

**IN THE MATTER OF AN OPPOSITION
by Polo Ralph Lauren, L.P. to application No.
No. 557,524 for the trade-mark U.S. POLO &
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 & 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 the 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.

Considering first the third ground of opposition insofar as it refers to application No. 550,265, Exhibit E to the Cohen affidavit establishes that the opponent's predecessor in title filed that application on October 3, 1985, that date being prior to the applicant's filing date. I have examined the Trade-marks Office records respecting that application which reveal that it was pending as of the applicant's advertisement date. The third ground therefore remains to be decided on the issue of confusion between the applicant's mark U.S. POLO & Design and the opponent's mark Design of a Horse. The material time for considering the circumstances respecting the issue of confusion in this instance is the applicant's filing date in accordance with the clear wording of Section 16(3) of the Act. 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 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 has used its trade-mark in Canada through its licensee Triton Industries Inc. although he fails to provide particulars of that use. In any event, the applicant's application is based on proposed use and I must therefore conclude that its mark had not become known at all in Canada as of the material time.

The opponent's trade-mark is also inherently distinctive. 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 but it does not evidence any use of the trade-mark Design of a Horse. Mr. Cohen states, in his affidavit, that the trade-mark Design of a Horse has been used in Canada for many years but he does not provide any facts to support that conclusion. Thus, I must conclude that the opponent's mark had not become known at all in Canada as of the applicant's filing date.

The length of time the marks have been in use is not a material circumstance in the present case. 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 a high degree of visual resemblance. The dominant feature of each is a representation of a horse's head within a border. Each mark also includes what appear to be crossed polo mallets. Thus, the ideas suggested by the two marks are also similar. There may be a difference between the way the marks at issue are sounded since the applicant's mark includes the wording U.S. POLO whereas the opponent's mark includes no written matter.

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, I find that the applicant has failed to satisfy the legal burden on it to show that its trade-mark is not confusing with the opponent's previously applied for trade-mark Design of a Horse. The third ground of opposition insofar as it is based on application No. 550,265 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 22nd DAY OF DECEMBER 1995.

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