

**IN THE MATTER OF AN OPPOSITION
by Polo Ralph Lauren Corporation to applica-
tion No. 629,985 for the trade-mark U.S. POLO
ASS'N filed by United States Polo Association**

On April 18, 1989, the applicant, United States Polo Association, filed an application to register the trade-mark U.S. POLO ASS'N based on proposed use in Canada with the following wares:

**men's, women's and children's wearing apparel
namely, pants, shirts, shorts, skirts, blouses,
coats, T-shirts, jackets, sweaters and jogging
wear namely, sweat-shirts, sweat-pants, sweat-
shorts and fleece-lined jackets.**

The application was amended to include a disclaimer to the words U.S. POLO and was subsequently advertised for opposition purposes on February 7, 1990.

The opponent, Polo Ralph Lauren Corporation, filed a statement of opposition on May 31, 1991, a copy of which was forwarded to the applicant on June 27, 1991. The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the opponent's trade-marks POLO, POLO BY RALPH LAUREN, Polo Player Design (illustrated below) and RALPH LAUREN & Design (illustrated below) registered under Nos. 312,324; 314,406; 314,256 and 318,560 respectively for various clothing items.

Registration No. 314,256

Registration No. 318,560

The second ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3) of the Act because, as of the applicant's filing date, the applied for trade-mark was confusing with the opponent's three registered trade-marks POLO, POLO BY RALPH LAUREN and RALPH LAUREN & Design noted above and the trade-mark POLO RALPH LAUREN & Design all previously used in Canada by the opponent in association with articles of clothing and accessories.

The third ground is that the applicant's application does not comply with the provisions of Section 30(e) of the Act. The fourth ground is that the applied for trade-mark is not distinctive in view of the use of the opponent's marks by itself and its registered users and in view of use of certain marks by Triton Industries Inc.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavits of Victor Cohen, Michael Belcourt and John P. MacKay. As its evidence, the applicant filed the affidavit of Jan Ickovic. Only the opponent filed a written argument and an oral hearing was conducted at which both parties were represented.

As for the first ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

The most pertinent of the opponent's four registered trade-marks is POLO registered under No. 312,324 for "slacks, belts, bathrobes, hats, handkerchiefs, socks and shorts." Thus,

a consideration of the issue of confusion between that mark and the applicant's mark will

effectively decide the first ground of opposition.

The applicant's trade-mark is not inherently strong since it suggests that the wares are for use in conjunction with the game of polo or that they are associated with an organization called United States Polo Association. In his affidavit, Mr. Ickovic states that the applicant has licensed Triton Industries Inc. to use the applied for mark in Canada and that Triton has effected sales of clothing items in Canada in association with the applied for trade-mark in excess of \$10 million for the period 1989 to 1991. I therefore able to conclude that the applicant's mark has become known to some extent in Canada as of the material time.

The opponent's trade-mark is inherently weak since the word "polo" is used to refer to a specific type of coat and a specific type of shirt. The Belcourt affidavit establishes that the opponent's licensee has effected sales of men's clothing items in association with one or more of its four registered trade-marks in Canada in excess of \$160 million for the period 1986 to 1990. Although Mr. Belcourt is somewhat vague in his affidavit, it appears that a significant portion of those sales were of clothing items bearing the registered mark POLO. The opponent's evidence also establishes fairly significant advertising of that mark in Canada.

The applicant's agent submitted that the advertising materials appended to the Belcourt affidavit invariably associate the opponent's mark POLO with the designer Ralph Lauren and that therefore the opponent has not acquired any independent reputation for its mark POLO. I disagree. As noted by the opponent's agent, some of those advertisements refer to the mark POLO 'per se.' More importantly, many of them identify POLO as a mark of Ralph Lauren in such a fashion that consumers would likely view POLO as a brand mark and RALPH LAUREN as a house mark referring to the opponent Polo Ralph Lauren Corporation. The MacKay affidavit is also some evidence that the opponent's mark POLO has acquired an independent reputation. Thus, I am able to conclude that the opponent's mark has become known throughout Canada.

The length of time the marks have been in use favors the opponent. The wares of the

parties overlap and presumably their trades could also overlap. In fact, the Ickovic and Belcourt affidavits establish that, in some instances, the wares of the parties are purchased by the same retail department store chains. The applicant's agent submitted that the trades of the parties differ in that the opponent's wares are more "upscale" and higher in price than the applicant's. The evidence is unclear on that point and, in any event, there are no restrictions as to trade or price in the opponent's statement of wares or the applicant's statement of wares and that is what governs: see the decisions in Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R.(3d) 3 at 10-11 (F.C.A.) and Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R.(3d) 110 at 112 (F.C.A.) and pages 11-13 of the recent unreported decision of the Federal Court of Appeal in Miss Universe, Inc. v. Dale Bohna (Court No. A-841-92; November 7, 1994). If the statements of wares had such restrictions, that might have affected my conclusion respecting Sections 6(5)(c) and 6(5)(d) of the Act although the decision in Bagagerie SA v. Bagagerie Willy Ltée (1992), 45 C.P.R.(3d) 503 at 509-510 (F.C.A.) may suggest otherwise, at least with respect to any restrictions as to price.

The marks themselves bear some resemblance both visually and phonetically. In fact, the applicant has adopted the entirety of the opponent's registered mark POLO as the dominant feature of its proposed mark. The ideas suggested by the two marks are very similar, both suggesting the game of polo. This similarity is underscored by the opponent's extensive use of its registered mark Polo Player Design (No. 314,256) in conjunction with its mark POLO.

In his affidavit, Mr. Ickovic states that, notwithstanding the applicant's sales of its U.S. POLO ASS'N clothing in Canada, no instances of actual confusion between his company's mark and the opponent's marks have been brought to his attention. Although the wares of the parties are in some cases sold to the same department store chains, it is not entirely clear that the wares of the parties are sold in the same stores of those chains in the same geographical locations. Furthermore, it appears that the opponent's wares are in a different price range from those of the applicant and that the opponent's wares comprise menswear whereas the applicant's wares sold to date could have been entirely children's clothing or women's apparel.

Thus, even if the wares of the parties have, in some instances, been sold in the same stores, it seems likely that they would not have been sold in the same area of those stores. The applicant's agent himself submitted that, to date, the trades of the parties have differed. Furthermore, as submitted by the opponent's agent, there is no evidence that Mr. Ickovic made any enquiries as to actual confusion or that the applicant had implemented any reporting system for such matters. All we have is Mr. Ickovic's bare statement. Thus, I cannot give great weight to Mr. Ickovic's observation that he is unaware of any instances of actual confusion between the marks at issue.

The Ickovic affidavit evidences four third party registrations for clothing marks which include the component POLO. It appears that the applicant is relying on this state of the register evidence to mitigate the significance of any resemblance between the marks at issue. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see the opposition decision in Ports International Ltd. v. Dunlop Ltd. (1992), 41 C.P.R.(3d) 432 and the decision in Del Monte Corporation v. Welch Foods Inc. (1992), 44 C.P.R.(3d) 205 (F.C.T.D.). Also of note is the decision in Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd. (1992), 43 C.P.R.(3d) 349 (F.C.A.) which is support for the proposition that inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located.

In the present case, the applicant has only evidenced four third party registrations owned by two different companies. In the absence of evidence of use, the mere existence of four such registrations on the register is insufficient to allow me to conclude that any of those marks has been used more than minimally in the marketplace. Thus, the applicant's state of the register evidence is of no effect in the present case.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the similarities between the wares, trades and marks of the parties and

notwithstanding Mr. Ickovic's observation about the lack of instances of actual confusion, I find that I am left in a state of doubt respecting the issue of confusion between the marks at issue. Since the legal burden is on the applicant, I must resolve that doubt against it. The first ground of opposition is therefore successful and the remaining grounds need not be considered.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 30TH DAY OF NOVEMBER 1994.

**David J. Martin,
Member,
Trade Marks Opposition Board.**