

THE POLO/LAUREN	}	IPC No. 14-2006-000169
COMPANY L.P.,	}	Opposition to:
<i>Opposer,</i>	}	
	}	Appl'n Serial No. : 04-2005-004336
-versus-	}	Date Filed : May 12, 2005
	}	Trademark : "POLO CLASSICS &
MELINDA ATAIZA doing business	}	DESIGN"
under the name and style of WINE	}	
APPAREL,	}	
<i>Respondent-Applicant.</i>	}	
x-----x	}	Decision No. 2007-29

DECISION

This is an opposition to the registration of the mark "POLO CLASSICS & DESIGN" bearing Serial No. 4-2005-004336 filed on May 12, 2005 covering the goods "t-shirts, pants, caps, jogging pants, jackets falling under class 25 of the International Classification of goods which application was published for opposition on July 17, 2006 in the Intellectual Property Philippines (IPP) E-Gazette.

The Opposer in the instant inter partes proceedings is "THEPOLO/LAUREN COMPANY L.P." a limited partnership duly organized and existing under the laws of the State of New York, United States of America, with business address at 625 Madison Avenue, 11th Floor, New York, New York 10022, U.S.A.

On the other hand, the Respondent-Applicant is "Wine Apparel" as indicated in the trademark application being opposed and so with the acknowledgement issued by the Bureau of Trademarks, nevertheless as shown in the Notice of Allowance and the Response submitted to the official action undertaken by the examiner, the name "MELINDA ATAIZA" is indicated as president/general manager, with address at Block 19, Golden Wood Street, Greenwoods Executive Village, Pasig City.

The grounds for the opposition are as follows:

- "1. 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:

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

"(d) Is identical with a registered mark belonging to a different proprietor or 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 constitute 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 constitute 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: *Provided*, further, That the interests of the owner of the registered mark are likely to be damaged by such use;

xxx xxx xxx

- “2. The approval of the application in question will violate Opposer’s right to its registered trademarks: “POLO RALPH LAUREN” (Certificate of Registration No. 038659, April 15, 1988); “Representation of a POLO PLAYER” (Certificate of Registration No. 045683, July 14, 1989); “POLO SPORT” (Certificate of Registration No. 41996110991, October 18, 2001); “POLO PLAYER SYMBOL” (Certificate of Registration No. 063119, July 21, 1996); “POLO” (Certificate of Registration No. 41996107597, April 12, 2002); “RLX POLO SPORT” (Certificate of Registration No. 4199806853, December 31, 2002); “EXTREME POLO SPORT RALPH LAUREN RL & FLAG DESIGN” (Certificate of Registration No. 41997125737); and to its newly applied trademark “POLO DOUBLE BLACK” (Application Serial No. 42006008013, July 21, 2006) (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 and application 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 “G” while a printed copy from the IPP website regarding details of “POLO DOUBLE BLACK” is attached herewith and made an integral part hereof as Annex “H”;
- “3. The Opposer’s internationally famous and well-known trademarks “POLO BY 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 Article 6bis of the Paris Convention which have been incorporated in Section 123.1 (e) and (f) of the Intellectual Property Code;
- “4. Respondent-Applicant’s mark “POLO CLASSICS & DESIGN” is identical or confusingly similar to the above-mentioned “POLO” trademarks of 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 licensee and/or dealers;

- "5. The approval of the application in question will cause great and irreparable damage and injury to herein Opposer;
- "6. That the Opposer is the registered owner of the trademarks: "POLO RALPH LAUREN" (certificate of Registration No. 038659, April 15, 1988); "Representation of a POLO PLAYER" (Certificate of Registration No. 045683, July 14, 1989); "POLO SPORT" (Certificate of Registration No. 41996110991, October 18, 2001); "POLO PLAYER SYMBOL" (Certificate of Registration No. 41996107597, April 12, 2002); "RLX POLO SPORT" (Certificate of Registration No. 4199806853, December 31, 2002); "EXTREME POLO SPORT RALPH LAUREN RL & FLAG DESIGN" (Certificate of Registration No. 41997125737); and to its newly applied trademark "POLO DOUBLE BLACK" (Application Serial No. 42006008013, July 21, 2006) and prior user of the said marks for:
- (a) Perfumery & Cosmetics (Class 3);
 - (b) Hand tools and implements; cutler; side arms; razors (Class 8);
 - (c) Binoculars, eyeglass cases, eyeglass chains, eyeglass cords, eyeglass frames; eyeglasses, spectacle frames, spectacle glasses, spectacles (optics); telescopes (Class 9);
 - (d) Hand tags, catalogues, stationary, shopping bags, patterns for dressmaking and making clothes and wrapping paper (Class 16);
 - (e) Attaché cases, backpacks, bags (garments) bags for campers, bags for climbers, beach bags, belts, briefcases, card cases, cases of leather or leather board, handbags, keycases, parasols, pocket wallets, satchel (school) school bags, school satchels, suitcases, traveling bags, umbrella sticks, umbrellas (class 18);
 - (f) Bed fitting, bedding, furniture, picture frames, jewelry cases, statuettes and wickerworks (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, napkins, 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 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, 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 hanging (non-textile) (Class 27);
- (k) Sporting goods, namely, basketballs, volleyballs, golf balls and golf bags (Class 28); and
- (l) Retail store services (class 42);

- “7. The Opposer “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 of prior use of its infringing mark;
- “8. 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 volumes of sales of said goods, have contributed immensely to the international recognition acquired by the goods of the Opposer identified by said marks:
- “9. 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;
- “10. The 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;
- “11. That it bears stressing that the composite mark “POLO CLASSICS & DESIGN” is obviously not registrable because it is identical or confusingly similar to the above-mentioned “POLO” trademarks of Opposer 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 good are the same as or connected with the goods manufactured or sold by Opposer, its licensees and/or dealers;
- “12. That the way “POLO CLASSICS & DESIGN” is written, printed and reproduced in its stylized form is identical to the usual font style of the “POLO” trademarks both here and abroad;

- “13. The said “POLO” trademarks have become firmly and widely identified with the products of Opposer and/or its distributors, dealers, licensees and agents; and
- “14. That the trademarks of Opposer have been recognized by the Minister of Trade Honorable Luis Villafuerte in his Memorandum dated November 20, 1980 as internationally well-known trademarks. Pursuant to the said Villafuerte Memorandum and the 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. 4-2005-004336 should be denied.
- “15. That under the foregoing circumstances and pursuant to Section 123 (d), (e) and (f) of Republic Act No. 8293, Article 6bis of the Paris Convention and the aforementioned Memorandum of Minister Villafuerte and Ongpin, the Intellectual Property Philippines is authorized to refuse all application for 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.

In compliance to Office Order No. 79, Series of 2005, Opposer submitted the following as its documentary evidence.

1. Affidavit of Mr. David Brown;
2. Certificate of Authenticity;
3. Supporting documents consisting of Annexes “A” to “GG” inclusive of sub-markings;
4. Exhibits “A” to “F-43”, inclusive of sub-markings.

On the other hand, Respondent-Applicant did not file the required Answer together with the affidavit of witness/witnesses necessary and the documents to support the trademark application being opposed despite receipt of the Notice to Answer issued by the Bureau of Legal Affairs, which was sent through registered mail with return card bearing No. C-2554 on December 11, 2006.

Section 11 of the Summary Rules (Office Order No. 19, Series of 2005) provides:

Section 11. *Effects of failure to file an Answer.* In case the Respondent-Applicant fails to file an answer, or if the answer is filed out of time, the case shall be decided on the basis of the petition or opposition, the affidavit of the witnesses and documentary evidence submitted by the Petitioner or Opposer.

The issue to be resolved in the instant proceedings is:

WHETEHR OR NOT THE RESPONDENT-APPLICANT IS
ENTITLED TO THE REGISTRATION OF THE MARK “POLO CLASSICS
& DESIGN”.

The applicable provision of law is, Section 123 of Republic Act No. 8293, which provides, thus:

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

- (d) Is identical with a registered mark belonging to a different proprietor or 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;”

The law is very clear that a mark cannot be registered if it is *identical* 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, Trademarks 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 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 for 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 million of terms and combinations of letters 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.

Let the filewrapper of the trademark "POLO CLASSICS & DESIGN" subject matter of this case together with a copy of this DECISION be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 09 March 2007.

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