

**IN THE MATTER OF AN OPPOSITION
by Polo Ralph Lauren, L.P. to application No.
557,526 for the trade-mark U.S. POLO ASS'N
& Design filed by United States Polo Association**

On February 18, 1986, the applicant, United States Polo Association, filed an application to register the trade-mark U.S. POLO ASS'N & Design (illustrated below) 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 October 8, 1986.

Polo Ralph Lauren Corporation filed a statement of opposition on November 6, 1987, a copy of which was forwarded to the applicant on November 26, 1987. On July 25, 1995, leave was requested pursuant to Rule 42 of the Trade-marks Regulations to file an amended statement of opposition to change the opponent to Polo Ralph Lauren, L.P. in view of an assignment of trade-mark rights from Polo Ralph Lauren Corporation. The applicant was given an opportunity to object to that request but did not do so. I consider that the Rule 42 request is justified and I therefore grant leave to the opponent to amend its statement of opposition to change the opponent to Polo Ralph Lauren, L.P.

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 and RALPH LAUREN & Design registered under Nos. 312,324; 314,406; 314,256 and 318,560 respectively for various clothing items. 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 four registered trade-marks 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 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 trade-mark Design of a Horse (illustrated below) previously used and made known in Canada by the opponent and the subject of a previously filed application (No. 550,265) for the following wares:

clothing namely, suits, slacks, ties, sweaters, shirts, coats, jackets, pants, jeans, shorts, blouses, tops, dresses, skirts, swimsuits, robes, socks, scarves, pyjamas, kilts, caps, mufflers, squares, collars, shawls, shoes, boots and slippers.

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 fifth ground is that the applicant's application does not comply with the provisions of Section 30(e) of the Act.

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 only the opponent was 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 two marks will effectively decide the first ground of opposition.

The applicant's trade-mark is inherently distinctive although it does suggest some connection with an organization called United States Polo Association. In his affidavit, Mr. Ickovic states that the applicant's licensee, Triton Industries Inc., has not yet sold any goods in Canada in association with the applied for mark. I must therefore conclude that the applicant's mark has not become known at all in Canada.

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. Some of the advertisements appended to the Belcourt affidavit refer to the mark POLO 'per se.' 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, L.P. or its predecessor in title, 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 evidence of both parties reveals that they both sell their wares through Canadian department stores. The marks themselves bear some resemblance visually and phonetically since the applicant's mark includes the entirety of the opponent's registered mark as its dominant feature. The ideas suggested by the two marks are very similar, both suggesting the game of polo. This similarity is underscored by the extensive use of the opponent's registered mark Polo Player Design (No. 314,256) in conjunction with its mark POLO.

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 the reputation associated with the opponent's registered mark, I am left in a state of doubt respecting the issue of confusion. Since the onus is on the applicant, I must resolve that doubt against it. Consequently, the first ground of opposition is successful insofar as it is based on the opponent's registration for its mark POLO. The remaining grounds therefore need not be considered.

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

DATED AT HULL, QUEBEC, THIS 22nd DAY OF DECEMBER 1995.

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