

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2172632
BY THE POLO/LAUREN COMPANY L.P.
TO REGISTER A SERIES OF TRADE MARKS
IN CLASSES 8,9,16,18,20,21,24,25,27, 28 AND 35**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 80316
BY MALHOTRA SHAVING PRODUCTS LTD**

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IN THE MATTER OF Opposition thereto under No. 80316

by Malhotra Shaving Products Ltd

BACKGROUND

1. On 21 July 1998 The Polo/Lauren Company L.P. applied to register the following series of two marks:



2. The first mark in the series is limited to the colours black, white and red. The application has been made in the following 11 Classes of goods and services – 8,9,16,18,20,21,24,25,27,28 and 35. This opposition concerns two Classes only – 8 and 21. The applied for specifications in those Classes are:

Class 8:

Hand tools; namely, forks, ice picks, manicure sets, meat choppers, mincing knives, nutcrackers, oyster openers, palette knives, paring knives, pedicure sets, penknives, razor blades, razor cases, razor strops, razor, electric or non-electric, scaling knives, silver plate; knives, spoons, forks, table cutlery, table forks, tableware, tin openers, tongs, vegetable choppers, vegetable knives, vegetable shredders, vegetable slicers.

Class 21:

Household and kitchen utensils; namely, beer mugs, bottle openers, bread bins, bread boards, footwear brushes, butter dishes, candelabra, candle extinguishers, candle rings, candlesticks, cocktail stirrers, coffee services, coffeepots, comb cases, combs, cookie jars, cooking pots, cooking utensils, corkscrews, crockery, cups, decanters, dishes, drinking flasks, drinking glasses, egg cups, figurines, fruit cups, glass bowls, glassware, goblets, ice buckets, jugs, kettles, liqueur sets, pans, pepper mills, perfume sprayers, perfume vaporizers, pitchers, porcelain ware, pots, poultry rings, salad bowls, salt cellars, salt shakers, saucepans, shaving brushes, soap boxes, soap holders, soup bowls, statues of porcelain, terra-cotta or glass, statuettes of porcelain, terra-cotta or glass, sugar bowls, table plates, tableware, tankard, teapots, toilet brushes, toilet cases, toilet utensils, toothbrushes, toothpicks, trays, urns, utensils for household purposes, vases.

3. The application is numbered 2172632.

4. On 1 November 2001 Malhotra Shaving Products Limited filed notice of opposition to this application. They are the proprietors of the following Community Trade Mark:

No.	Mark	Classes	Specification
633529	SPORT	3	Shaving soap and cream, after-shave lotion.
		8	Safety razors, safety razor blades and shaving systems, shaving cases; hair clippers; manicure sets.
		21	Shaving brushes; shaving brush stands; combs and sponges; brushes; toothbrushes; nail brushes; comb cases; cosmetic utensils; soap dishes and holders; polishing brushes and gloves, shoe trees.

It is an earlier trade mark within the meaning of Section 6(1) of the Act having a filing date of 19 September 1997. On the basis of this CTM registration opposition is raised against the following goods within the application in suit:

Class 8: Manicure sets, razor blades, razor cases, razor strops, razor, electric or non-electric.

Class 21: Footwear brushes, comb cases, combs, shaving brushes, soap boxes, soap holders, toilet brushes, toilet cases, toilet utensils, toothbrushes, toothpicks.

5. The remaining goods in these Classes are not objected to. The opponents base their opposition on Section 5(1) and/or 5(2)(b) of the Act.
6. The applicants filed a counterstatement in which they deny the grounds of opposition.
7. Both sides ask for an award of costs in their favour.
8. A Registry Hearing Officer reviewed the case and indicated that he considered a decision could be reached from the papers available and the standard authorities and without recourse to a hearing. The parties were nevertheless reminded of their right to be heard or to make written submissions. Neither side has asked to be heard or offered written submissions beyond those contained in the statement of grounds, counterstatement and evidence. Acting on behalf of the Registrar and with the above material in mind I give this decision.
9. The opponents have filed evidence in the form of a witness statement by S Ravindran and the applicants have filed a witness statement by James Edward Robey. As most of this material is in the nature of submissions I do not propose to offer a summary but will bear in mind the comments made in reaching my decision.

DECISION

10. The relevant part of the statute reads:

“5.-(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) 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.”

Section 5(1)

11. The opponents' case under this head turns on the submission that the marks are identical because the word SPORT (the opponents' mark) is entirely contained within the mark applied for and furthermore is not represented in a special font or type. If the matter turned on whether there is anything special about the presentation of the word SPORT in the applicants'

mark I would have to agree with the opponents' submission. The word is presented in an entirely unexceptional font.

12. The applicants' mark here is, of course, a great deal more than the word SPORT. The question of whether marks are identical or simply very similar has been considered in *IDG Communications Ltd's Trade Mark Application* [2002] RPC 10 at page 283 where the marks in issue were DIGIT and digits. The Hearing Officer concluded that the marks were not identical. His reasoning by reference also to Simon Thorley QC's decision in *BAYWATCH* (unreported SRIS O/051/01) can be found on pages 286 to 288 of the decision.

13. I also bear in mind the opinion of Advocate General Jacobs in *SA Societe LTJ Diffusion v SA SADAS* Case C-291/100 where he concluded that:

“The concept of identity between mark and sign in Article 5(1)(a) of Council Directive 89/104/EEC covers identical reproduction without any addition, omission or modification other than those which are either minute or wholly insignificant.”

14. On the basis of the principles adopted in the above cases I conclude that the respective marks are not identical. The opposition based on Section 5(1) must fail.

Section 5(2)(b)

15. In considering this ground I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

Similarity of goods

16. For ease of reference it is convenient to set out the respective sets of goods:

Applicants' goods (those objected to only)

Class 8

Manicure sets, razor blades, razor cases, razor strops, razor, electric or non-electric.

Class 21

Footwear brushes, comb cases, combs, shaving brushes, soap boxes, soap holders, toilet brushes,

Opponents' goods

Class 3:

Shaving soap and cream, after-shave lotion.

Class 8

Safety razors, safety razor blades and shaving systems, shaving cases; hair clippers; manicure sets.

Class 21

Shaving brushes; shaving brush stands; combs and sponges; brushes;

toilet cases, toilet utensils, toothbrushes,
toothpicks.

toothbrushes; nail brushes; comb cases;
cosmetic utensils; soap dishes and
holders; polishing brushes and gloves,
shoe trees.

17. The opponents' statement of grounds indicates that they rely principally on the clashes that exist within the Classes at issue but also regard the goods in the other Classes as being similar. The applicants do not admit that all the goods are the same or similar but do not explain the basis for their views.

18. In the CANON case the ECJ stated:

“23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.”

19. It does not require detailed analysis to establish that certain goods (manicure sets, razor blades and razors) appear in both the Class 8 specifications albeit that the razors are qualified as being of the 'safety' variety in the opponents' specification. In this respect the general in the applicants' specification must include the specific in the opponents' specification. The other items – razor cases and razor strops – are or may be part of shaving systems, equivalent to shaving cases or complementary items within the CANON test. All the Class 8 goods are, therefore either identical or closely similar.

20. So far as Class 21 is concerned, again a number of terms appear in both specifications and must be considered identical. In this category I place comb cases, combs, shaving brushes and toothbrushes. Other items appear to be alternative methods of describing the same thing. Thus soap boxes and soap holders are akin to soap dishes, and toilet utensils and toilet cases are akin to cosmetic utensils and comb cases. If they are not actually the same they are certainly very closely similar. A third category, consisting of footwear brushes and toilet brushes, must be contained within the general term brushes. Finally toothpicks, whilst having no direct counterpart in the opponents' specification, must be considered closely complementary to a toothbrush and similar to that item.

21. It follows that all the opposed goods are either identical or similar.

Distinctive character of the opponents' mark

22. The distinctive character of the earlier trade mark is a factor that must be taken into account, *Sabel v Puma*, paragraph 24. As no evidence has been filed bearing on use of the opponents' mark, I can only base my consideration on the inherent characteristics of the mark in the context of the goods for which it is registered (and on which the opposition is based).

23. The applicants have suggested in their counterstatement that it is common for trade marks for a wide range of goods to have the word SPORT as a suffix and that as a result the

public are used to distinguishing such marks. Mr Robey, the applicants' professional representative in this matter, has given evidence on the point on the form of a UK and CTM database search for marks containing the word SPORT.

24. State of the register evidence is rarely of assistance unless supported by evidence that marks are in use in the marketplace (*British Sugar Plc v James Robertson & Sons Ltd*, [1996] RPC 281). That fundamental problem is compounded in this case by the fact that the database prints include pending and abandoned marks and registrations that post-date the relevant date in these proceedings. I, therefore, find this material to be of very limited value save in so far as it suggests that SPORT is a word which is of interest to a number of traders and may be seen as possessing desirable characteristics or associations in a trade mark context.

25. As SPORT is the only element in the opponents' earlier trade mark it must be considered to be the distinctive element. It is a well known dictionary word. But, so far as I am aware, it has no particular descriptive significance in the context of the opponents' goods other than being suggestive of vitality and pleasure. If there is an allusive quality to the word it is an oblique one. I, therefore, consider the word SPORT to be averagely distinctive in relation to the goods.

Similarity of marks

26. The visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by those marks bearing in mind their distinctive and dominant components, *Sabel v Puma* paragraph 23. The matter must be judged through the eyes of the average consumer of the goods/services in question, *Sabel v Puma*, paragraph 23. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant but rarely has the chance to make direct comparisons between marks. Imperfect recollection must, therefore, be allowed for, *Lloyd Schuhfabrik v Klijsen Handel*, paragraph 27.

27. Before comparing the marks at issue I should comment briefly on the applicants' mark. It consists of the letters RLX and the words POLO SPORT set against a dark background. The letters RL and X are of the same size and much larger than the words POLO SPORT. The letter X is presented in a colour which contrasts with the preceding letters. There is a further, and in my view minor stylistic point, in that the letter L is conjoined with the X in the sense that it runs into the bottom left diagonal of the X.

28. I find the *10 ROYAL BERKSHIRE POLO CLUB TRADE MARK* case, [2001] RPC 32 page 643, to be of assistance in determining my approach to the issue before me. In that case the composite mark 10 ROYAL BERKSHIRE POLO CLUB applied for in respect of Class 3 goods was opposed by the proprietors of the mark POLO (registered for identical goods). It will be convenient to record the Appointed Person's reasons for allowing the applicants' appeal:

“30 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 page 250 per Lord Simonds.

- 31 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.
- 32 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.
- 33 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] F.S.R. 283, CA, at page 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."

29. I should add by way of a footnote to the above that the applied for mark had the words POLO CLUB presented in a different typeface from the words ROYAL BERKSHIRE and in, arguably, a more visually prominent lettering. The precise form of presentation can be seen on page 646 of the RPC in question.

30. There can be no doubt that the word SPORT is a clearly visible element within the applied for mark. It is not, in my view, presented as a free standing or independent element but rather as part of the combination POLO SPORT. At least, I do not think the average consumer would regard those words as being unconnected. They form a visual, aural and conceptual whole. Those words are themselves dominated by the letters RLX which form the most striking visual feature of the applied for mark. It would be surprising if these considerations did not also play a decisive part in aural and conceptual appraisal of the marks.

So far as the latter is concerned the word POLO is likely to be seen as functioning adjectively to qualify the noun sport. But it is the nature of the sport ie. polo that is likely to be taken as giving precision to the idea and thereby creating the dominant impression within the phrase POLO SPORT.

31. The ECJ authorities caution against over analysis of marks and emphasise that the average consumer rarely has the opportunity to compare marks side by side. Imperfect recollection must be allowed for. In that respect consumers are likely to have an overall impression of the marks in their mind. That overall impression is in turn likely to be shaped by the distinctive and dominant elements. To adapt Mr Hobbs' words from 10 ROYAL BERKSHIRE POLO CLUB, the message of the applicants' mark comes from the letters and words in combination. It is unlikely that consumers would focus on the word SPORT without also noticing that it forms part of the composite phrase POLO SPORT which in turn is a subordinate element to the letters RLX. In short there is an undeniable point of similarity having regard to the common element SPORT but the marks taken as wholes are not distinctively similar (to borrow that expression from *Torremar Trade Mark*, [2003] RPC 4).

Likelihood of confusion

32. In *RALEIGH INTERNATIONAL Trade Mark*, [2001] RPC 11, page 202, Mr Hobbs QC, sitting as the Appointed Person said:

“Similarities between marks cannot eliminate differences between goods or service; and similarities between goods and services cannot eliminate differences between marks. So the purpose of the assessment under section 5(2) must be to determine the net effect of the given similarities and differences.”

33. In the light of my views on the marks themselves, it follows that there can be no likelihood of confusion even if the applicants' mark is used on identical goods.

34. The opposition fails accordingly.

Costs

35. The applicants are entitled to a contribution towards their costs. This is not a case where the applicants have been greatly burdened in providing evidence and I have not been able to place any weight on the material they have provided. In all the circumstances I order the opponents to pay the applicants the sum of £750. This sum is 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 06 day of January 2003

**M Reynolds
For the Registrar
the Comptroller-General**