

## OPPOSITION No B 3 233 561

**The Polo/Lauren Company L.P.**, 650 Madison Avenue, 10022 New York, United States (opponent), represented by **Cabinet Cande-Blanchard-Ducamp (Aarpi Plasseraud IP Avocats)**, Rue de Richelieu, 104, 75002 Paris, France (professional representative)

against

**Mauricio David Adler**, Loyola 599, 1414 Caba, Argentina (applicant), represented by **Disain IP**, Calle Catedrático Abelardo Rigual, 10 - Bl. 1, Esc. 1, 5º B, 03540 Alicante, Spain (professional representative).

On 05/12/2025, the Opposition Division takes the following

### DECISION:

1. Opposition No B 3 233 561 is upheld for all the contested goods and services.
2. European Union trade mark application No 19 081 771 is rejected in its entirety.
3. The applicant bears the costs, fixed at EUR 620.

### REASONS

On 30/01/2025, the opponent filed an opposition against all the goods and services of European Union trade mark application No 19 081 771 'Wellington Polo Club' (word mark). The opposition is based on European Union trade mark registration No 4 049 334 and French trade mark registration No 1 501 334, both for 'POLO' (word mark). The opponent invoked Article 8(1)(b) and Article 8(5) EUTMR for both earlier marks.

### REPUTATION – ARTICLE 8(5) EUTMR

For reasons of procedural economy, the Opposition Division will first examine the opposition in relation to the earlier EUTM registration No 4 049 334 for the word mark 'POLO'.

According to Article 8(5) EUTMR, upon opposition by the proprietor of a registered earlier trade mark within the meaning of Article 8(2) EUTMR, the contested trade mark will not be registered where it is identical with, or similar to, an earlier trade mark, irrespective of whether the goods or services for which it is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered, where, in the case of an earlier European Union trade mark, the trade mark has a reputation in the Union or, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

Therefore, the grounds for refusal of Article 8(5) EUTMR are only applicable when the following conditions are met.

- The signs must be either identical or similar.
- The opponent's trade mark must have a reputation. The reputation must also be prior to the filing of the contested trade mark; it must exist in the territory concerned and for the goods and/or services on which the opposition is based.
- Risk of injury: use of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.

The abovementioned requirements are cumulative and, therefore, the absence of any one of them will lead to the rejection of the opposition under Article 8(5) EUTMR (16/12/2010, T-357/08, BOTO CYL / BOTOX, EU:T:2010:529, § 41; 16/12/2010, T-345/08, BOTO LIST / BOTOX, EU:T:2010:529, § 41). However, the fulfilment of all the abovementioned conditions may not be sufficient. The opposition may still fail if the applicant establishes due cause for the use of the contested trade mark.

In the present case, the applicant did not claim to have due cause for using the contested mark. Therefore, in the absence of any indications to the contrary, it must be assumed that no due cause exists.

#### **a) Reputation of the earlier trade mark**

Reputation implies a knowledge threshold that is reached only when the earlier mark is known by a significant part of the relevant public for the goods or services it covers. The relevant public is, depending on the goods or services marketed, either the public at large or a more specialised public.

In the present case, the contested trade mark was filed on 20/09/2024. Therefore, the opponent was required to prove that the trade mark on which the opposition is based had acquired a reputation prior to that date. In principle, it is sufficient that the opponent show that its mark already had a reputation on that date. While it follows from the wording of Article 8(5) EUTMR that the conditions for its application also need to be present at the time of taking the decision, and therefore the reputation of the earlier mark must subsist until the decision on the opposition is taken, any subsequent loss of reputation is for the applicant to claim and prove.

The evidence must also show that the reputation was acquired for the goods for which the opponent has claimed reputation, namely:

Class 18: *Handbags, backpacks, travelling bags, purses, pouches.*

Class 25: *Clothing, shoes and footwear; headgear.*

The opposition is directed against the following goods and services:

Class 3: *Perfumes; eau de cologne; deodorants for personal use [perfumery]; cosmetics.*

Class 18: *Luggage; all-purpose carrying bags; suitcases; travelling bags; trunks [luggage]; boxes and drawers of leather and/or leatherboard; sling bags for carrying infants; school bags; luggage tags; card wallets [leatherware]; pocket wallets; umbrellas and parasols.*

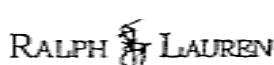
Class 25: *Clothing; ready-made clothing; clothing; footwear; headgear; parts of clothing, footwear and headgear.*

Class 35: *Retail sales services in relation to the following goods: dress, clothing, footwear, headgear and clothing accessories, travelling bags, handbags, wallets, perfumes, eau de cologne, deodorants for personal use, cosmetics; sales administration; procuring of contracts for the purchase and sale of goods; rental of sales stands; assistance in product commercialization, within the framework of a franchise contract; developing promotional campaigns for business; development of promotional campaigns; dissemination of advertisements; dissemination of advertisements via the internet; dissemination of advertising via online communications networks; dissemination of commercial information; dissemination of advertising, marketing and publicity materials; distribution of promotional matter; dissemination of advertising matter; direct mail advertising; dissemination of advertising and promotional materials; commercial administration of the licensing of the goods and services of others; commercial administration of the licensing of the goods and services of others; business management of retail outlets; business management of wholesale and retail outlets; preparation of advertising campaigns; preparing promotional and merchandising material for others; presentation of goods on communication media, for retail purposes; providing assistance in the field of product commercialization; compilation, production and dissemination of advertising matter; dissemination services of advertisement matter; business merchandising display services; franchising services providing marketing assistance; market research services relating to broadcast media; wholesale ordering services; advertisement and publicity services by television, radio, mail; wholesale services in relation to clothing; online retail services for downloadable virtual clothing; advertising; retail store services in the field of clothing; retail store services in the field of clothing; online retail services relating to clothing; retail store services in the field of clothing; retail services connected with the sale of clothing and clothing accessories; retail services in relation to clothing; advertising services relating to the commercialization of new products.*

In order to determine the mark's level of reputation, all the relevant facts of the case must be taken into consideration, including, in particular, the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

On 16/05/2025 and 06/06/2025, the opponent submitted evidence to support this claim. As the opponent requested that certain commercial data contained in the evidence be kept confidential vis-à-vis third parties, the Opposition Division will describe the evidence only in the most general terms without divulging any such data. The evidence consists of the following documents:

- Annex 4: various brand rankings (2000-2023) showing the opponent's marks

 RALPH LAUREN

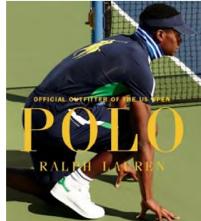
 POLO RALPH LAUREN

'RALPH LAUREN', or as some of the world's most valuable and influential brands. According to Interbrand's Best Global Brands, in 2015, the opponent was ranked 91 with a brand valued at

USD 4 629 million and in 2016 it was ranked 96 with a brand valued at USD 4 092 million.

- Annex 5: advertising campaigns featuring the 'POLO' lines in several European



countries    . For example, the 2019 EU advertising campaign 'Family is who you love' and 'every moment is a gift'



holiday campaign  
2022

*POLO trademark 2019 EU campaign (examples in Paris and Munich) ; the advertisements*



*Advertisement on the church of La Madeleine under renovation and in the subway, Paris - 2022 and images*

of stores, including Galeries Lafayette in Paris (2017), all displaying the mark



'POLO'

*Examples of interior and exterior design of POLO RALPH LAUREN stores in Europe*

- Annexes 6 and 32: advertising campaigns published in 2021 for Ralph Lauren sneakers featuring the mark 'POLO'.
- Annex 7: press clippings in English and French (e.g. *The Guardian*, *Time*, *Elle*, *Grazia*, *Les Echos*, *Vogue*), dated between 2018 and 2020, referring to the trade mark 'POLO', its creation in 1967, history and 50th anniversary





- Annexes 8-10: examples of 'POLO GOLF' use, for example



, 'POLO TENNIS'

and 'POLO



SPORT', for example , from, inter alia, the French, German, Italian and Spanish websites.

- Annexes 11-12: press articles published in several Member States of the European Union and extracts from RALPH LAUREN's unique Instagram account relating to sporting events such as the Wimbledon tournament in 2019,



2020, 2021, 2022, 2023 and the US Open Tennis Tournament for which RALPH LAUREN had the opportunity to dress top athletes.

- Annexes 13-21: evidence relating to perfumery.
- Annex 22: excerpts from RALPH LAUREN's unique Instagram account, which extensively feature the mark 'POLO' on clothing, footwear and headwear and are followed by several million followers worldwide between 2019 and 2023, for



example  
arguments.

included in the opponent's arguments.

- Annex 23: an overview of the opponent's French website showing all the 'Ralph Lauren' stores in Europe and images included in the opponent's arguments



Polo Ralph Lauren store Roma



POLO RALPH LAUREN stores in Athens and Valencia

- Annex 24: various opposition and Board of Appeal decisions (EUIPO), as well as decisions on a national level (e.g. France), confirming the reputed character of the earlier mark.
- Annex 25: numerous press articles (2018-2024) on the RALPH LAUREN clothing, footwear and headwear collections, featuring the 'POLO' mark, distributed in the European Union and particularly in France, Germany, Spain, Italy and Portugal.
- Annex 26-31: catalogues for the 'POLO' footwear collections (Spring 2019, Spring 2020, Autumn 2020, Spring 2021, Autumn 2021, Spring 2022).
- Annex 33: a certificate, dated 29/07/2022, from Mrs C.P., a member of the Board of Directors of Ralph Lauren Europe, attesting to very substantial sales figures in the European Union between 2005 and 2022.
- Annex 34: a statement, dated 06/07/2022, from Mrs C.P., a member of the Board of Directors of Ralph Lauren Europe, attesting to very substantial sales in France for 'POLO' trade mark products (2017-2022).
- Annex 35: a table summarising the very substantial sales in Europe of Ralph Lauren products featuring the 'POLO' trade mark between 2019 and 2023.

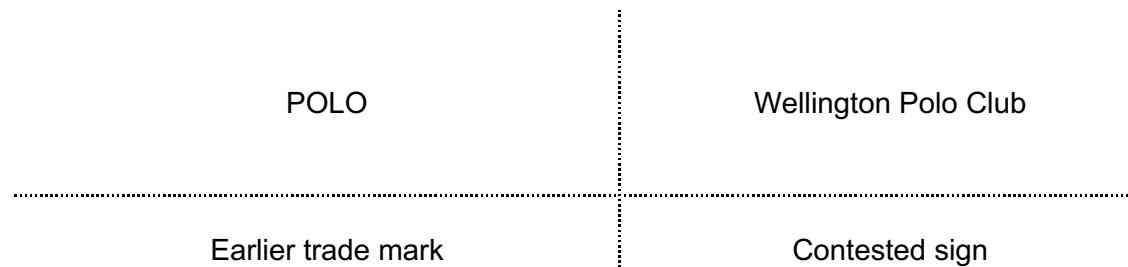
It is clear from the evidence that the earlier European Union trade mark has been subject to long-standing and intensive use, as shown in catalogues, shop displays, promotional material, on websites and in press articles, and is generally known on the relevant market, where it enjoys a consolidated position among leading brands. This is also confirmed by the information provided on the brand rankings showing that the opponent's brands are amongst the world's most valuable brands. Furthermore, the opponent has been the official outfitter of important sporting events, such as the UK Wimbledon tennis tournament (since 2006), which has given the earlier mark 'POLO' significant exposure in Europe. Finally, the financial figures for Europe shown in the evidence are very substantial. Moreover, the opponent operates many 'Ralph Lauren' stores in Europe located in exclusive street locations and regional malls in large urban markets. Therefore, all this evidence shows, unequivocally, that the mark enjoys a high degree of recognition among the relevant public.

Although the evidence submitted also includes the marks 'RALPH LAUREN' and the polo player logo, there is no doubt that it proves the intensive use of the earlier mark 'POLO', which, while it is associated with the other marks in the evidence, also plays an independent role, given that it is used on many occasions on its own in a prominent way, such as on commercialised goods. In most of the evidence submitted, the word 'POLO' appears in considerably larger letters than any of the other verbal elements used, such as 'Ralph Lauren'. Moreover, simultaneous use of independent marks does not necessarily affect the distinctive or reputed character of the individual marks if that independent character is perceived as such by the relevant public, which is clearly the case here. The earlier mark 'POLO', even if used in relation to other marks, will be immediately recognised as an independent reputed element.

On the basis of the above, the Opposition Division concludes that 'POLO' has acquired a strong reputation in the European Union, and this at least in relation to *clothing* in Class 25. The evidence refers to many Member States, including Germany, Spain, France and Italy, which, considering the size of the geographical area and the proportion of the overall population living there, is a substantial part of the European Union.

For reasons of procedural economy, the reputation in relation to the remaining goods will not be analysed as the fact whether the mark has a reputation for those goods is not relevant for the outcome of the decision as will become clear below.

### b) The signs



The relevant territory is the European Union.

The global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components (11/11/1997, C-251/95, *Sabèl*, EU:C:1997:528, § 23).

The earlier sign is the word 'POLO' and is fully incorporated as the second verbal element in the contested sign.

When the sole component of the earlier mark is entirely included within the contested mark, the signs at issue are partially identical in such a manner as to create a certain impression of visual similarity in the relevant public's minds (20/06/2018, T-657/17, HPC POLO / POLO et al., EU:T:2018:358, § 30).

The word 'POLO' in the earlier mark will be perceived as referring to the game of polo, which is played between two teams of players riding on horses.

In some languages, such as French and Spanish, 'POLO' might also refer to a type of shirt. However, in other languages, such as English, the word 'POLO' as such does not refer immediately to any item of clothing. The word is not usually used on its own in relation to clothing but together with the words 'shirt' or 'neck', as 'polo shirt' or 'polo neck' (14/06/2017, R 2368/2016-1, HPC POLO / POLO et al., § 26).

Irrespective of how it is perceived in the different languages in relation to specific clothing articles, this word in the earlier mark nevertheless retains a minimum degree of inherent distinctive character with regard to the goods concerned, since it corresponds to a sign registered as an EU trade mark, the validity of which cannot be challenged in opposition proceedings (20/06/2018, T-657/17, HPC POLO / POLO et al., EU:T:2018:358, § 34).

The expression 'POLO CLUB' in the contested sign refers to an organisation of people with an interest in the game of polo. It has a normal degree of distinctiveness in relation to all the contested goods and services in Classes 3, 18, 25 and 35 given that even if some can be used for playing polo, there is nothing in their description to the effect that they relate to goods specifically designed for that purpose (26/03/2015, T-581/13, Royal County of Berkshire POLO CLUB (fig.) / BEVERLY HILLS POLO CLUB (fig.) et al., EU:T:2015:192, § 49).

The word 'Wellington' in combination with the words 'POLO CLUB' will be perceived as referring to a place (the capital city of New Zealand) or as a male given name or surname. Therefore, the expression 'Wellington Polo Club' as a whole refers to a polo club in, or named, 'Wellington'. It has a normal degree of distinctiveness in relation to the relevant goods and services.

**Visually and aurally**, the signs coincide in 'POLO', which constitutes the full earlier mark and the second element in the contested sign. The signs differ in the first word 'Wellington' and the third word 'CLUB' in the contested sign.

Therefore, even considering that the common element 'POLO' in the earlier mark might only have a minimum degree of inherent distinctiveness for part of the public, the signs are visually and aurally similar at least to a low degree.

**Conceptually**, reference is made to the previous assertions concerning the semantic content conveyed by the marks. The signs will be associated with a similar meaning on account of the element 'POLO' which is, however, further specified in the contested sign due to the addition of the words 'Wellington' and 'Club'. Therefore, even considering that the common element 'POLO' in the earlier mark might only have a minimum degree of inherent distinctiveness for part of the public, the signs are similar at least to a low degree.

Taking into account that the signs have been found similar in at least one aspect of the comparison, the examination of the existence of a risk of injury will proceed.

### c) The 'link' between the signs

As seen above, the earlier mark is reputed and the signs are similar at least to a low degree. In order to establish the existence of a risk of injury, it is necessary to demonstrate that, given all the relevant factors, the relevant public will establish a link (or association) between the signs. The necessity of such a 'link' between the conflicting marks in consumers' minds is not explicitly mentioned in Article 8(5) EUTMR but has been confirmed by several judgments (23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 29, 31; 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 66). It is not an additional requirement but merely reflects the need to determine whether the association that the public might establish between the signs is such that either detriment or unfair advantage is likely to occur after all of the factors that are relevant to the particular case have been assessed.

Possible relevant factors for the examination of a 'link' include (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 42):

- the degree of similarity between the signs;
- the nature of the goods and services, including the degree of similarity or dissimilarity between those goods or services, and the relevant public;
- the strength of the earlier mark's reputation;
- the degree of the earlier mark's distinctive character, whether inherent or acquired through use;
- the existence of likelihood of confusion on the part of the public.

This list is not exhaustive and other criteria may be relevant depending on the particular circumstances. Moreover, the existence of a 'link' may be established on the basis of only some of these criteria.

The establishment of such a link, while triggered by similarity (or identity) between the signs, requires that the relevant sections of the public for each of the goods and services covered by the trade marks in dispute are the same or overlap to some extent.

According to the Court of Justice of the European Union,

It is therefore conceivable that the relevant section of the public as regards the goods or services for which the earlier mark was registered is completely distinct from the relevant section of the public as regards the goods or services for which the later mark was registered and that the earlier mark, although it has a reputation, is not known to the public targeted by the later mark. In such a case, the public targeted by each of the two marks may never be confronted with the other mark, so that it will not establish any link between those marks.

(27/11/2008, C-252/07, Intel, EU:C:2008:655, § 48.)

The relevant public is both the general and professional public. The degree of attention will vary from average (e.g. perfumes, bags, clothing and retail/wholesale of such goods) to high (business services in Class 35) taking into account the impact that those services might have on the functioning and success of a company.

The Court of Justice has also noted,

... that certain marks may have acquired such a reputation that it goes beyond the relevant public as regards the goods or services for which those marks were registered. In such a case, it is possible that the relevant section of the public as regards the goods or services for which the later mark is registered will make a connection between the conflicting marks, even though that public is wholly distinct from the relevant section of the public as regards goods or services for which the earlier mark was registered.

(27/11/2008, C-252/07, Intel, EU:C:2008:655, § 51-52.)

The earlier mark 'POLO' has a strong reputation in the European Union at least for *clothing* in Class 25.

The signs are visually, aurally and conceptually at least similar to a low degree.

The opposition is directed against the following goods and services:

Class 3: *Perfumes; eau de cologne; deodorants for personal use [perfumery]; cosmetics.*

Class 18: *Luggage; all-purpose carrying bags; suitcases; travelling bags; trunks [luggage]; boxes and drawers of leather and/or leatherboard; sling bags for carrying infants; school bags; luggage tags; card wallets [leatherware]; pocket wallets; umbrellas and parasols.*

Class 25: *Clothing; ready-made clothing; clothing; footwear; headgear; parts of clothing, footwear and headgear.*

Class 35: *Retail sales services in relation to the following goods: dress, clothing, footwear, headgear and clothing accessories, travelling bags, handbags, wallets, perfumes, eau de cologne, deodorants for personal use, cosmetics; sales administration; procuring of contracts for the purchase and sale of goods; rental of sales stands; assistance in product commercialization, within the framework of a franchise contract; developing promotional campaigns for business; development of promotional campaigns; dissemination of advertisements; dissemination of advertisements via the internet; dissemination of advertising via online communications networks; dissemination of commercial information; dissemination of advertising, marketing and publicity materials; distribution of promotional matter; dissemination of advertising matter; direct mail advertising; dissemination of advertising and promotional materials; commercial administration of the licensing of the goods and services of others; commercial administration of the licensing of the goods and services of others; business management of retail outlets; business management of wholesale and retail outlets; preparation of advertising campaigns; preparing promotional and merchandising material for others; presentation of goods on communication media, for retail purposes; providing assistance in the field of product commercialization; compilation, production and dissemination of advertising matter; dissemination services of advertisement matter; business merchandising display services; franchising services*

*providing marketing assistance; market research services relating to broadcast media; wholesale ordering services; advertisement and publicity services by television, radio, mail; wholesale services in relation to clothing; online retail services for downloadable virtual clothing; advertising; retail store services in the field of clothing; retail store services in the field of clothing; online retail services relating to clothing; retail store services in the field of clothing; retail services connected with the sale of clothing and clothing accessories; retail services in relation to clothing; advertising services relating to the commercialization of new products.*

### **Goods and services for which a link is found**

It is common for successful clothing brands to expand into the sectors of perfumery and cosmetics. Therefore, the opponent's *clothing* has a clear connection with all the contested goods in Class 3.

The same goes for most of the contested goods in Class 18. Successful clothing brands often expand into home articles (e.g. *boxes and drawers of leather and/or leatherboard*), luggage articles and all kinds of bags. Moreover, some of the contested goods (all kinds of bags, *umbrellas and parasols*) are often paired with clothing to match colours and styles or are sold in the same outlets (e.g. *sling bags for carrying infants* often sold in baby/children clothing outlets). Therefore, there is a connection between the opponent's *clothing* and all the contested goods in Class 18.

The contested clothing, footwear or headgear articles, and parts thereof, in Class 25 are clearly linked to the opponent's reputed *clothing*. The clothing articles are identical to the opponent's *clothing* while the footwear and headgear, and parts of clothing, footwear and headgear, all belong to the same market sector, being the fashion sector. Therefore, the contested goods in Class 25 are closely related to the opponent's *clothing*.

The contested *retail sales services in relation to the following goods: dress, clothing, footwear, headgear and clothing accessories, travelling bags, handbags, wallets, perfumes, eau de cologne, deodorants for personal use, cosmetics; wholesale services in relation to clothing; online retail services for downloadable virtual clothing; retail store services in the field of clothing; retail store services in the field of clothing; online retail services relating to clothing; retail store services in the field of clothing; retail services connected with the sale of clothing and clothing accessories; retail services in relation to clothing* are retail and wholesale services in relation to clothing, footwear, headgear, clothing accessories, luggage, bags, wallets, perfumery and cosmetics. Since these services refer to the sale of goods that show a connection with the opponent's *clothing*, as explained above, these goods and services are also clearly connected.

Therefore, taking into account and weighing up all the relevant factors of the present case, it must be concluded that in relation to all the goods in Classes 3, 18 and 25, and the services mentioned above in Class 35, when encountering the contested mark, the relevant consumers in the European Union will be likely to associate it with the earlier sign, that is to say, establish a mental 'link' between the signs. Irrespective of the inherent distinctiveness of the element 'POLO' in the earlier mark for those goods and services that clearly show a connection, the reputation of the earlier mark is sufficiently strong and the similarities between the signs sufficient as the earlier mark is fully included in the contested sign. Consequently, the word 'POLO' as used in the contested sign will inevitably evoke in the consumers' mind the opponent's reputed mark. Therefore, the (at least) low degree of similarity between the signs is largely counterbalanced by the strong reputation of the earlier mark and the clear connection between the abovementioned goods and services. However, although a 'link' between

the signs is a necessary condition for further assessing whether detriment or unfair advantage are likely, the existence of such a link is not sufficient, in itself, for a finding that there may be one of the forms of damage referred to in Article 8(5) EUTMR (26/09/2012, T-301/09, CITIGATE / CITICORP et al., EU:T:2012:473, § 96).

### **Remaining services in Class 35 for which the existence of a link will not be analysed**

The remaining services in Class 35 are *sales administration; procuring of contracts for the purchase and sale of goods; rental of sales stands; assistance in product commercialization, within the framework of a franchise contract; developing promotional campaigns for business; development of promotional campaigns; dissemination of advertisements; dissemination of advertisements via the internet; dissemination of advertising via online communications networks; dissemination of commercial information; dissemination of advertising, marketing and publicity materials; distribution of promotional matter; dissemination of advertising matter; direct mail advertising; dissemination of advertising and promotional materials; commercial administration of the licensing of the goods and services of others; commercial administration of the licensing of the goods and services of others; business management of retail outlets; business management of wholesale and retail outlets; preparation of advertising campaigns; preparing promotional and merchandising material for others; presentation of goods on communication media, for retail purposes; providing assistance in the field of product commercialization; compilation, production and dissemination of advertising matter; dissemination services of advertisement matter; business merchandising display services; franchising services providing marketing assistance; market research services relating to broadcast media; wholesale ordering services; advertisement and publicity services by television, radio, mail; advertising; advertising services relating to the commercialization of new products*. For reasons of procedural economy, the link for those remaining services will not be analysed, and those services will be examined below under the ground of Article 8(1)(b) EUTMR, where they are successfully challenged.

### **d) Risk of injury**

Use of the contested mark will fall under Article 8(5) EUTMR when any of the following situations arise:

- it takes unfair advantage of the distinctive character or the repute of the earlier mark;
- it is detrimental to the repute of the earlier mark;
- it is detrimental to the distinctive character of the earlier mark.

Although detriment or unfair advantage may be only potential in opposition proceedings, a mere possibility is not sufficient for Article 8(5) EUTMR to be applicable. While the proprietor of the earlier mark is not required to demonstrate actual and present harm to its mark, it must 'adduce *prima facie* evidence of a future risk, which is not hypothetical, of unfair advantage or detriment' (06/07/2012, T-60/10, ROYAL SHAKESPEARE / RSC- ROYAL SHAKESPEARE COMPANY et al., EU:T:2012:348, § 53).

It follows that the opponent must establish that detriment or unfair advantage is probable, in the sense that it is foreseeable in the ordinary course of events. For that

purpose, the opponent should file evidence, or at least put forward a coherent line of argument demonstrating what the detriment or unfair advantage would consist of and how it would occur, that could lead to the *prima facie* conclusion that such an event is indeed likely in the ordinary course of events.

The opponent claims that use of the contested trade mark would take unfair advantage of the distinctive character or the repute of the earlier trade mark and be detrimental to the distinctive character and repute of the earlier trade mark.

### **Unfair advantage (free-riding)**

Unfair advantage in the context of Article 8(5) EUTMR covers cases where there is clear exploitation and 'free-riding on the coat-tails' of a famous mark or an attempt to trade upon its reputation. In other words, there is a risk that the image of the mark with a reputation or the characteristics which it projects are transferred to the goods and services covered by the contested trade mark, with the result that the marketing of those goods and services is made easier by their association with the earlier mark with a reputation (06/07/2012, T-60/10, ROYAL SHAKESPEARE / RSC- ROYAL SHAKESPEARE COMPANY et al., EU:T:2012:348, § 48; 22/03/2007, T-215/03, VIPS / VIPS, EU:T:2007:93, § 40).

The opponent bases its claim on the following:

- All the evidence submitted establishes that an unfair advantage is probable, in the sense that it is foreseeable in the ordinary course of events. Indeed, the evidence shows that 'POLO' has been an iconic mark for many years, synonymous with chic, luxury, prestige and quality. This sign is present in each of the opponent's collections and particularly in its clothing, shoes and perfumes collections, allowing consumers to identify at a glance that an item displaying this sign comes from the famous 'RALPH LAUREN' fashion company.
- The 'POLO' trade mark reflects an image of quality and prestige, which could positively influence the choice of the consumer. The use of the contested sign on goods and services in Classes 3, 18, 25 and 35 would clearly take unfair advantage of such repute, in order to benefit from the power of attraction, the reputation and the prestige of the 'POLO' mark and to exploit, without paying any financial compensation, the marketing efforts expended by the opponent in order to create and maintain the trade mark's image.
- Furthermore, the actual use of the contested sign reinforces the likelihood of confusion/association with the earlier reputed mark. The applicant uses the sign 'Wellington Polo Club' on various products, with the term 'POLO' being very prominent in relation to the other verbal elements (Evidence 36-37),



[https://www.instagram.com/wpcofficial/p/CTWn13DoyQ/?img\\_index=1](https://www.instagram.com/wpcofficial/p/CTWn13DoyQ/?img_index=1)

Moreover, the applicant further exacerbates the potential confusion with RALPH LAUREN products by prominently displaying the year 1967, which marks the founding of the earlier reputed mark 'POLO'. This year is consistently featured on the products sold by the applicant, reinforcing the association between the contested sign and RALPH LAUREN. By incorporating this historical reference, the applicant creates a stronger connection to the well-established reputation and legacy of RALPH LAUREN, which is likely to mislead consumers into believing there is an affiliation or endorsement by the renowned fashion house. This practice increases the likelihood of confusion and unfair advantage by capitalising on the long-standing recognition and prestige associated with the RALPH LAUREN brand. With regard to perfumery products, the opposing party's imitative attitude is particularly shocking and demonstrates particular bad faith on the part of the applicant in the use of the 'Wellington Polo Club' trade mark,

RALPH LAUREN	WELLINGTON POLO CLUB
 <a href="https://www.notino.fr/ralph-lauren/polo-blue-gold-blend-eau-de-parfum-pour-homme/">https://www.notino.fr/ralph-lauren/polo-blue-gold-blend-eau-de-parfum-pour-homme/</a>	 <a href="https://www.ebay.com/itm/315100414251">https://www.ebay.com/itm/315100414251</a>
 <a href="https://www.ebay.fr/itm/393226300124">https://www.ebay.fr/itm/393226300124</a>	 <a href="https://www.perfumeriaspigmento.com.ar/wellington-polo-club-set-polo-club-negro-edp-90-ml-deo/p">https://www.perfumeriaspigmento.com.ar/wellington-polo-club-set-polo-club-negro-edp-90-ml-deo/p</a>

Use of the term 'POLO' by the applicant demonstrates that 'POLO' is often used alone, placed in a central and dominant position and, therefore, directly perceptible by the consumer who will remember only 'POLO', the additions being only accessory and in discreet fonts and sizes. In addition, the applicant's desire to align closely with RALPH LAUREN's practices can also be evidenced by the labels affixed to the products, which create a marked impression of *déjà vu*,



By presenting it as a POLO range 'by Wellington', the applicant creates real confusion in the mind of the consumer, who might mistakenly believe that the products come from economically linked companies.

According to the Court of Justice of the European Union

... as regards injury consisting of unfair advantage taken of the distinctive character or the repute of the earlier mark, in so far as what is prohibited is the drawing of benefit from that mark by the proprietor of the later mark, the existence of such injury must be assessed by reference to average consumers of the goods or services for which the later mark is registered, who are reasonably well informed and reasonably observant and circumspect.

(27/11/2008, C-252/07, Intel, EU:C:2008:655, § 36.)

Taking into account the relevant contested goods and services in Classes 3, 18, 25 and 35 for which a link has been established, the relevant public is the public at large for most of the goods and services and the professional public for the other (wholesale), and the degree of attention is average.

The applicant's intention is not a material factor. Taking unfair advantage of the distinctiveness or the repute of a trade mark may be a deliberate decision, for example, where there is clear exploitation and riding on the coat-tails of a famous mark, or an attempt to trade upon the reputation of a famous mark. However, taking unfair advantage does not necessarily require a deliberate intention to exploit the goodwill attached to someone else's trade mark.

The concept of taking unfair advantage 'concerns the risk that the image of the mark with a reputation or the characteristics that it projects are transferred to the goods covered by the mark applied for, with the result that the marketing of those goods is made easier by that association with the earlier mark with a reputation' (19/06/2008, T-93/06, MINERAL SPA / SPA (fig.) et al., EU:T:2008:215, § 40; 22/03/2007, T-215/03, VIPS / VIPS, EU:T:2007:93, § 40; 30/01/2008, T-128/06, CAMELO (fig.) / CAMEL (fig.) et al., EU:T:2008:22, § 46).

In the present case, the earlier mark has obtained a strong reputation and has become an attractive and powerful brand in the European Union. The evidence submitted by the opponent shows that the earlier mark has a positive image and is associated with high quality, luxury and elegance.

As explained in section c) of this decision, considering the strong reputation of the earlier mark, the similarities between the signs due to the incorporation of the full earlier mark into the contested sign and the fact that the conflicting goods and services

show a close connection, the relevant public will make a link between the marks. This link will create an association that will produce a commercial benefit for the applicant as the image of high quality, luxury and elegance will be easily transferred to the applicant's goods and services. Therefore, there is a high probability that the use of the mark applied for may lead to 'riding on the coat-tails'; that is to say, it would take unfair advantage of the reputation of the earlier mark and the considerable investments undertaken by the opponent to achieve that reputation. The use of the trade mark applied for could also lead to the perception that the applicant is associated with or belongs to the opponent and, therefore, could facilitate the marketing of the goods and services for which registration is sought.

This conclusion is also supported by the evidence submitted by the opponent (Evidence 36-37) showing how the mark is used on the market with an even higher resemblance to the overall brand image created by the opponent, making a link and injury even more likely.

On the basis of the above, the Opposition Division concludes that in relation to all the contested goods in Classes 3, 18 and 25 and *retail sales services in relation to the following goods*: *dress, clothing, footwear, headgear and clothing accessories, travelling bags, handbags, wallets, perfumes, eau de cologne, deodorants for personal use, cosmetics; wholesale services in relation to clothing; online retail services for downloadable virtual clothing; retail store services in the field of clothing; retail store services in the field of clothing; online retail services relating to clothing; retail store services in the field of clothing; retail services connected with the sale of clothing and clothing accessories; retail services in relation to clothing* in Class 35, the contested trade mark is likely to take unfair advantage of the distinctive character or the repute of the earlier trade mark.

### **Other types of injury**

The opponent also argues that use of the contested trade mark would be detrimental to the distinctive character or the repute of the earlier trade mark.

As seen above, the existence of a risk of injury is an essential condition for Article 8(5) EUTMR to apply. The risk of injury may be of three different types. For an opposition to be well founded in this respect, it is sufficient if only one of these types is found to exist. In the present case, as seen above, the Opposition Division has already concluded that the contested trade mark would take unfair advantage of the distinctive character or repute of the earlier trade mark in relation to the goods and services for which a link has been established. It follows that there is no need to examine whether or not other types also apply.

### **e) Conclusion**

Considering all the above, the opposition is well founded under Article 8(5) EUTMR insofar as it is directed against the following goods and services:

Class 3: *Perfumes; eau de cologne; deodorants for personal use [perfumery]; cosmetics.*

Class 18: *Luggage; all-purpose carrying bags; suitcases; travelling bags; trunks [luggage]; boxes and drawers of leather and/or leatherboard; sling bags for carrying infants; school bags; luggage tags; card wallets [leatherware]; pocket wallets; umbrellas and parasols.*

Class 25: *Clothing; ready-made clothing; clothing; footwear; headgear; parts of clothing, footwear and headgear.*

Class 35: *Retail sales services in relation to the following goods: dress, clothing, footwear, headgear and clothing accessories, travelling bags, handbags, wallets, perfumes, eau de cologne, deodorants for personal use, cosmetics; wholesale services in relation to clothing; online retail services for downloadable virtual clothing; retail store services in the field of clothing; retail store services in the field of clothing; online retail services relating to clothing; retail store services in the field of clothing; retail services connected with the sale of clothing and clothing accessories; retail services in relation to clothing.*

Therefore, the contested trade mark must be rejected for all those goods and services.

The remaining contested services in Class 35 for which for reasons of procedural economy the link was not examined, will be examined under Article 8(1)(b) EUTMR below.

## **LIKELIHOOD OF CONFUSION – ARTICLE 8(1)(b) EUTMR**

Pursuant to Article 8(1)(b) EUTMR, a likelihood of confusion exists if there is a risk that the public might believe that the goods or services in question, under the assumption that they bear the marks in question, come from the same undertaking or, as the case may be, from economically linked undertakings. Whether a likelihood of confusion exists depends on the appreciation in a global assessment of several factors, which are interdependent. These factors include the similarity of the signs, the similarity of the goods and services, the distinctiveness of the earlier mark, the distinctive and dominant elements of the conflicting signs, and the relevant public.

The opposition is based on more than one earlier trade mark. The Opposition Division finds it appropriate to first examine the opposition in relation to the opponent's French trade mark registration No 1 501 334 for the word mark 'POLO'.

### **a) The goods and services**

The goods and services on which the opposition is based are, *inter alia*, the following:

Class 35: *Advertising and business.*

The remaining contested services are the following:

Class 35: *Sales administration; procuring of contracts for the purchase and sale of goods; rental of sales stands; assistance in product commercialization, within the framework of a franchise contract; developing promotional campaigns for business; development of promotional campaigns; dissemination of advertisements; dissemination of advertisements via the internet; dissemination of advertising via online communications networks; dissemination of commercial information; dissemination of advertising, marketing and publicity materials; distribution of promotional matter; dissemination of advertising matter; direct mail advertising; dissemination of advertising and promotional materials; commercial administration of the licensing of the goods and services of others; commercial administration of the licensing of the goods and services of others; business management of retail outlets; business management of wholesale and retail outlets; preparation of advertising campaigns; preparing promotional and*

*merchandising material for others; presentation of goods on communication media, for retail purposes; providing assistance in the field of product commercialization; compilation, production and dissemination of advertising matter; dissemination services of advertisement matter; business merchandising display services; franchising services providing marketing assistance; market research services relating to broadcast media; wholesale ordering services; advertisement and publicity services by television, radio, mail; advertising; advertising services relating to the commercialization of new products.*

The contested *sales administration; procuring of contracts for the purchase and sale of goods; assistance in product commercialization, within the framework of a franchise contract; dissemination of commercial information; commercial administration of the licensing of the goods and services of others; commercial administration of the licensing of the goods and services of others; business management of retail outlets; business management of wholesale and retail outlets; providing assistance in the field of product commercialization; franchising services providing marketing assistance; market research services relating to broadcast media; wholesale ordering services* are included in the broad category of, or overlap with, the opponent's *business*. Therefore, they are identical.

The contested *rental of sales stands; developing promotional campaigns for business; development of promotional campaigns; dissemination of advertisements; dissemination of advertisements via the internet; dissemination of advertising via online communications networks; dissemination of advertising, marketing and publicity materials; distribution of promotional matter; dissemination of advertising matter; direct mail advertising; dissemination of advertising and promotional materials; preparation of advertising campaigns; preparing promotional and merchandising material for others; presentation of goods on communication media, for retail purposes; compilation, production and dissemination of advertising matter; dissemination services of advertisement matter; business merchandising display services; advertisement and publicity services by television, radio, mail; advertising; advertising services relating to the commercialization of new products* are identically contained, or included in the broad category of, or overlap with, the opponent's *advertising*. Therefore, they are identical.

#### **b) Relevant public – degree of attention**

The average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect. It should also be borne in mind that the average consumer's degree of attention is likely to vary according to the category of goods or services in question.

In the present case, the services found to be identical target a professional public with specific knowledge and expertise.

The degree of attention will be rather high since the services might have an important impact on the functioning and success of a company.

#### **c) The signs**

The relevant territory is France. The meaning of the elements 'POLO' and 'Wellington Polo Club' have been set out above in the comparison of the signs on the grounds of Article 8(5) EUTMR, to which reference is made.

Both 'POLO' and 'Wellington Polo Club' have a normal degree of distinctiveness in relation to the relevant services in Class 35.

As the earlier mark 'POLO' is fully included in the contested sign 'Wellington Polo Club', the signs are visually, aurally and conceptually similar to at least a low degree.

#### **d) Distinctiveness of the earlier mark**

The distinctiveness of the earlier mark is one of the factors to be taken into account in the global assessment of likelihood of confusion.

According to the opponent, the earlier trade mark has a reputation in France in connection with all the goods and services for which it is registered and in particular for the relevant services found to be identical to the contested services, namely *advertising and business*. This claim must be properly considered given that the distinctiveness of the earlier trade mark must be taken into account in the assessment of likelihood of confusion. Indeed, the more distinctive the earlier mark, the greater will be the likelihood of confusion, and therefore marks with a highly distinctive character because of the recognition they possess on the market, enjoy broader protection than marks with a less distinctive character (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 18).

The evidence submitted by the opponent to prove the reputation and high distinctive character of the earlier trade mark has already been listed and examined above under the grounds of Article 8(5) EUTMR.

As there is no evidence referring to the relevant services *advertising and business* in Class 35 offered to third parties, no enhanced distinctiveness can be established in relation to those services.

Consequently, the assessment of the distinctiveness of the earlier mark will rest on its distinctiveness *per se*. In the present case, the earlier trade mark as a whole has no meaning for any of the services in question from the perspective of the public in the relevant territory. Therefore, the distinctiveness of the earlier mark must be seen as normal.

#### **e) Global assessment, other arguments and conclusion**

The appreciation of likelihood of confusion on the part of the public depends on numerous elements and, in particular, on the recognition of the earlier mark on the market, the association that can be made with the registered mark, and the degree of similarity between the marks, and between the goods or services identified. It must be appreciated globally, taking into account all factors relevant to the circumstances of the case (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 18; 11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 22).

Evaluating likelihood of confusion implies some interdependence between the relevant factors and, in particular, a similarity between the marks and between the goods or services. Therefore, a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the marks and vice versa (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 17).

The earlier mark has an average degree of distinctiveness. The relevant public is the professional public whose degree of attention is rather high.

The services are identical.

The signs are visually, aurally and conceptually similar at least to a low degree.

Taking into account that the earlier mark is fully included in the contested sign, it is considered that the similarities between the signs are sufficient to create a likelihood of confusion in relation to identical services, this even with a high degree of attention. According to the interdependence principle mentioned above, the lower similarity between the signs is counterbalanced by the identity between the services.

Likelihood of confusion covers situations where the consumer directly confuses the trade marks themselves, or where the consumer makes a connection between the conflicting signs and assumes that the services covered are from the same or economically linked undertakings. Indeed, it is highly conceivable that the relevant consumer will perceive the contested mark as a sub-brand, a variation of the earlier mark, configured in a different way according to the type of goods or services that it designates (23/10/2002, T-104/01, *Fifties / Miss Fifties* (fig.), EU:T:2002:262, § 49).

Considering all the above, the Opposition Division finds that there is a likelihood of confusion on the part of the public and therefore the opposition is well founded on the basis of the opponent's French trade mark registration in relation to the following services:

*Class 35: Sales administration; procuring of contracts for the purchase and sale of goods; rental of sales stands; assistance in product commercialization, within the framework of a franchise contract; developing promotional campaigns for business; development of promotional campaigns; dissemination of advertisements; dissemination of advertisements via the internet; dissemination of advertising via online communications networks; dissemination of commercial information; dissemination of advertising, marketing and publicity materials; distribution of promotional matter; dissemination of advertising matter; direct mail advertising; dissemination of advertising and promotional materials; commercial administration of the licensing of the goods and services of others; commercial administration of the licensing of the goods and services of others; business management of retail outlets; business management of wholesale and retail outlets; preparation of advertising campaigns; preparing promotional and merchandising material for others; presentation of goods on communication media, for retail purposes; providing assistance in the field of product commercialization; compilation, production and dissemination of advertising matter; dissemination services of advertisement matter; business merchandising display services; franchising services providing marketing assistance; market research services relating to broadcast media; wholesale ordering services; advertisement and publicity services by television, radio, mail; advertising; advertising services relating to the commercialization of new products.*

It follows that the contested trade mark must also be rejected for all these services.

## **COSTS**

According to Article 109(1) EUTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party.

Since the applicant is the losing party, he must bear the opposition fee as well as the costs incurred by the opponent in the course of these proceedings.

According to Article 109(1) and (7) EUTMR and Article 18(1)(c)(i) EUTMIR, the costs to be paid to the opponent are the opposition fee and the costs of representation, which are to be fixed on the basis of the maximum rate set therein.



### The Opposition Division

Vít MAHELKA

Saida CRABBE

Christophe DU JARDIN

According to Article 67 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds for appeal must be filed within four months of the same date. The notice of appeal will be deemed to have been filed only when the appeal fee of EUR 720 has been paid.