

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3,273,439 BY SC GOLD
RETAIL LIMITED

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF CLARE BOUCHER
(O/312/19) DATED 3 JUNE 2019.

DECISION

Introduction

1. This is an appeal from the decision of Ms Clare Boucher, for the Registrar, dated 3 June 2019 (O/312/19) where she dismissed the opposition of Direct Gold Retail Limited to SC Gold Retail Limited's trade mark application (No. 3,273,439) under sections 3(6) and 5(2)(b) of the Trade Marks Act 1994. SC Gold Retail appeals that decision in relation to section 5(2)(b) only.
2. Direct Gold Retail Limited ("Direct Gold") applied to register the following mark in relation to goods in Classes 9, 12, 24, 25 and 28:



3. SC Gold Retail Limited (SC Gold) opposed the application on the basis of its earlier word mark DIRECT GOLF which is registered in respect of goods and services in Classes 12, 16, 18, 25, 28 and 35.
4. The appeal is only against the Hearing Officer's comparison of the signs and the subsequent finding of likelihood of confusion. Accordingly, SC Gold does not challenge the Hearing Officer's conclusions that some of the goods are identical and some are similar (Decision, paragraphs 25 to 32), the characteristics of the average consumer and the purchasing acts (Decisions, paragraphs 35 to 38), or her finding as to the distinctiveness of the earlier mark (Decision, paragraph 51).

Standard of review

5. The standard of appeal is by way of review. Neither surprise at a Hearing Officer's conclusion nor a belief that he or she has reached the wrong decision will suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong. The relevant principles were set out

in *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17 by Daniel Alexander QC and more recently by the Supreme Court in *Actavis Group PTC EHF v ICOS Corporation* [2019] UKSC 15. What is meant by a material error was explained by Lord Carnworth in the Supreme Court in *R (R) v Chief Constable of Greater Manchester* [2018] UKSC 47, [2018] 1 WLR 4079 at paragraph 64:

In conclusion, the references cited above show clearly in my view that to limit intervention to a “significant error of principle” is too narrow an approach, at least if it is taken as implying that the appellate court has to point to a specific principle—whether of law, policy or practice—which has been infringed by the judgment of the court below. The decision may be wrong, not because of some specific error of principle in that narrow sense, but because of an identifiable flaw in the judge's reasoning, such as a gap in logic, a lack of consistency, or a failure to take account of some material factor, which undermines the cogency of the conclusion. However, it is equally clear that, for the decision to be “wrong” under CPR r 52.11(3), it is not enough that the appellate court might have arrived at a different evaluation...

6. And, in *Z, R (On the Application Of) v London Borough of Hackney* [2019] EWCA Civ 1099 Lewison LJ at paragraph 66 highlighted that:

It is not enough simply to demonstrate an error or flaw in reasoning. It must be such as to undermine the cogency of the conclusion. Accordingly, if there is no such error or flaw, the appeal court should not make its own assessment.

7. When considering this appeal, and applying the principles I have outlined above, it is important to remember the high bar set.

The Appeal

8. Mr Harris, for the Appellant, accepts that the direction in law the Hearing Officer gave herself was correct, but he says she fell into error when applying it.
9. The Appellant suggests that the Hearing Officer was mistaken in her assessment of visual similarity. She undertook this comparison in paragraphs 44 to 46 of her Decision (headings and footnotes omitted):

In my view, the larger size of the letters makes the words “MAJOR” and “GOLF” more eye-catching than the word “DIRECT”. This dominance is reinforced by the use of bold black and bright orange, against the paler grey of “DIRECT”. To my mind, “MAJORGOLF” has the greatest relative weight in the overall impression, although “DIRECT” still makes a contribution to the overall impression of the mark.

The opponent submits that the marks are visually highly similar. To me this seems to be predicated on a finding that the comparison is essentially between DIRECT GOLF and GOLF DIRECT. I have found that “MAJORGOLF” has the greatest relative weight. However, I must compare the marks as wholes, given that “DIRECT” is, in my view, not negligible.

All the words in the opponent’s mark are present in the applicant’s. In the latter, they are split over two lines, are different sizes, and “DIRECT” is essentially after the word “GOLF” in the contested mark (it being below and right-aligned), whereas it precedes it in the earlier mark. The first word of the applicant’s mark is also different. Given my earlier finding on the overall impression of the applied for mark, and the similarities and differences that exist between the marks as a whole, there is, to my mind, only a low level of visual similarity between these marks.

10. Mr Harris submits that the Hearing Officer gave too much weight to the visual impact of MAJOR GOLF and too little to the word DIRECT. Had she given the right weight

to the word DIRECT, he submits, she would have found more than a low level of similarity.

11. In my view, the Hearing Officer is perfectly entitled to see the words MAJOR GOLF as having more weight in the mark than the word DIRECT. Furthermore, she does not ignore the word DIRECT; rather, she gives it less weight and then she goes on to explain why. Her reasoning, while short, is clear and I see no reason to impeach it in this respect.

12. Mr Harris submitted next that the Hearing Officer erred in her assessment of aural similarity in paragraph 47 of her Decision:

The opponent's mark has three syllables and will be articulated "DIE-REKT GOLF". The applicant's mark has three or five syllables, depending on whether the average consumer says the word "DIRECT". It will be articulated "MAY-JUR GOLF" or "MAY-JUR GOLF DIE-REKT". In the first instance, only one syllable is the same, although it has the same position in the phrase; in the second, the applicant's mark is noticeably longer. Either way, I consider there to be only a low degree of aural similarity between the marks.

13. Mr Harris complains that when comparing the full mark MAJOR GOLF DIRECT the Hearing Officer merely says that the mark applied for is noticeably longer. He went on to submit that consumers might see the mark differently from the Hearing Officer. The role of the Hearing Officer is to form a view on how the average consumer will consider a mark and not on how any possible consumer might do so. In my view, the Hearing Officer looked at visual similarity in a sensible way – looking at the length of words or phrases - and so she was perfectly entitled to come to the conclusion she did.

14. The next part of Mr Harris's submissions was directed to the Hearing Officer's findings of conceptual similarity in paragraphs 48 and 49 of her Decision:

The word "GOLF" is likely to be perceived as referring to the sport and "DIRECT" suggests that the consumer is getting the goods straight from the manufacturer and it may also bring to mind the idea of a quick and efficient service.

In the case of the opponent's mark, I consider that the average consumer would interpret it as meaning that the goods come from an undertaking called "MAJORGOLF". The opponent submits that "MAJOR" will "indicate quality or allude to a golf tournament which are often referred to as 'majors'". The latter meaning is, in the opponent's view, reinforced by the pennant device over the J, as it sees this as "a representation of the flag on the greens". I agree that the device is likely to be seen in this way, but am not persuaded that the word "MAJOR" will have no conceptual content in its own right. I am aware that it is only the most prestigious golf tournaments that are known as "majors". The word itself may have several meanings. In addition to those suggested by the opponent, it could also be seen as referring to the size of the undertaking. I find the marks to be conceptually similar to a medium degree, on the basis that they both share the concept of "golf". The contested mark does also contain the element "direct", but, as I have already found, this has a lesser weight in the overall impression of that mark.

15. In short, Mr Harris argued that the word MAJOR should be given less weight in the aural comparison than DIRECT. He went on to submit that MAJOR is a weak distinctive term and describes a large version of GOLF DIRECT. Indeed, although never expressly put this way, his submissions went towards suggesting that MAJOR should be given very little weight so the comparison should really be between GOLF DIRECT and DIRECT GOLF and that these carry the same concept. He even went as

far as citing a Board of Appeals decision (R 289/2017-2 *GOLF DIRECT* (10 October 2017) where the marks compared were GOLF DIRECT and DIRECT GOLF. However, these were not the marks at issue in the instant case and it would be wrong to proceed on the basis they were.

16. In any event, I agree with the Hearing Officer that the word DIRECT suggests the consumer getting the goods directly from a manufacturer (although I would put it slightly differently, namely the goods are not purchased through an intermediary as it might be direct from an importer or major distributor). I also tend to think this meaning is much stronger when the word DIRECT is at the end or appears as a subsidiary part of the mark. Nevertheless, I accept that the Hearing Officer is entitled to find as she did and so the meaning applies wherever the word is placed.
17. This leads to Mr Harris's second point on conceptual meaning. He said that while a concept has been given to DIRECT it was not considered in the comparison in paragraph 49. However, in her last sentence, the Hearing Officer clearly considers the role DIRECT plays and reiterates that it would be given lesser weight. It is true that this sentence was after she said the marks were conceptually similar to a medium degree, but considering the meaning she gave to DIRECT that word is unlikely to increase the similarity to any significant degree. Accordingly, the Hearing Officer was perfectly entitled to reach the conclusion she did.
18. The remainder of the appeal was largely dependent on the Hearing Officer being wrong in her assessment of the similarity of the mark, and in particular, the weight she gave to the word DIRECT in each mark. As I have concluded, she was perfectly entitled to reach the conclusions she did. It follows that her assessment of the likelihood of confusion also stands.

Conclusion

19. I therefore uphold the Hearing Officer's decision and dismiss the appeal in its entirety.
20. The Respondent played no part in the appeal proceedings. Accordingly, I make no order as to costs.

PHILLIP JOHNSON
APPOINTED PERSON
31 JANUARY 2020

For the Appellant: PHILIP HARRIS (Lane IP Limited)

The Respondent did not take part in the appeal.