O/0632/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003830267
BY GOLFING GREEN LIMITED TO REGISTER:

AS A TRADE MARK IN CLASSES 21, 24, 25 & 28

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 438542 BY
GALVIN GREEN AB

BACKGROUND AND PLEADINGS

1. On 9 September 2022, GOLFING GREEN LIMITED ("the applicant") applied to register the trade mark shown on the cover of this decision ("the applicant's mark") in the UK for the following goods:

Class 21: Water bottles; Reusable stainless steel water bottles; Reusable stainless steel water bottles sold empty; Drinking bottles; Bottles, sold empty; Insulated bottles [flasks];Sports bottles sold empty; Drinking bottles for sports.

Class 24: Golf towels.

Class 25: Golf clothing, other than gloves.

Class 28: Golf gloves; Golf tees; Golf flags; Golf ball markers; Golf bag tags; Golf tee bags; Golf club covers; Golf divot repair tools; Golf club head covers; Articles for playing golf; Headcovers for golf clubs; Golf flags [sports articles];Covers for golf club heads; Divot repair tools [golf accessories];Head covers for golf clubs; Tools (Divot repair -) [golf accessories];Covers (Shaped -) for golf club heads; Pitch mark repair tools [golf accessories];Divot repair tools being golf accessories.

2. The applicant's mark was published for opposition purposes on 11 November 2022 and, on 11 January 2023, it was opposed by Galvin Green AB ("the opponent").

3. The opposition is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). In respect of the sections 5(2)(b) and 5(3) grounds, the opponent relies on the following marks:[1]

[1] The opponent initially relied upon additional marks that were subject to a proof of use request by the applicant. However, the opponent has amended its statement of grounds to remove the reliance upon these additional marks.

UK registration no. 3680240

Filing date 11 August 2021; registration date 25 February 2022

Priority date: 10 April 2019 (EU)[2]

Relying on all goods and services, namely:

Class 9:	Application software; Computer e-commerce software; Sunglasses; Sports glasses; Pedometers; Cases for sunglasses.
Class 18:	Golf umbrellas; Travel luggage; Casual bags; Textile shopping bags; Canvas bags; Kit bags; Wallets.
Class 25:	Clothing; Sportswear; Rainproof clothing; Sweaters; Cardigans; Baseball caps; Hats; Caps [headwear]; Shirts; Tennis shirts; Tee-shirts; Skirts; Blouses; Socks and stockings; Gloves [clothing]; Pants; Over-trousers; Shorts; Jackets [clothing]; Neckerchiefs; Golf footwear; Belts [clothing]; Golf trousers; Golf caps; Golf skirts; Golf shorts; Golf footwear; Functional underwear.
Class 28:	Golf clubs; Golf club grips; Golf club covers; Golf balls; Golf club bags; Sports equipment; Golf gloves; Golf tees; Articles for playing golf; Golf ball retrievers; Golf ball markers; Golf tee bags; Covers (Shaped -) for golf bags; Golf bag tags of leather.

[2] The opponents' first and second marks were filed pursuant to Article 59 of the Withdrawal Agreement between the UK and the EU. As such, the opponent is permitted to rely on the earlier filing dates of its EU marks as priority dates,

Class 35: Online retail services relating to clothing; Online retailing relating to clothing accessories; Online retailing relating to bags; Online retailing relating to footwear; Online retailing relating to headgear; Online retailing relating to golf equipment; Computerized on-line ordering services; Organisation of customer loyalty programs for commercial, promotional or advertising purposes; Wholesale ordering services; Sales administration; Business management services relating to electronic commerce.

Class 41: Organisation of golf competitions; Organisation of sporting events; Golf driving range services; Organization of golf tournaments; Instruction in golfing skills; Planning of professional golf tournaments; Arrangement of professional golf tournaments.

("the opponent's first mark");

UK registration no. 3680245

Filing date 11 August 2021; registration date 25 February 2022

Priority date: 10 April 2019 (EU)

Relying on all goods and services, which I note are identical to the terms of the opponent's first mark.

("the opponent's second mark"); and

GALVIN GREEN

UK registration no. 916670507

Filing date 3 May 2017; registration date 5 October 2017

Relying on all goods and services, namely:

Class 9: Application software; Computer e-commerce software; Sunglasses; Sports glasses; Pedometers; Cases for sunglasses.

Class 18: Golf umbrellas; Travel luggage; Casual bags; Textile shopping bags; Canvas bags; Kit bags; Wallets.

Class 25: Clothing; Sportswear; Rainproof clothing; Sweaters; Cardigans; Baseball caps; Hats; Caps [headwear]; Shirts; Tennis shirts; Tee-shirts; Skirts; Blouses; Socks and stockings; Gloves [clothing]; Pants; Over-trousers; Shorts; Jackets [clothing]; Neckerchiefs; Golf footwear; Belts [clothing]; Golf trousers; Golf caps; Golf skirts; Golf shorts; Golf footwear; Functional underwear.

Class 28: Golf clubs; Golf club grips; Golf club covers; Golf balls; Golf club bags; Sports equipment; Golf gloves; Golf tees; Articles for playing golf; Golf ball retrievers; Golf ball markers; Golf tee bags; Covers (Shaped -) for golf bags; Golf bag tags of leather.

Class 35: Online retail services relating to clothing; Online retailing relating to clothing accessories; Online retailing relating to bags; Online retailing relating to footwear; Online retailing relating to headgear; Online retailing relating to golf equipment; Computerized on-line ordering services; Organisation of customer loyalty programs for commercial, promotional or advertising purposes; Wholesale ordering services; Sales administration; Business management services relating to electronic commerce.

Class 41: Organisation of golf competitions; Organisation of sporting events; Golf driving range services; Organization of golf tournaments; Instruction in golfing skills; Planning of professional golf tournaments; Arrangement of professional golf tournaments.

("the opponent's third mark").

4. Under the section 5(2)(b) ground, the opponent claims that the goods covered by the applicant's mark are identical or highly similar to its own goods and services. I note that the opponent argues that the marks are identical and refers to section 5(2)(a) of the Act. Clearly, the marks are not identical and, further, the opponent has not relied upon section 5(2)(a) as a basis for its opposition. Given that the pleadings go on to refer to the interdependency principle and suggest that any lesser degree of similarity between the marks is offset be the identity or high similarity of the goods and services, I am of the view that the references to section 5(2)(a) of the Act and identical marks are typographical errors. Such errors are ones that should have been picked up by the Tribunal upon the filing of the document and a request for the refiling of the same should have been made. Having said that, given the stage these proceedings are now at and the ease at which this issue could be regularised, I see no merit in taking such an approach. I will, instead, proceed on the basis that the opponent's case is that the marks are similar and ignore the reference to section 5(2)(a) of the Act. All of this is to say that the opponent's case can be boiled down to a claim that the identity/similar of the goods and services and the similarity of the goods are such that there exists a likelihood of confusion.

5. The opponent's pleadings under the section 5(3) ground set out that the marks are similar and that because the opponent's marks enjoy a reputation in the UK and other countries, the relevant public will believe that there is an economic connection between the marks. This connection will result in the applicant obtaining an unfair advantage of the opponent's marks and, further, use of the applicant's mark will lead to a dilution or blurring of the reputation and distinctive character of the opponent's marks.

6. Under the section 5(4)(a) ground, the opponent relies on signs that are identical to the marks relied upon under the section 5(2)(b) and 5(3) grounds. I will not reproduce those here but, for the avoidance of doubt, I will refer to them as the opponent's first sign, second and third signs. The opponent claims to have used all three signs throughout the UK, the first and second since 10 April 2019 and the

third since 3 September 1996. The opponent claims to have used all of its signs for the same set of goods and services, being the following:

> "Application software; Computer e-commerce software; Sunglasses; Sports glasses; Pedometers; Cases for sunglasses. Golf umbrellas; Wallets; Casual bags; Textile shopping bags; Canvas bags; Kit bags; Golf bag tags of leather; Clothing; Sportswear; Rainproof clothing; Sweaters; Cardigans; Baseball caps; Hats; Caps (headgear); Shirts; Tennis shirts; Tee-shirts; Skirts; Blouses; Socks and stockings; Gloves [clothing]; Pants; Over- trousers; Shorts; Jackets [clothing]; Neckerchiefs; Golf footwear; Belts (clothing); Golf trousers; Golf caps; Golf skirts; Golf shorts; Golf footwear; Golf clubs; Golf club grips; Golf club covers; Golf balls; Golf club bags; Sports equipment; Golf gloves; Golf tees; Articles for playing golf; Golf ball retrievers; Golf ball markers; Golf tee bags; Online retail services relating to clothing; Online retailing relating to clothing accessories; Online retailing relating to bags; Online retailing relating to footwear; Online retailing relating to headgear; Online retailing relating to golf equipment; Computerized on-line ordering services; Organisation of customer loyalty programs for commercial, promotional or advertising purposes; Wholesale ordering services; Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; Sales administration."

7. The opponent claims that it has built goodwill in its signs in the UK and that use of the applicant's mark will constitute a misrepresentation that will deceive customers into thinking that the goods provided under that mark are the goods of the opponent or are somehow endorsed by the opponent. The opponent argues that this would result in damage to its business.

8. The applicant filed a counterstatement denying the claims made. It did make a request for proof of use, however, the marks at which this request was aimed have been withdrawn from the proceedings. As such, the issue of proof of use is no longer live.

9. The opponent is represented by Stevens, Hewlett & Perkins and the applicant is represented by Dehns. Only the opponent filed evidence in chief. No hearing was requested and only the opponent filed written submissions in lieu. This decision is taken after careful consideration of the papers.

10. 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

11. The opponent's evidence in chief came in the form of the witness statement of Nicholai Stein dated 21 September 2023. Mr Stein is the Chief Executive Officer of the opponent, a position he has held since 16 September 2019. His evidence is accompanied by nine exhibits, being those simply labelled as Exhibit 1 to Exhibit 9, and speaks to the opponent's use of its marks/signs.

12. I do not intend to summarise the documents filed by the parties in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

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

13. 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."

14. 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."

15. The opponent's marks qualify as "earlier trade marks" for the purposes of this decision since they were applied for at an earlier date and enjoy earlier priority dates than the filing date of the applicant's mark.[3] None of the opponent's marks that remain at issue in these proceedings were registered more than five years prior to the filing date of the applicant's mark. They are not, therefore, subject to the proof of use provisions set out at section 6A of the Act. As a result, the opponent is permitted to rely on all goods and services for which its marks are registered.

16. 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:

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

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

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

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

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

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

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

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

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

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

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

(k) if the association between the marks creates a risk that the public 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

17. The applicant's goods are set out at paragraph one above and the opponent's goods and services are set out at paragraph three.

18. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. 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 that:

> "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".

19. 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.

20. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court ("GC") 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."

21. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM),* Case T-325/06, the GC stated that "complementary" means:

> "...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."

Class 21

Water bottles; Reusable stainless steel water bottles; Reusable stainless steel water bottles sold empty; Drinking bottles; Bottles, sold empty; Insulated bottles [flasks];Sports bottles sold empty; Drinking bottles for sports.

22. I will start by saying that all of the above goods, despite not all of them expressly stating as such, are capable of being sports bottles. Turning to the opponent's submissions, these set out that the above goods are similar, or at least complementary, to its own class 28 goods of "sports equipment" that sits in each of its marks' specifications. I agree that the goods are similar, however, I do not consider them to be complementary in the way described by the case law. The goods are clearly of different natures and have different methods of use and purposes. However, I consider it likely that the goods are selected by the same user and will be available via the same trade and distribution channels. For example, the opponent's goods are so broad they may cover equipment for any type of sport and it is my understanding that it is common in the trade for undertakings that produce sports equipment to sell their own branded water bottles for use in said sport. Such goods will, in my view, be available at similar locations in retail stores. Taking all of this into account, I am of the view that there exists a low degree of similarity between the goods.

Class 24

Golf towels.

23. The opponent's submissions in respect of the above goods mirror those in respect of the applicant's class 21 goods, namely that they are similar to "sports equipment" in its specifications. The opponent's goods can cover a range of golfing equipment such as golf bags and golf clubs,[4] and while the goods may differ in nature or method of use, I consider that there may be some degree of overlap in purpose. I

[4] I note that the remaining terms in its class 28 list of goods are all golf related but I will focus on the submitted case.

say this because the aim of a golf towel is not solely to dry a golf club in inclement weather but it can also be used to clean the heads of the user's golf clubs by wiping away mud or sand that may accumulate during the ordinary course of playing golf. Given the broad nature of the opponent's term, it may include handheld equipment used to clean and/or scrub the head of a golf club for this same purpose. In addition, the goods will clearly overlap in user as someone purchasing golf equipment (as covered by the opponent's term) is also likely to buy a golf towel. As for trade channels, this overlaps on the basis that golf club or golf bag manufacturers, for example, are also likely to produce and sell golf towels. While the goods are not complementary or competitive in nature, the aforementioned overlaps are sufficient to give rise to between a low and medium degree of similarity.

Class 25

Golf clothing, other than gloves.

24. The opponent submits that the above goods are identical to its own class 25 goods. On the basis that the opponent's marks all include the term "clothing", which can cover golf clothing, I agree with the opponent and find that these goods are identical under the principle outlined in *Meric*.

Class 28

Golf gloves; Golf tees; Golf ball markers; Golf tee bags; Golf club covers; Articles for playing golf.

25. The above goods appear identically in all of the opponent's marks' specifications. These goods are, therefore, self-evidently identical.

Golf club head covers; Headcovers for golf clubs; Covers for golf club heads; Head covers for golf clubs; Covers (Shaped -) for golf club heads.

26. The above terms of the applicant are all different expressions for head covers for golf clubs. “Golf club covers” in the opponent’s marks’ specifications can cover a range of covers for clubs, including head covers and, as a result, I find that these goods are identical under the principle outlined in *Meric*.

Golf flags; Golf bag tags; Golf divot repair tools; Golf flags [sports articles]; Divot repair tools [golf accessories]; Tools (Divot repair -) [golf accessories]; Pitch mark repair tools [golf accessories]; Divot repair tools being golf accessories.

27. While the opponent’s marks’ specifications do not expressly include the above goods, they do include the terms “articles for playing golf” and “sports equipment”. Both terms are broad enough that they cover the above goods meaning that they are identical under the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

28. 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. I must then decide the manner in which these goods 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.”

29. The opponent submits that the average consumer for the goods at issue are golf players, golfing enthusiasts and golfing professionals. While that may be the case for the golf related products, the goods at issue include general goods such as sport bottles and clothing at large. As a result, I find that the average consumer base for the goods at issue is the general public at large. The goods will be available via general retailers, sports retailers or golfing retailers such as pro shops at golf clubs. In all scenarios, the goods will be displayed on shelves or racks where they will be self-selected by the consumer. I also consider that the goods will be available online via the websites of general, sport or golf retailers. The selection process online will involve the consumer viewing an image of the goods on a webpage. As a result, I consider that the selection of the goods will be primarily visual though I do not discount an aural component playing a role by way of word of mouth recommendations, or advice from sales assistants during a custom fitting for golf clubs with a golf professional.

30. Some of the goods, such as water bottles and golf tees, for example, will be selected frequently. Other goods, such as golf clubs, will be selected far less frequently. The costs of the goods will vary considerably as water bottles and golf tees are very cheap goods whereas golf clubs can be relatively expensive. For the most part, I am of the view that the selection process for the goods will attract a medium degree of attention. I say this because, even for the more expensive goods such as golf clubs, consumers will still consider a range of ordinary factors such as materials used, suitability/fit, durability, style (for clothing/golf bags) and information as to how the goods may improve their golf came (for golf balls/golf clubs that may advertise more distance or control to the user, for example). That being said, goods such as golf tees, golf ball markers and divot repair tools will be more casual and less expensive purchases that are selected with a lower degree of attention.

Comparison of the marks

31. 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.

32. 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."

33. 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.

34. The respective trade marks are shown below:

The opponent's marks	The applicant's mark
 ("the opponent's first mark")	

 (“the opponent’s second mark”) GALVIN GREEN (“the opponent’s third mark”)	

35. I have submissions from the parties in respect of the comparison of the marks. While these are noted, I do not intend to reproduce them here but will, if necessary, discuss them further below.

Overall Impression

The applicant’s mark

36. The applicant’s mark is a figurative mark that consists of multiple elements. The first element is a large green circular device within which sits the letters ‘GG’ in white. Underneath this sits the words, ‘GOLFING GREEN’ in the same shade of green as the circular device. The letter/word elements are in the same standard typeface. All of these elements sit on a black square background. The opponent submits that the ‘GG’ element is the dominant element of the applicant’s mark. I appreciate that it is the largest element of the applicant’s mark and that it consists of readable elements. However, the letters ‘GG’ only serve to represent the first letters of the two words, ‘GOLFING GREEN’. As such, I disagree with the opponent and find that ‘GOLFING GREEN’ will be viewed as the strongest element of the mark from a trade mark perspective. The ‘GG’ circular device will not be ignored but it will play a lesser role. As for the black background, this will have a very limited impact due to its role as a banal background element.

The opponent's first mark

37. The opponent's first mark is a figurative mark, the centre of which is a device element that consists of the letter 'G' which sits within a partially dissected circular device. The opponent has referred to this as a 'GG' device. While I appreciate that the partially dissected circle may be intended to represented a backwards 'G', I do not consider that consumers will view it as such. Going forward, I will refer to this device as simply the figurative 'G' element. Curved around this element sit four words which are, in clockwise starting from the top left (being where people reading the English language tend to begin), 'GREEN GALVIN GREEN GALVIN'. Given that this is merely the same two words repeated, I consider it will only impact once upon the mark as a whole. Again, the opponent submits that it is the central device element that dominates the overall impression of the marks. For similar reasons to those discussed above, I am of the view that the word element will play the greater role in the overall impression of the mark with the figurative 'G' element playing a lesser role.

38. As above, it is my view that the word element in the opponent's first mark will be viewed as 'GREEN GALVIN'. However, the opponent's company name, the opponent's evidence and the opponent's pleaded position all suggest that the mark is meant to read as 'GALVIN GREEN'. While I have doubts as to whether this will be the case, I will proceed on this basis as it represents the opponent's best case. I will, therefore, say nothing further regarding the mark being perceived as 'GREEN GALVIN'.

The opponent's second mark

39. The opponent's second mark is a figurative mark that reproduces the figurative 'G' element that sits at the centre of the first mark. There are no other elements in the mark, meaning that its overall impression is dominated by this sole element.

The opponent's third mark

40. The opponent's third mark is a word only mark that consists of the words 'GALVIN GREEN'. There are no other elements that contribute to the overall impression of the mark, which lies equally in the words themselves.

Visual Comparison

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

41. I consider that the most prominent point of similarity between the marks lies in the shared use of the word 'GREEN'. This word sits at the end of the dominant elements of both parties' marks (although I appreciate that it does appear twice in the opponent's mark). I appreciate that the word 'GALVIN' in the opponent's mark and 'GOLFING' in the applicant's mark do share some letters, however, they are different words altogether (again, I appreciate that 'GALVIN' appears twice in the opponent's mark). As for the device elements, I appreciate that both marks feature a circular device element at their centres that consists of the letter 'G' (reproduced twice in the applicant's mark). However, I do not consider this to be a considerable point of similarity on the basis that they are of a different stylisation and play a lesser role in the overall impression of the marks. Lastly, the overall get ups of the marks differ, so too does their use of colour. On the latter point, I appreciate that registration of a mark in black and white covers use in any colour, however, this does not extend to contrived colour splits such as the one used by the applicant. Overall, I consider that these marks are visually similar to a low degree.

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

42. These marks differ in their get ups and the use of the words 'GOLFING GREEN' in the applicant's mark. As above, I appreciate that the central element of both marks is a circular device element that consists of the letter 'G' (reproduced twice in the applicant's mark). As was also the case above, I do not consider this to be a considerable point of similarity on the basis that (1) the stylisation differs and (2)

they play lesser roles in the overall impressions of the respective marks. As such, I am of the view that these marks are visually similar to, at best, a very low degree.

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

43. As was the case with the opponent's first mark, the word 'GALVIN' in the opponent's mark and 'GOLFING' in the applicant's mark do share some letters, however, they are different words altogether. The marks do share the word 'GREEN', which sits at the end of the word elements of both marks. All other elements present in the applicant's mark differ. Despite all of this, I am of the view that as a word only mark, the opponent's mark is capable of being presented in the same shade of green and same typeface that the applicant has used for its presentation of 'GOLFING GREEN'. Taking all of this into account, I am of the view that the marks are visually similar to between a low and medium degree.

Aural Comparison

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

44. Aurally, I do not consider that consumers will necessarily pronounce the figurative 'GG' or 'G' elements that sit at the centre of the parties' marks. I say this because the purpose of those elements will be viewed as simply standing for the other words in those marks. Further, I do not consider that consumers would articulate 'GALVIN GREEN' twice. Therefore, the comparison here is between the words 'GALVIN GREEN' and 'GOLFING GREEN'. Both marks consist of three syllables that will be pronounced in the ordinary way. The pronunciation of 'GREEN' will be the same across both marks. Despite being different words, I appreciate that 'GALVIN' and 'GOLFING' do share some degree of aural similarity. Taking all of this into account, it is my view that these marks are aurally similar to an above medium degree.

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

45. Despite what I have said above, I am of the view that when considering the opponent's second mark, the consumers will articulate the letter 'G'. This is on the basis that it is the only element capable of pronunciation. Even though the element of applicant's mark that will be pronounced ('GOLFING GREEN') consists of three uses of the letter 'G', none of which will be pronounced as a single letter 'GEE'. As such, I find that these marks are aurally dissimilar.

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

46. Given that I do not consider that 'GG' in the applicant's mark will be pronounced, the comparison here is as it was at paragraph 43 above. The outcome reached at that paragraph therefore applies here, namely that these marks are aurally similar to an above medium degree.

Conceptual Comparison

47. I will consider the comparison of the applicant's mark against the opponent's first and third marks together. This is because the concept of both marks will lie in the words 'GALVIN GREEN' and the figurative 'G' element in the opponent's first mark will do nothing to alter this.

The opponent's first and third marks and the applicant's mark

48. Under its arguments in respect of the marks being conceptually similar, the opponent submits that:

> "The marks are conceptually similar due to the minimal difference between the Opponent's Earlier Trade Marks and the Application. The Application and all but one of the Opponent's Earlier Trade Marks comprise of an alliterative name which comprises two words both beginning with the letter "G". The word GREEN is the second word in these names."

49. While noted, I see no merit in this argument. The sharing of an alliterative name is not a solid basis for a finding of conceptual similarity. I note that the marks consist of the identical word 'GREEN', however, this does not necessarily mean that the concept associated with that word will be the same.

50. When consumers view the words 'GOLFING GREEN' in the applicant's mark, I am of the view they will attribute it a unitary meaning, being that of the green on a golf course, which is where the hole is located. As for the letters 'GG', I consider that these will be understood as standing for 'GOLFING GREEN' and will, therefore, add nothing by way of conceptual impression. As for the opponent's marks, I am of the view that it may be perceived in two different ways. The first being that 'GALVIN GREEN' will be viewed as a name. While I appreciate that 'GALVIN' is not a common name by any stretch of the imagination, the combination with 'GREEN' (being a popular surname) may indicate to consumers that the mark represents the full name of a person. Alternatively, the words will be viewed as a combination of an unknown or made-up word with no obvious meaning, being 'GALVIN', followed by a reference to the colour green.[5] In such circumstances, the opponent's marks, when viewed as wholes, will have no obvious meaning.

51. In either of the scenarios described above, I am of the view that the marks are conceptually different. Regardless of how 'GALVIN GREEN' is perceived, the meaning taken from the shared word 'GREEN' will differ across the marks. I say this because use as a surname or a reference to the colour green are clearly different to a reference to a green on a golf course. For the avoidance of doubt, I am of the view that the shared use of a central element that consists of the letters 'G' or 'GG' are not points of conceptual similarity because those elements will be understood as standing for the words in their respective marks. To confirm, I consider that the marks are issue are conceptual dissimilar.

[5] I appreciate that 'GREEN', in the context of golf will be understood as a reference to the area where the hole is located. However, there is nothing in the mark that would point towards this being the understood meaning. On this point, I remind myself that when assessing the conceptual similarity of marks, it is usually done without reference to the goods or services at issue. See paragraph 62 of the decision of Professor Phillip Johnson in *EMILIANA*, Case BL O/052/22

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

52. The only element in the opponent's second mark that is capable of carrying a concept is the letter 'G'. While consumers will believe that this is meant to stand for a word beginning with 'G', there is no indication what this is. As a result, the opponent's second mark has no obvious conceptual meaning. Given the obvious concept associated with the applicant's mark, I find that these marks are conceptually dissimilar.

Comments in respect of the marks relied upon and my approach going forward.

53. I consider it necessary to pause at this stage to remind myself that my comparison between the applicant's mark and the opponent's second mark has resulted in a finding that they are aurally and conceptually dissimilar and that, at best, they are visually similar to a very low degree. In light of this level of similarity when compared to the levels found in respect of the opponent's first and third marks, I see no merit in the opposition reliant upon the opponent's second mark continuing. I take this approach because it follows that if the opposition in respect of the opponent's first and third marks succeeds then, plainly, the presence of the opponent's second mark will offer nothing further. Alternatively, it follows that if the opposition fails in respect of the opponent's first and third marks then given the significantly lower level of similarity (and even dissimilarity) offered by the second mark, the reliance upon this mark will fail also.

54. In light of the above, I will proceed in considering the opponent's first and third marks only and will say no more about its second mark for the remainder of this decision.

Distinctive character of the opponent's marks

55. 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)."

56. 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 or services for which it is registered, 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. As the opponent has filed evidence of use, I consider it necessary to assess whether said use gives rise to a finding that the distinctiveness of the opponent's marks have been enhanced through use. However before doing so, I will consider the inherent position.

57. In assessing the first mark, I consider it necessary to point out that the fact that 'GALVIN GREEN' is reproduced twice in the mark will not effect its distinctiveness. I am of the view that 'GALVIN GREEN' will be attributed varying levels of

distinctiveness depending on how it is understood. As discussed above, it will have two meanings, the first being a name and the second being a combination of an unknown or made-up word and a reference to the colour green. In respect of the former impression, I am of the view that it enjoys a medium degree of inherent distinctiveness. While it is not descriptive or allusive to the goods at issue and even though 'GALVIN' may be an unusual name, use of a full name on trade marks is not particularly remarkable. In respect of the latter meaning, I am of the view that the combination of an unknown word and a reference to a colour is somewhat unusual. As such, in circumstances where 'GALVIN GREEN' is not viewed as a name, I find that it enjoys between a medium and high degree of inherent distinctiveness. While I do not consider that the figurative 'G' element in the centre of the mark will be overlooked, the fact it will be understood as standing for the first letter of the words 'GALVIN' or 'GREEN' leads me to conclude that it will not contribute to the distinctive character of the mark to significant enough a degree to increase the distinctiveness beyond the level created by the words 'GALVIN GREEN'. As a result, I am of the view that the opponent's first mark enjoys either a medium or a medium to high degree of distinctive character depending on its perceived meaning.

58. Turning to the opponent's third mark, this is a word only mark made up of the words 'GALVIN GREEN'. Given what I have said in respect of the opponent's first mark, I am of the view that the same finding can apply here, namely that the opponent's third mark is inherently distinctive to a medium or between a medium and high degree depending on how it is understood.

59. I turn now to consider the evidence of use before me. The opponent's evidence sets out that it was founded in 1990 and that it currently offers clothing and accessories to customers in the UK via over 500 suppliers and directly from its website, galvingreen.com. Printouts from the website showing the goods it offers for sale are provided.[6] I note that some of these are undated but others were obtained from the internet archive facility, the Wayback Machine, and are from prior

[6] Exhibit 2

to the relevant date. The archival website printouts show blurred images; however, I can make out that they show a range of golf clothing and accessories such as hats and golf towels.

60. In respect of suppliers, I note that the evidence sets out that the opponent's goods are available at a number of notable and prestigious outlets across the UK. A list of these is provided and while I do not intend to reproduce them in full here, I note that they include the pro shops at golf courses such as Gleneagles, Turnberry, JCB Golf Club, Royal and Ancient Golf Club. There is no information surrounding these golf courses, however, it is my understanding that they are popular and reputed golf clubs in the UK.

61. The opponent has provided sales figures for its brand which I have reproduced below:

Year	**Sales (£)**
2017:	6,510,233
2018:	6,416,653,
2019:	6,305,935
2020:	7,820,242,
2021:	7,173,854
2022:	7,544,891
Total:	27,534,913

62. While the narrative evidence does not say what goods this turnover covers, I remind myself that at the outset of Mr Stein's witness statement, he confirms that the opponent sells golf clothing and accessories. Further, not only does the website evidence support this position, but I also note that a number of sample invoices from 2013 to 2021 are provided in evidence.[7] Having considered these, I can confirm that they fall in line with the stated position that the opponent sells various golf clothing and accessories to consumers in the UK. Before moving on, I wish to

[7] Exhibit 4

point out that given the placement of the relevant date in 2022 (being 9 September), it is likely that some of the above figures for that year are from after the relevant date. I have no way to calculate how much, however, this is a point I will bear in mind going forward.

63. The evidence goes on to discuss a number of sponsorships with golfers. In support of this, the opponent has included a draft press release dated 21 January 2022 as well as a range of website printouts and press coverage.[8] I note that this evidence includes reference to a range of professional golfers that are sponsored to wear Galvin Green. I do not intend to reproduce the full list of names here but note that they include a range of players that play on the PGA Tour, the Korn Ferry Tour and the DP World Tour. While there is no information as to what these tours are, it is my understanding that they are the three largest men's golf organisations in the world. It is also my understanding that while there are many British golfers who are members of the PGA Tour and Korn Ferry Tour, they focus mainly on golfing events in America. Having said that, in respect of the PGA Tour, I will say that despite its presence in America, it is reasonable to conclude that those events will be viewed on television by consumers in the UK. As for the DP World Tour, it is my understanding that this focuses mostly on events across Europe and regularly includes events in the UK that are also commonly televised. In addition to the above, I note that evidence is provided in relation to Galvin Green being the official supplier of weatherwear to the 2014 and 2018 European Ryder Cup teams.[9] It is my understanding that the Ryder Cup is the largest team event in the golfing world that pits players from Europe against players from America.[10]

64. Lastly, a wide range of media coverage and social media posts are provided over approximately 50 pages of evidence.[11] I have no intention of discussing this evidence in full as I note that some of it is undated and, therefore, it is not clear if it is from prior to the relevant date or not. Having said that, I note that the evidence

[8] Exhibit 5
[9] Exhibit 6
[10] It is my view that the points I have made in this paragraph are not those that would be in serious dispute. As such, I am of the view that I am entitled to take judicial notice of the same. On this point see *Chorkee Ltd v Cherokee Inc.,* Case BL O/048/08
[11] Exhibit 9

does it include adverts and features from prior to the relevant date in various golfing publications such as Golf Monthly, Plugged in Golf and Luxury Magazine. Further, there are posts shown on social media websites such as Twitter wherein the GALVIN GREEN brand is discussed. I note that all of these images show a range of golf clothing goods such as jackets, fleeces, outwear, gloves, hats.

65. Taking all of the evidence into account, I am satisfied that the opponent's use in the years leading up to the relevant date was at a sufficient level so as to warrant a finding that the distinctiveness of its first and third marks have been enhanced through use. It is also clear to me that the opponent has made efforts to promote its brand by way of sponsorship of golfers on various tours and, further, it has obtained a sizeable level of sales from 2017 onwards. On the latter point, I appreciate that the market for golf clothing and accessories may be large, however, I consider that a turnover over of approximately £27 million over six years is representative of a respectable market share, especially in what is likely to be a fast moving and competitive market. All that being said, I do not consider that this finding extends to all of the goods at issue. I say this because the evidence appears to demonstrate a particular focus on golf clothing, golf hats and golf gloves (I note that the evidence shows golf towels which, as a class 24 good, is not covered by the opponent's specifications). I note that additional goods such as umbrellas, belts and backpacks are provided in evidence, however, these are shown on just one printout[12] that is undated and is, therefore, incapable of pointing to the position as at the relevant date.

66. As a result of the above, I am satisfied that the distinctiveness of the opponent's first and third marks has been enhanced to a high degree in respect of "golf clothing", "golf hats" and "golf gloves".

Likelihood of confusion

67. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the

[12] See pages 7 and 8 of Exhibit 2

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 vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's marks, 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 or her mind.

68. I have found the parties' goods to range from being similar to a low degree to being identical. I have found the average consumer for the goods to be members of the general public at large who will select the goods with primarily visual considerations (though I do not discount the aural component) and after having paid, generally, a medium degree of attention. I have, however, found that some lower cost goods would attract a lower degree of attention. In respect of the similarity of the marks at issue, I have found the applicant's mark to be:

a. similar to a low degree, aurally similar to an above medium degree and conceptually dissimilar to the opponent's first mark; and
b. similar to between a low and medium degree, aurally similar to an above medium degree and conceptually dissimilar to the opponent's third mark.

69. I have found the opponent's marks to be inherently distinctive to a medium or to between a medium and high degree depending on how it is understood by the consumer. However, I have found that these levels have been enhanced to high degree (in respect of some goods only) due to the use made of the marks.

70. The opponent submissions in respect of confusion are as follows:

"We submit that given the high degree of similarity between the marks and the similar goods and services, there is a likelihood of confusion, including the likelihood of association by the average consumer."

71. Taking all of the above into account and even bearing in mind the principle of imperfect recollection, I am of the view that consumers will not misremember or inaccurately recall the parties' marks for one another. I appreciate that there are points of similarity between the marks, mainly coming from the shared use of the word 'GREEN', however, the visual and aural differences in the remaining parts of the marks are sufficient to offset this. Further, the differences created by the conceptual hooks of the marks is also sufficient to offset any similarity created by the shared use of the word 'GREEN'.[13] Consequently, I find that there exists no likelihood of direct confusion in respect of the marks at issue, even on identical goods and in circumstances where consumers pay a lower degree of attention.

72. I turn now to consider indirect confusion. In doing so, I remind myself of 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

[13] On this point, I remind myself of the case of *The Picasso Estate v OHIM*, Case C-361/04 P wherein the CJEU set out that conceptually differences may counteract visual and aural similarities, which I consider is the case here.

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 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)".

73. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

74. In the present case, I see no reason why a consumer would, upon being confronted by the marks at issue, believe them to emanate from the same or economically

connected undertakings. While I have found 'GALVIN GREEN' to enjoy a high degree of enhanced distinctive character (for some goods, not all), this lies in the opponent's marks as wholes and not the individual word 'GREEN'. As such, the shared element cannot be said to be so strikingly distinctive that consumers would believe that only one undertaking uses it. In any event (and in the context of the parties' marks as wholes), the parties' use of this shared element evokes a different concept.[14] In addition, the applicant's mark clearly cannot be said to be one that adds non-distinct elements to the opponent's marks that would be viewed as logical indicators for a sub-brand or brand extension of 'GALVIN GREEN'. In my view, consumers would consider it entirely illogical for an undertaking with a highly distinctive mark, being 'GALVIN GREEN' to change its mark to 'GOLFING GREEN'. Not only does this change the entire meaning of the branding but it is a change that would weaken its distinctiveness by virtue of 'GOLFING GREEN' being seen as an allusive concept to golf related goods. Lastly, I have no reason to find that consumers would view the applicant's mark as an indicator of a collaboration, joint venture or merger between two undertakings. Taking all of the above into account, I find that there exists no likelihood of indirect confusion, even on identical goods or in instances where the consumers pays a lower degree of attention.

75. As a result of the above, the opposition reliant upon its section 5(2)(b) ground has failed in its entirety. I will now proceed to consider the remaining grounds of this opposition.

Section 5(3)

76. Section 5(3) of the Act states:

> "5(3) A trade mark which –

[14] On this point, I wish to point out that even if it were the case that the reference to 'GREEN' in the opponent's marks was viewed as describing a golfing green, this is a descriptive or allusive concept so any shared hook would not be overly compelling. As such, I consider that consumers would consider its use in respect of golfing related goods to be coincidental.

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark."

77. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case 252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure,* Case C-323/09, *Marks and Spencer v Interflora,* Case C383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24.*

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; G*eneral Motors, paragraph 26.*

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon, paragraph 29* and *Intel, paragraph 63.*

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there

is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68;* whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79.*

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34.*

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74.*

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and*

Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).

78. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the marks are similar. Secondly, the opponent must show that its marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the applicant's mark. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

79. The opponent relies on the same marks here as it did under its section 5(2)(b) ground, although as explained at paragraph 52 above, I will proceed with this decision on the basis of the opponent's first and third marks only.

Reputation

80. I have summarised the opponent's evidence at paragraphs 58 to 65 above. While that summary related to an assessment of enhanced distinctiveness, it is equally relevant here as the relevant date and territory that formed the basis of my assessment above are the same under the present ground. I do not intend to reproduce my summary here but remind myself that over the course of the six years leading up to the relevant date, the opponent sold approximately £27 million worth of goods in the UK, that its goods were available via a range of well-known pro shops at golf clubs, its clothing appeared in a number of different golf publications and, finally, it made advertising efforts in the form of sponsorships of golfers who play on various global tours. Following similar reasons to those given at paragraph 64 above, I am satisfied that, at the relevant date, the opponent

enjoyed a fairly strong reputation across the UK in “golf clothing”, “golf hats” and “golf gloves”.

Link

81. As noted above, my assessment of whether the public will make the required mental ‘link’ between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks.

82. The applicant’s mark is similar to a low degree, aurally similar to an above medium degree and conceptually dissimilar to the opponent’s first mark and similar to between a low and medium degree, aurally similar to an above medium degree and conceptually dissimilar to the opponent’s third mark.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public.

83. While I have conducted a full comparison above, that was in respect of the opponent’s marks as registered and not in relation to the reputed goods. I do not intend to undertake another full comparison here but will say that, plainly, “golf clothing, other than gloves” in class 25 and “golf gloves” in class 28 of the applicant’s specification are identical to the opponent’s reputed goods. As for the remaining goods, they are not identical but are similar on the basis that while their natures and methods of use differ, they will be selected by the same consumer and available via the same trade channels. The purpose of the goods also differs; however, I do appreciate that all of the goods are either expressly reserved for use whilst playing golf or, due to their broad wording, can be used whilst playing golf. As such, there is a limited overlap in purpose. Lastly, the goods are not competitive and neither are they complementary. As such, I find that those goods that are not identical are similar to at least a low degree.

84. For the sake of completeness and in accordance with the present test, I consider it necessary to point out that all of the goods at issue will be selected by the same section of the relevant public.

The strength of the earlier mark's reputation.

85. I have found that the opponent's marks enjoy a fairly strong reputation.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use.

86. Inherently, I have found the opponent's marks to be either distinctive to a medium degree or to between a medium and high degree, depending on how the words 'GALVIN GREEN' are understood. I consider that as a result of the evidence before me, this has been enhanced to a high degree due to the use made of them.

Whether there is a likelihood of confusion

87. I have found that there exists no likelihood of confusion between the marks.

Conclusions on link

88. While the opponent's marks enjoy a high degree of distinctive character and a fairly strong reputation, I am of the view that the differences between the marks will offset any risk of consumers believing that the marks are linked. As was the case when considering confusion under the section 5(2)(b) ground, I accept that consumers may notice the shared use of the word 'GREEN'. However, the concept associated with that word across both parties' marks is different.[15] Therefore, I do not consider the shared use of this word to be a particularly compelling point that would lead

[15] As per footnote 14 above, I am of the view that even if 'GREEN' did create a shared conceptual hook, it would be a descriptive or allusive one which would lead me to conclude that consumers would considered its shared use as merely coincidental.

consumers to believe that there is any connection between the marks. In addition, the visual and aural differences[16] are also factors that point away from a finding that the marks are likely to be linked to one another. Ultimately, in taking all of this into account, I am of the view that when confronted with the applicant's mark, consumers who are aware of the 'GALVIN GREEN' brand would not be caused to wonder whether the marks were linked.

89. As there is no link created between the marks, there can be no damage. As a result, the opposition based on section 5(3) fails at this stage. I will now proceed to consider the section 5(4)(a) ground.

Section 5(4)(a)

90. 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."

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

[16] Despite the marks being, aurally, similar to an above medium degree, I make this point more in reference to the difference in the words 'GOLFING' and "GALVIN".

> "(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."

92. I can deal with this ground swiftly. I accept that, based on the evidence before me (and as already assessed above), there exists a strong level of protectable goodwill in the opponent's business in respect of "golf clothing", "golf hats" and "golf gloves"[17] and that the opponent's signs are distinctive of and/or associated with that goodwill. However, I do not consider that this ground would garner the opponent any success. This is on the basis that while the test for misrepresentation is different from that for likelihood of confusion in that it entails "deception of a substantial number of members of the public" rather than "confusion of the average consumer", it is unlikely that the difference between the legal tests will produce different outcomes.[18] In the present case, there was no confusion under the 5(2)(b) ground assessed above and, for the same reasons discussed throughout this decision, I consider that a similar finding applies here, namely that use of the applicant's mark would not deceive a substantial number of members of the public.

93. The opposition reliant upon section 5(4)(a), therefore, fails.

CONCLUSION

94. The opposition fails in its entirety and, subject to any successful appeal of my decision, the applicant's mark may proceed to registration for all goods that it seeks to protect.

[17] On the basis that they are identical to the marks relied upon under my assessments of enhanced distinctiveness and reputation above.
[18] See *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501

COSTS

95. As the applicant has succeeded, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. I note that the only stage of proceedings that the applicant has engaged in during these proceedings was to file a counterstatement. Having said that (and even though it did not file evidence), I do consider that the applicant is entitled to some costs in respect of the evidence rounds as it was required to consider the evidence filed by the opponent. Therefore, in the circumstances, I award the applicant the sum of £500 as a contribution towards its costs. The sum is calculated as follows:

Considering the notice of opposition and filing a counterstatement in response:	£200
Considering evidence:	£300
Total:	**£500**

96. I hereby order Galvin Green AB to pay GOLFING GREEN LIMITED the sum of £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 4th day of July 2024

A COOPER
For the Registrar