O-0795-23

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO. 3653938

BY

DANIEL PARTRIDGE

TO REGISTER

The Golphers

AS A TRADE MARK IN CLASS 25

AND

OPPOSITION THERETO (UNDER NO. 429998)

BY

AMERICAN INTERNATIONAL GROUP, INC.

BACKGROUND

1) On 10 June 2021, Daniel Partridge ('the applicant') applied to register the words, The Golphers, as a trade mark, in respect of the following goods:

> **Class 25:** Golf footwear; Golf shoes; Golf trousers; Golf shirts; Golf shorts; Golf caps; Golf skirts; Golf clothing, other than gloves; Sports clothing [other than golf gloves]; Children's headwear; Children's footwear; Children's wear; Children's outerclothing; Children's clothing; Costumes for use in children's dress up play.

2) The application was published in the Trade Marks Journal on 15 October 2021 and notice of opposition was later filed by American International Group, Inc ('the opponent'). The opponent claims that the trade mark application offends under Section 5(2)(b) of the Trade Marks Act 1994 ('the Act').

3) In support of its ground under section 5(2)(b) of the Act, the opponent relies upon the following trade mark registration in class 25, as follows:

- **UKTM 918180141**

  GOLFHER

  Class 25: visors; apparel; aprons; hats; caps.

  Filing date: 14 January 2020
  Date of entry in register: 18 July 2020

4) It is claimed that the respective marks are near-identical and that the respective goods are identical or highly similar such that there exists a likelihood of confusion under Section 5(2)(b).

5) The trade mark relied upon by the opponent is a comparable mark (EU)[1] which is an 'earlier' mark, in accordance with section 6 of the Act. As it had not been registered for five years or more at the filing date of the contested application, it is not subject to the proof of use conditions as per Section 6A of the Act.

6) The applicant filed a counterstatement. The following points are made therein:

- A likelihood of confusion is denied.
- It is agreed that the parties' goods may be similar, but the applicant states that he would need proof of use from the opponent to 'confidently admit or deny this'.
- It is agreed that the definite article, 'The', and the plural versus singular would not significantly differentiate the respective marks if they were spelt identically. However, the applicant submits that the different spellings of the marks means that the contested mark is a play on the word 'gopher' which is intended to generate a very specific cartoon-themed image of a gopher playing golf whereas the earlier mark will be seen as a combination of the words 'golf' and 'her', referring to women in golf. It is said that the marks are therefore completely different.

7) The opponent is represented by Pinsent Masons LLP. The applicant is without legal representation. Neither party has filed any evidence nor any submissions beyond those made in the notice of opposition/counterstatement. Neither party requested a hearing nor filed written submissions in lieu. I now make this decision after consideration of the papers before me.

DECISION

8) Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in

[1] Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

accordance with EU law as it stood at the end of the transition period. As the provisions of the Act relied upon in these proceedings are derived from an EU Directive, I will, therefore, take account of trade mark case law of the EU courts.

9) Section 5(2)(b) of the Act states:

> "5. - (2) A trade mark shall not be registered if because –
>
> (a)….
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.
>
> 5A. Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

10) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The correct approach

11) In the light of the applicant's comments made in the counterstatement about proof of use being necessary from the opponent to show that the respective goods are, in fact similar, it is necessary for me to explain what the correct approach is that I must take when assessing the similarity between the parties' goods.

12) The first point to make is that, as noted earlier, the opponent's mark is not subject to the 'proof of use' requirement. The opponent is therefore entitled to rely upon all of its goods in class 25 without having to show that it has actually used its mark in relation to any of them. The second point is that I am required to make the assessment of the likelihood of confusion notionally and objectively based on the opponent's goods, as registered, and the applicant's goods, as applied for, in accordance with the relevant case law. That assessment requires that I must not take into account the actual way that either party has used their marks in the marketplace or the kinds of goods that those marks have been used in relation to thus far. Further, I must consider all of the circumstances in which the mark applied for might be used if it were registered[2]. In this connection, in *Devinlec Développement Innovation Leclerc SA v OHIM,* Case C-171/06P, the CJEU stated:

"59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance

[2] As per *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited,* Case C- 533/06, [66]

was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks."

The actual goods currently being provided and/or the current marketing strategies being adopted by either party in the marketplace is therefore not relevant to my assessment.

Comparison of goods

13) All relevant factors relating to the goods should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the CJEU, Case C-39/97, stated at paragraph 23 of its judgment:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

14) Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

> (a) The respective uses of the respective goods or services;
>
> (b) The respective users of the respective goods or services;
>
> (c) The physical nature of the goods or acts of service;
>
> (d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

15) I also note that in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM* Case T-133/05) ('*Meric*'), the General Court held that:

"29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275,paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42)."

16) The goods to be compared are:

Opponent's goods	Applicant's goods
Class 25: visors; apparel; aprons; hats; caps.	**Class 25:** Golf footwear; Golf shoes; Golf trousers; Golf shirts; Golf shorts; Golf caps; Golf skirts; Golf clothing,

	other than gloves; Sports clothing [other than golf gloves]; Children's headwear; Children's footwear; Children's wear; Children's outerclothing; Children's clothing; Costumes for use in children's dress up play.

17) The opponent's 'hats' and 'caps' are identical to the applicant's 'golf caps' and 'children's headwear' in accordance with the *Meric* case law referred to above. The opponent's specification also includes the term 'apparel'. This is a broad term which, to my mind, encompasses all of the applicant's various kinds of clothing and therefore those respective goods are also identical as per *Meric*. I also consider the term 'apparel' to be broad enough to cover the applicant's various shoes and footwear. Even if I am wrong about that, those goods are, in any event, highly similar given that the users and trade channels will be the same, the goods may be made from the same or similar materials and their intended purpose is the same (to adorn the body).

Average consumer and the purchasing process

18) It is necessary to determine who the average consumer is for the respective goods, and the manner in which they are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

19) The average consumer for the respective goods is the general public. The purchasing act will be primarily visual as they will be selected after perusal of racks/shelves in high-street stores or from photographs/images on Internet websites or in catalogues. That is not to say, though, that the aural aspect should be ignored since the goods may sometimes be the subject of discussions with sales representatives, for example. The cost of the goods is likely to vary. However, factors such as size, material, comfort/fit, aesthetics and/or suitability for purpose are likely to be taken account of by the consumer. Generally speaking, I find that a medium degree of attention is likely to be paid during the purchase for the goods at issue.

Comparison of marks

20) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> ".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take account of their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

21) The marks to be compared are:

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The earlier mark consists of the single, plain word GOLFHER. The overall impression lies solely in the word itself. The contested mark consists of the words 'The Golphers'. The word 'The' at the beginning of the mark is prominently positioned and makes a contribution to the overall impression but to a lesser extent than the word 'Golphers'.

22) Visually, a point of difference is the presence of 'The' at the beginning of the contested mark, which is absent from the earlier mark. The respective words 'GOLFHER' and 'GOLPHERS' are highly similar to the eye, despite the difference between the letters 'P' and 'F' in the middle of those words, and the presence of the additional letter 'S' at the end of the contested mark, which is absent from the earlier mark. Overall, there is a high degree of visual similarity between the marks.

23) Aurally, the respective words 'GOLFHER' and 'Golphers' are highly similar, despite the additional 'S', which will be vocalised in the contested mark, but not in the earlier mark. The vocalisation of 'The' at the beginning of the applicant's mark creates a point of aural difference. Overall, there is a high degree of aural similarity between the marks.

24) Conceptually, the applicant contends that 'GOLFHER' will be perceived as a combination of the words 'GOLF' and 'HER'. I accept that there may be a proportion of consumers who perceive the earlier mark in that way, so that the mark brings to mind a female golfer, particularly when used on goods aimed at women/girls. However, there is also likely, in my view, to be another proportion of consumers who merely perceive the mark as being a misspelling of the word, 'GOLFER', and will perceive the contested mark merely as meaning a golfer *per se* and nothing more. Turning to its own mark, the applicant contends that 'The Golphers' will bring to mind the concept of a gopher playing golf. However, I consider it unlikely that the average consumer will immediately grasp such a meaning without more in the mark to lead them to that meaning. In my view, when faced with the plain words 'The Golphers',

there will be a proportion of average consumers who merely perceive those words as being a misspelling of the term ‘The Golfers’; the immediate conceptual message that will be created in those consumers’ minds will therefore be of a group of golfers *per se* and nothing more. There may also be another proportion of consumers who perceive the contested mark as meaning female golfers, due to the spelling of the contested mark as ‘The Golphers’ (my emphasis). It follows that, whichever way the respective marks are perceived, they are conceptually highly similar.

Distinctive character of the earlier mark

25) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH* v *Klijsen Handel BV,* Case C-342/97 the CJEU stated that:

> “22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

The earlier mark is the plain word ‘GOLFHER’, absent any stylisation or embellishments. Whichever way the earlier mark is conceptualised (as per my earlier findings in paragraph 24), it is clearly strongly allusive in relation to apparel for playing golf. For those kinds of goods, I find that the earlier mark has a low degree of distinctiveness, despite its misspelling. For other kinds of apparel (not for golf), the allusive message is not immediately apparent, and I find the mark to have a normal level of distinctiveness in relation to those goods.

Likelihood of confusion

26) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V).*

27) The respective goods are identical or, at least, highly similar. The marks are also visually, aurally and conceptually highly similar. These are very strong factors weighing in the opponent’s favour. Bearing in mind those factors, and notwithstanding that, for certain of the goods at issue, the distinctiveness of the earlier mark is low (as opposed to medium), I find that an average consumer paying a medium degree of attention is likely, through imperfect recollection, to mistake one mark for the other when used in relation to all of the relevant goods. **The opposition under Section 5(2)(b) of the Act succeeds in full.**

COSTS

28) As the opponent has been successful, it is entitled to a contribution towards its costs. Using the guidance in Tribunal Practice Notice 2/2016, I award the opponent costs on the following basis:

Preparing a statement and considering the other side's statement	£200
Official fee (Form TM7)	£100
Total:	**£300**

29) I order Daniel Partridge to pay American International Group, Inc the sum of **£300**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of August 2023

Beverley Hedley
For the Registrar,
the Comptroller-General