

Intellectual Property Office of Singapore Case Summary: The Polo/Lauren Company, L.P. v United States Polo Association [2015] SGIPOS 10

Source: <https://www.ipos.gov.sg/resources/hearing-mediation>
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These are opposition proceedings commenced by The Polo/Lauren Company LP (“the Opponents”) in relation to the trade mark application T1215440A (“the Application Mark”) filed by United States Polo Association (“the Applicants”). Two grounds of opposition were relied upon, namely, Sections 7(6) and 8(2)(b) of the Trade Marks Act (Cap 332, 2005 Rev Ed).

The Opponents’ bad faith claim under Section 7(6) was premised on a settlement agreement that was reached between the parties in 2003 to resolve their trade mark dispute in the US. This ground failed because the Opponents were not able to discharge the very high burden of proof involved in an allegation of bad faith.

The Opponents’ claim under Section 8(2)(b) was based on their earlier registered trade mark T9604857H. The details of the Opponents’ earlier trade mark and the Application Mark are shown in the table below:

The Opponents’ earlier trade mark T9604857H	The Application Mark T1215440A
 <p data-bbox="188 1016 284 1043">Class 9</p> <p data-bbox="188 1077 659 1167">Specification of goods: “Spectacles, spectacle frames, lenses, sunglasses and parts and fittings therefor”</p>	 <p data-bbox="683 1016 778 1043">Class 9</p> <p data-bbox="683 1077 1153 1200">Specification of goods: “Eyewear; ophthalmic eyewear frames; reading glasses; sunglasses; eyeglass cases and covers; sun visors (eyewear)”</p>

The IP Adjudicator, applying the “step-by-step” approach in Section 8(2)(b), found that there was only a very low degree of similarity between the two trade marks, and that there was identity between the goods. Although the first two “steps” were satisfied, the claim failed because the IP Adjudicator found that there would not be a likelihood of confusion (which is the requisite “third step”).

What is interesting about this case is the IP Adjudicator’s analysis of the argument on the pricing of eyewear. There was an argument that confusion was unlikely because both the Applicants’ eyewear and the Opponents’ eyewear were expensive items and hence purchasers were likely to exercise a higher degree of care when purchasing the parties’ eyewear. The IP Adjudicator indicated that, in considering pricing as a factor in the confusion inquiry, it would not be appropriate to consider if *the Opponents’ eyewear and/or the Applicants’ eyewear* were expensive items. Rather, in order to pay heed to the Court of Appeal’s decision in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911, the reference point should be the normal or average price of eyewear *as a type or category of goods*.

She also indicated that it was not necessary in every case to focus on the price of the type of goods concerned. Ultimately, the aim of the exercise was to determine the degree of care that the average consumer was likely to pay when purchasing that type of goods. In this exercise, there might be factors other than price which were more useful.

In her assessment, eyewear was a type of goods the purchase of which involved a fairly high degree of care regardless of their price range. She gave the following reasons. First, eyewear as a type of goods was not purchased on a regular or frequent basis. Second, eyewear as a type of goods was usually bought through salespersons particularly when they are sold in optical shops. Third, eyewear was a type of goods that would command a higher degree of fastidiousness on the part of a consumer who was likely to inspect the product closely in order to decide if the particular spectacle frame fit well in terms of comfort level (e.g. whether the nose pad of the spectacle frame sat comfortably on the consumer’s nose bridge). This fairly high degree of care and attention that the average consumer would pay when

purchasing eyewear, coupled with the very low degree of similarity between the two marks, were reasons for her conclusion that there was no likelihood of confusion.

Disclaimer: The above is provided to assist in the understanding of the Registrar's grounds of decision. It is not intended to be a substitute for the reasons of the Registrar. The full grounds of decision can be found at <https://www.ipos.gov.sg/resources/hearing-mediation>.