

In The Matter Of A Trade Mark Application No. T97/10618J by Boby Footwear Pte Ltd

And

**Opposition Thereto By
The Polo/Lauren Company, L.P.**

*Before Principal Assistant Registrar Elizabeth V. Cardoza
21 June 2005*

Trade Marks – Opposition to registration – Distinctiveness - Whether the application mark satisfies the requirements of distinctiveness under Section 10 of the Trade Marks Act (Cap. 332, 1992 Rev. Ed.)

Trade Marks – Opposition to registration – Proprietorship of the mark – whether the Applicant had a bona fide claim to proprietorship of the application mark under Section 12(1) of the Trade Marks Act (Cap. 332, 1992 Rev. Ed.)

Trade Marks – Opposition to registration – Whether registration of the application mark would cause deception or confusion - Section 15 of the Trade Marks Act (Cap. 332, 1992 Rev. Ed.)

Trade Marks – Opposition to registration - whether the Application mark is confusingly similar to an earlier registered trade mark – Section 23 of the Trade Marks Act (Cap. 332, 1992 Rev. Ed.)

The Applicant BOBY FOOTWEAR PTE LTD, a Singapore company, filed an application on 29 August 1997 to register their trademark comprising: “L & A POLO” and “person on horse” device in respect of “articles of clothing, shoes and ties, all included in Class 25”. The Opponent, THE POLO/LAUREN COMPANY, L.P., an American company, is the registered proprietor of 40 trade marks in Singapore comprising the word “POLO”, and the device of a polo player, (used separately, or together, or with other marks) in respect of a wide range of goods in the fashion industry. In class 25 the Opponents had 13 registrations for marks comprising the words Polo and/or the device of a polo player. The Opponents started doing business in Singapore in 1987 and their sales turnover from 1987 to 1997 ranged from about S\$ 2.2 million to S\$2.75m, and thereafter was about S\$20 million each year. Their advertising and promotional expenditure was about S\$ 200,000 from 1987 to 1997 and thereafter about S\$150,000 each year.

The relevant portions of the Trade Marks Act relied upon by the Opponents’ are sections 10, 12, 15 and 23. The Opponents contended that the opposed mark “L & A POLO with the device of a polo player” is visually and/or phonetically identical to, and/or substantially similar to or so resembles their “family of POLO marks”, of which the essential features are the word “POLO” and/ or the “polo player” device, that it will likely deceive or cause confusion to the public. The Applicant’s goods under the trade mark application are “articles of clothing, shoes and ties”, which fall within the general description of “fashion wear” and are similar or identical to the description of the wide range of articles of fashion and accessories that the Opponents’ deal in, including but not limited to goods in Class 25.

The Opponent further contended that it was the first to use the word mark POLO as well as the polo player device in Singapore in relation to fashion goods including goods under Class 25. As such, the Applicant could not validly claim to be the bona fide proprietors of the trade mark applied for, and are attempting to take advantage of the Opponent’s established goodwill and reputation in the marks. They also argued that the Applicants mark was not distinctive under section 10 in view of the reputation that the Opponents had in their marks.

The Applicant argued that it had commenced use of its mark in 1997, and their mark is distinguishable from Opponents’ in two respects, first, that letters “L&A” are a significant component, and that their device of the horse-rider/ polo player device has no visible “clubs” or any “upswing posture”. They also argued that only one of the Opponents marks, with the device of a polo player and the words Polo Ralph Lauren are relevant to this opposition.

Held, disallowing registration

1. The Opponents’ evidence shows that they have used their family of POLO Marks mark in Singapore as early as 1987. The use is substantial and their family of POLO marks are known to a substantial number

of persons worldwide, and within Singapore. The application made by the Applicant to register a mark incorporating that same element/ same main features, will lead the public to assume that the mark is an addition to the Opponents' "family of marks" and the public will be confused or deceived if that is not the case. The opposition under section 15 succeeds.

2. The opposition under section 23 succeeds as all three elements are satisfied. Firstly, the marks in issue belong to different proprietors and the Opponent's POLO Marks are already on the register. Secondly, the Opponent's and the Applicant's marks are identical or so nearly resemble each other; and finally, the Opponent's and the Applicant's marks are in respect of goods that are either the same goods, or goods of the same description. There is also a greater likelihood of confusion or deception as the goods of the parties overlap and it is not in dispute that they are goods of the same description.
3. The opposition under section 10 failed as the Applicant's mark had been found to be acceptable for registration and Registrar did not interfere with that decision. The opposition under section 12 failed as there was insufficient evidence from which the Registrar could find that the Application was made in bad faith.

Provisions of legislation discussed:

- Trade Marks Act (Cap. 332, 1992 Rev. Ed.) sections 10, 12, 15 and 23.

Case referred to:

- Bali Trade Mark (1969) RPC 472
- De Cordova v Vick (1951) 68 RPC 103
- In The Matter of An Application By Beck, Koller & Company (England) Limited [1947] RPC 76
- Kellogg Co. v Pacific Food Products Sdn Bhd (1999) 2 SLR 651
- Corporate Licensing Pty Ltd v RAFFLES HOTEL (1886) LIMITED, [2002] SGIPOS
- Pianotist Co's Application (1906) 23 RPC 774
- Smith Hayden & Co's Application (1945) 63 RPC 97
- The Polo/Lauren Company L.P. v United States Polo Association [2002] 1 SLR 326
- Jellinek's Application [1946] 63 RPC 59

Representation:

- Mr Sukumar Karuppiah (M/s Ravindran Associates) for the Opponent.
- Mr Han Wah Teng (M/s Rodyk & Davidson) for the Applicant.