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Supreme Court orders registration of 'polo' mark despite existence of earlier 'polo' marks
Thailand - Tilleke & Gibbins

Examination/opposition
National procedures

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In *Young Sangyo Co Ltd v Department of Intellectual Property* (November 25 2013), the Supreme Court has overturned a decision of the Intellectual Property and International Trade Court (IP & IT Court) in which the latter had found the figurative trademark BEVERLY HILLS POLO CLUB was confusingly similar to the earlier figurative trademark SANTA BARBARA POLO & RACQUET CLUB.

Plaintiff *Young Sangyo Co Ltd* filed an application for the registration of the trademark BEVERLY HILLS POLO CLUB (and polo player device) with the Department of Intellectual Property of Thailand for goods in several classes, including Classes 9 and 28 of the [Nice Classification](#) (Application Nos 595158 and 595162):



The registrar rejected the application under Section 13 of the [Trademark Act](#) on the ground that the trademark was identical or similar to the registered trademarks of others - namely:

- the trademark RLX POLO SPORT (and device) (Registration No TM102221) for goods in Class 9:



- the trademark POLO (and device) (Registration No TM184935) for goods in Class 18:



- the trademark SANTA BARBARA POLO & RACQUET CLUB (and device) (Registration No TM193574) for goods in Class 9:

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- the trademark POLO WORLD (and device) (Registration No TM174819) for goods in Class 9:



The plaintiff appealed to the Board of Trademarks. The board confirmed the registrar's order, finding that the plaintiff's trademark was identical or similar to the registered trademarks of others to the extent that it might cause public confusion as to the proprietorship or origin of the goods.

The plaintiff argued that the registrar's order and the Board of Trademarks' decision were unlawful, as its trademark was not identical or similar to the registered trademarks of others to the extent that it could cause confusion among the public. The plaintiff filed a civil suit with the IP & IT Court, requesting that the court withdraw the registrar's order and the board's decision, and order the Department of Intellectual Property to proceed with registration of the mark.

The IP & IT Court dismissed the case, considering that the mark applied for was confusingly similar to the registered trademark SANTA BARBARA POLO & RACQUET CLUB of the Santa Barbara Polo & Racquet Club. The plaintiff appealed to the Supreme Court.

On November 25 2013 the Supreme Court pronounced its judgment. The court stated that, due to its appearance and pronunciation, the plaintiff's trademark BEVERLY HILLS POLO CLUB was clearly different from the registered trademark SANTA BARBARA POLO & RACQUET CLUB, as well as the other cited trademarks. The court also considered that, although the marks both included the word 'polo', this did not preclude the plaintiff from using that word as part of its trademark, given that its overall appearance and pronunciation was not confusingly similar. In addition, as the plaintiff had disclaimed the words 'Beverly Hills' and 'club', it had no exclusive rights over those words. Finally, the plaintiff had successfully proven that it had used and advertised the mark in numerous countries without any confusion since 2001.

The Supreme Court thus overturned the IP & IT Court's judgment and dismissed the Board of Trademarks' decision. It ordered the Department of Intellectual Property to proceed with registration of the plaintiff's trademark in Class 9 and Class 28.

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