

THE POLO/LAUREN COMPANY, L.P.,	}	IPC NO. 14-2007-00318
Opposer,	}	Case Filed: 05 November 2007
	}	Opposition to:
- versus -	}	Appl. Serial No.: 4-2005-004861
	}	Date Filed : 26 May 2005
MA. SHARMAINE R. MEDINA	}	Trademark: "PO168LO &
Respondent-Applicant.	}	HORSE AND LOGO"
x-----x	}	Decision No. 2008-162

DECISION

This pertains to the Opposition filed by POLO/LAUREN COMPANY, L.P., a limited partnership duly organized and existing under the laws of the State of New York, U.S.A. with business address at 625 Madison Avenue, 11<sup>th</sup> Floor, New York, New York 10022, U.S.A., to the registration of the trademark "PO168LO & HORSE LOGO" for all kinds of articles of outer clothing and underwear for men, women, teen-agers and children namely, shirts, blouses, skirts, suits, pants, trousers, jeans, vests, dresses, ties, coats, jackets, sandos covered under Class 25 filed under Application Serial No. 4-2005-004861 on 26 May 2005 in the name of MA. SHARMAINE R. MEDINA of 2D1-3 Juan Luna Plaza, #668 Juan Luna St., Binondo, Manila.

The facts and grounds upon which the opposition to the registration of the trademark PO168LO & HORSE LOGO were anchored are as follows:

1. "Opposer, THE POLO/LAUREN COMPANY, L.P., is a limited partnership duly organized and existing under the laws of the State of New York, U.S.A. with business address at 625 Madison Avenue, 11<sup>th</sup> Floor, New York, New York 10022, U.S.A.
2. "Respondent-Applicant is a natural person with address at 2D 1-3 Juan Luna Plaza, 668 Juan Luna St., Binondo, Manila.
3. "Opposer took notice on August 9, 2006 that Application Serial No. 4-2005-004861 for the mark "PO168LO & HORSE LOGO" for Class 25 goods was published for opposition on July 13, 2007 in the IPO Trademark E-Gazette.
4. "On August 10, 2006, Opposer through the undersigned counsel filed an Urgent Motion for Extension of Time to File Notice of Opposition from August 13, 2007 to September 12, 2007 to October 11, 2007. Another extension of thirty (30) days was requested and granted from September 12, 2007 to October 11, 2007. This Opposition is being filed within the extension period granted.
5. "Opposer believes that it will be damaged by the approval of such application and therefore, hereby files this Verified Petition for Opposition thereto with its accompanying affidavits of witnesses and supporting documents in compliance with Office Order No. 79.
6. "The approval of the application in question is contrary to Section 123 (d), (e) and (f) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines, which provides as follows:

*"Section 123. Registrability. – 123.1. A mark cannot be registered if it:*

- d) *Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:*
- (i) *The same goods or services, or*
  - (ii) *Closely related goods or services, or*
  - (iii) *If it nearly resembles such a mark as to be likely to deceive or cause confusion;”*
- e) *Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: Provided, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;”*
- f) *Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark are likely to be damaged by such use;”*

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7. “The approval of the application in question will violate Opposer’s right to its registered trademarks: “POLO RALPH LAUREN” (Cert. of Reg. No. 038659, April 15, 1988); “REP. OF POLO PLAYER” (Cert. of Reg. No. 045683, July 14, 1989); “POLO SPORT” (Cert. of Reg. No. 41996110991, October 18, 2001); “POLO PLAYER SYMBOL” (Cert. of Reg. 063119, July 21, 1996); “POLO” (Cert. of Reg. No. 41996107597, April 12, 2002); “RLX POLO SPORT” (Cert. of Reg. No. 4199806853, December 31, 2002), “EXTREME POLO SPORT RALPH LAUREN RL & FLAG DESIGN” (Cert. of Reg. No. 41997125737, Nov. 13, 2003); and “POLO DOUBLE BLACK” (Cert. of Reg. No.42006008013, May 21, 2007) (hereinafter collectively known as the “POLO” trademarks) for the goods covered and the right of Opposer to extend the use thereof to other goods. All of the foregoing registrations continue to be in full force and effect. Certified true copies of the registration certificates for the foregoing trademarks are attached herewith and made integral parts hereof as Annexes “A” to “H”;
8. “The Opposer’s internationally famous and well-known trademarks “POLO RALPH LAUREN”; “POLO PLAYER DEVICE”; “POLO RALPH LAUREN & DESIGN”; “RALPH LAUREN & DEVICE”; “POLO PLAYER DEVICE” and any of its derivative “POLO” trademarks are also entitled to protection as a trademark under the pertinent provisions of Articles 6bis of the Paris Convention which have been incorporated in Section 123.1 (e) and (f) of the Intellectual Property Code;
9. “Respondent-Applicant’s mark “PO168LO & HORSE LOGO” is identical or confusingly similar to the above-mentioned “POLO” trademarks or Opposer; is intended to ride on the popularity and goodwill of the Opposer’s mark and to confuse, deceive and/or mislead

the purchasing public into believing that Respondent-Applicant's goods are the same as or connected with the goods manufactured or sold by Opposer, its licensees and/or dealers;

10. "The approval of the application in question will cause great and irreparable damage and injury to herein Opposer;
11. "That the Opposer is the registered owner of the trademarks : "POLO RALPH LAUREN" (Cert. of Reg. No. 038659, April 15, 1988); "REP. OF POLO PLAYER" (Cert. of Reg. No. 045683, July 14, 1989); "POLO SPORT" (Cert. of Reg. No. 41996110991, October 18, 2001); "POLO PLAYER SYMBOL" (Cert. of Reg. 063119, July 21, 1996); "POLO" (Cert. of Reg. No. 41996107597, April 12, 2002); "RLX POLO SPORT" (Cert. of Reg. No. 4199806853, December 31, 2002), "EXTREME POLO SPORT RALPH LAUREN RL & FLAG DESIGN" (Cert. of Reg. No. 41997125737, Nov. 13, 2003); and "POLO DOUBLE BLACK" (Cert. of Reg. No.42006008013, May 21, 2007) and prior user of said marks for:
  - (a) Perfumery & Cosmetics (Class 3);
  - (b) Hand tools and implements; cutlery; side arms; razors (Class 8);
  - (c) Binoculars, eyeglass cases, eyeglass chains, eyeglass cords, eyeglass frames, eyeglasses, spectacle frames, spectacle glasses, spectacles (optics), telescopes (Class9);
  - (d) Hand tags, catalogues, stationery, shopping bags, patterns for dressmaking and making cloths, and wrapping paper (Class 16);
  - (e) Attache cases, backpacks, bags (garments) bags for campers, bags for climbers, beach bags, belts, briefcases, card cases, cases of leather or leather board, handbags, key cases, parasols, pocket wallets, satchel (school) school bags, school satchels, suitcases, traveling bags, umbrella sticks, umbrellas (Class 18);
  - (f) Bed fittings, bedding, furniture, picture frames, jewelry cases, statuettes, and wickerwork (Class 20);
  - (g) Houseware and kitchen utensils, ceramics, glassware, porcelain, earthenware, perfume sprayers and vaporizers, and vases (Class 21);
  - (h) Bedspreads, bed linen, blankets, coasters, coverlets, curtain holders, curtains, eiderdowns, face towels, furniture coverings, handkerchiefs, household linen, mats, napkin, pillow shams, pillowcases, place mats, quilts, serviettes, traveling rugs, table runners, table cloths, table mats, table linen, towels, tapestries, and wall hangings (Class 24);
  - (i) Wearing apparel, namely, sweaters, shirts, including knit shirts, dress shirts, sport shirts, sweat shirts, and t-shirts; jackets, ties, suits, slacks, ascots, bathing suits, belts, blouses, skirts, dresses, coats, hats, caps, tuxedos, pants, jeans, shorts, tops, vests, robes, hosiery, scarves, pajamas, underwears, kilts, mufflers, squares, shawls; footwear namely shoes, boots, slippers, athletic shoes, blazers, headbands, wristbands, coveralls, overalls, sweat pants, and sleepwear (Class 25);
  - (j) Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors, wall hangings (non-textile) (Class 27);
  - (k) Sporting goods, namely, basketballs, volleyballs, golf balls, and golf bags (Class 28); and
  - (l) Retail store services (Class 42);
12. "That Opposer's "POLO" trademarks for the foregoing classes of goods have been in continuous use in the Philippines for a sufficiently long period of time while the Respondent-Applicant never claimed any period or prior use of its infringing mark. Thus, even on equitable considerations based on its prior use vis-à-vis the non-use by Respondent-Applicant, Opposer has superior rights to its Polo trademarks;

13. "The Long use of, and the large amounts spent by the Opposer, its licensees, dealers, or agents for advertisement and promotion/publicity worldwide for the various goods bearing their aforementioned trademarks which, together with the volume of sales of said goods, have contributed immensely to the international recognition acquired by the goods of the Opposer identified by said marks;
14. "That Opposer's "POLO" trademarks are well-known marks because of numerous trademark registrations worldwide and the great volume of its worldwide sales. The said trademark is advertised extensively in the United States and other countries throughout the world, including the Philippines;
15. "That Opposer's "POLO" trademarks have therefore become very strong and popular marks with a well-established goodwill and solid business reputation throughout the world, including the Philippines;
16. "That it bears stressing that the composite mark "PO168LO & HORSE LOGO" is obviously not registrable because it is identical or confusingly similar to the above-mentioned "POLO" trademarks of Opposer, more specifically the "POLO PLAYER SYMBOL" and "REP. OF POLO PLAYER" and is intended to ride on the popularity and goodwill of the Opposer's mark and to confuse, deceive and/or mislead the purchasing public into believing that Respondent-Applicant's goods are the same as or connected with the goods manufactured or sold by Opposer, its licensees and/or dealers;

Opposer's Polo Player Symbol (Cert. of Reg. No. 063119) :



Opposer's Rep. of Polo Player (Cert. of Reg. No. 045683):



Respondent-Applicant's PO168LO & Horse Logo:



**PO168LO**

17. "That the way "PO168LO & HORSE LOGO" is drawn, sketched printed and reproduced is confusingly similar, if not identical to the "POLO PLAYER SYMBOL" and "REP. of POLO PLAYER" trademarks of Opposer both here and abroad;
- 17.1 "The similarities are obvious. First, both logos involve a man riding a horse;
- 17.2 "Second, both of the men depicted in the logos riding the horse are holding objects in the shape of a stick;
- 17.3 "Third, both sticks are held in such a way that they are both pointing at the same direction;
- 17.4 "The tip of the stick of Respondent-Applicant's logo looks like a mallet, just like that of Opposer's;
- 17.5 "It is of course clear to the general public that the "POLO PLAYER SYMBOL" and "REP. OF POLO PLAYER" are meant to depict the sport of polo;
- 17.6 "Polo is a team sport played outdoor on horseback in which the objective is to score goals against an opposing team. Riders score by driving a white wooden or plastic ball (size 3-3.5 inches, weight 4.25-4.75 ounces) into the opposing team's goal using a long-handled mallet.
- 17.7 "Respondent-Applicant in its malicious attempt to copy and infringe on the prior existing rights of Opposer over its long standing "POLO PLAYER SYMBOL" and "REP. OF POLO PLAYER", tried to imitate the polo player logo by copying all of the essential elements of the logo as enumerated in Paragraphs 17.1, 17.2, 17.3 and 17.4 and in the process, creating unsubstantial differences that pale into insignificance;
- 17.8 "While the hat of Respondent-Applicant's human figure appears to be different from the polo cap of Opposer's polo player, the difference is slight. Respondent-Applicant's rider also holds what also looks like a mallet and the angle of the horse in relation to the viewer is the same as that of Opposer's;
- 17.9 "Such slight differences should be completely ignored. Aside from creating a degrading imitation of the classes "POLO PLAYER SYMBOL" and "REP. OF POLO PLAYER" of the Opposer, there is no question that Respondent-Applicant intended to copy Opposer's foregoing logos to enjoy a free ride on the popularity and goodwill of the well known Polo trademarks of the Opposer;
- 17.10 "Also, the word "PO168LO" does not save the day for Respondent-Applicant as well. The numbers "168" are not dominant, substantial or significant enough to

prevent any confusion due to the confusing similarity between the Polo trademarks of the Opposer and the said mark of the Respondent-Applicant. The main, essential or dominant portion of the mark of Respondent-Applicant is still "POLO";

- 17.11 "In sum, both the word mark and logo are complete imitations of the existing Polo trademarks and clearly show that Respondent-Applicant intended to copy and imitate the Polo trademarks of the Opposer in bad faith. It must also be considered that the goods covered by both marks are exactly the same and are under the same class (Class 25).
18. "That said "POLO" trademarks have become firmly and widely identified with the products of Opposer and/or its distributors, dealers, licensees, and agents; and
19. "That the trademarks of Opposer have been recognized by the Minister of Trade Luis Villafuerte in his Memorandum dated November 20, 1980 as internationally well-known trademarks. Pursuant to the said Villafuerte Memorandum and the subsequent Memorandum of the Minister of Trade Roberto V. Ongpin dated October 25, 1983 directing compliance with the provisions of Article 6bis of the Paris Convention, Opposer is entitled to protection of its "POLO" trademarks for which reason Application Serial No. 4-2005-004861 should be rejected;
20. "That under the foregoing circumstances and pursuant to Sec. 123 (d), (e) and (f) of Republic Act No. 8293, Article 6bis of the Paris Convention and the aforementioned Memoranda of Ministers Villafuerte and Ongpin, the Intellectual Property Code is authorized to refuse all applications for trademarks which constitute a reproduction, translation or imitation of a trademarks which constitute a reproduction, translation or imitation of a trademark originally owned by a person, natural or corporate, who is a citizen of a country signatory to the Paris Convention for the Protection of Industrial Property and filed by persons other than the original owners thereof;
21. "As a last note, this Honorable Office recently promulgated Decision No. 2006-91 dated September 21, 2006 in favor of Opposer in "The Polo/Lauren Company, L.P. v. Luis D. Delos Reyes (Inter Partes Case No. 14-2005-00087)" which was an opposition to the mark "Polo Extreme (Stylized Form)" with Application Serial No. 4-2003-011209. Of relevance to the present opposition, this Honorable Office ruled:

"In trademark registration cases, certificate of registration is prima facie evidence of the validity of registration, the registration and ownership of the mark and the exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate (Levi Strauss & Co. v. Clinton Aparelle, Inc., 470 SCRA 253-254 (2005))

Considering that the trademark "POLO" is a registered mark, it is no longer subject of appropriation by any third party, such as the herein Respondent-Applicant, if the same mark is being used on identical, similar or related goods.

As shown by the evidence, the trademark "POLO" has been registered in the United States Patent and Trademark Office bearing Registration No. 1,363m459 in Class 25 of the International classification of goods on October 1, 1985 or more than twenty (20) years ago before the filing of the Respondent-Applicant's trademark application. (Annex "G")

Another vital point to consider is the fact that the trademark "RALPH LAUREN" of the Opposer was declared as an internationally well known trademark under Memorandum dated 20 November 1980 of the then Honorable Minister Luis R. Villafuerte of the Ministry of Trade confirming our obligations under the Paris Convention for the Protection of Industrial Property to which the Republic of the Philippines is a signatory.

Moreover, as shown by the evidence presented by Opposer, Respondent-Applicant's mark "POLO EXTREME" is confusingly similar to the Opposer's trademarks "POLO", "POLO BY RALPH LAUREN", "POLO SPORT", "EXTREME POLO SPORT", hence, Respondent-Applicant intended to ride on the popularity and goodwill of the Opposer's mark and to confuse, deceive and/or mislead the purchasing public into believing that Respondent-Applicant's goods are the same as or connected with the goods manufactured or sold by the Opposer, its licensees and/or dealers.

In the light of the forgoing circumstances and pursuant to the Memorandum of Minister Luis R. Villafuerte of the then Minister of Trade dated 20 November 1980, the trademark "POLO EXTREME" of the Respondent-Applicant which constitute a reproduction, translation, or imitation of the trademark originally by the herein Opposer, organized and existing under the laws of the State of New York, United States of America, a country signatory to the Paris Convention, cannot be allowed registration. Accordingly, the Notice of Opposition filed by Opposer is, as it is hereby SUSTAINED. Consequently, said trademark application bearing Serial No. 4-2003-011209 for the mark "POLO EXTREME" filed on December 8, 2003 by Luis D. Delos Reyes is, as it is hereby, REJECTED." (Emphasis supplied)

A certified true copy of the foregoing Decision No. 2006-91 is attached hereto and made an integral part hereof as Annex "I".

22. "The decision favoring Opposer's Polo trademarks was further buttressed by another decision, namely, Decision No. 2007-29 dated March 9, 2007 in "The Polo/Lauren Company, L.P. v. Melinda Ataiza (Inter Partes Case No. 14-2006-000169)" for the infringing mark "POLO CLASSICS & DESIGN". In said case, this Honorable Office held:

"The law is very clear that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor with a registered mark belonging to a different proprietor or mark with an earlier filing or priority date.

"The mark "POLO" has been registered in the United States Patent and Trademark Office on October 1, 1985 bearing Registration No. 1,363,459 and the claim of use is 1967 for the goods clothing namely, suits, slacks, trousers, shorts, jackets, blazers, dress shirts, sweatshirts, sweaters, hats, belts, socks, blouses, skirts, coats, and dresses in Class 25 of the International Classification of goods, or more than twenty (20) years ago before the filing of the Respondent-Applicant's trademark application.

Records will show that the mark "POLO Ralph Lauren" has been registered with the then Bureau of Patents, Trademark and Technology Transfer now the Intellectual Property Philippines way back in April 15, 1988 under Registration No. 38659 (Annex "A").

The "Presentation of POLO Player" of Opposer which is exactly the design forming part of the Respondent-Applicant's mark is likewise registered with the Intellectual Property Philippines way back on July 14, 1989 (Annex "B").

One vital point to be considered is that, the Opposer's registered trademarks above-mentioned were used in the Philippines since February 14, 1980 as indicated in the certificate of registration.

In order to avoid confusing similarity with Opposer's mark, the Respondent-Applicant combined the word "POLO" and the "Design" consisting of presentation of a polo player and added the word "CLASSIC", a maneuver which could not be tolerated.

As shown by the evidences presented, the word "POLO" is always accompanied by the name "RALPH LAUREN" which is declared as internationally well-known trademark under Memorandum dated 20 November 1980 of the then Honorable Luis R. Villafuerte of the Ministry of Trade confirming our obligations under the Paris Convention of the Protection of Industrial Property to which the Republic of the Philippines is a signatory.

Finally, it is truly difficult to understand why, of the millions of terms and combinations of letter and designs available, the Respondent-Applicant had to choose exactly the same mark of the Opposer, if there was no intent to take advantage of the goodwill of the Opposer's mark.

WHEREFORE, viewed in the light of all the foregoing, this Bureau finds and so holds that Respondent-Applicant's mark "POLO CLASSICS & DESIGN" is confusingly similar to Opposer's mark "POLO" and "Representation of Polo Player" and as such the Opposition is hereby SUSTAINED. Consequently, trademark application bearing Serial No. 4-2005-004336 filed on May 12, 2005 for the mark "POLO CLASSICS & DESIGN" is hereby REJECTED."

A certified true copy of the foregoing Decision No. 2007-29 is attached hereto and made an integral part hereof as Annex "J". It is noteworthy to mention that the cited "Representation of POLO Player" in the Decision pertains exactly to Trademark Certificate of Registration No. 045683 dated July 14, 1989 which is one of the trademark registrations that Respondent-Applicant maliciously copied for its present opposed application.

23. "It is truly difficult to understand why, of the millions of terms and combination of letters and designs available, the Respondent-Applicant had to choose exactly the same or confusingly similar marks as that of the Opposer's for goods that are exactly similar to another unless it is for the sole purpose of riding on the popularity of Opposer's well-known trademark;

The Notice to Answer dated 14 November 2007 was sent to Respondent-Applicant through her agent and attorney-in-fact, Angel O. Olandres Jr. on 28 November 2007, directing Respondent-Applicant to file her Verified Answer within thirty (30) days from receipt of the said notice. For failure of Respondent-Applicant to file the required Answer, this Bureau in Order No. 2008-1276 considered Respondent-Applicant to have waived her right to file the same and accordingly submitted this instant suit for decision based on the Opposition, affidavits of the witnesses and documentary evidence submitted by Opposer.

Filed as evidence for the Opposer, based on the records, are the following:



1. Certified true copy of Certificate of Registration No. 38659 for the trademark POLO/RALPH LAUREN - *Annex "A"*
2. Certified true copy of Certificate of Registration No. 45683 for the trademark REPRESENTATION OF POLO PLAYER - *Annex "B"*
3. Certified true copy of Certificate of Registration No. 41996110991 for the trademark POLO SPORT - *Annex "C"*
4. Copy of Certificate of Registration No. 63119 for the trademark POLO PLAYER SYMBOL - *Annex "D"*
5. Certified true copy of Certificate of Registration No. 41996107597 for the trademark POLO - *Annex "E"*
6. Certified true copy of Certificate of Registration No. 4199806853 for the trademark RLX POLO SPORT - *Annex "F"*
7. Certified true copy of Certificate of Registration No. 41997125737 for the trademark EXTREME POLO/SPORT/RALPH LAUREN/RL & FLAG DESIGN - *Annex "G"*
8. Certified true copy of Certificate of Registration No. 42006008013 for the trademark POLO DOUBLE BLACK - *Annex "H"*
9. Certified true copy of Decision No. 2006-91 dated September 21, 2006 rendered/issued by BLA for IPC No. 14-2005-00087 - *Annex "I"*
10. Certified true copy of Decision No. 2007-29 dated March 9, 2007 rendered/issued by BLA for IPC No. 14-2006-00169 - *Annex "J"*
11. Copy of USPTO issued Trademark Registration No. 1,363,459 for the Trademark POLO - *"Annex "K"*
12. Copy of USPTO issued Trademark Registration No. 1,745,274 for the Trademark POLO BEAR - *Annex "L"*
13. Copy of USPTO issued Trademark Registration No. 2,077,082 for the Trademark POLO RALPH LAUREN & DEVICE - *Annex "M"*
14. Copy of USPTO issued Trademark Registration No. 1,742,330 for the Trademark POLO BEAR BY RALPH LAUREN - *Annex "N"*
15. Copy of USPTO issued Trademark Registration No. 2,688,377 for the Trademark RLX POLO SPORT - *Annex "O"*
16. Copy of USPTO issued Trademark Registration No. 1,622,635 for the Trademark POLO with STYLIZED LETTERS "PRLC" - *Annex "P"*
17. Copy of USPTO issued Trademark Registration No. 1,530,948 for the

- Trademark POLO USA
18. Copy of USPTO issued Trademark Registration No. 1,249,050 for the Trademark POLO University by Ralph Lauren - *Annex "Q"*
  19. Copy of USPTO issued Trademark Registration No. 2,718,880 for the Trademark POLO SPORT RALPH LAUREN with American Flag - *Annex "R"*
  20. Copy of USPTO issued Trademark Registration No. 1,951,601 for the Trademark POLO SPORT - *Annex "S"*
  21. Copy of USPTO issued Trademark Registration No. 1,537,444 for the Trademark POLO with "EST MCMLXVII" - *Annex "T"*
  22. Copy of USPTO issued Trademark Registration No. 1,622,636 for the Trademark POLO RALPH LAUREN SPORTSMAN - *Annex "U"*
  23. Copy of USPTO issued Trademark Registration No. 1,378,247 for the Trademark POLO RALPH LAUREN & DEVICE - *Annex "V"*
  24. Copy of USPTO issued Trademark Registration No. 1,935,665 for the Trademark POLO RALPH LAUREN - *Annex "W"*
  25. Copy of USPTO issued Trademark Registration No. 1,398,585 for the Trademark POLO with the letters RL - *Annex "X"*
  26. Copy of USPTO issued Trademark Registration No. 2,013,947 for the Trademark REPRESENTATION OF A POLO PLAYER - *Annex "Y"*
  27. Copy of USPTO issued Trademark Registration No. 2,718,847 for the Trademark POLO JEANS CO. RALPH LAUREN - *Annex "Z"*
  28. Copy of USPTO issued Trademark Registration No. 2,049,948 for the Trademark POLO JEANS CO. - *Annex "AA"*
  29. Copy of USPTO issued Trademark Registration No. 2,686,291 for the Trademark POLO GOLF - *Annex "BB"*
  30. Copy of USPTO issued Trademark Registration No. 2,088,937 for the Trademark POLO CHINO RALPH LAUREN - *Annex "CC"*
  31. Copy of USPTO issued Trademark Registration No. 978,166 for the Trademark POLO by RALPH LAUREN - *Annex "DD"*
  32. Copy of USPTO issued Trademark Registration No. 1,067,698 for the Trademark POLO by RALPH LAUREN - *Annex "EE"*
  33. Affidavit of David R. Brown - *Annex "FF"*
  - *Annex "GG"*

For consideration in particular is the propriety of Application Serial No. 4-2005-004861. The issue hinges on the termination of whether or not Respondent-Applicant is entitled to register the trademark PO168LO & HORSE LOGO on *all kinds of articles of outer clothing and underwear for men, women, teen-agers and children namely, shirts, blouses, skirts, suits, pants, trousers, jeans, vests, dresses, ties, coats, jackets, sandos*, all falling under Class 25.

The Opposer's main arguments pivot or delve on the issue of confusing similarity between trademarks. In determining the existence of confusing similarity, it becomes imperative for this forum to make a careful comparison and scrutiny of the marks involved; to determine the points where these labels as they appear on the goods to which they are attached are similar, in spelling, sound and manner of presentation or general appearance. Both marks bear the word POLO with a device appearing as representation of a man riding a horse with a long-handled mallet and Respondent-Applicant's use or adoption of the same WORD and DEVICE for use on the same or related goods was Opposer's basis in bringing this action. For a better appreciation of the arguments posited, the two marks are reproduced hereunder exactly as it appears in the application or the facsimile copy of the registration records filed with this Office:



Opposer's REPRESENTATION OF POLO PLAYER LOGO

Filed: December 3, 1981  
Registered: July 14, 1989



Applicant's PO168LO & HORSE

Filed: May 26, 2005

A comparison of the competing marks reveals that the word POLO and a representation of a man riding a horse with a long-handled mallet appears in both labels of the contending parties. It can easily be observed that Respondent-Applicant adopted not only Opposer's word-mark POLO, likewise the DEVICE mark of a man riding a horse with a stick at the end of which appears like a mallet, was copied as well. Hence, comparing both marks in plain view there certainly is obvious, if not perfect similarity. Anyone is likely to be misled by the adoption of the same word-mark POLO in conjunction with a DEVICE involving a man riding a horse with a long-handled mallet, which for many years is known and identified to be Opposer's labels for perfumery and cosmetics. Hence, Respondents' mark PO168LO & HORSE LOGO lacks the element of originality to be sufficiently distinctive. The combination of the word mark and device used thereon is not one that would naturally occur to Respondent-Applicant or any other trader for that matter to use and/or conceptualize. The court observed in *Philippine Refining Co., Inc., vs. Dir. Of Patents and Sparklets Corp. vs. Walter Kiddie Sales Co.*, 104 F.2d 396, that "a trademark is designed to identify the user. But it should be so distinctive and sufficiently original as to enable those who come into contact with it to recognize instantly the identity of the user. It must be affirmative and definite, significant and distinctive, capable to indicate the origin." Likewise, our trademark law does not require identity, confusion is likely if the resemblance is so

close between two trademarks. Bolstering this observation is the pronouncement by the court in the case of Forbes, Munn & Co. (Ltd.) vs. Ang San To, 40 Phil. 272, 275 where it stated that *the test was similarity or “resemblance between the two (trademarks) such as would likely to cause the one mark to be mistaken for the other. . . . [But] this is not such similitude as amounts to identity.”* On the contrary, as happened in this case, there was no similitude but an exact replica that was applied.

Having shown and proven resemblance of the two marks at issue, we now delve on the matter of priority in use which certainly has decisive effect in the adjudication of the case. Culled from Opposer’s evidence are documents (*Annexes “A” to “H”, Opposer*) showing that Opposer is the registered owner in the Philippines of trademarks with the word POLO as well as a DEVICE described as REPRESENTATION OF POLO PLAYER, as follows:

Trademark	Registration Number	Nice Classification
POLO/RALPH LAUREN	38659	3
REPRESENTATION OF POLO PLAYER	45683	3
POLO SPORT	41996110991	25
RLX POLO SPORT	4199806853	8, 9, 14, 16, 18, 20, 21, 24, 25, 27, 28 & 42
EXTREME POLO/SPORT/RALPH LAUREN/R. & FLAG DESIGN	41997125737	3
POLO DOUBLE BLACK	42006008013 ( <i>deemed registered</i> )	3

Opposer’s trademarks, with the word POLO and DEVICE described as POLO PLAYER SYMBOL OR REPRESENTATION OF POLO PLAYER, were applied for trademark registration with the Intellectual Property Office as early as 03 December 1981 primarily for perfumery and cosmetics.

From the evidence presented, the stand of Opposer as prior user and registrant was put forth with greater plausibility. Opposer has been in the business and was using the POLO trademark as well as a DEVICE or LOGO of a man riding a horse with a long-handled mallet on perfumery and cosmetics since 1981 in the Philippines, as well as on goods belonging to Class 25, which trademarks with the word POLO, Opposer were able to obtain their registration in the Philippines as early as the year 1996 for the following goods:

*Wearing apparel, namely: pants, shorts, jackets, t-shirts, sport shirts, knit shirts, sweatshirts, hats, socks and footwear.*

These registrations are subsisting and have not been abandoned. Hence, Respondent-Applicant, by any parity of reasoning, cannot be considered an originator, prior registrant nor a prior applicant of the subject or questioned trademark. As held in the case of Unno Commercial Enterprises, Inc. vs. General Milling Corporation “*prior use by one will controvert a claim of legal appropriation by subsequent users.*” Hence, it may be concluded inevitably that Respondent-Applicant’s use of substantially the same mark on the same or related goods will result in an unlawful appropriation of mark previously used by Opposer and not abandoned.

This present Opposition is anchored on Opposer’s claim of ownership over the use of the POLO trademarks and the DEVICE or LOGO with a representation of a polo player for perfumery, cosmetics and wearing apparels falling under Classes 03 & 25 pursuant to Section 123.1 (d) of R.A. 8293, to wit:

*“Section 123. Registrability. – 123.1 A mark cannot be registered if it:*

xxx

- (d) *Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:*
- (i) *The same goods or services, or*
  - (ii) *Closely related goods or services, or*
  - (iii) *If it nearly resembles such a mark as to be likely to deceive or cause confusion;”*

xxx

it is worth mentioning at this juncture to bolster Opposer’s exclusive right over its registered trademarks POLO and the DEVICE of a man riding a horse with long-handled mallet and accord protection henceforth against any subsequent user is the established goodwill and reputation for its POLO trademarks and DEVICE described as REPRESENTATION OF POLO PLAYER that Opposer had earned over the years. Opposer’s registered POLO and REPRESENTATION OF POLO PLAYER logo trademarks are widely and popularly used by Opposer primarily on its perfumery and cosmetic products. The use and adoption by Applicant of substantially the same mark as subsequent user can only mean that Applicant wishes to reap on the goodwill, benefit from the advertising value and reputation of Opposer’s famous trademarks. Considering that these competing marks are being used on the same goods: *wearing apparels*, the simultaneous use of the same may lead to confusion in trade and would damage Opposer’s goodwill or reputation which it has painstakingly earned for a considerable period of time. Thus, Opposer will be damaged by the registration of the mark PO168LO & HORSE LOGO in favor of Respondent-Applicant as it has a priority or better right to these trademarks not only for perfumery and cosmetic products but also on goods falling under Class 25.

The right to register trademarks, trade names and service marks is based on ownership. Only the owner of the mark may apply for its registration (*Bert R. Bagano v. Director of Patents, et.al.*, G.R. No. L-20170, August 10, 1965). And where a trademark application is opposed, the Respondent-Applicant has the burden of proving ownership (*Marvex Commercial Co., Inc., v. Peter Hawpia and Co.*, 18 SCRA 1178). In the instant case, Respondent-Applicant did not present any evidence to prove its ownership over the subject PO168LO & HORSE logo, despite being given the opportunity to do so. Likewise, this Bureau cannot take for granted the inaction of Respondent-Applicant in defending its claim over the trademark “PO168LO & HORSE LOGO”. Such inaction of Respondent-Applicant is evidenced by its failure to file its Answer despite receipt of the Notice to Answer the Notice of Opposition, contrary to the disputable presumption that “a person takes ordinary care of his concern”, enunciated in Section 3(d) of Rule 131 of the Rules of Court.

It was the Respondent-Applicant’s option not to defend its case, contrary to the declared policy of the Supreme Court to the effect that “it is precisely the intention of the law to protect only the vigilant, not those guilty of laches.”

Finally, as provided for under Sec. 230 of R.A. 8293, otherwise known as the Intellectual Property Code of the Philippines:

“Sec. 230. *Equitable Principles to Govern Proceedings.* – In all inter partes proceedings in the Office under this Act, the equitable principles of laches, estoppel, and acquiescence where applicable, may be considered and applied.”

The Opposer having sufficiently corroborated its claim, the inevitable conclusion is that Opposer is the first adopter and prior registrant of the POLO trademarks as well as the DEVICE of a man riding a horse with a long-handled mallet for goods under Classes 03 and 25 and that the mark PO168LO & HORSE LOGO bearing Application Serial No. 4-2005-004861 can not

have any right superior to Opposer's POLO trademarks and REPRESENTATION OF POLO PLAYER to be used on goods falling under Class 25.

WHEREFORE, premises considered, the Notice of Opposition is, as it is hereby SUSTAINED. Consequently, Application bearing Serial No. 4-2005-004861 filed by MA. SHARMAINE R. MEDINA on 26 May 2005 for the registration of the mark PO168LO & HORSE LOGO for use on all kinds of articles of outer clothing and underwear for men, women, teenagers and children namely, shirts, blouses, skirts, suits, pants, trousers, jeans, vests, dresses, ties, coats, jackets, sandos covered under Class 25 is, as it is hereby, REJECTED.

Let the file wrappers of PO168LO & HORSE LOGO, subject matter of this case be forwarded to the Bureau of Trademarks for appropriate action.

SO ORDERED.

Makati City, 10 September 2008.

ESTRELLITA BELTRAN-ABELARDO  
Director, Bureau of Legal Affairs  
Intellectual Property Office