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AS PRECEDENT OF THE TTAB

MARCH 17, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Polo Ralph Lauren, L.P.

v.

United States Polo Association

Opposition Nos. 97,342; 99,766 and 99,778

Anthony F. Lo Cicero of Amster, Rothstein & Ebenstein for
Polo Ralph Lauren, L.P.

Joel B. Harris of Thacher, Proffitt & Wood for United States
Polo Association.

Before Hanak, Hohein and Bucher, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

The United States Polo Association (applicant) has
filed three applications seeking to register the three marks
shown below for, in each case, the following goods:

Class 14 JEWELRY OF PRECIOUS METAL; COSTUME JEWELRY;
WATCHES.

Class 16 CALENDARS; STATIONERY; DESKSETS; PENS;
PHOTOGRAPH ALBUMS; ADDRESS AND APPOINTMENT
BOOKS; ART PRINTS; POSTERS; GREETING CARDS;
AND MAGAZINES AND SERIES OF BOOKS FEATURING
POLO-RELATED TOPICS.

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Class 18 SADDLERY; TOTE BAGS; BACKPACKS; BRIEFCASES;
CALLING CARD AND KEY CASES; HANDBAGS; ANIMAL
FEED BAGS; AND UMBRELLAS.

Class 25 CLOTHING, NAMELY: TOPS; BOTTOMS; COATS;
JACKETS; TIES; BELTS; HEAD WEAR; FOOT WEAR;
AND SWIM WEAR; AND SWEAT PANTS, SHORTS AND
SHIRTS.

Serial No. 74/487,757

Serial No. 74/630,383

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Serial No. 74/630,392

Polo Ralph Lauren, L.P. (opposer) filed three notices of opposition alleging that long prior to the filing date of the first of applicant's three intent-to-use applications (February 7, 1994), opposer both used and registered the following six marks:

Reg. No. 984,005 May 14, 1974	SUITS, OVERCOATS, SWEATERS, TIES, SHIRTS AND PANTS	
Reg. No. 1,050,722 October 19, 1976	WOMEN'S CLOTHING- NAMESLY, TOPCOATS, RAINCOATS, JACKETS, SUIT JACKETS, SUIT COATS, SPORT COATS, SPORT JACKETS, BLAZERS, BLOUSES, SHIRTS, SHIRT JACKETS, PANTS, SKIRTS, DRESSES, SWEATERS, TEE SHIRTS, HATS AND SCARVES	
Reg. No. 1,378,247 January 14, 1986	MEN'S AND WOMEN'S WEARING APPAREL AND ACCESSORIES, NAMESLY, T-SHIRTS, SWEATSHIRTS, SWEATERS, JACKETS, PANTS, WIND- RESISTANT JACKETS	
Reg. No. 1,485,359 April 19, 1988	MENS', WOMENS' CHILDRENS' AND [sic] ATHLETIC SHOES	

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Reg. No. 1,512,754 November 15, 1988	CLOTHING - NAMELY, SUITS, SLACKS, TROUSERS, SHORTS, WIND-RESISTANT JACKETS, JACKETS, BLAZERS, DRESS SHIRTS, KNIT SHIRTS, SWEATSHIRTS, SWEATERS, HATS, BELTS, SOCKS, BLOUSES, SKIRTS, COATS AND DRESSES	
Reg. No. 1,729,192 November 3, 1992	JEWELRY	

Opposer has referred to the foregoing six marks as its "Polo Trademarks." Opposer alleged that all three of applicant's marks are confusingly similar to opposer's Polo Trademarks. In Opposition No. 97,342 at paragraph 5 of the notice, opposer further elaborated that "in particular, [applicant's mark] is confusingly similar to Opposer's Polo Player Symbol trademark."¹

Applicant filed answers which denied the pertinent allegations of the notices of opposition.

In an order dated January 23, 1997, this Board, at the request of the parties, consolidated the three oppositions.

¹ In Opposition Nos. 99,766 and 99,778, opposer alleged ownership of two additional registrations for the word POLO per se, namely, Registration No. 1,363,459 for clothing and Registration No. 1,446,173 for eyeglass frames and complete sunglasses. However, opposer has not made of record these registrations, nor has opposer discussed these registrations in its briefs. Accordingly, we will give no further consideration to these two additional registrations.

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Later still, this Board in an order dated February 13, 1998 granted opposer's motion for leave to file an amended notice of opposition setting forth a second ground of opposition, namely, that applicant lacked a bona fide intent to use any of the three marks which were the subject of its three intent-to-use applications.

In addition to the aforementioned six registrations properly made of record by opposer, the record in this case consists of, in part, the testimony depositions (with exhibits) of Lee Sporn (opposer's Vice-President for Intellectual Property and Associate General Counsel) and Merle R. Jenkins (President of USPA Properties, a subsidiary of applicant). Both parties filed briefs. Neither party requested a hearing.

Before discussing the merits of this case, a brief description of the parties is in order. Opposer is a very large producer of apparel and other items with 1997 sales exceeding \$600 million and 1997 advertising expenditures exceeding \$45 million. Virtually all of opposer's sales and advertising expenditures are for products bearing one or more of the Polo Trademarks. According to Mr. Sporn, opposer first used its polo player trademark per se in the late 1960's or early 1970's. (Sporn deposition page 5). The record demonstrates that opposer's marks consisting of a polo player per se, the word mark RALPH LAUREN, and the

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combination of the two have become famous. Indeed, even applicant concedes that "it is true that Ralph Lauren's marks are well-known." (Applicant's brief page 12).

As opposer acknowledges, "applicant United States Polo Association is an organization whose function is to manage the sponsorship of U.S. Polo Association polo tournaments." (Opposer's brief page 10). More specifically, the record demonstrates that applicant is a nonprofit organization established in 1890 which governs the sport of polo in the United States, Canada, Northern Mexico and parts of the Caribbean. Applicant promulgates and revises the rules for the sport of polo and organizes the principal polo tournaments. In addition, applicant supports 23 college polo programs. Currently, applicant is comprised of approximately 300 clubs, having approximately 3,300 individual members.

Since approximately 1988, applicant has supported its activities through a trademark licensing program. This program is managed by USPA Properties, a wholly-owned subsidiary of applicant. Applicant has licensed various of its marks -- other than the three marks which are the subject of the three oppositions -- to various manufacturers for use in connection with apparel, bedding, towels, watches, jewelry and perfume.

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Opposer and applicant are not strangers. In the early 1980's they were engaged in litigation before the United States District Court for the Southern District of New York. That lawsuit concluded with an unpublished opinion and a Final Order, both dated December 6, 1984. Applicant attached copies of both of these to its brief. Opposer attached a copy of the unpublished opinion to its brief, and discussed the Final Order at page 7 of its reply brief. The Court found that applicant's use of certain trademarks constituted an infringement of opposer's trademarks, including POLO BY RALPH LAUREN and the polo player symbol. However, we are unable to discern which of applicant's marks the Court found infringed opposer's trademark rights inasmuch as neither party to this proceeding provided copies of the numerous exhibits attached to the Final Order. Nevertheless, because opposer never contended that any of the three marks which applicant currently seeks to register are in violation of that 1984 Final Order, we make the presumption that they are not. A pertinent part of the 1984 Final Order is paragraph 9(c) which reads, in part, that "nothing contained herein shall be construed to prevent [applicant] from ... utilizing ... a mounted polo player or equestrian or equine symbol which is distinctive from [opposer's] polo player symbol in its content and perspective, provided that such symbol is used in

conjunction with trade dress, i.e., labels, hangtags and packaging, which does not utilize white or silver lettering on a blue background or emphasize the word POLO by presenting it in a rectangle or between parallel lines or in lettering larger than that of associated words or letters used to identify [applicant] ..."

This 1984 Final Order is of particular importance in the current proceeding because it has a major bearing on applicant's intent in creating and seeking to register the three marks which are the subject of this consolidated proceeding. There is no dispute that when applicant was in the process of creating the three marks which are the subject of this consolidated proceeding, it continuously compared the prototypes and final versions of its three marks with some or all of opposer's Polo Trademarks. As Mr. Jenkins explained, "the idea of the exercise was to come up with something that was not the same [as opposer's marks]." (Jenkins deposition page 29). Mr. Jenkins further stated that "all three of these marks [were created] in such a way that in our opinion no reasonable person would think that he was looking at a Polo Ralph Lauren product." (Jenkins deposition page 17).

Opposer characterizes applicant's actions as "intentional copying," and further states that therefore "the copier will be presumed to have intended to create a

confusing similarity of appearance and will be presumed to have succeeded." (Opposer's brief page 15). On the other hand, applicant explains that "having been involved with previous disputes with Ralph Lauren and hoping to avoid any future litigation, [applicant] designed each of the [three applied-for marks] with the specific purpose of avoiding confusing similarity between [applicant's] marks and Ralph Lauren's marks." (Applicant's brief page 6). Opposer cites numerous cases holding that when, in the process of developing its mark, a party defendant makes reference to plaintiff's mark, intentional copying can be presumed and further that said intentional copying can be presumed to have resulted in the creation of a confusingly similar mark. However, the unusual facts of this particular case are such that applicant's reference to opposer's marks during the creation of its three marks does not warrant a finding of intentional copying. Indeed, in light of the 1984 Final Order, applicant had to make reference to plaintiff's marks in order to make certain that applicant was in compliance with said Final Order. Thus, we find no bad faith adoption on the part of applicant.

Before beginning our likelihood of confusion analysis, it is important to ascertain the various types of products for which opposer has prior rights for its Polo Trademarks. Obviously, because opposer has properly made of record its

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aforementioned six registrations, opposer has prior rights in the polo player symbol per se for clothing, athletic shoes and jewelry. In addition, opposer has prior rights in the mark shown below for men's and women's wearing apparel and accessories. Registration No. 1,378,247.

Moreover, opposer has demonstrated that prior to the earliest of applicant's three filing dates (February 7, 1994), it had made use of its polo player symbol per se in connection with briefcases, personal diaries and desk accessories. (Sporn deposition page 13). Thus, opposer has established prior rights -- either through prior use or existing registrations -- for its polo player symbol per se (and some other of its marks) for at least one type of goods in each of the four classes for which applicant seeks to register its three marks. More specifically, opposer's registrations for its polo player symbol per se encompass at least some of applicant's class 14 goods (jewelry of precious metal and costume jewelry) and applicant's class 25

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goods (clothing). Moreover, opposer has made prior use of its polo player symbol per se for at least some of applicant's class 18 goods, namely, briefcases. Finally, with regard to certain of applicant's class 16 goods, namely, desksets and address and appointment books, we consider these to be extremely similar to opposer's desk accessories and personal diaries for which it has used its polo player symbol per se since approximately the mid 1980's. (Sporn deposition page 13). In this regard, we note that nowhere in its brief has applicant argued that confusion is not likely due to any dissimilarity in its goods and opposer's goods.

Given the fact that opposer's goods are identical to at least some or all of the goods in each of applicant's four classes, it follows that the other duPont factors of identical trade channels and identical purchasers likewise favor opposer's position. Moreover, applicant's description of its goods for each of its four classes is broad enough to encompass relatively inexpensive costume jewelry, inexpensive briefcases, inexpensive clothing and inexpensive desk sets and address and appointment books. Thus, the factors of the cost of the goods and the care exercised in their purchase likewise favor opposer.

This brings us to individual considerations of each of applicant's three marks in order to make determinations as

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to whether they are similar enough to opposer's Polo Trademarks such as there exists a likelihood of confusion. We will consider first applicant's mark pictured below which is the subject of its earliest application, namely, Application Serial No. 74/487,757.

Mr. Jenkins testified that with regard to each of applicant's three marks "the center of each mark, of course, is the active horseman." (Jenkins deposition pages 16 and 28). Of course, applicant's mark pictured above also contains the initials USPA beneath the active horseman. However, the active horseman is far larger than are the initials USPA. Moreover, applicant has not established that to consumers in general, the initials USPA have any meaning. In its 1984 decision the Court noted that Mr. Jenkins then testified that the initials USPA do "not have the degree of

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recognition that PGA or NFL does." In short, we find that applicant's mark pictured above is clearly dominated by the active horseman and that the initials USPA, depicted in much smaller size, do little to distinguish the first of applicant's marks from opposer's polo player per se mark. In comparing the active horseman portion of applicant's mark with opposer's polo player per se mark, we find that while there are certain differences, such as the fact that applicant's horse faces to the right and opposer's horse faces to the left and applicant's mallet is down while opposer's mallet is raised, nevertheless, applicant's mark in its entirety -- the active horseman with the initials USPA -- is similar enough to opposer's polo player per se such that their use on identical goods purchased by ordinary consumers is likely to result in confusion. In this regard, we note that when the goods of the parties are identical or nearly identical, "the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Accordingly, with regard to applicant's Application Serial No. 74/487,757, the opposition is sustained as to all four classes of goods.

We turn now to a consideration of applicant's application Serial No. 74/630,392 wherein it seeks to

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register the mark shown below for the same four classes of goods set forth earlier in this opinion.

We find that there exists no likelihood of confusion resulting from the contemporaneous use of the above mark and any of opposer's Polo Trademarks, even if the marks were used on identical goods. This is because applicant's mark depicted above is quite dissimilar from all of opposer's Polo Trademarks which have been properly made of record in this proceeding. In the above mark, the active horseman symbol is decidedly smaller than the lettering. Of equal importance, the words U.S. POLO ASS'N appear. Unlike the initials USPA, we find that ordinary consumers would readily recognize the words U.S. POLO ASS'N as referring to applicant, and clearly not to opposer. In making this finding of no likelihood of confusion, we have taken into account the fact that the goods of the parties are, in part, identical and the fact that opposer's Polo Trademarks are famous. However, our primary reviewing Court has made it

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clear that in appropriate cases, one duPont factor can outweigh all of the other factors. Kellogg Co. v. Pack'em Enterprises Inc., 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991). This is "especially [true] when that single factor is the dissimilarity of the marks." Champagne Louis Roederer v. Delicato Vineyard, 148 F.3d 1173, 47 USPQ2d 1459, 1460 (Fed. Cir. 1998). Thus, even if we assume that every other duPont factor (other than applicant's intent) favors opposer, we find in this case that applicant's mark pictured above is so dissimilar from any of opposer's Polo Trademarks that there is simply no likelihood of confusion. This is true despite the fact that opposer's marks are famous (as was opposer's mark in Kellogg) and despite the fact that the marks are used on identical goods (as was the case in Champagne Louis).

Finally, we turn to applicant's Application Serial No. 74/630,383 seeking to register the mark shown below, again for the same goods set forth earlier in this opinion.

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In the above mark, the active horseman design and the words UNITED STATES POLO ASSOCIATION are of approximately equal prominence. We find that the words UNITED STATES POLO ASSOCIATION appear in a prominent enough fashion such that they serve to distinguish the mark shown above from opposer's polo player per se mark as well as opposer's other Polo Trademarks, with one possible exception, namely, the mark (shown below) which is the subject of opposer's Registration No. 1,378,247 for "men's and women's wearing apparel and accessories, namely, T-shirts, sweatshirts, sweaters, jackets, pants, wind-resistant jackets."

In both applicant's third mark and opposer's mark which is the subject of Registration No. 1,378,247 there appears in the center a horse and rider surrounded by a circle of lettering. In both cases, the word at the top of the circle of lettering is the same, namely, POLO. While this is an

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extremely close question, we believe that if applicant's third mark and opposer's mark pictured immediately above were used on identical goods, there would be a likelihood of confusion. Moreover, to the extent that there are doubts on the issue of likelihood of confusion, they must be resolved in favor of opposer as the prior user and registrant. Accordingly, with regard to applicant's third application (Serial No. 74/630,383), we sustain the opposition with regard to applicant's class 25 goods (clothing) inasmuch as these goods are, in part, identical to the goods listed in opposer's Registration No. 1,378,247. As noted earlier in this opinion, when marks are used on identical goods, the degree of similarity of the marks required for a finding of likelihood of confusion declines.

However, opposer's Registration No. 1,378,247 is limited to wearing apparel and accessories, goods which are not identical to applicant's class 14 goods (jewelry and watches), applicant's class 16 goods or applicant's class 18

goods.²

We recognize, of course, that opposer is relying not only upon its registration rights, but also upon the rights it is derived from the use of its marks on various goods. While Mr. Sporn testified that opposer used its Polo Trademarks on a wide array of goods, he did not specify that opposer used the mark depicted in its Registration No. 1,378,247 on any goods other than clothing. Indeed, even with regard to opposer's most widely used mark, the polo player symbol per se, and even with regard to opposer's largest category of goods (clothing), Mr. Sporn testified that "not every article of clothing has the polo player symbol on it." (Sporn deposition page 58). In the absence of specific testimony or other evidence demonstrating that opposer has used the mark which is the subject of its Registration No. 1,378,247 on items other than apparel, we find that opposer simply failed to prove that it has common law rights in this mark for other types of goods, and in

² To the extent that opposer might argue that the word "accessories" in its identification of goods for Registration No. 1,378,247 might encompass some of applicant's class 18 goods (umbrellas, tote bags, key cases etc), we simply note that the word "accessories" is followed by a specific listing of the type of goods, namely, T-shirts, sweat shirts, sweaters, jackets, pants, wind-resistant jackets. Thus, we do not construe opposer's Registration No. 1,378,247 to encompass any of applicant's class 18 goods. Moreover, opposer's Registration No. 1,378,247 is limited to class 25 (clothing, including boots, shoes and slippers) and thus it could not encompass any class 18 goods.

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particular, the types of goods listed in applicant's classes 14, 16 and 18. With regard to applicant's goods in these three classes, we find that applicant's mark UNITED STATES POLO ASSOCIATION and active horse design is dissimilar enough from the mark which is the subject of opposer's Registration No. 1,378,247 such that their use on different types of goods is not likely to result in confusion.

In sum, with regard to applicant's application Serial No. 74/630,383, the opposition is sustained with regard to applicant's class 25 goods, and it is dismissed with regard to applicant's other three classes of goods.

Before leaving the issue of likelihood of confusion, we simply note that applicant properly made of record copies of the two marks shown below, both registered with the United States Patent and Trademark Office to third parties for clothing.

When shown these two marks, Mr. Sporn testified that at least with regard to the mark SANTA BARBARA POLO & RACQUET CLUB and design, he was of in view that said mark was not likely to cause confusion with opposer's Polo Trademarks. (Sporn deposition pages 66-67). Moreover, Mr. Sporn testified with regard to the mark BEVERLY HILLS POLO CLUB and design, that the words BEVERLY HILLS POLO CLUB create "a distinguishing feature" vis-à-vis opposer's Polo Trademarks. (Sporn deposition page 65). We simply note that we view the words UNITED STATES POLO ASSOCIATION and U.S. POLO ASS'N appearing in two of applicant's three marks as likewise creating a distinguishing feature vis-a-vis opposer's Polo Trademarks. In effort to distinguish the words in the above two third-party marks from the words UNITED STATES POLO ASSOCIATION or U.S. POLO ASS'N, Mr. Sporn could only state the following: "United States Polo, people think of us [opposer]." (Sporn deposition page 73). Mr. Sporn offered no evidence to support the notion that the words "United States Polo" are in any way associated with opposer. We simply fail to see how the words "United States Polo" conjure up opposer in the minds of consumers. In any event, the words in two of applicant's three marks are not "United States Polo," but rather they are UNITED STATES POLO ASSOCIATION and U.S. POLO ASS'N. We think that the words UNITED STATES POLO ASSOCIATION and its shortened form

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clearly refer to applicant, and would be perceived as so doing by members of the relevant purchasing public.

To conclude matters, we now turn to opposer's second basis for opposition, namely, that applicant lacked a bona fide intent to use any of its three marks. We find that this contention is totally unsupported by any evidence of record. Moreover, the record demonstrates that at since at least 1988, applicant has been actively licensing other of its marks in connection with a wide range of items. Indeed, applicant has, as previously noted, a separate subsidiary to specifically handle its licensing activities. We fully accept applicant's explanation that its not yet begun to use any of the three marks which are the subject of this consolidated proceeding simply because it did not wish to involve its licensees in legal action with opposer during the pendency of this opposition.

Decision: The opposition as to applicant's Application Serial No. 74/487,757 is sustained as to all four classes of goods. The opposition as to applicant's Application Serial No. 74/630,392 is denied as to all four classes of applicant's goods. The opposition as to applicant's Application Serial No. 74/630,383 is sustained as to applicant's class 25 goods, and is denied as to applicant's

class 14, class 16 and class 18 goods.³

E. W. Hanak

D. E. Bucher
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

³ At page 10 of its brief, applicant makes the allegation that "Mr. Sporn did acknowledge in his deposition that the USPA mark and design [Application Serial No. 74/487,757] is the least similar to Ralph Lauren's marks, thus at the very least, [applicant] should be allowed to make use of that mark to depict the sport it governs." In support of its allegation, applicant refers to pages 52 and 74 of Mr. Sporn's deposition. We have carefully reviewed the entire deposition of Mr. Sporn and in particular these two pages. We do not share applicant's view that Mr. Sporn stated that applicant's mark USPA and active horse design was the least similar to opposer's Polo Trademarks. In any event, the issue of likelihood of confusion is to be determined by this Board, and not by Mr. Sporn or others. Thus, in somewhat ironic fashion, the one mark which applicant thought that it should at the very least be allowed a registration for is the one mark for which applicant will be denied registration for all four classes of goods.