

**IN THE MATTER OF AN OPPOSITION
by Polo Ralph Lauren, L.P. to application No.
686,280 for the trade-mark VANCOUVER POLO
CLUB & Design filed by Vancouver Polo Club**

On July 19, 1991, the applicant, Vancouver Polo Club, filed an application to register the trade-mark VANCOUVER POLO CLUB & Design (illustrated below) based on proposed use in Canada with the following wares:

riding equipment, namely, saddles, bridles, polo wraps, saddle pads, spurs, whips and tack; polo helmets, mallets and protective equipment, namely, knee guards and elbow guards; wearing apparel, namely, shirts, t-shirts, sweaters, shorts, skirts, boots, breeches, pants, jackets, socks, caps, hats, visors, rain jackets, sports bags; souvenir items, namely, postcards, mugs, crests, badges, tit-tacks, decals, umbrellas; jewellery, namely, cuff links, rings, pendants and charms; stationery items, namely, pens, pencils, writing paper and envelopes

and with the following services:

operation of a polo club, the provision of physical facilities for the playing of polo, boarding and training horses, operating an equestrian centre for the boarding and training of horses, promoting and staging of polo tournaments, horse shows and competitive events with horses, private horse riding lessons, restaurant, bar and lounge facilities.

The application as filed contained a disclaimer to the words VANCOUVER, POLO and CLUB. The application was advertised for opposition purposes on July 1, 1992.

Polo Ralph Lauren Corporation filed a statement of opposition on September 1, 1992, a copy of which was forwarded to the applicant on March 19, 1993. On July 25, 1995, leave was requested pursuant to Rule 40 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 40 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-mark POLO registered under Nos. 312,324 and 393,743 and its trade-marks POLO BY RALPH LAUREN, Polo Player Design (illustrated below) and RALPH LAUREN & Design registered under Nos. 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 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 and with retail clothing store services.

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-marks POLO BY RALPH LAUREN, Polo Player Design, RALPH LAUREN & Design and POLO RALPH LAUREN & Design for which applications had previously been filed, the first three being applications to extend the statement of wares of existing registrations. 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.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavits of Victor Cohen, Michael Belcourt and D. Jane Mussett. As its evidence, the applicant filed an affidavit of its President, Gery Warner. Both parties 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 registered trade-marks is POLO registered under No. 312,324 for "slacks, belts, bathrobes, hats, handkerchiefs, socks and shorts" and under No. 393,743 for the following wares:

clothing, namely, suits, slacks, ties, sweaters and shirts; clothing, namely, coats, jackets, pants, jeans, shorts, blouses, tops, vests, dresses, skirts, swimsuits, robes, socks, scarves, pyjamas, mufflers, squares and shawls; footwear, namely, shoes and slippers; luggage; small leather goods, namely, belts, wallets, purses and suspenders; eyewear, namely, frames for prescription and non-prescription lenses and complete sunglasses.

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 inherently distinctive in relation to wares although it does suggest a connection with an organization called Vancouver Polo Club. The applicant's mark is descriptive of the polo club services for which registration is sought. Since the

applicant has failed to evidence any use of its mark, I must conclude that it has not become known at all in Canada.

The opponent's trade-mark POLO is inherently weak when used in association with some of the registered wares since the word "polo" is used to refer to a specific type of coat and a specific type of shirt. As for the opponent's other registered wares, the trade-mark is somewhat fanciful in that it suggests a connection with the sport of polo. The Belcourt affidavit establishes that the opponent's licensees have effected sales of men's clothing items in Canada in association with the trade-marks POLO and POLO BY RALPH LAUREN and with one or both of the trade-marks Polo Player Design and POLO RALPH LAUREN & Design in excess of \$200 million for the period 1979 to 1992. The Belcourt affidavit establishes that all of those sales were of clothing items bearing the registered mark POLO either alone or as part of composite marks.

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 Mussett affidavit is also some evidence that the opponent's mark POLO has acquired an independent reputation. Finally, both the Belcourt and the Cohen affidavits evidence the operation of retail clothing stores throughout Canada in association with the opponent's trade-mark POLO RALPH LAUREN & Design. Thus, I am able to conclude that the opponent's mark POLO has become well known throughout Canada.

The length of time the marks have been in use favors the opponent. The wares of the parties overlap since the opponent's registrations cover a wide range of clothing items and the applicant's statement of wares includes a number of items of wearing apparel. To that extent, the trades of the parties could overlap. The remaining wares in the applicant's application, namely polo equipment, souvenir items, jewellery and stationery items, differ from the

opponent's clothing wares. The polo-related services of the applicant are even more remote from the opponent's wares. Presumably, the applicant's trade related to its services and its remaining wares differs from the opponent's trade.

As for Section 6(5)(e), the marks at issue bear some resemblance visually and phonetically since the applicant's mark includes the entirety of the opponent's registered mark POLO. 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, that design mark being very similar to the design component of the applicant's proposed mark.

It is the applicant's position that any resemblance between the marks is mitigated by the common use by third parties of other trade-marks incorporating the word POLO. In this regard, Mr. Warner, in his affidavit, states that he was informed by Valerie Dorey that she was able to purchase t-shirts bearing the words POLO CLUB and ROYAL CANADIAN POLO CLUB at two different Vancouver shops and that neither item bore labels identifying the opponent. Mr. Dorey also informed Mr. Warner that she was able to obtain shirts bearing the word POLO from a Vancouver warehouse.

As submitted by the opponent's agent at the oral hearing, Ms. Dorey's statements are hearsay coming from Mr. Warner. Furthermore, they do not qualify as admissible hearsay in line with the unreported Federal Court decision in Labatt Brewing Company Limited v. Molson Breweries, A Partnership (May 28, 1996; Court No. T-646-95) because they do not satisfy the test of necessity. In other words, no indication was given as to why Ms. Dorey could not have sworn an affidavit of her own. Even if I were to consider Ms. Dorey's statements to be admissible, neither Mr. Warner nor Ms. Dorey was able to evidence the extent to which the several shirts located by Ms. Dorey have been sold in Canada. Thus, this evidence would have done little, in any event, to establish common use of POLO marks by third parties for clothing.

Mr. Warner also referred to Eddie Bauer catalogues which include references to polo shirts and “the new Eddie Bauer Polo Shirt.” Despite Mr. Warner’s assertion that those catalogues were distributed throughout British Columbia, there is no reliable evidence of record to support that assertion.

The applicant has also sought to rely on state of the register evidence introduced by the Warner affidavit. 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, Mr. Warner, in his affidavit, states that he was informed by the applicant’s trade-mark agent, Clifford W. Vermette, that Mr. Vermette’s staff did a search of the “...data base of the Department of Consumer and Corporate Affairs...” and Mr. Warner appended the results of that search as Exhibit P to his affidavit. No indication was given as to why that evidence could not have been introduced by means of an affidavit from the individual who actually conducted the search. The results of the search are double hearsay having been conducted by some unidentified person or persons who passed them on to Mr. Vermette who in turn passed them on to Mr. Warner.

A review of the search report reveals that, even if it could be admitted into evidence, it could not be given much weight. There is no indication how the search was carried out or whether the person conducting the search was experienced and knowledgeable in such matters. Furthermore, the search report provides only incomplete particulars of the entries located. In some cases, only part of the trade-mark located is reproduced. In other cases, there is an indication that the mark is a design mark but no representation of the design is

provided. In most cases, only an incomplete description of wares or services is given. There is no indication as to the basis for the application or registration located (e.g. - actual use, proposed use, use and registration abroad) and it is not clear whether any particular registration listed is current or expunged.

Even if I could discount the double hearsay aspect of the search and the various deficiencies, a review of the search reveals only a few third party registrations for trade-marks including the word POLO for clothing. The mere existence of only a few such third party registrations would not have allowed me to conclude that any of those marks was in active use. Thus, even overlooking all the deficiencies in the search report, it would not have advanced the applicant's case.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of the extent to which the opponent's registered mark POLO has become known, the fact that there is some resemblance between that mark and the applicant's mark, the fact that the opponent has also often used its Polo Player Design mark in conjunction with its mark POLO and the overlap in the wares and trades of the parties as they relate to clothing, I find that the applicant has failed to satisfy the onus on it to show that its mark is not confusing with the opponent's registered mark in respect of those particular wares. As for the remaining wares in the applicant's application and the applicant's services, they differ from the opponent's wares and, given the inherent weakness of the marks at issue, I find that the marks are not confusing in respect of the applicant's services and additional wares. Thus, the first ground of opposition is successful in part.

As for the third ground of opposition, the opponent did not specifically identify the first three applications it sought to rely on. Thus, that aspect of the third ground is not in compliance with Section 38(3)(a) of the Act and is therefore unsuccessful. The third ground therefore remains to be decided only on the basis of the opponent's previously filed application No. 589,976 for the trade-mark POLO RALPH LAUREN & Design.

The remaining grounds all turn on the issue of confusion between the applicant's mark and one or more of the opponent's marks relied on in respect of its first ground of opposition except that the third ground does not include reliance on the opponent's mark POLO 'per se.' Although those grounds are decided at earlier material times, that does not materially change the result when considering the issue of confusion between the applicant's mark and the opponent's mark POLO or, in the case of the third ground, the opponent's mark POLO RALPH LAUREN & Design. Thus, similar results follow with respect to each of those grounds.

In view of the above, I refuse the applicant's application in respect of the following wares:

wearing apparel, namely, shirts, t-shirts, sweaters, shorts, skirts, boots, breeches, pants, jackets, socks, caps, hats, visors, rain jackets, sports bags

and I otherwise reject the opponent's opposition.

DATED AT HULL, QUEBEC, THIS 1st DAY OF OCTOBER, 1996.

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