

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

Trade Mark No. T1114738Z  
Hearing Date: 26 September 2017

**IN THE MATTER OF A TRADE MARK REGISTRATION IN THE NAME OF**

**ROYAL COUNTY OF BERKSHIRE POLO CLUB LTD**

**AND**

**APPLICATION FOR DECLARATION OF INVALIDITY THEREOF BY**

**THE POLO/LAUREN COMPANY, L.P.**

Hearing Officer: Ms Tan Mei Lin  
Principal Assistant Registrar of Trade Marks

Representation:

Mr Sukumar Karuppiah (Ravindran Associates) for the Applicant

Ms Janet Lim (Intellect Worldwide (S) Pte Ltd) for the Registered Proprietor

**GROUND OF DECISION**

1 Horses – there is something about this spirited animal that inspires life, books, movies, sport and even fashion. No wonder then that polo is known as the sport of kings. And that Ralph Lauren, son of immigrants to America made good, chose a polo player on horseback for his clothing emblem. To what extent should the motif of this beast of beauty and freedom be carved out from the domain of common consciousness and shared imagination, to be monopolised as a trade mark right? And to what extent can one prevent another from using the idea of a polo player on horseback, whether in the same or different narrative?

2 In the case before me, the Polo/Lauren Company, L.P. (“the Applicant”) seeks to challenge the rights of Royal County of Berkshire Polo Club Ltd (“the Proprietor”) to the use of the word “Polo” and/or a device of a polo player. Among other things, I have to decide if

these signs are so distinctive of the Applicant that it is viewed as its exclusive badge of origin such that other traders should not be allowed to use these signs.

3 This is not the first time the Applicant is attempting to stop a competitor from using such signs, at least in the area of consumer goods. In the past 12 years, at least 6 cases were heard before this tribunal and the Courts<sup>1</sup> on this issue with various outcomes.

4 The trade mark the Applicant is seeking to invalidate in this case is:



5 The Subject Mark was registered on 20 October 2011 (“the Relevant Date”), in relation to the following goods:

<b>Class No.</b>	<b>Goods</b>
9	Spectacles, spectacle cases, spectacle frames, spectacle glasses, sun glasses.
18	Leather and imitations of leather, and goods made from these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harnesses and saddlery, articles of luggage, suitcases, briefcases, tote bags, work bags, toiletry bags, waist bags, sling bags, shoe bags, school bags, overnight bags, jewellery bags (empty), gym bags, clutch bags, bags for clothes, bags made of leather, bags made of imitation leather, handbags, shoulder bags, purses, wallets, shopping bags, suit carriers, attache cases, rucksacks, holdalls, pouches [bags].
25	Articles of clothing, footwear and headgear.

“the Subject Goods”).

6 On 30 December 2013 the Applicant applied for the Subject Mark to be declared invalid. The Proprietor filed its Counter-Statement in defence of the registration on 19 February 2014.

7 The Applicant filed evidence in support of its application on 17 December 2014. The Proprietor filed evidence in support of the Subject Mark’s registration on 30 April 2015. The Applicant filed its evidence in reply on 8 December 2015. Following the close of evidence, a

<sup>1</sup> *Polo/Lauren Co, L.P. v United States Polo Association* [2016] SGHC 32, *The Polo/Lauren Company, L.P. v United States Polo Association* [2015] SGIPOS 10, *The Polo/Lauren Company, L.P. v Lohmun Leather Products* [2009] SGIPOS 1, *The Polo/Lauren Co, L.P. v Shop In Department Store Pte Ltd* [2006] SGCA 14, *The Polo /Lauren Co, L.P. v Shop In Department Store Pte Ltd* [2005] SGHC 175, *The Polo/Lauren Company, L.P. v Bobby Footwear Pte Ltd* [2005] SGIPOS 16.

Pre-Hearing Review (“PHR”) was held on 6 January 2016. Subsequent to the PHR, the parties requested for more time before the matter is set down for hearing due to ongoing discussions between them. On 21 June 2017, the Applicant confirmed that the matter may be fixed for hearing.

8 The Proprietor filed its written submissions (“the Proprietor’s Written Submissions”) on 7 September 2017 and the Applicant filed its written submissions (“the Applicant’s Written Submissions”) on 8 September 2017. The matter came up for hearing on 26 September 2017 and at the hearing the parties submitted Written Rebuttal Submissions (“the Applicant’s Written Rebuttal Submissions” and “the Proprietor’s Written Rebuttal Submissions” respectively).

### **Grounds of Invalidation**

9 The Applicant relies on a number of grounds in the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”) in support of this application for a declaration of invalidity. They are:

- (a) Sections 23(3)(a)(i) read with Section 8(2)(b) of the Act (“the Similarity Ground”);
- (b) Section 23(3)(a)(iii) read with Section 8(4)(b)(i) of the Act (“the Well Known and Damaging Interest Ground”); and
- (c) Section 23(3)(b) read with Section 8(7)(a) of the Act (“the Passing Off Ground”).

10 For completeness, the Applicant’s Statement of Grounds of Invalidation also stipulated four other grounds, namely, Sections 7(1)(a) and 7(6) read with Section 23(1) and Section 8(4)(b)(ii)(A) and Section 8(4)(b)(ii)(B) read with Section 23(3)(a)(iii) of the Act. However, in the course of the Registrar’s case management during which grounds had to be confirmed, the Applicant indicated by letter dated 10 July 2017 that it was not pursuing these grounds.

### **Applicant’s Evidence**

11 The Applicant’s evidence comprises the following:

- (a) A Statutory Declaration made by Anna Dalla Val, Vice President, Intellectual Property Counsel of Ralph Lauren Corporation, and also Vice President and Secretary of PRL International, Inc. (PRL International, Inc. being the General Partner of the Applicant), on 10 December 2014 in New York, United States of America (“the Applicant’s 1<sup>st</sup> SD”); and
- (b) A Statutory Declaration in Reply made by the same Anna Dalla Val on 4 December 2015 in New York, United States of America (“the Applicant’s 2<sup>nd</sup> SD”).

### **Proprietor’s Evidence**

12 The Proprietor’s evidence comprises a Statutory Declaration made by Michael Amooore, General Manager of the Proprietor, on 17 April 2015 in Winkfield, United Kingdom (“the Proprietor’s SD”).

### **Applicable Law and Burden of Proof**

13 The applicable law is the Act. Under Section 101(c)(i) of the Act, “the registration of a person as proprietor of a registered trade mark shall be prima facie evidence of the validity of the original registration”. The burden of proof in the present case falls on the Applicant to prove at least one of the grounds of invalidity relied upon on the balance of probabilities.

### Background

14 The Proprietor is a polo club founded in 1985 in the County of Berkshire, England. It claims to be the most exclusive polo club in England with success so resonant that the Prince of Wales became an honoured lifetime member soon after its creation. Apart from polo sport and polo club activities, the Proprietor has also ventured into consumer goods such as apparels, bags, footwear, eyewear, fashion items and accessories.




15 Besides the Subject Mark, the Proprietor also owns the following trade mark registrations in Singapore:










TM No.	Trade Mark	Class No.	Goods
T1219216H	<b>ROYAL COUNTY OF BERKSHIRE POLO CLUB</b>	9	Spectacles; sunglasses; sport glasses (eye glasses); monocles; pince-nez; eyewear; frames for spectacles; cases, chains, cords and holders adapted for spectacles, sunglasses and eye glasses, cases and holders adapted for lenses; contact lenses,; cases, containers and holders adapted for contact lens; part and fittings for all the aforesaid goods
T1219224I	<b>ROYAL COUNTY OF BERKSHIRE POLO CLUB</b>	18	Leather; imitation leather; animal skins; hides; trunks (luggage); traveling bags; umbrellas; parasols; walking sticks; whips; saddlery; articles of luggage; suitcases; briefcases; tote bags; work bags; toiletry bags; waist bags; sling bags; shoe bags; school bags; overnight bags; jewellery bags (empty); gym bags; clutch bags; bag for clothes; bags for clothes pegs; bags made of imitation leather, bags made of leather; handbags; shoulder bags; travel bags made of plastic materials; luggage bags; bags; shopping bags, garment bags, cosmetic bags [not fitted]; baggages; wheeled bags; beauty cases [not fitted]; carrying bags (other than disposable carrier bags), pouches [bags]; purses; leather wallets; suit carriers; Rucksacks;











			Cosmetic holdalls (not fitted); haversacks; duffel bags; attache cases; cases for key; shoulder belts made of leather or imitation leather
T1219225G	<b>ROYAL COUNTY OF BERKSHIRE POLO CLUB</b>	25	Articles of clothing for men, women and children including jeans, shirts, blouses, skirts, T-shirts, pants, shorts, trousers, sweaters, pull-overs, knitwears, jersey, jumpers, cardigans, jackets, swimming costumes, underwear, sleepwear, pyjamas, gowns, sportswear, socks, stocking, belts, caps and ties; raincoat; footwear and headgear









16 The Subject Mark has not yet been used by the Proprietor in Singapore, although it has been used in other countries such as the United Kingdom and Malaysia.

17 The Applicant, The Polo /Lauren Company, LP, is a limited partnership existing under the laws of New York and is the registered proprietor in Singapore of some 51 marks containing or consisting of the word “Polo” and/or a polo player device in various classes including Class 9 (eyewear), Class 18 (leather goods) and Class 25 (clothing and footwear), namely:





S/No.	Trademark Registration No.	Trademark	Class
1	T7878659G		03
2	T89206659H		03
3	T8803255B		03
4	T9200365J	<b>POLO SPORT</b>	03
5	T0016737F	<b>POLO SPORT RALPH LAUREN SKIN FITNESS</b>	03

6	T9811990A	POLO JEANS CO.	03
7	T8500514G	<b>POLO</b> Ralph Lauren	03
8	T1205796A		03
9	T1205793E		03
10	T1205792I		03
11	T1205792I		03
12	T8300346E	Ralph  Lauren	08
13	T8300357J	Ralph  Lauren	09
14	T9604857H		09
15	T1108752B	<b>POLO</b>	09
16	T8300354F	Ralph  Lauren	14
17	T9205449B		14
18	T8300360J	POLO BY RALPH LAUREN	16

19	T8300361I	Ralph  Lauren	16
20	T8903299H	POLO BY RALPH LAUREN	18
21	T8300358I	Ralph  Lauren	18
22	T9604858F		18
23	T0716550F	POLO	18
24	T0716552B	 POLO	18
25	T0716554I	 POLO RALPH LAUREN	18
26	T9604859D		20
27	T8300347C	Ralph  Lauren	21
28	T8300350C	Ralph  Lauren	24
29	T8604792G	Ralph  Lauren	24
30	T9604860H		24
31	T9100082H	POLO	25
32	T9900713I	POLO	25

33	T9610633J	POLO BY RALPH LAUREN	25
34	T9505622D	POLO SPORT	25
35	T8906215C		25
36	T8801941F		25
37	T1002681C	POLO TENNIS	25
38	T9601391Z	POLO JEANS CO.	25
39	T8504342A	Ralph Lauren 	25
40	T8504920I		25
41	T8503624G		25
42	T9610634I	Ralph Lauren 	25
43	T9900714G		25
44	T9604861F		25



46	T8300352Z		27
47	T9205448D		28
48	T9205444A	<b>POLO</b>	28
49	T9900440G	POLO JEANS CO.	35
50	T9900441E	 Polo Ralph Lauren	35
51	T9302456B	 Polo Ralph Lauren	42

(“the Applicant’s Marks”).

18 The usage of the Applicant’s Marks dates back to 1987 or earlier and the annual sales figures in Singapore of goods bearing the Applicant’s Marks for the fiscal years 1987 to 2013 are summarised below:

<b>Fiscal Year Ending 31 March</b>	<b>Amount (in excess of S\$)</b>
1987	2,250,000.00
1988	5,630,000.00
1989	12,860,000.00
1990	19,460,000.00
1991	20,400,000.00
1992	19,500,000.00
1993	23,300,000.00
1994	23,000,000.00
1995	18,850,000.00
1996	23,310,000.00
1997	27,500,000.00
1998	20,000,000.00
1999	20,200,000.00
2000	20,000,000.00
2001	21,000,000.00
2002	23,000,000.00
2003	21,580,000.00
2004	21,570,000.00
2005	25,000,000.00
2006	23,000,000.00
2007	22,000,000.00

2008	23,000,000.00
2009	25,000,000.00
2010	12,350,000.00
2011	16,200,000.00 (sub total: <b>489,960,000.00</b> )
2012	21,550,000.00
2013 (partial)	19,800,000.00
<b>Grand Total</b>	<b>531,310,000.00</b>





19 The Applicant had also since 1989 engaged in extensive advertising, such advertising being conducted primarily in print media having a wide circulation in Singapore. The approximate amounts expended in advertising and promoting the sale of products bearing the Applicant's Marks in Singapore for the period covering the fiscal years 1989 through 2009 have been substantial too. This is summarised below:


<b>Fiscal Year Ending 31 March</b>	<b>Amount (in excess of S\$)</b>
1989	140,000.00
1990	100,000.00
1991	218,400.00
1992	274,700.00
1993	160,600.00
1994	287,600.00
1995	220,200.00
1996	381,900.00
1997	362,300.00
1998	200,000.00
1999	200,000.00
2000	200,000.00
2001	213,000.00
2002	134,000.00
2003	175,000.00
2004	200,000.00
2005	300,000.00
2006	300,000.00
2007	300,000.00
2008	260,000.00
2009	170,000.00
<b>Grand Total</b>	<b>4,800,700.00</b>

20 In addition, the Applicant's goods are also offered for sale and provided through the Applicant's global website, [www.ralphlauren.com](http://www.ralphlauren.com).

21 The Applicant relies on the following earlier trade marks ("collectively the Applicant's Earlier Marks") under the Similarity Ground and Well Known and Damaging Interest Ground<sup>2</sup>:

<sup>2</sup> Applicant's Written Submissions at [46].

Applicant's Earlier Marks	Class	Goods
<b>Applicant's Device Marks</b>		
 <p>T9604857H (14 May 1996)</p>	9	Eyewear and eyewear accessories, namely, eyeglass cases, pince-nez cases, pince-nez chains, pince-nez cords, eyeglass frames, eyeglass cords, spectacle cases, spectacle frames, spectacle glasses, spectacles, sunglass cases, sunglass cords, sunglass frames, sunglass chains and sunglasses in international class 9; all excluding goods adapted for use in horse riding or the playing of polo.
 <p>T9604858F (14 May 1996)</p>	18	Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks.
 <p>T9604861F (14 May 1996)</p>	25	Jackets, shirts, polo shirts, t-shirts, trousers, suits, slacks, sweaters, neck ties, socks, overcoats, blazers, shorts, belts (clothing), knit shirts and shoes.
 <p>T9900714G (27 January 1999)</p>	25	Men's, women's and children's clothing, namely, sweaters, shirts, including knit shirts, dress shirts, sport shirts, polo shirts, sweat shirts and tee shirts; jackets, neckties, trousers, suits, slacks, ascots, bathing suits, belts (clothing), blouses, skirts, dresses, coats, hats, caps, tuxedos, pants, jeans, overcoats, shorts, tops, vests, robes, hosiery, scarves, pyjamas, underwear, kilts, mufflers, shawls; footwear, namely shoes, boots, slippers and athletic shoes; blazers, wristbands, coveralls, overalls, sweat pants and sleepwear in International Class 25.

<b>Applicant's Composite Mark</b>		
 <b>POLO</b> T0716552B (2 August 2007)	18	Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks.
<b>Applicant's Word Marks</b>		
<b>POLO</b> T9100082H (7 January 1991)	25	Slacks, jackets; jeans and sports footwear, all being articles of clothing; but not including clothing for use in horse riding or the playing of polo.
<b>POLO</b> T9900713I (27 January 1999)	25	All goods in Class 25 but not including goods adapted for use in horse riding or the playing of polo.
<b>POLO</b> T0716550F (2 August 2007)	18	Trunks, suitcases, travelling bags, valises, briefcases, attached cases, handbags, purses (not of precious metals or coated therewith), pocket wallets; key cases and billfolds, all in the nature of wallets; umbrellas and parasols; parts and fittings in class 18 for all the aforesaid goods.
<b>POLO</b> T1108752B (1 July 2011)	9	Spectacles, spectacle frames, lenses, sunglasses and parts and fittings therefor.

## MAIN DECISION

### Ground of Invalidation under the Similarity Ground

22 Section 23(3)(a)(i) of the Act reads:

(3) The registration of a trade mark may be declared invalid on the ground—

(a) that there is an earlier trade mark in relation to which —

(i) the conditions set out in section 8(1) or (2) apply;

...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

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

(2) A trade mark shall not be registered if because —

...

(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 exist a likelihood of confusion on the part of the public.

### ***Decision on the Similarity Ground***

24 The law in relation to Section 8(2)(b) is well-established: the leading case is the Court of Appeal’s decision in *Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911 (“*Staywell*”). In *Staywell* the court reaffirmed the “*step-by-step*” approach which may be summarised as follows. The first element is to assess whether the respective marks are similar. The second element is to assess whether there is identity or similarity between the goods or services for which registration is sought as against the goods or services for which the earlier trade mark is protected. The third element is to consider whether there exists a likelihood of confusion arising from (or to use the words of the section: *because of*) the two similarities. The court made it clear that “*the first two elements are assessed individually before the final element which is assessed in the round*” (*Staywell* at [15]). If, for any one step, the answer is in the negative, the inquiry ends, and the opposition will fail. These principles are equally applicable to post-registration invalidation actions based on the same substantive provision above, such as the present case.

### ***Comparison of Marks***

25 In assessing the marks for similarity, I have taken the following principles into account:

(a) The assessment of marks similarity is mark-for-mark, without consideration of any external matter. (*Staywell* at [20].)

(b) The marks are to be compared for visual, aural and conceptual similarities. There is no requirement that all three aspects of similarity must be made out before the marks can be found to be similar. Trade-offs can occur between the three aspects of similarity in the marks-similarity inquiry. The three aspects of similarity are but signposts meant to guide the inquiry and I must ultimately come to a conclusion whether the marks, when observed in their totality, are similar rather than dissimilar. This is inevitably a matter of impression. (*Staywell* at [17]-[18].)

- (c) When assessing two contesting marks, I should bear in mind that the average consumer has imperfect recollection. Therefore, the two marks should not be compared side by side and examined in detail because the person who is confused often makes a comparison from memory removed in time and space from the marks. (*Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 (“*Hai Tong*”) at [62(a)]). That said, the court or tribunal is entitled to have special regard to the distinctive or dominant components of a mark, even while it assesses the similarity of the two marks as composite wholes, since those (distinctive or dominant components) tend to stand out in the consumer’s imperfect recollection. (*Staywell* at [23].)
- (d) The signs/marks are considered from the viewpoint of the average consumer – *not* an unthinking person in a hurry, but rather, a person who would exercise some care and good sense in making his purchases. (*The Polo/Lauren Co, LP Shop In Department Store Pte Ltd* [2006] SGCA 14 (“*Polo (CA)*”) at [34].)

### *Distinctiveness*

26 I am mindful of the Court’s guidance in *Staywell* at [30] that distinctiveness is a factor integrated into the visual, aural and conceptual analysis as to whether the competing marks are similar and it is not a separate step within the marks-similarity inquiry. However, following the approach of the Court of Appeal in *Hai Tong* at [26], for the purpose of elucidating the analytical process, I will highlight it here as a separate step first before applying my findings within the context of the mark-similarity analysis.

27 Assessment of the degree of distinctiveness of the earlier trade mark is important “*in order to determine the extent of the latitude that will be allowed to a user of features that appear in that mark*” (*Hai Tong* at [27]). Further, the Court of Appeal in *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2012] SGCA 56 said at [20]:

...the “distinctiveness” of the registered trade mark is a factor to be considered in the visual, aural and conceptual analysis to determine whether the allegedly infringing sign and the trade mark are similar. It stands to reason that the more distinctive the registered trade mark, the more it is necessary to show sufficient alterations to, or difference in, the sign in order that it may not be held to be similar to the trade mark

...

Conversely, the more descriptive a mark, the greater the latitude afforded to the defendant in using words or ideas of a generic nature, even if these have some similarity to what is found in the registered mark. The rule that proscribes impermissible similarity cannot be applied in precisely the same manner to a mark that uses common descriptive words or devices as to one that does not (*Hai Tong* at [30]).

28 As mentioned at [21], the Applicant relies on 3 types of earlier marks for this invalidation:

- (a) “POLO” (“the Word Mark”);

(b)  (“the Device Mark”); and

(c)  “ POLO ” (“the **Composite Mark**”).

29 The Proprietor submits that the Applicant’s Earlier Marks lack distinctiveness as they are descriptive of the Applicant’s goods in Classes 9, 18 and 25. In this regard, the Proprietor says that the word “Polo” describes a sport where players ride on horseback with long mallets or it may refer to a kind of collared T-shirt (commonly referred to as “Polo” shirts)<sup>3</sup>. Further, the word “Polo” and/or a polo player device is/are commonly used and adopted as trade marks or part thereof by many traders both internationally and locally in Singapore particularly where it relates to goods in Classes 9, 18 and 25. The fact that there are numerous registrations in the Register containing the word “Polo” and/or a polo player device supports the contention that the “Polo” word in simpliciter and a polo player device are common and lack distinctiveness<sup>4</sup>. These registrations are:

<u>Trademark (Application No)</u>	<u>Class</u>	<u>Status</u>	<u>Proprietor</u>
SANTA BARBARA POLO & RACQUET CLUB (T9709297Z)	09	REGISTERED	SANTA BARBARA POLO & RACQUET CLUB
BEVERLY HILLS POLO CLUB (T9400364Z)	09	REGISTERED	YOUNG SANGYO CO., LTD
MARC O’ POLO (T8802508D)	09	REGISTERED	MARC O’ POLO INTERNATIONAL GMBH
U.S. POLO ASSN. (T1215179H)	09	REGISTERED	UNITED STATES POLO ASSOCIATION
JEAN POLO (T1115323A)	09	REGISTERED	VISION RICH
POLO XCHANGE (T1103090C)	09	REGISTERED	NOVA VISION ENTERPRISE PTE LTD
POLO SMITH (T0808824F)	09	REGISTERED	HOU GINE TRADING COMPANY
LA MARTINA & HORSE DEVICE (T0417771F)	09	REGISTERED	QUILATE SERVICOS LIMITADA
GREENWICH POLO CLUB (T9801329A)	18	REGISTERED	GREENWICH POLO CLUB, INC
POLO DESIGN STUDIO (T9701901F)	18	REGISTERED	SEAGER INC PTE LTD
UNITED STATES POLO ASSOCIATION (T9611672G)	18	REGISTERED	UNITED STATES POLO ASSOCIATION

<sup>3</sup> Proprietor’s Written Submissions at [15].

<sup>4</sup> Proprietor’s Written Submissions at [16].

USPA & HORSE DEVICE (T9605119F)	18	REGISTERED	UNITED STATES POLO ASSOCIATION
POLO WORLD CREATION (T1318128C)	18	REGISTERED	GLOBAL NET PTE LTD
POLO REPUBLIC (T1016068D)	18	REGISTERED	MK GIFT & BAG
POLO CROWN (T1000088A)	18	REGISTERED	SARL INTERNATIONAL POLO GUIDE
SWISS POLO (T0906716A)	18	REGISTERED	LOHMUN LEATHER PRODUCTS PTE LTD
POLO SPIRIT (T0812669E)	18	REGISTERED	POLO SPIRIT PTE LTD
MARCOPOLO (T8904696D)	25	REGISTERED	PACODY (FAR EAST) LTD
MIKAL POLO (T1312183C)	25	REGISTERED	HANSAM PTE LTD
ROYAL MARSHAL POLO CLUB (T1305002B)	25	REGISTERED	NITRI DESIGN AND ENGINEERING
EXPRESS POLO (T1304505C)	25	REGISTERED	ACE STAR MARKETING SDN BHD
POLO FEDERATION (T1215407Z)	25	REGISTERED	LEE CHEE PEAU
WP & HORSE DEVICE (T1210580Z)	25	REGISTERED	LAI BOON HON
FRENCH POLO (T1008345J)	25	REGISTERED	ORIENTAL HARDWARE & BUILDING MATERIAL PTE LTD
POLO PLAYER ON HORSE DEVICE (T0804811B)	25	REGISTERED	UNITED STATES POLO ASSOCIATION
MILANPOLO (T0717299E)	25	REGISTERED	ANNTAA TRADING PTE LTD
CLASSIC POLO (T0708643F)	25	REGISTERED	ROYAL CLASSIC MILLS PVT LTD
BEVERLY HILLS POLO CLUB (T0210372C)	25	REGISTERED	YOUNG SANGYO CO., LTD
POLOGARAGE (T0313622F)	25	REGISTERED	POLO GIYIM SANAYI VE TICARET ANONIM SIRKETI
MASTER POLO (T0319521D)	25	REGISTERED	SCOTT POLO
POLO PACIFIC (T0407559Z)	25	REGISTERED	SHOP IN DEPARTMENT STORE PTE LTD
THE DRY POLO (T0418495Z)	25	REGISTERED	WALTON INTERNATIONAL LTD

30 I am unable to agree with the Proprietor that the Applicant's Earlier Marks lack distinctiveness. Firstly, there is no application by the Proprietor to invalidate the Applicant's trade marks for being devoid of distinctive character, descriptive or generic. The Applicant's Earlier Marks must therefore enjoy a "presumption of validity" and be considered to have at least a minimum degree of inherent distinctiveness. Secondly, even if I accept that the word



“Polo” will be perceived by the public as referring to the game of polo, there is no evidence that the Applicant’s goods are intended for use in horse riding or the playing of polo. In fact, the Applicant’s specification of goods for the “POLO” word marks in Class 25 specifically excludes goods adapted for use in horse riding or the playing of polo. As for the point that the word “Polo” may refer to a kind of collared T-shirt (commonly referred to as “Polo” shirts), I accept that in relation to “polo shirts” and “t-shirts” the inherent distinctiveness of the Word Mark is extremely low but with regard to all other goods in Classes 9, 18 and 25, I find that the Applicant’s Earlier Marks have a normal degree of inherent distinctiveness. Considering the fact that the word “polo” is not an invented word and a device of a polo player is not one with a high level of imaginative content (being something that exists in reality and not an arbitrary graphic creation), I do not think that their distinctiveness is any higher than normal.

31 I am also unable to agree with the Proprietor that the mere fact that numerous registrations in the Register contain the word “Polo” and/or a polo player device is evidence that the “Polo” word in simpliciter and a polo player device lacks distinctiveness. One of the most frequent arguments canvassed by applicants is that the earlier trade mark or one of its components has low distinctive character given that there are many trade marks that consist of, or include, the element in question. Where this argument is supported only by the reference to trade mark registrations, this is not per se particularly conclusive, as it does not necessarily reflect the situation in the market. In other words, on the basis of information from the Register only, it cannot be assumed that all the trade marks have been effectively used. It would be more helpful if the evidence could demonstrate that consumers have been exposed to widespread use of, and become accustomed to, trade marks that include the element in question in order to prove that this element has a low degree of distinctive character. Regrettably, evidence of this nature was not produced in this case.

32 I am further reminded by the Applicant that in *The Polo/Lauren Co LP v United States Polo Association* [2016] SGHC 32 (“*USPA HC*”), a case concerning the Device Mark, the same argument was made by the defendant therein and was rejected by the Court. The defendant in that case argued that:

The polo player in devices of trade marks is thus a common feature and is not particularly distinctive. There is thus no reason that it should be granted an additional layer of protection that is usually reserved for marks which are inventive and which are technically distinctive.

However, the Court found at [36] that the mere existence of other trade marks using a polo player device was inconclusive and found that there was no evidence that the Applicant’s Device Mark has a lower level of distinctiveness:

I am not persuaded by the defendant’s argument. It is unclear to me as to how *Polo/Lauren 2002* supports the proposition that the Opposition Mark is less distinctive – the point which the judge sought to make through his observation was that the use of a polo player as a motif in that case *in itself* signified nothing in trade mark law. There is, in my view, insufficient evidence to demonstrate that the Opposition Mark has a lower level of distinctiveness. The mere fact that there are other registered trade marks comprising a polo player on horse-back is not necessarily indicative of the distinctiveness of the Opposition Mark; those marks could either be dissimilar, or do not lead to a likelihood of confusion. To the extent that the defendant is suggesting that the registration of these trade marks is evidence, similar to

*Castellani*, that the use of polo players in graphical devices has become commonplace in respect of eyewear, there is no such evidence before me.

33 Having examined the inherent distinctiveness of the Applicant's Earlier Marks, I will now proceed to examine whether any of them have acquired enhanced distinctiveness at the Relevant Date as a consequence of the use made of it. In this regard, I note that the issue whether acquired distinctiveness can be taken into account at the mark similarity stage does not appear to be settled law. This is because if the assessment of marks similarity is mark-for-mark without consideration of any external matter, then it would not be permissible to look at the actual use of the mark (via sales and promotion of products bearing the mark). Nevertheless, I will consider acquired distinctiveness to see if it has been made out in the first place. If it is not made out, nothing turns upon it in any event.

34 As mentioned at [17], the Applicant has registered some 51 marks containing or consisting of the word "Polo" and/or a polo player device in various classes including Classes 9 18 and 25 in Singapore. While the Applicant contends that it has used its marks in Singapore since around 1987, the more pertinent issue is whether by virtue of such use, the Applicant's Earlier Marks (and none other) have acquired enhanced distinctiveness by the Relevant Date.

35 It is the Proprietor's case that the Applicant's Earlier Marks have not been used on its own but only in conjunction with the Applicant's other registered trade marks such as the words "Ralph Lauren"<sup>5</sup> or "Ralph"<sup>6</sup> and accordingly the Applicant's evidence does not show that any of the earlier marks has acquired enhanced distinctiveness.

36 The Proprietor further reminds me that in *Polo (CA)*, a case concerning the Word Mark in Class 25, the Court of Appeal found that the mark had not acquired distinctiveness. It held at [17]:

...The appellant here had not done anything either to promote or use the mark POLO" on its own. The mark "POLO" has always been used and linked with Ralph Lauren. Thus, we cannot see how the appellant could claim that the word mark "POLO" has acquired distinctiveness...

37 I am aware that the relevant date for the assessment of acquired distinctiveness in this case is 20 October 2011 and the decision in *Polo (CA)* cannot be relied on here as the relevant date there is different and the goods concerned in the present case are also wider in that they include goods in Classes 9 and 18. I will therefore review the evidence lodged herein independently.



38 I will first comment on the evidence generally. I start with the Applicant's invoices<sup>7</sup>. As the invoices show use of various signs over time, I will summarise what I see for ease of reference.

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<sup>5</sup> Proprietor's Written Submissions at [17].

<sup>6</sup> Proprietor's SD at [25].

<sup>7</sup> Exhibited at ADV-3 of the Applicant's 1<sup>st</sup> SD.

Period	Sign appearing on invoices
1989 to March 2001	 POLO RALPH LAUREN
April 2001 to March 2007	 POLO RALPH LAUREN
	<b>POLO JEANS CO. RALPH LAUREN</b>
April 2007 to March 2009	RALPH LAUREN
	<b>POLO JEANS CO. RALPH LAUREN</b>
	<b>POLO JEANS CO. RALPH LAUREN</b>
April 2010 to October 2012	RALPH LAUREN
	POLO RALPH LAUREN
	POLO JEANS COMPANY
	<b>RALPH LAUREN CHILDRENS</b>

39 Based on the invoices it appears as follows:

- (a) The polo player device and the word “Polo” have never been used on their own on the Applicant’s invoices;
- (b) While the polo player device was used together with the words “Polo Ralph Lauren” in the composite form, “ POLO RALPH LAUREN ” (“**the Composite Sign**”), the use was only in the initial years and from April 2007 onwards, the polo player device ceased to feature on the Applicant’s invoices; and
- (c) Other than the use of **POLO JEANS COMPANY**, the use of the word “Polo” has always been accompanied by the words “Ralph Lauren”.

40 It is the Composite Sign that appears on the Applicant’s price tags<sup>8</sup>.

41 Moving on to the Applicant’s promotional materials<sup>9</sup>, my observations are as follows:

- (a) The Device Mark almost never features in the text of the advertisements (as opposed to photographs of the Subject Goods on the advertisements, which I will deal with at [45(c)]). If at all they are featured in the text, they are featured only prior to March 1997 in the form of the Composite Sign<sup>10</sup>;
- (b) A substantial portion of the materials in fact features only the words “Ralph Lauren”, without the word “Polo” and without the polo player device;

<sup>8</sup> Applicant’s 1<sup>st</sup> SD at pages 158-161, 168, 173-174, 176-177, 181-189, 190, 192-197, 199-200, 202-204, 206-211, 213-222, 224. The price tags were lodged for the period before April 1997 only.

<sup>9</sup> Exhibited in ADV-4 of the Applicant’s 1<sup>st</sup> SD. On a related note, it appears that the evidence from page 708 onwards relate to Malaysia and I have therefore not taken them into account.

<sup>10</sup> Applicant’s 1<sup>st</sup> SD at page 613.

- (c) Whenever the word “Polo” is used, it is almost always accompanied by the words “Ralph Lauren”. Whilst in some of these materials the word “Polo” is in larger font than the words “Ralph Lauren”, this does not detract from the fact that they are still used together as a composite sign; and
- (d) There are some incidences of use of “POLO JEANS CO.” per se (without the words “Ralph Lauren”) in 2003 and before<sup>11</sup> but the materials in subsequent years do not seem to show this use anymore.

42 I will now move on to consider the evidence in the context of the Subject Goods.

43 In relation to the goods in Class 9 (such as eyewear), no evidence of use relating specifically to these goods was lodged. As a result, I am unable to tell if any of the earlier marks have even been used on Class 9 goods as of the Relevant Date, much less acquired an enhanced distinctive character.

44 In relation to Class 18 goods (such as handbags), I note from the advertisements lodged that the trade mark referred to on these goods is “Ralph Lauren”<sup>12</sup>. None of the Applicant’s Earlier Marks appear to feature anywhere on the goods.

45 In relation to Class 25 goods (such as clothing and footwear), much more evidence was tendered and my observations are:

- (a) In relation to the Device Mark, whenever the Device Mark is used in the text of the advertisements, it is always accompanied by the words “Ralph Lauren”<sup>13</sup>;
- (b) The Device Mark does not appear to feature at all in the text of the advertisements after 1990;
- (c) Some of the advertisements show photographs of clothing bearing the Device Mark per se, for example, on the chest area of the clothing<sup>14</sup>. However, the more critical issue I have to decide is whether by virtue of such use, consumers regard the Device Mark as a badge of origin (as opposed to something else, such as, mere decoration) and therefore it has acquired enhanced distinctiveness. Given that there is little evidence before me of the extent of this use and the effect of this use on consumers, I am unable to conclude that this has occurred;
- (d) In relation to the Word Mark, more often than not it is used together with the words “Ralph Lauren”<sup>15</sup>;
- (e) There are some instances of use of “Polo Jeans Co.”<sup>16</sup> and at at least one advertisement showing shoes bearing the Word Mark per se<sup>17</sup>. But again, the

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<sup>11</sup> Applicant’s 1<sup>st</sup> SD at pages 632, 649, 656, 657, 667 and 668 (not exhaustive).

<sup>12</sup> Applicant’s 1<sup>st</sup> SD at pages 609, 611, 615 and 620.

<sup>13</sup> Applicant’s 1<sup>st</sup> SD at pages 532, 537, 546, 556 (not exhaustive).

<sup>14</sup> Applicant’s 1<sup>st</sup> SD at pages 532, 622, 624, 625, 628, 629, 638, 640, 643, 647,655, 663, 666, 674 (not exhaustive).


<sup>15</sup> Applicant’s 1<sup>st</sup> SD at pages 549, 550, 552, 558, 583, 642, 647, 675 (not exhaustive).

<sup>16</sup> Applicant’s 1<sup>st</sup> SD at pages 632 and 656 (not exhaustive).

<sup>17</sup> Applicant’s 1<sup>st</sup> SD at page 563.


extent of this type of use and the effect such use has on consumers is not clear from the evidence;



- (f) In relation to the Composite Mark, “ POLO ”, its use is only in the form of the Composite Sign, “ POLO  RALPH LAUREN ”; and
- (g) The invoices and price tags refer to the Composite Sign.

46 Last but not least, the Applicant’s website is [www.ralphlauren.com](http://www.ralphlauren.com)<sup>18</sup>. It does not contain the word “Polo”.

47 Having reviewed the Applicant’s evidence carefully, I come to the view that there is insufficient evidence to show that any of the Applicant’s Earlier Marks have acquired an enhanced level of distinctiveness in relation to any of the Subject Goods.

48 The evidence lodged does not show use of the Composite Mark. Even if it may be said that the Composite Mark is used in the Composite Sign “ POLO  RALPH LAUREN ” (which I doubt), the use is always accompanied by the highly distinctive words “Ralph Lauren” and there is no evidence to suggest that by virtue of such use the Composite Mark on its own, without the words “Ralph Lauren” have acquired enhanced distinctiveness. As for the Device Mark and Word Mark, while there is some use of it per se, as mentioned at [45(c)] and [45(e)], the extent and effect of such use is not clear.

49 The bulk of the evidence shows use of the Applicant’s Earlier Marks in conjunction with the highly distinctive words “Ralph Lauren”. Even if I accept that acquired distinctiveness, or enhanced distinctiveness, may be achieved as a result of use of the Applicant’s Earlier Marks in conjunction with other signs such as the Composite Sign, there is nothing in the evidence to suggest this has occurred in the present case. The words “Ralph Lauren” being highly distinctive are likely to feature in the consumers’ imperfect impression of the Composite Sign. Further, having regard to the fact that average consumers tend to regard trade marks as a whole and do not usually proceed to analyse their various details, it makes it less likely that use of the Applicant’s Earlier Marks as part of an element of the Composite Sign would have made an impression on consumers that was independent of the impression created by the Composite Sign as a whole.

50 Finally, where a mark has never been used as a sole badge of origin, this lends weight to the inference that the trader does not depend on the mark standing alone to serve as a trade mark (see *Société des Produits Nestlé SA and another v Petra Foods Ltd and another* [2016] SGCA 64 at [59]).

51 The level of distinctiveness therefore remains as I have indicated at [30]: extremely low for the Word Mark in relation to “polo shirts” and “t-shirts” and normal with regard to all other goods in Classes 9, 18 and 25, as well as the Device Mark and the Composite Mark.




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<sup>18</sup> Applicant’s 1<sup>st</sup> SD at [13].

52 Bearing in mind the level of distinctiveness of each of the Applicant’s Earlier Marks, I will now compare the marks visually, aurally and conceptually.

53 The visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

54 For ease of reference, the marks to be compared are:

<i>Applicant’s Earlier Marks</i>	<i>Subject Mark</i>
	 <i>Royal County of Berkshire</i> <b>POLO CLUB</b>
 <b>POLO</b>	
<b>POLO</b>	

55 It is settled law and not disputed by the parties that each of the earlier marks must be compared independently with the Proprietor’s mark and one cannot attempt to combine separately registered marks and rely on them as a single composite mark. To do so would be contrary to the principle that extraneous matters cannot be taken into account in the marks-similarity stage (*Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] 5 SLR 618 at [70]).

*Visual Comparison*

56 It has been held that the approach to be taken in assessing visual similarity is to assess the marks in totality, without placing undue emphasis on any component, unless it is warranted (*Hai Tong* at [41]) and that only after a holistic assessment of the visual characteristics of the two marks can the conclusion that these marks are visually similar be reached (*Jamal Abdunaser Mahmoud Al Mahamid v Global Tobacco Manufacturers (International) Sdn Bhd* [2015] SGHC 42 (“*Global Tobacco HC*”) at [23]).

57 The Subject Mark is a composite sign comprising 3 elements:

- (a) A polo player device at the top of the sign;
- (b) The words “POLO CLUB” in plain font and in upper case at the bottom of the sign; and

- (c) The words “Royal County of Berkshire” in a contrasting font in the middle of the sign between the polo player device and the words “POLO CLUB”.


58 The Applicant submits that the technical distinctiveness in the Subject Mark is in the polo player device. The words “Royal County of Berkshire” are in a very stylised script and barely discernible and can only be read upon very close scrutiny. As for the words “POLO CLUB”, though they are visible and pronounceable as such, they are dwarfed by the polo player device which is much bigger by about 4-fold. Further, the words may be considered descriptive of a polo club<sup>19</sup>.

59 On the other hand, the Proprietor contends that technical distinctiveness lies in the words “Royal County of Berkshire” and “POLO CLUB” which are prominently displayed and discernible<sup>20</sup>.

60 I do not agree with the Applicant that technical distinctiveness in the Subject Mark lies only in the polo player device. In my view, the 2 textual elements in the Subject Mark are highly distinctive technically as they are not in any way descriptive of any characteristic of the goods. As for the point that the words “Royal County of Berkshire” and “POLO CLUB” may only be read upon close scrutiny and are each “*dwarfed*” by the polo player device, this has no bearing on technical distinctiveness but only the issue of whether these elements are dominant in the Subject Mark.

61 I now come to the analysis of the dominant component of the Subject Mark. In carrying out this analysis, I recognise that words do not “talk” in trademarks (*Hai Tong* at [41]). That is, words in composite marks do not dominate or constitute the whole of such marks simply because they are words. The question that has to be asked, as noted by the Court of Appeal in *Hai Tong*, is whether the words are dominant on the facts of each mark.

62 In the present case, considering the size, position, font and orientation of the words “POLO CLUB”, I do not see how it may be said that the words are dwarfed by the polo player device. In fact, I find that the presence of the polo player device reinforces the dominance or at least co-dominance of the element “POLO CLUB” as it emphasises the “Polo” portion of “POLO CLUB”. This was also the finding in the case of *Hai Tong* where the Court of Appeal concluded that the textual component of the composite mark was the

dominant component of the mark “  ” and the device component relatively insignificant as it underscored the textual component by emphasising the “Rose” portion of “Lady Rose”.

63 With regard to the words “Royal County of Berkshire”, they may be of a stylised script, but they are nevertheless of a good size and clearly legible. Given that the average consumer is one who would exercise some care and a measure of good sense in making his or her purchases, I do not think that these words would be ignored, missed or forgotten in the consumers’ overall visual impression of the sign considering the following:

- (a) The words are in bold;

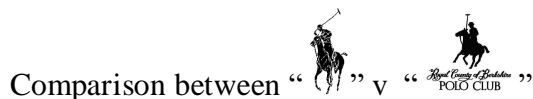
<sup>19</sup> Applicant’s Written Submissions at [68].

<sup>20</sup> Proprietor’s Rebuttal Submissions at [V(d)].

- (b) They are in a contrasting font from the words “POLO CLUB”, which causes them to stand out and catch the eye;
- (c) They occupy a central position in the sign as a whole;
- (d) They extend much more widely than the other 2 elements in the sign (comprising 4 words made up of 22 letters); and
- (a) The prominence of the words “POLO CLUB” invites attention to these words as they put in context the name of the Proprietor’s polo club.

64 Even if it may be said that in imperfect recollection, the average consumer may not necessarily recall the entire phrase “Royal County of Berkshire”, the fact remains that the phrase would, nonetheless, have affected his perception of the Subject Mark and his recollection of it.

65 As a result, considering the Subject Mark as a whole, I do not agree that the 2 textual components of the Subject Mark are negligible to the extent that they can be disregarded. In my view, the words “Royal County of Berkshire” and “POLO CLUB” both play essential parts in the overall impression conveyed by the Subject Mark. None of the elements - the polo player device, the words, “Royal County of Berkshire” or the words, “POLO CLUB” - are more outstanding or memorable than the others. In other words, there is *no* dominant component in the Subject Mark. Both the device and the 2 separate lines of text are equally significant in the Subject Mark. Bearing in mind that it is only when other components of a complex mark are of negligible significance, that it is permissible to make the comparison solely on the basis of any dominant element(s) (*Hai Tong* at [62(b)]), the visual comparison between the earlier marks and the Subject Mark cannot therefore be on the basis of the polo player device or the word “Polo”. I must thus compare the Applicant’s Earlier Marks against the Subject Mark as a whole without giving special regard to either the device or any particular word/words in the Subject Mark.



66 The marks under comparison share one common denominator: a device of a polo player. The Applicant submits that there is a high degree of visual similarity between the Subject Mark and the Device Mark<sup>21</sup>. The Proprietor however contends that the marks are not similar and submits that the respective parties’ polo player devices bear the following differences:

- (a) The device in the Subject Mark depicts “*an inactive polo player in rest position with mallet in vertical upright position on a stationary horse*” with the Applicant’s mark adopts “*an active polo player with mallet swung to the back in ready-to strike position on a charging horse*”; and
- (b) The device in the Subject Mark is in pure black and is represented in 2-D outlook while the device in the Applicant’s mark is in 2-tones, black and white, and represented in a 3-D outlook.

67 I have difficulty seeing how the claimed differences of the “*stationary horse*” and “*inactive polo player*” depicted in the Subject Mark can be sustained given that the

<sup>21</sup> Applicant’s Written Submissions at [79].



positioning of the horse's legs in the Subject Mark clearly shows the horse to be in motion and the polo player to be raising his mallet in readiness to strike. In any event, I also find it highly unlikely that the average consumer with imperfect recollection will be cognizant of minor variances such as the angle of the polo player's mallet and the running speed of the horse, without the benefit of a side-by-side comparison and I come to the view that the device in the Subject Mark bears similarities to the Device Mark.

68 Having said that, the assessment of similarity of two marks means more than taking just one component of a composite mark and comparing it with another mark. The High Court stated in *USPA HC* at [17] that the test for visual similarity is not one of substantial reproduction, but rather, visual similarity is to be assessed by examining each of the marks in question as a whole, bearing in mind their dominant and distinctive components and by reference to the overall impressions created by the mark or signs.

69 Comparing the marks as wholes, taking into account the following:

- (a) The level of distinctiveness of the Device Mark is normal and the fact that it does not enjoy a high threshold before a competing sign will be considered dissimilar to it;
- (b) The fact that the device and the 2 lines of text are equally significant in the Subject Mark and the average consumer's imperfect recollection of the Subject Mark is unlikely to be dominated by the device only;
- (c) The characteristics of the average consumer - not an unthinking person in a hurry, but rather, a person who would: (a) exercise some care and good sense in making his purchases; and (b) tend to regard trade marks as a whole and not usually proceed to analyse their various details; and
- (d) The fact that any similarity that consumers may perceive in the devices used in the respective marks, will be far outweighed by the greater degree of dissimilarity in the fact that the Subject Mark contains 2 rows of text, while the Applicant's Device Mark has none;

I am of the view that the marks are more dissimilar than similar.

Comparison between  " POLO " v  " Royal Bunch of Grapes POLO CLUB "

70 It is trite that marks must be compared as wholes but, for a moment, I will compare the word element in the Composite Mark with the word elements in the Subject Mark. In this regard, *Ferrero SPA v Sarika Connoissuer Cafe Pte Ltd* [2011] SGHC 176 ("*Ferrero*") at [51] affords a handy, non-exhaustive checklist:

In the case of word marks, a determination of visual similarity typically involves looking at the (a) length of the marks; (b) structure of the marks (*i.e.*, whether there are the same number of words); and (c) whether the same letters are used in the marks (*Ozone Community* at [49], citing *Bently & Sherman, Intellectual Property Law* (Oxford University Press, 3rd Ed, 2009) at 865 ("*Bently & Sherman*").

71 Length-wise, the word element in the Composite Mark is 4-letters long, while the Subject Mark has 30 letters in the word elements “Royal County of Berkshire” and “POLO CLUB”. Structurally, from the perspective of “*whether there are the same number of words*”, the Composite Mark has only 1 word while the Subject Mark has 6. As for the issue “*whether the same letters are used in the marks*”, the commonality between the Composite Mark and the Subject Mark lies only in 1 word or 4 letters out of the 30 letters in the Subject Mark. The word elements in the respective marks are therefore more dissimilar than similar.

72 This exercise is conducted at a high degree of granularity, but it must be borne in mind that the objective of the above is to help ascertain whether these marks can be said to be visually similar as wholes. Comparing the marks as wholes and taking into account the following:

- (a) There is no dominant component in the Subject Mark;
- (b) There is no dominant component in the Composite Mark;
- (c) The level of distinctiveness of the Composite Mark is normal and does not enjoy a high threshold before a competing sign will be considered dissimilar to it;
- (d) The guidance of the High Court in *The Polo /Lauren Co, LP v Shop In Department Store Pte Ltd* [2005] SGHC 175 (“*Polo HC*”) at [26] that “... *In cases where there is a common denominator, it is important to look at the differences between the mark and the sign in order to decide whether the challenged sign has been able to distinguish itself sufficiently and substantially...*”;
- (e) The average consumer is unlikely to notice the similarities between the respective marks without also noticing that the Subject Mark contains the additional words “Royal County of Berkshire” and “CLUB”; and
- (f) Even with imperfect recollection, it is likely the average consumer would still remember that the Subject Mark is more complex and has a much longer textual component than the Composite Mark;

I come to the view that the marks have a low degree of visual similarity.

  
Comparison between “POLO” v “Royal County of Berkshire POLO CLUB”

73 In respect of the Word Mark, the Applicant submits that there is visual similarity, albeit to a low degree<sup>22</sup>. The similarity lies in the word “Polo” which is the first word in one of the 3 components of the Subject Mark, namely, “POLO CLUB”.

74 I am unable to agree with the Applicant. In my view, the following visual differences between the 2 marks would be obvious to the average consumer:

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<sup>22</sup> Applicant’s Written Submissions at [119].

- (a) The additional device component in the Subject Mark;
- (b) The additional words “Royal County of Berkshire” in bold and stylised font which causes them to stand out and catch the eye; and
- (c) The word “Polo” is linked with the word “Club”.

75 The above differences far outweigh any visual similarity due to the coincidence of the word “Polo”. Considering the fact that the word “Polo” is merely a word in one of the 3 components of the Subject Mark, I cannot see how the word “Polo” would dominate the consumers’ overall impression of the Subject Mark.

76 As such, I see no visual similarity between the Word Mark and the Subject Mark.

#### *Aural Comparison*

77 With regard to aural comparison, it is clear from *Staywell* (at [31] and [32]) that there are two possible approaches. One approach is to consider the dominant and distinctive components of the marks (“the Dominant Component Approach”). The other approach which does not involve considering the dominant components is to undertake a quantitative assessment as to whether the competing marks have more syllables in common than not (“the Quantitative Assessment Approach”).



78 The Applicant submits that the Device Mark is most likely to be verbalised as “polo player” and that the Subject Mark too may also be verbalized as a “polo player” mark given that the polo player device is the dominant element<sup>23</sup>.

79 I am unable to agree with the Applicant. In my view, no aural comparison may be undertaken for this set of marks as the Device Mark, being a device only mark has no verbal element to speak of. At the very most, its visual or conceptual content can be described orally. The ‘meaning’ that the image evokes, or its ‘description’, will be assessed visually and conceptually but they will not be subject to a phonetic comparison or it will only repeat the outcome of the visual or conceptual comparison respectively, where these elements have already been assessed. This view was also expressed by the Honourable Justice Lee Siu Kin in *Polo HC* at [22] where he said:

... Whether a mark that is found to have no aural component may nonetheless be found to be aurally similar to another mark does not appear to be settled law; for example, in *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2014] SGIPOS 10, the principal assistant registrar found that there could be no aural similarity given that the mark which the opponent sought to rely on had no aural component. This aspect of the decision was undisputed and was therefore not disturbed in the appeal to the High Court: *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] 5 SLR 618 at [85]. Personally, I have my reservations. To find aural similarity where no aural

<sup>23</sup> Applicant’s Written Submissions at [89].

component exists seems to allow for visual or conceptual similarity to be accounted for within the assessment of aural similarity.

80 What this means is that this aspect of comparison results in a neutral conclusion rather than the marks are aurally dissimilar.

81 Before I move on, I would like to comment on a point that the Applicant brought up. This relates to the relevance of the fact that on the Register, the Registrar has commonly described the device in both the Applicant’s polo player device marks as well as the Subject Mark with terms containing the words “polo-player”, as shown below:

<b>Applicant’s Trade Marks</b>	<b>Device Description</b>	<b>Subject Mark</b>	<b>Device Description</b>
T9604857H	Polo-player	T1114738Z	Polo-player horse
T9604858F	Man horse jockey		
T0716552B	Polo-player		
T9900714G	Polo-player		
T9604861F	Polo-player		

82 The “Device Description” is a field found under the heading “Mark Index”. Mark indexing is merely an administrative function undertaken by the Registry to describe the elements that make up a trade mark. The purpose is to facilitate searches of marks from the Register. Where the trade marks consist of words, the indexing process is fairly straight forward and the words in the mark will be entered into the field “Words in Mark” under the heading “Mark Index”. However, where the trade marks contain or consist of devices, the Registrar will have to describe the device in the field “Device Description”. In order to minimise subjectivity and inconsistency, the terms which may be used for indexing are limited to those in the Registrar’s “Glossary of Device Descriptors”. As such, the way the Registrar indexes devices in trade marks has no effect whatsoever on the nature of the trade mark or the applicant’s rights in it and is in no way indicative of how it is perceived by the average consumer.



83 The Applicant submits that both the Composite Mark and the Subject Mark would be verbalised as “polo player”<sup>24</sup> and therefore this set of marks should also be found to be aurally similar.

84 For the same reasons I have given above at [79], I am unable to agree that either the Composite Mark or the Subject Mark would be verbalised as “polo player” as that is not the aural component in the marks.

85 In my view, the Composite Mark would be verbalised as “Polo” as that is the textual element in the mark. As for the Subject Mark, the aural component in the mark are the words “Royal County of Berkshire” and “POLO CLUB”. The question is how the consumer would verbalise this 10-syllable mark. If the average consumer verbalises it as “Royal County of

<sup>24</sup> Applicant’s Written Submissions at [111].

Berkshire Polo Club”, applying the Quantitative Assessment Approach, the marks are more dissimilar than similar as they have 2 syllables in common and 8 which are not.

86 Even recognising as the High Court did in *Han’s (F & B) Pte Ltd v Gusttimo World Pte Ltd* [2015] 2 SLR 825 (“*Han’s*”) that it may be doubtful that the average consumer would make constant reference to a long phrase every time he refers to it, I am still of the view that the marks are more dissimilar than similar aurally. In coming to this decision, I consider that from the aural perspective, the dominant and distinctive element in the Subject Mark is the textual component “Royal County of Berkshire”. This is so for several reasons:

- (a) In terms of size of the words, the words “Royal County of Berkshire” are not so small that they will not be articulated by the consumer or be regarded as subsidiary as was found in *Han’s* in relation to the words “Cuisine of Naniwa” relative to the word “HAN”;
- (b) In terms of position, when articulated, the words “Royal County of Berkshire” come before the words “POLO CLUB” and consequently, these words are less likely to be forgotten in a consumer’s imperfect recollection than the words towards the end of the phrase;
- (c) In terms of the role of the words, the words “POLO CLUB” are not particularly distinctive from the aural perspective as it does not say what the name of the polo club is.

87 As a result, whether applying the Dominant Component Approach or the Quantitative Assessment Approach, the marks are aurally more dissimilar than similar.

  
Comparison between “POLO” v “Royal County of Berkshire POLO CLUB”

88 The Applicant submits that the Word Mark is aurally similar to the Subject Mark as both marks may be referred to as “Polo”<sup>25</sup>.

89 While I agree that the Word Mark would be referred to as “Polo”, for the reasons stated at [85] and [86], I am of the view that the Subject Mark is more likely to be referred to as “Royal County of Berkshire Polo Club” or “Royal County of Berkshire” for short. Again, whether applying the Dominant Component Approach or the Quantitative Assessment Approach, the marks are aurally more dissimilar than similar.

#### *Conceptual Comparison*

90 With regard to conceptual similarity, the inquiry is to “*uncover the ideas that lie behind and inform the understanding of the mark as a whole*” (*Staywell* at [35]).


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<sup>25</sup> Applicant’s Written Submissions at [119].

91 I will deal with all 3 sets of marks together under this heading.

92 The Applicant submits that the idea connoted by the Applicant’s Earlier Marks and the Subject Mark are conceptually similar in that they all convey the idea of a game of polo and therefore, there is a substantial degree of conceptual similarity<sup>26</sup>. In support of this the Applicant relies on the decision of this tribunal in *The Polo/Lauren Company, L.P. v United States Polo Association* [2015] SGIPOS 10 (“USPA”) where the IP Adjudicator found that



the double horseman mark, “” was conceptually identical to the Applicant’s Device Mark as both conveyed the idea of the game of polo.

93 While I agree with the Applicant that the Applicant’s Earlier Marks convey the idea of a game of polo, I do not agree that this is the idea connoted by the Subject Mark. I also do not find that *USPA* assists the Applicant. In *USPA*, the textual component in the mark was merely “USPA” and not “U.S. Polo Association” and no evidence was led to show that the public in Singapore was aware that “USPA” is the acronym for “U.S. Polo Association”. That being the case, it was found that the concept of an association would unlikely come to mind and the only concept conveyed by the mark was the idea of the game of polo. In this case, however, the textual components in the Subject Mark are “Royal County of Berkshire” and “POLO CLUB”. A meaningful concept is clearly conveyed by these words, namely, a name of a polo club and the place where the club is situated. This is so even if the consumer is not sure where Berkshire is located.

94 I bear in mind the Applicant’s submission that the idea of a polo club situated within a certain geographical location does not change its basic meaning, which evokes the idea of the game of polo. However, given the Court of Appeal’s exhortation in *Staywell* that 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 (*Staywell* at [35]), I do not think it would be correct for me to focus on the idea of the game of polo without considering the ideas given by the other elements of the mark. Taken together with the other elements of the mark, namely, the words “Royal County of Berkshire” and “POLO CLUB”, I am of the view that the Subject Mark evokes the idea of a place or location or, also, a particular polo club.

95 All things considered, overall, I find the marks to be conceptually more dissimilar than similar.

#### *Conclusion on Similarity of Marks*

96 I now consider whether the respective marks, “*when observed in their totality, are similar rather than dissimilar*”, noting the Court of Appeal’s rejection of the suggestion that “*any modicum of similarity would compel the court to make a finding of marks-similarity*” at [19] of *Staywell*.

<sup>26</sup> Applicant’s Written Submissions at [91], [111] and [119].




Comparison between “” v “”

97 I have found that the respective marks are (a) visually more dissimilar than similar; (b) aurally neutral; and (c) conceptually more dissimilar than similar. Overall, my finding is that the marks are more dissimilar than similar.




Comparison between “**POLO**” v “”

98 I have found earlier that the composite marks are (a) visually similar to a low degree; (b) aurally more dissimilar than similar; and (c) are conceptually more dissimilar than similar. Bearing in mind that "*trade-offs can occur between the three aspects of similarity in the marks-similarity inquiry*" ([18] of *Staywell*), and that a finding of similarity of marks can be made even though not all three aspects of similarity are established, I find that overall there is a low degree of similarity between the marks.



Comparison between “**POLO**” v “”

99 My finding earlier on this set of marks is that they are (a) visually dissimilar; (b) aurally more dissimilar than similar; and (c) conceptually more dissimilar than similar. Overall, my finding is that the marks are dissimilar rather than similar in their totality.

100 The similarity of the competing marks is a “*threshold requirement that had to be satisfied before the confusion inquiry is undertaken*” (*Staywell* at [15]). Given that the threshold requirement has been met for the Composite Mark, I will go on to consider the likelihood of confusion under Section 8(2)(b) in relation to this mark which is registered only in Class 18.

101 As for the Device Mark and the Word Mark, the threshold requirement has not been met and this is enough to dispose of the matter in favour of the Proprietor.

*Comparison of Goods*

102 The Applicant submits that there is identity and similarity of goods between the Applicant’s Earlier Marks and the Subject Mark. The identical goods are indicated in bold below:

Class 18

Specification of Goods in Applicant’s Composite Mark (Registration No. T0716552B)	Specification of Goods in Subject Mark
<b>Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and</b>	<b>Leather and imitations of leather, and goods made from these materials and not included in other classes; animal skins, hides;</b>

travelling bags; umbrellas, parasols and walking sticks.	<b>trunks and travelling bags; umbrellas, parasols and walking sticks;</b> whips, harnesses and saddlery, articles of luggage, suitcases, briefcases, tote bags, work bags, toiletry bags, waist bags, sling bags, shoe bags, school bags, overnight bags, jewellery bags (empty), gym bags, clutch bags, bags for clothes, bags made of leather, bags made of imitation leather, handbags, shoulder bags, purses, wallets, shopping bags, suit carriers, attache cases, rucksacks, holdalls, pouches [bags].
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103 The Proprietor does not dispute that there is similarity in the goods<sup>27</sup>. In my view the goods are not just similar but at least for the goods indicated in bold, they are also identical. For reasons of procedural economy, I will not undertake a full comparison of all the goods. Instead I will first assess the invalidation in relation to the items in bold which are obviously identical to those covered by the earlier trade marks. If the invalidation fails where the goods are identical, it follows that it will also fail where the goods are only similar.

*Likelihood of Confusion (with the Applicant’s Composite Mark)*

104 There are at least two types of confusion under Section 8(2)(b) of the Act. The first is where the consumer mistakes one mark for another. The second is where consumers may perceive that the contesting marks are different, but may yet remain confused as to the origin which each mark signifies, and may perceive that goods or services of both marks emanate from the same source or from sources that are economically linked or associated (see *Hai Tong* at [74]). The Court of Appeal, nonetheless, recognised at [75] that confusion in the sense of “*mere association*” is not enough. This means that “*it is not sufficient that the relevant segment of the public would recognise or recollect similarities between the contesting marks if there is no likelihood of confusion as to origin ensuing*”. Similar views were also expressed by the Court of Appeal in *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 (“*City Chain*”) at [58].

105 Further, in *Sarika*, the Court of Appeal said that the test to be adopted in determining likelihood of confusion is whether a substantial portion of the relevant public will be confused. In this regard, the Court of Appeal also said in *Sarika* (at [57]) that:

... the essence of this requirement is that there must not be an insubstantial number of the relevant public being confused. This standard is above *de minimis* and must be appreciable, though it is not necessary to show that a majority of the public is confused. It is insufficient, however, if only a “single member” of the relevant public is confused or if only a “very small and unobservant section” is confused ...

<sup>27</sup> Proprietor’s Written Submissions at [24.4].



106 In assessing the likelihood of confusion, certain ‘extraneous factors’ may be taken into account, whereas others cannot (see *Staywell* at [63]–[93]).




(i) *Factors Relating to the Impact of Marks-Similarity on Consumer Perception*

The degree of similarity of the marks

107 I have held at [98] that overall there is a low degree of similarity between the Composite Mark and the Subject Mark. This factor in the consideration of likelihood of confusion therefore lies in the Proprietor's favour – "*Clearly, the greater the similarity between the marks, the greater the likelihood of confusion*" ([96] of *Staywell*) and conversely, the lesser the similarity between the marks, the lower the likelihood of confusion.

The reputation of the marks

108 The Subject Mark has not been used in Singapore and does not appear to have a reputation in Singapore. As for the Composite Mark, I have found at [48] that there has been

no use of the Composite Mark . Even if it may be said that the Composite Mark, “ POLO ” is used in the form of the Composite Sign, “ POLO  RALPH LAUREN ” (which I very much doubt), the use is always accompanied by the highly distinctive words “Ralph Lauren” and there is no evidence to suggest that by virtue of such use, the Composite Mark on its own, without the words “Ralph Lauren”, have acquired a reputation.

109 The Applicant submits that the fact that there are no less than 51 marks which contain or consist of the word “Polo” and/or a polo player device is evidence that the word “Polo” and the polo player device are truly essential features of the Applicant’s Marks and indispensable components of the Applicant’s family of marks. As a result, members of the public in Singapore have come to associate marks containing such features with the Applicant and no other<sup>28</sup>.

110 I cannot agree with the Applicant that the mere fact that the Applicant has many registrations on the Register with the word “Polo” and/or a polo player device goes to show that consumers associate these components with the Applicant. It is the Applicant’s use in trade that matters and which is capable of having an effect on consumer perception.

111 Nevertheless, even if I take into account the Applicant’s use in trade of a variety of marks containing the word “Polo” and/or a polo player device, there is nothing in the evidence to suggest that by virtue of such use, customers have come to associate marks containing such features with the Applicant and no other. Without evidence that this has occurred, I cannot make such a finding, especially in light of the evidence that the use is almost always accompanied by the highly distinctive words “Ralph Lauren”.

112 In any event, the authorities are clear that “mere association” in itself is not a sufficient basis for concluding that there is a likelihood of confusion. The Court of Appeal said in *Hai Tong* at [75]:

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<sup>28</sup> Applicant’s Written Submissions at [11].

However, the “mere association” by the relevant segment of the public of the earlier registered mark with the later allegedly infringing sign based on their similar use is not *in itself* a sufficient basis for concluding that there is a likelihood of confusion in the absence of any possibility of misapprehension as to the *origin* of the goods or services concerned (see *City Chain* ([17] *supra*) at [58]). Put another way, it is not sufficient that the relevant segment of the public would recognise or recollect similarities between the contesting marks if there is no likelihood of confusion as to origin ensuing.

113 This factor is therefore neutral. It does not increase the likelihood of confusion or reduce it.

The impression given by the marks and the possibility of imperfect recollection of the marks

114 The Applicant submits that the dominant feature of the Subject Mark is the polo player device and as such the impression given by both marks is that they originate from the same source or at the very least are somewhat related<sup>29</sup>.

115 However, given my finding:

- (a) At [51] that the distinctiveness of the Composite Mark is of a normal level;
- (b) At [65] that the polo player device is not the dominant feature in the Subject Mark (there being no dominant feature); and
- (c) At [94] that the Subject Mark as a whole (which includes the words “Royal County of Berkshire” and “POLO CLUB”) evokes the idea of a place or a location or, also, a particular polo club;

I am of the view that there is insufficient basis to find that imperfect recollection of the marks gives rise to a likelihood of confusion.

*Factors Relating to the Impact of Goods-Similarity on Consumer Perception*

The normal way in, or the circumstances under, which consumers would purchase goods of that type

116 Generally, the goods concerned here (such as handbag, briefcase, travelling bag, wallet) may be bought from brick-and-mortar shops or on the Internet.

117 When such goods are purchased from a brick-and-mortar shop, customers can themselves choose the items 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 to buy is generally made visually. Accordingly, the visual aspect plays an important role in the assessment of likelihood of confusion. However, I do not discount that aural considerations may also play a part, including as word of mouth recommendations, whether in a shop or elsewhere. Nevertheless, even when acting on a recommendation, the purchaser is unlikely to complete the selection process without sight of the goods, at which point the trade mark is likely to be visible.

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<sup>29</sup> Applicant’s Written Submissions at [102(i)].

118 If bought from the Internet, consumers would only perceive the trade marks visually. Under such circumstances, the textual content is also important as one would have to enter the text of the mark into the address bar or search engine in order to get to the desired website (*Hai Tong* at [53]). As such, the element “Royal County of Berkshire” would have a significant impact on the consumer and this reduces the likelihood of confusion.

Whether the products are expensive or inexpensive items

119 The Proprietor submits that the Applicant’s goods are (1) “*high end and pricey*” and (2) “*sold in exclusive stores located in up-market exclusive boutiques in prime shopping areas*”<sup>30</sup>. I do not accept these submissions. Firstly, there is no evidence adduced by the Proprietor in support of these contentions. Secondly, it is clear from *Staywell* that it is impermissible to consider extraneous factors relating to a trader’s superficial marketing choices.

120 Accordingly, the disparity in the price range (if any) of the goods covered by the parties’ competing marks are factors which are not inherent in the goods themselves but are the product of superficial trading choices and cannot be taken into account in the confusion inquiry. This point was very succinctly put by the learned IP Adjudicator in *USPA*, in the context of the price of eyewear, as follows:

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).

121 So what is the normal or average price of goods of this type? The Applicant submits that being non-luxury items, they are inexpensive goods as compared to houses and cars. They would require less care and attention from the average consumer, and point towards a greater likelihood of confusion.

122 In my view, goods of this type vary widely in quality and price. Whilst certainly not as expensive as houses and cars, such goods are also not so cheap that one would buy them without putting in at least some thought into the process. To my mind, when selecting items such as wallets and bags, the average consumer will pay attention to considerations such as size, style, colour, material, workmanship and cost. Overall, the average consumer is likely to pay a medium degree of attention to the selection of goods of this type and therefore, more likely than not, would notice the differences between the marks.

The nature of the goods and whether they would tend to command a greater or lesser degree of fastidiousness and attention on the part of prospective purchasers

123 The Applicant submits that the goods are ordinary and common. They are not luxury items and at most may only be termed as fashionable goods.

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<sup>30</sup> Proprietor’s Written Submissions at [24.3.4(e)(v)] and [24.5(c)].

124 I do not disagree with the Applicant but I do not see that these indicate that a lesser degree of fastidiousness and attention would be paid to the purchase of such goods either. In fact, to my mind, the goods being fashionable items and highly personal in nature, are not likely to be purchased in a hurry. I think that at least a medium level of attention would be paid to ensure that the goods meet the user's needs, for example in terms of size, colour and style. They may also entail the purchaser trying the item for suitability, inspecting the goods to see the material and checking out the compartments of the bag or luggage. In this regard, this factor again shows that consumers would, more likely than not, notice the differences between the marks.

The likely characteristics of the relevant consumers and whether they would or would not tend to apply care or have specialist knowledge in making the purchase

125 The average consumer in Singapore has been described as literate, educated, exposed to the world and unlikely to be easily hoodwinked (*McDonald's Corp v Future Enterprises Pte Ltd* [2005] 1 SLR(R) 177 at [64]).

126 Although the goods concerned are used widely across segments of the public and the consumers may not have specialist knowledge, they are nevertheless still likely to apply a sufficient level of care to ensure that they buy what they need and what they are looking for. In respect of goods in Class 9, the High Court in *USPA HC* said at [43]:

...As the [IP] Adjudicator noted, eyewear is not purchased on a regular basis. This type of goods is highly personal and is not something that would be purchased in a hurry but rather, would involve a high level of attention being paid by the consumer...eyewear is likely to be purchased on a myriad of factors including not just comfort but also its appearance, any purchase would likely entail a detailed visual inspection of the eyewear.

127 Similarly, for the goods concerned here, which are not just fashionable items but intended to serve a function as well, consumers are likely to purchase them only after visually inspecting them and, as such, are more likely than not to notice the differences between the marks.

Whether the transactions are routine or infrequent

128 The goods concerned, inter alia, handbags, briefcases, travelling bags, wallets, are not everyday purchases like consumables or daily essentials for everyday living. They are not items that are bought routinely and are more likely to be carefully selected, with consequent greater attention being paid to the trade marks used on those goods. This reduces the likelihood of confusion.

*Conclusion on Likelihood of Confusion*

129 Taking all the above factors into account, I find that even allowing for the identity of the goods and taking into account the doctrine of imperfect recollection, the fact that:

- (a) there is only a low degree of similarity between the marks;
- (b) a medium level of attention will be paid by consumers when purchasing such goods; and

- (c) goods of this type are usually bought after a visual inspection of the goods or from the Internet;

there is no likelihood of confusion arising, whether it be confusion as to origin from the same source or confusion as to the origins of goods bearing the respective marks being economically linked. Even if there is some possibility of initial interest confusion between the marks, it is clear from *Staywell* at [116] that initial interest confusion does not constitute confusion for the purpose of Section 8(2) of the Act. This element is thus not made out and the ground of invalidation under the Similarity Ground therefore fails.

### **Ground of Invalidation under the Well Known and Damaging Interest Ground**

130 Section 8(4)(a) read with 8(4)(b)(i) of the Act reads:

**8.—(4)** Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark shall not be registered if —

- (a) the earlier trade mark is well known in Singapore; and

- (b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —

- (i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark...

### ***Decision on ground of invalidation under the Well Known and Damaging Interest Ground***

131 Under this ground, the Applicant has the burden of establishing the following:

- (a) The whole or essential part of the Subject Mark is identical with or similar to the Applicant's earlier trade mark;
- (b) The Applicant's earlier trade mark is well known in Singapore;
- (c) Use of the Subject Mark in relation to the goods claimed would indicate a connection with the Applicant; and
- (d) Use of the Subject Mark is likely to damage the Applicant's interests.


132 The earlier trade marks relied upon under this ground are the same as those relied upon for the ground of invalidation under the Similarity Ground.

### ***Similarity of Marks***


133 The High Court in *Rovio* (at [146]) held that there was no difference between the similarity of marks comparison in Section 8(2)(b) and Section 8(4) of the Act. I have dealt with the issue of marks-similarity earlier under Section 8(2)(b) and found as follows: (a) in respect of the Device Mark and the Word Mark, they are more dissimilar than similar to the Subject Mark; and (b) in respect of the Composite Mark, there is a low degree of similarity to the Subject Mark.

134 The inquiry therefore ends here in respect of the Device Mark and the Word Mark, and I will proceed to analyse the other elements under this ground in respect of the Composite Mark.

*Whether the Applicant's Composite Mark is Well Known in Singapore*

135 For the avoidance of doubt, the issue here is not whether the Applicant's Composite Sign, “” is well known in Singapore but whether the Composite Mark,

 “**POLO**”, is.

136 Given my finding earlier at [48] that the evidence does not show any use of the Composite Mark but only, at best, use of “”, I have difficulty finding that it is only the Composite Mark on its own that is well known to the relevant sector of the public in Singapore. This is simply not borne out by the evidence.

137 Having found (on the evidence adduced by the Applicant) that the Applicant's Composite Mark is not well known in Singapore, technically, I need not go on to consider whether the use of the Subject Mark in relation to the Subject Goods would indicate a connection between those goods and the Applicant, and is likely to damage the interests of the Applicant. However, in case I am wrong, I will proceed to consider the next element.

*Confusing Connection*

138 In relation to this element, it has been settled by the Court of Appeal in *Sarika* at [76]-[77], that implicit in this requirement is that a likelihood of confusion must be shown in relation to the connection between the goods of the Proprietor and the Applicant.

139 I have concluded at [129] that there is no reasonable likelihood of confusion arising in this case. For the same reasons that led me to arrive at that conclusion, I am of the view that a confusing connection has not been established by the Applicant.

140 Thus even if I am wrong in finding that the Composite Mark is not well known in Singapore, this ground would still fail on the basis that a confusing connection is not made out.

*Conclusion on ground of invalidation under Well Known and Damaging Interest Ground*

141 The ground of invalidation under the Well Known and Damaging Interest Ground therefore fails.

**Ground of Invalidation under the Passing Off Ground**

142 Section 8(7)(a) of the Act reads:

A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented —

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade.

...

### ***Decision on the Passing Off Ground***

143 The Court of Appeal in *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] SGCA 33 (“*Singsung*”) set out the legal framework for the tort of passing off at [26]-[28] as follows:

26 The basic principle undergirding the law of passing off is that a trader should not sell his or her goods on the pretext that they are the goods of another trader. There are two oft-quoted formulations of the tort of passing off. The first is found in Lord Diplock’s speech in *Erven Warnink Besloten Vennootschap and another v J Townend & Sons (Hull) Ltd and another* [1979] 1 AC 731 (“*Advocaat*”) at 742 where Lord Diplock stated five characteristics of a cause of action in passing off, namely: (1) a misrepresentation (2) made by a trader in the course of trade, (3) to prospective customers of his or ultimate consumers of goods or services supplied by him, (4) which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable consequence) and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a quia timet action) will probably do so.

27 The second formulation is the “classical trinity” stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd v Borden Inc and others* [1990] WLR 491 (“*JIF Lemon*”) at 499:

... The law of passing off can be summarised in one short general proposition – no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying “get-up” (whether this consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. Whether the public is aware of the plaintiff’s identity as the manufacturer or supplier of the goods or services is immaterial, as long as they are identified with a particular source which is in fact the plaintiff. ... Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.

28 Both Lord Diplock’s five characteristics in *Advocaat* and Lord Oliver’s reformulation in *JIF Lemon* have found expression in the judgments of our courts

(see, for example, *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 (“*Novelty*”) at [36]). It has been suggested in a number of cases that there is no difference between these formulations, and that the main elements of the tort of passing off are encapsulated in the classical trinity of goodwill, misrepresentation and damage (see for example, *Novelty* at [37] and *Nation Fittings (M) Sdn Bhd v Oystertec plc and another suit* [2006] 1 SLR(R) 712 (“*Nation Fittings*”) at [148]). We accept this, by and large, as the correct position. However, we also agree with Prof Wadlow’s view that Lord Diplock’s five characteristics, focusing as they do on the issue of misrepresentation and damage, “probes more deeply into the inwardness of the tort” (Christopher Wadlow, *The Law of Passing-Off: Unfair Competition by Misrepresentation* (Sweet & Maxwell, 4th Ed, 2011) (“*Wadlow on Passing Off*”) at para 1–027). The essence of passing off – that no person is permitted to steal another’s trade *by deceit* – must not be forgotten. What the tort seeks to protect is not the plaintiff’s use of a mark, name or get-up *per se*; rather, the tort seeks to prevent the defendant from causing damage to the plaintiff by committing an actionable misrepresentation.

144 With the above in mind, I examine the elements of passing off in turn.

#### *Goodwill*

145 The Court of Appeal in *Singsung* clarified the nature of goodwill at [33]-[34] as follows:

33 The goodwill relevant to a passing off action is not goodwill in the mark, logo or get-up (*CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975 (“*CDL Hotels*”) at [45]). Instead, the tort of passing off protects a trader’s *relationship* with his customers. As was stated by Lord Parker of Waddington in *AG Spalding & Bros v A W Gamage Ld* (1915) 32 RPC 273 at 284:

There appears to be considerable diversity of opinion as to the nature of the right, the invasion of which is the subject of what are known as passing off actions. The more general opinion appears to be that the right is a right of property. This view naturally demands an answer to the question – property in what? Some authorities say property in the mark, name, or get-up improperly used by the defendant. Others say, property in the business or goodwill likely to be injured by the misrepresentation. Lord Herschell in *Reddaway v Banham* (LR (1906) AC 139) expressly dissents from the former view; and if the right invaded is a right of property at all, there are, I think strong reasons for preferring the latter view. ...

34 In our judgment, goodwill, in the context of passing off, is concerned with goodwill in the business *as a whole*, and not specifically in its constituent elements, such as the mark, logo or get-up that it uses (see *Lifestyle 1.99 Pte Ltd v S\$1.99 Pte Ltd (trading as ONE.99 SHOP)* [2000] 1 SLR(R) 687 (“*Lifestyle 1.99*”) at [20]–[24]; *Wadlow on Passing Off* at paras 3–003 and 3–004; James Mellor QC *et al*, *Kerly’s Law of Trade Marks and Trade Names* (Sweet & Maxwell, 15th Ed, 2011) (“*Kerly’s Law of Trade Marks and Trade Names*”) at para 18–100). Goodwill does not exist on its own, but attaches to a business in the jurisdiction and is manifested in the custom that the business enjoys: *CDL Hotels* at [46]. Goodwill may be proved by evidence of



sales or of expenses incurred in promoting the goods and services in association with the mark, brand or get-up which they bear (see *SPGA* at [22]).

146 There is no dispute that the Applicant operates a business and no real dispute that the business has acquired sufficient goodwill to justify protection under the law of passing off. The issue between the parties is whether a polo player device and/or the word “POLO” is distinctive of that business.


### *Misrepresentation*

147 There are 2 essential components in the element of misrepresentation: a misrepresentation made by the Proprietor, and confusion or likelihood of confusion caused by this misrepresentation (see also *Law of Intellectual Property of Singapore (Sweet & Maxwell, 2014 Rev Ed)* by Professor Ng-Loy Wee Loon (“*Law of Intellectual Property of Singapore*”) at [18.0.1]).


148 The Court of Appeal in *Singsung* also clarified at [38] that an actionable misrepresentation mandates the threshold requirement that the Applicant’s mark or getup must be distinctive.

38 In our judgment, the issue of distinctiveness is best understood as a threshold inquiry in the context of determining whether the defendant has committed an actionable misrepresentation. **Simply put, if a mark or get-up is not distinctive of the plaintiff’s products or services, the mere fact that the defendant has used something similar or even identical in marketing and selling its products or services would not amount to a misrepresentation that the defendant’s products or services are the plaintiff’s or are economically linked to the plaintiff...**

(Emphasis mine)

149 I have examined the Applicant’s evidence of use earlier in the context of acquired distinctiveness. I have no doubt that it shows that the Composite Sign “ ” is distinctive of the Applicant. But this would not assist the Applicant as the Subject Mark



“ ” is not similar to the Composite Sign.

150 Perhaps recognising this difficulty, the Applicant submits that the Word Mark and the Device Mark are essential features of the Applicant’s Marks, and are distinctive of the Applicant’s goods and no other<sup>31</sup>. However, based on the evidence before me and my findings as follows:

- (a) While there appears to have been some use of the Word Mark and/or the Device Mark per se<sup>32</sup>, the extent of this type of use is not clear. The volume of sales and promotional figures I have relate to all of the Applicant’s Marks;

<sup>31</sup> Applicant’s Rebuttal Submissions at [55].

<sup>32</sup> The word “Polo” being used on shoes (see [45(c)]) and the polo player device being used on the chest area of clothing (see [45(e)]).

- (b) The bulk of the evidence shows usage of the Word Mark and/or the Device Mark together with the highly distinctive words “Ralph Lauren”;
- (c) The level of distinctiveness of the Word Mark and/or the Device Mark<sup>33</sup>, is not so high that one is likely to assume that a mark containing such elements must necessarily come from the Applicant or an entity related to it; and
- (d) Bearing in mind that average consumers tend to regard trade marks as wholes and do not usually analyse their various details, it is less likely that use of the Word Mark and/or the Device Mark as part of an element of the Applicant’s Marks would have made an impression on consumers that was independent of the impression created by the Applicant’s Marks as a whole;

I am unable to come to this conclusion.

151 Even if I am wrong on this, misrepresentation must give rise to a likelihood of confusion before it is actionable. In this regard, I have earlier considered the likelihood of confusion arising from the use of the Applicant’s Composite Mark and the Subject Mark and found it unlikely (at [129]). Given that I do not even find similarity between the Subject Mark and the Word Mark (at [99]) or the Subject Mark and the Device Mark (at [97]), the likelihood of confusion arising from the Word Mark or Device Mark is even more remote.

152 Finally, I remind myself that it is not sufficient for passing off purposes to show that some members of the public might wonder whether the Subject Mark is connected with the Applicant. A substantial number must be likely to assume that there is such a connection before there can be passing off. I am not persuaded that there is any such likelihood in this case.

153 As misrepresentation has not been established, and misrepresentation is an essential component of the tort of passing off, it follows that the Applicant’s claim for passing off must fail.

*Conclusion on ground of invalidation under the Passing Off Ground*

154 The ground of invalidation under the Passing Off Ground fails.

**Conclusion**

155 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the present application for a declaration of invalidity fails on all grounds. The Proprietor is entitled to costs to be taxed, if not agreed.

Date of Issue: 14 December 2017

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<sup>33</sup> Extremely low in respect of the Word Mark for “polo shirts” and “t-shirts” but normal for all other goods in Classes 9, 18 and 25, and normal in respect of the Device Mark (see [30]).