

## Newsletter

January 2018

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## *The Polo/Lauren Company L.P. v Royal County of Berkshire Polo Club Ltd [2017] SGIPOS 19*

### Facts

The Polo/Lauren Company (the "**Applicant**") sought to invalidate the Royal County of Berkshire Polo Club Ltd's (the "**Proprietor**") registration for a composite mark (the "**Proprietor's Mark**") comprising the word "Polo" and a device of a polo player in Classes 9, 18 and 25 covering goods like spectacles, leather goods and articles of clothing as follows:



The Applicant is a well-known retailer, and since 1989, it has engaged in extensive advertising conducted primarily in print media having a wide circulation in Singapore. The Applicant also offers its goods for sale via its global website at <http://www.ralphlauren.com>. The Applicant based the invalidation action on its prior use and rights in these registered trade marks (the "**Applicant's Marks**") invoking Section 23(3)(a)(k) read with Section 8(2)(b) ("**the Similarity Ground**"), Section 23(3)(a)(iii) read with Section 8(4)(b)(i) ("**the Well Known Ground**"), and Section 23(3)(b) read with Section 8(7)(a) ("**the Passing Off Ground**"):

1.  in Classes 9, 18 and 25 (the "**Device Mark**");
2. **POLO** in Classes 9, 18 and 25 (the "**Word Mark**"); and
3.  **POLO** in Class 18 (the "**Composite Mark**").

### Decision

The invalidation failed on all grounds.

The Hearing Registrar considered the level of distinctiveness in the Applicant's Marks and held that the level of distinctiveness in relation to the Applicant's goods in Classes 9, 18 and 25 was normal, but extremely low for the Word Mark in relation to "polo shirts" and "t-shirts".



The Hearing Registrar reaffirmed the necessity to compare each of the Applicant's Marks independently with the Proprietor's Mark, as opposed to relying on separately registered marks as a single composite mark.

## Similarity in Marks

Visually, she only found a very low degree of visual similarity between the Proprietor's Mark and the Applicant's Composite Mark because both marks share the word element "POLO" and the device of the polo player. The degree of similarity is nevertheless low because even with imperfect recollection, the average consumer is likely to still remember that the Proprietor's Mark is more complex and has a much longer textual component including "Royal County of Berkshire".

Aurally, she found no similarity between the Applicant's Composite Mark and Word Mark, and the Proprietor's Mark. No aural comparison could be undertaken between the Applicant's Device Mark and the Proprietor's Mark because, in her view, a device only mark has no verbal element to speak of.

She also clarified that the "device description" endorsed against all marks recorded on the Trade Marks Register is merely an administrative reference for the Singapore Registrar to describe the elements that make up a trade mark. The purpose of indicating such a description is to facilitate searches of marks from the Register. The fact that device descriptions are identical for both sets of marks has no effect on the nature of the marks or indicative of how these marks are perceived by the average consumer.

She also found no conceptual similarity between the Applicant's Marks and the Proprietor's Mark. She agreed that the Applicant's Marks conveyed the idea of a game of polo, but found that the Proprietor's Mark instead conveyed the idea of a name of a polo club and the place where the club is situated.

## Likelihood of Confusion

Applying the principles of the 3-step test established in *Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911, the Registrar only considered the Applicant's earlier rights in the Composite Mark in the decision to invalidate the Proprietor's Mark. The Proprietor did not dispute that there was similarity in the goods in Class 18.

The Registrar emphasised that confusion in the sense of "mere association" was insufficient. There had to be confusion as to the origin of the goods. In considering the application of several extraneous factors, the Registrar was of the view that:

1. The Applicant's reputation was inapplicable as its actual use of the mark is always accompanied by the highly distinctive words "Ralph Lauren";
2. The mode of purchase of these goods, whether from brick-and-mortar shops or via the Internet would entail visual perception of the marks, and the additional word elements "Royal County of Berkshire" in the



Proprietor's Mark would have a significant impact on the consumer, thus reducing the likelihood of confusion;

3. Goods of this type vary widely in quality and price. Whilst these are not as expensive as houses and cars, such goods are nevertheless not so cheap such that consumers would purchase them without at least putting some thought into the purchase process. Assuming that consumers would devote at least a medium degree of attention, it is likely that they would notice the differences between the marks.

Considering the low degree of similarity between the marks, that consumers will pay at least a medium level of attention when purchasing the goods, and that such goods would be purchased only after a usual visual inspection is conducted, the Registrar found no likelihood of confusion.

## Well Known Ground

Following the discussion on the Applicant's reputation, the Registrar found that the Applicant's Composite Mark on its own could not be held to be well known to the relevant sector of the public in Singapore, and therefore well known in Singapore.

In any case, the confusing connection element would not be fulfilled since there was no likelihood of confusion.

## Passing off Ground

Whilst the Registrar agreed that the Applicant did have goodwill in its business in Singapore, the evidence submitted was not clear as to whether such goodwill vested solely in the Applicant's Word Mark, Device Mark or Composite Mark.

In any case, again, misrepresentation must give rise to a likelihood of confusion before it is actionable. No likelihood of confusion was found.

## Comments

This decision emphasises the importance of devising a suitable filing strategy. The Applicant's Word Mark and Device Mark, whilst ensuring a broader scope of protection, were insufficient as bases to challenge the Proprietor's Mark. It is also important to note that in some cases, indications endorsed against marks on the Register may only be meant for the Registrar's reference only. Ultimately, it is an average consumer's perception that matters when examining the various elements in the 3-step test, particularly the similarity element.

The Registrar also emphasised the principle that words may not be accorded special regard or significance in composite marks, unless the other elements are negligible in size or meaning. The main consideration remains as to which element or elements are dominant in a composite mark.

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