

O-245-05

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2364885  
BY B. ABLE MOBILITY  
TO REGISTER THE TRADE MARK**

**KADDY KING**

**IN CLASS 12**

**AND IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 92758  
BY HUMBER IMPORTS**

## **BACKGROUND**

1) On 3 June 2004, B.Able Mobility of The Granary, 174b London Road, East Grinstead, West Sussex, RH19 1ES applied under the Trade Marks Act 1994 for registration of the following trade mark:



2) Registration was sought in respect of the following goods in Class 12: “Golf Trolley”.

3) On 26 August 2004 Humber Imports of Unit 31 Priory Tec Park, Saxon Way, Hessle, East Yorkshire HU13 9PB filed notice of opposition to the application. The ground of opposition is in summary:

The opponent has been selling electric golf trolleys under the name of “ALINI CADDY KING” since September 2003. The mark applied for therefore offends against Section 5(4)(a) of the Trade Marks Act 1994. Attached to the statement of grounds is an invoice, dated 1 September 2003 for the sale of ten “Caddy King Electric Trolleys” at a cost of £1,527.50 to Louth Golf Centre Ltd. Also attached is a leaflet for “Caddy King Electric Golf Trolley”.

4) The applicant subsequently filed a counterstatement denying the opponent’s claim, and also stating that it has been selling the goods under the mark in suit in Spain for the past year. The applicant also attached an invoice, dated 2 August 2003, for the sale of twenty “KADDY KING electric golf trolleys” to an address in Malaga. Also attached are two leaflets with the same photograph and information with the exception of the price and the telephone numbers. One leaflet is labelled for the UK the other for Spain.

5) Only the opponent filed evidence in these proceedings. Both sides ask for an award of costs. Neither side wished to be heard, so I shall make my decision from the papers.

## **OPPONENTS’ EVIDENCE**

6) The opponents filed a witness statement, dated 2 March 2005, by John Harrison the Sales Manager of the opponent company. He states that his company has, since September 2003, sold electric golf trolleys under the name “Caddy King”. At exhibit HU/B4/002 he provides a copy of the first sale of these items. This is the same invoice as attached to the statement of grounds. It shows a date of 1 September 2003, and relates to the sale of ten “CADDY KING Electric Trolleys” to Louth Golf Centre. He states that since September 2003 his company has sold over 4000 golf trolleys in the UK. Mr Harrison states that his company owns the following URL’s:

caddyking.com (registered 04/05/04)

caddyking.co.uk (registered 08/04/04)  
alinicaddyking.com (registered 04/05/04)  
alinincaddyking.co.uk (registered 08/04/04)

7) Mr Harrison states that in July 2004 they received a communication from the applicant stating that they owned the mark in suit and threatening legal action. He claims that the applicant has been advertising their products under the mark in suit together with the “®” logo on eBay. Mr Harrison also provides the following exhibits:

HU/B4/003: A users guide to the product which is not dated and appears to be a mock up and not a final version. It refers to the “ALINI Caddy King PRO” with the word “ALINI” being in a circle device, the words “Caddy” and “King” being in larger print with the word “King” in bold and the word “PRO” being in bold and in orange.

HU/B4/004: A copy of the applicant’s advertisement on eBay showing use of the “®” logo after the name “KADDY KING”. This is dated 16 January 2005.

HU/B4/005: A copy of the communication from the applicant to a customer of the opponent seeking cessation of use of the term “Caddy King”. This is not addressed or dated.

HU/B4/006: A copy of a letter from the opponent to the applicant referring to the communication in exhibit HU/B4/005. This letter pointed out that the mark was not registered and that the opponent had prior rights.

HU/B4/007: This consists of three leaflets advertising the opponent’s product. On two of the leaflets the product is advertised as:



This is identical to the use described in HU/B4/003. The other leaflet merely refers to “Caddy King Electric Golf Trolley”. None of the leaflets are dated.

8) That concludes my review of the evidence. I now turn to the decision.

## **DECISION**

9) The only ground of opposition is under Section 5(4)(a) which reads:

“5.(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) ....

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

10) In deciding whether the mark in question “KADDY KING” offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs Q.C., in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purpose of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] A.C. 731 is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of “passing off”, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.””

11) The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. It is clear from Article 4(4)(b) that the earlier right had to have been “acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed...”. The relevant date may therefore be either the date of the application/ priority claimed for the mark in suit (although not later), or the date at which the acts first complained of commenced – as per the comments in *Cadbury Schweppes Pty Limited v. The Pub Squash Co Pty Ltd* [1981] RPC 429.

12) In the instant case I must assess whether use of the applicant's mark KADDY KING was as at the date of application, liable to be prevented by the law of passing off. The onus is on the opponent to make out a prima facie case. If he succeeds, in the circumstances of this case, I need to return to the applicant's own position in view of his claim to seniority of user. I say this because, although a Section 5(4)(a) claim has to be established at the date of the application, it is clear that an opponent could have had no such right if an applicant's use is protected in the UK from an earlier date or if, by the relevant date, an applicant had established his own actionable goodwill in the UK, (*Habib Bank* [1982] RPC 1 at 24).

13) In *South Cone Inc. v. Jack Bessant, Dominic Greensmith, Kenwyn House, Gary Stringer (a partnership)* [2002] RPC 19 Pumrey J. in considering an appeal from a decision of the Registrar to reject an opposition under Section 5(4)(a) said:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* [1946] 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus, the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.”

14) This cannot be interpreted in a prescriptive fashion. There will be occasions when the evidence does not fall within the above parameters but still establishes goodwill for passing off purposes - see the decision of Professor Annand, sitting as the Appointed Person, in *Loaded* BL O/191/02.

15) The opponent has asserted that it had goodwill and reputation at the relevant date. However, the evidence filed to show use of the opponent's mark is, with one exception, not dated. The exception is the invoice showing the sale of ten electric golf trolleys to Louth Golf Centre at a cost of £1,527.50 on 1 September 2003. The invoice referred to the electric golf trolleys as “CADDY KING”. I note that the literature filed is divided between that which uses this term and that which refers to the following mark:



16) Considered overall it seems clear that the opponent had some trade in the UK prior to the relevant date. However, the deficiencies in the evidence makes it

impossible to assess the extent of the opponent's goodwill in the businesses conducted under either of the two marks "CADDY KING" or "Alini Caddy King Pro". The average consumer for the product is clearly the normal club golfer. This is made clear in the literature filed and also as it is well known that, in the main, the professional golfer uses a human as a caddy not an electric trolley. Even if I were to consider that average consumer would view the initial word of the mark "Alini" as a house mark and would similarly ignore the last word "Pro" as being allusive of the quality of the product, thus allotting all of the goodwill and reputation to the mark "CADDY KING" the opponent is in no better position. Although no evidence has been filed on the size of the market it is widely known that there are thousands of golf courses in the UK, each with several hundred members. In addition there are those who whilst not playing the game themselves nevertheless purchase golfing equipment as presents. The number of consumers for this product must be considered as being in the hundreds of thousands. The literature filed in the evidence by the opponent is not dated, nor has the opponent given any details as to its distribution. I am left with the fact that the opponent has four URL's registered which include the term "CADDY KING" and the invoice for ten trolleys to a single outlet.

17) Taking all of the above into consideration it is my opinion that the opponent has not shown that he has reputation and goodwill, amongst the relevant public, in the name "CADDY KING" or "ALINI CADDY KING PRO" in relation to golf trolleys. The opposition under Section 5(4)(a) therefore falls at the first hurdle.

18) As the applicant has been successful it is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of £500. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 6<sup>th</sup> day of September 2005**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**