is a larger version of the first mark and also a negative of the first mark. The nature of packaging for goods in class three will necessitate use of a positive and negative image as the goods are commonly sold in glass containers which are then enclosed in cardboard. The mark when used on glass will frequently be more easily seen in the negative. Such variations are in my view trivial. The third mark in the series is the same as the second except that it includes a square border. This has no significant effect on the identity of the mark.

35) In my view, the most dominant feature of the applicant's marks is the device of a polo player. The words "Royal County of Berkshire" and "Polo Club" are arranged around the device of the polo player, making this the visual centrepiece of the mark. The words "Polo Club" are easy enough to read because they are placed in a comparatively horizontal position relative to the device of the polo player. The words "Royal County of Berkshire" are a little less easy to absorb because of their position relative to the polo player device. Because of this one needs to change the position of one's head to read these words.

36) For the applicant, Ms McFarland contended that where words are in a roundel or going round in a circle the notional reader would assume that the words are meaningful rather than just pretty edging and that they are there to be read and understood. I do not accept this contention. Clearly the polo player is the dominant feature of the first three marks in the series.

37) Ms McFarland accepted at the hearing that the polo player elements of both parties were visually similar. In giving the polo player device prominence, the applicant has captured the distinctive character of the opponent's trade mark. It is a misrepresentation if the similarity leads or is likely to lead the public to believe that the goods offered by the defendant are goods of the plaintiff. The words "Royal County of Berkshire Polo Club" are insufficiently prominent to dispel the expectation that would be aroused by the opponent's reputation, that the polo player device identifies the goods of the opponent. Consequently the opponent has established misrepresentation with regard to the first three marks in the applicant's series of four marks.

38) The fourth mark in the applicant's series consists of the device of a polo player with the words ROYAL COUNTY OF BERKSHIRE, POLO CLUB written in two straight lines underneath the device. Mr Hobbs QC, sitting as the appointed person considered the mark shown below:



39) The opposition was based on the opponent's earlier registration of the word POLO. Mr Hobbs commented:

".....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 analogous 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."

40) It appears to me that applying the same reasoning to the fourth mark in the applicant's series of marks produces the same result. It is true that it does not contain the stylised numeral "10" from the earlier case, but the presence of this feature does not appear to have been critical to Mr Hobbs' decision. The presence of the device of a polo player reinforces the semantic association between the respective marks. It is a fine judgement in this instance but it is still difficult to see how the average consumer could overlook the presence of the words ROYAL COUNTY OF BERKSHIRE and CLUB in the applicant's mark.

41) It is with some hesitation that I come to the conclusion that the words "Royal County of Berkshire POLO CLUB" are the dominant feature of the applicant's fourth mark. Mr Hornby contended that the size of the horseman device was larger than in the marks considered in previous decisions and as such it had become the dominant feature. I do not agree that the very marginal increase in the size of the device element would affect the overall message that the mark sends to the average consumer, although it does diminish that message.

42) I take into account the acknowledged reputation and goodwill in the words "POLO", "Ralph Lauren" and the device of a polo player and the similarity between the polo player devices and also the goods. However, in my view the differences between the respective marks is such that the average consumer is unlikely to expect goods marketed under the

applicant's mark to originate from the opponent or from an economically linked undertaking.

43) As I have found both goodwill and misrepresentation under the horseman device, damage to the opponent's business is inevitable.

44) The opposition under Section 5(4) has therefore been successful in relation to marks 1-3 in the series but not successful in relation to the fourth mark. At the hearing Mr Hornby contended that if he was successful with regard to any of the marks then the others must fall as they are part of a series. I do not agree with this contention. The applicant can request to amend the registration from a series of four marks to a single mark.

45) Although not formally withdrawing the opposition under Section 5(2) Mr Hornby chose not to make any submissions on this ground and accepted that then his Section 5(2) ground added nothing to the merit of his argument. I agree with his reasoning. In reaching my decision under Section 5(4) I have taken into account factors such as reputation, similarity of marks and goods and found against the applicant on three of the series of four marks. My decision regarding the fourth mark in the series would not have been different under Section 5(2).

46) The opposition to the first three of the applicant's series of four trade marks has been successful. As grounds for refusal exist only in respect these three marks the application will be allowed to proceed to registration if, within one month of the end of the appeal period for this decision, the applicants file a TM21 withdrawing the first three marks in their series leaving only the fourth mark on the Register.

47) If the applicants do not file a TM21 withdrawing marks 1-3 inclusive as set out above the application will be refused in its entirety.

48) In dealing with the costs under opposition number 47418 Ms McFarland addressed me regarding the withdrawal of opposition number 48571. She sought costs above the scale regarding this late withdrawal as they had enquired of the opponent some time ago whether they would withdraw this opposition, the abandonment was at the last moment and that the costs incurred by the applicant were significantly more than the scale charges which would normally be paid. Ms McFarland opined that in view of the decision by Mr Geoffrey Hobbs acting as the Appointed Person, in a case between the same parties and dealing with the same marks, it was inevitable that the opposition would fail as the cases closely resembled each other.

49) In my view the fact that the abandoned case was, according to the applicant, so similar to a previous case should have meant that less work was required in preparing for the hearing. Also, had the hearing proceeded and a finding been made against the opponent, there were no reasons put forward as to why the costs awarded would be above the normal scale. Whilst it is undesirable for the opponent to wait until two days prior to the hearing to withdraw the opposition, it seems to me that at least this has the advantage of saving both parties the costs of attending the hearing. I therefore can see no reason to award costs above the normal scale. I have been asked by both parties to amalgamate the costs award to the applicant into the costs in this case. The costs awarded to the applicant are £435.

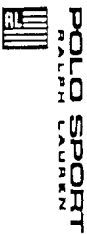

50) The opposition having succeeded the opponent is entitled to a contribution towards costs.


I order the applicant to pay the opponent the sum of £1135. This sum has to be adjusted to take into account the costs awarded to the applicant regarding the abandoned opposition 48571. In that case the applicant was awarded costs of £435. I therefore order the to pay the the sum of £700. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of July 2001

George W Salthouse
For the Registrar
The Comptroller General

ANNEX A

Trade Mark	Number	Class	Effective Date	Specification
POLO	638708	3	18 / 7 / 45	Perfumery, toilet preparations (not medicated), cometic 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.	657863	3	1 / 4 / 47	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.
 RL POLO SPORT RALPH LAUREN Water Basics	2007609	3	23 / 12 / 94	Soaps, perfumery, toilet water, essential oils, cosmetics, dentifrices, cologne, shaving gel, shaving cream, after-shave balm, after-shave foam, skin lotion, skin cream, face moisturizer, talcum powder, anti-perspirant spray and deodorant stick for personal use and sun screen products; all for men; all included in Class 3; but not including hair products.
	657864	3	1 / 4 / 47	Bath salts, talcum powder, face powder, scalp stimulating preparations, lotions for use after shaving, face cream, all being non-medicated toilet preparations; and lipstick, brilliantine, hair lotions, shampoos, dentifrices, soaps and perfumes.

 <p>Polo Ralph Lauren RALPH LAUREN CREST</p>	1484052	3	28 / 11 / 91	Fragrant preparations included in Class 3
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