

**IN THE MATTER OF AN OPPOSITION by Polo
Ralph Lauren, L.P. to application No. 544,477 for
the trade-mark United States Polo Association &
Design filed by United States Polo Association**

On June 21, 1985, the applicant, United States Polo Association, filed an application to register the trade-mark United States Polo Association & 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 disclaims all the reading matter except for the word ASSOCIATION and was advertised for opposition purposes in the Trade-marks Journal issue dated August 27, 1986.

The original opponent, Polo Ralph Lauren Corporation, filed a statement of opposition on November 8, 1987. A copy of the statement of opposition was forwarded to the applicant on November 26, 1987. The applicant responded by filing and serving a counter statement. An amended statement of opposition was filed on or about July 26, 1995 for reason that the original opponent had assigned its rights in the marks relied on in the statement of opposition to the current opponent 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 each of 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.

regn. 314,256

regn. 318,560

The second ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16 of the Act because, as of the applicant's filing date, the applied for trade-mark was confusing with the opponent's above-mentioned registered trade-marks and with the trade-mark POLO RALPH LAUREN & Design (illustrated below) 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 opponent's trade-mark HORSE DESIGN (illustrated below) previously used in Canada by the opponent in association with articles of clothing and accessories and in respect of which application No. 550,265 had been previously filed in Canada by a predecessor in title to the opponent.

The fourth ground is that the applied for trade-mark is not distinctive in view of the opponent's use of its marks (and use by former registered user of the opponent) and in view

of use of certain marks by Triton Industries Inc. The last ground is that the applicant's application does not comply with the provisions of Section 30(e) of the Act.

The opponent's evidence consists of the affidavits of Victor Cohen, Michael Belcourt and John P. MacKay. The applicant's evidence consists of the affidavit of Jan Ickovic. Only the opponent filed a written argument, however, both parties were represented at an oral hearing.

With respect to 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 *Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers* (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). The onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. 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 relevant of the opponent's four registered trade-marks is POLO PLAYER DESIGN regn. No. 314,256. Thus, a consideration of the issue of confusion between POLO PLAYER DESIGN and the applied for mark will effectively decide the first ground of opposition.

As noted by the opponent in its written argument, the applied for mark derives its inherent distinctiveness from the combination of the depiction of a horse, a polo helmet, crossed polo mallets, a horseshoe and a reference to the name "United States Polo Association." There is no evidence that the applied for mark has acquired any reputation in Canada.

The opponent's mark POLO PLAYER DESIGN is also inherently distinctive when used in association with the opponent's wares namely, clothing. The Belcourt affidavit establishes that the opponent's former registered user (the registered user regime was

abolished as of June 9, 1993) has effected sales of men's clothing items in Canada in association with one or more of the opponent's registered marks in excess of \$160 million for the period 1986 to 1990 and that advertising expenditures for the same period were in excess of \$3.5 million. Mr. Belcourt does not provide a breakdown of sales or advertising under individual marks but he does indicate that the clothing items frequently have the POLO PLAYER DESIGN mark embroidered on them. The representative print advertisements appended as Exhibit A to Mr. Belcourt's affidavit show the opponent's various marks. The Mackay affidavit provides some further evidence that the opponent's individual marks POLO PLAYER DESIGN and POLO have become known in Canada in association with men's clothing.

The length of time the marks have been in use favours the opponent. The wares of the parties overlap and presumably their trades could also overlap. The marks themselves bear some degree of visual resemblance. In this respect, both the applied for mark and the opponent's mark POLO PLAYER DESIGN include a depiction of a horse and a polo mallet (two mallets in the applied for mark) as prominent design features. Further, the applied for mark includes the entirety of the opponent's mark POLO. The ideas suggested by the applied for mark and the opponent's registered marks POLO and POLO PLAYER DESIGN are similar namely, the sport of polo. It is also likely that consumers would incorporate the word "polo" in describing the design marks in issue.

The applicant has submitted that the significance of any resemblance between the applied for mark and the opponent's marks POLO PLAYER DESIGN and POLO is mitigated by the state of the register evidence introduced by means of the Ickovic affidavit. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R.(3d) 432 (TMOB) and *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R.(3d) 205 (F.C.T.D.). See also *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 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 does not assist the applicant's case.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. I have also taken into consideration the following passage from *Source Perrier (Societe Anonyme) v. Canada Dry Ltd.* (1982) 64 C.P.R.(2d) 116 at 121:

In view of my conclusions above, and particularly in view of the similarities between the wares, trades and marks in issue, and the extent to which the opponent's marks POLO PLAYER DESIGN and POLO have become known, I find that the applicant has failed to satisfy the legal burden on it to show that the applied for mark is not confusing with the opponent's

registered trade-mark POLO PLAYER DESIGN. The first ground of opposition is therefore successful and the remaining grounds need not be considered.

In view of the above, the applicant's application is refused.

DATED AT HULL, QUEBEC, THIS 22 DAY OF November, 1995.

**Myer Herzig,
Member,
Trade Marks Opposition Board.**