

The Polo/Lauren Company L.P. v United States Polo Association
[2002] SGHC 10

Case Number : OM 600025/2001, NM 600110/2001, 600131/2001, 600144/2001: OM 600026/2001, NM 600132/2001, 600145/2001

Decision Date : 18 January 2002

Tribunal/Court : High Court

Coram : Choo Han Teck JC

Counsel Name(s) : Sukumar Karupiah, Deborah Menon and Vicki Heng (Ella Cheong & G Mirandah) for the opponent/appellant; Chow Kin Wah and Pearleen Loh (Alban Tay Mahtani & De Silva) for the applicant/respondent.

Parties : The Polo/Lauren Company L.P. — United States Polo Association

Trade Marks and Trade Names – Registration – Application to set aside – Considerations in determining whether mark will cause confusion – Likelihood of deception or confusion – Distinction between the two marks – ss 15 & 23 Trade Marks Act (Cap 332, 1992 Ed)

Judgment

GROUND OF DECISION

1. The two Originating Motions were applications by the opponent to set aside the registration of the applicant's marks. The opponent is the registered owner of a trademark polo player and is a well known company producing various products, notably, fragrances and clothing, all of which carry their trademark polo player on horseback, and sometimes in combination with the words "*Ralph Lauren*" or "*Polo Ralph Lauren*". The applicant is the *United States Polo Association* which had ventured into consumer products such as luggage and clothing. It is the sole governing body of the sport of polo in North America (including Canada). It applied under Class 18 and Class 25 of the Trade Marks Act, 1992, Ch 332 to register its mark which also depicts a polo player on horseback. The main differences in the two marks are, first, the polo player on the opponent's mark appears with his polo club on the upswing, whereas the applicant's mark shows the player with his polo club on the low swing. Secondly, the applicant's mark has the letters "*USPA*" beneath the mark. The opponent's logo is just a motif without lettering. The Assistant Registrar of Trademarks allowed the applications and the opponent applied by these Originating Motions to set aside the registrations.

2. There is no dispute that the governing statutory provisions are ss 15 and 23 of the 1992 Act which provide as follows:

"15. (1) It shall not be lawful to register as a trademark or part of a trade mark any matter the use of which would, by reason of its being *likely to deceive or cause confusion* or otherwise, be entitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

...

"23. (1) Except as provided by section 25, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly *resembles a trade mark belonging to a different proprietor and already on the register* in respect -

(a) the same goods;

(b) the same description of goods; or

(c) services or a description of goods which are associated with those goods or goods of that description."

3. I have taken the liberty of marking in italic form the portions of the statutory provisions above which Mr. Karuppiah, counsel for the opponent, relied upon in this appeal. Counsel also referred to various case-law authorities governing the registration of such marks. Many of these authorities had been the reference points in the decision of the assistant registrar. Mr. Chow, counsel for the applicant also does not quarrel with the authorities relied upon by Mr. Karuppiah and the assistant registrar; so it seems that the law is sufficiently clear. The contention of Mr. Karuppiah was chiefly on what he submitted to be an erroneous application of those principles. From the judgment of Lord Upjohn in *Bali TM* [1969] RPC 472, 496 the following general principles were favourably received in the House of Lords. First, citing Morton J in *Hack's Trade Mark* (1940) 58 RPC 91, that "the question whether a particular mark is calculated to deceive or cause confusion is not the same as the question whether the use of the mark will lead to passing off". Secondly, citing Evershed J in *Jellinek's Trade Mark* (1946) 63 RPC 59, that it was "sufficient if the result of the registration of the trade mark will be that a substantial number of persons will be caused to wonder whether it might not be the case the two products come from the same source. It is enough if the ordinary person entertains a reasonable doubt". Evershed J continued with the important words, "the court has to be satisfied not merely that there is a possibility of confusion: it must be satisfied that there is a real tangible danger of confusion if the mark which it sought to register is put on the register". Thirdly, accepting that the application of the test was "necessarily a question of fact and degree in every case". In that case, the House of Lords agreed with the decision of the registrar and the High Court that the registration of the "*BALI*" mark by an American brassiere company was likely to cause confusion among the public with another brassiere name, "Berlei" on the ground that "phonetically there is a likelihood of deception or confusion".

4. The basic principle, enunciated in *Kellogg Co v Pacific Food Product Sdn Bhd* [1999] 2 SLR 651, 660 states that the "comparison of the earlier and proposed marks must be assessed taking into account the actual way and manner that the marks are used, and surrounding circumstances such as the similarities between marks and goods on which they are applied". Thus, one well-known textbook authority had this to say (and the passage which I am about to set out was specifically relied upon by the assistant registrar below, but which Mr. Karuppiah says was wrongly applied by her). This is a passage from the 12th edition of *Kerly's Law Of Trade Marks And Trade Names*, 17-08:

"Two marks, when placed side by side, may exhibit many and various differences, yet the main idea left on the mind by both may be the same. A person acquainted with one mark, and not having the two side by side for comparison, might well be deceived, if the goods were allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same mark as that with which he was acquainted. Thus, for example, a mark may represent a game of football; another mark may show players in a different dress, and in very different positions, and yet the idea conveyed by each might be simply a game of football. It would be too much to expect that person s dealing with trade-marked goods, and relying, as they recently do, upon marks, should be able to remember the exact details of the marks upon the goods with which they are in the habit of dealing. Marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole. Moreover, variations in details might well be supposed by customers to have been made by the owners of the trade mark they are already acquainted

with for reasons of their own."

5. Mr. Karuppiyah submitted that the assistant registrar erred in applying the law to the facts, and one of his grounds was that the assistant registrar's reliance on *Australian Law Of Trade Marks And Passing Off* by D.R. Shanahan was wrong. The relevant passage states:

"Where a trade mark combines a device with a word, customers will more naturally refer to the word when ordering the product. Thus similarities between the verbal features of two marks may give rise to confusion, notwithstanding that the accompanying devices are entirely dissimilar. Where on the other hand, the verbal features can be readily distinguished, this may greatly reduce the risk of confusion through similarities in other features of the marks."

Mr. Karuppiyah submitted that the assistant registrar's error lay in the comparison of two different marks - one, a composite mark with a device and the letters "USPA" and the other just a device (of a polo player on horseback). His argument was, essentially, that one must compare like with like and, in this case, unlike *Celine's Trade Mark* [1985] RPC 381, only the applicant's mark is a composite mark. I am unable to agree with this view simply because one is not always comparing like with like in any given dispute; the comparison will be between the two opposing marks and whether both marks are composite or not is just one factor to be taken into account. Mr. Karuppiyah further argued that the test should not be carried out by placing the two devices side by side for comparison. Instead, he submitted that what the assistant registrar ought to have done was to look only at the applicant's mark and ask whether that might be confused with the opponent's mark. That is an attractive argument in itself and may be a useful approach especially if the judge is familiar with the product against which the other is being compared, but I do not think that there is anything inherently wrong with the approach taken by the assistant registrar in this case. In any judicial proceedings it will be necessary for the judge testing alleged similarities between different articles to make a comparison. The assistant registrar's approach is more likely the rule than the exception, and is what I would, myself, prefer to adopt. Mr. Karuppiyah also submitted that the assistant registrar placed undue significance to the letters "USPA" on the applicant's mark. He argued that these letters were insignificant and an ordinary purchaser is unlikely to know what they stand for or mean. I will revert to this point shortly.

6. In response, Mr. Chow for the applicant pointed out that the applicant had been selling their products with the disputed mark since 1996 with no objection from the opponent. He raised the figures of the applicant's annual turnover (without challenge from Mr. Karuppiyah). The figures were reasonably large. The turnover from April 1996 to March 1997 was S\$1,111,305.95. Relying on *The Pianotist* [1906] RPC 774 and the *Kellogg* case, Mr. Chow emphasized the established principle that the issue of the likelihood of deception and confusion ought to be determined by taking into account the actual use of the mark, the idea behind the marks, the similarity of the marks, and the similarities of the goods that are being plied with the marks. Turning to the use of the mark Mr. Chow drew support from the *Solavoid Trade Mark* [1977] RPC 1 citing Lord Fraser's opinion as to why he thought that the public would be unlikely to be confused between the *Solavoid* sunglasses and the well known *Polaroid* sunglasses, a view formed essentially on the common fact that retailers display sunglasses of all makes together for the browsing and buying public to examine at their leisure. So it is with the products in this case, as Mr. Chow submitted, that the clothing are displayed for examination by shoppers who normally do not make their purchase without examining and, where possible, fitting the item. He says that the size of the garment and the name of the manufacture are clearly found on the labels of the clothing. To this, Mr. Chow added that the products of the applicant and opponent are sold exclusively in their own respective boutiques, the opponent's appearing more exclusive in the sense of being on the higher end of luxury goods, and so far as the applicant's goods are concerned,

they are sold by their own staff and not by the staff of emporiums or departmental stores where their boutiques may be found. These are unchallenged depositions set out in the affidavit of Merle Jenkins, the President of *USPA Properties*, a subsidiary of the applicant, who also said that the applicant's goods are not sold in any other way. I think that there can be no dispute that such evidence ought to be considered and due weight to be given to them in coming to the ultimate conclusion as to whether the applicant mark was sufficiently similar and likely to cause deception or confusion.

7. Finally, Mr. Karuppiyah submitted that the burden of proof was on the applicant to show that their mark was not calculated to deceive or confuse consumers and since there was no independent evidence from members of the public the applicant has failed to discharge that burden. I think that public opinion polls, if properly conducted, can be extremely helpful, and in some cases they may even be the pivotal evidence, but it is not a critical requirement to have such evidence in every case. It is only an evidential requirement and the absence or inadequacy of such evidence only means that the court will have to examine the other evidence, and its own examination of the marks, to see if the question (of deception and confusion) can be answered. Against this technical legal background one must take cognizance of the fact that the applicant has been using their mark since 1996 with reasonable success without objection of any kind from the opponent and the absence of evidence of confusion, though the evidential burden lay on the applicant, merely underlines the actual state of evidence in this case, that there is no evidence of deception or confusion. It is only one part of the entire frame that must be examined before the complete picture may be seen. I say this to dispel any notion that the absence of evidence of confusion is fatal to the applicant. The absence of such evidence, no matter whose burden it was to adduce, is not entirely to be ignored. The court is entitled to take into account that there was no evidence of confusion and give it such weight as it deems fit in the overall assessment of the case.

8. I will now address one other point on evidence raised by the opponent. It was submitted on their behalf that the assistant registrar was wrong to form the conclusion that when the clarity of the marks is lost in the embroidery on clothing products then the letters *USPA* will assume greater prominence in the mark as a whole. Mr. Karuppiyah referred to the unreported case of *The Royal County of Berkshire Polo Club* (applications No. 2106096 and 2119787), which concerned a dispute between the opponent and The Royal County of Berkshire Polo Club and drew my attention to a passage in the grounds of decision there in which the registrar there held:

"My initial impression was that these marks are not confusingly similar. However after seeing the photographs of the respective marks applied to a T-shirt and sweatshirt, I find it quite easy to see how these marks could be confused. Once applied to garments the similarities between the polo player device and the presence of the words arranged in a roundel, are much more striking than the differences between (some of) the words. In the case of the applicant's mark, the words are not easy to absorb because of their smaller size relative to the polo player device, the angle of some of the words, and the fact that some of the words are slightly less distinct when applied to a garment. From a normal viewing distance the marks create such a similar overall impression that one has to look closely to see which mark is which, even when they are side by side (which they will not always be)"

It is important to point out straightaway that the above remarks were applied to marks that are quite different from the disputed marks before me. In our present case, only the applicant's mark has letters as part of the composite mark. The opponent has a strictly pictorial device. This difference, in my view, is sufficient to draw a clear distinction between the two marks. Furthermore, in the *Royal County of Berkshire* case the registrar compared the marks as seen on photographs produced before

him. In the present case, both parties produced before me the actual clothing with their respective marks. Looking at the items as an ordinary shopper would, it seems to me that the letters *USPA* come through very distinctly even in the embroidered form, and thus I was not troubled in this regard as the registrar was in the *Royal County of Berkshire Polo Club* case. But more importantly, as was pointed out by Mr. Chow, that case two marks were being challenged by Ralph Lauren. One (discussed above and dwelled with by Karuppiyah) was successful, the other was not. In my view, the one that was not successful was much more pertinent to the present case before me. The second involved the comparison of the two competing device of a polo player on horseback and the registrar was not convinced that there was sufficient similarity as to cause confusion. I make no criticism of Mr. Karuppiyah whatsoever for dwelling on the first mark because he was obviously taking pains to press a point of general application; but in the light of what I have stated above, I am unable to agree with the views he proffered.

9. Reverting to the present marks, I think that it may be fair to assume that a person familiar with Ralph Lauren products may, in a quick and hurried moment, wonder if the applicant's device is that of the opponent's, but this would not be a fair application of the test in the light of the authorities that I have considered above. The test must be applied not just to people with a particular knowledge of a specific mark or any one individual however discerning or otherwise a shopper he might be, but to "a substantial number of persons of ordinary care and intelligence" *per* Lai Kew Chai J in the *Kellogg* case at page 659. To that I feel obliged to state the obvious that the test is considered in the context of such persons having a reasonable time to observe the mark and pay a modicum of attention to what they do. By reasonable time I do not mean to suggest an inordinately long time - just time enough. I do not think that I need to expand on this concept of reasonable time to a shopper. We are not here concerned with the indecisive customer who ponders over an item for hours; nor with a customer in a "grab-as-much-and-as-fast-as-you-can" promotion by a store, or, the impression of, in the words of Foster J in *Morning Star Co-Operative Ltd v Daily Star* [1979] FSR 113,117 (cited with approval by Lord Denning M.R. in *Newsweek v British Broadcasting Corp* [1979] RPC 441, 447), the "moron in a hurry" because he represents confusion in unreasonable circumstances. Anyone may mistake one maker's product for that of another's if he examines the product in a flash; but a common and ordinary consumer can reasonably be expected to spend a modicum of attention and reflect on what he is examining, at least for a moment that is longer than "in a flash", or, as Lord Denning stated in the *Newsweek* case, "the test is whether the ordinary, sensible members of the public would be confused. It is not sufficient that the only confusion would be to a very small, unobservant section of the society". In the context of the present case, and taking into account the marks, the labels on the goods that carry the marks, the nature of the goods and how they are actually sold, I am of the view that the applicant's mark is not calculated to deceive or cause confusion within the meaning of s 15 of the Act, nor is there any sufficient ground to reject it under s 23 of the same Act because I hold the view that the applicant's mark is not sufficiently similar as to cause confusion; and furthermore, the nature and circumstances in which the mark is used is unlikely to lead to confusion with that of the opponent's.

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

to mistake one for the other. So, having explored the very comprehensive arguments of counsel on both sides, I have arrived at the same conclusion as the assistant registrar.

11. For the above reasons I dismiss both motions by the opponent and order that costs to be taxed if not agreed between the parties. I would like to record my appreciation to both Mr. Karuppiah and Mr. Chow for their clear, concise, and able submissions which have been very helpful to me.

Sgd:

Choo Han Teck
Judicial Commissioner

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