

O-129-16

IN THE MATTER OF THE TRADE MARKS ACT 1994

**AND IN THE MATTER OF TRADE MARK APPLICATION NO. 3057681
IN THE NAME OF HQ ACCOUNTANCY SOLUTIONS LTD**

**AND IN THE MATTER OF OPPOSITION NO. 403205
BY THE POLO/LAUREN COMPANY LP**

**APPEAL BY HQ ACCOUNTANCY SOLUTIONS LTD
FROM THE DECISION OF
MR OLIVER MORRIS DATED 26 OCTOBER 2015**

DECISION



1. This is an appeal from a decision of Mr Oliver Morris on behalf of the Registrar, number BL O/501/15, in which he upheld the opposition to the trade mark application in the name of HQ Accountancy Solutions Ltd ("HQ") which had been brought by The Polo/Lauren Company Ltd ("the Opponent") on the basis of sub-section 5(2)(b) of the Trade Marks Act 1994.
2. For the reasons set out below, I dismiss the appeal.

Background

3. On 29 May 2014, HQ filed an application to register the trade mark shown below ("the HQ Mark") for the following goods in Class 25: Clothing, footwear, headgear; Clothing for horse-riding [other than riding hats].



4. After some exchanges between the UKIPO and HQ, the application was accepted for registration and was published for opposition purposes on 8 August 2014. The opposition was filed on 10 November 2014.
5. The opposition was brought pursuant to sub-sections 5 (2)(b), 5(3) and 5(4)(a) of the Act. The earlier marks relied upon for the purposes of sub-sections 5 (2)(b) and 5(3) either consisted of or included the word POLO. I set these out below, with some abbreviation of the specifications for convenience:

	Mark		Specification
1	UK Trade Mark No. 1431976 Registered on 28 Jan 1994	POLO	Class 25: articles of clothing for men, women and children ... not including clothing designed for use while playing polo ... polo neck sweaters and babies napkins
2	UK Trade Mark No. 1161232 Registered on 14 July 1989	POLO	Class 25: Slacks, jackets; jeans and sports footwear, all being articles of clothing; ... not including clothing for use in horse riding or the playing of polo
3	Community Trade Mark No. 404334 Registered on 12 Aug 2010.	POLO	Class 25: Clothing, underclothing; shoes and footwear; headgear; ... not including garments with polo necks, and ... sports clothing intended for use in playing polo
4	Community Trade Mark No. 8612871 Registered on 8 June 2010	POLO  RALPH LAUREN	Class 25: Clothing, footwear, headgear
5	Community Trade Mark No. 8814451 Registered on 8 June 2010	POLO JEANS.CO	Class 25: Clothing, footwear, headgear
6	Community Trade Mark No. 8928772 Registered on 10 Oct 2011	POLO TENNIS	Class 25: Footwear, headgear.
7	Community Trade Mark No. 9624784 Registered on 7 July 2011	POLO DENIM & SUPPLY	Class 25: Clothing, footwear, headgear;
8	Community Trade Mark No. 9417973 ¹ Registered on 14 March 2011		Class 25: Clothing, footwear, headgear

¹ There is a typographical error in paragraph 16 of the Hearing Officer's decision, where he gives the registration number of this CTM as 9624784, i.e. he repeats the number of mark 7 in the list. However, the correct number for this CTM does appear in the TM7.

6. In addition, the Opponent relied upon its goodwill in the mark POLO, which it claimed to have been using in the UK since at least the 1960s.
7. The first two marks listed in the table above were subject to proof of use, on the basis that the Hearing Officer explained in paragraphs 18 and 19 of his decision. HQ put the Opponent to proof of use only of the first of those, namely UK Mark 1431976 (mistyped in the Form TM8 as 143976).
8. The Opponent has been represented throughout these proceedings by its solicitors, Mishcon de Reya, whilst HQ has acted through its sole director and shareholder, Ms Nicole Fowler. Both parties filed evidence. Neither party requested a hearing before the Hearing Officer, who therefore decided the matter on the papers before him.
9. As discussed in more detail below, the Hearing Officer upheld the opposition against all of the goods in HQ's application on the basis of sub-section 5 (2)(b) of the Act and therefore did not go on to consider the merits of the opposition brought on the basis of sub-sections 5(3) and (4)(a).
10. Ms Fowler set out the reasons for HQ's appeal in her TM55 dated 31 October 2015. The Grounds of Appeal comprise four paragraphs. In the first paragraph, Ms Fowler explained why HQ applied for the HQ Mark: she is a member of a polo club who was selling T-shirts and similar goods with polo-themed designs on them. She decided to use the name "TPOLO" in relation to that business, which is run by HQ, and purchased a website and created a gmail address using the name TPOLO. This, she said, was the reason why the company applied to register the HQ Mark.
11. The next two paragraphs of the Grounds of Appeal describe the examination of the application by the UKIPO. Objections taken by the examiner were overcome by Ms Fowler and the HQ Mark was accepted for publication.
12. The substantive part of the Grounds of Appeal is found in the last paragraph which reads:

"On 8 October 2014 I received a Notice of Threatened Opposition from the UK Intellectual Property Office that they received a TM7a from the Opponent. This opposition was filed late, 1 week after the deadline for oppositions, which is 3 months after lodging the application. The IPO have now concluded that I filed an application for the word polo and

this will confuse the public. This assumption is false. I filed an application for the word Tpolo, not polo.”

13. There are therefore two elements to the appeal: (1) that the opposition was out of time and (2) that the Hearing Officer was wrong to reject the HQ Mark on the basis that the application was for the word POLO, not the word TPOLO.
14. In the usual way, once I had received the documents relating to the appeal a date was set for a hearing. The Opponent’s solicitors responded by inquiring whether the appeal could be dealt with on paper. I invited Ms Fowler’s views on this proposal and she confirmed that she would be happy to have the appeal decided on written arguments unless I wished for the opportunity to ask questions. Having considered the papers, I decided that an oral hearing was unnecessary. I vacated the hearing date and gave directions for the sequential exchange of written submissions. Both parties duly filed submissions, for which I am grateful. I have carefully considered their submissions, together with the evidence and documents in the case, in reaching this decision.

Standard of appeal

15. This appeal is by way of review, not a rehearing. *Reef Trade Mark* [2003] RPC 5 (“*Reef*”) and *BUD Trade Mark* [2003] RPC 25 (“*BUD*”) show that neither surprise at a Hearing Officer’s conclusion, nor a belief that he has reached the wrong decision, suffice to justify interference in this sort of appeal. Instead, I need to be satisfied that there is a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong; as Robert Walker LJ (as he then was) said at [28] in *Reef*:

“...an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance to interfere in the absence of a distinct and material error of principle.”

16. The role of the appeal court was reviewed more recently by Lewison LJ in *Fine & Country Ltd v Okotoks Ltd* [2013] EWCA Civ 672; [2014] F.S.R. 11, where he said:

“50. The Court of Appeal is not here to retry the case. Our function is to review the judgment and order of the trial judge to see if it is wrong. If the judge has applied the wrong legal test, then it is our duty to say so. But in many cases the appellant’s complaint is not that the judge has misdirected himself in law, but that he has incorrectly applied the right test. In the case of many of the grounds of appeal this is the position here. Many of the points which the judge was called upon to decide were essentially value judgments, or what in the current jargon are called multi-factorial assessments. An appeal court must be especially cautious about interfering with a trial judge’s decisions of this kind. ...

...

52. I would add to that citation the statement of Lord Steyn in *Smith New Court Securities Ltd v Citibank NA* [1997] A.C. 254, 274:

‘The principle is well settled that where there has been no misdirection on an issue of fact by the trial judge the presumption is that his conclusion on issues of fact is correct. The Court of Appeal will only reverse the trial judge on an issue of fact when it is convinced that his view is wrong. In such a case, if the Court of Appeal is left in doubt as to the correctness of the conclusion, it will not disturb it.’”

17. That guidance applies to appeals from the UKIPO, see *Dalsouple Société Saumuroise du Caoutchouc v Dalsouple Direct* [2014] EWHC 3963 (Ch), [2015] ETMR 8 in which Arnold J, having cited *Fine & Country*, added at [31]:

“... the Registrar of Trade Marks is a specialist tribunal, and therefore the warning given by Baroness Hale of Richmond in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49; [2008] 1 A.C. 678 at [30], ... is apposite in this context:

“... This is an expert tribunal charged with administering a complex area of law in challenging circumstances. To paraphrase a view I have expressed about such expert tribunals in another context, the ordinary courts should approach appeals from them with an appropriate degree of caution; it is probable that in understanding and applying the law in their specialised field the tribunal will have got it right: see *Cooke v Secretary of State for Social Security* [2002] 3 All ER 279, para 16. They and they alone are the judges of the facts. It is not enough that their decision on those facts may seem harsh to people who have not heard and read the evidence and arguments which they have heard and read. Their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts or expressed themselves differently. ...”

18. I bear all of that guidance in mind on this appeal.

The merits of the appeal

19. I can deal shortly with the first point raised in the Grounds of Appeal, suggesting that the opposition was brought out of time. The Opponent's first step in these proceedings was to file a Form TM7a dated 8 October 2014. That Form was filed in time and had the effect of extending the time for filing the opposition to 3 months from 8 August 2014, namely to 8 November 2014 (as time is calculated according to TPN 1/2013).
20. It is right that the Opponent did not file its opposition until 10 November 2014. However, the opposition was still filed in time, because 8 November 2014 was a Saturday, and the opposition was filed on the next working day, Monday, 10 November 2014. This was in accordance with section 80 (2) of the 1994 Act. HQ's point is, therefore, technically incorrect, and this Ground of Appeal must fail.

21. The second Ground of Appeal relates to one of the main planks of the Hearing Officer's reasoning in his decision. Ms Fowler contends that the HQ Mark consisted of the word TPOLO, and this was the thrust of her evidence and submissions below, as on the appeal. Indeed, in her witness statement she described the Opponent as having 'wilfully' ignored the letter T in the HQ Mark. She therefore considers that the Hearing Officer was wrong to treat the HQ Mark as if it consisted of the word POLO combined with a picture of a polo mallet.

22. The Hearing Officer was clearly well aware of Ms Fowler's view that the HQ Mark consisted of the word TPOLO and considered this argument expressly in the decision. First, in paragraph 10 of the decision, he said:

"TPOLO not POLO

10. Ms Fowler took issue with the opponent referring to the applicant's mark as consisting of the word POLO alongside a device of a polo mallet. She strongly argues that the mark consists of the word TPOLO, albeit the T being stylised. She states that the mark is an acronym based on the words "t-shirts" and "polo shirts" (some of the goods the opponent sells) with a "rustic look" and graphic representation of a T. She states that it makes no mention of polo and the graphic representation is not a polo mallet. She feels that the opponent's references represent an attempt to mislead the tribunal. Ms Fowler went so far as to demand that the opponent's references to POLO to be struck out from its evidence. I declined this request. The significance of a trade mark may often be open to interpretation. It matters not what the opponent or the applicant has called it in their evidence/submissions nor how the trade mark was recorded when it was filed at the IPO. What matters is how the average consumer will perceive it, a decision which I must reach, albeit bearing in mind the arguments that have been made by the parties."

23. The Hearing Officer was correct to say that what matters in terms of the assessment of a trade mark is how it would be perceived by the average consumer for the goods or services in question. He went on, therefore, to identify the average consumer and (separately) to consider how the HQ Mark would be viewed by such a consumer. In my judgment, there is no error in that approach.

24. Having considered the validity and distinctiveness of the earlier marks and the case law on section 5(2)(b), the Hearing Officer decided at paragraph 31 to focus on the opposition based

upon CTM 404334, because it consists of the word POLO, is registered for a fairly wide specification and was not subject to proof of use. He then compared the goods in that CTM specification to the goods in the HQ Mark specification. He found that they were identical, save for the goods which were specifically excluded from the Opponent's registration, and those he later held were similar to the rest of the goods in the CTM specification.

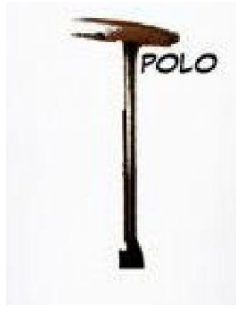
25. In paragraphs 38 - 40 of the decision, the Hearing Officer identified the average consumer and dealt with the nature of the purchasing act for the parties' respective goods. Nothing in the Grounds of Appeal suggests that HQ takes any issue with those findings by the Hearing Officer and, indeed, it seems to me that there is no criticism that should be made of them.
26. The central passage of the decision so far as the appeal is concerned is, therefore, the passage from paragraphs 41 to 47 in which the Hearing Officer compared the parties' respective marks, but especially paragraph 43 where the Hearing Officer set out his views as to how the HQ Mark would be perceived by the average consumer for the goods. He said:

“Comparison of marks

41. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

42. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:



and POLO

43. I have already touched on the dispute as to how the applied for mark will be perceived. I come to the view that the average consumer will see the applicant's mark as comprising the word POLO with a picture of a polo mallet alongside it. It will not be seen as an invented and stylised word TPOLO. The polo mallet does not blend with the word POLO in such a way to be seen in the manner suggested by the applicant. It may have been the applicant's intention to create a TPOLO mark, but that does not matter, it is the perception of the average consumer that matters. I accept that the mallet has a strong degree of stylisation and without context the average consumer may not know what it is. However, the word POLO gives it context so that its significance will be understood.

44. In terms of overall impression, the opponent's mark consists of just one element, the word POLO. That word, therefore, is the only aspect of its overall impression. In terms of the applicant's mark, the two elements (the word POLO and the polo mallet) make what I regard as a roughly equal contribution to the overall impression of the mark.

45. Aurally, the marks are identical. For the reasons already given, the applicant's mark will not be articulated as T-POLO. The only verbal element is the word POLO and I consider it unlikely that the average consumer will attempt to articulate the picture alongside that word. Consequently, both marks will be articulated as POELOW.

46. Visually, there is some similarity given the common presence of the word POLO in the mark. However, there is also a difference on account of the additional picture in the applicant's mark. Bearing in mind my assessment of the overall impressions of the marks, I consider that this equates to there being a medium (but not high) level of visual similarity.

47. Conceptually, the opponent's mark will be seen as a reference to the sport of polo. The applicant's mark will make much the same reference, although it has the added ingredient of a polo mallet. Nevertheless, given the shared significance of the sport of polo, there is a high degree of conceptual similarity."

27. I accept, as the Hearing Officer did, that Ms Fowler’s intention in creating the HQ Mark may have been to reflect the Tpolo name which HQ is using on its website (www.tpolo.co.uk) as well as more widely in relation to its goods, and that she meant to create a stylised TPOLO mark. However, in my judgment there is no error of principle or other material error in the Hearing Officer’s view that what is significant is not Ms Fowler’s subjective intentions, but how the HQ Mark would (objectively) be perceived by the average consumer. Ms Fowler submitted that the Hearing Officer was wrong because his view that the mark consists of the word POLO plus the device was only a personal opinion, but her own view that the mark consists of the invented word TPOLO is purely subjective. A Hearing Officer is required to consider a mark from the notional objective standpoint of the average consumer. That is what this Hearing Officer did, and there is nothing in his approach or reasoning which can properly be criticised as an error of principle. In my judgment, Mr Morris was fully entitled to conclude that the Mark would not be perceived as a 5-letter word beginning with the letter T but as the word POLO with a picture of an object beside it. I see no error in his conclusion in that regard, whether or not the average consumer would also recognise the object (which is not very clearly reproduced in the Mark) as a polo mallet.
28. Ms Fowler made a number of other submissions in writing to me, none of which in my judgment can properly be said to arise from the Grounds of Appeal, and which should have been pleaded. I mention them only for completeness. In particular,
- a) Ms Fowler challenged the distinctiveness of the Opponent’s marks. That was a point raised below, which the Hearing Officer dealt with at length in paragraphs 22-26 and 48-54 of his decision. Ms Fowler did not challenge those parts of the decision and I see nothing in her submissions which leads me to think that the Hearing Officer erred in any way in his findings in that regard;
 - b) Ms Fowler complained that “The registry appeal procedure has already determined that the trade mark TPOLO is unique in the appeal to the first objection by the registry. That is how the trademark first became published. The registry cannot override the appeal decision that the trademark Tpolo is unique by concluding that it is too similar to the trademark POLO ...” This reflects a misunderstanding on Ms Fowler’s part. The ‘appeal’ to which she refers related only to the question of the inherent registrability of the HQ Mark, not to the issue of its potential conflict with any earlier rights. There is no contradiction in the acceptance of a trade mark application by the IPO and an opposition later being lodged against that application by a trader.

c) Ms Fowler similarly complained that the Opponent's opposition amounted to an offence under the Theft Act 1968 or the Protection from Harassment Act 1997. There is in my view no merit at all in these complaints nor in the suggestion that somehow the Opponent has wrongly deprived HQ of its property. A trade mark application which has been accepted for publication by the UKIPO may be opposed by third parties on the grounds set out in section 5 of the Act, and this Opponent was entitled to oppose the application to register the HQ Mark as it has done. There is nothing in the papers before me to show that this trade mark opposition was inappropriate, improper or illegal, nor that the Hearing Officer went wrong in failing to make any such finding.

29. Quite apart from the fact that these points were not raised as they should have been in the Grounds of Appeal, there is in my view no merit in them.
30. In the circumstances, I do not find any error in the Hearing Officer's decision of the kind raised in the Grounds of Appeal. The Hearing Officer's conclusions on the s 5(2)(b) objection were drawn in a proper manner bearing in mind his findings, which he was entitled to make, as to the impact of the HQ Mark.
31. For these reasons, I dismiss the appeal.
32. As the losing party, of HQ Accountancy Solutions Ltd should make a contribution towards the Opponent's costs of the appeal, including its solicitors' written submissions. I order of HQ Accountancy Solutions Ltd to pay the sum of £300 to the Opponent as a contribution to its costs, to be paid by 8 April 2016. That sum is to be paid in addition to the sum of £1700 awarded by the Hearing Officer, which is to be paid within 14 days of the date of this decision.

Amanda Michaels
The Appointed Person

8th March 2016