BL O/0254/24

IN THE MATTER OF UK TRADE MARK APPLICATION NO. 3618155
IN CLASS 25
IN THE NAME OF NATALIA BUZZETTI

AND IN THE MATTER OF OPPOSITION NO. OP427029
BY LIFESTYLE EQUITIES C.V.

AND IN THE MATTER OF AN APPEAL FROM THE DECISION
OF MS TERESA PERKS DATED 9 MARCH 2023

DECISION

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1. This is an appeal from the decision of Teresa Perks (the "Hearing Officer"), BL O/0261/23, dated 9 March 2023, in which she upheld the opposition by Lifestyle Equities CV ("the Opponent") to an application by Natalia Buzzetti ("the Applicant") to register the device mark shown above.

Background

2. The trade mark application was filed on 29 March 2021, for the following goods in Class 25:

> *Clothing; clothing of leather; dresses; shirts; skirts; tailleurs; trousers; trousers shorts; hosiery; sweat shirts; t-shirts; pyjamas; stockings; vest tops; boxer shorts; brassieres; slips [underclothing]; hats; bandanas [neckerchiefs]; foulards [clothing articles]; neckties; mackintoshes; overcoats; coats; swimwear; combinations [clothing]; jackets; blousons; waist belts; pelisses; neck scarves [mufflers]; gloves; dressing gowns; shoes; slippers; boots; sandals; beach clothes; footwear; bathing caps; beach wraps; bath robes; swimming trunks; beach clothing.*

3. The Opponent filed its opposition on 22 September 2021 relying on two earlier UK registered device marks:

UK00915737653 Filing date: 10 August 2016 Registration date: 09 January 2017	
UK00001259226 Filing date: 30 January 1986 Registration date: 16 March 1990 The mark is subject to a disclaimer: *Use of this mark shall give no right to the exclusive use of the words "Polo Club" and "Beverley Hills"*	

4. The specification of both earlier marks included goods in Class 25 but the specification relied upon from the '226 Mark was narrower than the range of goods covered by the '653 Mark. In those circumstances, and as proof of use was required only for the '226 Mark, the Hearing Officer carried out her assessment by reference to the more recently registered '653 Mark. The specification relied upon was:

> *Clothing; suits; tuxedos; blazers; vests; blouses; overalls; pullovers; sweaters; sweater vests; sweatpants; sweatshirts; T-shirts; shirts; polo-shirts; shirts and casual tops with long and short sleeves; halter tops; sleeveless shirts; sport shirts; tops for exercise; jeans; pants; trousers; shorts; skirts; coats; jackets (clothing); outerclothing; ponchos; raincoats; sport coats; bathing suits; swimsuits; bikinis; bikini tops; Bermuda shorts; beach clothes; bath robes; body linen (garments); underwear; undergarments; undershirts; bodysuits; boxer shorts; bras; bustiers; hosiery; stockings; lingerie; leggings; night clothes; nightgowns; nightshirts; pajamas; panties; dresses; dressing gowns; belts (clothing); socks; footwear; athletic shoes; beach shoes; booties; espadrilles; flip-flops; gym boots; heels; pumps; sandals; shoes; slippers;*

sporting and gymnastic shoes; headwear; bandannas; baseball caps; caps; hats; headbands.

5. The Opponent relied upon sub-sections 5(2)(b), 5(3) and 5(4)(a) of the 1994 Act. It filed a witness statement from its CEO, Mr Daniel Haddad.

6. There was no hearing, but the Applicant filed written submissions. The Hearing Officer upheld the opposition on all three of the section 5 objections. The opposition was also based upon sub-section 3(6), and that objection was dismissed.

7. The Grounds of Appeal were lengthy and challenged almost all parts of the decision. In summary the Grounds were:

Ground 1: the Hearing Officer erred in her assessment of the similarity of the marks;

Ground 2: she erred in assessing the Opponent's evidence of use;

Ground 3: she failed to take into account the appropriate degree of attention of the average consumer;

Ground 4: those mistakes led to errors in assessing likelihood of confusion;

Ground 5: there were similar errors in assessing passing off;

Ground 6: the assessment under s 5(3) was wrong; and

Ground 7: the Hearing Officer failed to take into account the Applicant's points on due cause.

Standard of appeal

8. It was common ground that this appeal is by way of review, it is not a rehearing. The relevant principles were not in dispute. An appeal against a decision taken by the Registrar is by way of review. Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for the appellate tribunal to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong. See *Reef Trade Mark* [2003] RPC 5; and *Actavis Group PTC v. ICOS Corporation* [2019] UKSC [2019] UKSC 15, [2019] RPC 9 at [78] to [81].

9. The principles have been summarised in numerous cases. For instance, the Respondent referred me to the Court of Appeal's decision in *Volpi v Volpi* [2022] EWCA Civ 464 at [2]. The principles have also been stated in a number of recent trade mark appeals, such as by Sir Anthony Mann in *Stitch Editing Limited v. TikTok Information Technologies Ltd* [2023] EWHC 1167 (Ch) at paragraphs [6] to [8]:

> "6. The correct approach to appeals such as this has recently been confirmed in the decision of Richards J in *Instagram LLC v Meta 404 Ltd* [2023] EWHC 436 (Ch). In that case (which was another trade marks appeal case) the judge followed the guidance to be applied in appeals generally and set out in *Volpi v Volpi* [2022] EWCA Civ 464.
>
> > "i) An appeal court should not interfere with the trial judge's conclusions on primary facts unless it is satisfied that he was plainly wrong.
> >
> > ii) The adverb "plainly" does not refer to the degree of confidence felt by the appeal court that it would not have reached the same conclusion as the trial judge. It does not matter, with whatever degree of certainty, that the appeal court considers that it would have reached a different conclusion. What matters is whether the decision under appeal is one that no reasonable judge could have reached.
> >
> > iii) An appeal court is bound, unless there is compelling reason to the contrary, to assume that the trial judge has taken the whole of the evidence into his consideration. The mere fact that a judge does not mention a specific piece of evidence does not mean that he overlooked it.
> >
> > iv) The validity of the findings of fact made by a trial judge is not aptly tested by considering whether the judgment presents a balanced account of the evidence. The trial judge must of course consider all the material evidence (although it need not all be discussed in his judgment). The weight which he gives to it is however pre-eminently a matter for him.
> >
> > v) An appeal court can therefore set aside a judgment on the basis that the judge failed to give the evidence a balanced consideration only if the judge's conclusion was rationally insupportable.
> >
> > vi) Reasons for judgment will always be capable of having been better expressed. An appeal court should not subject a judgment to narrow textual analysis. Nor should it be picked over or construed as though it was a piece of legislation or a contract."

7. So far as the decision below is evaluative, an appellate court should also approach the appeal with caution:

> "76. So, on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out a balancing task afresh but must ask whether the decision of the judge was wrong by reason of some identifiable flaw in the judge's treatment of the question to be decided, "such as a gap in logic, a lack of consistency, or a failure to take account of some material factor, which undermines the cogency of the conclusion". (*Re Sprintroom Ltd* [2019] EWCA Civ 932)

8. And last, as Richards J observed in *Instagram*, proper respect should be paid to the decision of an expert tribunal in the field in question:

> "26. Finally, it is relevant to observe that this is an appeal from a tribunal with particular expertise. As Lady Hale observed in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49 at paragraph 30, the court should approach the appeal on the basis that it is probable that an expert tribunal, charged with applying the law in their specialist field, has probably got it right.""

10. I have kept these principles in mind when considering the present appeal.

Merits of the appeal

Ground 1: *the Hearing Officer erred in her assessment of the similarity of the marks*

11. The Applicant raised a number of criticisms of the Hearing Officer's assessment of similarity of the marks and said that this led to a mistaken assessment of the likelihood of confusion. The most significant point relates to an alleged inconsistency in the Hearing Officer's analysis of the similarity between the parties' marks.

12. The Hearing Officer started by analysing the overall impressions given by both marks, saying:

> *"The applicant's mark*
>
> 38. The applicant's mark consists of two identifiable elements, namely the silhouette of a polo horse with a rider wearing a helmet represented in profile

(facing right) and the words 'U.S. GRAND POLO EQUIPMENT & APPAREL'. The figurative and verbal elements of the marks are separated by a thick horizontal line. The words 'U.S. GRAND POLO EQUIPMENT & APPAREL', in capital letters, are placed below the figurative element, are of different sizes and appear on three levels, with the words 'US GRAND' (in a medium size) being placed above the word 'POLO EQUIPMENT' (in a smaller size), and the latter being placed above the words '& APPAREL' (in a larger size). Despite being spread on three levels, the words 'U.S. GRAND POLO EQUIPMENT & APPAREL' combine to form a unit referring to the concept of a brand called 'US GRAND' (or 'US GRAND POLO') which provides polo equipment and apparel.

39. Due to its size and central position, the figurative element has considerable visual impact, although in the overall impression of the mark, it will be perceived as reinforcing the reference to the sport polo conveyed by the words 'U.S. GRAND POLO EQUIPMENT & APPAREL', with the result both elements contribute roughly equally to the overall impression.

The opponent's mark

40. The opponent's mark is made up of two distinct components, namely a figurative element comprising a polo rider on horseback facing right and holding a polo mallet and a word element comprising the words 'BEVERLY HILLS POLO CLUB' in capital letters. The words 'BEVERLY HILLS' are displayed over an arch shape above the image of the horse and rider, whilst the words 'POLO CLUB" are presented in a straight line below it. Despite the words 'BEVERLY HILLS' and 'POLO CLUB' being positioned above and below the figurative element respectively, they combine to form a unit which will be naturally understood to represent that the goods come from a polo club based in Beverly Hills.

41. Although the figurative element is likely to be perceived as reinforcing the reference to the sport polo introduced by the words 'POLO CLUB', both elements have a substantial visual impact and contribute roughly equally to the overall impression."

13. In my judgment, the central points to take from this are that in each case the Hearing Officer considered that the word and device elements of the marks form "a unit" with the meaning she ascribed to them, and in both marks the visual and word elements

contribute roughly equally to the overall impression. She made no finding that one or both marks is dominated by the word POLO or the concept of polo.

14. The Applicant pointed to the Hearing Officer's finding in paragraph 38 that the device shows "a polo horse with a rider wearing a helmet." Had the device stood alone, I agree that this would have been surprising, as the rider is not holding a mallet or obviously posed as if playing polo, however it seems to me that she extrapolated the fact that the device shows a polo pony from the use of the word polo in the words of the mark. I think that this might well be how a consumer would see the device. Hence, I am not convinced that this point advances the Applicant's case.

15. The Hearing Officer went on to compare the marks:

> **"Visual similarity**
>
> 42. The marks coincide in the word 'POLO' and insofar as they both contain a figurative element representing the silhouette of a rider on a polo horse facing right that evokes the sport of polo.
>
> 43. The representations of the figurative elements in the respective marks present a number of differences, … Nonetheless, they coincide in significant respects, including the proportions and poses of the horses - both of which are depicted galloping, in profile, facing right, with the position of the legs being very similar – which means that notwithstanding the differences, there are some striking similarities between these figurative elements. In addition, the differences relating to the word elements 'U.S. GRAND' 'EQUIPMENT & APPAREL' and 'BEVERLY HILLS' 'CLUB' in the marks are not negligible. Consequently, the marks are **visually similar to a low to medium degree.**
>
> **Aural similarity**
>
> 44. The similarities in the pronunciation of the marks at issue stem from the common presence in the marks of the word 'POLO'. By contrast, the other word elements of those marks are completely different, namely the words 'BEVERLY HILLS' and 'CLUB' in the opponent's mark and the words 'U.S. GRAND EQUIPMENT & APPAREL' in the applicant's mark. Hence, notwithstanding the differences, there is a limited degree of phonetic similarity between the marks, and I find that they are **phonetically similar only to a very low degree.**

Conceptual similarity

45. The opponent's mark will be understood as referring to a polo club located in Beverly Hills. The applicant says that the contested mark will be understood as referring to a polo event called 'U.S. GRAND POLO'. However, whilst I do not exclude that some consumers (but not a significant part of them) might read the mark as the applicant suggests, the UK average consumer would, in my view, naturally split the contested mark into two parts, namely "US GRAND" and "POLO EQUIPMENT & APPAREL" because there is no evidence that such an event actually exists (or that the average consumer is aware of it), but also because of the way the words are presented (which separates the words "US GRAND" and "POLO") and the fact that the word 'POLO' qualifies the words 'EQUIPMENT & APPAREL'. Insofar as both marks evoke the concept of polo as a sport and contain a stylised representation of a polo rider on a horseback seen in profile and facing right, they are conceptually very similar.

46. Although the competing marks also contain a number of elements which introduce different concepts, including the concept of a club, the concept conveyed by the word 'GRAND', the concept of different geographical locations (namely the US and Beverly Hills) and the concept of apparel (which is descriptive) and equipment, these concepts are not sufficient to introduce differences neutralising the common element 'POLO' which conceptually remains the critical part of both marks. In my view, the marks are **conceptually similar to a medium to high degree."**

16. The Applicant submitted that the Hearing Officer had erred in her finding at paragraph 43, because it was incompatible with her findings in paragraphs 38-41. I accept that the way in which she phrased her reasoning in paragraph 43 is surprising, given her view that each mark forms a unit as she described them in paragraphs 38-41. Moreover, her reference to the differences in wording being "not negligible" suggest that she found them to be unimportant, whereas it seems to me that from a visual point of view not only are the words different but the manner in which they are set out in the marks (especially with the arching words over the device in the Opponent's mark and the different font sizes of the Applicant's mark) is visually significant.

17. Overall, however, it seems to me that there is at least a low level of visual similarity between the marks, given the similarities of the pony/rider in each of them. In my judgment, despite some peculiarities in her reasoning, I cannot say that the Hearing Officer was plainly wrong in assessing the visual similarity as low to medium.

18. The Applicant also submitted that the Hearing Officer had erred in her findings at paragraphs 45-46, again because they are incompatible with her findings in paragraphs 38-41. It submitted that it was incompatible with those findings for her to have said "Insofar as both marks evoke the concept of polo as a sport and contain a stylised representation of a polo rider on a horseback seen in profile and facing right, they are conceptually very similar" and that "the common element 'POLO' … conceptually remains the critical part of both marks." I consider that the first of those statements, in paragraph 45, cannot be said to be wrong. Both marks do, to some extent, include a reference to the sport of polo. However, it seems to me that the Hearing Officer's analysis at 38-41 did not include any finding that the critical part of the marks, whether conceptually or otherwise, was the common element POLO, or the concept of polo. That suggests that polo is the dominant element of both marks, yet that was not what she had found. She had made a comment more or less to that effect in paragraph 35 of the decision ("although the opponent's mark gravitates around the concept of the sport polo, it contains additional figurative and word elements which contribute to its distinctiveness") but it seems to me that in paragraphs 38-41 she moved on from that point. She made clear findings that each mark would be seen as a unit, with the words and device elements of roughly equal importance, and this does not seem to me to be compatible with a suggestion that POLO (or the sport of polo) is the dominant or critical element of either mark. In my view the Hearing Officer erred in saying that this was the critical element of both marks, not least in light of her own findings.

19. I also consider that on the same basis the Hearing Officer was wrong to suggest that the other conceptual points in each mark would not "neutralise" the impact of the word POLO/polo pony device. I consider that this was a clear error in her assessment of the conceptual similarity of the marks, given her own findings about the significance of their word elements. Applying her analysis at paragraphs 38-41, she should have found a low level of conceptual similarity between the marks.

20. The Applicant said that the Hearing Officer had failed to take into account the rule of thumb that words speak louder than devices. She did not advert to that point, but I do not think that this matters given her findings in paragraphs 38-41 about the overall impression given by each mark and the significance of the words in each mark.

21. The Applicant also submitted that the Hearing Officer should have found POLO to be descriptive or at least of low inherent distinctiveness for the goods in question, a point which she considered and rejected at paragraphs 35-37. I consider that there is no appealable error in her analysis as to descriptiveness/distinctiveness in those paragraphs, given the width of both parties' specifications.

22. I therefore accept Ground 1 to the extent that the conceptual similarity between the marks should have been found to be low rather than medium to high.

Ground 2: the Hearing Officer erred in assessing the Opponent's evidence of use

23. The Applicant submitted that the Hearing Officer made numerous errors in her assessment of the Opponent's evidence of use, in the form of a witness statement of Mr Daniel Haddad, the Opponent's CEO, which went to her findings of enhanced distinctiveness in paragraph 54, goodwill in paragraph 73 and reputation for s 5(3) in paragraph 82. The Applicant made a series of points about the inadequacies of the evidence filed, which it said the Hearing Officer had not properly taken into account, leading her to reach incorrect conclusions.

24. In my judgment, there are errors in the Hearing Officer's assessment of this evidence and its impact. At paragraph 51 she said:

> "Although most of Mr Haddad's evidence is about the global success of the opponent's 'brand', what is relevant in these proceedings in the use that has been made of the mark in the UK – because, self-evidently, use outside the UK cannot show that the mark has acquired an enhanced level of distinctive character through use in the UK."

She went on to summarise at paragraph 52 what she considered to be the "pertinent evidence" from the witness statement, and I comment on some of those points below.

25. The Applicant had criticised the Opponent's evidence at some length in its written submissions below, as the Hearing Officer acknowledged. She took a number of the Applicant's points on board, saying at paragraph 53:

> " …the evidence is not without deficiencies, for example, the turnover figures relate to clothing in general and are not broken down by product, there is no indication of market share and no specific marketing figures for the UK, and there is very little in terms of examples of marketing activities over and above images from some catalogues and pictures taken at trade shows."

26. She went on:

> "However, the revenue figures are unchallenged, and it remains that as at the relevant date of 29 March 2021, the opponent had been trading for at least 15 years achieving (a) UK average sales of clothing (including menswear, womenswear and childrenswear) of more than $1.7million per annum between 2006 and 2018 and (b) UK sales of clothing amounting to over $15million in the four-year period 2018-2022 – although a part of the total sales achieved between 2018 and 2022 must relate to goods sold after the relevant date of 29 March 2021, it is highly likely that a substantial part of those sales were achieved before the relevant date. …
>
> 54. Looking at the evidence as a whole, I am satisfied that, by the relevant date, the distinctiveness of the earlier mark had been enhanced to a high degree through the use made of it."

27. The Applicant complained that the Hearing Officer had not taken proper or adequate account of the points it had raised in its submissions, and it also criticised some aspects of her analysis of the evidence. In my judgment, there were some significant defects in the evidence, in so far as it related to the earlier marks, so that the long list of "pertinent" points set out by the Hearing Officer in paragraph 52 were in many cases not pertinent at all.

28. First and in my view most importantly, in paragraph 52 of the Decision the Hearing Officer referred throughout to evidence about "the Brand." That term was defined in Mr Haddad's witness statement as the name BEVERLY HILLS POLO CLUB, so that the Brand is not the same as either of the earlier marks. The Hearing Officer did not comment on that point, nor did she discuss the Applicant's further point that Mr

Haddad's evidence showed that the Opponent has a number of different logos which it uses, which he defined as the "BHPC marks." It is not clear to me that the BHPC marks are meant to include the earlier marks, but certainly they include other logos which are not the same or even particularly similar to the earlier device marks in issue. Most of the evidence related to the Brand, such as marketing efforts relating to the Brand, and to its renown, whilst almost none of the evidence related specifically to the earlier marks, or to use in the UK. Such narrative evidence as there was on these central points was almost completely unsupported by the documents Mr Haddad exhibited.

29. Mr Haddad said that the BHPC marks were used in a variety of ways, sometimes with the words BEVERLY HILLS POLO CLUB or the acronym BHPC. He did say that the earlier marks are used on garment labels, but no labels were exhibited by him. He also mentioned the marks being used on the Opponent's website, and gave some figures for UK visitors to it, but with no supporting documents showing the webpages.

30. The Hearing Officer set out in some detail Mr Haddad's claims about the Brand's reputation etc, but there is nothing in paragraph 52 which shows that she considered the question of whether he had proved that the two earlier marks had a reputation. Certainly, as the Applicant pointed out in its submissions below, the passage in the witness statement which is headed "Recognition by Third Parties" relates to the renown of the Brand, not of the earlier marks, or even the various BHPC marks. When dealing with the s 5(3) objection, the Hearing Officer made a comment at the end of paragraph 82 about the nature of the BEVERLY HILLS POLO CLUB brand, which must have related to the Brand in general, rather than to the two earlier marks.

31. In my view, these were errors in the Hearing Officer's analysis. What the Opponent needed to do was prove enhanced distinctiveness, goodwill and reputation in the two earlier marks, in relation to the goods relied upon, and only in the UK. The problem was not simply that the evidence made no attempt to break down sales by reference to different categories of clothing, a point which the Hearing Officer did note, but that most of the evidence did not clearly show use of the earlier marks as opposed to the Brand or other BHPC marks.

32. The lack of specificity of Mr Haddad's narrative might of course have been cured had the exhibits to his witness statement clearly shown use of the earlier marks on relevant

goods in the UK. However, the witness statement showed remarkably little use of this kind. The Hearing Officer noted the evidence about the use of "look books" and marketing material provided to the Opponent's licensees, but there was no evidence of the scale of use of such look books, nor was it said that these were made available to the public in the UK. The only look book in evidence was for footwear and Mr Haddad did not specify that this was used in the UK.

33. The Hearing Officer mentioned the Opponent's evidence as to marketing but did not comment on the fact that the marketing figures given do not relate to the UK. She mentioned the evidence of the Brand being showcased at trade and fashion shows, and said that the earlier mark could be seen in use in relation to casual shoes and clothing. However, Mr Haddad's exhibit includes just a single page which is marked as relating to a show in the UK. This does clearly show one of the earlier marks on what looks like an empty trade show stand, but no merchandise is displayed, in contrast to the pages showing goods marketed in Italy and other EU countries. In the circumstances, the bulk of the trade show evidence was not pertinent to the opposition, and the Hearing Officer erred in finding that such evidence showed use of the earlier marks in relation to casual shoes and clothing in the UK.

34. In paragraph 53, as set out above, the Hearing Officer noted some of the deficiencies in the evidence. However, it appears that she thought that these were overcome by what she said was the unchallenged evidence of revenue figures. It is right that the Applicant had not challenged Mr Haddad's veracity, but it had criticised his figures in its written submissions, both because they were not broken down by reference to particular goods, and because they did not relate to particular BHPC marks. The former point is a good one and had it been necessary for the Hearing Officer to assess whether the Opponent had proved use of the '226 mark, she could not have decided what would have been a fair specification on the basis of the evidence provided. However, the latter point appears to me to ignore Mr Haddad's evidence that all of the Opponent's clothing bears one of the earlier marks. That being so, I consider that the Hearing Officer cannot be said to have erred in finding that the earlier marks had been used in relation to clothing sold in the UK.

35. In paragraph 54 the Hearing Officer did not specify the goods in relation to which she found that the marks' distinctiveness had been enhanced, nor did she do so when taking enhanced distinctiveness into account in paragraph 59. The Applicant complained on the appeal that the Hearing Officer had not appreciated how low the Opponent's figures were, as a proportion of the enormous clothing market in the UK. They complained that she had underestimated the size of the market. That may be right, but I am not sure how much of an impact that would have had upon her conclusions.

36. In my view, she was entitled to find that the earlier marks had been used in relation to clothing sold in the UK, but I consider that her apparent acceptance of a good deal of evidence that was not relevant (as relating to the Brand, not the earlier marks, and as showing non-UK use) led her into error in finding that such use had enhanced the distinctiveness of the earlier mark to a high degree. Given the paucity of evidence about the use of the earlier marks in the UK, I consider that the Hearing Officer should not have found enhanced distinctiveness at all.

Ground 3: she failed to take into account the appropriate degree of attention of the average consumer

37. Although this point was run in wide terms in the Grounds of Appeal, at the hearing counsel limited his point to a few specific and rather unusual items of clothing in the Applicant's specification. The Hearing Officer had found the average consumer to be a member of the general public who would select the goods with a medium degree of attention. It does not seem to me that the Hearing Officer made any error in this regard, even for the more unusual goods in the specification, given that all of them are items of clothing, and the Opponent's mark covers clothing of all kinds. I reject this Ground of Appeal.

Ground 4: errors in assessing the likelihood of confusion

38. The Applicant criticised the Hearing Officer's assessment of the likelihood of confusion. She said in particular:

> "60. Even though the graphics of the figurative elements have dissimilarities, these are not striking points of dissimilarity, and are not sufficient to dispel the relevant consumer's impression that the figurative elements of the marks, perceived as wholes, are reasonably highly similar in their presentation of the silhouette of a polo rider galloping on a horseback depicted in profile and facing right with the position of the

horse and its legs being very similar. Further, both marks gravitate around the concept of the sport polo and include the word 'POLO'. It must also be noted that since neither the applicant's goods nor the opponent's goods are identified as being for use in the game of polo (being various items of clothes, footwear or headwear disconnected to polo playing), in both marks the reference to polo playing - introduced by both the figurative elements and the word 'POLO' - is distinctive.

61. However, I also bear in mind that the word 'POLO' is combined in each mark with different verbal elements to create separate units; in the contested mark are the words 'US GRAND POLO EQUIPMENT & APPAREL' and in the opponent's mark are the words 'BEVERLY HILLS POLO CLUB'. Further, the presentation of the word elements of the marks is different, because the words in the earlier mark are positioned above and below the device on an arched line (at the top) and a straight line (at the bottom) whilst the words in the contested mark are positioned below the device on three separate levels.

62. Having carefully considered all of the above, my conclusion in that, on balance, there is a likelihood of confusion. I reach this conclusion because (a) the goods involved are identical (or highly similar) and are not goods for use in polo playing, so the concept of the game of polo is distinctive for the goods at issue and the competing marks could be used in relation to the same types of fashion goods targeting the same segment of the market, (b) both marks contain devices based on horse riding polo players which are distinctively similar (to a reasonably highly degree) and create highly similar overall impressions, (c) the devices in the respective marks are distinctive and have considerable visual impact reinforcing the *"Polo"* message conveyed by the marks, and (d) the earlier mark (including the device) has a high degree of distinctiveness.

…

64. Having considered all of the above, my conclusion is that there is a likelihood of direct confusion because the average consumer paying a medium degree of attention is likely to recall the polo link and a very similar device (to which the user's eye will be drawn) and is likely to directly confuse the later mark with the earlier mark.

65. With regard to the significance to be attached to the word elements of the marks as a distinguishing feature, although the words in the marks tend to differentiate them, they do not do so to a degree that is sufficient to rule out any likelihood of confusion. This is because both marks gravitate around the distinctive concept of playing polo and the concept of a US-based geographical location – Beverly Hills

being based in the US. Further, the other verbal elements of the marks are all less distinctive than the words 'POLO' because the words 'EQUIPMENT & APPAREL' have no trade mark significance in the perception of the contested mark as whole (although they are not invisible) and the word 'CLUB' is qualified by the word 'POLO'. What matters is how consumers react to the overall combination of the words and figurative elements and in this case, it seems to me that the elements of similarity between the marks at issue prevail over the elements of dissimilarity.

66. **There is a likelihood of confusion. The opposition based upon Section 5(2)(b) is successful."**

39. The Applicant again submitted that the Hearing Officer's findings were incompatible with her own views as to the overall impression given by both marks. I have discussed that point above and in my judgment that the Hearing Officer's reasoning as to the likelihood of confusion does not reflect her views as to the marks' respective overall impressions. It contains a number of errors. Mr Wood properly conceded that if the Hearing Officer had got the comparison of the marks wrong, that meant that her analysis of the likelihood of confusion was also incorrect.

40. First, in paragraph 59 the Hearing Officer took into account her incorrect conclusion that the earlier marks have a highly enhanced distinctive character. Then in paragraph 60 she referred to both marks gravitating around the concept of the sport of polo. I have already criticised that finding in terms of the conceptual similarity of the marks, given her views as to the overall impressions of the marks. I would add, though, that had the Hearing Officer been entitled to make and rely on that point, it could have pointed her away from finding a likelihood of confusion because of the inclusion of the polo pony/rider elements in both devices. I say that in light of comments made by Miles J at [51] of *Lifestyle Equities CV v The Copyrights Group Ltd* [2021] EWHC 1212 (Ch) [2021] F.S.R. 32 and (in a judgment handed down after the Hearing Officer's decision in this case) by Mellor J at [213] of *Lifestyle Equities C.V. v Royal County Of Berkshire Polo Club Ltd* [2023] EWHC 1839 (Ch); [2023] F.S.R. 22:

"213 Overall, the existence and prominence of RL [Ralph Lauren] Polo … and of other 'polo-themed' brands in varying degrees in other markets, all using variants of horse and rider motifs, indicates that, with RL Polo as the exception, the average

consumer cannot rely on the motif as reliably indicating trade origin. In a sense, for a polo-themed brand, a horse and rider motif of some sort is almost *de rigeur*. Therefore, the average consumer has to rely on other material in the branding as well as indicating origin. This, of course, is consistent with the notion that the average consumer normally views the Mark and the Sign each as a whole and does not dissect either into its constituent elements."

41. Secondly, it seems to me that in paragraph 61 the Hearing Officer merely acknowledged the differences in the word elements and their presentation without weighing that point at all in the balancing exercise in paragraph 62. Thirdly, in paragraph 62 the Hearing Officer referred to both marks creating highly similar overall impressions, which is inconsistent with her earlier findings.

42. Then in paragraph 64 it seems to me that the Hearing Officer concentrated unduly on the figurative elements of the marks, which suggests that she was not considering the impact of the marks as a whole. This led her to say in paragraph 65 that the differences in wording between the marks could not rule out a likelihood of confusion. This seems to me to be plainly wrong. In particular, in paragraph 65 she found the references to Beverly Hills on the one hand and the U.S. to be a point of similarity, yet in paragraphs 38-41 she had appeared to find (rightly in my view) that these were points of distinction between the marks.

43. The Opponent asserted that the level of conceptual similarity between the marks would differ when assessing the likelihood of confusion from when assessing the similarity of the marks. I do not accept that submission. In my view, the tribunal must assess the similarity of the marks and apply its existing analysis of that point as part of its global assessment of the likelihood of confusion. There is no scope for applying some different standard at that stage, where all the threads of the global assessment are drawn together.

44. For all these reasons, I find that the Hearing Officer erred in assessing the likelihood of confusion. In my judgment, comparing the marks as a whole, bearing in mind the differences of wording and the overall impression the marks give, as found by the Hearing Officer, there is no likelihood that the average consumer would mistake one

mark for the other, even allowing for the identity of the goods and for imperfect recollection.

45. The Hearing Officer did not consider a likelihood of indirect confusion and there was no Respondent's notice asking for a finding of such confusion.

46. I therefore consider that Ground 4 of the Grounds of Appeal succeeds, and the objection based upon s 5(2)(b) fails.

Ground 5: there were similar errors in assessing passing off

47. The objection under s 5(4)(a) was again based upon the logo as shown in the '653 mark. The Hearing Officer's reasoning in relation to this point was brief. At paragraph 73 of the Decision, when considering the question of goodwill she said that, based on the same evidence, she was:

> "satisfied that at the relevant date the Opponent had goodwill in the ['653] mark in relation to clothing and footwear most of which appear to fall within the sub-category of casual clothing and footwear."

48. I have already expressed my concerns about the Hearing Officer's analysis of the evidence in so far as it related to clothing. The only evidence which could substantiate a claim to goodwill is, in my view, the sales figures and the evidence about the websites. The marketing figures, exhibits from trade shows and other licensing documents do not seem to me to help establish goodwill in the UK. However on balance it seems to me that the Hearing Officer did have enough evidence before her to justify a finding of goodwill (albeit on a small scale) in respect of clothing.

49. As for her finding goodwill in relation to footwear, the Applicant submitted that there was no evidence of use of the earlier marks for footwear in the UK. The sales figures relied upon by the Hearing Officer in relation to clothing did not include figures for footwear sales. The look book to which the Hearing Officer referred did show footwear, but was not said to relate to the UK market. In my view, the evidence fell far short of showing goodwill for footwear. This finding cannot be sustained.

50. The Hearing Officer went on to find that the Applicant's mark would make a misrepresentation. She said at paragraph 74 that the similarities discussed in respect of the s 5(2)(b) grounds would mislead the relevant public "into purchasing the applicant's goods in the belief that they are the opponent's goods." As Mr Wood properly conceded at the hearing, if her findings on s 5(2)(b) fall away, then so do her findings on s 5(4)(a). In my view, for the reasons I have given above in relation to the likelihood of confusion, there is no potential for misrepresentation of this kind to arise by use of the Applicant's mark.

51. The appeal succeeds on Ground 5 as to s 5(4)(a).

Ground 6: *the assessment under s 5(3) was wrong*

52. The Hearing Officer's analysis of reputation as the basis of the s 5(3) objection also related back to her findings based on Mr Haddad's evidence. At paragraph 82 she said that the mark:

> "enjoyed a good level of reputation in the UK for casual clothing and casual footwear at the relevant date. An important aspect of the distinctiveness and reputation of the Opponent's BEVERLY HILLS POLO CLUB brand is that [it is] a premium lifestyle brand selling high-quality casual clothing and footwear for use off the polo field."

53. In my judgment, the reference to footwear is once again mistaken, and the last sentence of paragraph 82 again reflects a mistake on the part of the Hearing Officer, in not drawing a proper distinction between evidence as to the distinctiveness and reputation of "the Brand" and the more limited evidence relating to use of the earlier mark in the UK. Had the Hearing Officer not erred in this way, had she noted the lack of evidence as to marketing, publicity and renown in the UK, for the marks relied upon ,as opposed to the Brand, it is not clear to me that she would have found the mark to have a reputation at all. In my judgment, the evidence did not establish the necessary reputation.

54. The Hearing Officer found a link would be made between the marks taking into account her view of the similarity of the marks, her view that the earlier marks have a good level of reputation in the UK and the likelihood of confusion which she had found. At

paragraph 85, the Hearing Officer added that even had she not found a likelihood of confusion, she would have found such a link. She gave no reason why that would be so.

55. At paragraphs 86-92 she went on to find that the use of the Applicant's mark would take unfair advantage of the earlier mark, following her finding of a likelihood of confusion. At paragraph 87, she added that even if she was wrong about the likelihood of confusion, she would have found a link and unfair advantage.

56. However, the Opponent's pleaded case in its TM7 was based upon squarely there being a likelihood of confusion. The Hearing Officer was therefore wrong to consider whether these aspects of the s 5(3) objection might be established in the absence of a likelihood of confusion. In my judgment, it was not open to her to find a link or unfair advantage without there being a likelihood of confusion, and given my own findings above that there is no likelihood of confusion, the s 5(3) objection must fail.

57. In the circumstances, I need not consider the Applicant's claim to have due cause to use its mark, which was pleaded, but which the Hearing Officer failed to consider.

Conclusions

58. For all these reasons, the appeal succeeds. The application may proceed to registration.

59. As the successful party, the Applicant is entitled to a contribution towards its costs. Applying the usual scale, I will order the Opponent to pay the Applicant £1600 in respect of its costs of the appeal. I will also order it to pay the Applicant £1200 in respect of its costs below. Both sums are to be paid by 5 pm on 15 April 2024.

Amanda Michaels
The Appointed Person
25 March 2024

Mr Sam Carter instructed by **Maguire Boss** appeared for the Appellant/Applicant

Mr Aaron Wood of **Brandsmiths** appeared for the Respondent/Opponent.