

Bird & Bird

Report of UK Trade Mark Cases

For the CIPA Journal

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Trade mark decisions

No risk of confusion or dilution

Lifestyle Equities C.V. & Anr v Royal County of Berkshire Polo Club Ltd & Ors (Mr Justice Mellor; [2023] EWHC 1839 (Ch); 19 July 2023)

Mr Justice Mellor dismissed claims by Lifestyle Equities for trade mark infringement and passing off on the basis there was no risk of confusion or that the public would make a link between the marks. Parisa Fard reports.

Background

This judgment related to claims brought by Lifestyle Equities, owner of the BEVERLY HILLS POLO CLUB ("BHPC") marks. Lifestyle Equities argued that its BHPC marks were infringed in various territories by Berkshire Polo Club's use of the sign 'ROYAL COUNTY OF BERKSHIRE POLO CLUB' ("RCBPC"). Lifestyle Equities therefore brought claims under sections 10(2) and 10(3) (and equivalent EU legislation) and a claim in passing off. The section 10(3) claim was limited to dilution of distinctive character only.



The parties sought resolution of alleged infringements occurring in the UK, EU, Chile, Panama, Peru, Mexico and the UAE. They therefore agreed to apply UK and EU law to all these territories and that the decision of the High Court would bind the parties in all jurisdictions in dispute, although this was not specified in the case.

Section 10(2)

The Judge noted that the market for polo-themed clothing was crowded and that there were several brands using logos that depicted mounted polo players. The Judge found there was consequently no distinctiveness in the horse and rider motif of the BHPC marks or in the words "Polo Club". He concluded therefore that the names of the brands were the primary point of distinction, and the distinctiveness resided in the marks as a whole.

He rejected Lifestyle Equities' arguments that there was direct confusion because there was a total lack of evidence of confusion, or a likelihood of confusion, in any jurisdiction despite the brands having coexisted for significant periods of time in certain jurisdictions. The Judge was also critical of Lifestyle Equities' evidence, aspects of which he found to be "materially misleading and untrue" and presented with "exaggeration ... as to the scale and reach of the BHPC brand".

The Judge also rejected Lifestyle Equities' arguments for indirect confusion because the crowded market, along with the elements of the marks, militated against anyone viewing the RCBPC sign as a sub-brand or as a brand refresh of the BHPC mark.

Section 10(3) and Passing Off

The claim under section 10(3) that the distinctive character of the BHPC marks would have been diluted was also rejected. While the Judge acknowledged that Lifestyle Equities' marks had a degree of reputation for certain goods in Italy, Spain and the UK, he found that the average consumer would have made no link between the BHPC marks and the RCBPC sign. Even if a link would have been made, at best, a consumer might simply have wondered whether there was a connection before concluding there was not because of the differences between marks. As such, there was no risk of injury under section 10(3). Since the infringement claims had failed, the passing off claim also failed.

The Judge considered that Lifestyle Equities' evidence had not been prepared in the spirit of the rules on evidence and noted that their approach to litigation had been as "oppressive as possible and not proportionate".



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