

O-292-07

**IN THE MATTER OF AN APPLICATION TO PROTECT INTERNATIONAL
REGISTRATION NO. 855386 IN THE NAME OF POLO CLUB**

AND

**OPPOSITION THERETO UNDER NO. 71289
BY COMMUNE DE SAINT-TROPEZ**

**IN THE MATTER OF an application
to protect international registration
No. 855386 in the name of
Polo Club and opposition thereto
under No. 71289 by
Commune de Saint-Tropez**

Background

1. On 27 April 2005, Polo Club applied to extend the protection of their trade mark registered under the Madrid Protocol to the United Kingdom. The trade mark is set out below:



and is for the following specification of goods and services:

Class 25

Ready-made clothing for men, women and children, knitwear and hosiery, lingerie, underwear, pyjamas, dressing gowns, peignoirs, sweaters, skirts, dresses, briefs, trousers, jackets, coats, furs (clothing), costumes, shirts, layettes, ties, shawls, foulards, stoles, scarves, belts (clothing), gloves (clothing), woolly hats, headgear for wear, caps; socks, stockings, tights; footwear (with the exception of orthopaedic footwear), boot liners, slippers, boots; swimming costumes and shorts; waterproof clothing.

Class 28

Games, toys, card, board or table games, and their component parts; draughts sets, chess sets, parlour games for adults and children; lottery games; games of chance, knowledge, skill and forecasting; playing cards; gymnastic and sports articles (except clothing, footwear and mats); automatic games and apparatus for electronic games (pocket or otherwise) other than prepaid apparatus and apparatus designed for use only with a television set.

Class 41

Training, education, entertainment; organisation and conducting of conferences, colloquiums, workshops, conventions, seminars and competitions (education or entertainment); production of films, films on videotapes and radio broadcasts, radio

and television entertainment, videotape, radio and television programme editing, organisation of exhibitions for cultural or educational purposes, sports and cultural activities, organisation of sports competitions, organisation of shows (services of an impresario); publication of books and texts (other than publicity).

2. On 3 February 2006 Commune de Saint-Tropez filed notice of opposition against this designation, the grounds under Section 5(2)(b) based on the opponent's own International Registration No. 705249 and Community Trade Mark No. 1030584.

3. The applicant filed a counter-statement denying similarity of the respective marks for there to exist a likelihood of confusion, It acknowledged that identical goods and services in classes 25 and 41 of the respective specifications were involved but denied any similarity in respect of goods in class 28.

4. Both parties filed evidence. Neither requested to be heard and the applicant alone filed written submissions in lieu of a hearing. After a careful study of all the papers I give this decision.

Opponent's evidence

5. This takes the form of a witness statement by Sarah Elizabeth Kenyon and is dated 10 October 2006. Miss Kenyon is a consultant for Miller Sturt Kenyon, the opponent's representatives in these proceedings.

6. Ms Kenyon attaches to her witness statement, exhibit 1, which is a trade marks decision from the French National Institute of Industrial Property (INPI), along with a certified English translation thereof. The decision relates to proceedings involving the trade marks Polo Club Saint-Tropez Haras De Gassin and device as in these proceedings and Polo Cup International Saint-Tropez.

Applicant's evidence

7. This is a witness statement by Puravee Shah dated 11 January 2007. Ms Shah is a trade mark attorney employed by Murgitroyd & Co, the applicant's representatives in these proceedings. Ms Shah confirms she is authorised to submit the witness statement of behalf of the applicant.

8. Ms Shah makes comments on the irrelevance of the decision filed as the opponent's evidence. I do not intend to summarise these comments but will take them into account as appropriate. At PS1 Ms Shah exhibits a copy of another decision issued by INPI. The document is in French and no translation is attached as part of the evidence.

9. Ms Shah states that Saint-Tropez is the name of a town on the French Riviera with an estimated population of 5,542 and a transient population of tens of thousands in the summer months. She states that Saint-Tropez is a fashionable beach resort with a worldwide renown and for many years has been associated with high fashion. At PS 2 Ms Shah exhibits an extract taken from a number of websites on 11 January 2007 to support her claims.

10. Ms Shah concludes her statement by making various comments about the respective marks which I do not intend to summarise but will consider as appropriate.

11. No further evidence was filed by either party.

Decision

12. Section 5(2)(b) of the Act states:

“ 5.-(2)A trade mark shall not be registered if because -

- (a)
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

13. The term “earlier trade mark” is defined in section 6 of the Act as follows:

“6.-(1) In this Act an “earlier trade mark” means-

- (a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

14. The marks relied on by the opponent are earlier trade marks within the definition of Section 6 of the Act. The opponent is not subject to the requirement to show proof of use of these marks under the provisions of The Trade Marks (Proof of Use, etc.) Regulations 2004.

15. In determining the question under Section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77 and *Marca Mode CV v Adidas AG and Adidas Benelux B.V.* [2000] E.T.M.R.723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors: *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question: *Sabel BV v Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant –but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture he has

kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen B.V.* paragraph 27;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki v Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 29.

16. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the goods and/or services, the category of goods and/or services in question and how they are marketed.

17. Both parties filed evidence comprising decisions issued in disputes adjudicated upon by the French equivalent of the Trade Marks Registry. Although the applicant did not file an English translation of the decision as part of its evidence, it did file a translation as part of its written submissions. This seems to me to be a rather unsatisfactory position however, the opponent did not object to this course of action and for reasons which will become clear, I intend to say no more about it.

18. For the reasons given by the Appointed Person in *Zurich Private Banking*, BL O/201/04 and referring to *Henkel KGaA v Deutsches Patent-und Markenamt*, Case C-


218/01, different national offices are not competent to adjudicate on the correctness or otherwise of each other's determinations. Neither are they required to treat each other's determinations as binding. The Appointed Person went on to say:

“That is not to say that each of them should or will simply ignore determinations of the others. The general principle is that each of them should give determinations of the others such weight (if any) as they might fairly and properly be said to bear in the decision-taking processes they are required to undertake independently of one another.”

19. The decisions filed in evidence are decisions of the French Office which was considering the impact of marks on the average consumer in that country. I am required to approach the marks from the perspective of the average consumer in this country.

20. A straight comparison of each of the respective marks shows that identical goods and services in classes 25 and 41 are involved, in that the goods and services protected by the opponent's registrations and relied upon by it in this opposition, are wholly contained within the specification of the applicant's mark. I note the opponent has given no explanation of why it thinks the applicant's goods in class 28 are in any way similar to the goods and services for which its earlier marks are protected: I do not consider them to be similar.

21. For ease of reference, I set out the respective marks below:

Applicant's mark	Opponent's Marks
	International Trade Mark 705249 SAINT-TROPEZ
	Community Trade Mark 1030584 SAINT-TROPEZ

22. No evidence of use of the marks relied on by the opponent has been filed and therefore it cannot rely on any enhanced reputation. Whilst the two marks relied on by the opponent differ, in that they are presented in slightly different typefaces, the difference is minimal and adds nothing of any significance to my consideration of the respective marks. Both of the opponent's marks are for the words Saint and Tropez separated by a hyphen. The applicant's mark consists of a device of a horse almost entirely contained within an incomplete circular flourish. The horse appears to be running in front of two posts and is carrying a rider who appears to be wielding a polo mallet above his head. The whole is contained within a circular border which contains the words POLO CLUB SAINT-TROPEZ above the device and the words HARAS

DE GASSIN below it, each set of words separated by a small diamond shape “dot”. The mark is subject to a claim to colour.

23. To the extent that each of the respective marks contain the words SAINT-TROPEZ, there must be a degree of similarity between them in terms of appearance and sound. The words SAINT-TROPEZ, however, are not dominant within the applicant’s mark. They appear after the words POLO CLUB and the mark also contains the comparatively large device elements as well as the words HARAS DE GASSIN.

24. The opponent’s marks bring to mind a geographical location whereas the applicant’s mark brings to mind a polo club located in or connected with a geographical location. Given the well-known British unfamiliarity with foreign languages, I do not consider the average consumer, who, given the goods at issue, would be the general public, would be aware of the meaning of the words HARAS DE GASSIN and thus I do not consider they would have any particular influence on the conceptual meaning of the mark as a whole for that average consumer.

25. Whilst I am prepared to accept that Saint-Tropez is a well-known French town, there is no relevant evidence before me to support the applicant’s claim that Saint-Tropez has any particular reputation in respect of clothing. The earlier marks have a moderate degree of inherent distinctiveness.

26. Taking all factors into account and adopting the global approach required, I have no doubt that even where there is identity of the respective goods and services, and allowing for the imperfect picture the consumer may have kept in mind, the differences in the respective marks are such that the average consumer will not be led into believing that the goods and services come from the same source. There is no likelihood of confusion and the opposition under section 5(2)(b) fails.

Costs

27. The opposition having failed, the applicant is entitled to an award of costs. I take into account the fact that a decision has been reached without a hearing taking place, though with written submissions having been prepared by the applicant, and that the evidence filed was minimal. I order the opponent to pay the applicant the sum of £700 as a contribution towards its costs. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of October 2007

**Ann Corbett
For the Registrar
The Comptroller-General**