

**IN THE HEARINGS AND MEDIATION GROUP OF
THE INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
REPUBLIC OF SINGAPORE**

Trade Mark No. T1215440A
6 March 2015

**IN THE MATTER OF A TRADE MARK APPLICATION BY
UNITED STATES POLO ASSOCIATION
AND
OPPOSITION THERETO BY
THE POLO/LAUREN COMPANY, L.P.**

Hearing Officer: Ng-Loy Wee Loon (Prof)
IP Adjudicator

Mr Prithipal Singh and Mr Prensai Chandrasekaran (Patrick Miranda Co (S) Pte Ltd) for
the Applicants

Mr Sukumar Karuppiah and Ms Joyce Khoo (Ravindran Associates) for the Opponents

Cur Adv Vult

GROUND OF DECISION

Introduction

1 This is an opposition to the registration of the trade mark under Trade Mark No. T1215440A (“the Application Mark”) filed by the United States Polo Association (“the Applicants”) on 17 October 2012. The application was accepted and published in the Trade Marks Journal on 30 November 2012.

2 The opponent is Polo/Lauren Company, L.P. (“the Opponents”). They filed their Notice of Opposition on 29 January 2013. The Applicants filed their Counter-Statement on 27 March 2013.

3 Both parties filed evidence to support their respective case. The Opponents filed two statutory declarations made by Ms Anna Dalla Val, one on 25 October 2013 (“the Opponents’ 1st SD”) and the other dated 13 June 2014 (“the Opponents’ 2nd SD”). Ms Anna Dalla Val is Senior Director, International Trademarks and Enforcement of Ralph Lauren Corporation and also Vice President and Secretary of PRL International, Inc. (PRL International, Inc. being the General Partner of the Opponents). The Applicants filed one statutory declaration dated 25 February 2014 made by Mr David Cummings (“the Applicants’ SD”), the President and Chief Executive Officer of USPA Properties, Inc., which is a wholly owned subsidiary of the Applicants.

4 The Pre-Hearing Review was held on 13 August 2014. The parties then filed written submissions (“the Opponents’ Written Submissions” and the “Applicants’ Written Submissions” as the case may be) on 13 February 2015, after which the opposition was heard on 6 March 2015. At the hearing, the Opponents submitted written skeletal rebuttals to the Applicants’ Written Submissions.

Grounds of Opposition

5 The Opponents rely on Sections 7(6) and 8(2)(b) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”) in this opposition.

6 For completeness, the Notice of Opposition also stipulated Sections 7(1)(a), 7(5) and 8(7)(a), but the Opponents did not proceed with these other grounds.

Background

7 The Applicants have been the governing body of the sport of polo in the United States since 1890. Apart from promoting this sport through activities such as umpire training, the Applicants have also ventured into the consumer product market selling clothing, watches, bags etc. The Applicants’ goods are sold under various trade marks, including the word marks “U.S. POLO ASSOCIATION”, “USPA” and a device depicting a polo player(s) on horseback.

8 The Applicants’ trade mark in T1215440A, the subject-matter of this opposition, comprises the word “USPA” and a device depicting two polo players on horseback. The pertinent details of T1215440A are shown below:

T1215440A	
	<p>Class 9</p> <p>Specification of goods: “Eyewear; ophthalmic eyewear frames; reading glasses; sunglasses; eyeglass cases and covers; sun visors (eyewear)”</p>
Application date: 17 October 2012	

9 The Opponents are the registered proprietors of a family of trade marks including a device of a polo player on a horse in action on its own or with words such as “RALPH LAUREN” and “POLO RALPH LAUREN”. They have registered their trade marks in many countries in various classes including Class 9 (eyewear), Class 14 (watches), Class 18 (leather goods) and Class 25 (clothing and footwear).

10 In Singapore, one of the Opponents’ registered trade marks is T9604857H. The pertinent details of this registration are set out below:

T9604857H	
	Class 9 Specification of goods: “Spectacles, spectacle frames, lenses, sunglasses and parts and fittings therefor.”
Application date: 14 May 1996	

11 The Opponents rely on this earlier registration T9604857H in their opposition under Section 8(2)(b).

12 This is not the first time that the Opponents and the Applicants have crossed swords in opposition proceedings in Singapore. Back in the early 2000s, the Opponents unsuccessfully opposed the registration of another one of the Applicants’ trade marks under the repealed Trade Marks Act 1992 (“the Old Act”). Both parties have made submissions about the relevance or irrelevance of this earlier set of opposition proceedings for the purposes of the present opposition under Section 8(2)(b) of the Act. More will be said about these submissions in due course.

13 Both parties, either directly or indirectly, have also been involved in trade mark litigation outside of Singapore. Their litigation in the U.S. resulted in a settlement agreement between the Applicants and a related company of the Opponents in 2003. This settlement agreement forms the central plank of the Opponents’ opposition under Section 7(6) in the present case. The Opponents’ case is that the Applicants’ application to register the Application Mark in Class 9 was made in bad faith because this application is prohibited by this settlement agreement. The Applicants dispute that the settlement agreement has such an effect.

Burden of Proof

14 The Opponents do not dispute that they bear the burden of proof in these proceedings.

15 Indeed there is clear authority for the proposition that the legal burden of proof in opposition proceedings is borne by the opponent. In *Valentino Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203 (“*Valentino*”), a case concerning trade mark opposition proceedings, the Court of Appeal held as follows (at [21]):

It is in line with common sense and logic that he who asserts must prove although, depending on the evidence tendered, the evidential burden could shift to the other side. *The legal burden of proof required to substantiate a ground to oppose the registration of a trade mark remains throughout on the party making the application, and this would be the [opponent] in the present case.*

[Emphasis added]

MAIN DECISION

Ground of Opposition under Section 7(6)

16 Section 7(6) of the Act reads:

A trade mark shall not be registered if or to the extent that the application is made in bad faith.

The Law: General Principles

17 The leading case in this area is the Court of Appeal's decision in *Valentino*. Here is a summary of the general principles laid down in *Valentino* which are particularly pertinent to this case:

- (a) Bad faith includes dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area of trade being examined: *Valentino* at [25].
- (b) The test for bad faith contains both a subjective element (*viz.*, what the trade mark applicant knew) and an objective element (*viz.*, what ordinary persons adopting proper standards would think): *Valentino* at [29].
- (c) If a registrant of a trade mark has proprietorship of that trade mark, or at the very least, the right to register that trade mark, then such registration of the trade mark should fall well within the standards of acceptable commercial behaviour observed by reasonable and experienced persons in the particular trade. Conversely, where it can be shown that the applicant knew of an exclusive proprietary right of another in relation to the trade mark it seeks to furtively register, then any such registration would, almost invariably, quite clearly fall short of the relevant standards: *Valentino* at [38].
- (d) An allegation of bad faith is a serious claim to make, and it must be distinctly proved and this will rarely be possible by a process of inference: *Valentino* at [30].

The Opponents' Submissions

18 The Opponents' case on bad faith rests on one contention, that is, the Applicants filed the application to register the Application Mark in Class 9 knowing that this was a breach of their obligations undertaken in a settlement agreement dated 5 September 2003 ("the 2003 Settlement Agreement") made between the Applicants and PRL USA Holdings Inc ("PRL"), a related company of the Opponents.

19 PRL had sued the Applicants in the U.S. for trade mark infringement, and the 2003 Settlement Agreement ensued from this litigation. According to the Opponents, the 2003 Settlement Agreement regulates the Applicants' use of their various trade marks, including the Application Mark, but confines such use to goods in Class 14 (watches only), Class 18, Class 25 and Class 28 *only*. To put it another way, the Opponents' case is that the Settlement Agreement prohibits the Applicants from using the Application Mark on other goods, in particular Class 9 goods.

20 The Opponents could not and did not produce the 2003 Settlement Agreement in evidence because of confidentiality clauses therein. Instead, the Opponents adduced evidence which is in the public domain. This took the form of the decision of the United States District Judge Robert W Sweet dated 6 March 2013 in *United States Polo Association Inc v PRL USA Holdings Inc* ("the 2013 U.S. Judgment").¹ Sweet J was hearing PRL's motion to hold the Applicants in contempt for violating an injunction granted in an earlier case. In his judgment, Sweet J provided some background to the earlier litigation between the parties in the U.S., and it was in this context that references were made to the 2003 Settlement Agreement.

21 The Opponents highlighted a specific part of Sweet J's judgment where he said:

The 2003 Settlement Agreement set forth terms for [the Applicants] to use its name and certain other logos, designs and packaging on apparel, leather goods and watches.

22 The goods referred to in this passage – apparel, leather goods and watches – are found in Class 25, Class 18 and Class 14 respectively. Therefore, the Opponents argued, this part of Justice Sweet's judgment corroborates their case that the 2003 Settlement Agreement does not permit use of the Applicants' trade marks on Class 9 goods (eyewear).

23 The Opponents also pointed out that the Applicants' SD did not dispute the Opponents' assertions about the terms in the 2003 Settlement Agreement. The Opponents cited *Ng Hee Thoong v Public Bank Bhd* [1995] 1 MLJ 281 ("*Ng Hee Thoong*"), where the Court of Appeal of Malaysia stated that in evaluating affidavit evidence, where the defendant makes a positive assertion upon a material issue in his affidavit, the failure of the plaintiff to contradict it would usually be treated as an admission by him of the fact so asserted. This Malaysian case has been applied by the Singapore District Court in *Pacific Timber Ltd v Koh Teong Pheng* [2004] SGDC 26 ("*Pacific Timber*") at [7]. Relying on these cases, the Opponents submitted that the Applicants' failure to contradict the Opponents' assertions should be treated as an admission that the 2003 Settlement Agreement prohibits the Applicants from using the Application Mark on eyewear in Class 9.

24 The Opponents' case may be summarised as follows. The facts in this case satisfy the two components – the subjective component and the objective component – in the test for bad faith: see [17(b)] above. With regard to the subjective component, the Applicants being a party to the 2003 Settlement Agreement knew that the use of the Application Mark on eyewear in Class 9 is a breach of the term of this agreement. With regard to the

objective component, any ordinary person would find the Applicants' conduct in applying to register their Application Mark in Class 9 knowing that this was a breach of contract, unacceptable. This is akin to the scenario where a trade mark applicant registers a trade mark knowing that someone else has an exclusive proprietary right in the trade mark. Such conduct quite clearly falls short of the standards of acceptable commercial behaviour as observed by the reasonable man: see [17(c)] above.

The Applicants' Submissions

25 The Applicants do not dispute the existence of the Settlement Agreement. However, they strongly object to the Opponents' interpretation of the terms and conditions in this agreement.

26 Like the Opponents, the Applicants could not and did not produce the 2003 Settlement Agreement in evidence. In fact, the Applicants' SD made no reference to the 2003 Settlement Agreement.

27 However, the Applicants registered their objections to the Opponents' assertions about the 2003 Settlement Agreement in their written submissions. These objections are set out, in particular, in paragraph [4.05.03] of the Applicants' Written Submissions ("AWS Paragraph [04.05.03]"). This paragraph is set out below:

The SA [ie. the 2003 Settlement Agreement] purports to govern *inter alia* the use by the Applicant of its trade marks, in relation to products which fall within the ambit of Class 14 (solely watches), Class 18, Class 25 and Class 28 (solely limited to products that pertain to the sport of polo) only.

The SA **does not** govern the registration and use (by the Applicant) of the Applicant's trade marks in relation to goods which fall within the ambit of Class 09 [including but not limited to eyewear; ophthalmic eyewear frames; reading glasses; sunglasses; eyeglass cases and covers; sun visors (eyewear)].

Further, the SA expressly stipulates that the Applicant and the Opponent do not waive any rights that the parties have with respect to products or product classes not covered by the SA.

28 I have set out AWS Paragraph [4.05.03] in full because, at the hearing, the Opponents objected to this paragraph and requested that I expunge this paragraph from the Applicants' Written Submissions or disregard it. I shall deal with the Opponents' request in my decision below.

29 The Applicants also pointed out that they have registered trade marks in various countries for goods outside of these classes, such as the following two registrations in Singapore and Hong Kong:

Jurisdiction	Mark	Class
Singapore T9901099G (Filed on 8 February 1999)		Class 3 (perfumes)
Hong Kong 301566937 (Filed on 19 March 2010)		Class 9 (eyewear) Class 16 (paper products) Class 24 (household textiles) Class 34 (smokers' articles)

30 The Applicants submitted that these registrations support their case that the 2003 Settlement Agreement has no application to goods outside of Classes 14, 18 and 25. The Opponents' replies to this submission are the following. In relation to pre-2003 registrations such as the one in Singapore in Class 3 (T9901099G), these are registrations obtained before the conclusion of the 2003 Settlement Agreement, and therefore fell outside of the ambit of the agreement. In relation to post-2003 registrations such as the one in Hong Kong in Classes 9, 16, 24 and 34, the Opponents reserved their right to take action as they deemed fit.

31 The Applicants' case may be summarised as follows. The Opponents bear the burden of proving their allegation of bad faith: see [15] above. This burden of proof can rarely be discharged by a process of inferences: see [17(d)] above. But this is in effect what the Opponents are doing. They are attempting to discharge their burden of proof without putting in evidence the 2003 Settlement Agreement, and instead asking the Registrar to draw inferences about the scope of the 2003 Settlement Agreement and to make a finding of bad faith based on these inferences.

Preliminary Issue

32 I shall first deal with a preliminary issue raised by the Opponents during the hearing. The Opponents requested that AWS Paragraph [4.05.03] be expunged from the Applicants' Written Submissions or be completely disregarded. AWS Paragraph [4.05.03] has been set out in full at [27] above.

33 The Opponents submitted that the contents of AWS Paragraph [4.05.03] constitute new evidence and, in introducing this new evidence in their written submissions, the Applicants had deprived the Opponents of responding to this new evidence in their statutory declaration in reply. The Opponents argued that they have been prejudiced by this lost opportunity. As authority, the Opponents relied on the case *MCI Group Holdings SA v Secondment Pty Ltd* [2014] SGIPOS 15, where the Registrar refused to

allow one party in the proceedings to adduce two additional statutory declarations on the day of the hearing itself.

34 In my view, *if* the contents in AWS Paragraph [4.05.03] constitute new evidence, there would be a more fundamental problem with this paragraph: it is set out in the Applicants' Written Submissions, as opposed to a statutory declaration. Tendering any evidence via written submissions is against the general rule set out in Rule 69 of the Trade Marks Rules (Cap 332, 2008 Rev Ed) ("the Rules"). Rule 69 provides as follows:

69.—(1) In any proceedings before the Registrar under the Act or these Rules, evidence shall be given by way of a statutory declaration, unless otherwise provided by the Act or these Rules or directed by the Registrar.

35 I have looked carefully at the contents of AWS Paragraph [04.05.03]. There are in essence three statements therein, namely:

- (a) The 2003 Settlement Agreement applies to goods in Classes 14, 18 and 25 only.
- (b) The 2003 Settlement Agreement does not apply to goods in Class 9.
- (c) The 2003 Settlement Agreement expressly stipulates that the parties do not waive their rights with respect to goods not covered by the agreement.

36 I find that the first two statements are in effect the Applicants' rebuttal or challenge to the Opponents' interpretation of the scope of the 2003 Settlement Agreement. The Applicants were offering their alternative interpretation of the agreement in these two statements. There is no new fact asserted in these two statements.

37 However, the third statement is a different matter: it refers to a contractual term that purportedly exists in the 2003 Settlement Agreement. This is an assertion of a new fact. The alleged existence of this contractual term is of paramount importance to the issue at hand, and hence it must be tendered via a statutory declaration made under oath.

38 Therefore, I shall completely disregard the following statement in AWS Paragraph [04.05.03] in my decision:

Further, the SA expressly stipulates that the Applicant and the Opponent do not waive any rights that the parties have with respect to products or product classes not covered by the SA.

My Findings

39 At the heart of the Opponents' case of bad faith is that the 2003 Settlement Agreement prohibits the Applicants from using their trade marks, including the Application Mark, on goods in Class 9. Therefore, to succeed in making out their case on bad faith, the Opponents must prove that this is indeed the proper scope of the 2003 Settlement Agreement.

40 The Opponents' primary evidence is the 2013 U.S. Judgment by Sweet J. As mentioned earlier, Sweet J was hearing PRL's motion to hold the Applicants in contempt for violating an injunction granted in an earlier case. The Applicants denied that they had violated this injunction. To determine if the activities of the Applicants complained of fell

within the terms of the injunction, Sweet J provided an account of the earlier litigation between the parties in the U.S. For our purposes, the important points to note in his account are the following:

- (a) In 2000, PRL brought an action against the Applicants, seeking to bar the use of the Applicants' name, the Double Horsemen Mark and other logos on apparel and related products ("the Apparel Litigation").
- (b) On 5th September 2003, PRL and the Applicants entered into the 2003 Settlement Agreement that "partially settled" the claims made by PRL against the Applicants in the Apparel Litigation.²
- (c) The 2003 Settlement Agreement set out the terms for the Applicants "to use its name and certain other logos, designs and packaging on apparel, leather goods and watches".³ This is the part of Sweet J's judgment that the Opponents relied on in their submissions: see [21] above.
- (d) However, the parties "failed to resolve whether the [Applicants] had a right to use four variants of the Applicants' Double Horsemen Mark. Instead, the parties agreed to resolve that issue though a trial before the Honourable George B. Daniels, and to have the results of the trial incorporated into the 2003 Settlement Agreement."⁴
- (e) In October 2005, at the trial before the Honourable George B. Daniels, the jury concluded that three of the four variants of the Applicants' Double Horsemen Mark did not infringe PRL's single horseman marks when used on apparel, leather goods and watches. Specifically, "the jury found (i) [the Applicants'] solid double horseman mark infringed PRL's Polo Player Symbol trademarks; and (2) [the Applicants'] solid double horseman mark with 'USPA', outline double horseman mark, and outline double horseman mark with 'USPA' did not infringe PRL's Polo Player Symbol trademarks."⁵
- (f) The findings of the 2005 jury trial were upheld by the U.S. Court of Appeals for the 2nd Circuit. The appellate court's decision is reported as *PRL USA Holdings Inc v U.S. Polo Ass'n Inc* 520 F 3d 109 (2nd Cir, 2008).

41 In my view, Sweet J's account raises questions about the Opponents' interpretation of the scope of the 2003 Settlement Agreement.

42 First, in the Opponents' interpretation, the 2003 Settlement Agreement prohibits the Applicants from using their trade marks *including the Application Mark* on certain goods. However, in Sweet J's record, this agreement only "partially settled" the claims between PRL and the Applicants in the Apparel Litigation, leaving the unresolved claims relating to the Applicants' right to use four variants of the Double Horsemen Mark to be decided by a jury trial. Even more significantly, the jury found that three of these variants were non-infringing marks when used on apparel, leather goods and watches, a finding which was upheld on appeal. Of these three variants, the *solid double horseman mark with "USPA"* is particularly pertinent to our case because the Application Mark comprises a double horseman device and the word "USPA". Since the parties agreed to abide by the outcome of the jury trial and to incorporate the outcome of the jury trial into the 2003

Settlement Agreement, and since the *solid double horseman mark with “USPA”* was found to be non-infringing, it stands to reason that the *solid double horseman mark with ‘USPA’* was not incorporated into the 2003 Settlement Agreement. Thus, is it not possible that the Application Mark was left out of the 2003 Settlement Agreement?

43 Second, in the Opponent’s interpretation, the 2003 Settlement Agreement prohibits the Applicants from using their trade marks on *goods other than apparel, leather goods and watches*. In this regard, they relied on Sweet J’s statement that the 2003 Settlement Agreement “set forth terms and conditions for [the Applicants] to use its name and certain other logos, designs and packaging on apparel, leather goods and watches”. In essence, their reasoning amounts to this: the 2003 Settlement Agreement governs use of the Applicants’ trade marks on apparel, leather goods and watches, and *therefore* this agreement prohibits use of the Applicants’ trade marks on other goods in particular eyewear in Class 9. However, there is nothing in this statement to allow me to make the conclusion that *therefore* the 2003 Settlement Agreement prohibits the Applicants from using their trade marks on goods other than apparel, leather goods and watches. Is it not possible (as contended by the Applicants) that the agreement covers apparel, leather goods and watches only, and therefore has no application outside of these goods?

44 I appreciate that the Opponents are not able to produce the 2003 Settlement Agreement because they are bound by the confidentiality clauses therein, and that they have little choice but to resort to the 2013 U.S. Judgment to provide information about the 2003 Settlement Agreement. However, I have found that the information disclosed in Sweet J’s judgment raises more questions than it answers about the proper scope of the 2003 Settlement Agreement.

45 The Opponents’ entire case of bad faith is based on inferences. The law in this regard is very clear. An allegation of bad faith is a serious claim to make, and it must be distinctly proved and this will rarely be possible by a process of inference: see [17(d)] above. I pause to add that there is no absolute prohibition against drawing inferences. The thrust of this legal principle is that the tribunal must be cautious about making findings of bad faith based on inferences. This point was made by Tay Yong Kwang J in *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 (“*Festina*”) at [114]:

The concept of bad faith is extremely wide in the sense that *the courts can infer instances of bad faith* and decide according to the justice of individual cases. Naturally, *the court should also be cautious in not over-extending this concept* lest it becomes a weapon of terror against competitors of trade mark proprietors.

[Emphasis added]

46 Tay J in *Festina* also said at [98] that a party alleging bad faith must meet “a high threshold”. I find that the Opponents have not met the “high threshold” that has been set for bad faith claims.

47 It is also because of the “high threshold” set for bad faith claims that I decline to treat the omission of any mention of the 2003 Settlement Agreement in the Applicants’ SD as an admission by the Applicants of the Opponents’ assertions about the scope of the 2003 Settlement Agreement. The Malaysian case *Ng Hee Thoong* and the Singapore case *Pacific Timber* cited by the Opponents concerned applications for summary judgment. In

both cases, the defendants had filed an affidavit to oppose the grant of summary judgment in which the defendants made certain assertions as to why they were not liable for the claims. These assertions were not contradicted by the plaintiff in affidavits in reply. The court used the principle “what a party does not contradict is usually treated as an admission by the party of the fact so asserted” as the basis for granting unconditional leave to defend the action. The court did not apply this principle to conclusively determine the liability of the parties vis-à-vis each other. Therefore, this principle has very limited application. In my view, it would be inappropriate to apply this principle in bad faith claims where the law has set a “high threshold” to be met by the party alleging bad faith.

48 The ground of opposition under Section 7(6) therefore fails.

Ground of Opposition under Section 8(2)(b)

49 Section 8(2)(b) of the Act reads:

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.

50 The term “earlier trade mark” is defined in Section 2(1) to mean:

- (a) a registered trade mark or international trade mark (Singapore), the application date of which was made earlier than the trade mark in question, taking into account (where appropriate) of the priorities claimed in respect of the trade marks;
- (b) a trade mark which, at the date of the application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was a well known trade mark, and includes a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (a) subject to its being so registered.

51 The Opponents relied on only one of their registered trade marks in this opposition. This is the registered trade mark T9604857H. The application date of T9604857H is 14 May 1996, which is earlier than the application date of the Application Mark (12 October 2012). Undoubtedly, T9604857H qualifies as an “earlier trade mark” for the purposes of Section 8(2)(b).

52 The leading case on Section 8(2)(b) is the Court of Appeal’s decision in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 (“*Staywell*”). The appellate court reaffirmed the step-by-step approach in the analysis of this provision. Under this approach, there are three elements, *viz.* similarity between the marks, identity or similarity between the goods or services, and confusion brought about by these two similarities. All three elements must be satisfied.

The Marks-Similarity Inquiry

(A) The Law: General Principles

53 Here is a summary of the general principles governing this inquiry, laid down in *Staywell*, that are particularly pertinent to this case:

- (a) The marks are to be compared for visual, aural and conceptual similarities. But these three aspects of similarity are only signposts towards answering the question of whether the marks are similar, and must not be applied in a formulaic manner. There is no prescribed requirement that all three aspects of similarity must be made out before the marks can be found to be similar: *Staywell* at [18].
- (b) Ultimately, the question is whether the marks when observed in their totality are similar rather than dissimilar. Answering this question is inevitably a matter of impression: *Staywell* at [17].
- (c) Although the marks are to be compared in their totality, the tribunal is entitled to have special regard to the dominant components in a mark. This is because in reality the average consumer rarely has the chance to compare the two marks side by side; instead, he is making the comparison based on an imperfect recollection of the two marks in his mind. In this comparison, it would be the dominant component – what is outstanding and memorable about the mark – that tends to stand out and draw his attention: *Staywell* at [23].

(B) My Findings

54 For convenience, the two marks to be compared are set out in this table:

The Opponents' Earlier Mark	The Application Mark
	

55 I should stress that setting out the two marks in this table is only a matter of convenience. I am very mindful that I must guard against a side-by-side microscopic analysis of the two marks, unpacking the similarities or differences in their details. This would contravene the doctrine of imperfect recollection which mandates that the comparison must be from the perspective of the average consumer who only has an imperfect recollection of the marks in his mind: see [53(c)] above.

56 Also for convenience, I shall refer to the Opponents' earlier mark as the "Single Polo Player Mark". As for the Application Mark, it is a composite mark with two

components: the device and the text “USPA”. I shall refer to the device in this composite mark as the “Double Horsemen Device”.

(i) Visual comparison

57 This aspect is the most contentious between the parties. The Opponents’ case is that the Double Horsemen Device is the dominant component in the Application Mark. They argued that, when the Double Horsemen Device is compared against the Single Polo Player Mark, the similarity is clear. The Applicants’ case is that the text “USPA” is the dominant component in the Application Mark. They argued that when this text is compared against the Single Polo Player Mark, the dissimilarity is clear.

58 Much of the disagreement in this marks-similarity inquiry lies in the identification of the dominant component in the Application Mark. To the Opponents, the dominant component is the Double Horsemen Device. To the Applicants, it is the text “USPA”.

59 I will begin the analysis by reiterating that the so-called “words speak louder” principle is no longer the law in Singapore. This principle, when applied in the visual assessment of a composite mark comprising a textual component and a device, invariably resulted in the textual component being identified as the dominant component in the mark. This principle was debunked by the Court of Appeal in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 (“*Hai Tong*”). The Court of Appeal then made this ruling (at [62(d)]):

The textual component of a composite mark or sign *could* (but will not necessarily or always) be the dominant component of the mark or sign.

60 In other words, there is no presumption in favour of any component in this inquiry. Instead, the inquiry is to be guided by looking at various factors. I set out hereunder the factors which are pertinent to this case:

- (a) The technical distinctiveness of the component: *Staywell* at [28]. “Technical distinctiveness” refers to the capacity of a mark to function as a badge of origin. This capacity can be inherent (“inherent distinctiveness”) where, for example, the mark is meaningless in the context of the goods or services of the application. This capacity can also be acquired (“acquired distinctiveness”) as a result of long and extensive usage of the mark by its proprietor: *Staywell* at [24]. If there is a component in the composite mark which has inherent technical distinctiveness and/or acquired technical distinctiveness, that component may be the dominant component.
- (b) The size of the component: *Hai Tong* at [62(d)(ii)] and [62(e)(i)]. If there is a component which is bigger in size relative to the other component(s) in the composite mark, the bigger component may be the dominant component.
- (c) The position of the component within the composite mark: *Hai Tong* at [62(d)(ii)]. This factor was applied for example in *Jamal Abdunaser Mahmoud Al Mahmid v Global Tobacco Manufacturers (International) Sdn Bhd* [2015] SGHC 42 (“*Jamal Abdunaser Mahmoud Al Mahmid*”) where the composite mark

comprised a device and a word. The High Court found that the word component was the dominant component because it was “centralised in the visual field...[and as such] it was the word to which the eye was drawn” (at [27]).

61 None of these factors are in themselves conclusive of whether a particular component is the dominant component in the composite mark. These factors are merely guidelines because ultimately, the issue of similarity of marks is a matter of impression: see [53(b)] above.

62 It is also possible to find that there is no dominant component in the composite mark. If an authority is needed for this proposition, it can be found *Saville Perfumery Ld v June Perfect Ld and W Woolworth & Co Ld* (1941) 58 RPC 147 (“*June Perfect*”). The court there was concerned with the section in the UK Trade Marks Act 1938 which made it an infringement for a defendant to use a mark “so nearly resembling [the registered trademark] as to be likely to deceive or cause confusion”. In the context of comparing the marks to determine if there was resemblance, Sir Wilfred Greene MR said (at pp 161–162):

[T]he class of customer among the public which buys the goods does not interest itself in such detail [of the mark]. In such cases, the mark comes to be remembered by some feature in it which strikes the eye and fixes itself in the recollection. Such a feature is referred to sometimes as the distinguishing feature, sometimes as the essential feature, of the mark. ... Now the question of resemblance and the likelihood of deception are to be considered by reference not only to the whole mark, but also to its distinguishing feature or essential features, *if any*.

[Emphasis added]

63 Although *June Perfect* is a case decided under the old trade mark legislation, this passage of the Master of Rolls’ judgment was cited with approval by the Court of Appeal in *Hai Tong* (at [40(d)].)

64 If the tribunal finds that there is no dominant component(s) in the mark, it simply means that, when the mark is assessed in its totality, no special emphasis or attention will be given to any of the components in the mark.

65 Before I proceed to apply these principles to the facts of this case, it is convenient at this juncture to deal with the issue of whether the outcomes in the earlier trade mark litigation between the parties is relevant or not. I have mentioned, as background information about the parties, that they had crossed swords in opposition proceedings in Singapore in the early 2000s. The Opponents had opposed the registration of another one of the Applicants’ trade marks in Class 18 and Class 25 under the Old Act. The two marks in those opposition proceedings are set out below:

The Opponents' earlier mark in the 2001/2002 opposition proceedings	The Applicants' mark in the 2001/2002 opposition proceedings
	

66 The Registrar found that no confusion was likely to arise by the use of these two marks in relation to goods in Class 18 and Class 25: *United States Polo Association v The Polo/Lauren Company, L.P.* [2001] SGIPOS 7. In arriving at this conclusion, it appears that the Registrar applied the “words speak louder” principle to find that the text “USPA” in the opposed mark was prominent and hence its presence was sufficient to allow the public to distinguish between the two marks. On appeal, Choo Han Teck J agreed that there was no likelihood of confusion: *Polo/Lauren Co LP v United States Polo Association* [2002] 1 SLR(R) 129 (“*Polo/Lauren (HC, 2002)*”).

67 The Opponents argued that the outcome of the 2001/2002 proceedings is not helpful in the marks-similarity inquiry in this opposition because the law has changed since *Hai Tong*: the principle that “words speaker louder” no longer applies today. I agree. There are two other reasons. First, the opposed mark in those proceedings is not the same as the Application Mark in this opposition. Second, the outcome in those proceedings was based on provisions in the Old Act which were worded differently from Section 8(2)(b) of the Act.

68 Other than the 2001/2002 opposition proceedings in Singapore, there are the trade mark lawsuits between the Applicants and PRL in the U.S. In the Opponents’ Written Submissions, they had relied on an earlier lawsuit (which Sweet J referred to in the 2013 U.S. Judgment) in which the court found that the Applicants’ mark was similar to PRL’s mark.⁶ At the hearing, when I asked for details of the marks involved, the counsel for the Opponents advised that the Opponents would not be pursuing this line of argument – rightly so, in my view. One reason is that, from what I can glean from that lawsuit (reported as *U.S. Polo Ass’n v PRL USA Holdings Inc* 800 F Supp 2d 515 (SDNY 2011)), the parties’ marks in that lawsuit are different versions of the marks that we are concerned with in this opposition.

69 I turn now to the substantive arguments of the parties in this case.

70 The Opponents identified the Double Horsemen Device as the dominant component in the Application Mark. They relied on the size factor and the technical distinctiveness factor:

- (a) The text of “USPA” in the Application Mark is “much smaller” in font size and hence it is the device that stands out.⁷
- (b) The Double Horsemen Device possesses inherent technical distinctiveness in that it is the one which the public perceives as a badge of origin, and not merely as a

decorative element. The Opponents pointed to the fact that the Applicants had obtained registration of the Double Horsemen Device on its own in Class 18 and in Class 25. The text “USPA”, on the other hand, has no meaning to the public in Singapore. This text may be an acronym for “U.S. Polo Association”, but there is no evidence that the public in Singapore is aware of this.

- (c) The Single Polo Player Mark possesses inherent technical distinctiveness, as well as a high degree of acquired technical distinctiveness. To prove the latter, the Opponents provided sales figures (1987–2013) and their advertising and promotion expenditure (1989–2009) in Singapore.

71 I am not persuaded by the Opponents’ arguments. Looking at the Application Mark as a whole, I do not agree that the text “USPA” is much smaller than the device. I find that the size of the text “USPA” compares well with the size of the Double Horsemen device. Therefore, the size factor is neutral in this case: it does not point to either the text or the device as the dominant component in the Application Mark. When considering the factor of size, it is often relevant to consider at the same time the relative position of the components within the composite mark. In this case, the position of the text “USPA” is not subordinate to the Double Horsemen Device: they lie side by side, equal to each other.

72 The factor of technical distinctiveness does not aid the Opponents either. Since it is the Opponents’ case that the text “USPA” is meaningless, this means that the text possesses inherent technical distinctiveness. Again, this factor puts this text on equal footing with the Double Horsemen Device.

73 As for the Opponents’ claim that the Single Polo Player Mark has a high degree of acquired technical distinctiveness, this has not been proved. The sales figures and advertising expenditure tendered by the Opponents are unhelpful. Of the many sample invoices tendered as evidence of their sales in Singapore in 1987–2013, not one of them featured the Single Polo Player Mark on its own; they featured either the Single Polo Player Mark with the words “POLO RALPH LAUREN” or just words such as “RALPH LAUREN”.⁸ Of the many sample advertisements tendered as evidence of their promotional activities in Singapore, the vast majority featured only the word marks such as “POLO” or “RALPH LAUREN” or “POLO RALPH LAUREN”.⁹ At the hearing, when I asked the counsel for the Opponents if he could point me to evidence of prior use of the Single Polo Player Mark on its own, he explained that it was difficult to gather such evidence because the Opponents are a fashion house which sells various products under their family of trade marks. I appreciate the difficulty faced by the Opponents, but this also means that I have difficulty making a finding that the Single Polo Player Mark has acquired technical distinctiveness.

74 The Applicants identified the text “USPA” as the dominant component in the Application Mark. They relied on the technical distinctiveness factor:

- (a) The text “USPA” has inherent technical distinctiveness. In the Applicants’ Written Submissions, they asserted that they have registered the text “USPA” on its own in Singapore. At the hearing, when I requested for details of such registrations,

counsel for the Applicants provided three registration numbers: T1313871Z (Class 9), T0510175F (Class 18) and T0421063B (Class 25).

- (b) The Double Horsemen Device is not particularly distinctive because devices depicting a polo player(s) are common in the eyewear and fashion sectors. In the Applicants' Written Submissions, they provided a non-exhaustive list of Singapore registrations for eyewear in Class 9, where the registered mark comprised or included a device depicting polo player(s) on horseback. Here are the relevant examples from the Applicants' list:

S/N	Registration details	Mark
1.	Registered proprietor: Yong Sangyo Co Ltd T9400364Z (Class 9) T9705448B (Class 14) T9201824J (Class 25)	
2.	Registered proprietor: Santa Barbara Polo & Racquet Club T9709297Z (Class 9) T9303353G (Class 14) T9303355C (Class 18) T9303354E (Class 25)	
3.	Registered proprietor: Royal County of Berkshire Polo Club Ltd T1114738Z (Classes 9, 18, 25)	

75 It should be noted that these Singapore registered trade marks were cited in the Applicants' Written Submissions or during the hearing. They were not tendered via a statutory declaration.

76 This issue of tendering of evidence otherwise than by way of a statutory declaration also arose in the bad faith claim. In the bad faith claim, I decided to completely disregard the Applicants' assertion of a fact which was not properly tendered under oath: see [32]–[38] above. Here, however, I am comfortable to take judicial notice of the Singapore registrations which were not tendered via the Applicants' SD. In this regard, I am guided by the principles provided by the leading authority on the law of evidence in Singapore, Professor Jeffrey Pinsler in his book *Evidence, Advocacy and the Litigation Process* (4th Edition) (Lexis Nexis: 2013) at [11.002]:

A fact may be so well established that the court may assume its existence without proof. In such circumstances, proof is unnecessary because the fact has an objective existence which constitutes proof beyond and unaffected by, the specific circumstances of the case. ... [The court] may exercise its own initiative in taking judicial notice of a fact after making the necessary enquiry into the circumstances. For example, judicial notice has been taken of the state of the economy (and, more specifically, the existence of a recession and economic recovery), currency appreciation and exchange rate over a period of time, Singapore's status as a free port and busy trading centre for more than a century, the trading activities of oil companies and a state of competition, customs, the polygamous nature of Chinese marriages, the area of navigation in a port and the nature of a sport.

[Emphasis added]

77 In this case, the facts relate to the existence of the Singapore registered trade marks cited by the Applicants. Do these facts have “an objective existence” which is “unaffected by the specific circumstances of the [present] case”? The answer must be a “yes”. The existence of these two trade marks can be objectively verified via a search of the register of trade marks of Singapore, and their existence is entirely independent of the specific circumstances of the present case. After the hearing, I checked the database of trade marks maintained by the Intellectual Property Office of Singapore, and verified that all the Singapore registrations cited by the Applicants, set out in [74] above, do exist.

78 Having taken judicial notice of the Singapore trade mark registrations cited by the Applicants, I am nevertheless unconvinced that the text “USPA” is the dominant component in the Application Mark. The Applicants relied on the registration of the text “USPA” on its own (in Classes 9, 18 and 25) as indication that this word has inherent distinctiveness. But the Double Horsemen Device on its own is also a registered mark (in Classes 18 and 25). Therefore both the text and the device can be said to have some inherent distinctiveness. It may be that, relative to the text “USPA”, the Double Horsemen Device has less inherent distinctiveness because there are other registered trade marks featuring polo player(s). However, I find that the visual impact of this device in the Application Mark cannot be said to be negligible.

79 Looking at the Application Mark as a whole, I find that *neither* the Double Horsemen Device *nor* the text “USPA” is more outstanding or memorable than the other. The factors of size, position and technical distinctiveness are all neutral. Neither component can be said to be much bigger in size than the other. Neither enjoys a more prominent position than the other in the mark. Both components have inherent technical distinctiveness.

80 In other words, there is *no* dominant component in the Application Mark. Both the device and text are equally significant in the Application Mark. Therefore, the visual comparison between the Single Polo Player Mark and the Application Mark cannot be on the basis of “Single Polo Player Mark versus Double Horsemen Device” or “Single Polo Player Mark versus USPA”. This is the effect of applying the following principle laid down in *Hai Tong* (at [62(b)]):

When the other components of a complex mark are of negligible significance, it is permissible to make the comparison solely on the basis of any dominant element(s).

81 I must thus compare the Single Polo Player Mark against the Application Mark as a whole without giving special regard to either the device or the text in the Application Mark. In this comparison, I find that whilst there is a small degree of similarity between the devices, the presence of text “USPA” in the Application Mark significantly reduces this similarity. My conclusion is that there is only an extremely low degree of visual similarity between the two marks in this case.

(ii) Aural comparison

82 This is the least contentious of the three aspects. In fact, both parties agreed that there is no aural similarity between the two marks because there is no text in the Single Polo Player Mark which can be used to compare against the text "USPA" in the Application Mark.

83 It should be noted that initially via their written submissions, the Opponents argued that the marks are aurally similar because the Double Horsemen Device in the Application would be verbally described as “polo players” and the Single Polo Player Mark would be verbally described as “polo player”. At the hearing, the Opponents did not pursue this line of argument.

84 I should point out that there are some cases where the tribunal has found aural similarity between a strictly pictorial device mark and a mark comprising a device and text. For example, in *Dainichiseika Colour & Chemicals Mfg Co Ltd v OHIM Case T-389/03* (unreported, but referred to in *La Chemise Lacoste SA v Baker Street Clothing Ltd* [2011] RPC 165 at 183), the earlier mark was a pictorial device of a pelican whereas the opposed mark comprised the word “PELICAN” and a device depicting a bird. The General Court found that a substantial number of the relevant public would refer to the earlier mark by the term "pelican" and, on this basis, decided that the two marks were phonetically identical or very similar. A local example is *S.Tous, S.L. v Ng Wee Ping* [2010] SGIPOS 6, where the Registrar found aural similarity between two marks both of which were pictorial devices (one depicted a picture of a bear, and the other depicted an outline of a bear).

85 However, there are also cases involving strictly pictorial devices where the tribunal found that the marks were not aurally similar or where the tribunal dispensed with the aural assessment altogether. Examples of such cases are *Samuel Smith Old Brewery (Tadcaster) v Lee (t/a Cropton Brewery)* [2012] FSR 7 at [93], *The Timberland Company v Avtar Singh and Harkirat Singh Trading as Aero Club* [2011] SGIPOS 14 at [61], and *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2014] SGIPOS 10 at [60].

86 These cases illustrate that the issue of whether there is aural similarity when one mark (or both) is a strictly pictorial device(s), is very fact-centric. As mentioned, the Opponents did not pursue the issue of aural similarity. They did not point to any evidence that would support their argument that the relevant public is likely to verbalise the Single Polo Player Mark as “polo player”. Indeed it seems to me that the evidence suggests

otherwise. I have already indicated, in the visual comparison, that the Opponents had difficulties showing use of the Single Polo Player Mark on its own (see [73] above). For example, the vast majority of the sample invoices tendered as evidence of their sales in Singapore featured the Single Polo Player Mark used in conjunction with the words “POLO RALPH LAUREN”. If the Single Polo Player Mark is often used in conjunction with the Opponents’ word marks, it is likely that when the average consumer sees the Single Polo Player Mark on its own, he will verbalise it as “Polo Ralph Lauren mark”, and not “polo player” as the Opponents claimed.

87 I therefore find that there is no aural similarity in this case.

(iii) Conceptual comparison

88 In the conceptual comparison, the aim is to “uncover the ideas that lie behind and inform the understanding of the mark as a whole” (*Staywell* at [35]). It has also been said that the comparison is of “the feelings and images intended to be evoked by each mark” (*Jamal Abdunaser Mahmoud Al Mahmud* at [36]).

89 The Opponents submitted that there is a high degree of similarity between the two marks because the idea behind both marks is the same, namely, the sport of polo. The Applicants submitted that there is no conceptual similarity because the idea evoked by the Single Polo Player Mark is that of a single polo player whereas the idea evoked by the Application Mark is not only the sport of polo but also “U.S. Polo Association”.

90 There are two problems with the Applicants’ submission. First, I have already mentioned that there is no evidence to show that the relevant public in Singapore is aware that “USPA” is the acronym for “U.S. Polo Association”. That being the case, it is unlikely that what comes to the mind of this public, when they encounter the Application Mark, is an association related to the sport of polo.

91 Second, it seems inappropriate to slice up one idea into fine layers and impute one layer of the idea (single polo player) to one mark, and the other layer of the same idea (polo association) to the other mark. This is too nuanced an approach, one that involves a public who “over-thinks”. It is for this reason, in my view, that the High Court rejected a similar attempt to make fine distinctions within one broad idea. In *Jamal Abdunaser Mahmoud Al Mahmud*, the plaintiff’s composite mark comprised the word “Manchester” and a coat of arms. The defendant’s composite mark comprised the word “Manchester” and a device depicting the letter “M”. In the conceptual assessment, the defendant argued that the concepts evoked by both marks were different: the plaintiff’s mark evoked traditional Britain whereas the defendant’s mark evoked a contemporary England. The High Court responded to the defendant’s argument as follows (at [39]):

[I]n both marks, the word “Manchester” occupies a significant part. Taking each mark as a whole, the conceptual objective is the evocation of whatever it is that the word “Manchester” is supposed to evoke: it may be England or Britain, whether it is the Britain of tradition or contemporary English. *Different aspects of England or Britain are perhaps evoked by the two marks, but it is ultimately the same object.*

[Emphasis added]

92 In the present case, I find that the Single Polo Player Mark conveys the idea of the game of polo.

93 As for the Application Mark which is a composite mark, it is important to bear in mind this caution issued by the Court of Appeal in *Staywell* at [35]:

Greater care is ... needed in considering what the **conceptually** dominant component of a composite mark is, because *the idea connoted by each component might be very different from the sum of its parts.*

[Emphasis in italics added]

94 Just like in the visual comparison, I find that there is no dominant component in the Application Mark for the purposes of the conceptual comparison. Assessing the Application Mark as a whole, I find that the Double Horsemen Device (just like the Single Polo Player) conveys the idea of the game of polo. The presence of the text “USPA”, since there is no evidence that it has any meaning to the public in Singapore, does not add or subtract from this idea.

95 I therefore find that the two marks are conceptually identical.

(iv) Overall comparison

96 I have found that the marks are visually similar (to an extremely low degree) and conceptually identical. There is no aural similarity.

97 It is possible to find, in an overall assessment of the marks, that the marks are similar even if they are not similar in all three aspects: see [53(a)] above. Ultimately, the question is whether the two marks, when observed in their totality, are similar rather than dissimilar, and answering this question is inevitably a matter of impression: see [53(b)] above. Looking at the two marks in their totality, I find that they are similar. The degree of similarity, though, is a very low one. Nevertheless, the first requirement in Section 8(2)(b) is satisfied in this case.

The Goods-Identity/Similarity Inquiry

98 Both parties’ goods are in Class 9. The specific goods to be compared are the following:

- (a) The Opponents’ Specification of Goods: “Spectacles, spectacle frames, lenses, sunglasses and parts and fittings therefor”.
- (b) The Applicants’ Specification of Goods: “Eyewear; ophthalmic eyewear frames; reading glasses; sunglasses; eyeglass cases and covers; sun visors (eyewear)”.

99 The Opponents submitted that there is identity between all the goods except for “reading glasses” found in the Applicants’ Specification of Goods. In the case of “reading glasses”, they submitted that these are similar to “spectacles” listed in the Opponents’ Specification. The Applicants agreed with this matching.

100 In my view, the term “reading glasses” and “spectacles” are often used interchangeably. I find that there is identity between *all* the goods of the parties. Therefore, the second requirement in Section 8(2)(b) is satisfied in this case.

The Confusion Inquiry

(A) The Law: General Principles

101 Here is a summary of the legal principles governing the confusion inquiry, laid down in *Staywell*, which are particularly pertinent to this case:

- (a) The confusion inquiry in Section 8(2)(b) must take into account the actual and notional fair uses to which the registered proprietor of the earlier trade mark has or might fairly put his registered trade mark and compare this against any actual and notional fair use to which the trade mark applicant may put his mark should registration be granted: *Staywell* at [60].
- (b) The only relevant type of confusion, for the purposes of Section 8(2)(b), is that which is brought about by the similarity between the competing marks and the similarity between the goods and services in relation to which the marks are used: *Staywell* at [15].
- (c) Factors relating to the impact of marks-similarity on consumer perception include the following:
 - (i) The degree of similarity between the marks. The greater the similarity between the marks, the greater the likelihood of confusion, and vice versa: *Staywell* at [96(a)]. Further, it is possible to give more weight to the degree of similarity in a particular aspect (*viz.* visual, aural or conceptual) of the mark. For example, if the goods are normally sold based on the consumer’s direct perception, the visual aspect of the mark would be more important than the aural or conceptual aspects of the mark: *Staywell* at [20].
 - (ii) The reputation of the marks. A strong reputation can but does not necessarily equate to a higher likelihood of confusion: *Staywell* at [96(a)].
- (d) Factors relating to the impact of goods-similarity on consumer perception include the following:
 - (i) The normal price of goods. Where the goods are expensive items, the average consumer is likely to pay greater attention and care when buying such goods and this affects his ability to detect subtle differences: *Staywell* at [96(b)].
 - (ii) The nature of the goods. For example, where the nature of the goods is such that specialist knowledge is required in making the purchase, the average consumer is also likely to pay greater attention and care when buying such goods: *Staywell* at [96(b)].

- (iii) The frequency and typical mode of purchase of the goods. For example, the consumer is likely to pay greater attention when the purchase transaction is infrequent (compared with routine purchases): *Staywell* at [94].
- (e) It is not permissible to consider factors which are external to the marks and to the goods in question, and which are susceptible to changes that can be made by a trader from time to time, such as price differentials between the parties' goods: *Staywell* at [95].

(B) *My Findings*

102 I repeat my findings in the marks-similarity inquiry and the goods-similarity inquiry: there is overall a very low degree of similarity between the marks, and there is identity between the goods. These two factors are critical in the confusion inquiry, but there are other factors to consider. In particular, the reputation factor and the consumer perception factor.

103 Both parties claimed that they had reputation in their respective marks. However, neither was able to prove this claim. In the case of the Opponents' Single Polo Player Mark, I have already mentioned in the visual comparison that the Opponents were unable to show prior use of the Single Polo Player Mark on its own: see [73] above. As for the Application Mark, the evidence tendered by the Applicants was not helpful for various reasons. For example, the Applicants provided "worldwide" sales figures without any supporting evidence. In any event, given the territorial nature of trade mark rights, it is only sales *in Singapore* that mattered, but the Applicants did not indicate which portion of the "worldwide" revenue figures can be attributed to the Singapore market. There is also no evidence of any prior use of the Application Mark in Singapore in relation to eyewear. The invoices provided by the Applicants to show shipments of their goods (travel cases) to Singapore did not feature any mark, or they featured the Applicants' word mark "U.S. POLO ASSOCIATION"¹⁰ and not the Application Mark.

104 As for the consumer perception factor, both parties made submissions on the price and nature of eyewear. The Opponents argued that eyewear are not expensive items; rather, they are ordinary and common products used by the general public who would not pay a greater degree of care and attention than the usual. The goods being eyewear also means that the appearance of the Application Mark on the goods would usually be on the spectacle frames and any clarity of the Double Horsemen Device in the Application Mark would be lost and would appear very close to the Single Polo Player Mark. Further, eyewear is generally sold in optical shops which carry various brands. All these factors, the Opponents argued, weigh in favour of a finding of confusion.

105 The Applicants countered that their eyewear and the Opponents' eyewear are expensive items, and hence the average consumer would pay much time, thought and care when making the purchase. As for the appearance of the Application Mark on spectacle frames, if at all the clarity of the Double Horsemen Device is lost, this leaves the textual component "USPA", which sits side-by-side with the device, standing out even more prominently, thereby allowing the consumer to distinguish between the Application Mark from the Single Polo Player Mark. The Applicants also relied on some observations made by Choo Han Teck J in *Polo/Lauren (HC, 2002)*. It will be recalled that Choo J held that

there was no likelihood of confusion between the Opponents' Single Polo Player Mark and another one of the Applicants' marks. One of the learned judge's reasons for this finding is the following:

[T]here is a small but not entirely insignificant fact, and that is that there are a number of other companies that are using a polo player as a device as part of their mark. Mr Chow drew my attention to the Beverly Hills Polo Club, the Santa Barbara Polo & Racquet Club, World Polo Championships, among others. While it is generally neither a useful nor relevant exercise to compare marks that are not the subject of the current proceedings, in this instance, the reference to the other marks is pertinent in so far as they illustrate the simple point that many common objects may represent diverse as well as related or similar interests. For example, a dog may represent a kennel club, or a veterinary clinic, or a pet shop. So the use of a dog or, as in this case, a polo player as a motif, in itself signifies nothing in trade mark law.

[Emphasis added]

106 The Applicants accepted that Choo J's decision in *Polo/Lauren (HC, 2002)* was made under the Old Act, and that the opposed mark there is different from the Application Mark. However, they argued that the reasoning and logic used by the High Court in the assessment for confusion remains relevant in Section 8(2)(b) of the Act. The Applicants' argument here is similar to the argument that they made in the marks-similarity inquiry, namely, devices featuring polo player(s) are common in the eyewear sector and hence are not particularly distinctive. It is the text "USPA" which has greater trade mark significance and its presence, the Applicants submitted, eliminates any likelihood of confusion.

107 The Applicants' argument that their eyewear and the Opponents' eyewear are expensive items requires closer examination. The Court of Appeal has made it very clear in *Staywell* that the confusion inquiry in Section 8(2)(b) must take into account not just the actual use but also the *notional* fair use of the marks by both parties: see [101(a)] above. At present, both the Applicants and the Opponents may be selling only high-end eyewear (an assertion which, incidentally, is not supported by any evidence). But what if the registration of the Application Mark is allowed, and both the Opponents and the Applicants decide to move into the mid- or even low-price range of eyewear? Such use would surely constitute fair notional use by the parties of their marks. The implication of the Applicants' argument is that the presence or absence of confusion will depend on whether the Applicants and the Opponents decide to sell high-end eyewear or low-end eyewear. Decisions of traders on pricing of their products are a classic example of "external" matters which are "susceptible to changes that can be made by a trader from time to time" – factors which are impermissible in the confusion inquiry: see [101(e)] above. That is why in *Staywell*, the Court of Appeal held that it was not legitimate to take into account, in the confusion inquiry, the fact that the opponents operated a 6-star hotel whereas the trade mark applicant operated a 4-star hotel. The appellate court noted that "the range of notional fair uses would easily extend across the spectrum of 4- to 6-star hotel segments" (at [102]) and that "differences in the intended market segments" were irrelevant in the confusion inquiry (at [84]). It bears to repeat the policy consideration underlying the court's decision (at [90]):

[This is to give] adequate regard to the proprietary rights of the [registered proprietor of the earlier trade mark]. Otherwise, a subsequent trader would be able to enter the market using a trade mark that was very similar to the [earlier trade] mark, applied to similar if not identical goods and yet avoid liability by means of an express disclaimer, or by using cheaper materials and selling his goods at a much lower price and saying that because of these steps, there is no likelihood of confusion notwithstanding the high degree of similarity or even of identity between the marks and between the goods.

108 Thus, when determining the degree of care that the average consumer will pay when purchasing eyewear, it is inappropriate to consider if *the Opponents'* and/or *the Applicants' eyewear* are expensive or inexpensive items. The reference point should be the normal or average price of eyewear *as a type or category of goods*. For example, cars are expensive goods whereas erasers are inexpensive goods, and hence the degree of attention and care that goes into buying a car would be greater than that which goes into buying an eraser. This is what the Court of Appeal meant when it said, “The *price of the type of goods being sold* is distinct from the issue of *price disparity between the parties' products*.” (*Staywell* at [96(b)], emphasis added).

109 Having clarified this matter, though, I do not think that it is necessary in every case to focus on the price of the type of goods concerned. Ultimately, the aim of the exercise is to determine the degree of care that the average consumer is likely to pay when purchasing that type of goods. In this exercise, there may be factors other than price which are more useful.

110 In my view, eyewear is a type of goods the purchase of which involves a fairly high degree of care regardless of their price range, for the following reasons. First, eyewear as a type of goods is not purchased on a regular or frequent basis. Second, eyewear as a type of goods is usually bought through salespersons particularly, as the Opponents have pointed out, when they are sold in optical shops. Third, eyewear is a type of goods that will command a higher degree of fastidiousness on the part of a consumer who is likely to inspect the product closely in order to decide if the particular spectacle frame fits well in terms of comfort level (e.g. whether the nose pad of the spectacle frame sits comfortably on the consumer's nose bridge).

111 Frequency and mode of purchase of the goods, and the nature of the goods themselves, have been accepted by the Court of Appeal in *Staywell* as factors that would affect the level of attention that the consumer is likely to devote to the purchase, and hence relevant to the issue of likelihood of confusion: see [101(d)(ii)–(iii)] above. The Court of First Instance (now known as “the General Court”) in *Devinlec Développement Innovation Leclerc SA v OHIM* Case T-147/03 also noted at [63] that:

... in the case of goods such as those covered by the marks in question here [viz. watches and clocks], which are not purchased regularly and are generally bought through a salesperson, the average consumer's level of attention, as the Board of Appeal rightly found, must be taken to be higher than usual, and therefore fairly high.

112 My conclusion is as follows. The identity between the goods is a factor that points to the existence of a likelihood of confusion. Where similarity of the marks is concerned, it should be noted that eyewear are usually purchased based on visual inspection and hence the visual aspect of the marks is likely to have a greater impact on the consumer: see [101(c)(i)] above. In this case, there is only a very low degree of visual similarity between the marks. This, coupled with the fairly high degree of care and attention that the average consumer will pay when purchasing eyewear, are factors which point away from a likelihood of confusion. Assessing all these factors in the light of the doctrine of imperfect collection, I find on balance that there is no likelihood of confusion in this case.

113 For completeness, I would add that confusion for the purposes of Section 8(2)(b) can be of two kinds: where the consumer thinks that the goods bearing the opposed mark are those of the registered proprietor of the earlier trade mark, or the consumer thinks that the parties using these two marks are economically-linked (*Staywell* at [99] and *Hai Tong* at [74]). In this case, I find that there is no likelihood of either type of confusion. Therefore, the third requirement in Section 8(2)(b) is not satisfied in this case.

114 The ground of opposition under Section 8(2)(b) therefore fails.

Conclusion

115 Having considered all the evidence filed and the submissions made in writing and orally, I find that the opposition fails on both grounds under Section 7(6) and Section 8(2)(b). Accordingly, the Application Mark shall proceed to registration. The Applicants are also entitled to costs to be taxed, if not agreed.

Dated this 2nd day of June 2015

Ng-Loy Wee Loon (Prof)
IP Adjudicator
Intellectual Property Office of Singapore

¹ The Opponents' 1st SD, Exhibit ADV-5.

² The Opponents' 1st SD, Exhibit ADV-5 at p 727.

³ The Opponents' 1st SD, Exhibit ADV-5 at p 728.

⁴ The Opponents' 1st SD, Exhibit ADV-5 at p 728.

⁵ The Opponents' 1st SD, Exhibit ADV-5 at p 728.

⁶ The Opponents' Written Submissions at para [86(ii)].

⁷ The Opponents' Written Submissions at para [86(xiv)].

⁸ The Opponents' 1st SD, Exhibit ADV-3.

⁹ The Opponents' 1st SD, Exhibit ADV-4.

¹⁰ The Applicants' SD, at [13] and pp 433–437 in Exhibit DC-11.