

O-198-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION Nos. 2641961 & 2641963
BY GBR POLO LIMITED
TO REGISTER THE TRADE MARKS
GBR POLO & POLO JOHNBULL
IN CLASS 25
AND**

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS
THERE TO UNDER No. 400279 & 400281 BY
THE POLO/LAUREN COMPANY L.P.**

BACKGROUND

1) On 12 November 2012 GBR Polo Limited (hereinafter the applicant) applied to register the trade marks GBR POLO (2641961) and POLO JOHN BULL (2641963) in respect of the following goods:


In Class 25: Clothing; shirts; jackets; underwear; shoes; hats; hosiery; scarves; shawls; girdles; layette; clothing for children; swimsuits; wedding veil; raincoat.

2) The applications were examined and accepted, and subsequently published for opposition purposes on 15 February 2013 in Trade Marks Journal No.6979.

3) On 15 May 2013 The Polo/Lauren Company L.P. (hereinafter the opponent) filed notices of opposition. The grounds of the oppositions are in summary:

a) The opponent is the proprietor of the following trade marks:

Mark	Number	Date of application / registration	Class	Specification relied upon
POLO	CTM 4049334	29.09.04 12.08.10	25	Clothing, underclothing; shoes and footwear; headgear; clothing for men, women, children and infants, jeans, slacks, trousers, skirts, shorts, wraps, jerseys, sweaters, waistcoats, dresses, jumpers, sleepwear, robes, warm-up suits, rainwear, sweaters, scarves, hats, caps, mittens, snow suits, belts, smocks, swimwear, playsuits, bibs, stockings, socks, waterproof clothing, underwear; footwear for men, women, children, and infants shoes, sneakers, sandals, slippers, boots; headgear for men, women, children, and infants hats, headbands, earmuffs, caps, sweaters, dress shirts, blouses; jackets, ties, suits, bathing suits, belts, skirts, dresses, coats, hats, caps, tuxedos, pants, vests, hosiery, scarves, pyjamas, underwear, kilts, mufflers, shawls; footwear, shoes, boots, slippers, and athletic shoes; blazers, headbands, wristbands, coveralls, overalls, sweat pants, and sleepwear; but not including shirts other than dress shirts, and not including garments with polo necks, and not including any of the aforesaid goods being sports clothing intended for use in playing polo.
POLO TENNIS	CTM 8928772	04.03.10 10.10.11	25	Footwear, headgear
POLO DENIM & SUPPLY	CTM 9624784	23.12.10 07.07.11	25	Clothing, footwear, headgear; boots; shoes; slippers; sandals; trainers; socks and hosiery; hats; caps; berets; scarves; gloves; mittens; belts (being articles of clothing); shirts; T-shirts; sports shirts; trousers; jeans; shorts; sports shorts; swimwear; underwear; lingerie; tracksuits; articles of outerwear; coats; jackets; ski jackets; waterproof and weatherproof clothing; ski wear; suits; jumpers; cardigans; knitwear; leggings; neckties; pyjamas; waistcoats; headbands and wristbands; menswear; womenswear; childrenswear; underclothing; clothing for men, women, children and infants; slacks; skirts; wraps; jerseys; blouses; dresses; sleepwear; robes; sweatshirts; bibs; stockings; earmuffs; ties; tuxedos; vests; kilts; shawls; blazers; overalls.

POLO JEANS CO.	CTM 8814451	15.01.10 13.06.10	25	Clothing, footwear, headgear.
POLO  RALPH LAUREN	CTM 8612871	13.10.09 08.06.10	25	Clothing, footwear, headgear.

b) The opponent contends that the marks applied for are similar to its earlier marks as they all contain the word POLO and that the word POLO is the dominant element in all the marks. The opponent contends that the goods in Class 25 of its earlier marks are identical to the goods applied for and therefore the marks in suit offend against Section 5(2)(b) of the Act.

c) The opponent relies upon all of the marks listed above and claims that it has reputation in the UK in the marks such that use of the marks in suit, without due cause, would take unfair advantage of, and/or be detrimental to, the distinctive character or the repute of the earlier marks. Specifically they allege that use of the marks would:

i) free ride on the coat tails of the reputation and/or prestige of the opponent's earlier marks, thereby deriving illegitimate benefit from it and exploiting the marketing efforts of the opponent.

ii) As the opponent will not control the manner in which the marks applied for are used they may be used on goods of inferior quality which would tarnish the reputation of the opponent.

iii) The opponent owns a number of POLO marks and use of the marks in suit would dilute the distinctive character of the opponent's marks and cause an immediate association with the opponent's goods. The public will cease to associate goods as originating from a single source but will start associating it with multiple undertakings. This will result in the loss of sales by the opponent. The mark in suit therefore offends against Section 5(3) of the Act.

d) The opponent also claims unregistered rights in the term POLO which it states it has used since at least 1960 and has a considerable reputation and goodwill .As the marks applied for are similar and for similar goods there is a likelihood of misrepresentation with consequent damage to the opponent. The marks in suit therefore offend against Section 5(4)(a) of the Act.

4) On 29 July 2013 the applicant filed a counterstatement denying all the grounds. It put the opponent to strict proof of use of its marks. The applicant also contended that confusion will not occur as the marks and goods are different.

5) The oppositions were consolidated on 7 August 2013. Only the opponent filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard. Only the opponent provided written submissions which I shall take into account as and when they are relevant.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 10 June 2013, by Anna Dalla Val the Vice President and Secretary of PRL International Inc, General Partner of the opponent. She states that her role in the company is to manage and protect the opponent's worldwide intellectual property rights and she has a considerable understanding of the development and use of the opponent's trade marks. She has full access to the records of the opponent. She states that the opponent has used its POLO mark and its family of POLO marks in the UK on clothing and fashion accessories such as wallets, bags and belts. She provides the following sales and marketing figures for Europe (including the UK):

F/Y	2006	2007	2008	2009	2010	2011
Net sales US\$ millions	623	763	886	1025	1051	1177
Marketing € millions	22	26	28	27	30	37

7) Ms Val states that approximately 20% of the above sales relate to the UK but she does not state how she reaches this conclusion. It is clear from the evidence that POLO products are sold throughout the UK in independent retail outlets and also factory stores. The latter are branded POLO RALPH LAUREN. She also provides the following exhibits:

- ADV10: this contains extracts from the opponent's website which shows use of POLO and the CTM 8612871 device mark.
- ADV12 & 13: extracts from UK magazines published during 2001 to 2004 which show use of POLO on clothing footwear and headgear.

8) Overall the evidence is clearly generic. It is not focussed on the marks upon which the opposition is based; indeed there is no mention of several of the marks which are relied upon in the evidence of Ms Val. Virtually none of the evidence relates solely to the UK despite claims of reputation and goodwill being made in the statement of grounds. Most of the exhibits and the witness statement deal with the global position and consists of internal documentation.

9) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

10) I will first consider the ground of opposition under Section 5(2)(b):

5.-(2) A trade mark shall not be registered if because -

(a)

- (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.”

11) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

12) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier trade marks. Because of the interplay between the date the marks in suit were advertised (15 February 2013) and the registration dates of the opponent’s marks, the Trade Marks (Proof of Use, etc) Regulations 2004, do not come into play.

13) When considering the issues under Section 5(2) and the likelihood of confusion, I take into account the guidance from the settled case law provided by the CJEU in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. In *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods/ services in question; who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements; nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(g) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient;

(i) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing process

14) I must now determine the average consumer for the goods of the parties. Both parties have specifications, broadly speaking, of clothing, footwear and headgear. Such goods will be sold in, inter alia, traditional retail outlets on the high street, through catalogues and on the Internet. Neither party's specifications are limited in any way, and so I must keep all of these trade channels in mind. The average consumer of the goods at issue is a member of the general public who is likely, in my opinion, to select the goods mainly by visual means. I accept that more expensive items may be researched or discussed with a member of staff. In this respect I note that in *New Look Ltd v OHIM Cases- T-117/03 to T-119/03 and T-171/03*, the General Court (GC) said this about the selection of clothing:

“50. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly, the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

15) In the same case the Court also commented upon the degree of care the average consumer will take when selecting clothing. It said:

“43. It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question (see, by analogy, Case C 342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As Ohim rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

16) Clearly, the average consumer’s level of attention will vary considerably depending on the cost and nature of the item at issue. However, to my mind even when selecting routine inexpensive items of clothing such as socks, the average consumer will pay attention to considerations such as size, colour, fabric and cost. Overall the average consumer is likely to pay a reasonable degree of attention to the selection of items of clothing, footwear or headgear.

Comparison of trade marks

17) To my mind the opponent’s strongest case is under its CTM 4049334 POLO. I will therefore compare this mark to those applied for which are GBR POLO (264161) and POLO JOHNBULL (2641963).

Distinctive and dominant components

18) Clearly, the opponent’s mark is a well known English word with an accepted meaning as a sport and a type of shirt. The opponent’s mark is distinctive for the, broadly speaking, clothing, footwear and headgear goods for which it is registered, particularly given the exclusion in the specification. The applicant’s mark GBR POLO has two independent elements. The letters GBR are commonly used as shorthand for Great Britain, often in a sporting context, and would be recognised as such by the average consumer. The word POLO is, as already stated, a well known English word.

19) Similarly, the applicant's other mark POLO JOHNBULL consists of two elements. The first has already been commented upon. The second is the well known name of a cartoon character who was the personification of the average England yeoman. The character is well known for the attributes of being honest, hard headed, fond of food and drink, horses and country pursuits and prepared to fight, particularly the French, to defend his country. Usually depicted as being slightly corpulent, and wearing a Union Flag waistcoat, frock coat, a short top hat and riding boots. This is also an independent and distinctive element of the mark. I will approach the comparison of the trade marks with these conclusions in mind.

Visual similarity

20) The applicant's marks each have an element which is completely different to the opponent's mark. The opponent's mark appears in full as the second element in the applicant's first mark and the first element in the applicant's second mark. There is therefore a moderate degree of visual similarity.

Aural similarity

21) Again the applicant's marks each contain an element which is different to the opponent's mark whilst also having the opponent's mark in its entirety as a separate element. There is therefore a moderate degree of aural similarity.

Conceptual similarity

22) As mentioned previously the opponent's mark is the name of a well known, albeit exclusive, sport. To my mind, the average consumer will view the applicant's mark GBR POLO, alludes to the Great Britain polo team, even though I do not believe that is actually is such an entity. Similarly the applicant's mark POLO JOHNBULL again emphasises the English/British nature of the sport. Clearly the overwhelming impression is in relation to the sport of polo.

Comparison of goods

23) Clearly, the opponent's specification encompasses the applicant's specification. **The goods must therefore be regarded as identical.**

Likelihood of confusion

24) I must now take all the above into account and consider the matter globally taking into account the interdependency principle- a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and services and vice versa. Clearly the goods are identical, and the opponent's mark is encapsulated within both of the applicant's marks. The opponent's mark retains its distinctive character within the applicant's marks despite the presence of other elements. This means that there is a likelihood of consumers being confused into believing that the

goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(2)(b) therefore succeeds.**

25) In view of the above I do not need to consider the other grounds of opposition.

CONCLUSION

26) **The opponent has succeeded in respect of both of the applicant's marks.**

COSTS

27) As the opponent has been successful it is entitled to a contribution towards its costs. As the cases were consolidated only one set of evidence was filed, much of which was irrelevant, and one set of submissions. The costs have been reduced accordingly.

Preparing statements and considering the other side's statements	£300
Expenses	£400
Preparing evidence	£100
Preparing submissions	£200
TOTAL	£1000

28) I order GBR Polo Limited Inc. to pay The Polo/Lauren Company L.P. the sum of £1000. 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 6th day of May 2014

**George W Salthouse
For the Registrar,
the Comptroller-General**