

TRADE MARKS ACT 1994

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

AND IN THE MATTER OF OPPOSITION THERETO UNDER
NO. 47418 BY THE POLO/LAUREN COMPANY LP

DECISION

Introduction

1. This is an appeal to the Appointed Person from a decision of Mr. Salthouse, the Hearing Officer acting for the Registrar, dated the 24th July 2001.
2. On the 13th May 1997, Royal County of Berkshire Polo Club Ltd (“the Applicant”) applied to register a series of four trade marks. The fourth mark in the series is depicted below:



3. The application was made in respect of a wide specification of goods in Class 3, including perfumery.

4. On the 28th August 1997, The Polo/Lauren Company L.P. (“the Opponent”) filed notice of opposition to the application. So far as relevant to this appeal, the grounds of opposition were that:
 - (a) The Opponent was the proprietor of a number of trade marks (including registered trade marks) consisting of or including the word POLO and/or a device of a polo player on horseback, and at all material times it had a significant goodwill and reputation in these marks.

 - (b) Registration would be contrary to the provisions of section 5(4)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”).

5. The opposition proceeded to a hearing before Mr. Salthouse and in his written decision dated the 24th July 2001 he concluded that the opposition failed in respect of the fourth mark in the series but succeeded in respect of the first three. Accordingly, he allowed the application to proceed to registration if, within one month of the end of the appeal period for his decision, the Applicant withdrew the first three marks in the series.

The Appeal

6. In August 2001 the Opponent gave notice of appeal to an Appointed Person. It appealed against the decision of the Hearing Officer in respect of the fourth mark in the series.
7. Before me, Mr. Hornby of Clifford Chance appeared on behalf of the Opponent and Miss McFarland, instructed by Messrs. Bailey Walsh & Co. appeared on behalf of the Applicant.
8. Both parties agreed that I should treat the appeal as a review rather than a rehearing and that I should follow the approach set out by Pumfrey J. in *South Cone Incorporated v. Jack Bessant & Others* (a decision of 25th July 2001), at paragraph 6:

"My approach will be as follows. Findings of primary fact will not be disturbed unless the hearing officer made an error of principle or was plainly wrong on the evidence. His inferences from the primary facts may be reconsidered, but weight will be given to his experience. No question of the exercise of a discretion arises. In this way, error will be corrected, but a different appreciation will not be substituted for that of the hearing officer if he has arrived at his conclusion without error."

The Appeal under section 5(4)(a) – Passing Off

9. The Opponent developed its submissions under this ground of objection. Similarly, before the Hearing Officer, the Opponent submitted that this ground of objection provided its strongest case.
10. My attention was first drawn to the primary facts found by the Hearing Officer, findings with which the Opponent took no issue. The Hearing Officer found

the Opponent had established a goodwill in the United Kingdom in goods in Class 3 under the words “POLO” and “RALPH LAUREN”, and also the device of a polo player, described as the “new horseman / polo player device”. He further found that the goods of the Opponent were identified by the words “POLO”, “RALPH LAUREN” and the “new horseman/polo player device”, both individually and collectively by the relevant date. The marks had been used in a variety of ways. Typical examples of the styles of use are set out in the decision and are reproduced below:

Advertising:



Packaging:



11. Having made these findings of primary fact, the Opponent submitted that the Hearing Officer should have gone on to find that the objection under section 5(4)(a) was made out. It was submitted that in failing to make such a finding, the Hearing Officer erred in principle. Moreover, I was invited to reconsider his conclusion that there was no likelihood of passing off.

12. As to the error of principle, the Opponent submitted that the Hearing Officer had placed too much reliance upon a decision of Mr. Geoffrey Hobbs Q.C, sitting as an Appointed Person, in the case of *10 ROYAL BERKSHIRE POLO CLUB Trade Mark* [2001] RPC 32. In that case Mr. Hobbs Q.C considered the mark shown below:



13. The Hearing Officer cited the following passage from paragraphs 31 to 33 of the decision of Mr. Hobbs:

“... 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 L.J. 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.”

14. In his decision, the Hearing Officer then continued:

“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 judgment 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."

15. The Opponent submitted that in these paragraphs the Hearing Officer fell into error in placing too much reliance upon the decision of Mr. Hobbs and in failing to consider the mark in issue in the present case afresh. It was further submitted that the decision of Mr. Hobbs very much depended upon the particular marks there in issue and, specifically, upon the presence of the numeral 10 in the applicant's mark. No such distinction could be drawn in the present case. On the contrary, it was said, the polo player device in the mark in issue in this case was accepted to be similar to the "new horseman / polo player" device of the Opponent.

16. I am unable to accept these criticisms of the decision of the Hearing Officer. It appears to me that the Hearing Officer did consider the mark in issue in this case afresh, but found the reasoning of Mr. Hobbs in the earlier case to be helpful. The Hearing Officer clearly had well in mind the differences between the marks in issue in the two cases, in that the mark the subject of the present application does not contain the stylised numeral “10”, but does contain a polo player device which is similar to the “new horseman / polo player” device of the Opponent.
17. The Hearing Officer arrived at his conclusion on the basis that it was difficult to see how the average consumer could overlook the presence of the words “*Royal County of Berkshire*” and “CLUB” in the mark of the Applicant. With some hesitation he came to the conclusion that the wording “*Royal County of Berkshire POLO CLUB*” was a dominant feature of the Applicant’s mark. Like the Hearing Officer, I have not found this an easy case to decide. Nevertheless, again like him, I conclude that the presence of the words “*Royal County of Berkshire*” and “CLUB” are unlikely to be overlooked and I also have in mind the reasoning of Mr. Hobbs that adjectival use of a word is distinguishable from the use of the same word as a noun and that the resulting differences of perception may be sufficient to preclude a likelihood of confusion. In the present case the word “POLO” does function adjectivally in the context of the Applicant’s mark. Accordingly, I too have come to the conclusion that the marks are not so similar as to be likely to cause confusion or deception and that the differences between the marks are 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.

18. Accordingly the appeal must be dismissed.

19. The Hearing Officer concluded that the opposition having succeeded on three marks in the series, the Opponent was entitled to a contribution to its costs. He ordered the Applicant to pay to the Opponent the sum of £1135. This sum had to be adjusted to take into account the costs awarded to the Applicant regarding an abandoned opposition in which the Applicant was awarded costs of £435. He therefore ordered the Applicant to pay the sum of £700.

20. The Opponent has now failed on the appeal and the parties agreed that I should follow the usual practice with regard to costs. I therefore order the Opponent to pay to the Applicant the sum of £1135 as a contribution to its costs of the Appeal. Taking into account the order of the Hearing Officer this will mean that the Opponent has to pay to the Applicant a balance of £435.

DAVID KITCHIN, Q.C

31st January 2002