O/0062/24

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NOS.
UK00003514793 & UK00003442550
IN THE NAME OF PLAY SIX LTD
FOR THE FOLLOWING TRADE MARKS

IN CLASSES 16, 18, 25 & 28

AND

IN CLASS 41

AND

APPLICATIONS FOR DECLARATIONS OF INVALIDITY UNDER NOS. 504394 & 504396 BY PGA EUROPEAN TOUR

BACKGROUND AND PLEADINGS

1. Play Six Ltd ("the proprietor") is the owner of the following trade marks:

UK registration no. 3514793

Filing date 22 July 2020; registration date 8 January 2021

Registered for the following goods:

Class 16: Golf scorecard holders; Golf scorecards; Golf yardage books.

Class 18: Golf umbrellas.

Class 25: Golf caps; Golf clothing, other than gloves; Golf footwear; Golf shirts; Golf shoes; Golf shorts; Golf skirts; Golf trousers.

Class 28: Golf bag carts; Golf bag tags; Golf bag tags of leather; Golf bag trolleys; Golf bags; Golf bags, with or without wheels; Golf bags with or without wheels; Golf ball markers; Golf balls; Golf club bags; Golf club covers; Golf club grips; Golf club head covers; Golf divot repair tools; Golf flags; Golf flags [sports articles];Golf gloves; Golf practice apparatus; Golf practice nets; Golf tee bags; Golf tees; Golf training aids; Golfing gloves.

("the proprietor's first mark"); and

UK registration no. 3442550

Filing date 7 November 2019; registration date 31 January 2020

Registered for the following services:

Class 41: Golf tournaments (Organising of -).
("the proprietor's second mark").

2. On 30 November 2021, PGA European Tour ("the applicant") applied to have the proprietor's marks declared invalid under section 47 of the Trade Marks Act 1994 ("the Act"). The applications are both brought under sections 5(2)(b) and 5(4)(a) of the Act and is targeted at the entirety of the goods and services in the proprietor's marks' specifications.

3. Under the 5(2)(b) ground of both applications, the applicant relies upon the following marks:

UK registration no. 3211918
("the applicant's first mark");

GOLF 6s
UK registration no. 3211914
("the applicant's second mark"); and

GOLF SIXES
UK registration no. 3211913
("the applicant's third mark").

4. All of the applicant's marks share the same filing and registration dates, being 9 February 2017 and 26 May 2017, respectively. Further, the applicant's marks are all registered for identical goods and services, being the following:

Class 9: Computer software and computer programmes; video games; pre-recorded disks and tapes; recorded magnetic and opto-

magnetic data carriers; CDs, DVDs, CD-ROMs, videos; electronic publications (downloadable); downloadable electronic publications in relation to golf; application software and downloadable application software relating to golf, golf matches or golf tournaments; software (recorded programs), including software for games, computer software and downloadable computer software, all relating to golf, golf matches or golf tournaments; interactive software products relating to golf, golf matches or golf tournaments; recorded or downloaded audio, sounds, images, multimedia files, text or data files (including but not limited to files consisting of or containing information relating to tournament schedules, match results, draws or scores, rankings, player statistics), all relating to golf, golf matches or golf tournaments; audio material, video material, and podcasts, all being downloadable, all relating to golf, golf matches or golf tournaments; sunglasses; cases and cords for sunglasses; mobile phone accessories; mouse mats; computer game programs; encoded or magnetic credit cards, debit cards and affinity cards; mobile phone holders; holders for electronic tablets and portable computers activated by touch screen.

Class 25: Clothing; footwear; headgear.

Class 28: Sporting articles; golf apparatus and equipment; golf accessories; equipment for playing the game of golf; ball markers; ball retrievers; golf balls; golf bags; golf clubs; golf club head covers; golf tees; golf gloves; divot and pitch mark repair tools; body training apparatus; games based on or relating to the game of golf; small electronic games other than for use with a television set; playing cards; hand held computer games; games and playthings; toys, except scale model vehicles, scale model automobiles and toy automobiles; board games; puzzles; inflatable toys.

Class 41: Education; golf training and coaching and providing access to, and information on, golf training and coaching; health and fitness services; provision of facilities for playing golf; conferences relating to golf; publication of interactive educational and entertainment products namely films, books, DVDs, videos, CD-Roms; entertainment services; entertainment services relating to golf; sporting activities; television and radio entertainment; provision and production of television and radio entertainment all relating to golf, golf matches or golf tournaments; organising and conducting golf tours, golf matches and golf tournaments; entertainment and sporting services consisting of the provision of a website featuring tournament schedules, match fixtures, match results, draws or scores, sporting performances, facts and figures, order of merit, rankings, player statistics, career money list, sporting videos, golf-related video, audio, film clips, photographs, or other multimedia materials, all relating to golf, golf matches or golf tournaments; provision of a website featuring a searchable database of information relating to golf, golf matches or golf tournaments; provision of information or advice relating to golf, golf matches, or sporting competitions (including golf tournaments); provision and production of live and recorded sporting and cultural events for radio, film, television and the internet; provision and production of audio and visual recordings; provision of admission tickets for golf matches or for sporting, cultural or entertainment events; radio and television coverage of sporting events; provision of games over the internet or on a wireless electronic device; production of hospitality services and packages (entertainment) in relation to golf events; booking and reservation service and hospitality for sporting, cultural and entertainment events; hospitality services, namely, providing corporate hospitality and entertainment; publication of magazines, programmes and other printed matter relating to golf, golf tournaments and golf competitions; evaluation of sporting facilities; rental and hire of sports equipment.

5. The applicant relies upon all of the above goods and services in its application against the proprietor's first mark. However, in respect of the application against the proprietor's second mark, the applicant only relies on those services underlined above.

6. The applicant's position under its 5(2)(b) ground is that the marks at issue are "highly visually and phonetically similar and they are even more similar from a conceptual perspective."[1] Further, the applicant's position is that the goods and services covered by both parties' marks are identical. As a result, the applicant claims that there is a likelihood of confusion, which includes a likelihood of association, between the marks on the part of the relevant public. In addition, I note that the applicant has argued that it owns a family of marks and that its marks all enjoy enhanced distinctiveness by virtue of the use made of them.

7. Under the 5(4)(a) ground of both applications, the applicant relies on the signs 'GOLFSIXES' ("the applicant's first sign") and:

("the applicant's second sign").

8. In respect of both signs, the applicant claims to have used them throughout the UK since February 2017 for the service of "organising and conducting golf tours, golf matches and golf tournaments." Under this ground, the applicant claims that it has accrued substantial goodwill in both signs and that use of the proprietor's marks on the goods and services for which they are registered would create a misrepresentation on the part of the relevant public who would believe that the goods/services of the proprietor originated from, were connected to or were endorsed by the applicant.

[1] This position is taken from the relevant answers given in the applicant's applications for declarations of invalidity

9. The proprietor filed counterstatements wherein it made some concessions as to the similarity of the parties' goods and identity between the parties' services. However despite this, the proprietor maintained its denial of the claims made against it.

10. Upon the filing of the proprietors' counterstatements, the Tribunal wrote to the parties on 30 August 2022 and confirmed that, under Rule 62(1)(g) of the Trade Marks Rules 2008, the proceedings would be consolidated.

11. The applicant is represented by Keltie LLP and the proprietor is unrepresented. Both parties filed evidence in chief. No hearing was requested and only the applicant filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

12. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

13. The applicant filed evidence in the form of the witness statement of Mr James Pinney dated 13 April 2023.[2] Mr Pinney is the Deputy General Counsel for the applicant, a position he has held since 1 January 2020. Prior to this, Mr Pinney held the role of Commercial Lawyer for the applicant since his joining on 20 August 2018. I note that Mr Pinney's evidence is accompanied by 27 exhibits, being those labelled JP1 to JP27.

[2] This evidence was initially filed on 24 November 2022 but was subsequently amended on 13 April 2023.

14. The proprietor's evidence came in the form of the witness statement of Mr Tim Rich dated 2 January 2023. Mr Rich is the founder and sole director of the proprietor and his statement is accompanied by three exhibits, being those labelled TR1 to TR3.

15. I do not propose to summarise the parties' evidence or the applicant's submissions here. However, I have taken them all into consideration in reaching my decision and will refer to them below, where necessary.

DECISION

16. Sections 5(2)(b) and 5(4)(a) have application in invalidation proceedings because of the provisions of section 47(2) of the Act, which states as follows:

> "47. -
>
> (2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-
>
> (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
>
> (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,
>
> unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.
>
> (2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).
>
> (2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of

whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D)-(2DA) [Repealed]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become

sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) […]

(4) […]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed."

Section 5(2)(b): legislation and case law

17. Section 5(2)(b) of the Act reads as follows:

"(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 or association with the earlier trade mark."

18. Section 5A of the Act states as follows:

"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."

19. The applicant's marks qualify as "earlier trade marks" for the purposes of this decision since they were applied for at earlier dates than the proprietor's marks.[3] The applicant's marks did not complete their registration processes more than five years prior to the filing date of the proprietor's marks or the date of the applications at issue meaning that they are not subject to proof of use pursuant to section 6A of the Act. This means that the applicant can rely upon all goods and services for which its marks are registered.

20. The following principles are gleaned from the decisions of the EU courts in *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 Office for Harmonization in the Internal Market (Trade Marks and Designs) ("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:

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

[3] See Section 6(1)(a) of the Act

(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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

21. As I have set out above, the proprietor has accepted that the services at issue under the application aimed at its second mark are identical. As such, I will proceed on the basis that the services of the proprietor's second mark are identical to the services of the applicant. Therefore, a full comparison of the services of the proprietor's second mark is not necessary.

22. In respect of the goods in the proprietor's first mark, I have also noted above that the proprietor has accepted that the goods for which this mark is protected are similar to the goods within the specifications of the applicant's marks. That being said, there is no indication as to what level of similarity it considers to exist between them. As a result, I am still required to proceed to assess the goods and services comparison insofar as it relates to the first application only. However, as a result of the aforementioned concession, it follows that I must conclude at least some degree of similarity between all goods at issue.

23. The proprietor's goods under its first mark are set out at paragraph one above. The goods and services relied upon by the applicant are set out at paragraph four above.

24. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

> "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".

25. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(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.

26. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated 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 trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

27. In making the following comparison, I remind myself of Section 60A(1)(b) of the Act which sets out that goods (or services, for that matter) are not to be regarded as dissimilar from each other solely on the ground that they appear in different classes under the Nice Classification.

Class 16

Golf scorecard holders; Golf scorecards; Golf yardage books.

28. I will compare the above goods of the proprietor with "golf accessories" which sits in the class 28 list of goods in the applicant's specifications. While goods across different classes can be found to be identical, I consider that the differing nature of the above proprietor's goods (being goods that cover a range of paper goods, printed material or stationery)[4] and the nature of the applicant's goods (being a range of goods that cover sporting articles, apparatus and equipment) means that they are not identical under the principle outlined in the case of *Meric*. However, they are still capable of being similar. This is because while these goods may also differ in method of use, they overlap in user and purpose in that someone playing golf will use both parties' goods to assist them in playing the game of golf. Lastly, the parties' goods are all likely to be produced and sold by the same undertakings meaning that there is an overlap in trade channels. While I do not consider the goods to share a competitive or complementary relationship, I am content to conclude that the aforementioned overlaps result in a medium degree of similarity between the goods.

Class 18

Golf umbrellas.

29. Following the same reasoning set out in my preceding assessment, I do not consider that the nature of the above goods is such that I can find them identical

[4] This is on the basis that, by virtue of being goods in class 16, the proprietor's g

to “golf apparatus and equipment” in the applicant’s specifications. That being said, I do consider that there is a degree of similarity between them. This is on the basis that the applicant’s goods can reasonably cover apparatus that is attached to golf trolleys to allow for users to attach their golf umbrellas to their trolley to allow for handsfree use of the umbrella to keep them dry. While such goods differ in nature, method of use and purpose from the proprietor’s golf umbrellas themselves, I consider that they overlap in user and trade channels. This is on the basis that someone using a golf umbrella whilst playing golf is likely to seek such apparatus to attached to their trolley and such goods are likely to be produced and sold by the same undertakings. Further, following the fact that the applicant’s goods can cover adapters for use with umbrellas in attaching them to trolleys, for example, I consider that there is a degree of complementarity between the goods. This is because the use of a golf umbrella is important to such an apparatus and I consider it likely that the consumers will believe that such goods are the responsibility of just one undertaking.[5] Taking all of this into account, I consider that if these are similar to a medium degree.

Class 25

Golf caps; Golf clothing, other than gloves; Golf footwear; Golf shirts; Golf shoes; Golf shorts; Golf skirts; Golf trousers.

30. The applicant’s specifications all contain “clothing”, “footwear” and “headgear”. None of these terms are limited and, therefore, can cover those clothing, footwear and headgear items used for playing golf. As a result, I consider that these goods are identical under the principle outlined in *Meric*.

Class 28

Golf bag carts; golf bag tags; golf bag tags of leather; golf bag trolleys; golf bags; golf bags, with or without wheels; golf bags with or without wheels; golf ball markers; golf balls; golf club bags; golf club covers; golf club grips; golf club head covers; golf divot

[5] *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

repair tools; golf flags; golf flags [sports articles]; golf gloves; golf practice apparatus; golf practice nets; golf tee bags; golf tees; golf training aids; golfing gloves.

31. While I note that I could go through the above goods and make individual findings as to the self-evident identity or *Meric* identity between them and specific goods of the applicant, I do not consider this a necessary approach. I am of the view that my finding in relation to the above goods can be condensed on the basis that all of the above are types of "golf apparatus and equipment", "golf accessories" or "equipment for playing the game of golf", being terms that appear in the applicant's specifications. Therefore, I do not consider that it is controversial to simply find that all of the above goods of the proprietor are identical under the principle outlined in *Meric* to the aforementioned goods of the applicant.

The average consumer and the nature of the purchasing act

32. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. 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. (as he then was) 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."

33. In my view, the average consumer for the goods at issue will be members of the general public. The goods at issue will be available via various retailers such as general retailers (for clothing goods for example) or sports (more specifically, golf)

retailers (for the range of golf related goods). Regardless of the retailer, the goods at issue will be displayed on shelves or racks and self-selected by the consumer. In addition, the goods at issue will also be available via these retailers' online equivalents where they will be displayed on webpages and will be selected by the consumer after having viewed an image of the products. In my view, the visual aspect will dominate the selection process, however, I do not discount the aural component playing a role by way of word of mouth recommendations or after discussions with sales persons. I say the latter point particularly in relation to the selection of golf clubs, for example, which may be purchased after the consumer participates in a golf club fitting session wherein they try different golf clubs with the assistance of a 'golf professional'. Even where this occurs, the consumer will still review the products visually.

34. It is my understanding that the goods at issue will range both in price and in the frequency of the purchase. On the one hand, golf accessories such as golf tees and golf scorecards will be inexpensive and purchased relatively frequently whereas some of the sporting equipment goods such as golf clubs may be rather expensive and infrequently purchased. Turning to the level of attention paid, I am of the view that the inexpensive and frequently selected goods (such as golf tees) will be selected with a low level of attention. However, goods such as golf clubs will attract a range of factors such as the type of club (be that a wood, iron, wedge or putter), the materials used (such as the shaft or club head material) and the suitability of the clubs to the golfer's handicap. While they are goods that can be rather expensive, the factors considered are not particularly complex and I am of the view that, regardless of the price, the consumer will pay a medium degree of attention. For the avoidance of doubt, I also consider that the range of clothing goods will attract a medium degree of attention based on the fact that the consumer will consider factors such as style, fit and materials used.

35. Turning to the services at issue, I am of the view that the average consumer for these will be business users that are looking to arrange or organise golfing tournaments. It is my understanding that members of the general public do not ordinarily organise their own golf tournaments but will, instead, attend those put on by businesses such as local golf clubs, for example. I am of the view that when a

consumer seeks these services, they will be available from the organisers directly. The consumer is likely to view the services offered on a list, in a catalogue or on a website. That being said, I am of the view that the aural component will play a significant role as the consumer will likely need to discuss their requirements and arrangements with the service provider directly. Therefore, I am of the view that the selection process will be dominated by the aural component but a visual element will still play a role. In respect of the frequency of selection and cost of these services, I am of the view that they are likely to be selected relatively infrequently and will likely be relatively expensive services as the organisation of a golf tournament is likely to involve a lot of varying components. Depending on the type of tournament being organised, I am of the view that the level of attention paid will be either medium or above medium (but not high). This is on the basis that some consumers will only be looking to organise a local tournament at a golf club with no public attendees or press coverage so the factors considered are likely to relatively straight forward. However, other consumers may require the organisation of larger events and, therefore, will require more detailed considerations such as those in relation to ensuring members of the public can attend the event or ensuring that press in attendance are given the appropriate access, for example.

Comparison of the marks

36. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

37. 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."

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

39. The respective trade marks are shown below:

The applicant's marks	The proprietor's marks
 ("the applicant's first mark"); GOLF 6s ("the applicant's second mark") GOLF SIXES ("the applicant's third mark")	 ("the proprietor's first mark")  ("the proprietor's second mark")

40. The proprietor's marks are technically different on the basis that the representation of the second mark contains a blank space at its beginning, one which is not present in its first mark. However, from a trade mark perspective, I do not consider that this point of difference will be noticed by the average consumer and, therefore, consider that it has no impact on the mark whatsoever. As a result, I will proceed on the basis that the proprietor's marks are identical and will consider them

together in the following assessments. For the sake of this comparison, I will refer to the proprietor's marks in the singular, i.e. the proprietor's mark.

41. I have comments and submissions from both parties that I do not intend to reproduce here but confirm that I have taken them into account in making the following comparison.

Overall Impression

42. The proprietor's mark is a figurative mark that consists of the word 'six' presented in a standard red typeface. Throughout the word 'six' is a white line that starts at the bottom of the letter 's' and runs through the entirety of the word, ending at the top of the letter 'x'. Given that consumers are naturally drawn to elements of marks that can be read, the word 'six' dominates the overall impression of the marks. As for the stylistic flourish, I do not consider that it is particularly remarkable and, in my view, it will play only a negligible role in the mark's overall impression.

43. The applicant's first mark is a figurative mark that consists of the word 'GOLFSIXES' in a black, standard typeface and a figurative element. I note that the letters 'G-O-L-F' are presented in bold whereas 'S-I-X-E-S' are not. Given the differing use of a bold and standard typeface across the letters together with the fact that 'GOLF' and 'SIXES' are well-known words in the English language, I am of the view that despite being presented as one word, it will be identified as two. Above this element sits a figurative representation of the number '6'. In assessing the overall impression of the mark, I bear in mind that while presented as one word, the impression given by 'GOLF' and 'SIXES' will differ. I say this because while 'GOLF' may be presented in bold, the nature of the goods for which the mark is registered (being golf related goods and services) means that it will be viewed as descriptive and, therefore, plays a lesser role in the context of the mark overall. As a result, the word 'SIXES' will play a greater role. As for the figurative number '6', it is my view that given its size and placement within the mark together with its shared meaning, I consider that it will play an equal role to that of the word 'SIXES'.

44. The applicant's second and third marks are both word only marks that are 'GOLF 6s' and 'GOLF SIXES', respectively. For the same reasons discussed in the preceding paragraph, namely that 'GOLF' is descriptive of the goods and services at issue, I am of the view that '6s' and 'SIXES' will play the greater role in the overall impression of their respective marks with 'GOLF' playing a lesser role.

Visual Comparison

The applicant's first mark and the proprietor's mark

45. Visually, the marks share the letters 's-i-x'. This is the dominant element of the proprietor's mark and forms three of the five letters in the dominant element of the applicant's mark (being 'SIXES'). The marks differ in the presence of the word 'GOLF', the letter 'E-S' in 'SIXES', the figurative number '6' in the applicant's mark, neither of which have any counterpart in the proprietor's mark. The presentation of the marks and the words within them differ. While neither of these are particularly striking from a visual standpoint, they still constitute points of visual difference, albeit slight. Taking all of this into account and bearing in mind the overall impression of the marks, I am of the view that the marks at issue are visually similar to between a low and medium degree.

The applicant's second mark and the proprietor's mark

46. Visually, I appreciate that both of these marks include a representation of the number '6', however, they are different from a visual standpoint on the basis that it is written out in letter form in the proprietor's mark and in numerical form in the applicant's. As for possible points of similarity, I have given consideration to the fact that the applicant's mark, by virtue of being a word only mark in black and white, is capable of being presented in any standard typeface and in any colour (although without the white flourish). This means that the applicant's mark can be presented in the same red typeface as that used by the proprietor. I have also considered that the applicant's second mark contains a letter 's' at its end. While both of these points are noted, I do not consider that they are sufficient to warrant

a finding that these marks are similar to any degree. As such, I find that these marks are visually dissimilar.

The applicant's third mark and the proprietor's mark

47. As the applicant's third mark is a word only mark in black and white, it is (as was the case with the second mark above) capable of being presented in the same typeface and colour as used in the proprietor's mark (although without the white flourish). The marks share the letters 's-i-x', which is the dominant element of the proprietor's mark and makes up three of the five letters in the dominant element of the applicant's mark. The marks differ in the presence of the word 'GOLF' and the letters 'E-S' which sit at the beginning and end of the applicant's mark, respectively. While average consumers tend to focus on the beginnings of marks,[6] this is not always the case as it has been found that common elements at the ends of marks may also have an impact.[7] On this point, I consider that the impact of the word 'GOLF' on the applicant's mark as a whole is such that it will not draw much focus from the consumer. Taking all of this into account, I am of the view that these marks are visually similar to a higher than medium degree.

Aural Comparison

48. Despite their different presentations, I consider that the applicant's marks will all be pronounced as 'GOLF SIXES'.[8] On this point, I appreciate that 'GOLF' is descriptive, however, I remind myself of the fact that a word may be descriptive, this does not mean that it is aurally invisible.[9] As a result, all of the applicant's marks consist of three syllables that will be pronounced in the ordinary way. As for the proprietor's mark, this consists of just one syllable that will be pronounced in the ordinary way. The sole aural element of the proprietor's mark is identical to the second syllable of the applicant's marks. The other two elements in the applicant's marks have no counterpart in the proprietor's mark. Taking all of this into account

[6] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02
[7] See, for example, *Bristol Global Co Ltd v EUIPO,* T-194/14
[8] While '6' in the applicant's first mark is capable of being pronounced, I do not consider that consumers will pronounce the mark as a whole as 'SIX-GOLF-SIXES'.
[9] See *Purity Hemp Company Improving Life as Nature Intended,* Case BL O/115/22

and bearing in mind the overall impression of the marks at issue, I am of the view that they are aurally similar to medium degree.

Conceptual Comparison

49. While the applicant's first mark has a figurative element, I do not consider that it presents any additional conceptual impact of that mark. This is on the basis that the applicant's first mark contains the word 'SIXES' and the figurative presentation of a number '6' will only serve to reinforce that. As such, the concept of all three of the applicant's marks will be dominated by 'GOLF SIXES' (or 'GOLF 6s') and, therefore, have identical concepts. I will, therefore, assess them together.

50. When confronted with the applicant's marks, the average consumer will understand that the word 'GOLF' is descriptive of the goods and services at issue, namely that they are all golf related goods (or can reasonably cover golf related goods).[10] As for the 'SIXES' or '6s' elements, I have given consideration as to whether 'sixes' means anything in relation to the game of golf. While I appreciate that there are variations to the game of golf (such as stroke play, match play, stableford and scrambles, for example), I have no knowledge of any use of the term 'sixes' insofar as it relates to a type of golf game or format.[11] Further, golf is commonly played by a maximum of four people so, again, I have no knowledge of 'sixes' in respect of golf.[12] Instead, the 'SIXES' or 6s' elements will simply be understood as a plural for the number six. As a whole, 'GOLF SIXES' has no unitary meaning beyond that which is created by the individual words themselves. As for the proprietor's mark, this will be understood as a reference to the number six which, like the applicant's marks, has no meaning in relation to golf goods or services.

[10] This is on the basis that the applicant's class 25 goods are broad enough to cover golf clothing, footwear and headgear.
[11] I note that evidence is before me to demonstrate that the format of the tournament offered by the applicant is one that is played over six golf holes. While that may be the case, there is nothing to suggest that such a format is known to average consumers.
[12] I make these findings in reliance upon my own knowledge as an average consumer for the types of goods and services at issue. I do so in reliance upon the case of *esure Insurance Ltd v Direct Line Insurance Plc,* [2008] EWCA Civ 842 which sets out that Hearing Officers are, where appropriate, entitled to rely on their own general knowledge.

51. Plainly the concept associated with the number six dominates both parties' marks. While I do not consider this concept to be identical (on the basis that one is plural and the other is singular), it remains very highly similar. Additionally, while I consider the word 'GOLF' in the applicant's marks to be descriptive, it still acts as a point of conceptual difference, albeit only a slight one. Taking all of this into account, I am of the view that the marks at issue are conceptually similar to a high degree.

Distinctive character of the applicant's marks

52. 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 *Windsurfing Chiemsee 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)."

53. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods and services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The applicant has specifically pleaded that its marks enjoy an enhanced degree of distinctive character. I will assess this point further below but, first, I will consider the inherent position.

54. As it is a common element in all of the applicant's marks, I will assess the 'GOLFSIXES' element first (be that presented as 'GOLF SIXES', 'GOLF 6s' or '**GOLF**SIXES'). Starting with 'SIXES'/'6s', I have discussed the meaning of this when considering the concept of the marks above wherein I found that this is neither descriptive or allusive of the applicant's goods or services. Having said that, the use of a plural number (be that in letter or numerical form) is not particularly remarkable from a trade mark perspective. As such, I am of the view that 'SIXES' carries a medium degree of inherent distinctiveness. As for 'GOLF', I have mentioned above that this is descriptive of the goods at issue and I, therefore, do not consider that it contributes to the distinctiveness of any of the marks at issue. Taking this into account, I find that these words (be they presented as 'GOLF SIXES', 'GOLF 6s' or '**GOLF**SIXES') are inherently distinctive to a medium degree. As these elements are the only ones in the applicant's second and third marks, it follows that these marks enjoy a medium degree of inherent distinctiveness.

55. The question I must consider now is whether the device element in the applicant's first mark contributes to the distinctiveness of that mark to the point that it results in a different finding to that which I have reached above in respect of the applicant's second and third marks. While I accept that it does contribute to the mark to some degree, this is not enough to enhance the distinctiveness beyond that which lies in 'GOLF SIXES'. I say this because (1) the figurative element is not stylised in a particularly remarkable manner and (2) the inclusion of a figurative element that simply offers an alternative replication of the number six is, again, not particularly remarkable. As a result, I find that the applicant's first mark also enjoys a medium degree of inherent distinctiveness.

56. Having considered the inherent position, I turn to consider the issue of enhanced distinctiveness. In doing so, I note that evidence before me makes no reference to the sale of any of the goods at issue and, instead, focuses on the provision of organisational services for an annual golf tournament. As such, any claim to enhanced distinctiveness can only apply to these services.

57. The evidence sets out that the applicant launched the 'GOLFSIXES' tournament in February 2017. This is confirmed by way of press coverage in the form of articles from publications such as the Telegraph and on the BBC's website from 2017.[13] It appears to me from the evidence that the tournaments were held once a year, the first being in England in May 2017, the second also being in England in May 2018 with the third being in Portugal in June 2019. It is noted that the fourth tournament was scheduled to take place in Portugal in 2020 but was cancelled in March 2020 due to the COVID-19 pandemic.

58. I note that the first two 'GOLF SIXES' tournaments were not only televised and broadcast on the BBC and Sky Sports but also online via GolfChannel.com.[14] It is also stated that the 2019 tournament, while hosted outside of the UK, was still broadcast on the BBC via its digital channel. Aside from a vague claim that the tournaments attracted a significant viewership, there are no viewership figures provided.[15] As such, it is not possible for me to determine what is meant by a significant viewership as, in my view, this is a subjective statement. In terms of in person attendance at these tournaments, the evidence sets out that the 2017 tournament was attended by 4,800 people and the 2018 tournament was attended by 10,004 people.[16] No figures are provided for the 2019 tournament. These attendance figures are noted; however, I do not consider that they are reflective of significant levels of attendance, especially when considering the likely size of the market at issue for such sporting events.

59. In selling tickets, sponsorships and broadcasting rights, the applicant accrued a turnover between 2017 and 2019 of £1,591,286. While the narrative evidence sets

[13] JP2
[14] JP3
[15] Evidence of it being broadcast is referenced in an article taken from the applicant's website at JP4
[16] This is confirmed at JP8 which shows a Tweet posted by the applicant to its account on 6 May 2018

out that this is UK turnover, the fact that the evidence expressly states that the turnover covers ticket sales which could likely means that a portion of those sales for the 2019 tournament would have been to non-UK based customers on the basis that the tournament for that year was held in Portugal. I also note that two years of advertising expenditure have been provided which indicate that between 2018 and 2019, the applicant incurred a spend of £146,297 in promoting the GOLFSIXES tournament in the UK. Even ignoring the fact that the 2019 tournament took place outside of the UK, I am of the view that when compared to the likely size of the market for the services at issue here, these figures are representative of a low level of use.

60. In respect of the turnover point, I note that the evidence makes reference to additional activities undertaken for charity which did not generate any associated turnover. The evidence sets out that these charitable activities were attended by 2,676 young golfers from 233 golf clubs in 2019. Again, while these figures are noted, I do not consider that they are representative of a sizeable level of use.

61. Taking all of the evidence into account, I appreciate that it demonstrates that the applicant had, under its marks, organised and arranged golf tournaments between 2017 and 2019 and that it intended to do so in 2020. However, I do not consider that the level of use associated with these tournaments was, by 2019, at a significant enough level to show that the applicant's marks had become well known in the UK to the point that their distinctiveness had been enhanced. For the avoidance of doubt, this finding also takes into account the fact that the 2020 tournament was cancelled due to the COVID-19 pandemic. In respect of this point, I appreciate that a party's lack of use as a result of the COVID-19 pandemic in 2020 could be overcome in a consideration of enhanced distinctiveness if it was the case that any use prior to this was significant and longstanding. On balance of the evidence before me, this is not the case here as the applicant's use of its marks prior to the COVID-19 cancellation was neither significant or long standing enough to warrant such a finding. As a result, I find that the inherent position stands, namely that the applicant's marks enjoy a medium degree of distinctive character.

Likelihood of confusion

62. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the applicant's mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

63. As set out above, the applicant's pleadings sought to rely on the argument that its marks are part of a family of marks. While noted, I can deal with this swiftly on the basis that the pleadings on this point are somewhat limited in that they simply state that, "the Applicant owns a 'family' of marks incorporating the word 'SIX and/or the digit 6."[17] No further argument was provided in pleadings and neither was the position advanced by way of further submissions. Additionally, no evidence has been provided in order to establish that the public would expect any mark with the 'SIXES' suffix (or reference to the number six in the singular, for that matter) to be connected to the applicant. This line of argument must, therefore, fail.

64. I have found the parties' goods and services to be identical or similar to a medium degree. I have also found that the average consumer for the goods will be members of the general public whereas the average consumer for the services at issue will be business users. The goods at issue will be selected via primarily visual means,

[17] See Q5 on the TM26 filed in each of the applications

although I do not discount an aural component playing a part. For the services, these will be selected via primarily aural means, although a visual element will play a part. I have concluded that the average consumer will pay a medium degree of attention when selecting the majority of the goods at issue. However, I do appreciate that the selection of some goods may involve a low degree of attention and that the selection of the services will involve a medium or above medium (but not high) degree of attention. I have found that the applicant's marks are inherently distinctive to a medium degree. In respect of the similarity of the marks at issue, I have found that the proprietor's marks are:

a. Visually similar to between a low and medium degree, aurally similar to a medium degree and conceptually similar to a high degree with the applicant's first mark;
b. Visually dissimilar, aurally similar to a medium degree and conceptually similar to a high degree with the applicant's second mark; and
c. Visually similar to a higher than medium degree, aurally similar to a medium degree and conceptually similar to a high degree with the applicant's third mark.

65. In considering confusion, I remind myself that both of the applications rely on all three of the applicant's marks which are registered for a range of identical or similar goods and identical services. It follows that so long as I find that there is a likelihood of confusion in respect of one of the applicant's marks, both applications will succeed in full. While the applicant's marks do not differ greatly from one another, I am of the view that the applicant's best case lies in its third mark. This is where I will begin and, if necessary, will return to consider the others if necessary.

66. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I consider it likely that when confronted with the proprietor's marks and the applicant's third mark, average consumers will be unable to accurately recall or remember which mark was which. In reaching this finding, I acknowledge that the applicant's third mark is a word only mark presented in black and white and is, therefore, capable of being used in the same or a similar typeface and the same colour as the word in the proprietor's marks. Throughout this decision, I have found

that the word 'GOLF' is descriptive of the applicant's goods and services. On this point, I note that the proprietor's marks are registered for identical or similar goods and services that also relate to golf. As such, I consider that when the consumer is confronted with both marks, they are likely to overlook the word 'GOLF', despite its presence at the beginning of the applicant's mark.[18] Following this, I am of the view that the reference to the number six in the singular or plural will also be overlooked. Consequently, I consider that there is a likelihood of direct confusion between the proprietor's marks and the applicant's third mark.

67. For completeness, I now proceed to consider a likelihood of indirect confusion. In doing so, I refer to the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This

[18] On this point, I remind myself of the case of *Bristol Global* (cited above) which found that common elements at the ends of marks may be sufficient to create a likelihood of confusion.

may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

68. Taking all of the above into account, I am satisfied that average consumers are likely to believe that the parties' marks originate from the same or economically connected undertakings. While I appreciate that, in considering indirect confusion, the consumer may notice the presence of the word 'GOLF' (or the lack thereof), I do not consider that they will notice the difference in the reference to the number six in the singular or plural. On this point, while indirect confusion acknowledges that consumers notice the differences between marks, it is not automatically the case that all differences will be noticed. As such, the differences between 'six' and 'SIXES' is so slight that I consider it will still be overlooked in considering the present assessment. Taking this into account, I am of the view that the addition of 'GOLF', even sitting at the beginning of the applicant's mark, will be viewed as an additional element that it entirely logical and consistent with a sub-brand or brand extension of the 'SIX'/SIXES' branding, namely one that focuses on golf. Alternatively, if it is not viewed as a sub-brand or brand extension (on the basis that both marks are used in respect of golf related goods or services), I am of the view that consumers will consider it plausible that, on goods and services relating specifically to golf, the undertaking 'GOLF SIXES' would drop the 'GOLF' element due to its directly descriptive nature. As above, the imperfect recollection of 'SIX'/'SIXES' will be overlooked and the consumer would still be confused. Consequently, I consider that there exists a likelihood of indirect confusion between the proprietor's marks and the applicant's third mark.

69. As set out above, the success of the applicant's third mark means that both of the applications succeed in full. It is not, therefore, necessary for me to assess the remaining marks of the applicant. Even if I were, I am of the view that the outcomes for those marks will be the same as those outcomes reached in relation to the applicant's third mark. As a result, the applications under the 5(2)(b) grounds succeed in full.

70. For the sake of completeness, I will proceed to consider the 5(4)(a) ground.

Section 5(4)(a)

71. Section 5(4)(a) of the Act reads as follows:

> "(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, where the condition in subsection (4A) is met,
> >
> > (aa) …..
> >
> > (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."

72. Subsection (4A) of Section 5 states:

> "(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

73. In *Discount Outlet v Feel Good UK,* [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

> "55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.
>
> 56. In relation to deception, the court must assess whether *"a substantial number"* of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

74. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

> "Establishing a likelihood of deception generally requires the presence of two factual elements:
>
> (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation[1] 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 indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source[2] or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which 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 claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(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 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."

Relevant Date

75. In *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O-410-11, Mr Daniel Alexander Q.C., as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

"43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

> 'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.' "

76. Neither of the proprietor's marks have a priority date meaning that the relevant dates for the present ground is their filing dates, being 22 July 2020 for the first mark and 7 November 2019 for the second mark. While I note that the proprietor's evidence claims that it had been developing its marks since 2013 (being before the applicant used its marks/signs),[19] there is no actual evidence of use of the proprietor's marks. This is because internal development of a brand is not use that is capable of being the start of the behaviour complained about. On this point, I note that the proprietor's evidence expressly states that, as at the date of Mr Rich's statement, the proprietor has yet to begin trading. As such, the position I have to consider is, as above, the filing dates of the proprietor's marks.

Goodwill

77. The first hurdle for the applicant is that it needs to show that, at the relevant dates, it had the necessary goodwill in its business and that the signs relied upon were distinctive and/or associated with that goodwill. On this point, I remind myself that the applicant relies on the signs 'GOLFSIXES' and:

[19] See TR1 to TR3 which show a range of emails from between 16 July 2012 and 17 June 2015 that attached three different logo concepts, the latter being what is referred to as 'the final logo' which I note, is not reflective of the marks at issue in these proceedings.

78. The applicant claims that it has been using the above signs since February 2017 across the UK and that it enjoys a protectable level of goodwill in “organising and conducting golf tours, golf matches and golf tournaments.”

79. Goodwill was described in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

> “What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

80. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

> “27. There is one major problem in assessing a passing of 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 that 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. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

81. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

"[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."

82. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

"62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by *s.2(2) of the Trade Marks Act 1994*. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in *BALI Trade Mark [1969] R.P.C. 472*. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small.

That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used "but had not acquired any significant reputation" (the trial judge's finding). Again that shows one is looking for more than a minimal reputation."

83. Goodwill arises as a result of trading activities. I have summarised the applicant's evidence in respect of its use of its marks when considering the assessment of an enhanced distinctive character at paragraphs 56 to 61 above. While that summary related to my assessment of the marks under the 5(2)(b) ground, it equally applies to the present ground on the basis that the marks relied upon under that ground are identical or very highly similar to the signs relied upon here.[20] In making my assessment in respect of enhanced distinctiveness, I found that the evidence was insufficient to warrant a finding that the applicant's use of its marks was sufficient to enhanced their distinctiveness beyond the inherent level. While that may be the case, I remind myself that under 5(4)(a) grounds, small businesses which have more than a trivial goodwill can protect signs which are distinctive of those businesses under the law of passing off even though the goodwill and reputation may be small.[21] Therefore, while I do not consider that the applicant's use is at a level that enhances the distinctives of its marks, it may still warrant a finding that its signs enjoy a protectable level of goodwill.

84. In considering the evidence filed, I remind myself that, as summarised above, it demonstrates that in 2017 and 2018, the applicant organised the 'GOLFSIXES' golf tournament in the UK and that the 2019 tournament, while in Portugal, was available for viewing in the UK.[22] I also remind myself that the applicant's turnover between 2017 and 2019 stood at £1,591,286 over a period of three years. In addition, the UK-based golf events put on by the applicant attracted a total of 14,804 attendees over two years. I also remind myself that the total advertising spend for 2018 and 2019 stood at £146,297. This is not demonstrative of a large level of use or expenditure and neither does it demonstrate longstanding use.

[20] On this point, I note that the applicant's first sign is 'GOLFSIXES' whereas the applicant's third mark under the 5(2)(b) ground was 'GOLF SIXES'. While not identical, any use of 'GOLF SIXES' is, in my view, use of 'GOLFSIXES'. Further, the applicant's first mark is identical to the applicant's first sign relied upon here.
[21] See, for example, *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590
[22] I note that the evidence sets out that the tournament was cancelled in 2020 due to the COVID-19 pandemic.

However, bearing in mind what I have said in the preceding paragraph, I am of the view that this use is sufficient to warrant a finding that the applicant enjoys a protectable level of goodwill and that the signs relied upon were distinctive of and/or associated with that goodwill as at the relevant dates. I am also of the view that the use shown in the evidence relates to the services relied upon under the present ground, namely “organising and conducting golf tours, golf matches and golf tournaments”. In respect of the level of goodwill enjoyed by the applicant, I am of the view that this is likely to be low.

Misrepresentation and damage

85. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

> “There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is
>
> > “is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”
>
> The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd*. (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

> “.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions

are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion."

86. In considering the issue of misrepresentation, I consider it necessary to deal with the applications against the proprietor's marks separately. While the marks are identical, the goods and services in the specifications differ and given that the applicant only relies on services under the present ground, the outcomes will not necessarily be the same On the basis that the services for which the applicant enjoys goodwill are identical to the services of the proprietor's second mark,[23] I will begin there.

The proprietor's second mark

87. I can deal with the application against this mark swiftly. I remind myself that, under the 5(2)(b) ground, I found there to be a likelihood of confusion between the parties' marks. In assessing the present ground, I remind myself of the case of *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, wherein Kitchin LJ set out that it was doubtful whether the difference between the legal tests for likelihood of confusion and misrepresentation will (all other factors being equal) produce different outcomes. Because the applicant's signs are identical or highly similar to those marks relied upon under the 5(2)(b ground, I am of the view that this principle applies here. As such, I am satisfied that a finding of misrepresentation (and subsequently, damage) follows the outcome of the 5(2)(b) ground in respect of the application against the proprietor's second mark.

The proprietor's first mark

88. As was the case above, the considerations in respect of the similarity of the marks under the 5(2)(b) ground are applicable in the present assessment in relation to the proprietor's first mark. However, I note that I have not made any assessment

[23] This is on the basis that I have already found that the services for which the applicant enjoys goodwill in are identical to the services of the proprietor under the 5(2)(b) ground.

in relation to the goods of the proprietor's first mark and the services for which the applicant enjoys goodwill. As such, the finding of misrepresentation cannot follow the finding in respect of likelihood of confusion in the same way it did for the proprietor's second mark.

89. In considering this ground, I remind myself that, as set out at paragraph 74 above, the relevant test I must consider in respect of this mark is the closeness or otherwise of the respective fields of activity in which the applicant and the proprietor carry on business. While I appreciate that the goods and services at issue cover golf related goods and services, the fields of activity are different. One is for the organisation of sporting events whereas the other is for the provision of goods used in the course of playing golf. I appreciate that a claim for passing off may succeed where there is no common field of activity, however, I remind myself that the burden to overcome this hurdle is a significant one.[24] As above, I have found that the applicant only enjoys a low level of goodwill and, in my view, this is far from sufficient to be able to overcome such a burden. Lastly, I note that there is no evidence from the applicant pointing to any damage in its business due the proprietor's marks. I appreciate that this is not always necessary where the fields of activity are similar. However, in cases such as this one where the parties operate in a different lines of business, the onus is on the applicant to prove that such damage exists.[25] As a result, I find that the application reliant upon the 5(4)(a) ground against the proprietor's first mark fails in its entirety.

CONCLUSION

90. While the application reliant upon the 5(4)(a) ground against the proprietor's first mark failed, the application reliant upon the 5(2)(b) ground against that mark succeeded in full. As for the application against the proprietor's second mark, both grounds have succeeded in full.

91. As a result, subject to any appeal in this matter, both of the proprietor's marks are hereby cancelled in their entirety.

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[24] *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA)
[25] See page 545 of *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J

COSTS

92. As the applicant has succeeded in full, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. While I appreciate that the applicant filed two applications, I note that neither application was particularly complex and that the forms filed in respect of both were highly similar. As such, I do not consider it appropriate to grant a double costs award for the task of preparing the invalidation applications but will, instead, make a single costs award in a slightly higher amount (whilst remaining on the scale) to reflect the requirement to prepare two applications.

93. In the circumstances, I award the applicant the sum of **£1,500** as a contribution towards its costs. The sum is calculated as follows:

Preparing the invalidation applications and considering the proprietor's counterstatements:	£300
Preparing evidence:	£500
Preparation of written submissions:	£300
Official fees (x2):	£400
Total:	**£1,500**

94. I hereby order Play Six Ltd to pay PGA European Tour the sum of £1,500. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 29th day of January 2024

A COOPER
For the Registrar