

**DALAM MAHKAMAH TINGGI MALAYA DI KUALA LUMPUR
(BAHAGIAN DAGANG)**

SAMAN PEMULA NO. : D-24IP-21-04/2014

DALAM PERKARA satu Permohonan Cap

Dagangan No. **95009307** bagi “  ”
dalam **Kelas 9** atas nama The Polo/Lauren
Company, L.P. di 650 Madison Avenue, New York,
New York 10022, United States of America.

DAN

DALAM PERKARA satu Bangkangan terhadapnya
oleh BRG Brilliant Rubber Goods (M) Sdn. Bhd.
(dahulunya dikenali sebagai Brilliant Rubber Goods
Sdn. Bhd.) di 26 & 27, Yee Seng Godown, Lot 3,
Jalan 1/113A, Batu 4½, Jalan Kelang Lama, 58000
Kuala Lumpur;

DAN

DALAM PERKARA satu Rayuan daripada
keputusan bertarikh 17.03.2014 oleh Pendaftar
Cap Dagangan, Malaysia, menurut Seksyen-
seksyen 28(5) dan (6) Akta Cap Dagangan 1976
dan Aturan 87, Kaedah-Kaedah Mahkamah 2012.

Antara

BRG Brilliant Rubber Goods (M) Sdn. Bhd. ... Plaintiff

Dan

1. The Polo/Lauren Company, L.P. ... Defendan

2. Pendaftar Cap Dagangan, Malaysia ... Pihak

Berkepentingan

Grounds of Decision

Azizah Nawawi, J:

Introduction

- [1] This is an appeal against the decision of the Registrar of Trade Marks, Norainan Bt. Abd Latip, pursuant to section 28(5) dan (6) of the Trade Marks Act 1976 read with Order 87 Rules of Court 2012.
- [2] On 17.3.2014, the Registrar had dismissed the Plaintiff's opposition against the registration of the  mark in Class 9 via Application No. 95009307 which was filed by the Defendant, The Polo/Lauren Company L.P.
- [3] After hearing the parties, this Court had dismissed the Plaintiff's appeal.

The Salient Facts

- [4] The Plaintiff is a company incorporated in Malaysia. It has, by itself or its licensees, been manufacturing and selling a wide range of goods under the Polo marks in Malaysia and had

obtained registration for its Polo marks, namely the  mark, in Classes 25 and 28 in Malaysia on **28.08.1981**:

Trademark No.	Mark	Class
M/091943		28
M/091944		25

- [5] The Plaintiff opposed the registration of the mark  (“**Defendant’s Mark**”) in Class 9 on, *inter alia*, the ground that the Defendant’s Mark is confusingly and deceptively similar to the Plaintiff’s family of polo related trade marks (“*the Plaintiff’s POLO marks*”).
- [6] The Defendant is a Limited Partnership of the State of New York, and based in Madison Avenue, New York, United States of America. The Defendant is the proprietor of several related or family of marks such as ‘Ralph Lauren’, ‘Polo’ and/or Polo player Device (*‘the Ralph Lauren Marks’*), use on their own or in conjunction with each other in various combinations in respect of a wide range of goods, in Malaysia and in other countries. The Defendant is also a world renowned manufacturer and trader of a

wide range of articles of fashion and accessories bearing the Ralph Lauren Marks.

[7] The Defendant also owns the copyright in the device of a polo



player , ('the Artistic Work') which was first published in 1971. Under the Berne Convention for the Protection of Literary and Artistic Works 1986 to which both Malaysia and the USA are members, the Defendant also enjoys copyright protection in the said Artistic Work in Malaysia.

[8] In the present case, the Defendant's Mark is a composite mark, comprising two (2) words, '*Ralph Lauren*' and a device of a '*polo player in motion*'. The words '*Ralph Lauren*' have been derived from the name of the founder of the Defendant, Mr. Ralph Lauren, a renowned American fashion designer, whose achievement started in the year 1967 with the creation of neck ties bearing the mark 'polo'.

[9] The Defendant's Mark was filed on 7.9.1995 in relation to goods in Class 9, '*Spectacles, spectacle frames, lenses, sunglasses and parts and fittings thereof: all included in class 9.*'

[10] It is not in dispute that the Defendant has six (6) other registered trademarks in the Registry, which corresponds to the Defendant's Mark, but in other different classes:-

No	Trademark No	Presentation of Mark	Class	Date of Registration
1.	91006565	Ralph  Lauren	14	16.10.1991
2.	95009308	Ralph  Lauren	16	7.9.1995
3.	95009309	Ralph  Lauren	18	7.9.1995
4.	95009310	Ralph  Lauren	21	7.9.1995
5.	95009311	Ralph  Lauren	24	7.9.1995
6.	95109312	Ralph  Lauren	27	7.9.1995

[11] The Defendant is also the registered proprietor of ten (10) other registrations of the 'polo player device', in classes 9, 14, 16, 18, 21, 24, 25, 25, 27 and 28, with the earliest registration dated **7.12.1982** in Class 25. From these registrations, it is to be noted that the Defendant had registered the '*polo player device*' in Class 9 since 7.9.1995.

NO.	TRADE MARK NO.	REPRESENTATION OF MARK	CLASS	EFFECTIVE
i.	95009313		9	7 Sep 1995
ii.	92005052		14	16 Oct 1991
iii.	95009314		16	7 Sep 1995
iv.	95009315		18	7 Sep 1995
v.	95009316		21	7 Sep 1995
vi.	95009317		24	7 Sep 1995
vii.	M/097832		25	7 Dec 1982
viii.	95009325		25	7 Sep 1995
ix.	95009318		27	7 Sep 1995
x.	92004874		28	14 July 1992

[12] The Defendant is also the registered owner of the word mark '*RALPH LAUREN*' in Class 28 since 14.7.1992.

[13] The Defendant's application was accepted by the Registrar and advertised in the Government Gazette on 4.2.2010. The Plaintiff filed a Notice of Opposition to oppose the Defendant's application on 31.3.2010. On 17.3.2014, the Registrar dismissed the Plaintiff's oppositions and allowed the Defendant's application to register the Defendant's Mark under Class 9.

[14] Being dissatisfied with the Registrar's decision, the Plaintiff files this appeal.

The Findings of the Court

[15] It is common ground that under s. 67 of the Trade Marks Act 1976 ('TMA 1976'), this Court has the power to review, reverse or otherwise vary the decisions of the learned Registrar.

[16] It is also common ground that the burden of proof is on the Defendant, as the applicant for registration of the Defendant's

 Ralph Lauren

Mark, to satisfy the Registrar and this Court that the said Mark is registrable under the TMA 1976. In **Yong Teng Hing b/s Hong Kong Trading Co & Anor v Walton International Ltd** [2012] 6 CLJ 337 FC, Justice Zulkefli Makinudin, CJ (Malaya) held at p. 348 as follows:

"[12] It is to be noted in the present case, the respondent filed its notice of opposition before the appellant's mark could be registered. On this point it is our judgment that the onus is on the appellant to prove that he is entitled to register the "GIORDANO" trade mark."

[17] The Plaintiff's grounds of appeal are as follows:

- (i) that the Registrar failed to find that the Defendant's Marks are confusingly/deceptively similar to the Plaintiff's POLO marks and offends sections 14 and 19 of the TMA 1976;
- (ii) that the Registrar failed to find that the Defendant is not the *bona fide* proprietor of the Marks under section 25(1) of the TMA 1976;
- (iii) that the Registrar failed to consider that the Plaintiff has acquired goodwill and reputation in its business in relation to the POLO marks and that the POLO marks;
- (iv) that the Registrar failed to find that the Defendant failed to establish the distinctiveness of its Marks under section 10 of the TMA 1976;
- (v) that the Registrar has erred in law and/or facts in failing to hold that the registration and/or use of the Defendant's Mark by the Defendant would constitute passing off in common law, contrary to Section 82(2) of the TMA 1976.

Issue (i) whether the Registrar had erred in failing to find that the Defendant's Mark is confusingly and / or deceptively similar to the Plaintiff's POLO marks

[18] It is the submission of the Plaintiff that the Registrar had erred in allowing the Defendant's Mark to proceed to registration as the said Mark is not entitled to registration under Section 19 and

Section 14(1)(a) of the TMA 1976 by reason of its confusing and / or deceptive similarity to the POLO marks.

[19] The Plaintiff states that it has been using the POLO marks in relation to its goods in Malaysia long before the date of application of the Defendant's Mark, since 1981 when the Plaintiff's  mark was registered. The Plaintiff also submits that the evidence shows that there has been extensive use and promotion of the POLO marks by the Plaintiff and / or its licensees which consequently shows that the POLO marks have become distinctive of the Plaintiff and its goods in Malaysia.

[20] However, the Defendant submits that when comparing the Plaintiff's Mark and the Defendant's Mark, they are *not* confusingly or deceptively similar, as can be seen from the following plain visual comparison:

PLAINTIFF'S MARK		DEFENDANT'S MARK
	VS.	

[21] It is trite law that the likelihood of confusion must be considered at the date of the application to register the Defendant's Mark, which is 7.9.1995 for class 9. (see **Industria De Diseno Textil, SA v Edition Concept Sdn Bhd** [2005] 3 MLJ 347)

[22] In determining whether the Defendant's Mark is confusingly similar to the Plaintiff's Mark, the relevant test can be found in the Supreme Court decision of **Tohtonku Sdn Bhd v Superace (M) Sdn Bhd** [1992] 2 MLJ 63, where the Court held that:

"The 'test' which Wan Adnan J was referring to were contained in Parker J's judgment in The Pianotist Co Ltd in the following terms:

"You must take two words. You must judge them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trademarks is used in a normal way as a trade mark for the goods of the respective owners of the marks."

[23] The test formulated by the Court in the **Pianotist** case, as accepted by our Supreme Court in **Tohtonku**, in determining whether there is any likelihood of confusion can be summarised as follows:

- (i) by comparison of the conflicting marks;
- (ii) by considering the goods/services to which the conflicting marks are to be applied; and

- (iii) by considering the type of customers of the proprietors of the conflicting marks.

The underlying consideration would be all the circumstances surrounding the usage or proposed usage of the conflicting marks taken as a whole in determining whether there will be any likelihood of confusion.

- [24] It must also be emphasised that the circumstances of use to be considered must be with reference to the time the Defendant's mark was applied for registration, that is, on 7.9.1995 for class 9. In **Walton International case** (supra), which involved an appeal against the Registrar's decision to dismiss an opposition against registration for the trade mark "**GIORDANO**", the Federal Court held at page 346:

*"At the outset we would like to state here that the relevant date upon which the court has to decide whether the appellant is entitled to register the "GIORDANO" trade mark in Class 9 is the **appellant's application date** on 25 July 1992"*

- [25] In the present case, the finding of the Registrar in respect of section 14 of the TMA 1976 is as follows:

"2. The first issue at hand is under Section 14 and Section 19 of the Trade Marks Act 1976 (Act 175) which concerns the matter of identical and/or

similarity and the likelihood of deception and/or confusion. It should be a firsthand noted that there are only two registered trademarks (application no. M/091943 and application no. M/09144) under the said Marks whereas the other remaining forty eight trademarks under the said Marks are with the legal status of either “Opposition Pending” or “Accepted” or “Request for Ex-Parte Hearing” or “Objection Maintained” or “KIV Appeal” as of date. The said Opposed Mark and the said Marks are not identical to each other but they do share similarity in the usage of device of a polo player.

.....

4. *In furtherance, I am of the view that comparison of trademarks should be made as a whole and that comparison which is made by looking at both marks under the said Opposed Mark and the said Marks as a whole will further on decrease the matter of mere similarities exist between the said Opposed Mark and the said Marks especially when the “wordtalk principle” is applied here whereby the trade and the public will acknowledge the said Opposed Mark as the “Ralph Lauren” and the said Marks as “Polo” and/or “Polo Haus” only. Therefore it is safe to say that the said Opposed Mark is not similar and/or identical to any of the said Marks.”*

[26] The Plaintiff's first ground of objection is premised on section 19(1) of the TMA 1976. Section 19(1) of the TMA 1976 reads as follows:

“(1) No trade mark shall be registered in respect of any goods or description of goods –

(a) that is identical with a trade mark belonging to a different proprietor and entered in the Register in respect of the same goods or description of goods or in respect of services that are closely related to those goods; or

(b) that so nearly resembles such a trade mark as is likely to deceive or cause confusion.”

[27] Section 19(1) prohibits the registration of a trade mark that is either identical with a trade mark belonging to a different proprietor, or so nearly resembles it as is likely to deceive or cause confusion entered in the Register in respect of the same goods or description of goods.

[28] Therefore, in this appeal, the registration of  will not be allowed if:

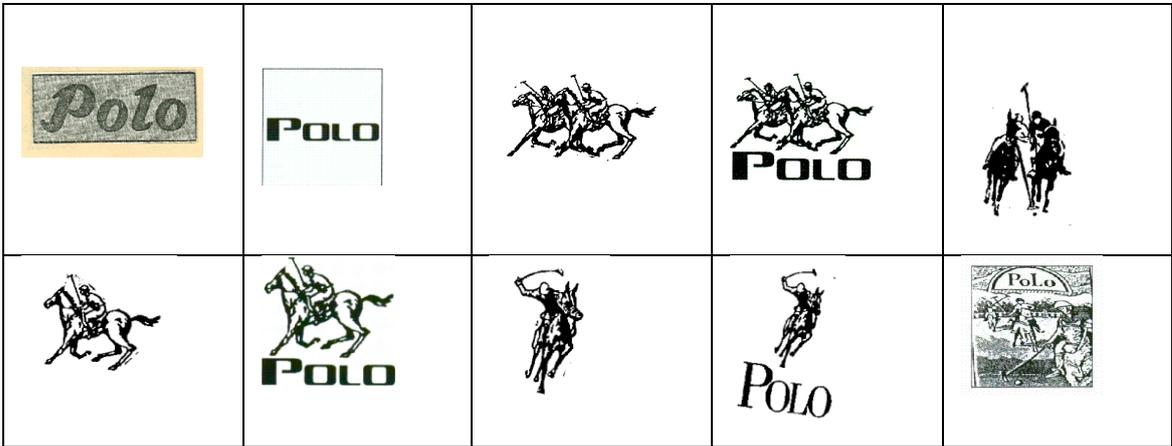
- (i)  is identical with  or so nearly resembling  as is likely to deceive and cause confusion; and
- (ii) that the Plaintiff's goods are the same goods or the same description of goods as the respondent's goods.

[29] Having considered the Plaintiff's registered mark  and the Defendant's  registered Mark, I agree with the finding of the Registrar that there is no similarity between the two marks. Visually, conceptually or phonetically, the two (2) marks are clearly different.

[30] Therefore, I agree with the finding of the Registrar that having compared as a whole of the Defendant's Mark against the Plaintiff's registered mark, the Defendant's Mark is not similar and/or identical to the Plaintiff's registered mark.

[31] Surely, the words "*Ralph*" and "*Lauren*" as well as a device of polo player on horseback makes the Defendant's Marks totally different from the Plaintiff's registered marks. Therefore, I am of the considered opinion that the use of the Defendant's trade mark would not result in confusion and deception in a manner which would offend section 19(1) of the TMA 1976.

[32] However, it is the submission of the Plaintiff that premised on section 14(1)(a) of the TMA 1976, the Defendant’s Mark is also confusingly and deceptively similar to the Plaintiff’s family of trademarks, namely "Polo", "POLO", "Polo Haus", "Polo player device", "Horse device" and/or marks containing the word "Polo" and/or "POLO" with or without the "Polo player device" or "Horse device" ("the **POLO** marks"). Some of the said POLO marks are as follows:



[33] 14(1)(a) of the TMA 1976 provides as follows:

“14. Prohibition on registration

- (1) A mark or part of a mark shall not be registered as a trade mark –
 - (a) If the use of which is likely to deceive or cause confusion to the public or would be contrary to law;”

[34] The objective and purpose of section 14(1)(a) is held by the Federal Court in **Walton International Ltd** (supra) as follows:

“[25] The objective and purpose of s. 14(1)(a) of the Act is to protect the public and consumers from instances of confusion or deception as a result of the use of two similar marks. Thus, under s. 14(1)(a) of the Act, a mark shall be refused registration if use thereof is likely to deceive or cause confusion to the public notwithstanding that it is the result of use of an earlier identical or similar mark, whether registered or not in Malaysia and which is being used in relation to good or services which may be different from that sought to be registered.” (emphasis added)

[35] It is the submission of the Plaintiff that where an earlier mark is part of a series of marks owned by the same proprietor and that part taken is the common element of this series of marks, the likelihood of confusion or deception is very high. The reason is that the public might erroneously assume that the later mark is an extension of the series of marks and thus the goods/services have the same source of origin (i.e. ‘another horse from the same stable’).

[36] In this instance, the Plaintiff submits that after making a comparison with the Plaintiff’s family of Polo marks, the similarities between the Defendant’s Mark and the Plaintiff’s POLO marks are as follows:-

- (i) Both have the device of a polo player in motion and / or the concept of polo as their central and distinguishing feature;
- (ii) Device of a polo player used in the Defendant's Mark is visually and conceptually confusingly similar to that in some of the POLO marks; and
- (iii) The general impression which will be immediately imparted on the minds of members of the trade and public in viewing the Defendant's Mark and the POLO marks would be that of a polo player.

[37] However, I am of the considered opinion that the Plaintiff cannot simply make a sweeping statement that the Defendant's Mark is similar to any of the series of mark owned by the Plaintiff. In order to claim ownership of the marks, it is incumbent on the Plaintiff to prove ownership through registration, or that it is the common law proprietor of those marks.

[38] In the case **The Infamous Nut Co Ltd's Trade Marks [2003] R.P.C. 7**, the applicant applied to register a series of four device marks each comprising a monkey eating a monkey nut in respect of "*nuts; tree nuts, ground nuts and peanuts; all being shelled and/or roasted and/or otherwise processed*" in Class 29 and in respect of "*nuts; tree nuts, ground nuts and peanuts; all being fresh and/or unprocessed*" in Class 31. The applications for the marks were opposed, on the basis of the opponent's earlier marks registered in Classes 29 and 31 for respectively roasted peanuts and fresh peanuts for the word MONKIES either alone or together with a device of a monkey holding a peanut. In the

Trade Marks Registry, the hearing officer rejected the opposition. The opponent appealed and contended, *inter alia*, that one of the factors to be taken into account in the global appreciation of the visual, oral and conceptual similarities of the marks in question was that its registered trademarks constituted a “series” or “family” of “monkey holding a nut” marks. In dismissing the appeal, it was held that:

“37. In some circumstances, it may be possible for the opponent to argue that an element in the earlier trade mark has achieved enhanced distinctiveness in the eyes of the public because it is common to a “family of marks” in the proprietorship and use of the opponent ... However, that has not been shown by the evidence to exist in the present opposition and cannot, as contended by Mr Walters on behalf of the opponent, be presumed from the state of the register in Classes 29 and 31”.

[39] From the **The Infamous Nut case**, it is clear that in order to rely on a ‘series’ or ‘family’ of polo or the polo player device, the Plaintiff must show evidence of the proprietorship and use of the ‘series’ or ‘family’ of the Plaintiff’s polo marks.

[40] The same position was taken in the **Torremar Trade Mark [2003] R.P.C. 4**, where it was held that:

“24. The view that the established significance is origin specific may be supported by evidence directed to the

*way in which the mode or element of expression has been used as the basis for a “family” of distinctively similar marks: Duonebs Trade Mark January 2, 2001 SRIS O/048/01 (Mr Simon Thorley Q.C.); The Infamous Nut Company Ltd's Application September 17, 2001 SRIS O/411/01 (Professor Ruth Annand); Lifesource International Inc.'s Application; Opposition of Novartis Nutrition AG [2001] E.T.M.R. 106, p.1227 (Opposition Division, OHIM). The view that the established significance is origin neutral **may be supported by evidence directed to the way in which the mode or element of expression has been used by traders and consumers more generally***

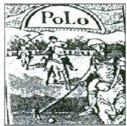
25. *In neither case can the proposition in contention be substantiated simply by evidence of entries in the register of trade marks: entries in the register do not in themselves affect the way in which marks are perceived and remembered”.*

[41] Therefore, the onus is on the Plaintiff to prove its proprietorship and use of the family of Polo marks. They cannot simply claim monopoly over the ‘horse device’ or ‘polo player device’ unless they are the registered owner or common law owner of the same.

[42] From the applications filed by the Plaintiff over the years, only



have been registered in Classes 25 and 28, whilst others have been abandoned or pending opposition:

				
Registered Class 25 & 28		Opposition Pending		Opposition Pending
				
Abandoned		Opposition Pending/abandoned for class 25 and 18	Request for ex-parte hearing	Request for ex-parte hearing

[43] With regards to its claim on proprietorship and use of the family of polo marks, in paragraph 7 of the Statutory Declaration affirmed on 6.9.2010 by Lim Chin Yee in the Opposition proceedings, the Plaintiff claims that its licensee, BRG Top-Line Marketing Sdn Bhd, has been manufacturing and selling shoes, boots and clothing articles bearing the POLO marks since 1989 and exhibited the “POLO and Horse Device” (exhibit LCY- 4).



[44] However, exhibit 'LCY – 4' is just a picture of the mark . There is nothing on 'LCY- 4' to show that this mark has been used on goods since 1989 as claimed by the Plaintiff. Exhibit 'LCY – 5 & 6' are invoices and delivery orders, to show the sale of polo pants and polo shirts. Again there is nothing from these invoices and delivery orders to show that the Plaintiff have been selling pants and shirts bearing the '*POLO and horse device*' since 1989 , before the registration of the Defendant's mark.

[45] The earliest possible '*POLO and horse device*' mark of the Plaintiff in the market can be seen from the advertisement in exhibit 'LCY – 7' in the year 1995. However, by just looking at the two marks, they are clearly different. The main difference can be seen from use of the name 'Ralph' and 'Lauren'. I find that the name 'Ralph Lauren' forms the integral and significant part of the Defendant's Mark.

 <p>(Plaintiff's Mark)</p>	<p>Ralph  Lauren</p> <p>(Defendant's Mark)</p>
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[46] The Plaintiff's main complaint is the use of the device of a polo player in motion in the Defendant's mark. The Plaintiff submits that this feature is the most important feature to be considered in

determining whether the Defendant's Mark is confusingly similar to the Plaintiff's Marks. Therefore, the Defendant's Mark would in all likelihood be referred to as a 'polo mark' in the same manner as the Plaintiff's POLO marks in view of the fact that the device of a polo player and the concept of polo are the main and integral features of both the Defendant's Mark and the POLO marks.

[47] However, I am also of the considered opinion that we cannot simply select the '*device of a polo player in motion*' in the Plaintiff's mark and compare it with the '*device of a polo player in motion*' in the Defendant's Mark, and completely ignore the words '**Ralph Lauren**'. The dangers of selecting component feature of a mark and comparing it with selective components of another mark was highlighted in the case of **Eriktico v. Erector** [1935] 52 R.P.C 136 where the Court held:

"I do not think it is right to take a part of a word and compare it with a part of the other word; one word must be considered as a whole..I think it is a dangerous method to divide the word up and seek to distinguish a portion of it from a portion of the other word."

[48] This principle would also extend to comparison of composite marks, as the Defendant's  Mark, which consist of two or more different element. In **Nokia Corporation v Truong And Others** (2005) 66 I.P.R 511, it was held that:

*“...it is a composite mark, consisting of two elements – the word “Nokia” and the trident device. **When identifying trade mark infringement, the issue is whether one or more of the “essential elements” of the mark have been infringed and this cannot be done by focussing on one element of the mark while completely ignoring other elements ...**”* (emphasis added)

[49] I agree with the Defendant that the Plaintiff has not complied with the basic principles of comparisons of marks. The Plaintiff has effectively dissected the ‘*device of a polo player in motion*’ from the Defendant’s Mark in order to make the comparison, and in doing so has completely ignored the words ‘*Ralph Lauren*’, which forms the striking feature of the Defendant’s Mark. The Plaintiff did not apply the *Pianotist* test as adopted in *Tohtonku’s* case that when comparing marks, the marks must be viewed as a whole.

[50] Further, in the case **Harrods Application** (1935) 52 RPC 65, it was held that if the element of the mark (‘*polo player device*’) is common, then potential consumers will not pay much attention to this common element, as the customers will be looking at the other feature, the uncommon element (‘*Ralph Lauren*’). At page 70 of the Judgement, the Court held that:

*“Now, it is a well recognized principle that has to be taken into account in considering the possibility of confusion arising between two trademarks, that, **where those two marks contain a common element which is also***

contained in a number of other marks in use in the market, such a common occurrence in the market tends to cause purchasers to pay more attention to the other features of the respective marks and to distinguish between them by those other features.”
(emphasis added)

[51] Therefore, even if there was a common element in the ‘*polo player device*’, premised on ***Harrods*** case, the use of the words ‘Ralph Lauren’ by the Defendant on its mark will not cause any likelihood of confusion.

[52] The same position was taken in the United Kingdom decision of **10 Royal Berkshire Polo Club Trade Mark** (2001) RPC 643. This case involved a dispute between the mark ‘**10 Royal Berkshire Polo Club**’ filed in Class 3 and the “**POLO**” family marks registered (5 earlier POLO registered marks were cited) by Polo Lauren Company in the same Class 3 for the same and similar goods. It was held that there is no likelihood of confusion between the two (2) marks despite the fact that both marks are for the same or similar Class 3 goods and both have the same word ‘POLO’ in them. It was held that:

“ ... mere association which the public might make between two trademarks as a result of their analogous semantic content is NOT in itself a sufficient ground for concluding that there is a likelihood of confusion even if the earlier mark has a particularly distinctive character

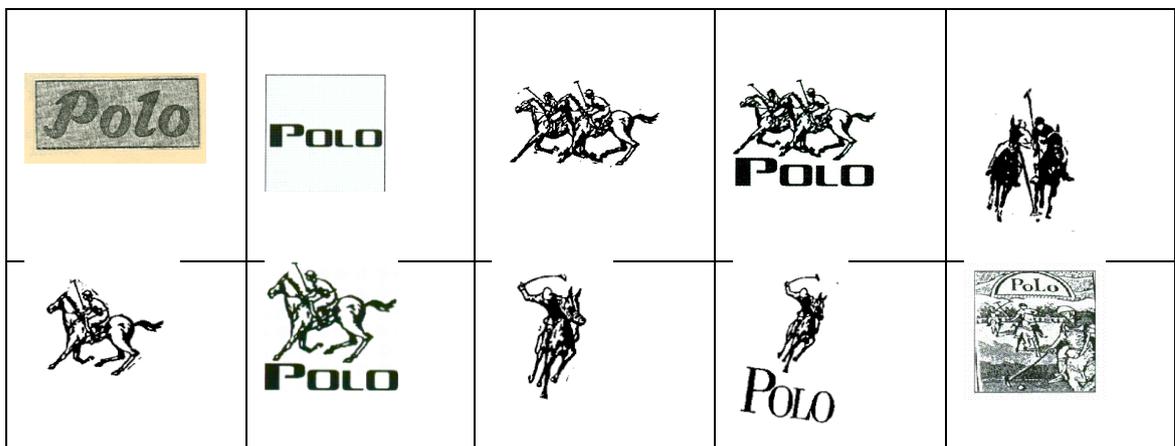
(either per se or because of the reputation it enjoys in the market place)

.....

... I am satisfied that the use of the word POLO as part of the applicant's mark does not capture the distinctiveness of the opponents earlier trademarks. I do not think that people exposed to the use of the applicant's mark would notice that it contained the word POLO without also noticing that it contained the words ROYAL BERKSHIRE and CLUB."

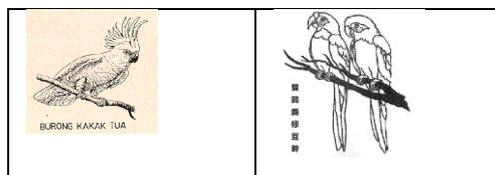
[53] Even if we accept the Plaintiff's contention that its family marks already have a reputation in the market (as the "POLO" family marks registered by Polo Lauren Company in **10 Royal Berkshire Polo Club Trade Mark**), the same is not a sufficient ground to conclude that there is a likelihood of confusion as the customers would also notice the words '*Ralph Lauren*'.

[54] Therefore, since the Plaintiff's family of marks –



is different from the Defendant's  mark, the Registrar is correct to dismiss the Plaintiff's opposition to the registration of the Defendant's marks in Class 3 and 16. As such, the Plaintiff's appeal premised on section 14(1)(a) of the TMA 1976 must fail.

[55] The Plaintiff also relied on this Court's decision in the case of **Federal Oats Mill Sdn Bhd v Teong Fatt Commodities (M) Sdn Bhd and Pendaftar Cap Dagangan**, Kuala Lumpur High Court O.S. No. 24IP-16-07/2013, decision dated 20.5.2014, where this Court has allowed the Plaintiff's application for rectification of the 1st Defendant's trade mark registration for Double Parrot device on, *inter alia*, the grounds that the 1st Defendant's trade mark was confusingly similar to the Plaintiff's trade mark comprising of a single Parrot device with the words *Burung Kakak Tua*. The marks which are held to be confusingly similar are as follows:



[56] In **Federal Oats Mill's** case, whichever way one looks at the marks, it is still '*burung kakak tua*'. But in the present case, the

Plaintiff's registered Mark is the 'polo' mark



or



whereas the Defendant's Mark



will be referred to as

the 'Ralph Lauren' aurally rather than the 'polo player device' as the Plaintiff is trying to portray.

Issue (ii) whether the Registrar erred in failing to find that the Defendant is not the bona fide proprietor of the Offending mark under Section 25(1) of the Trade Marks Act 1976

[57] Section 25 of the TMA 1976 provides that *"Any person claiming to be the proprietor of a trade mark used or proposed to be used by him may make application to the Registrar for the registration of that mark in the Register in the prescribed manner."*

[58] With regards to the opposition premised on Section 25 of the TMA 1976, the Registrar made the following findings:

"9. Proprietorship should be proven either by authorship with an intention to use or prior usage of the mark in dispute. The Applicant here had through their conduct shown an intention to use the said Opposed Mark as an indicator for goods they traded under Class 9 and they had also tendered in evidences showing their

prior usage of the said Opposed Mark. The Applicant had also stated that the said Opposed Mark is derived from the name of the Applicant's company founder, Mr. Ralph Lauren who is a renowned American fashion designer having started his business in America in the late 60's. The Applicant in addition stated that the polo player device was also the brainchild of Mr. Ralph Lauren who had commissioned the artistic works which was first published in 1971. Although the Opponent has acquired registration for several trademarks as in the said Marks, but I am of the opinion that the Applicant had genuinely used and applied for the registration of the opinion that the Applicant had genuinely used and applied for the registration of the said Opposed Mark as was submitted in all of the evidences tendered herein. This is supported by the fact that the said Opposed Mark as was discussed earlier on is different than the said Marks when compared as a whole in which the said Opposed Mark was created with such uniqueness that is not similar at all with the said Marks. Therefore, I am of the opinion that the Applicant is the rightful and bona fide proprietor of the said Opposed Mark in Malaysia enabling the Applicant to apply for the registration of the said Opposed Mark under Section 25(1) of the Trade Marks Act 1976 (Act 175).

[59] It is the submission of the Plaintiff that the Defendant has failed to substantiate its claim to proprietorship under **Section 25(1)** of the TMA 1976 for the following reasons:

- (i) There is no evidence that there had been use of the Defendant's Mark in Malaysia before the date of first use of the POLO Marks.
- (ii) that the Defendant's evidence does not support its contention that there was been long and extensive use of the Defendant's Mark in Malaysia for the following reasons:-
 - (a) None of the invoices adduced by the Defendant during opposition proceedings show any use of the Defendant's Mark in Malaysia before the date of first use of the POLO marks. The earliest invoices adduced (which are unclear and which do not clearly show the date on which they were issued) were allegedly only issued in the year 1990.
 - (b) The selection of invoices adduced by the Defendant does not show that it had achieved substantial sales in Malaysia.
 - (c) All advertising and promotional materials adduced by the Defendant are dated well after the date of first use of the Plaintiff's POLO marks.
 - (d) A large number of advertising and promotional materials adduced by the Defendant relate to the "RALPH LAUREN" mark without the device of a horse as opposed to the Defendant's Mark.

- (e) The tenancy agreement dated 21.03.1988 between Lian Seng Properties Sdn Bhd and Added Assets Sdn Bhd did not show any use or promotion in relation to goods bearing the Defendant's Mark.

- (iii) The Plaintiff, on the other hand, had by itself or its licensees made extensive use of the POLO marks as part of their business name, signage and as a source identifier of their business and goods in Malaysia long before the Defendant's Application was filed and before the Defendant purportedly commenced use of the Defendant's Mark in Malaysia.

- (iv) The Defendant may not rely on the alleged use or registration of the Offending Mark in other countries as trade marks are territorial in nature. Therefore, any evidence of registration, use or promotion of the Defendant's Mark in other countries would be irrelevant to the present proceedings and no weight should be attached to such documents.

[60] **Kerly's Law of Trade Marks and Trade Names** (13th edition) touched on section 17(1) of the English Trade Marks Act 1938 (corresponding to section 25(1) of the TMA 1976) and observed that:

“ ... claiming that he is entitled to be registered as the proprietor ... [the] claim must in some sense be a justified one.. Provided however that the claim of proprietorship is made in good faith and is not rebuttable on the ground that in fact someone else was the proprietor, it is difficult to see how it can be objected to.”

[61] Prior to the application for registration of the Defendant's Mark in Class 9 on 7.9.1995, it is not in dispute that the Defendant is already the registered proprietor of the  mark in Class 14 since 16.10.1991. The Defendant is also the registered



proprietor of the  mark in Class 25 since 1982 and in Class 9 itself since 7.9.1995 and the word mark '**RALPH LAUREN**' in Class 28 since 14.7.1992.

[62] Bearing in mind that the Defendant is the registered owner of the  mark in Class 14 since 1991, I agree with the Defendant that it has every right to make the claim that it is the *bona fide* proprietor of the Defendant's Mark  in good faith.

[63] On the other hand, as at 7.9.1995, the Plaintiff is only the registered proprietor of the Mark . All the other marks bearing the 'polo player device' are yet to be registered.

[64] With regards to the usage of the marks, I find that the earliest use


of the Plaintiff's  mark was in an advertisement in 1995. There is no evidence of the use of this mark since the date of the registration of the  mark in 1981 as claimed by the Plaintiff. The invoices issued in 1989 simply refer to 'polo' shirts and pants.

[65] The Defendant on the other hand has been able to provide extensive evidence of the use of the '*Polo Player device*' and the words '*Ralph Lauren*' marks since 1991 as can be seen from the sales invoice dated 30.4.1991. The said invoice bears the words '*polo*', '*Ralph Lauren*' and the '*Polo Player device*'. In **Acushnet Company v Metro Golf Manufacturing Sdn Bhd** [2006] 7 CLJ 557, the court applied the decision of Morrit J in **Cheetah Trade Mark** [1993] FSR 263, where Morrit J held that the use of a registered trade mark on an invoice is a use in the course of trade:

"[79] In Cheetah Trade Mark [1993] FSR 263 Mr. Morrit J held when granting the plaintiffs relief sought in their summary judgment application that:

- (1) *use a registered trademark on invoices and delivery notes was just as much an infringement as stamping the mark on a container for the goods.*
- (2) *use of a registered trade mark on an invoice, even if rendered long after sale and delivery, was still a use in the course of trade.”*

[66] The Plaintiff also relied on the case of **In the Matter of the Trade Marks Act, 1983 and in the matter of Vitamin’s Ld’ Application** [1956] RPC 1 where the application for registration was refused on the ground that the applicant had sought to register a mark with the knowledge that someone else had originated a similar mark.

[67] However, in **Vitamin’s Ld’ Application** (supra), the subject matter is an identical trade mark, “**Pabalate**”. In our present case, the Defendant’s Mark is totally different to the Plaintiff’s



mark.

[68] The Plaintiff also relied on the decision of the Court of Appeal in **Walton International Limited v Yong Teng Hin; Pendaftar Cap Dagangan, Malaysia (Interested Party)** [2010] 8 CLJ 802 where the Court said at page 813:

*“[27] A person cannot be properly registered unless he is the proprietor of the mark. (see: Re Hicks Trade Mark [1897] 22 VLR 636). A proprietor is a person who at the moment he makes application to be registered to the exclusive use of the name or the mark, whether he then or before publicly adopted it. **A man cannot be said to have adopted a name or a mark if someone else has done so before him.**”*

[69] In the above case, Walton International Limited (supra), the trade mark in question is an identical mark, the “**GIORDANO**” trade mark. In the present case, the Defendant is not adopting the Plaintiff’s  trade mark. The Defendant is seeking to register its own trade mark , which is totally and incredibly different from the Plaintiff’s trade mark.

Issue (iii) whether the Registrar erred in failing to give substantial weight and due consideration to the Plaintiff’s goodwill and reputation

[70] The reputation and goodwill of a trader is extremely important given that it is the goodwill of a trader that will retain its customer base and attract or draw prospective customers to purchase the goods offered.

[71] In **The Commissioner of Inland Revenue v Muller & Co's Margarine Ltd** [1901] AC 217, it was held by Lord Macnaghten at page 223 that **'Goodwill'** may be defined as the *"benefit and advantage of the good name, reputation and connection with a business, whether it is a business that provides services or manufactures and/or distributes certain products. In other words, goodwill is the attractive force that brings in custom."*

[72] The Plaintiff submits that it has built its name and reputation in Malaysia from the date of first use of the Polo marks in 1981. Therefore, the Registrar should have given due regard to the fact that the Plaintiff has obtained extensive reputation and goodwill its business under the POLO marks as that is exactly what sets the Plaintiff apart from other traders in the market. It is also the underlying reason behind the confusion that would be caused by the use and registration of the Defendant's Mark, as members of the trade and the public who have become so accustomed with the goods bearing the polo marks originate from the Plaintiff. As such, members of the trade and the public would be confused or deceived into believing that the goods distributed under the Defendant's Mark originate from the Plaintiff or are associated with the Plaintiff.

[73] However, I am of the considered opinion that since the Plaintiff's marks are different from the Defendant Mark, then the issue of the Plaintiff's goodwill and reputation in its business relating to the "POLO" marks is not relevant. This is because even if the Plaintiff, as the proprietor of the "POLO" mark, has substantial goodwill and reputation, that does not prohibit the Defendant from

registering the Defendant's Mark, as it is different from the Plaintiff's Polo mark.

[74] The two marks are clearly distinguishable that members of the trade and the public would not assume or be deceived that the goods bearing the Defendant's  Mark could in any way be associated with the Plaintiff's  mark.

[75] In any event, I find that the Defendant has provided extensive evidence of use of their marks over the years. Sales of goods bearing the Defendant's family of Ralph Lauren Marks have exceeded RM226 million from the years 1989 to 2009. This clearly shows that the Defendant has acquired substantial goodwill and reputation of its Ralph Lauren Marks in Malaysia, long before the application for the present mark.

[76] Therefore, the use by the Defendant of its marks is highly unlikely to ride upon the alleged goodwill and reputation of the Plaintiffs marks. The use of the words '*RALPH LAUREN*' within the Defendant's Mark would associate the mark with the Defendant and no other. The Plaintiff's contention that the use by the Defendant of the Defendant's Mark would be a misrepresentation is therefore misplaced. The general public is very much aware of the reputation of '*RALPH LAUREN*'.

Issue (iv) the Registrar erred in allowing the Defendant's Mark to proceed to registration when the Defendant has failed to

discharge the onus of proof that the said mark is distinctive of the Defendant

[77] With regards to the issue of distinctiveness, section 10(2A) and (2B) of the TMA, 1976 reads as follows:

“(2A) For the purposes of this section, “distinctive”, in relation to the trade mark registered or proposed to be registered in respect of goods or services, means the trade mark must be capable of distinguishing goods or services with which the proprietor of the trade mark is or may be connected in the course of trade from goods or services in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered, subject to conditions, amendments, modifications or limitations, in relation to use within the extent of the registration.

(2B) In determining whether a trade mark is capable of distinguishing as aforesaid, regard may be had to the extent to which –

(a) the trade mark is inherently capable of distinguishing as aforesaid; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

(3) *A trade mark may be registered in the Register in respect of any good or services.”*

[78] The Plaintiff submits that the Defendant’s Mark cannot be said to be one that is adapted to distinguish the Defendant’s goods from the goods of other traders, in particular, the Plaintiff, as members of the trade and public will assume that the Defendant’s goods originate from the Plaintiff or that the Defendant is associated with the Plaintiff in some way despite the fact that no such association exists.

[79] However, I agree with the Defendant that the Defendant’s Mark is indeed distinctive and is capable of distinguishing the Defendant’s goods given the substantial goodwill and reputation it enjoys in Malaysia in relation to the business relating to the sale of goods and services bearing the Defendant’s Ralph Lauren Marks. The prior registration of corresponding marks to that of the Defendant’s Mark in other classes is conclusive that the Defendant’s Mark is indeed distinctive and is capable of distinguishing the Defendant’s goods.

[80] Apart from the various registrations of the Ralph Lauren Marks, the independent report dated 10.5.2006 by ACNielsen shows that the Ralph Lauren Marks are the most popular brand in Malaysia in 2006.

[81] However, the Plaintiff submits that the Defendant may not rely on a report by ACNielsen in support of its allegation that the

Defendant's Mark is distinctive of the Defendant as the mere publication of a report does not mean that the Malaysian public concurs with the findings of the report and the report fails to meet the minimum criteria for admissibility as evidence. Reliance is made on the cases of **Lam Soon Edible Sdn Bhd v Hup Seng Perusahaan Makanan (M) Sdn Bhd** [2010] 4 MLJ 702 and **Ginvera Marketing Enterprise Sdn Bhd v Tohtonku Sdn Bhd** [2011] 6 CLJ 799. In **Ginvera Marketing** (supra), Justice Azhar Mohamed (as His Lordship then was) held at pages 707 - 708:

[22] The principles regarding survey evidence is discussed in Kerly's Law of Trademarks, 14 edn at p. 608. It has been held that the basic rules of a survey in order to be probative were set out in *Imperial v. Phillip Morris* [1984] RPC 293 are:

- (i) *All surveys conducted, their methodology must be disclosed.*
- (ii) *The totality of all answers must be disclosed.*
- (iii) *The questions must not be leading.*
- (iv) *The questions asked must not be lead (sic) the interviewees into a field of speculation upon which he would not have otherwise have embarked.*
- (v) *The exact answers and not abbreviations must be provided.*

(vi) Coding must be accurately carried out and coding methods disclosed.

(vii) The instruction given to the interviewers must be disclosed.

[82] It is therefore the submission of the Plaintiff that the ACNielsen report adduced by the Defendant during the Opposition proceedings is inadmissible and should be disregarded by this court as the same have failed to meet the minimum requirement as set out in **Ginvera Marketing** case.

[83] However, I am of the considered opinion that the cases relied on by the Plaintiff are not applicable on the present facts as the Defendant did not commission the ACNielsen report. In the cases relied on by the Plaintiff, the relevant party relying on the report had commissioned the same to establish non-use or to establish possible deception and/or confusion. Due to the fact that a party would effectively have commissioned the survey, the courts have imposed safeguards to ensure the survey reports are not biased and the evidence can be safely relied on by the Courts. This is not the case here. The report was not commissioned by the Defendant. Hence it is an independent assessment of the Defendant's brand and its standing compared to other brands present within the market. The Defendant's reliance on the report was in addition to the extensive evidence of use that had been tendered to prove that the Defendant's mark is distinctive of the Defendant.

[84] Bearing in mind that the Defendant owns the artistic copyright in the polo player device, the various registrations of the Ralph Lauren Marks, the extensive evidence of use of the Defendant's Mark and/or the Ralph Lauren Marks and the independent report by ACNielsen which shows that the Ralph Lauren Marks are the most popular brand in Malaysia in 2006, it cannot be denied that the Defendant's Mark is indeed distinctive and is capable of distinguishing the Defendant's goods from goods provided by any other trader.

Issue (v) the Registrar erred in law and/or in fact in failing to hold that registration and/or use of the Defendant's Mark by the Defendant would constitute passing-off in common law, contrary to Section 82(2) of the Trade Marks Act 1976

[85] The Plaintiff submits that the use of the Defendant's Mark in relation to the Defendant's goods is calculated to deceive or cause confusion and will lead the goods distributed under the Defendant's Mark being passed off as, being mistaken for or associated with, the goods of the Plaintiff.

[86] However, I am of the considered opinion that the Registrar has no jurisdiction on issues of passing off. Whether there is a case that would constitute passing off is for the Court to decide, and the Plaintiff ought to commence its case for passing off in the High Court. That is the purpose of Section 82(2) of the TMA 1976, which reads:

“Notwithstanding subsection (1), nothing in this Act shall be deemed to affect the right of action against any person for passing off goods or services as those of another person or the remedies in respect thereof.”

[87] In fact, the Registrar has made the same finding:

“An opposition of passing off action was also mentioned by the Opponent under Section 82(2) of the Trade Marks act 1976 (Act 175) which must not be considered here as the Registrar’s function is to decide on the registration matter of a trade mark in which the passing off action under common law should be dealt with by the court with competent jurisdiction only.”

Conclusion

[88] The Plaintiff relied on its family of trademarks, but the only mark that is registered is the  mark. For this mark, the Plaintiff had not adduced any evidence to show actual use since the date of registration in 1981, as the invoices merely refer to polo shirts and pants. There is no actual use in respect of goods in Class 9.

[89] On the other hand, the Defendant’s family of marks, the Ralph Lauren Marks have been registered in various classes, with the earliest polo player device registered in 1982 in Class 25. The earliest  Mark was registered in Class 14 in 1991.

The Defendant's Mark is clearly distinctive of the Defendant. The Defendant's Mark is visually and phonetically different from the Plaintiff's marks. Therefore, there cannot be any actual or likelihood of confusion or deception.

[90] In the premise, I find no merit in the Plaintiff's appeal and the same is dismissed with costs.

(AZIZAH HAJI NAWAWI)
JUDGE
HIGH COURT MALAYA
(Commercial Division)
KUALA LUMPUR

Dated: 10th April 2015

For the Plaintiff : KP Ng/Wendy Lee
Messrs Shook Lin & Bok
Kuala Lumpur.

For the Defendant : Jasdev Singh
Messrs Jasdev Chambers
Kuala Lumpur.

