


Intellectual Property Office of Singapore

Case Summary: The Polo/Lauren Company, L.P. v Royal County of Berkshire Polo Club Ltd [2017] SGIPOS [19]

Source: <https://www.ipos.gov.sg/resources/hearing-mediation>

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This case concerns the trade mark “  ” (“the Mark”) registered in the name of Royal County of Berkshire Polo Club Ltd (“the Proprietor”) since 20 October 2011 in respect of:

Class No.	Goods
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 Goods”).

The Polo/Lauren Company, L.P (“the Applicant”) applied on 30 December 2013 for the Mark to be declared invalid on the grounds, among other things, that the Mark is confusingly similar to its earlier trade marks:

Applicant’s Earlier Trade Marks	Registered in Class
 (“the Device Mark”)	9, 18 and 25
 POLO (“the Composite Mark”)	18
POLO (“the Word Mark”)	9, 18 and 25


The Registrar was of the view that the words “Royal County of Berkshire” and “Polo Club” were not negligible components in the Mark and the comparison of the marks cannot be on the basis of the polo player device and/or the word “Polo” alone. As for the earlier trade marks, the Registrar found that the distinctiveness of the Word Mark was extremely low in respect of the “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 as well as the Composite Mark.

In light of the above, the Registrar concluded that the Device Mark and the Word Mark were both more dissimilar than similar to the Subject Mark. As for the Composite Mark, the Registrar found that there

was a low degree of similarity and that there was identity between the goods. However, the claim failed because there would not be a likelihood of confusion.

One of the key contentions of the Applicant in this case is that the word “Polo” and a polo player device are 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.

The Registrar considered the Applicant’s use in trade of a variety of marks containing the word “Polo” and/or a polo player device, and found that the evidence fell short of showing that consumers identified these elements alone with the Applicant. The Registrar found that the evidence showed very little use by the Applicant of the Word Mark and the Device Mark on their own. Furthermore, the effect of such use on the members of the public was not clear from the evidence. The bulk of the evidence showed that the Applicant has been using the Word Mark and the Device Mark in conjunction with the words

“Ralph Lauren”, such as, in “ ” but given the distinctiveness of the words “Ralph Lauren”, the Registrar was unable to conclude that it was only the Word Mark and/or the Device Mark that consumers relied on to identify the Applicant’s goods.

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