UNITED STATES POLO ASSOCIATION,
Opposer,

- versus -

RAMESH L. MIRPURI
Respondent-Aplicant.
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IPC No. 14-20080-00357
Opposition to:

Appln. Serial No. 4-2007-009375
Date Filed: 29 August 2007

Trademark: "3 Polo Players on a Horse Logo"

Decision No. 2010-49

DECISION

United States Polo Association ("Opposer"), a corporation organized and existing under the laws of Illinois, United States, with office address at 771 Corporate Drive, Suite 430, Lexington, Kentucky, filed on 15 December 2008 an opposition to Trademark Application Serial No. 4-2007-009375. The trademark application[1] filed by RAMESH L. MIRPURI ("Respondent-Applicant"), of Soliven corner MRR Street, Manggahan, Pasig City, covers men's, ladies and children's t-shirts, polo shirts, jeans, pants, slacks, blouses, skirts, shorts, dresses, jackets, sweater, jogging suits, sweatshirts, vests, socks, sandos, briefs, panties, brasses, lingeries and stockings under Class 25 of the International Classification of Goods. [2]

The Opposer alleges the following:

"4.1 Respondent-Applicant's 3 Polo Players on a Horse mark is confusingly similar to Opposer's registered USPA Trademarks, in particular, the Two Polo Players mark, in violation of Section 123.1 (d) of the Intellectual Property Code.

"4.2 Respondent-Applicant's 3 Polo Players on a Horse mark is confusingly similar to Opposer's well-known USPA Trademarks and Two Polo Players mark, in violation of Section 123.1 (e) of the IP Code and international treaties.

"4.3 Respondent-Applicant used and appropriated the mark 3 Polo Players on a Horse in bad faith."

The Opposer's evidence consists of the following:

1. Exhibits "A", "B" and "C" - Certified true copies of Registration Nos. 4-2000-05531, 4-2000-04899 and 4-2005-05533;

2. Exhibits "D", "E", "F" and "G" - Printouts of the details appearing on the IPO online database;

3. Exhibits "H" to "M" - Catalogues containing pictures of clothing items bearing Two Polo Players mark;

4. Exhibits "N" and "0" - Photos of packaging bearing the Two Polo Players mark;

1 The subject trademark application was published for opposition in the Intellectual Property Office E-Gazette on 15 August 2008

2 The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral treaty administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement concerning the International Classification of Goods and Services for the purpose of the Registration of Mark Concluded in 1957.

5. Exhibits “P” to “P-17 - Printouts from the Product Gallery page of Opposer’s www.uspoloassn.com website;

6. Exhibits “Q” and “Q-1” - History and Corporate Structure of the Opposer;

7. Exhibits “R” and “R-1” - Information about Opposer’s product;

8. Exhibit “S” - Copy of Opposer’s Master License Structure Chart;

9. Exhibit “T” - List showing the details of all the Opposer’s pending applications and registrations for the USPA trademark including the Two Polo Players mark;

10. Exhibits “U”, “V”, “W”, “X”, “Y”, “Z”, ‘‘AA”, “BB” and “CC” -Certified copies of representative registration certificates for the Two Polo Players trademark from the selected countries/regions;

11. Exhibits “DD” to “00-5” -Opposer’s retail stores and products all showing the USPA trademarks and the Two Polo Players mark;

12. Exhibit “PP” -The duly authenticated Affidavit of Mr. Peter J. Rizzo, Executive Director of Opposer; and

13. Exhibits “QQ” and “RR” -Certified copy of decision and a press statement issued by the Opposer

On 18 May 2009, the Respondent-Applicant filed his Verified Answer alleging, among other things, the following:

“5.1. Most of the exhibits submitted by Opposer, together with its Notice of Opposition, do not comply with Office Order No. 79 and are therefore, inadmissible, more particularly:

Exhibits “D”; “E”; “F”; “G”; “H”; “I”; “J”; “K”; “L”; “M”; “N”; “P” to “P-17”; “Q” and “Q-1”; “R” and “R-1”; “S”; “T”; “X”; ‘‘AA’’ “DD”; “EE”; “FF” to “FF-4”; “GG” to “GG-2”; “HH‘‘ “II”; “JJ”; “KK”; “LL”; “MM”; “NN” to “NN-2”; “OO” to “00-5’‘ and “RR” as well as Annexes “A” to “I” of the affidavit of Peter J. Rizzo.

“5.2. There is neither legal nor factual basis for Opposer’s claim that it will be damaged by the registration of the trademark 3 POLO PLAYERS ON A HORSE LOGO in favor of Respondent-Applicant.

“5.3. Respondent-Applicant’s mark 3 POLO PLAYERS ON A HORSE LOGO is neither identical nor confusingly similar to any of Opposer’s marks, particularly its DEVICE OF TWO POLO PLAYERS.

As a very weak mark (as shown in Exhibits “4” to “4-h”), Opposer cannot claim the exclusive right to use the DEVICE OF POLO PLAYERS. Consequently, Opposer cannot invoke Section 123.1 (d) of the IP Code in opposing Respondent-Applicant’s application in question.

”5.4. Opposer’s marks U.S. POLOASSN; UNITED STATES POLO ASSOCIATION & LOGO; 1890 P; U. S. POLO ASSN. SINCE 1890 & DEVICE; USPA; U. S. POLO ASSOCIATED FOUNDED 1890; and DEVICE OF TWO POLO PLAYERS are not well-known internationally and in the Philippines.

“5.4.a. No competent Philippine authority has declared Opposer’s marks particularly, its DEVICE OF TWO POLO PLAYERS, to be well-known internationally and in the Philippines. None of Opposer’s marks is included in the Villafuerte Memorandum dated November 30, 1980.

"5.4.b. Opposer failed to present substantial evidence to show that its marks, particularly, its DEVICE OF TWO POLO PLAYERS have met the criteria enumerated in Rule 102 of the Trademark Regulations by which a mark is judged to be well-known.

"5.4.c. Opposer cannot invoke, therefore, Section 123.1 (e) and (f) of the IP Code in opposing Respondent-Applicant's application in question.

"5.4.d. Neither can Opposer invoke Article 6bis of the Paris Convention.

"5.5. Opposer does not use in the Philippines its DEVICE OF TWO POLO PLAYERS mark. Consequently, no confusion, mistake, or deception is likely to take place with the use by Respondent-Applicant of his 3 POLO PLAYERS ON A HORSE LOGO."

The Respondent-Applicant submitted the following evidence:

1. Exhibits "1" to "1-b" -Copies of the Acknowledgment of Filing and Trademark Application Form of Application Serial No. 4-2007-009375 taken from the file wrapper of subject application;

2. Exhibits "2" to "2-b": "3"; "4" to "4-h"- Copies of the Registrability Report, together with a print out of Opposer's then pending Application Serial No. 42007-005105 filed May 21,2007, and print outs of the Search Results made by the Examiner, taken from the file wrapper of subject application;

3. Exhibit "5" - Copy of the Deed of Assignment of Application Serial No. 4-2007009375 executed in favor of Respondent-Applicant taken from the file wrapper of subject application;

4. Exhibits "6" and "7" - Copies of the Approval of Request for Extension and the Response dated March 31, 2008 taken form the wrapper of subject application;

5. Exhibits "8"; "9" and "9-a" -Copies of the action bearing mailing date of May 23, 2008 and the response thereto, including the drawing, taken from the file wrapper of subject application;

6. Exhibits "10" and "11" -Copies of the Recommendation for Allowance and Notice of Allowance taken from the file wrapper of subject application;

7. Exhibit /112" -Sample of Respondent-Applicant's label showing the mark 3 POLO PLAYERS ONA HORSE LOGO; and

8. Exhibit "13" - Duly notarized affidavit of the Respondent-Applicant, RAMESH L. MIRPURI.

The issues to be resolved in this case are the following:

1. Whether the Opposer's marks are well-known, and

2. Whether the Respondent-Applicant is entitled to register the mark 3 POLO PLAYERS ON A HORSE.

On the first issue, Rule 102 of the Trademark Regulations provides:

Rule 102. Criteria [or determining whether a mark is well-known. In determining whether a mark is well-known, the following criteria or any combination thereof may be taken into account:

(a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;

(b) the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;

(c) the degree of the inherent or acquired distinction of the mark;

(d) the quality-image or reputation acquired by the mark;

(e) the extent to which the mark has been registered in the world;

(f) the exclusivity of registration attained by the mark in the world;

(g) the extent to which the mark has been used in the world;

(h) the exclusivity of use attained by the mark in the world;

(i) the commercial value attributed to the mark in the world;

(j) the record of successful protection of the rights in the mark;

(k) the outcome of litigations dealing with the issue of whether the mark is a well-known mark; and

(l) the presence or absence of identical or similar marks validly registered for or used on identical or similar goods or services and owned by persons other than the person claiming that his mark is a well-known mark.

The Opposer submitted evidence to show its trademark TWO POLO PLAYERS AND HORSE LOGO has been registered in many countries[3] aside from the Philippines, to wit:

1. Australia - Registration No. 1129794
   Date Registered - 14 December 2006
   Class (es) - 18, 25

2. Brazil - Registration No. 821280805
   Date Registered - 07 January 2003
   Class (es) - 25

3. Chile - Registration No. 543.683
   Date Registered - 30 June 1999
   Class (es) - 25

4. European Union - Registration No. 004998696
   Date Registered - 16 February 2007
   Class (es) - 14, 18, 25

5. Hong Kong - Registration Nio. 300821970
   Date Registered - 04 May 2007
   Class (es) - 18, 25

3 Exhibits "U", “V”, “W”, “X”, “Y” "Z", "AA", "BB" and "CC."

6. Turkey - Registration No. 200621970
   Date Registered -26 March 2007
   Class(es) -14,18,25

7. Thailand - Registration No. 276839
   Date Registered -17 September 2007
   Class(es) -25

8. Saudi Arabia -Registration No. 540/71
   Date Registered -16 September 2000
   Class(es) -25

9. New Zealand -Registration No. 764689
   Date Registered -28 September 2007
   Class(es) -25

The Opposer also submitted evidence of sales of its products bearing the mark TWO POLO PLAYERS AND HORSE LOGO, which amount to nearly one billion (US) Dollars ($1,000,000,000.00) since its inception, and likewise in the years 2005, 2006 and 2007, the duly authenticated affidavit of Mr. Peter J. Rizzo, and its extensive and worldwide advertising/promotional campaigns.[4] The evidence submitted by the Opposer constitutes at least a combination of the criteria under Rule 102 of the Trademark Regulations, to consider the Opposer's mark a well-known mark.

Going now to the second issue, it is emphasized that the essence of trademark registration is to give protection to the owner of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the article to which it is affixed, to secure to him, who has been instrumental in bringing into a market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition, and to protect manufacturer against substitution and sale of an inferior and different article as his products.[5]

In this regard, Sec. 123.1, paragraphs (d), (e) and (f), provide:

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

x x x

(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 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;

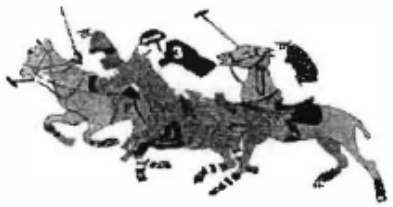
4 Exhibit "PP"
5 Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 November 1999, citing Etepha v. Director of Patents, 16 SCRA 495.

(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: Provided further, That the interests of the owner of the registered mark are likely to be damaged by such use;

Records show that the Opposer has registered more than one POLO trademarks in the Philippines, one of which being the DEVICE OF TWO POLO PLAYERS, which is the ultimate basis of its opposition to the Respondent-Applicant's trademark 3 POLO PLAYERS ON A HORSE LOGO. The Opposer filed for the registration of the DEVICE OF TWO POLO PLAYERS on 21 May 2007, and was granted Registration No. 4-2007-005105 on 22 September 2008. On the other hand, the Respondent-Applicant filed his trademark application on 29 August 2007. The competing trademarks are being used on similar goods under Class 25 of the International classification of goods.

The question is: Are the competing marks, as shown below, resemble each other such that confusion or deception is likely to occur?

Opposer's mark



Respondent-Applicant's mark

Notwithstanding the difference in the number of horses and polo players, and the direction to which the horses are "running" to, the Respondent-Applicant's mark is obviously a colorable imitation of the Opposer's mark. Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all the details be literally copied. Colorable imitation refers to such similarity in form, content, words, sound, meaning, special arrangement or general appearance of the trademark or trade name with that of the other mark or trade name in their over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article[6]. The depiction of polo players mounted on horseback and playing the sport is a highly unique and distinctive mark for use on clothing and similar or related goods. Thus, the mark becomes attached to the proprietor who first thought of using and actually used it, in commerce.

Thus, what is in comparison in this instance are not the actual technical details of the features in the competing marks. Instead, it is the idea or the concept manifested in the visual representations thereof. This is what the consumer will likely remember of the mark as used on clothing and related goods. Aptly, the idea or concept of polo players on horseback playing polo as appearing in the mark of the Respondent-Applicant is the very same idea or concept as that in the Opposer's. Accordingly, since the competing marks are used on the same goods, it is therefore, likely for confusion or deception to occur.

If Respondent-Applicant's mark is allowed for registration, the Opposer would likely be damaged. There would be confusion or deception as to the source or origin of the goods with the

6 Emerald Garment Manufacturing Corp. v Court of Appeals, G.R. No. 100098, 251 SCRA, 29 December 1995.

Respondent-Applicant riding on in the reputation and goodwill generated by the advertisement and promotion of the Opposer's mark.

The registration of the mark covered by trademark Application Serial No. 4-2007009375 thus, is proscribed by Section 123.1, paragraphs (d), (e) and (f) of the IP Code.

WHEREFORE, premises considered, the opposition is hereby SUSTAINED. Let the filewrapper of the Trademark Application Serial No. 4-2007-009375 together with a copy this Decision be returned the Bureau of Trademark (BOT) for appropriate action.

SO ORDERED.

Makati City, 30 July 2010.

NATHANIEL S. AREVALO
Director, Bureau of Legal Affairs
Intellectual Property Office