

O/0693/23

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NOS. 3414361,
3414350 & 3516813
BY SAMUEL RYDER LTD**

AND

**IN THE MATTER OF THE OPPOSITIONS THERETO
UNDER NOS. 417800-417803, 422302 & 422368 BY
RYDER CUP LIMITED AND RYDER CUP EUROPE LLP**

AND

**IN THE MATTER OF UK TRADE MARK NO. 3409719
REGISTERED BY RYDER CUP EUROPE LLP**

AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY
THEREOF UNDER NO. 504353 BY
SAMUEL RYDER LTD**

BACKGROUND AND PLEADINGS

1. These proceedings concern the oppositions to three applications for UK trade marks and an application to invalidate one of the earlier marks that is relied upon in these oppositions.

2. All the applications have been made by Samuel Ryder Ltd (“SRL”). This is a company established by some of the descendants of businessman and philanthropist Mr Samuel Ryder. In 1927, Mr Ryder donated a trophy to be awarded to the winners of a biennial competition between teams of professional male golfers, one from Great Britain and the other from the US, on the condition that the trophy be named “The Ryder Cup”. Further tournaments took place in 1929, 1931, 1933, 1935 and 1937. The next tournament was held in 1947, following the end of the Second World War. The competition is now between teams from Europe and the US and the venue alternates between them. From the 1950s until 2018, members of the Ryder family were invited to attend Ryder Cup matches as official guests.



3. The other parties to the proceedings are responsible for the organisation of the Ryder Cup golf tournament when it takes place in Europe. The Professional Golfers’ Association of America (“PGA”) is responsible for the event when it takes place in the US. The global intellectual property rights associated with the tournament are split between the US and the European organisations on a territorial basis.

4. The corporate structure of the European operations merits some explanation at the outset. Until 1974, the Professional Golfers’ Association (PGA) was responsible for running the tournament. In that year, the PGA European Tour split off from the PGA and the two organisations ran the tournament through a company called Ryder Cup Limited. Following a restructuring in 2004, Ryder Cup Limited became a wholly owned subsidiary of Ryder Cup Europe LLP, in which the PGA and PGA European Tour are majority shareholders.¹ Ryder Cup Limited (“RCL”) owns one of the marks that are relied upon in the oppositions, while Ryder Cup Europe LLP (“RCE”) owns the others. Except where it is relevant, I will refer to the parties together as “Ryder Cup”.

¹ First witness statement of Richard Hills, paragraphs 2-4.

The applications

5. SRL's three applications are detailed below:

3414361	<p>SAMUEL RYDER (“the word mark”)</p> <p>Application date: 16 July 2019</p> <p>Registration sought for goods and services in Classes 9, 25, 28, 35 and 41. A full specification can be found in Annex A.</p>
3414350	<p> (“the signature mark”)</p> <p>Application date: 16 July 2019</p> <p>Registration sought for goods and services in Classes 9, 14, 25, 28 and 41. A full specification can be found in Annex B.</p>
3516813	<p> SAMUEL RYDER CHARITABLE TRUST (“the figurative mark”)</p> <p>Application date: 28 July 2020</p> <p>Registration sought for goods and services in Classes 25, 28, 36 and 41. A full specification can be found in Annex C.</p>

Oppositions Nos 417800, 417802 and 422368

6. RCL opposed all three marks on the basis of sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). These oppositions concern all the goods and services in the applications and RCL relies on EU Trade Mark (“EUTM”) No. 684829 for **RYDER**

CUP.² This EUTM has an application date of 14 November 1997 and a registration date of 13 July 1999. Under section 5(2)(b), RCL relies on the following goods and services:

Class 9

Computer software and programmes; pre-recorded disks and tapes; sunglasses.

Class 25

Clothing, footwear, headgear; visors [hatmaking].

Class 28

Games and playthings; sporting articles.

Class 41

Entertainment services; sporting activities; running of golf tournaments; entertainment services including TV shows.

7. In the case of Opposition No. 417802 against the signature mark, RCL relies on the following goods, in addition to those goods and services listed above:

Class 14

Jewellery; horological and chronometric instruments; goods of precious metals; cufflinks.

8. RCL claims that the word mark is identical to its earlier mark in its most distinctive component which is “Ryder” and that the goods and services are similar. As a result, it asserts that there is a likelihood of confusion, which includes a likelihood of association, on the part of the public.

² Although the UK has left the EU and the transition period has now expired, EUTMs and International Marks which have designated the EU for protection are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, SI 2019 No. 269, Schedule 5. Further information is provided in Tribunal Practice Notice 2/2020.

9. In the case of the signature mark, RCL acknowledges that the contested mark is stylised, but submits that this stylisation does not materially alter the distinctive character of the mark. It claims that the goods and services are identical in nature, uses, users and channels of trade to the goods and services it is relying on. Consequently, there is a likelihood of confusion, which includes a likelihood of association, on the part of the public.

10. In the case of the figurative mark, RCL makes the same claims as in the earlier oppositions based on these marks, adding that:

“The services for which registration is sought in class 36 are similar to the goods and services for which the Opponent’s [RCL’s] mark is registered. In particular, sporting activities and the organisation of golf tournaments and golf competitions in class 41 are often associated with charity events, charity initiatives and charity fundraising, all activities in which the Opponent has been involved.”

11. Under section 5(3), RCL claims that EUTM No. 684829 has a reputation for all the goods in Class 25, *Sporting articles* in Class 28 and all the services in Class 41. It claims that use of the contested marks without due cause would lead the public to believe that SRL’s goods and services come from the same undertaking as RCL’s goods and services, or from an economically linked one. The historical significance of the name “Samuel Ryder” in connection with the golf tournament would make such an assumption inevitable. In addition, or in the alternative, RCL claims that SRL would unfairly benefit from the investment in, and promotion of, the earlier mark by RCL, its licensees and related companies. RCL also claims that the reputation of the earlier mark would be damaged if SRL’s goods and services were of a lower quality than, or differed from, the goods and services that RCL’s customers had come to expect.

12. In relation to the figurative mark, RCL makes the same claims and adds that the distinctiveness of the earlier mark would be diluted through the presence in the golf industry of a mark so similar to the earlier mark, which would have an impact on economic behaviour, for example, in the value of sponsorship or licensing deals that RCL would be able to obtain.

Oppositions Nos 417801, 417803 and 422302

13. RCE opposed the applications under sections 5(2)(b), 5(4)(a) and 3(6) of the Act. Claims under sections 5(1) and 5(2)(a) of the Act are also made against the word mark. These oppositions concern all the goods and services that have been applied for.

14. Under sections 5(1) and 5(2)(a) or (b), RCE is relying on EUTM No. 18087256 **SAMUEL RYDER** which has a filing date of 26 June 2019 and a registration date of 28 April 2021 and UK Trade Mark (“UKTM”) No. 3409719 which has a filing date of 26 June 2019 and a registration date of 16 April 2021. Both marks are registered for goods and services in Classes 9, 14, 16, 18, 21, 25, 28, 41 and 43. RCE is relying on the following goods and services (which are identical for both earlier marks):

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 and golf matches; 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; spectacles; cases and cords for sunglasses; visors; mobile phone accessories; mobile phone cases; mouse mats; computer game programs; encoded or magnetic credit cards, debit cards and affinity cards.

Class 25

Clothing; footwear; headgear.

Class 28

Games and playthings; sporting articles; golf equipment; golf balls, golf bags, golf clubs, golf tees, head covers for golf clubs; hand held computer games; playing cards; toys, soft toys; decorations for Christmas trees.

Class 41

Entertainment services; corporate hospitality (entertainment); sporting activities; organisation of golf tournaments and golf competitions; TV shows; providing information in relation to golf, golf tournaments and golf competitions; golf training and golf coaching; providing access to, and information on, golf training and coaching; publication of magazines, programmes and other printed matter relating to golf, golf tournaments and golf competitions; providing non-downloadable electronic publications in relation to golf, golf tournaments and golf competitions.

Class 43

Hotel services; restaurant services; bar and café services; hospitality services (food and drink).

15. In the case of Opposition No. 417803 against the signature mark, RCE relies on the following goods, in addition to those goods and services listed above:

Class 14

Jewellery; horological and chronometric instruments; cufflinks; trophies made of precious metals and their alloys.

16. Under section 5(2)(b), RCE is also relying on EUTM No. 4476164 **RYDER CUP**, which has a filing date of 24 May 2005 and a registration date of 20 June 2006. It is registered for services in Classes 35, 36, 39 and 43. In the oppositions to the word and figurative marks, RCE is relying on the following goods and services:³

³ RCE is not relying on this mark for the purposes of its opposition to the signature mark.

Class 35

The bringing together for the benefit of others, a variety of goods, enabling customers conveniently to view and purchase those goods in retail outlet or through interactive electronic platforms, or via mail order catalogues, or via websites, providing audio and video recordings, recorded tapes, discs, cassettes and CD's, recorded CD-ROM's, DVDs and other recorded magnetic and opto-magnetic data carriers, non-printed publications relating to golfers and to golf, clothing, footwear, headgear, including clothing, footwear, headgear for sport and clothing, footwear, headgear for golf, games, toys and playthings, gymnastic and sporting articles and sports equipment, golfing articles, golf apparatus and equipment, golf bags, golf clubs, golf gloves, golf tees, golf balls.

Class 43

Reservation of temporary accommodation; arranging of temporary accommodation; provision of food and drink; catering; restaurant, cafe, cafeteria, bar services.

17. In the case of the opposition against the figurative mark, RCE is relying on the following services:

Class 36

Charitable fund raising; providing information on charitable fund raising.

18. RCE makes the same claims as RCL made under section 5(2) in the oppositions based on EUTM 684829.

19. Under section 5(4)(a), RCE claims to have used the sign **RYDER CUP** throughout the UK since 1927 for the following goods and services: *Organisation and running of golf tournaments; Entertainment in the form of TV programmes relating to golf; Provision of information in relation to golf and golf tournaments; Downloadable and non-downloadable electronic publications and videos relating to golf; Clothing; Golf equipment; Provision of hospitality services.* It also claims to have used the sign **SAMUEL RYDER CLUB** throughout the UK since 2017 for *Provision of hospitality services at golf events.* RCE asserts that by virtue of the use and promotion of these

signs in connection with the aforementioned goods and services, it has built up goodwill (huge goodwill in the case of **RYDER CUP**) and that use of the contested mark would be a misrepresentation and liable to be prevented by the law of passing off. This would cause damage in the form of loss of earnings or damage to goodwill.

20. Under section 3(6), RCE claims that the applications were made in bad faith. It asserts that SRL's representatives requested consent to use and register the contested marks. When consent was denied, the applications were filed, according to RCE, in an attempt to secure leverage in further negotiations.

The Defences of the Trade Mark Applications

21. SRL filed counterstatements and defences denying the claims and putting the opponent to proof of use of EUTM Nos. 684829 and 4476164.

22. It denied that EUTM 684829 was a valid earlier trade mark for the purpose of the oppositions, as it maintained that the sign **RYDER CUP** was no longer able to function as a trade mark, being entirely descriptive of a trophy played for as part of an international team golf event. The sign had, in its view, become customary as the generic name for the event. It also noted the existence of other "RYDER" trade marks on the register. These were points that SRL did not pursue any further during the course of the proceedings, and by the time the matter came to me for a decision, the applicant had changed its legal representative. Consequently, I shall say no more about them.

23. With regards to the claims under section 5(3), SRL denied that use of the contested marks would be without due cause. It stated that the applicant is managed by the family of Samuel Ryder and argued that:

"The Applicant and persons connected with the Applicant have for many years acted as custodians of the SAMUEL RYDER brand, maintaining and protecting the legacy of the Samuel Ryder name protecting, maintaining and preventing misuse of IP related to the name, image and likeness of this pioneering individual while promoting charitable initiatives, philanthropic

ventures and commercial partnerships to maintain the integrity and heritage of an association with this unique individual.”

24. Furthermore, it denies having filed the applications in bad faith and put RCL and RCE to proof of use of the RYDER CUP marks (EUTMs Nos. 684829 and 4476164 respectively).

Cancellation No. 504353

25. UKTM No. 3409719 was applied for on 26 June 2019 and entered onto the register on 16 April 2021. It stands registered in the name of RCE for goods and services in Classes 9, 14, 16, 18, 21, 25, 28, 41 and 43. A full specification can be found in **Annex D**.

26. On 10 November 2021, SRL applied under section 47 of the Act for the trade mark registration to be declared invalid. The application is based on section 3(6) of the Act and concerns all the goods and services for which the mark is registered. SRL claims that RCE was warned that SRL was intending to register SAMUEL RYDER as a trade mark and that the two parties were engaged in discussions. During the course of these discussions, the application to register the mark was “*surreptitiously*” filed by RCE for a broad range of goods and services. SRL claims that RCE had no genuine intention to use the mark and that the application was made solely to block SRL from entering the market and registering the mark itself. Consequently, the application was made in bad faith.

27. RCE filed a counterstatement denying the above claims. In particular, it claims that the filing of the application was commercially coherent in view of its prior and ongoing use of the mark SAMUEL RYDER.

HEARING

28. A hearing was requested and this took place via videolink on 20 February 2023. Ryder Cup was represented by Denise McFarland of Counsel, instructed by Keltie

LLP. SRL was represented by Alan Fiddes of Murgitroyd & Company, having been represented earlier in the proceedings by The Trademark Cafe Limited.

EVIDENCE AND SUBMISSIONS

Ryder Cup's evidence in chief

29. Ryder Cup filed witness statements from the following:

- i) Richard Hills, the former Director of RCE from 1995 to November 2018. His evidence goes to the use and reputation of the earlier marks and the claimed goodwill. He also provides a brief history of the Ryder Cup and an account of the interactions between the directors of SRL and RCE, which has relevance for the claims of bad faith. His witness statement is dated 5 March 2021 and is accompanied by 46 exhibits.
- ii) John Yapp, the former Group Finance Director of PGA between 2001 and 2017 and a consultant for the PGA until the end of July 2019. His evidence goes to the history of the Ryder Cup and the role of RCE in developing the tournament into a major sports event. He states that RCE has promoted the name "Samuel Ryder" in connection with the tournament, and that there are other organisations that raise awareness of Samuel Ryder as a philanthropist without linking him to golf. Mr Yapp's witness statement is dated 1 May 2020.
- iii) Peter Dawson, President of the International Golf Federation and the former Secretary of The Royal and Ancient Golf Club of St Andrews and Chief Executive of The R&A, positions he held from 1990 until 2015. His evidence goes to the reputation of Ryder Cup and his belief that the name Samuel Ryder would be associated by the golf industry and golfing public with the Ryder Cup. His witness statement is dated 20 March 2020.
- iv) Kerry Haigh, Chief Championships Officer of PGAA since 2013. The evidence goes to the recent history of the Ryder Cup and the intellectual

property associated with it, including the use of SAMUEL RYDER as a mark. The evidence is dated 9 February 2021.

- v) Scott Crockett, Communications Director of the PGA European Tour and RCE since 2014. His evidence goes to the significance and connotations of the word “Ryder” in the mark “RYDER CUP”. His evidence is dated 26 January 2021. It is accompanied by exhibits showing the use of the word “Ryder” as a shorthand for the tournament.
- vi) Arnaud Boetsch, Communication & Image Director of Rolex SA, and Laurent Delanney, Associate Director Global Sponsorship of Rolex SA. Rolex has been a sponsor of the Ryder Cup since 1995. Their evidence (dated 5 May 2020 and 30 April 2020 respectively) goes to the association of the name “Samuel Ryder” with the Ryder Cup.
- vii) James Pinney, Deputy General Counsel at PGA European Tour since 1 January 2020, prior to which he was Commercial Lawyer since 2018. His evidence goes to the use of the mark RYDER CUP in relation to charitable fundraising activities and is accompanied by seven exhibits. It is dated 8 July 2021.

SRL’s evidence in chief

30. SRL filed witness statements from the following individuals:

- i) Thomas Ryder-Smith, of SRL. His witness statement goes to the efforts made to protect his great-grandfather’s name and the discussions between RCE and SRL. It is dated 11 November 2021 and accompanied by 12 exhibits.
- ii) Annabel Hanratty, a legal advisor at Murgitroyd & Company Limited, the representatives of SRL. Her witness statement presents the results of internet searches for information relating to Samuel Ryder. It is dated 12 November 2021 and is accompanied by 6 exhibits.

Ryder Cup's evidence in reply

31. Ryder Cup filed witness statements from the following individuals:

- i) Guy Kinnings, Deputy Chief Executive Officer and Chief Commercial Officer at the European Tour Group and the Ryder Cup Director for RCE. His evidence disputes the account of events given by Thomas Ryder-Smith in his witness statement. His evidence is dated 9 February 2022.
- ii) Richard Hills. His evidence responds to statements made in the witness statement of Thomas Ryder-Smith and is dated 9 February 2022.

Evidence in CA504353

32. For SRL, Mr Ryder-Smith filed a further witness statement dated 10 May 2022. There is some repetition of evidence given in his earlier witness statement.

33. Ryder Cup filed witness statements from the following individuals:

- i) Richard Hills. He gives his account of the interactions between RCE and the Ryder-Smiths and responds to statements in the above witness statement. It is dated 20 July 2022.
- ii) James Pinney. His evidence goes to the use of the name Samuel Ryder and responds Mr Ryder-Smith's evidence. It is dated 18 July 2022.
- iii) Guy Kinnings. His evidence responds to statements made by Mr Ryder-Smith. It is dated 13 July 2022.

Submissions

34. Ryder Cup filed written submissions on 4 March 2021 and 6 July 2021.

PRELIMINARY ISSUE

35. In Oppositions Nos. 417801, 417803 and 422302, RCE relies on an EUTM and a UKTM that are identical in terms of mark and specification. These are EUTM No. 18087256 and UK Application No. 3409719, which has since been registered. In its submissions dated 4 March 2021, Ryder Cup stated EUTM Application No. 18087256 no longer stood as a ground for opposition. In its later submissions dated 6 July 2021, it said that it would only comment on UK Application No. 3409719. For clarity, I note that the oppositions based upon EUTM No. 4476164 were also proceedings.

36. As the oppositions were all launched before IP Completion Day (31 December 2020), EUTMs continue to constitute earlier marks for the purpose of these proceedings, and it is not automatically the case that they may no longer be relied upon. However, I infer from its submissions, that Ryder Cup was no longer relying on the SAMUEL RYDER EUTM. Mr Fiddes's submissions at the hearing were predicated on the understanding that the outcome of the application to invalidate UKTM No. 3409719 would have a material impact on the oppositions, which would be the case if the EUTM were not in play. Ms McFarland did not challenge this assumption.

DECISION

37. As UKTM No. 3409719 is an earlier mark relied upon by RCE in its oppositions, I find it convenient to begin with the cancellation.

Application for a Declaration of Invalidity Against UKTM No. 3409719

38. The relevant parts of section 47 of the Act are as follows:

“(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

...

(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.

...

(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.

39. Section 3(6) of the Act is as follows:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

The Evidence

40. SRL was incorporated on 8 December 1995.⁴ Mr Ryder-Smith says that the company was set up *“in order to have a more formal structure for controlling and commercialising the Samuel Ryder name and associated intellectual property”*.⁵ This followed an approach earlier in the year to Mr Ryder-Smith’s father on behalf of Rolex who wished to use a photograph of Samuel Ryder for an advertisement proposed for use in the Ryder Cup programmes. Consent was given and the estate of Samuel Ryder received a payment of \$3,000. Mr Ryder-Smith states that Ryder Cup was aware of the request and the involvement of the family in approving the layout and copy of the advertisement.⁶ Mr Hills, for Ryder Cup, says he has no recollection of being made aware of this approach.⁷ This is plausible, as the text of the advertisement refers to Rolex being the official timekeeper for the 1995 tournament to be held in Rochester, New York.⁸ It was PGAA that was responsible for organising that contest.

⁴ Witness statement of Thomas Ryder-Smith, paragraph 10; see also Exhibit RH43.

⁵ *Ibid*, paragraph 10.

⁶ *Ibid*, paragraphs 8-9.

⁷ Second witness statement of Richard Hills, paragraph 2.

⁸ Exhibit TRS3.

41. Mr Ryder-Smith then states that between 1995 and 1997 SRL began to receive “several” commercial offers to use the name “SAMUEL RYDER” and that *“an intense period of negotiation began between Samuel Ryder Limited and the Ryder Cup.”* Mr Ryder-Smith acknowledges that at this point SRL owned no formal intellectual property. The offers included one made by a US golf ball manufacturing company. SRL contacted Ryder Cup, who made it clear that they would not be involved unless they had exclusive handling of the negotiations and that they would oppose an attempt to exploit the SAMUEL RYDER name financially.⁹ Again, Mr Hills states that he has no recollection of this offer and notes that the legal correspondence in Exhibit TRS4 that relates to it refers to the PGAA.¹⁰

42. In 1996, SRL filed an application to register SAMUEL RYDER as a trademark in the US. This was opposed by the PGAA, and SRL withdrew its application. Mr Ryder-Smith says that the reason for this was the threat of high legal costs.¹¹

43. There is then a gap in the timeline until, at some point in 2017, Brittany Ferries approached SRL to discuss a proposal for a commercial undertaking for the 2018 Ryder Cup to be held in France. Mr Ryder-Smith says that it was then that SRL began to investigate use of the SAMUEL RYDER name by third parties and *“noted that unauthorised use of the Samuel Ryder name had been taking place regularly, without any policing or objection from the Ryder Cup.”*¹²

44. In the meantime, PGAA had used the sign “SAMUEL RYDER CLUB” for a hospitality suite for the 2008 tournament held in the US. Commercial use was resumed in 2016.¹³ In Europe, the sign was first used at the 2018 Ryder Cup, and advertising for the services began in April 2017.¹⁴ A brochure can be viewed in Exhibit RH24. Exhibit RH28 contains a collection of 21 invoices to UK customers for hospitality packages in the Samuel Ryder Club, while Exhibit RH29 includes a spreadsheet showing enquiries about, and bookings for, Samuel Ryder Club packages made by

⁹ *Ibid*, paragraph 13.

¹⁰ Second witness statement of Richard Hills, paragraph 3.

¹¹ Witness statement of Thomas Ryder-Smith, paragraph 14.

¹² Witness statement of Thomas Ryder-Smith, paragraph 18.

¹³ Witness statement of John Yapp, paragraph 18.

¹⁴ First witness statement of Richard Hills, paragraph 58.

UK customers between February 2017 and September 2018. Mr Hills says that the spreadsheet shows that 2,895 UK customers made contact with Ryder Cup during this time, and adds that sales were also made through other channels.¹⁵

45. In June 2018, SRL employed a trade mark practitioner and began to consider the possibility of protecting the SAMUEL RYDER name. The following month, it approached Ryder Cup *“in entirely good faith, outlining our intentions to protect and use the Samuel Ryder name and to preserve our great grandfather’s legacy and heritage”*.¹⁶ Mr Hills, for Ryder Cup, states that Mr Ryder-Smith and his brother contacted Ryder Cup in 2018 asking for its cooperation in tackling alleged abuses of the name of their great-grandfather, Mr Samuel Ryder, by third parties. Mr Hills says that at this point he was unaware of the existence of SRL, which was not mentioned at the time by the brothers.¹⁷

46. A meeting took place in October 2018. The witnesses for Ryder Cup say that the date of the meeting was 12 October 2018, while Mr Ryder-Smith says that it was 23 October 2018. Mr Ryder-Smith’s account is as follows:

“20. At the October meeting, the Ryder Cup acknowledged that there had been no efforts by them to police or to stop use of the Samuel Ryder name by unauthorised third parties. Samuel Ryder Limited itemised several instances, with the first being a Golf Package holiday operator, using the domain www.SamuelRyder.com. ... Richard Hills, a Ryder Cup Europe Director in attendance at that meeting, also produced a printout of a homepage of a Golf Package Holiday operator using the brand name ‘Samuel Ryder’ and agreed that this was ‘disgraceful’ but stated that no efforts have been made to contact the operator.

21. The website at www.SamuelRyder.com remained live until 2020 when we wrote to them and asked them to remove the page ...

¹⁵ First witness statement of Richard Hills, paragraph 60.

¹⁶ *Ibid*, paragraph 19.

¹⁷ First witness statement of Richard Hills, paragraph 82.

22. Samuel Ryder Limited also noted that the Celtic Manor hotel in Wales was using the name 'Samuel Ryder' for a hospitality suite. Again, the Ryder Cup stated that no action had been taken in respect of this use, and still has not. The Celtic Manor is still using this name on the current website. ...

23. At the meeting on 23 October 2018, Samuel Ryder Limited and the Ryder Cup discussed again the topic of Samuel Ryder Limited registering trade marks to protect the Samuel Ryder name. The Ryder Cup set out that this would be unacceptable and would be firmly resisted by them, on the basis that the Ryder Cup should be the only party with any rights to the Samuel Ryder name.”

47. The witnesses for Ryder Cup dispute this account of the meeting. Mr Hills states:

“During the meeting it became apparent that concern over alleged abuses of Samuel Ryder’s name amounted to one example only, and it was only one of Messrs Ryder Smith’s agenda items. Their ultimate aim was in fact to secure RCE’s consent to the commercial exploitation of the name ‘SAMUEL RYDER’. RCE made it clear there and then, as well as in subsequent correspondence, that Messrs. Ryder Smith’s commercial use of the name SAMUEL RYDER for golf related goods and services would trade off the back of RCE because of the historical association between Mr Samuel Ryder and the Ryder Cup tournament and the significance of the name ‘Samuel Ryder’ in golf.”¹⁸

48. In his second witness statement, Mr Hills claims to have no recollection of making the comments attributed to him in Mr Ryder-Smith’s paragraph 20.¹⁹ He also states that he believes that the use of the SAMUEL RYDER name at the Celtic Manor was approved by Ryder Cup.²⁰

¹⁸ First witness statement of Richard Hills, paragraph 82.

¹⁹ Second witness statement of Richard Hills, paragraph 5.

²⁰ *Ibid*, paragraph 6.

49. Mr Kinnings gives a similar statement and adds that Ryder Cup clearly stated that any commercial exploitation of the SAMUEL RYDER name by SRL could only be within a limited scope and under licence from Ryder Cup.²¹

50. Mr Ryder-Smith states that further discussions over the ownership of the SAMUEL RYDER name took place between January and July 2019, but that on 26 June 2019 RCE “*surreptitiously*” filed the contested application for a list of goods and services that SRL had indicated were of potential interest to it. He continues:

“The timing of this filing seems to clearly suggest this application was filed solely with the intention of blocking any applications we might make – in the previous 20 years, the Ryder Cup had made no efforts or attempts to register the SAMUEL RYDER name in the UK, but within weeks of our meeting and our suggestion in good faith that we were looking to protect the name, trade mark applications had been filed by them covering a range of different types of goods and services.”²²

51. Mr Kinnings states that, while there was correspondence between the parties during the first half of the year, this cannot be characterised as a negotiation between them over the ownership of the name. He states that Ryder Cup maintained its position that “SAMUEL RYDER” could only be used under licence and that if any trade mark application were to be filed, it would be done by Ryder Cup.²³ He denies that the contested trade mark was applied for “*surreptitiously*” and states that the goods and services in the specification were those relevant to Ryder Cup’s business.²⁴

52. Finally, I note that Companies House filings show that SRL was dormant from its incorporation up to 31 December 2018.²⁵

²¹ Witness statement of Guy Kinnings, paragraph 3.

²² Witness statement of Thomas Ryder-Smith, paragraph 24.

²³ Witness statement of Guy Kinnings, paragraph 4.

²⁴ *Ibid*, paragraph 5.

²⁵ Exhibit RH44.

Assessment of the bad faith claim

53. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121, the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P, *Hasbro, Inc. v European Union Intellectual Property Office (EUIPO)*, Case T-663/19, *pelicantravel.com s.r.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-136/11, and *Psytech International Ltd v OHIM*, Case T-507/08.²⁶ Floyd LJ summarised the law as follows:

“The following points of relevance to this case can be gleaned from these CJEU authorities:

1. The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].
2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].
3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks

²⁶ Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why the decision refers to the trade mark case law of EU courts, even though the UK has left the EU.

signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacılık* at [45].

4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].

5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].

6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].

7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].

8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].

9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: *Lindt* at [41] – [42].

10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].

11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Mağazacılık* at [46].

12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: *Lindt* at [51] to [52].

13. Bad faith cannot be established solely on the basis of the size of the list of goods and services in the application for registration: *Psytech* at [88], *Pelikan* at [54]²⁷.

54. The relevant date is the date of application for UKTM No. 3409719, which is 26 June 2019.

55. According to Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are as follows:

- (i) What, in concrete terms, was the objective that the party alleged to have acted in bad faith has been accused of pursuing?
- (ii) Was that an objective for the purposes of which the contested application could not properly be filed?
- (iii) Has it been established that the contested application was filed in pursuit of that objective?²⁸

56. SRL accuses Ryder Cup of having applied to register the contested mark to block SRL from entering the market and using the mark itself, and of having no intention to use the mark in respect of the goods and services applied for. The General Court

²⁷ Paragraph 67.

²⁸ Paragraph 8.

(“GC”) found in *Copernicus-Trademarks v EUIPO (LUCEO)*, Case T-82/14, that the filing of a trade mark for the purposes of blocking applications by a third party, and without an intention to use the mark, was an act of bad faith. The answer to Mr Hobbs’s second question is that this is an objective for the purposes of which the contested application could not properly be filed.

57. An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: see *Red Bull GmbH v Sun Mark Limited & Anor* [2012] EWHC 1929 (Ch), paragraph 133.

58. The parties agree that SRL informed Ryder Cup of its intention to file a trade mark application for SAMUEL RYDER a few months before the contested application was made. Ryder Cup was therefore aware of SRL’s intentions. That said, SRL’s evidence indicates that it was a long-held position of the organisations responsible for the Ryder Cup golf tournament (whether based in Europe or the US) that any attempt by another party to commercialise the SAMUEL RYDER name would be resisted.

59. Mr Ryder-Smith notes that Ryder Cup had taken no action before this to register the SAMUEL RYDER name.²⁹ In his second witness statement, Mr Pinney states that the reasons for not doing so were, first, that unregistered trade mark rights are protected under common law (i.e. the law of passing off), and that, secondly, it owned a number of trade marks including the word “RYDER” on the basis of which it considered it could challenge unauthorised third-party use of SAMUEL RYDER.³⁰

60. The evidence shows that “SAMUEL RYDER” had, at the relevant date, been used for hospitality services at a golf tournament. Mr Fiddes submitted that it did not show that the use was made by RCE and drew my attention to the invoices in Exhibit RH28 that I have already mentioned. These come from a company called “Ryder Cup 2018 Commercial Limited French Branch”. Mr Hills has explained that it is RCE that is

²⁹ Witness statement of Thomas Ryder-Smith, paragraph 15.

³⁰ Paragraph 14.

responsible for the organisation of the Ryder Cup golf tournament when it is held in Europe. He has not, however, explained precisely how the company issuing the invoices relates to RCE. Nevertheless, in the light of the evidence as a whole, I consider it is reasonable to infer that this use was made by an organisation associated with RCE and with RCE's consent.

61. Mr Fiddes then submitted that RCE might have intended to use the contested mark for hospitality services, but that is all. However, the goods and services in the specification all either relate to golf or ancillary services, such as the Class 43 food and drink services, or goods that may be sold as merchandise, such as printed matter and clothing. The contested mark was, as I have already noted, first used in Europe from 2017 and the application for the mark is consistent with an attempt to protect Ryder Cup's commercial interests and any future commercial developments. I believe the facts to be as consistent with good faith as bad faith.

62. The application for a declaration of invalidity against UKTM No. 3409719 therefore fails and the mark remains registered.

The Oppositions

63. I find it convenient to begin with section 3(6), as the facts that must be considered are the same as those pertaining to the invalidation claim.

Section 3(6)

64. The relevant date for the word and signature marks is 16 July 2019. The relevant date for the figurative mark is 28 July 2020.

65. Ryder Cup accuses SRL of having filed the applications in knowledge of its own rights and its objections to SRL's proposals to register a trade mark. It further claims that SRL's motive was to secure leverage for negotiations between the parties. Ms McFarland submitted that, as the family had been official guests at the Ryder Cup, they were aware that RCE used the sign "SAMUEL RYDER" for a hospitality suite and that, as in *Fox Group International Ltd v Teleta Pharma Limited* [2021] EWHC 1714

(IPEC), SRL could be regarded as being “*fixed with that knowledge*”.³¹ Mr Ryder-Smith confirms that he and his brother were from 2005 the only individuals acting as directors of SRL.³² They were at the time of the relevant dates, and indeed for some period before, the controlling minds of SRL. I also note that Mr Hills for Ryder Cup states that it is “*quite likely [that the brothers] would have come across the SAMUEL RYDER CLUB hospitality suites hosted by RCE and PGAA*”.³³ In addition, Mr Yapp for Ryder Cup states that “*The Ryder-Smith family should have been aware of this because they were invited by RCE and attended both 2016 and 2018 as guests of RCE*” (my emphasis).³⁴ Neither Mr Hills nor Mr Yapp provides any further details. In my view, they both make suppositions as to the extent of the brothers’ knowledge. I have no photographic or video evidence to indicate how visible the name of that particular hospitality suite might have been to attendees in 2018, which was the only time it was used in Europe. Furthermore, the name has not been used for hospitality suites in the UK, but rather in the US and France on three occasions in total.

66. RCL is the proprietor of a German trade mark registration for SAMUEL RYDER in Class 25. The application was filed on 29 March 1996 and the mark has been renewed.³⁵ Ryder Cup has provided no evidence of use of this mark for the goods for which it is registered, and does not state whether it was specifically mentioned in any of the meetings between the parties, so it is unclear whether SRL is likely to have been aware of it.

67. Even if I accept that it is probable that SRL knew of Ryder Cup’s use of the mark, knowledge of another party’s use of a mark is not in itself evidence of bad faith: see *Lindt*, paragraphs 40-41. I am required to consider the intention of SRL at the time the applications were filed. Ryder Cup claims that it was to secure leverage in negotiations between the parties, after SRL had been told that Ryder Cup would object to the proposed application for a trade mark. Mr Kinnings states that:

³¹ Paragraph 62.

³² Witness statement of Thomas Ryder-Smith, paragraph 17.

³³ Paragraph 85.

³⁴ Paragraph 18.

³⁵ Exhibit RH46.

“I can also confirm that RCE interrupted correspondence with Party B [SRL] in relation to a trade mark licence when Mr Ryder-Smith requested the sum of £2 Million to assign to RCE the mark SAMUEL RYDER to which neither he, nor Party B had any rights or title. After this ludicrous request, RCE was left with no doubt that Mr Ryder-Smith and Party B had been driven by opportunistic motives and had approached RCE to concoct a situation that would enable them to gain some financial advantage.”³⁶

68. Mr Kinnings does not say on what date this request was made, whether it was made in writing or orally, and neither has he filed relevant correspondence as an exhibit. On the other hand, I note that SRL did not seek to challenge his evidence through cross-examination or by filing contradictory evidence. What Mr Kinnings says is not obviously incredible and so it is not open to me, in these circumstances, to disbelieve him. However, the absence of any date or context reduces the weight that I can place on this evidence.

69. What does Mr Ryder-Smith say about SRL’s motives? In my view, his evidence points to a belief on the part of SRL that it has a right to the name SAMUEL RYDER by virtue of the family connection. Recital 1 to the draft licence agreement drawn up in relation to the proposal to use the mark for golf balls that I have already mentioned reads as follows:

“Licensors [i.e. the Ryder-Smith brothers] represent that they are the closest living descendants of Samuel A. Ryder, and possess the right to use and license others to use the name ‘Samuel A. Ryder’ or ‘S.A. Ryder’ for commercial purposes.”³⁷

70. On 23 June 2020, Mr Ryder-Smith sent an email to an undertaking called “Samuel Ryder Golf” (the emphasis is mine):

³⁶ Witness statement dated 9 February 2022, paragraph 6.

³⁷ Exhibit TRS4, page 19.

“I am writing to you in my capacity as a director of, and on behalf of Samuel Ryder Ltd, which owns all associated IP and the design rights to the name ‘Samuel Ryder’.

It has come to your attention that your company is using the name Samuel Ryder to sell bespoke golf packages – therefore profiting from the golfing association of my great-grandfather, Samuel Ryder. We would like to know from whom / where this authorisation was obtained. If you would be so kind as to clarify this point, that would be much appreciated.

If there is a logical explanation then we can be satisfied that there is no infringement on the family name. I trust that you understand our concern.

We very much look forward to hearing from you at your earliest possible convenience.”³⁸

71. This email is dated after the word and signature marks were filed, but evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: see *Hotel Cipriani SRL & Ors v Cipriani (Grosvenor Street) Limited & Ors* [2008] EWHC 3032 (Ch), paragraph 167. It is consistent with the evidence from 1995 that shows that SRL believed there were rights in the name of Samuel Ryder that belonged to the family.

72. Ms McFarland submitted that the name of a historical figure and a commercial brand were two different things:

“... you have individual people who existed and who have a legacy and who have a history, but that is divorced from the independent goodwill and reputation of commercial rights which very often are built up around the brand decades if not hundreds of years after they are deceased.”³⁹

³⁸ Exhibit TRS7, page 36.

³⁹ Transcript, page 20.

73. There are no intellectual property rights in a name *per se*. I am satisfied that the Ryder-Smith brothers, and through them SRL, believed that they did have rights in the name of their great-grandfather. They were mistaken in that belief, but the question I must address is whether they objectively should have known that they did not have the right to apply to register the trade marks.

74. On 24 July 1995, following the approach by the golf ball manufacturing company, the brother's father received a letter from US attorneys regarding the proposed licence I quoted in paragraph 69 above. It said:

“For the time being, other than giving you specific comments on the proposed form of license, I believe it is most imperative that we deal with the issue of the rights to the name ‘Sam Ryder’ or ‘S.A. Ryder’ as used in competition with the trademark owned by the USPGA for RYDER. As I had mentioned to you by telephone, to the extent that we believe we could set aside some rights in some variant of the Ryder name for your license to The Doctors’ Group, we might want to promptly employ the priority rules for filing under the Paris Convention now that a similar filing has been made in the UK. Please let’s arrange, perhaps by conference call, for a communication between us and your intellectual property counsel in the UK as soon as possible.”⁴⁰

75. There is no indication in the evidence that such a call took place, but this evidence, together with the evidence of Ryder Cup’s opposition to the commercialisation by third parties of the name “Samuel Ryder” leads me to find that SRL should have known that it did not have the right to apply to register the word mark. I find that the application for UKTM No. 3414361 was made in bad faith, and the section 3(6) ground succeeds.

76. The remaining marks are variants of the name “Samuel Ryder” and SRL has adduced evidence to support a belief that some variant of the name may have been acceptable. On the basis of the evidence before me, I consider that Ryder Cup has not established a *prima facie* case that SRL was acting in bad faith when it filed the

⁴⁰ Exhibit TRS4, page 27.

applications for signature mark. The opposition against Application No. 3414350 fails under section 3(6).

77. The relevant date for the figurative mark is 28 July 2020, which is over a year later than the relevant date for the other two marks. Mr Ryder-Smith states that The Samuel Ryder Charitable Trust was formed “*from January 2020 onwards ... to continue the legacy of Samuel Ryder in a sporting capacity*”.⁴¹ He states that the trust began to sponsor amateur sporting events and developed relationships with Golf England, The Golf Trust, the Clutch Pro Tour and British Inclusive Golf. The date of application was just over a month after the email reproduced in paragraph 70 above, which in my view shows that Mr Ryder-Smith considered that there were rights in the name SAMUEL RYDER that could be infringed.

78. Ryder Cup claims that the application for this mark was a further attempt to achieve the same objectives that lay behind the filing of the earlier two, and to cause unnecessary disruption and expense to Ryder Cup. The application was filed during the course of the evidence rounds of the consolidated oppositions against the earlier two marks and SRL’s opposition to Ryder Cup’s Application No. 3409719.⁴² I accept that SRL would have known of Ryder Cup’s position on the use of the name of SAMUEL RYDER in association with golf, but I consider that the evidence shows that it considered that it was entitled to apply to register the mark. I find that a *prima facie* case of bad faith has not been made out in this opposition. The opposition against Application No. 3516813 fails under section 3(6).

Section 5(1)

79. The opposition under this ground is brought solely against the word mark. Although I found that the opposition under section 3(6) had succeeded, I shall deal fully with the opposition on the relative grounds.

80. Section 5(1) of the Act is as follows:

⁴¹ First witness statement of Thomas Ryder-Smith, paragraph 25.

⁴² SRL’s opposition fell away as no evidence was filed to support the claims.

“A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

81. Under this ground, RCE is relying on UKTM No. 3409719, which has survived the application for a declaration of invalidity. As the mark completed its registration process after the date on which the application for the word mark was filed, it is not subject to proof of use and RCE may rely on all the goods and services for which it is registered.

82. Both marks consist of the two words **SAMUEL RYDER** and are therefore identical.

83. The following goods and services appear in both specifications, either in identical wording or self-evidently synonymous terms (e.g. software/computer software):

Class 9

Software; computer software; game software; video game programmes; downloadable electronic publications; sunglasses and spectacles; cases adapted for mobile phones.

Class 25

Clothing; footwear; headgear.

Class 28

Games, toys and playthings; handheld electronic games; sporting articles and equipment; golf equipment; golf clubs; golf balls; golf tees; golf club head covers; golf bags.

Class 41

Entertainment; sporting ... activities; organisation of sporting ... events and activities; hospitality services (entertainment).

84. In *Gérard Meric v OHIM*, Case T-133/05, the GC stated that:

“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 für 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.”⁴³

85. The table below shows the goods and services I consider to be identical on this principle:

Class	Contested goods/services	Earlier goods/services
9	<i>Downloadable software; Computer software platforms; Computer software applications; Virtual reality software; Computer software for use in accessing, updating, manipulating, modifying, organizing, storing, backing up, synchronizing, transmitting and sharing data, documents, files, information and multimedia content relating to golf courses, the game of golf, golf instruction and golf competitions via a global computer network and via any other communications network.</i>	<i>Computer software</i>
	<i>Downloadable smartphone applications; Application software; Software and applications for mobile devices</i>	<i>Application software and downloadable application software relating to golf and golf matches</i>
	<i>Earphones and headsets for mobile telephones</i>	<i>Mobile phone accessories</i>
25	<i>Coats; jackets; shirts; sweatshirts; skirts; bandanas; gloves; waterproof clothing; underwear; socks; trousers; shorts; pyjamas; t-shirts.</i>	<i>Clothing</i>
	<i>Hats; caps; headbands</i>	<i>Headgear</i>
	<i>Sports shoes</i>	<i>Footwear</i>
28	<i>Video game apparatus; computer games apparatus; electronic games</i>	<i>Handheld computer games</i>

⁴³ Paragraph 29.

Class	Contested goods/services	Earlier goods/services
	<i>Sports games; board games</i>	<i>Games</i>
	<i>Toy golf sets</i>	<i>Toys</i>
	<i>Golf accessories; golf grips; golf gloves</i>	<i>Golf equipment</i>
	<i>Shafts</i>	<i>Sporting articles</i>
41	<i>Education; providing of training; organisation of training and instruction for the game of golf</i>	<i>Golf training and golf coaching</i>
	<i>Cultural activities; organisation of ... cultural events and activities; provision of ... cultural activities all relating to the professional video gaming industry; Entertainment services in connection with sports events; entertainment services in the form of public viewing of live and delayed broadcast of sports events; Distribution of sound and images recordings via the internet;</i>	<i>Entertainment services</i>
	<i>... television coverage of sports events</i>	<i>TV shows</i>
	<i>Organisation of golf events; organisation of sports competitions; arranging contests;</i>	<i>Organisation of golf tournaments and golf competitions</i>
	<i>Radio ... coverage of sports events; Information services concerning sports events ...</i>	<i>Providing information in relation to ... golf tournaments and golf competitions</i>
	<i>Provision of information relating to golf courses, including global positioning system ("GPS") information, for determining distances on golf courses and for accessing of relevant data and statistics related thereto.</i>	<i>Providing information in relation to golf...</i>
	<i>Electronic publication; providing on-line publications; Non-downloadable electronic publications</i>	<i>Providing non-downloadable electronic publications in relation to golf, golf tournaments and golf competitions</i>
	<i>Publication of printed matter and printed publications; publication of magazines, calendars, books, leaflets, posters.</i>	<i>Publication of magazines, programmes and other printed matter relating to golf, golf tournaments and golf competitions.</i>

86. In addition, I agree with Ryder Cup that *cords ... and cases for use with spectacles* in SRL's specification are identical to *cases and cords for sunglasses*. This is because spectacles and sunglasses are physically identical except for the lenses and so the same cords and cases will be used for both. I also agree that *earphones* and *headphones* can be types of mobile phone accessory and so fall within this broader term.

87. Ryder Cup submits that *Information services concerning ... entertainment* fall within the description of the following services: *Entertainment services; ... entertainment services including TV shows*. An entertainment information service could provide content that entertains the user and so I find these services to be identical. If I am wrong in this, they are highly similar and I will consider them under the section 5(2)(a) below.

88. I have found *Cultural activities; organisation of ... cultural events and activities; ... cultural activities all relating to the professional video gaming industry* to be included in the broad term *Entertainment services*, as the latter term could include activities and services of a cultural nature. However, in the event that I am wrong in this, I shall also consider them under section 5(2)(a) below.

89. I move now to *Organisation of exhibitions*. Ryder Cup submits that, to the extent that the exhibitions relate to golf, these services are similar to its own golf-related services in Class 41. I accept that SRL's term would include the organisation of exhibitions about golf. Those services would have the same users and purpose as RCE's *Providing information in relation to golf, golf tournaments and golf competitions*. The information could be provided by means of an exhibition. If the services are not identical, they are highly similar.

90. Ryder Cup also submits that SRL's *sporting ... activities all relating to the professional video gaming industry and organisation of electronic sports ... events, tournaments and competitions* are identical to its *Sporting activities* and *Running of golf tournaments* respectively, as electronic sports are widely considered to be sports or sporting activities. I note that Ryder Cup has provided no evidence to support this view.

91. In construing the terms used in the specifications, I am guided by the comments of Floyd J (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”⁴⁴

92. I also note that in *Sky Plc & Ors v Skykick UK Ltd & Anor* [2020] EWHC 990 (Ch), Arnold LJ set out the following summary of the correct approach to interpreting terms in specifications:

“...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

⁴⁴ Paragraph 12.

(4) A term which cannot be interpreted is to be disregarded.”⁴⁵

93. In my view, the average consumer would understand “sports” to refer to activities which are competitive and involve both skill and physical exertion, whether this is manifest in speed, strength, dexterity or a combination thereof. They are also governed by rules and watched by spectators for their entertainment. This, in my view, is the core of the possible meanings attributable to the term “*sporting activities*”.

94. I understand that “electronic sports” is a term that is used when referring to competitive video gaming. They share a number of characteristics with physical sports: competition, rules, spectators, and the exercise of skill. However, there is no evidence to suggest that participants exert themselves physically. I do not find them to be identical and so shall return to them when dealing with the section 5(2) grounds.

95. The opposition based on section 5(1) is successful in respect of the goods and services identified in paragraphs 83 and 85-89 above.

Section 5(2)(a) and (b): the oppositions based on the SAMUEL RYDER mark

96. Section 5(2) of the Act is as follows:

“A trade mark shall not be registered if because –

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

⁴⁵ Paragraph 56.

97. In considering the oppositions under section 5(2), I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v OHIM* (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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 greater 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; and

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

Goods and services comparison

98. It is settled case law that I must make my comparison of the goods and services on the basis of all relevant factors. These may include the nature of the goods and services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. Goods and services are complementary when

“... 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.”⁴⁶

99. The goods and services to be compared are shown in the table below. Where they appear in the specification of only one of the applications, I have noted this in the table below. Where I have not indicated which of the contested marks the terms apply to, they appear in the specifications of all of them. I also adopt the findings I made on identity or similarity of goods and services under section 5(1).

Contested goods and services	Earlier goods and services
<p><u>Class 9</u> (word mark, signature mark) <i>... frames, lenses ... for use with spectacles; Range finders; laser range finders; distance recording apparatus; cameras for recording and analysing golf swings; golf simulators; audiovisual teaching apparatus; apparatus for recording, transmission, processing and reproduction of sound, images or data relating to golf.</i></p>	<p><u>Class 9</u> <i>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 and golf matches; 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; interactive software products relating to golf, golf matches of 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;</i></p>

⁴⁶ *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82.

Contested goods and services	Earlier goods and services
	<p><i>sunglasses; spectacles; cases and cords for sunglasses; visors; mobile phone accessories; mobile phone cases; mouse mats; computer game programs; encoded or magnetic credit cards, debit cards and affinity cards.</i></p>
<p><u>Class 14</u> (signature mark) <i>Precious metals and their alloys; jewellery, precious and semi-precious stones; horological and chronometric instruments; pins (jewellery); brooches (jewellery); tie pins; tie clips; amulets (jewellery); rings (jewellery); earrings; bracelets (jewellery); key rings (trinkets or fobs); novelty key holders; cufflinks; necklaces (jewellery); sculptures; statuettes of precious metal; figurines (statuettes) of precious metal; jewellery; medals; commemorative medals of precious metal, medallions (jewellery); medallions not of precious metal; coins; semi-precious stones; gems (precious stones); horological and chronometric instruments including watches; clocks; wristwatches; electric clocks; pendulums (clock), stopwatches, watch straps.</i></p>	<p><u>Class 14</u> <i>Jewellery; horological and chronometric instruments; cufflinks; trophies made of precious metals and their alloys.</i></p>
<p><u>Class 25</u> (figurative mark) <i>Articles of outer clothing; sportswear; leisurewear; training clothing; tracksuits; training pants; sweatpants; anoraks; tops; polo shirts; vests; knitwear; jerseys; pullovers; sweaters; hooded tops; cardigans; waistcoats; pants; ties; mittens; scarves; wristbands; shoes; boots; sandals; slippers; training shoes; sun visors; belts; aprons; uniforms; articles of clothing, footwear and headgear for babies and children; bibs; baby boots.</i></p>	<p><u>Class 25</u> <i>Clothing; footwear; headgear.</i></p>
	<p><u>Class 28</u> <i>Games and playthings; sporting articles; golf equipment; golf balls, golf bags, golf clubs, golf tees, head</i></p>

Contested goods and services	Earlier goods and services
	<p><i>covers for golf clubs; hand held computer games; playing cards; soft toys; decorations for Christmas trees.</i></p>
<p><u>Class 35</u> (word mark) <i>Advertising, marketing and promotional services; promotion of sports competitions and events; promotion of goods and services through sponsorship of sports events; promotion of goods and services of third parties; advertising services relating to golf equipment and golf events; advertising for sports events; television advertising; radio advertising; advertising via the Internet; rental of advertising space on the internet; rental of advertising space at golf events; business administration; business management; office functions; Advertising; sponsorship (promotion and marketing services) and business management of a professional video gaming sports team and persons who participate in competitions and events for computer games; advertising, sponsorship (promotion and marketing services) of competitions and events for computer games; Retail services in relation to clothing, footwear, headgear, games, toys and playthings, video game apparatus, computer games apparatus, electronic games, sports games, golf games, handheld electronic games, board games, toy golf sets, sporting articles and equipment, golf equipment, golf accessories; the bringing together, for the benefit of others, of a variety of goods namely clothing, footwear, headgear, games, toys and plaything, video game apparatus, computer games apparatus, electronic games, sports games, golf games, handheld electronic games, board games, toy golf sets, sporting articles and equipment, golf equipment, golf accessories, enabling consumers to</i></p>	

Contested goods and services	Earlier goods and services
<p><i>conveniently compare and purchase those goods; the aforementioned services all available via any communications media.</i></p>	
<p><u>Class 36</u> (Figurative mark) <i>Charitable fund raising services.</i></p>	
<p><u>Class 41</u> <i>Organisation of Electronic sports and video gaming events, tournaments and competitions; ... provision of training [and] sporting ... activities all relating to the professional video gaming industry; information services concerning ... entertainment; audio and video recording services; issuing of tickets for events, including golf sports events; reservation of entry tickets to sports or entertainment events; ticket reservation services for entertainment, sporting and cultural events ...; the aforementioned services all available via any communications media.</i></p> <p><u>Class 41</u> (Figurative mark) <i>Radio or television coverage of sports events, namely radio or television reporting of sports events; ... the aforementioned services all available via any communications media.</i></p>	<p><u>Class 41</u> <i>Entertainment services; corporate hospitality (entertainment); sporting activities; organisation of golf tournaments and golf competitions; TV shows; providing information in relation to golf, golf tournaments and golf competitions; golf training and golf coaching; providing access to, and information on, golf training and coaching; publication of magazines, programmes and other printed matter relating to golf, golf tournaments and golf competitions; providing non-downloadable electronic publications in relation to golf, golf tournaments and golf competitions.</i></p>
	<p><u>Class 43</u> <i>Hotel services; restaurant services; bar and café services; hospitality services (food and drink).</i></p>

100. In *SEPARODE Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, stated that:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to

be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”⁴⁷

Class 9

101. RCE submits that *frames [and] lenses for use with spectacles* are complementary to its *Spectacles* and therefore highly similar. Frames and lenses are component parts of spectacles. I note that the GC held in *Les Éditions Albert René v OHIM*, Case T-336/03, that

“The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”⁴⁸

102. The purchaser of a pair of spectacles is likely to choose a frame in which a range of different lenses would be fixed. The physical nature of the component goods does not change in the finished product, and the intended purpose of them is the same. I find that there is a high degree of similarity between them.

103. I shall now consider *Range finders; laser range finders; distance recording apparatus; cameras for recording and analysing golf swings; golf simulators*. These are all electronic devices which Ryder Cup submits are used by golfers in order to practise and improve their performance. They are therefore targeted towards the same end user as Ryder Cup’s *Golf equipment* and will be distributed through the same trade channels. The physical nature and method of use are different and there is no competition between them. I find there to be a medium degree of similarity between the goods.

⁴⁷ Paragraph 5.

⁴⁸ Paragraph 61.

104. I construe SRL's *audiovisual teaching apparatus* to refer to electronic equipment intended for educational and training purposes and which involves the use of sound and images. I accept that *golf training and golf coaching* could be provided wholly or partially through such apparatus. There is therefore some overlap in user, likely to be some overlapping trade channels, and a degree of complementarity. In my view, the average consumer would be likely to assume that the training and the electronic equipment were the responsibility of the same undertaking. I find that there is a low to medium degree of similarity between the goods and Ryder Cup's services.

105. The final goods to be considered in this class are *Apparatus for recording, transmission, processing and reproduction of sound, images or data relating to golf*. RCE submits that these goods are complementary to its own *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; pre-recorded disks and tapes; recorded magnetic and opto-magnetic data carriers; CDs, DVDs, CD-ROMs, videos*.

106. I agree with Ryder Cup that the goods are complementary. SRL's goods serve to reproduce sound and images and includes apparatus that would be used to play Ryder Cup's recordings. There is likely to be some overlap in trade channels, and the goods are likely to be sold in some of the same outlets. The end consumers are the same. The nature of the goods is different. They are not in competition. I find that they are similar to a low to medium degree.

Class 14

107. The terms *Jewellery, Horological and chronometric instruments* and *Cufflinks* appear in both specifications.

108. SRL's *pins (jewellery); brooches (jewellery); tie pins; tie clips; amulets (jewellery); rings (jewellery); earrings; bracelets (jewellery); necklaces (jewellery); medallions*

(jewellery); medallions not of precious metal are all included in Ryder Cup's broader *Jewellery* and so are identical per *Meric*.

109. SRL's *Horological and chronometric instruments including watches; clocks; wristwatches; electric clocks; pendulums (clocks); stopwatches* are all included in Ryder Cup's broader *Horological and chronometric instruments* and so are identical per *Meric*.

110. I understand the term *Precious metals and their alloys* to refer to the raw materials that are used to make goods such as jewellery or trophies. Their purpose would therefore be different. SRL's goods are more likely to be purchased by manufacturers, rather than the general public who would be the users of Ryder Cup's goods. However, precious metals may also be bought as an investment by members of the public. They are not in competition with each other; neither are they complementary. There would, in my view, be some shared trade channels as precious metals may be bought from jewellers. Taking all these factors into account, I find that there is a low degree of similarity between the goods.

111. I consider that the same rationale applies with regard to SRL's *Precious and semi-precious stones; semi-precious stones; gems (precious stones)*. They are similar to Ryder Cup's *Jewellery* to a low degree.

112. Ryder Cup submits that SRL's *Key rings (trinkets or fobs); novelty key holders* are accessories or complementary items to the Class 14 goods within its own specification. I accept that they may be made from the same materials as Ryder Cup's goods and they will be sold to the same users. There may be some overlap in trade channels. They have a different purpose and they are not in competition, nor are they complementary. Their method of use is different. I find that they are similar to a low degree.

113. I shall compare SRL's *Sculptures; Statuettes of precious metal; Figurines (statuettes) of precious metal* with Ryder Cup's *Trophies made of precious metals and their alloys*. Both parties' goods share the same physical nature. The primary purpose of Ryder Cup's goods is to commemorate an achievement, as trophies may be given

to the winners of, in particular, sporting competitions. They may also have a decorative purpose. SRL's goods are primarily decorative but a trophy could take the form of a sculpture or statuette. The users are the same and I consider that there will be some overlap in trade channels. The goods are not complementary. I find that there is at least a medium degree of similarity between the goods.

114. SRL's *Medals; commemorative medals of precious metal* are made from the same metals used for jewellery. Their purpose is to identify a person, their rank or a particular achievement, so this differs from that of jewellery, the purpose of which is to adorn the person in an aesthetic way. Their method of use is the same, as they are worn on the body, and there may be some overlap in trade channels. The goods are not in competition, nor are they complementary. I find that they are similar to *Jewellery* to a medium degree.

115. SRL's *Coins* could also be made from the same metals used for jewellery. Their primary purpose is different, as they are used as currency or (if no longer legal tender) are collected as items of historical interest. They may, however, also be worn as part of items of jewellery and so there is some shared purpose and overlap in trade channels. The goods are not in competition, nor are they complementary. I find that they are similar to a low degree.

116. The final goods in Class 14 of SRL's specification are *Watch straps*. These are complementary to Ryder Cup's *Horological instruments* (in so far as that term encompasses "watches"). The straps may be made from a variety of materials, including metals. A watch is necessary for the use of the strap and I consider it likely that the consumer would expect a watch manufacturer to produce straps for its watches. They are, therefore, complementary. The goods will be targeted towards the same users and sold through the same retailers. I find that the goods are similar to at least a medium degree.

Class 25

117. All the goods in Class 25 of the specification of Application No. 3516813 are included in Ryder Cup's broader *Clothing; footwear; headgear* and so are *Meric* identical.

Class 35

118. For completeness, I note here that the following text appears at the end of the list of services in this Class: "*the aforementioned services all available via any communications media*". However, nothing turns on this.

119. The first services I shall consider are *Advertising, marketing and promotional services; promotion of goods and services of third parties; advertising services related to golf equipment and golf events; advertising for sports events; television advertising; radio advertising; advertising via the internet; rental of advertising space on the internet*. Ryder Cup submits that where the services are offered in relation to goods or services covered by its own mark, the contested services are similar "*because they are offered in connection to, and are instrumental to the sale of, those goods/services.*"⁴⁹ I must, however, look at the core meanings of the terms. The nature and purpose of the goods and services differ, as do the trade channels. The goods and services are not in competition. Nor do I find them to be complementary, as the average consumer would not think that the same undertaking is providing *Advertising, marketing and promotional services; promotion of goods and services of third parties* and the goods or services being advertised or promoted. While I do not discount the possibility that there may be some shared users, this is not enough for me to find that the services are similar.

120. Ryder Cup makes the following submissions in relation to SRL's *Promotion of sports competitions and events* and *Promotion of goods and services through sponsorship of sports events*:

⁴⁹ Written submissions of 4 March 2021, Annex A, page 2.

“The Opponent’s [Ryder Cup’s] specification covers sporting activities and the running of golf tournaments. The promotion of sports competitions and events is similar because the target customers would be the very organisers of sports competitions and the services would be offered in the same context. Moreover, at sports competition merchandise (such as clothing and sport equipment) is sold as well as food and drink and hospitality are offered. We also note that sponsors and sponsorships are a major source of revenue for the Opponent.”⁵⁰

121. It appears to me that what Ryder Cup is saying here is that the providers of the services in its specification (*Sporting activities; Running of golf tournaments*) are the users of SRL’s *Promotion of sports competitions and events*. I can accept this. However, it means that the users of the respective services are not the same, as the users of Ryder Cup’s services are participants and spectators. The trade channels will also be different, as will the nature and purpose of the services. I do not find them to be in competition. While Ryder Cup’s services are essential for the provision of *Promotion of sports competitions and events*, I do not consider that the consumer would believe that they come from the same undertaking. The same reasoning applies in the case of *Promotion of goods and services through the sponsorship of sports events*. I find that these services are dissimilar.

122. I turn now to *Rental of advertising space at golf events*, which I shall compare with Ryder Cup’s *Running of golf tournaments*. The nature and purpose of these services are different, as are the users. The trade channels will also differ. However, I do consider that there is a degree of complementarity between the services. SRL’s services depend on the existence of golf events, including tournaments, and it is possible that an undertaking running such an event would also rent out advertising space at the course. The CJEU stated in *Kurt Hesse v OHIM*, Case C-50/15 P, that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services.⁵¹ I find that there is a low degree of similarity between the respective services.

⁵⁰ *Ibid.*

⁵¹ Paragraph 23.

123. SRL's *Business administration; business management; office functions* comprise the day-to-day functions of running a business, including filing company and tax returns, book keeping, recruitment and procurement of goods and services. I find that the services differ in nature, purpose and trade channels from any of Ryder Cup's goods or services. There is no competition or complementarity. There may be some overlap in user, as SRL's services could be purchased by businesses in any sector. However, this is insufficient for me to find that there is any similarity.

124. The next group of services is *Advertising, sponsorship (promotion and marketing services) and business management of a professional video gaming sports team and persons who participate in competitions and events for computer games; advertising, sponsorship (promotion and marketing) of competitions and events for computer games*. Ryder Cup submits that:

“The Opponent's computer games would be instrumental to the activities for which the Applicant's services would be offered. Moreover, computer games and video games fall under the description of 'e-sports', which are widely considered 'sports' or 'sporting activities'. Therefore the respective goods and services would be offered to potential customers in the same field and are complementary, so they must be considered similar.”⁵²

125. SRL's services relate to advertising, sponsorship, promotion and marketing of participants in e-sports events and competitions and those events and competitions themselves. The purpose of these services is to increase the public's awareness of the events and those who compete in them. The users will be the organisers of the events or the owners of the teams or the individual participants themselves. The purpose and use are therefore different from those of Ryder Cup's *Computer games*. The trade channels and nature of goods and services also differ. There is no competition between them. I do not consider that there is any complementarity in the trade mark sense. I find RSL's services dissimilar to *Computer games*.

⁵² Written submissions of 4 March 2021, Annex A, page 3.

126. I shall consider whether a comparison with *Sporting activities* puts Ryder Cup in a better position. First, I note that it has provided no evidence to support its submission that “e-sports” would be widely considered to be “sports” or “sporting activities”. I have already found that the average consumer would understand the core meaning of “sport” to involve physical exertion. The purpose of Ryder Cup’s services is to enable individuals or a team to compete against others in a physical activity. The purpose, method of use and users are different from those of SRL’s services. The trade channels differ. I do not consider that there is any complementarity between the services. They are also dissimilar.

127. The last group of Class 35 services is *Retail services in relation to clothing, footwear, headgear, games, toys and playthings, video game apparatus, computer games apparatus, electronic games, sports games, golf games, handheld electronic games, board games, toy golf sets, sporting articles and equipment, golf equipment, golf accessories; the bringing together, for the benefit of others, of a variety of goods namely clothing, footwear, headgear, games, toys and playthings, video games apparatus, computer games apparatus, electronic games, sports games, golf games, handheld electronic games, board games, toy golf sets, sporting articles and equipment, golf equipment, golf accessories, enabling consumers to conveniently compare and purchase those goods.*

128. The goods that are the subject of the retail services are all covered by terms in RCE’s specification. The similarity of goods and the retail of those goods has been considered in the following case law: *Oakley, Inc v OHIM*, Case T-116/06; *Sanco SA v OHIM*, Case C-411/13 P; *Assembled Investments (Proprietary) Ltd v OHIM*, Case T-105/05, which was upheld on appeal in *Waterford Wedgwood Plc v Assembled Investments (Proprietary) Ltd*, Case C-398/07 P. These cases were helpfully reviewed by Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Tony Van Gulck v Wasabi Frog Ltd*, BL O/394/14. It is clear from this case law that where one party’s retail services are to be compared to the other party’s goods, the retail services will be different in nature, purpose and method of use from those goods. Despite these differences, where there is some complementarity and shared trade channels, retail services *may* be similar to goods. It is equally clear that complementarity alone will not suffice for a finding of similarity, where from the consumer’s point of view, the retail

services of the applicant would not normally be offered by the same undertaking as the goods. Furthermore, I note that I must not treat the retail services as goods, although consideration of the retail services normally associated with the goods should be made. In my view, the average consumer would expect the retail services and the goods to be offered by the same undertaking and so I find that they are similar to a low to medium degree.

Class 36

129. I understand “charitable fund raising” to refer to the process of gathering contributions, typically money, by either requesting donations from individuals, businesses, crowd funding, etc. or by carrying out a task or activity to raise money. Ryder Cup submits that such tasks or activities could include entertainment or hospitality events and so SRL’s services are complementary to its own services in Class 41. It refers me to the evidence of James Pinney which sets out some of the events with which Ryder Cup has been involved and which seek to raise funds for a variety of charities.

130. I have already cited the judgment of the GC in *Boston Scientific*, where it considered the meaning of complementarity. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as “complementary” and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC, sitting as the Appointed Person, noted in *Sandra Amalia Mary Elliot v LRC Holdings (LUV/LOVE Trade marks)*, BL O-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does

not follow that wine and glassware are similar goods for trade mark purposes.”⁵³

131. He continued:

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”⁵⁴

132. I consider that there is a degree of complementarity between the services and agree that the average consumer will be accustomed to seeing entertainment and hospitality events put on in order to raise money for a charitable purpose. I can find no other similarity between them, and I note that Ryder Cup has not made any arguments other than those based on complementarity. I find that SRL’s Class 36 services are similar to a low degree to Ryder Cup’s *Entertainment services*.

Class 41

133. For completeness, I note here that the following text appears at the end of the list of services in this Class: “*the aforementioned services all available via any communications media*”. However, as with Class 35, nothing turns on this.

134. In paragraph 87 above, I found that, if I am wrong about the identity of *Information services concerning ... entertainment* and *Entertainment services*, they are highly similar.

135. In paragraph 88 above, I found *Cultural activities; organisation of ... cultural events and activities; provision of ... cultural activities all relating to the professional video gaming industry* to be included in the broad term *Entertainment services*, but noted that I would also consider them under this ground in case that finding is wrong. The nature of the services and their purpose is similar, and they are also aimed at the same users. There is likely to be an overlap in trade channels and, if they are not

⁵³ Paragraph 18.

⁵⁴ Paragraph 20.

identical services, they will be in competition with each other. If they are not identical, they are highly similar.

136. I came to the same finding in paragraph 89 regarding a comparison between SRL's *Organisation of exhibitions* and Ryder Cup's *Providing information in relation to golf, golf tournaments and golf competitions*.

137. Ryder Cup submits that SRL's *Organisation of ... video gaming events, tournaments and competitions* is similar to its computer game software, as that software would be essential to the running of such events. Ryder Cup's specification includes the terms *Computer game programs* and *video games*. I shall compare SRL's services with the second of these. The purposes, method of use and nature of the goods and services are different, but they will target the same end users. Ryder Cup's goods are essential for the delivery of SRL's services and the average consumer is likely to think that they come from the same undertaking, with the business responsible for a particular game running events and competitions to promote its use. Therefore, I find that there is complementarity between the goods and services. Overall, I consider there to be a medium degree of similarity between them. The same rationale applies in the case of *Organisation of Electronic sports ... events, tournaments and competitions* as I understand that "electronic sports" refers to competitive video gaming.

138. I shall also compare SRL's *Provision of training [and] sporting ... activities all relating to the professional video gaming industry* to Ryder Cup's *video games*. In my view, the same reasoning applies as above and I find that the goods and services are similar to a medium degree.

139. Ryder Cup has made no specific submissions about the similarity of SRL's *Audio and video recording services* to any of its own goods or services. I shall compare them to *Entertainment services* as I consider this to be Ryder Cup's best case. The users of SRL's services are the undertakings that wish to provide audio-visual content to their own customers, who would be the users of Ryder Cup's *Entertainment services*. The purpose and nature of the services differ and if there is any overlap in trade channels it is small. However, SRL's services are essential for the use of relevant *Entertainment*

services and the same undertaking may provide the recording services and distribute the content to the end-user. Consequently, the services are complementary. I find that *Audio and video recording services* are similar to *Entertainment services* to a medium degree.

140. Ryder Cup submits that SRL's *Issuing of tickets for events, including golf sports events; reservation of entry tickets to sports or entertainment events; ticket reservation services for entertainment, sporting and cultural events* are

“... activities ancillary to entertainment services and to other services in the Opponent's specification. As such, they would be targeting the same customers and would be provided in the same context. Therefore, they must be considered identical.”⁵⁵

141. I agree that SRL's services would be ancillary to Ryder Cup's entertainment services and sporting activities. However, I do not think that this necessarily makes them identical. SRL's services are provided to customers wishing to purchase tickets to events. They also include services supplied to any promoters and/or organisers of such events if they prefer to outsource the task to a third party. Consequently, those services may be supplied either by the third party or by the event organiser or promoter. The purpose of SRL's services is to supply an audience for the event and enable the prospective audience member to obtain tickets. The purpose of Ryder Cup's services is to entertain the customer. There will be some shared trade channels. There is a degree of complementarity because the event organiser needs a means of selling tickets and the consumer would be used to seeing the services provided by the same undertaking. I find that there is at least a medium degree of similarity between the services.

Summary

142. I have found the following contested goods and services to be identical or similar to goods and services in RCE's specification:

⁵⁵ Written submissions of 4 March 2021, Annex A, page 4.

Identical

Class 14

Jewellery; horological and chronometric instruments; pins (jewellery); brooches (jewellery); tie pins; tie clips; amulets (jewellery); rings (jewellery); bracelets (jewellery); cufflinks; necklaces (jewellery); medallions (jewellery); medallions not of precious metal; horological and chronometric instruments including watches; clocks; wristwatches; electric clocks; pendulums (clock); stopwatches.

Class 25

Article of outer clothing; sportswear; leisurewear; training clothing; tracksuits; training pants; sweatpants; anoraks; tops; polo shirts; vests; knitwear; jerseys; pullovers; sweaters; hooded tops; cardigans; waistcoats; pants; ties; mittens; scarves; wristbands; shoes; boots; sandals; slippers; training shoes; sun visors; belts; aprons; uniforms; articles of clothing, footwear and headgear for babies and children; bibs; baby boots.

Highly similar

Class 9

... Frames [and] lenses for use with spectacles.

Class 41

... Cultural activities; organisation of ... cultural events and activities; organisation of exhibitions; provision of ... cultural activities all relating to the professional video gaming industry; information services concerning ... entertainment.⁵⁶

Similar to at least a medium degree

Class 14

Sculptures; statuettes of precious metal; figurines (statuettes) of precious metal; watch straps.

⁵⁶ If not identical.

Class 41

Issuing of tickets for events, including golf sports events; reservation of entry tickets to sports or entertainment events; ticket reservation services for entertainment, sporting and cultural events

Similar to a medium degree

Class 9

Range finders; laser range finders; distance recording apparatus; cameras for recording and analysing golf swings; golf simulators.

Class 14

Medals; commemorative medals of precious metal.

Class 41

Provision of training [and] sporting ... activities all relating to the professional video gaming industry; organisation of Electronic sports and video gaming events, tournaments and competitions; audio and video recording services.

Similar to a low to medium degree

Class 9

Audiovisual teaching apparatus; apparatus for recording, transmission, processing and reproduction of sound, images or data relating to golf.

Class 35

Retail services in relation to clothing, footwear, headgear, games, toys and playthings, video game apparatus, computer games apparatus, electronic games, sports games, golf games, handheld electronic games, board games, toy golf sets, sporting articles and equipment, golf equipment, golf accessories; the bringing together, for the benefit of others, of a variety of goods namely clothing, footwear, headgear, games, toys and playthings, video games apparatus, computer games

apparatus, electronic games, sports games, golf games, handheld electronic games, board games, toy golf sets, sporting articles and equipment, golf equipment, golf accessories, enabling consumers to conveniently compare and purchase those goods.

Similar to a low degree

Class 14

Precious metals and their alloys; precious and semi-precious stones; key rings (trinkets or fobs); novelty key holders; coins; semi-precious stones; gems (precious stones).

Class 35

Rental of advertising space at golf events.

Class 36

Charitable fund raising.

143. I have found the following services to be dissimilar:

Class 35

Advertising, marketing and promotional services; promotion of sports competitions and events; promotion of goods and services through sponsorship of sports events; promotion of goods and services of third parties; advertising services related to golf equipment and golf events; advertising for sports events; television advertising; radio advertising; advertising via the internet; rental of advertising space on the internet; business administration; business management; office functions; Advertising, sponsorship (promotion and marketing services) and business management of a professional video gaming sports team and persons who participate in competitions and events for computer games; advertising, sponsorship (promotion and marketing) of competitions and events for computer games.

144. In *eSure Insurance Limited v Direct Line Insurance Plc*, [2008] EWCA Civ 842 CA, Lady Justice Arden stated that:

“... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”⁵⁷

145. Therefore, the opposition to the word mark based on UKTM No. 3409719 fails with respect to the Class 35 services listed in paragraph 143 above.

Average consumer and the purchasing process

146. In *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors* [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

“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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”⁵⁸

147. For Ryder Cup, Ms McFarland submitted that the average consumer of the goods and services in play would be a member of the general public who would see the mark on TV, social media and the internet and hear it used on the radio. They might also receive word-of-mouth recommendations.⁵⁹ Mr Fiddes for SRL submitted that the

⁵⁷ Paragraph 49.

⁵⁸ Paragraph 60.

⁵⁹ Skeleton argument, paragraph 48.

consumers for SRL's goods and services would be different from those of Ryder Cup's goods and services, with the possible exception of some retail services in Class 35.⁶⁰

148. I agree that for the majority of the goods and services for which I found identity or similarity the average consumer would be a member of the general public who would both see and hear the mark used. For SRL, these goods and services include the following: *Frames [and lenses] for use with spectacles; range finders; laser range finders; the class 35 retail services; Cultural activities; Organisation of ... cultural events and activities; organisation of exhibitions; provision of ... sporting and cultural activities all relating to the professional video gaming industry; organisation of Electronic sports and video gaming events, tournaments and competitions; information services concerning ... entertainment.* In my view, they are likely to make their choice of entertainment and sport-related services or the Class 9 goods after seeing advertisements or browsing the internet and so visual aspects of the mark would be more significant. They may also receive word-of-mouth recommendations and/or discuss prospective purchases with sales staff, so I must not ignore the aural element of the marks. The price of the goods will vary, as will the frequency with which they are purchased. Overall, I consider that the average consumer of these goods and services (and those of Ryder Cup that are similar) will pay a medium degree of attention when purchasing them.

149. The general public will also purchase *Audiovisual teaching apparatus; Distance recording apparatus and cameras for recording and analysing golf swings; golf simulators; apparatus for recording, transmission, processing and reproduction of sound, images or data related to golf;* and the ticket services in Class 35. The purchasing process will, in my view, be very similar to that discussed above and I find that this average consumer would pay a medium degree of attention. However, I also consider that these goods and services would be purchased by businesses and professionals, such as golf coaches in the case of the electronic aids to help improve golf performance. These goods and services will have a significant impact on the quality of the services that the businesses can deliver to their customers, and so I take

⁶⁰ Skeleton argument, page 12.

the view that they will be paying a degree of attention that is slightly higher than medium.

150. Finally, there is also a group of goods and services that I believe would only, or predominantly, be purchased by businesses or professionals. These are the *Provision of training ... activities all relating to the professional video game industry; Audio and video recording services* in Class 41 and the *Rental of advertising space at golf events* in Class 35. The purchasing process is likely to be largely visual, although I do not discount the possibility of word-of-mouth recommendations or advice. In the case of the *Rental of advertising space at golf events*, the average consumer will consider issues such as attendance figures and whether the events receive any television coverage. The average consumer will pay a slightly higher than medium degree of attention for the same reasons as I have given in the previous paragraph.

Comparison of the marks

151. It is clear from *SABEL* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo* that:



“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”⁶¹

152. It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give

⁶¹ Paragraph 34.

due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

153. The respective marks are shown below:

Contested marks	Earlier mark
<p data-bbox="284 528 539 562">SAMUEL RYDER</p> <p data-bbox="284 580 531 613">("the word mark")</p>  <p data-bbox="284 792 592 826">("the signature mark")</p>  <p data-bbox="284 1066 592 1099">("the figurative mark")</p>	<p data-bbox="876 528 1131 562">SAMUEL RYDER</p>

The word mark

154. I have already found the word mark to be identical to the earlier mark shown above.

155. The average consumer will recognise "SAMUEL" as a first name that is fairly common in the UK. They will also understand "RYDER" to be a surname. The two words therefore hang together to form a unit and the overall impression of the mark lies in that unit.

The signature mark

156. The contested mark consists of the words "SAMUEL RYDER" presented as a signature. In my view, the surname "RYDER" is clearly identifiable. The first name is less clear. However, I consider that a significant proportion of consumers will read this as "SAMUEL". For these consumers, the mark would form a unit, as with the word

mark. It would be perceived as the signature of an individual named “Samuel Ryder”. For consumers who cannot decipher the first word, the word “RYDER” will play the largest part in creating the overall impression of the mark, as this is more legible. The signature stylisation also contributes to the overall impression of the mark.

157. The stylisation is the sole point of visual difference between the marks. I find them to be visually highly similar. The marks are aurally identical. Conceptually, both will bring to mind an individual by the name of “SAMUEL RYDER” and so are identical.

The figurative mark

158. The contested mark is a composite mark consisting of the words “SAMUEL RYDER” in large capital letters, each on its own line, with the words “CHARITABLE TRUST” in very small capital letters beneath them. To the left of the words is a device which Ryder Cup submits represents a dandelion seedhead. Even if the average consumer does not see it in this way, I believe they will see a plant. The device is in greyscale. The average consumer tends to view the verbal elements as more distinctive than figurative elements: see *Wassen International Ltd v OHIM (SELENIUM-ACE)*, Case T-312/03, paragraph 37. I consider that to be the case here, and it is “SAMUEL RYDER” that carries the message about the origin of the goods and services, given its size and the descriptive nature of “CHARITABLE TRUST”. The latter phrase informs the consumer about the type of organisation using the mark. “SAMUEL RYDER” plays the greater role in creating the overall impression of the mark, with a lesser role played by the device. I consider that the remaining words will play a very small, if any, part.

159. Ryder Cup submits that the marks are highly similar. The entirety of the earlier mark is contained in the contested mark, but I cannot ignore the other elements. Overall, I find that they are visually similar to a medium degree.

160. When spoken, the contested mark is longer, having an additional five syllables (“CHAR-EE-TAH-BUL-TRUST”), thus doubling the length. However, the first five are identical. I find the marks to be aurally similar to a medium degree.

161. The contested mark contains conceptual content that is additional to that provided by “SAMUEL RYDER”. There is the plant device. The words “CHARITABLE TRUST” will convey the purpose of the undertaking using the mark. I find that the marks are conceptually similar to a low degree.

Distinctive character of the earlier mark

162. In *Lloyd Schuhfabrik Meyer*, 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 Alternberger* [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).”

163. Registered trade marks possess varying degrees of inherent distinctive character. Marks that are suggestive of, or allude to, a characteristic of the goods or services would sit at the lower end of a spectrum of distinctiveness, while those marks that are invented words with no allusive qualities would sit towards the top.

164. The earlier trade mark “SAMUEL RYDER” would be recognised by the average consumer as being a person’s name. I think it fair to conclude, even in the absence of evidence, that Samuel is a fairly common forename in the UK; of itself, it has a below average degree of distinctive character. I do not consider that “Ryder” is a particularly unusual surname in the UK. Considering the mark as a whole, I find it to have an average degree of inherent distinctive character. Ryder Cup has not provided any evidence of use of this mark for the goods and services that I have found to be similar to the goods and services still at issue. I therefore find that the average degree of inherent distinctive character of this earlier mark has not been enhanced through use.

Conclusions on likelihood of confusion

165. There is no scientific formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where a number of factors need to be borne in mind. I must also take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services or vice versa. I keep in mind 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 they have in their mind.

166. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting 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 recognised 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.”⁶²

The word mark

167. As the marks are identical, it is my view that the average consumer, irrespective of the degree of attention paid, would be likely to mistake one mark for the other and hence be directly confused, even where there is only a low degree of similarity between the goods and services.

168. The opposition under section 5(2)(a) is successful in relation to the goods and services listed in paragraph 142 above.⁶³ It fails in relation to the Class 35 services listed in paragraph 143.

Signature mark

169. The earlier mark is, as I have noted, a word mark. In *LA Superquimica v EUIPO*, Case T-24/17, the GC held that such plain word marks protect the word or words contained in the mark in whatever form, colour or typeface.⁶⁴ I remind myself that I found that a significant proportion of consumers would perceive the signature to consist of the same words that make up the earlier mark. Therefore, I find that they would be directly confused as to the origin of the goods and services. Where the proportion of the relevant public likely to be confused is significant enough to warrant the intervention of the court or the tribunal, a likelihood of confusion may be found: see *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, paragraph 34. I believe that to be the case here. I find that there is a likelihood of direct confusion even where there is only a low degree of similarity between the goods and services.

⁶² Paragraph 16.

⁶³ Except where those goods and services listed are not included in the specification, e.g. the Class 14 goods.

⁶⁴ Paragraph 39.

170. The opposition under section 5(2)(b) is successful in relation to all the goods and services in the application.

Figurative mark

171. The differences between the marks are such that, in my view, the average consumer would not mistake one for another and be directly confused. I shall therefore consider whether there is a likelihood of indirect confusion. In *LA Sugar*, Mr Iain Purvis QC gave a number of examples of occasions when this might occur:

“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).⁶⁵

172. This list is non-exhaustive, as Arnold LJ subsequently acknowledged in *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, paragraph 12.

⁶⁵ Paragraph 17.

173. As the figurative mark is also a composite mark, I remind myself of the comments of Arnold J (as he then was) in *Whyte and Mackay Ltd v Origin Wine UK Ltd & Anor* [2015] EWHC 1271 (Ch) where he considered the impact of the CJEU's judgment in *Bimbo* on the court's earlier judgment in *Medion*. He said:

“18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks – visually, aurally and conceptually – as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meaning of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of

confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

174. It is my view that “SAMUEL RYDER” plays an independent distinctive role in the contested figurative mark. When the average consumer sees goods or services sold under that mark, I believe that they will assume they come from a charitable arm of the proprietor of the earlier mark and are intended to raise funds for charitable purposes. I find that there is a likelihood of indirect confusion.

175. The opposition under section 5(2)(b) is wholly successful.

Section 5(2)(b): the oppositions based on the Ryder Cup marks

Proof of Use of the Earlier Marks

176. SRL put RCE and RCL to proof of use of EUTM Nos. 684829 and 4476164, both of which are **RYDER CUP** word marks. It did so in the context of the oppositions against all three of its applications.

177. Section 6A of the Act is as follows:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section ‘the relevant period’ means the period of 5 years ending with the date of the application for registration mentioned in subsection

(1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

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

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) 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.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be

construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) 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.”

178. Section 100 of the Act provides that:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

179. The relevant periods are as follows:

Application	Relevant Period	Goods and Services subject to Proof of Use
3414350	17 July 2014 – 16 July 2019	<u>EUTM No. 684829</u> Classes 9, 14, 25, 28, 41. <u>EUTM No. 4476164</u> Classes 35, 43.
3414361	17 July 2014 – 16 July 2019	<u>EUTM No. 684829</u> Classes 9, 14, 25, 28, 41. <u>EUTM No. 4476164</u> Classes 35, 43.
3516813	29 July 2015 – 28 July 2020	<u>EUTM No. 684829</u> Classes 9, 14, 25, 28, 41. <u>EUTM No. 4476164</u> Class 36

180. Both of these earlier marks are EUTMs and so the EU is the relevant territory in which use must be shown.

181. The case law on genuine use was summarised by Arnold J (as he then was) in *Walton International Limited v Verweij Fashion BV* [2018] EWHC 1608 (Ch):

“114. *The law with respect to genuine use.* The CJEU has considered what amounts to ‘genuine use’ of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundersvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816] [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at

[36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to

provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].

182. In his first witness statement, Mr Hills summarises the activities of Ryder Cup under the RYDER CUP EUTMs as follows:

“9. In the last few decades, the operation of the Ryder Cup tournament by RCE (and its related merchandising and commercial activities under the trade mark RYDER CUP) has become a multi-million pound business. RCE’s commercial activities under the RYDER CUP trade mark are not limited to the days on which the Ryder Cup tournament takes place or to the territory where the Ryder Cup takes place. The commercial activities of RCE under the mark RYDER CUP go well beyond the organisation and televising of the Ryder Cup tournament itself, reaching into merchandise (Apps, sunglasses, clothing, footwear and headgear, games and sporting articles, and many other items) and the organisation of travel, accommodation and hospitality.

10. In particular, in the four years leading up to a Ryder Cup tournament in Europe, in addition to negotiating with the Host Country and Venue and dealing with all aspects of the organisation of the tournament itself, RCE is active in negotiating sponsorship and broadcasting deals, promoting the tournament and maintaining relationships with the press, promoting the sale of, and selling, tickets and hospitality packages for the tournament, signing licencing deals for the production of branded merchandising and selling branded merchandising items.

11. Even when the tournament takes place on US soil, RCE continues its commercial activities in Europe.”

183. The table below shows annual turnover under the mark RYDER CUP in Europe.⁶⁶

YEAR	TURNOVER
2010	£35,058,332
2011	£1,828,952
2012	£12,471,989
2013	£2,052,320
2014	£53,743,234
2015	£1,402,791
2016	£12,972,717
2017	£3,310,058
2018	£73,597,528

184. It will be seen that the turnover is significantly higher when the tournament is held in Europe. Mr Hills estimates that 20-30% of the turnover would originate from UK sources and relate to UK activity, but he does not state the basis on which he makes this assessment.

185. The numbers of spectators for the most recent tournaments hosted in Europe are shown are as follows: 147,000 in 2002 (The Belfry, England); 260,000 in 2006 (The K

⁶⁶ Paragraph 12.

Club, Ireland); 244,000 in 2010 (Celtic Manor, Wales); 239,611 in 2014 (Gleneagles, Scotland); and 273,090 in 2018 (Le Golf National, France).⁶⁷

186. The table below shows the marketing expenditure for the promotion of the tournament, tickets, hospitality packages and branded merchandise.⁶⁸

YEAR	EXPENDITURE
2010	£452,456
2011	£161,277
2012	£238,775
2013	£317,615
2014	£648,130
2015	£239,896
2016	£302,389
2017	£206,322
2018	£726,813

187. Mr Hills states that a significant proportion relates to expenditure in the UK. As an example, £100,000 was spent in the UK in June and July 2014 and £160,000 in 2018. Marketing and promotional activities addressed to the UK public included e-mailshots, monthly newsletters, advertising on various websites and social media and in print, billboard displays, radio advertising, and a promotional stand at another golf tournament.⁶⁹

188. Mr Fiddes submitted that the evidence did not show that the marks had been genuinely used for the goods and services RCE and RCL sought to rely on. There were three main reasons for this: first, that the evidence did not provide sufficient detail to be able to determine in respect of exactly what goods and services the marks had been used; secondly, that the evidence did not show that any use that there might have been, was made by the owner of the relevant trade mark or with its consent; and thirdly, that the mark used was not an acceptable variant of the registered mark. I shall deal with the first and third of these points in the analysis that follows. In relation to the second point, I note that at the start of my decision, I outlined the corporate structure of Ryder Cup. The proprietor of EUTM 684829 (RCL) is wholly owned by RCE, which

⁶⁷ Paragraph 19. The list in Mr Hills' witness statement gives 2016 as the year the tournament was held in France but, as is apparent from other parts of the evidence, this is a typographical error.

⁶⁸ Paragraph 15.

⁶⁹ Paragraph 18.

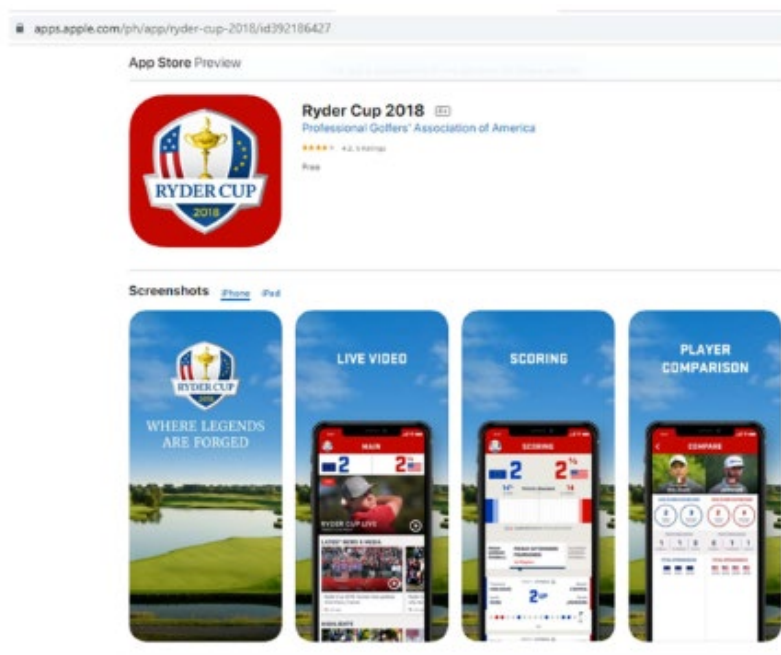
is responsible for putting on the golf tournament in Europe. Consequently, I find that, at the least, use of the EUTM will have been with the consent of the proprietor.

189. Ryder Cup has been put to proof of use for a relatively long list of goods and services. I shall go through these class-by-class. However, where possible, I will aim to avoid repetition.

Class 9

Computer software and programmes

190. Exhibits RH2 and RH2A contain website screenshots showing a downloadable software application which allows users to access news, live scoring, live radio and video highlights of the current tournament. By its very nature, then, this application would be made available around the time of each of the contests. Given that Ryder Cup is responsible for the tournament only when it is held in Europe, it will be the 2018 application that is relevant for the present purposes. The image below shows that application available to be downloaded on the Apple App Store.



191. The copyright owners are listed at the bottom of the image as The PGA of America, Ryder Cup Limited and Turner Sports. I remind myself that the earlier mark that covers the Class 9 goods, and that is subject to proof of use, is owned by RCL.

192. Mr Hills says that the download data for 2018 was as follows:⁷⁰

2018 TW (Web/Mobile/App)	Final Total	USA	Europe
Unique Users	5.7mm		
Visits	16.6mm		
Pageviews	68.4mm		
Live Stream Starts	3.2mm		
Live Streaming (min)	30.4mm		
IOS App Downloads	310k	115k	179k
Android App Downloads	123k	40k	70k

193. Mr Fiddes drew my attention to the fact that these figures referred to Europe, rather than the EU, and noted that a geographical definition of “Europe” was the territory west of the Ural Mountains.⁷¹ This would include a number of countries, and a significant population, not in the EU.

194. I have considered whether there is anything in the evidence that would enable me to make any reasonable inferences as to the number of downloads in the EU. Analytics in Exhibit RH41 show that during the relevant period 8 or 9 of the countries with the largest number of Ryder Cup Europe’s Facebook followers were in the EU, accounting for around 77% of the total. Only two non-EU countries in Europe are shown as the list goes on: Switzerland and Iceland. The data for Instagram shows a similar picture, although this time EU Member States account for 7 out of the top 10 locations for followers.⁷² In addition, this century the European tournament has been held three times in the UK, once in Ireland and once in France, and nowhere outside the EU. I consider it reasonable therefore to infer that during the relevant period a significant proportion of the interested European public resided in the EU. There were around 249k downloads of the app in Europe in 2018. Even if only half were from EU residents, that would amount to around 125k downloads. There is nothing in the

⁷⁰ Paragraph 26.

⁷¹ Transcript, page 40.

⁷² Exhibit RH42.

evidence to indicate whether this is a large number of downloads for an app, but I take account of the fact that this was an app designed to provide news and coverage of a specific, time-limited event, and that there is no *de minimis* level of genuine use.

195. I note that the app is shown as being free to the end user, but that is not unusual in the world of apps. The information on the App Store does not state that it is available as a reward for buying other goods or services or present it as a promotional exercise to encourage the consumer to buy tickets to the event.

196. The next question I must consider is whether the use shown is acceptable. Mr Fiddes submitted that it was not. The mark is shown on a banner across a shield device, in the centre of which is a trophy. On either side of this trophy are the flags of the US and Europe. Below the banner can be found the date “2018”. In the image below, the background is red, but I am not considering this to be part of the mark as used, as the shield appears elsewhere on differently coloured backgrounds.⁷³



197. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, the CJEU said:

“31. It is true that the ‘use’ through which a sign acquires distinctive character under Article 7(3) of Regulation No. 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish

⁷³ The image is taken from Exhibit RH2, page 4.

'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No. 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)."

198. On seeing this mark, the average consumer would, in my view, assume that the trophy is the Ryder Cup and that the mark comes from the entity responsible for organising the competition. The words "RYDER CUP" would be perceived as indicative

of the origin of the goods supplied under the mark and so I find that this is an acceptable variant of the RYDER CUP mark as registered.

199. It is my view that genuine use has been made of the mark in respect of the app, but now I must decide what would be a fair specification. In *Euro Gida Sanayi ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, summed up the law as follows:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”⁷⁴

200. In *Property Renaissance t/a Titanic Spa v Stanley Dock Hotel Ltd t/a Titanic Hotel Liverpool & Ors* [2016] EWHC 3103 (Ch), Carr J summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

⁷⁴ Pages 10-11.

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”⁷⁵

201. The term *Computer software and programmes* is very broad and would encompass software intended for a wide variety of different purposes. It would not be fair for RC to be able to rely on the whole of that term in the light of the use that has been shown. I consider that it is possible to identify *Downloadable application software related to golf matches or golf tournaments* as a distinct subcategory and I find that this constitutes a fair specification.

⁷⁵ Paragraph 47.

Pre-recorded disks and tapes

202. Exhibit RH3 contains images of the cover of DVDs released shortly after the 2014 and 2018 Ryder Cup tournaments. There are also Amazon print outs, which show release dates of 17 November 2014 and 26 November 2018 and reviews from customers based in the UK, France and Germany from the period 2014-2020. The number of reviews is 14 for the relevant period for the oppositions to the word and signature marks and 12 for the relevant period for the opposition to the figurative mark. Both the words “RYDER CUP” and a shield logo containing those words appear on the products. However, it is not clear how many of these products were sold and no turnover figures are given.



203. At the hearing, I noted that the turnover figures did not distinguish between goods. Ms McFarland referred me to the comment of Mr Hills in paragraph 56 of his first witness statement, where he said that it was virtually impossible to file a fully detailed breakdown of sales. I acknowledge that the courts have not identified particular types of documents that must be filed as evidence of use: see *PLYMOUTH LIFE CENTRE Trade Mark*, BL O/236/13, paragraph 22. However, the Appointed Person, Mr Daniel Alexander QC, went on to say that “*By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken*”. What I have described in the above paragraph is the only evidence

relating to sales of pre-recorded disks and tapes. In my view, this falls short of what would be required to show use sufficient to create or maintain a market for such goods.

Sunglasses

204. Exhibit RH2B contains an advertisement dated 19 September 2014 for Ryder Cup special edition Bolt sunglasses. A logo featuring the words can be seen on the left arm.⁷⁶

205. There are also photographs of the goods in a retail environment.⁷⁷ The first dates from 2018, but there is no indication that the goods, or their packaging, bear the RYDER CUP mark. The sunglasses are stocked on the second shelf from the top, with two items displayed on the bottom shelf. The RYDER CUP logo can, in contrast, be seen on the other goods, such as range finders, that are displayed in close proximity to the sunglasses.



206. The second photograph, from 2014, shows the trophy logo on the arm of at least one of the pairs of sunglasses and on all the boxes.

⁷⁶ Page 2.

⁷⁷ Pages 4 and 5.



207. Data from the onsite 2014 Ryder Cup shop shows that 138 pairs of sunglasses from this manufacturer were sold, generating £13,581.⁷⁸ In 2018, 153 pairs of sunglasses were sold at a value of €14,923.21.⁷⁹ There is no evidence to indicate that any sales were made at other points in time.

208. Even in 2018, the sunglasses were sold in a “RYDER CUP” retail outlet. In *Aegon UK Property Fund Limited v The Light Aparthotel LLP*, BL O/472/11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered whether use of a shop or company name in relation to goods and services could constitute genuine use. He said:

“17. ... unless it is obvious, the proprietor must prove that the use was in relation to the particular goods or services for which the registration is sought to be maintained.

18. In *Céline SARL v Céline SA*, Case C-17/06 (*Céline*), the Court of Justice gave guidance as to the meaning of ‘use in relation to’ goods for the purpose of the infringement provisions in Article 5(1) of the Directive. Considering a

⁷⁸ Exhibit RH14A.

⁷⁹ Exhibit RH14B.

situation where the mark is not physically affixed to the goods, the court said at [23]:

‘... even where the sign is not affixed, there is use ‘in relation to goods or services’ within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party.’

19. The General Court has, on more than one occasion, proceeded on the basis that a similar approach applies to the non-use provisions in what is now Article 42 of the European Union Trade Mark Regulation. For example, in *Strategi Group*, Case T-92/09, the General Court said:

‘23. In that regard, the Court of Justice has stated, with regard to Article 5(1) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989, L 40, p. 1), that the purpose of a company, trade or shop name is not, of itself, to distinguish goods or services. The purpose of a company name is to identify a company, whereas the purpose of a trade name or a shop name is to designate a business which is being carried on. Accordingly, where the use of a company name, trade name or shop name is limited to identifying a company or designating a business which is being carried on, such use cannot be considered as being “in relation to goods or services” (*Céline*, paragraph 21).

24. Conversely, there is use “in relation to goods” where a third party affixes the sign constituting his company name, trade name or shop name to the goods which he markets. In addition, even where the sign is not affixed, there is use “in relation to goods or services” within the meaning of that provision where the third

party uses that sign in such a way that a link is established between the sign which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party (see *Céline*, paragraphs 22 and 23).’

20. Those passages must be read together with the general requirements of proof of use in *Ansul* at [43] that there is a genuine use of a trade mark where the mark is used in accordance with its essential function namely to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services.”

209. In *Cactus SA v OHIM*, Case T-24/13, the GC held that the owner of a mark who had used it only as the name of a shop had used the mark “in relation to” the natural plants, flowers and grains sold in the shop, as well as in relation to retail services for those goods. This is because it had demonstrated that the public would link the otherwise unbranded goods to the mark used for the shop and regard the owner of that mark as being responsible for the quality of the goods.

210. There is no evidence to suggest that a link was established between the earlier mark and the sunglasses in 2018, or that the consumer would regard Ryder Cup as being responsible for the quality of the goods. This leaves me with the sale of 138 pairs of sunglasses in 2014. While this is proven commercial use, I do not consider that it would be seen as warranted in the economic sector to maintain or create a share in the European Union market for sunglasses. I find that genuine use of the RYDER CUP word marks is not shown for sunglasses.

Class 14

Jewellery, horological and chronometric instruments; goods of precious metals; cufflinks.

211. Mr Hills states that the photograph below was taken at the site shop at the 2018 Ryder Cup in Paris. It shows a variety of metal items: cufflinks, ball markers, a bag tag,

a picture frame, and what I take to be divot tools, key rings and bracelets. My assumption in the last three cases is confirmed by a printout of the order proposal for jewellery items.⁸⁰ The words “RYDER CUP” are featured in a logo on the bag tag, divot tools and key rings, while the trophy alone can be seen on the cufflinks. There may also be some items at the back of the photograph, but these are not clear. The name “Decayeux” is visible on the front of the display case.



212. Mr Hills describes all these goods as “Ryder Cup branded”. The order proposals show that two logos were suggested for use: the shield that appears on the bag tag, and the trophy that appears on the cufflinks. There is no evidence of use of the word marks on any of the boxes or other packaging.

213. The goods bearing the shield are the bag tag, divot tool, ball marker and key ring. Sales of these goods from the tournament shop were as follows:⁸¹

Item	Number of Units	Sales (€)
Palladium key ring	22	1,456.67
Palladium bag tag	14	1,073.33
Gold bag tag	6	95.00

⁸⁰ Exhibit RH3B.

⁸¹ Exhibit RH14B.

Item	Number of Units	Sales (€)
Gold key ring	6	450.00
Palladium divot tool	3	260.01
Gold divot tool	3	350.01
TOTAL	54	3,685.02

214. The spreadsheet in Exhibit RH14A shows that there were sales of cufflinks and several jewellery items at the 2014 tournament shop. However, there is no evidence that the RYDER CUP marks were used on the products or their packaging. I am therefore left with the goods shown in the table above. As with the sunglasses, I accept that there is commercial use, but that the scale of use shown is insufficient to be warranted to maintain or create a share of the market in *Goods of precious metals*. I find that Ryder Cup has not shown genuine use for the Class 14 goods.

Class 25

Clothing, footwear, headgear; visors [hatmaking]

215. Exhibits RH4-RH8 contain photographs showing various items of clothing on sale at the 2014 and 2018 onsite shops and on the Ryder Cup website in 2014. The specific items are sweatshirts, polo shirts, tops, caps, zip-up jackets and T-shirts. An example is shown below, with the second image a blown-up section of the first photograph.⁸²



⁸² Exhibit RH4.



216. As in the example shown above, most of the clothing in the images bears the words “RYDER CUP” in the shield logo.



217. In Exhibit RH8, there is also an image of golf shoes that Mr Hills says is dated 2014, but the words “RYDER CUP” are not mentioned on the shoes or in connection with them.

218. The spreadsheets in Exhibits RH14A and RH14B contain a large number of entries relating to items of clothing or headgear, with a small number of items of footwear. In my view, there is no evidence of use in relation to *Visors [hatmaking]*. This is because I interpret that term to cover parts of a hat that would be sold to trade customers, rather than visors that are sold as a finished article and worn to protect the wearer’s eyes from the glare of the sun.

219. The goods appear to be sourced from a wide range of suppliers, including the likes of Ralph Lauren and adidas. The images reproduced in the above paragraphs suggest that a significant proportion of the items of clothing bear the RYDER CUP mark, either in words alone or as part of the shield logo that I found to be acceptable use.

220. The 2014 spreadsheet extends to 92 pages and records £5.027 million of sales. The majority of sales concern clothing and headgear. The table containing 2018 data is 31 pages long. Mr Hills states that turnover amounted to €7,895 million. Again, the majority of the sales concern clothing and headgear. I consider that genuine use has been made of the mark for goods that fall into these categories.

221. The evidence shows a range of different types of headgear: caps, beanies and visors. I consider that *Headgear* would be a fair specification for these goods. In terms of clothing, it is my view that *Casual clothing; Leisure clothing* would be a fair specification, encompassing the range of different items that are shown in the evidence.

Class 28

Games and playthings

222. The photograph below shows teddy bears on sale in the onsite shop at the 2014 tournament at Gleneagles. The shield logo can be seen on the bears' clothing:⁸³



223. Just over 1000 teddy bears were sold, generating over £21,000 in revenue.⁸⁴ No games or playthings appear to have been sold by the onsite shop in 2018 and I have no evidence of any sales at any time outside the few days on which the Gleneagles tournament was taking place. In my view, this scale and duration of use is insufficient to create or maintain a share in the market for either games and playthings, or even teddy bears, within the EU. Ryder Cup has not shown genuine use of the mark for these goods.

Sporting articles

224. Photographs from the 2014 and 2018 onsite shops show a variety of golf-related articles for sale, all bearing the shield logo containing the words "RYDER CUP", as seen in the image reproduced below.⁸⁵ These goods include golf balls, tees, pitchforks, ball markers, covers for golf club heads, golf gloves and golf bags.

⁸³ Exhibit RH9, page 3.

⁸⁴ Exhibit RH14A.

⁸⁵ Exhibit RH9, page 4.



225. I have combed through the spreadsheets in Exhibits RH14A and RH14B to try to estimate the value of the sales of these goods. My findings are recorded in the table below. However, there are some items on the spreadsheets that I have not been able to identify. For example, the figures for golf bags include goods described as “wheeled bags”, “caddie bags”, “cart bags” and “stand bags”. I have not included other bags.

Goods	Value of Sales in 2014 (£)	Value of Sales in 2018 (€)
Golf balls	75,325.10	162,356.99
Ball markers	107,698.10	28,059.07
Pitchforks	37,237.50	12,816.65
Sets containing a selection from the following: balls, ball markers, pitchforks, tees	64,636.00	173,165.94
Golf gloves	7,486.00	6,444.53
Golf club covers	37,087.00	102,773.35
Golf bags	8,472.00	5,029.58
TOTAL	337,941.70	490,646.11

226. The evidence also indicates that some of these goods were available from the online shop. Exhibit RH11 contains a screenshot which Mr Hills states is from 2016 and which shows a pitchfork offered for sale.

227. Taking the evidence as a whole, I consider that RCE has made genuine use of the RYDER CUP marks for a variety of sporting articles associated with golf. I do not

consider that it would be fair to limit the specification to only those items shown in the evidence. To my mind, a fair specification would be *Golf equipment and accessories*.

Class 35

The bringing together for the benefit of others, a variety of goods, enabling customers conveniently to view and purchase those goods in retail outlet or through interactive electronic platforms, or via mail order catalogues, or via websites, providing audio and video recordings, recorded tapes, discs, cassettes and CD's, recorded CM-ROM's, DVDs and other recorded magnetic and opto-magnetic data carriers, non-printed publications relating to golfers and to golf, clothing, footwear, headgear, including clothing, footwear, headgear for sport and clothing, footwear, headgear for golf, games, toys and playthings, gymnastic and sporting articles and sports equipment, golfing articles, golf apparatus and equipment, golf bags, golf clubs, golf gloves, golf tees, golf balls.

228. I have already referred to the shops that are set up during the tournament. The words RYDER CUP are shown in the logo both inside and outside the shop, as seen in the photographs below from 2014.⁸⁶

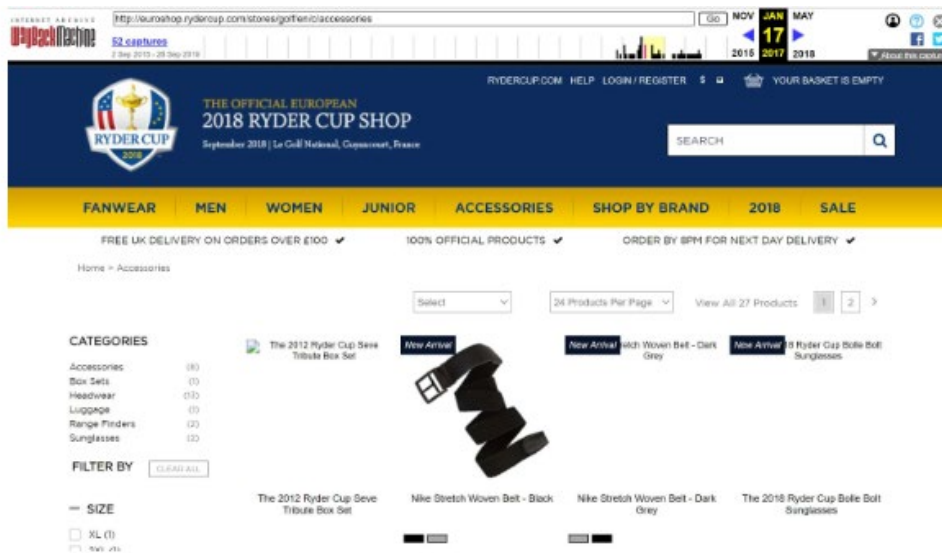


⁸⁶ Exhibit RH13, pages 1 and 2.



229. Turnover from the onsite shop was £5,027,337.61 in 2014 and €7,895,582.53 in 2018.⁸⁷

230. An online shop has also been available during the relevant period, as is shown by the following screenshot taken from the Wayback Machine and dated 17 January 2017.⁸⁸ The remaining screenshots are dated 23 June 2017, 7 July 2017 and 23 May 2018 and show polo shirts, sports shoes, caps and mobile phone cases.



⁸⁷ Paragraph 39.

⁸⁸ Exhibit RH12, page 3.

231. Mr Hills states that turnover figures from online sales of RYDER CUP-branded goods to UK customers in connection with the 2014, 2016 and 2018 tournaments were £935k, £181k and £544k respectively.⁸⁹

232. In *Netto Marken-Discount AG & Co KG v Deutsches Patent- und Markenamt*, Case C-420/13, the CJEU held that it was possible to register a trade mark for services involved in the bringing together of other services, even where some of the latter services were provided by the trade mark proprietor itself. By analogy, services for the bringing together or retailing of goods may include services where some of the goods brought together are the proprietor's own goods. Indeed, given that the subject matter of the services in Class 35 is the bringing together of a selection of goods for the convenience of the public, and other related services intended to encourage consumers to purchase those goods from the trade mark owner, the trade origin of the goods themselves does not appear to be particularly important. Provided there is sufficient selection in the range and/or quality of goods brought together for the public's convenience so as to constitute a service to consumers and/or other identifiable retail services are provided, such services may be protected by a trade mark in Class 35. In principle, this should be possible even where the services in question are intended to induce the consumer to purchase the proprietor's own goods or, as in this case, goods that are sold as "official merchandise" approved by the proprietor.

233. The goods sold in the onsite shops and on the website are official merchandise sourced from a variety of different suppliers. In my view, RC has used the mark for these services in so far as they relate to the retail of clothing and golfing articles, brought together in a physical retail environment or on a website. I find that a fair specification for these services would be *The bringing together for the benefit of others, a variety of goods, enabling customers conveniently to view and purchase those goods in retail outlet or via websites, providing leisure and casual clothing, footwear, headgear, including clothing, footwear, headgear for golf, golfing articles, golf apparatus and equipment, golf bags, golf gloves, golf tees, golf balls.*

⁸⁹ Paragraph 56.

Class 36

Charitable fund raising; providing information on charitable fund raising.

234. The evidence adduced to show use of the marks for the Class 36 services related to charitable fundraising consists of the witness statement of James Pinney listed at (vii) in paragraph 29 above. I briefly summarise this evidence below:

- (i) The European Tour Foundation was named as the Official Charity of the 2018 Ryder Cup, which meant that it would benefit from a number of fundraising activities in the 12 months prior to the tournament.⁹⁰ These included a gala dinner at Versailles just before the competition hosted by the French Golf Federation and RCE;⁹¹
- (ii) The Ryder Cup European Development Trust has supported grass-roots golf projects in Europe since 2006. An undated webpage states that the Trust's fund amounts to £2.2 million and that it has supported over 35 projects in over 30 countries. The Trust is allocated a share of the profits from European Ryder Cup matches. No other sources of funding are indicated. The pages from the Trust's website show the shield logo with the words "EST. 1927" appearing below the words "RYDER CUP".⁹² The consumer will understand these additional words to refer to the date on which the Ryder Cup was established and they will not have any significance in terms of trade origin. This version of the shield logo is, in my view, also acceptable use of the RYDER CUP mark;
- (iii) Ryder Cup tickets, hospitality packages and a Vice Captain's golf buggy have been offered as lots in fundraising auctions in May 2018 and September and November 2019. The shield logo was used in 2018 and the words "RYDER CUP" in the two brochures from 2019;⁹³ and
- (iv) Exhibit JP6 contains a spreadsheet which Mr Pinney states is a list of charities and events supported by RCE under the RYDER CUP mark. The

⁹⁰ Exhibit JP2.

⁹¹ Exhibit JP1.

⁹² Exhibit JP3.

⁹³ Exhibits JP4-5 and JP7.

information in the spreadsheet is not wholly clear. It shows details of tickets that appear to have been offered as prizes in charity auctions, but not how the mark was used, nor the exact nature of RCE's involvement.

235. While the evidence is not extensive, I consider that there is enough for me to find that Ryder Cup has used the mark in connection with *Charitable fund raising*. I find no evidence that it has used it in connection with *Providing information on charitable fund raising*.

Class 41

Sporting activities; running of golf tournaments

236. In his skeleton, Mr Fiddes maintained SRL's denial that Ryder Cup had not proved that it had used the mark for these services, including the *Running of golf tournaments*. During the course of the hearing, he accepted that the mark had a reputation for the golf competition.⁹⁴ In my view the evidence clearly shows that, at four-yearly intervals, Ryder Cup has run a golf tournament in Europe. No use is shown for *sporting activities* more widely, and so I consider that, because the *Running of golf tournaments* is a distinct subcategory of sporting activity, it would not be fair to allow Ryder Cup to rely on a wider term.

Entertainment services; entertainment services including TV shows.

237. Turning now to *Entertainment* and *Entertainment services including TV shows*, I note that the evidence adduced by Mr Hills to prove use for these services is a 2018 brochure for a hospitality package which includes as one of its services full TV coverage of the play⁹⁵ and a screenshot from the Ryder Cup website dated 2 October 2016 which contains a link to radio coverage. However, when magnified, it appears that this is a link to the coverage provided by BBC Radio 5 Live, rather than Ryder Cup. There is no evidence to say whether Ryder Cup provided the television

⁹⁴ Transcript, page 45.

⁹⁵ Exhibit RH24.

programmes or the facility to watch a third party's broadcast services. I find that the evidence does not show that the mark has been used for these services.

Class 43

Reservation of temporary accommodation; arranging of temporary accommodation

238. Mr Hills states that Ryder Cup organises and sells travel and accommodation services. An example is given in Exhibit RH23, which consists of a brochure offering such packages to the 2014 Ryder Cup in Gleneagles. Both the RYDER CUP word mark and the shield logo are used. Exhibit RH22 shows a Facebook advertisement for a hotel package for the 2018 tournament in Paris. The shield logo is in the top right corner. No information is given on sales and there are no invoices. Consequently, I find there to be insufficient evidence to show that genuine use of the mark for *Reservation of temporary accommodation* and *Arranging of temporary accommodation*.

Provision of food and drink; catering; restaurant, cafe, cafeteria, bar services.

239. Exhibit RH24 is the hospitality brochure for the 2018 tournament. The different options shown in this brochure all offered food and drink services, from fine dining to buffet-style. The shield logo is shown on the brochure. Exhibit RH25 contains 6 sample invoices for 2014 to customers in the UK and Germany amounting to £613,321.60 and 9 for 2018 to customers in the UK, France and Italy amounting to €606,211.92. The invoices bear the version of the shield logo with the words "EST. 1927" in place of the year of the tournament. Given the range of catering options, I find that the mark has been genuinely used for *Provision of food and drink; catering; restaurant, cafe, cafeteria and bar services*.

Summary

240. I find that Ryder Cup may rely on the following goods and services in all the oppositions:

Class 9

Downloadable application software related to golf matches or golf tournaments.

Class 25

Casual clothing; leisure clothing; headgear.

Class 28

Golf equipment and accessories.

Class 35

The bringing together for the benefit of others, a variety of goods, enabling customers conveniently to view and purchase those goods in retail outlet or via websites, providing leisure and casual clothing, footwear, headgear, including clothing, footwear, headgear for golf, golfing articles, golf apparatus and equipment, golf bags, golf gloves, golf tees, golf balls.

Class 41

Running of golf tournaments.

Class 43

Provision of food and drink; catering; restaurant, cafe, cafeteria, bar services.

237. In Opposition No. 422302, RCE may also rely on the following services:

Class 36

Charitable fund raising.

Comparison of goods and services

Class 9

238. I find that the following goods are identical per *Meric* to the Class 9 goods for which I found proof of use: *Software; downloadable software; computer software; computer software applications; software and applications for mobile devices.*

239. I also consider that SRL's *computer software for use in accessing, updating, manipulating, modifying, organizing, storing, backing up, synchronizing, transmitting and sharing data, documents, files, information and multimedia content relating to golf courses, the game of golf, golf instruction and golf competitions via a global computer network and any other communications networks* include Ryder Cup's goods and so are identical. If I am wrong in this, they are highly similar.

240. I understand that *computer software platforms* are the environments in which software, such as Ryder Cup's *Downloadable application software related to golf matches or golf tournaments*, operates. This could include software or hardware. There will likely a degree of similarity in the nature of the goods and they could be targeted towards the same users. The purposes are different. The goods are not in competition, but there may be a degree of complementarity. Ryder Cup's goods are dependent on a software platform in which to operate and the average consumer may assume that the same undertaking is responsible for the software platform and the application software. I find that the goods are similar to a medium degree.

241. The primary purpose of *Game software and video game programmes* is different from that of Ryder Cup's goods. SRL's goods would be purchased for the purposes of entertainment, while Ryder Cup's application software would be used to provide information. There may be an overlap in users and trade channels. The nature of the goods will also be similar, as both are software. They are not in competition or complementary. I find that there is a low degree of similarity between them.

242. In my view, the same rationale applies in the case of *Virtual reality software*.

243. SRL's *Downloadable electronic publications* would include goods with the same purpose as Ryder Cup's goods, i.e. to give information about golf matches or tournaments. They would be targeted towards the same users and may be available through similar trade channels. There is competition between the goods, as the user may choose to download an app or a publication. The method of use will be slightly different, as application software would be expected to be more interactive than a publication. Overall, I find that the goods are similar to at least a medium degree.

244. Earlier in my decision, I found there to be a medium degree of similarity between SRL's *Range finders; laser range finders; distance recording apparatus; cameras for recording and analysing golf swings; golf simulators* and Ryder Cup's golf equipment.

245. I can see no reason to find similarity for SRL's other Class 9 goods with any of the goods and services that have survived the proof of use assessment.

Class 14

246. In *Compagnie des montres Longines & Anor v OHIM*, Case T-505/12, the GC rejected the argument that jewellery and watches were similar to clothing: see paragraphs 46-60. I can see no reason to find similarity for SRL's Class 14 goods with any of the goods and services that have survived the proof of use assessment.

Class 25

247. The two tables below capture my findings from a comparison of the Class 25 goods of the respective parties:

Goods covered by the word and signature marks	Comparison with Ryder Cup's goods
<i>Clothing.</i>	<i>Meric identical to Casual clothing; Leisure clothing.</i>
<i>Footwear.</i>	The physical nature is different, but there are some shared purposes and they will be targeted towards the same users. The method of use is similar in that they are worn on the person. There are also likely to be some shared trade channels. I find at least a medium degree of similarity.
<i>Headgear.</i>	Identical to <i>Headgear.</i>
<i>Coats; jackets; shirts; sweatshirts; skirts; bandanas; gloves; waterproof clothing; socks; trousers; shorts; t-shirts.</i>	RC's broad terms would include goods covered by SRL's terms and so they are <i>Meric identical.</i>
<i>Hats; caps; headbands.</i>	<i>Meric identical to Headgear.</i>

Goods covered by the word and signature marks	Comparison with Ryder Cup's goods
<i>Underwear; pyjamas.</i>	They have the same users, trade channels, method of use, purpose and physical nature. If they are not identical per <i>Meric</i> , they are highly similar.
<i>Sports shoes.</i>	As above, under <i>Footwear</i> , I find at least a medium degree of similarity.

Goods covered by the figurative mark	Comparison with RC's goods
<i>Clothing.</i>	<i>Meric</i> identical to <i>Casual clothing; Leisure clothing.</i>
<i>Footwear.</i>	The physical nature is different, but there are some shared purposes and they will be targeted towards the same users. The method of use is similar in that they are worn on the person. There are also likely to be some shared trade channels. I find at least a medium degree of similarity.
<i>Headgear.</i>	Identical to <i>Headgear.</i>
<i>Leisurewear.</i>	Synonymous with <i>Leisure clothing</i> , and so identical.
<i>Articles of outer clothing; sportswear; training clothing; tracksuits; training pants; sweatshirts; jackets; coats; waterproof clothing; anoraks; shirts; tops; t-shirts; polo shirts; vests; knitwear; jerseys; pullovers; sweaters; hooded tops; cardigans; waistcoats; pants; shorts; ties; socks; gloves; mittens; scarves; wristbands; belts; aprons; articles of clothing for babies and children.</i>	RC's broad terms would include goods covered by SRL's terms and so they are <i>Meric</i> identical.
<i>Headbands; hats; caps; sun visors; articles of headgear for babies and children.</i>	<i>Meric</i> identical to <i>Headgear.</i>
<i>Shoes; boots; sandals; slippers; sports shoes; training shoes;</i>	As above, under <i>Footwear</i> , I find at least a medium degree of similarity.

Goods covered by the figurative mark	Comparison with RC's goods
<i>articles of footwear for babies and children; baby boots.</i>	
<i>Uniforms</i>	They have the same users, method of use and physical nature as <i>Casual clothing</i> and <i>Leisure clothing</i> . The purposes are slightly different as uniforms will be worn primarily for work or to indicate membership of a group or organisation. Trade channels are likely to be different and the goods are not in competition. I find them similar to a medium degree.
<i>Bibs</i>	<i>Bibs</i> are worn by babies and persons with certain physical disabilities to keep their clothing clean when they are eating. The purposes are therefore different. The users are the same and there may be some similarity in the materials the goods are made from. The method of use is similar. There is some overlap in trade channels as bibs for babies will be sold through the same outlets as casual clothing for babies. I find that they are similar to a low degree.

Class 28

248. SRL's *sporting articles and equipment* includes RC's *Golf equipment and accessories* and so they are identical per *Meric*. Ryder Cup's term includes SRL's *Golf equipment and golf accessories, including golf clubs, golf grips, golf balls, golf gloves, golf tees, golf club head covers, golf bags, shafts* and they are also identical.

249. SRL's *Games, toys and playthings; video game apparatus; computer games apparatus; electronic games; sports games; handheld electronic games; board games; toy golf sets* are sold through different trade channels from Ryder Cup's *Golf equipment and golf accessories*. There may be some overlap in user, but the purpose of the goods will only be similar at a general level (i.e. providing amusement to the user). The method of use and physical nature are different and the goods are neither in competition nor complementary. Even in the case of *toy golf sets*, I consider it

unlikely that the same undertakings would be responsible for both the sports equipment and the toy versions. I find them to be dissimilar.

Class 35

250. SRL's *Retail services in relation to clothing, ... headgear, ... sporting articles and equipment, golf equipment, golf accessories; the bringing together, for the benefit of others, of a variety of goods namely clothing, ... headgear, ... sporting articles and equipment, golf equipment, golf accessories* are identical to RCE's *The bringing together for the benefit of others, a variety of goods, enabling customers conveniently to view and purchase those goods in retail outlet or via websites, providing leisure and casual clothing, footwear, headgear, including clothing, footwear, headgear for golf, golfing articles, golf apparatus and equipment, golf bags, golf gloves, golf tees, golf balls.*

251. I adopt my findings from paragraph 122 above, where I found that *Rental of advertising space at golf events* to be similar to a low degree to *Running of golf tournaments.*

252. I can see no reason to find similarity for SRL's remaining Class 35 services with any of the goods and services that have survived the proof of use assessment.

Class 36

253. SRL's *Charitable fund raising services* are identical to Ryder Cup's *Charitable fund raising services.*

Class 41

254. SRL's *Sporting ... activities; organisation of sporting ... events and activities; organisation of golf events; organisation of sports competitions; arranging contests* are identical to RC's *Running of golf tournaments* either self-evidently or on the *Meric* principle.

255. Ryder Cup submits that SRL's *Education and providing of training* are complementary to, targeted to the same industry and distributed through the same trade channels as its Class 41 services. The only services for which I found genuine use were *Running of golf tournaments*. The purposes of these services differ and I am not persuaded that they are supplied through the same trade channels. I do not consider they are complementary in a trade mark sense. While there may be some overlap in user and both may concern golf, this is not sufficient for me to find that there is any similarity between the services.

256. The nature of SRL's *Entertainment; ... cultural activities; organisation of ... cultural events and activities* differs from that of Ryder Cup's *Running of golf tournaments*. The same users may use both parties' services, but their purpose is different. I do not consider that they are distributed through the same trade channels or that there is competition between them. Neither do I find them to be complementary. I consider that the parties' services are dissimilar.

257. Ryder Cup's *Running of golf tournaments* are essential to the supply of SRL's *Radio or television coverage of sports events*⁹⁶ in so far as those events are golf competitions. However, I do not consider that the consumer would expect the same undertaking to be responsible for both services, given the specialist skills involved in radio and television broadcasting. They are not, in my view, complementary. They would be targeted towards the same users and there is a degree of competition, as the golf enthusiast could choose to attend in person or watch or listen to coverage of the event. The trade channels would be different. The purposes would be similar. I find that there is a low degree of similarity between the services.

258. In contrast, I consider that the consumer would expect the same undertaking to be responsible for SRL's *Information services concerning sports events...* and Ryder Cup's *Running of golf tournaments* and so I find that they are complementary. They would be targeted towards the same users and may be distributed through overlapping trade channels. I find that there is a medium degree of similarity between the services.

⁹⁶ The term in the specification for Application No. 3516813 is *Radio or television coverage of sports events, namely radio or television reporting of sports events*.

259. Earlier in my decision, I referred to Ryder Cup's submission that, to the extent that they related to golf, SRL's *Organisation of exhibitions* were similar to its own golf-related services. There I compared the services to *Provision of information in relation to golf, golf tournaments and golf competitions*. Here the relevant comparison is with *Running of golf tournaments*. The purposes and nature of the services are different, although they may be aimed towards the same users. I do not consider that the trade channels will be the same. There is no competition between the services and any complementary is, in my view, not sufficiently pronounced for me to find similarity between the services.

260. The next services I shall consider are SRL's *Organisation of electronic sports and video gaming events, tournaments and competitions; education, provision of training, sporting and cultural activities all relating to the professional video gaming industry*. Ryder Cup submits that the services are similar to its own services, including *Running of golf tournaments*, and that "*the emergence of e-sports, also golf e-sports, further points to the similarity of these services*".⁹⁷ Ryder Cup has adduced no evidence on golf e-sports so I must make my comparison on the basis of my understanding of the terms. Earlier in my decision, I found a medium degree of similarity between the *provision of sporting ... activities all relating to the professional video gaming industry* and *organisation of electronic sports ... events, tournaments and competitions* and Ryder Cup's *Sporting activities*. This is, of course, a broader term than the *Running of golf tournaments*. I consider that the services at issue here would be aimed towards different users, with any similarity in purpose being at a very general level of organising competitive events. The trade channels will, in my view, be different. The services are not in competition, nor are they complementary. I find that they are dissimilar.

261. SRL's *Entertainment services in connection with sports events; entertainment services in the form of public viewing of live and delayed broadcast of sports events* and *Hospitality services (entertainment)* may be distributed through some of the same trade channels as Ryder Cup's services. They will be aimed at the same user, but the nature of those services is different. The purposes are similar only at a general level.

⁹⁷ Annex A to written submissions of 4 March 2021, page 4.

The services are not in competition, nor are they complementary. I find that they are similar to a low degree.

262. SRL's *Provision of information relating to golf courses, including global positioning system ("GPS") information, for determining distances on golf courses and for accessing of relevant data and statistics related thereto* is targeted towards the same users as Ryder Cup's services. The nature and purpose of the service is different, but there may be some overlap in distribution channels as the information could be supplied to enhance the experience of spectators at the event. The services are not in competition, nor are they complementary. I find there is a low degree of similarity.

263. In paragraphs 140-141 above, I compared SRL's *Issuing of tickets for events; reservation of entry tickets to sports or entertainment events; Ticket reservation services for entertainment, sporting and cultural events* with Ryder Cup's services, which included entertainment, general sporting and golf services. I found a medium degree of similarity. In so far as SRL's services could cover golf events, I adopt these findings. *Issuing of tickets for events; reservation of entry tickets to sports ... events; Ticket reservation services for ... sporting ... events* are similar to a medium degree to the *Running of golf tournaments*. I find no similarity for *Reservation of entry tickets to ... entertainment events* and *Ticket reservation services for entertainment ... and cultural events*.

264. SRL's *Organisation of training and instruction for the game of golf* would be targeted towards the same users as Ryder Cup's *Running of golf tournaments*. The purposes are different. However, there may be some overlapping trade channels and the same undertaking may provide both services. The services are not in competition and if there is any complementary it is at a fairly low level. I consider that there is a low degree of similarity between the services.

265. I can see no reason to find similarity between SRL's *Distribution of sound and images recordings via the internet; information services concerning ... entertainment; audio and video recording services; electronic publication; publication of printed matter and printed publications; publication of magazines, calendars, books, leaflets, posters;*

providing on-line publications; non-downloadable electronic publications and Ryder Cup's goods and services.

Summary

266. I have found the following contested goods and services to be identical or similar to goods and services for which genuine use was shown:

Identical

Class 9

Software; downloadable software; computer software; computer software applications; software and applications for mobile devices; computer software for use in accessing, updating, manipulating, modifying, organizing, storing, backing up, synchronizing, transmitting and sharing data, documents, files, information and multimedia content relating to golf courses, the game of golf, golf instruction and golf competitions via a global computer network and any other communications networks.

Class 25

UKTMs 3414361 and 3414350: Clothing; headgear; coats; jackets; hats; caps; shirts; headbands; sweatshirts; skirts; bandanas; gloves; waterproof clothing; underwear; socks; trousers; shorts; pyjamas; t-shirts.

UKTM No. 3516813: Clothing; headgear; articles of outer clothing; sportswear; leisurewear; training clothing; tracksuits; training pants; sweatshirts; jackets; coats; waterproof clothing; anoraks; shirts; tops; t-shirts; polo shirts; vests; knitwear; jerseys; pullovers; sweaters; hooded tops; cardigans; waistcoats; pants; shorts; ties; socks; gloves; mittens; scarves; wristbands; headbands; hats; caps; sun visors; belts; aprons; uniforms; articles of clothing ... and headgear for babies and children.

Class 28

Golf equipment and golf accessories, including golf clubs, golf grips, golf balls, golf gloves, golf tees, golf club head covers, golf bags, shafts.

Class 35

Retail services in relation to clothing, ... headgear, ... sporting articles and equipment, golf equipment, golf accessories; the bringing together, for the benefit of others, of a variety of goods namely clothing, ... headgear, ... sporting articles and equipment, golf equipment, golf accessories.

Class 36

Charitable fund raising services.

Class 41

Sporting ... activities; organisation of sporting ... events and activities; organisation of golf events; organisation of sports competitions; arranging contests.

Similar to at least a medium degree

Class 9

Downloadable electronic publications.

Similar to a medium degree

Class 9

Computer software platforms; range finders; laser range finders; distance recording apparatus; cameras for recording and analysing golf swings; golf simulators; apparatus for recording, transmission, processing and reproduction of sound, images or data relating to golf.

Class 25

UKTMs 3414361 and 3414350: *Footwear; sports shoes.*

UKTM No. 3516813: *Footwear; shoes; boots; sandals; slippers; sports shoes; training shoes; articles of ... footwear ... for babies and children; baby boots.*

Class 41

Information services concerning sports events ...; issuing of tickets for events; reservation of entry tickets to sports ... events; ticket reservation services for ... sporting ... events.

Similar to a low degree

Class 9

Game software; video game programmes; virtual reality software.

Class 25

Bibs.

Class 35

Rental of advertising space at golf events.

Class 41

Radio or television coverage of sports events; entertainment services in connection with sports events; entertainment services in the form of live and delayed broadcast of sports events; provision of information relating to golf courses, including global positioning system ("GPS") information, for determining distances on golf courses and for accessing of relevant data and statistics related thereto; hospitality services (entertainment); organisation of training and instruction for the game of golf.



267. I found the remaining goods and services to be dissimilar and so the oppositions under section 5(2)(b) fail in respect of those services.

Average consumer and the purchasing process

268. I adopt the findings I made earlier in my decision in paragraphs 146-150, save where they refer to goods and services that are no longer in play.

Comparison of the marks

269. The respective marks are shown below:

Contested mark	Earlier mark
<p data-bbox="284 474 542 506">SAMUEL RYDER</p>   <p data-bbox="400 725 699 869">SAMUEL RYDER CHARITABLE TRUST</p>	<p data-bbox="874 474 1062 506">RYDER CUP</p>

270. Both the contested word mark and the earlier mark are word marks containing the word “RYDER”, albeit in different positions. The overall impression of the earlier mark lies in the combination of the words, as they hang together as a unit with a meaning different from that of the mark’s separate parts. The average consumer will understand the term to refer to a trophy or sports competition. Earlier in my decision, I found that the average consumer would see the contested mark as a name, which also hangs together. Nevertheless, the shared element of “RYDER” creates visual and aural similarities, which would, in my view, not be counteracted by the conceptual differences. I find that the marks are visually and aurally similar to a low degree. If there is any conceptual similarity, it is very low.

271. In the light of my findings earlier in this decision, I consider that the degree of visual similarity between the signature mark and the earlier mark is lower than that between the word mark, although the aural and conceptual comparisons produce the same findings. The visual and aural similarity between the figurative and the earlier marks is very low, and that if there is any conceptual similarity it is also very low.

Distinctive character of the earlier mark

272. Earlier in my decision, I found that “RYDER” would be perceived by the consumer as a surname. The two words hang together and would be perceived as referring to a sports trophy or competition. In my view, the inherent distinctiveness of the mark “RYDER CUP” would be at a medium level, but the degree of use that has been made of the mark has enhanced that inherent distinctiveness to a very high level for the *Running of golf tournaments*. It has not, in my view, been enhanced for any other goods or services.

Likelihood of confusion

273. Even where the goods and services are identical, the differences between the marks are such that, in my view, the average consumer will not mistake one for the other. I find that there is no likelihood of direct confusion.

274. Moving to indirect confusion, I remind myself of the comments of Mr James Mellor QC (as he then was), sitting as the Appointed Person, in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. He said:

“... I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: ‘Taking account of the common element in the context of the later mark as a whole.’ (my emphasis).”⁹⁸

275. It is undeniable that the marks share a common element in the word “RYDER”. However, in neither case does it play an independent distinctive role in the overall impression of the mark. The later mark is, in my view, likely to bring the earlier mark to the mind of the average consumer but as Mr Mellor noted in *Duebros*, that is mere association rather than confusion.

⁹⁸ Paragraph 81.4.

276. The oppositions based on the RYDER CUP marks fail under section 5(2)(b).

Section 5(3)

277. Section 5(3) of the Act is as follows:

“A trade mark which –

(a) 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 (EU) 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 the repute of the earlier trade mark.”

278. The conditions of section 5(3) are cumulative. First, the opponent must show that the earlier mark is similar to the application. Secondly, it must satisfy me that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the application. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods/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.

279. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United*

Kingdom Ltd (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L'Oréal SA & Ors v Bellure & Ors* (Case C-487/07), *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09) and *Environmental Manufacturing LLP v OHIM* (Case C-383/12 P). 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; *General 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 and/or services, the extent of the overlap between the relevant consumers for those goods and/or 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 that 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) The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oréal*, paragraph 44.

g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods and/or 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 and/or services for which the earlier mark is registered, or a serious risk that this will happen in the future; *Intel*, paragraphs 76 and 77, and *Environmental Manufacturing*, paragraph 34.

h) 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.

i) 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 on the earlier mark; *L'Oréal*, paragraph 40.

j) 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 proprietor 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; *Interflora*, paragraph 74, and the court's answer to question 1 in *L'Oréal*.

Reputation

280. In *General Motors*, the CJEU held that:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on

the product or services marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

281. Ryder Cup claims that the **RYDER CUP** mark has a reputation for the following goods and services:

Class 25

Clothing; footwear; headgear; visors [hatmaking]

Class 28

Sporting articles

Class 41

Entertainment services; sporting activities; running of golf tournaments; entertainment services including TV shows.

282. I found that genuine use of the mark had not been shown for all of these goods and services and that a fair specification in the relevant Classes would be:

Class 25

Casual clothing; leisure clothing; headgear.

Class 28

Golf equipment and accessories.

Class 41

Running of golf tournaments.

The evidence

283. According to Mr Hills, the core activity of Ryder Cup is the running of golf tournaments. The turnover figures quoted earlier in my decision have not been broken down by good or service, but there is other evidence that goes to the reputation of the golf tournament. Earlier in my decision, I referred to attendance figures.⁹⁹ The competition is also followed on television, being broadcast in the UK on Sky TV with highlights on the BBC. Viewing figures were as follows:¹⁰⁰

2010 – Weighted average of 799k per broadcast and BBC highlights with a highest peak of 3.4m

2012 – Weighted average of 720k per broadcast or BBC highlights with a highest peak of 1.5m

2014 - Weighted average of 791k per broadcast or BBC highlights with a highest peak of 2.5m

2016 - Weighted average of 680k per live broadcast and a highest peak of 1.3m (BBC data not available)

2018 - Weighted average of 722k per broadcast or BBC highlights with a highest peak of 1.8m

⁹⁹ Paragraph 185 above.

¹⁰⁰ Witness statement of Richard Hills, paragraph 66.

284. Ryder Cup adduced a video of highlights of UK television coverage of the 2018 Ryder Cup tournament (VIDEO RH). During this video, the commentators make two references to Samuel Ryder as the founder of the competition.¹⁰¹

285. The tournament has also been covered in national newspapers, with Exhibits RH32-RH40 containing a selection of articles from UK, Irish, French, Spanish, German, Portuguese, Czech, Austrian, Danish, Belgian and Finnish publications, dating from 2012, 2014, 2016, 2018 and 2019. Among the UK publications are *The Times*, *Daily Mirror*, *The Guardian*, *The Scotsman*, *Daily Mail*, *The Sun*, *Daily Express*, *Daily Telegraph* and *Daily Record*. The mark is used in headlines, headings on pages or in the articles themselves. Some of this coverage refers to the competition in the shortened form “RYDER”.

286. The following table provides information on activity on the Ryder Cup website during each of the contests between 2010 and 2018:¹⁰²

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¹⁰¹ Between the 6th to 8th minute and between the 11th to 12th minute.

¹⁰² Witness statement of Richard Hills, paragraph 65, and Exhibit RH31.

2010 Ryder Cup (1- 4 October 2010)	<ul style="list-style-type: none"> - 144,826,000 pages were viewed, of which 780,000 were via the European website. - 65% of the sessions on the European website were from the UK.
2012 Ryder Cup (25 – 30 September 2012)	<ul style="list-style-type: none"> - An average of 233,000 daily UK visitors accessed Ryder Cup video content each day of the competition. - An average of 255,000 daily visitors accessed the Ryder Cup video content from the remainder of EU (excluding the UK) each day of the competition.
2014 Ryder Cup (23 – 28 September 2018)	<ul style="list-style-type: none"> - A total of 648,101 unique visitors accessed the Ryder Cup website from the UK on day 3 of the competition alone - A total of 688,359 unique visitors accessed the Ryder Cup website from the remainder of the EU (excl. the UK) on day 3 of the competition alone
2016 Ryder Cup (30 September – 2 October 2016)	<ul style="list-style-type: none"> - 1.5 million EU users were referred to the Ryder Cup website from search engines during the days of the tournament, of these 707,000 were from Google searches originating from the UK and a combined 433,000 from Google searches originating from Ireland, Germany, Sweden, Spain, France and Italy.
2018 Ryder Cup (28 – 30 September 2018)	<ul style="list-style-type: none"> - 165,900 unique visitors accessed Ryder Cup video content from the UK through the US Team website and 545,800 unique visitors accessed Ryder Cup video content from the UK through the European Team website - 161,700 unique visitors accessed Ryder Cup video content from a selection of other EU countries (excl. the UK) through the US Team website and 589,600 unique visitors accessed Ryder Cup video content from a selection of other EU countries (excl. the UK) through the European Team website -

287. I have summarised the evidence relating to the Class 25 and Class 28 goods in paragraphs 215-221 and 224-226 above.

Does the evidence show the mark has a reputation?

288. The date on which reputation must be assessed is the application date of the contested marks, i.e. 16 July 2019 and 28 July 2020. As the mark is an EUTM, the relevant territory in which there must be a reputation is the EU. The relevant public for the goods and services is the general public.

289. During the course of the hearing, Mr Fiddes accepted that the mark had a reputation for the golf competition.¹⁰³ In addition, in my view, the evidence clearly shows that Ryder Cup has run a golf tournament in Europe. While the nature of the competition is such that the tournament run by Ryder Cup takes place only every four years in Europe, the use by Ryder Cup and its predecessors in title is longstanding, going back to the 1920s. I also accept that there has been coverage in the EU when the event takes place in the US. Television viewing figures are high and the competition enjoys significant coverage in widely read newspapers. The evidence tells me that the competition is highly prestigious and that the teams who compete in it are widely seen as the best male golfers from their respective continents. The mark has a huge reputation among golf enthusiasts for the *Running of golf tournaments*. Given the extent of the coverage of the event on television and in widely read newspapers, I consider that the reputation will in addition be very strong among the general public.

290. I turn now to the remaining goods and services. I have no evidence of the size of the EU market for *Casual clothing, leisure clothing and headgear*, but it is reasonable to assume that it is large. The relevant public is the general public. There is limited evidence of sales or promotional activity outside the date of the 2014 and 2018 tournaments and any figures outside this period relating to turnover or marketing spend are not broken down by goods. In my view, the evidence falls short of demonstrating that Ryder Cup has a reputation for the limited, fair specification for Class 25.

291. The same shortcomings apply with regard to the evidence for *Golf equipment and accessories*, although I accept that the size of the relevant public will be smaller than for the Class 25 goods. Nevertheless, sales of under £350k in 2014 and €500k in 2018,

¹⁰³ Transcript, page 45.

combined with scant evidence of promotional activity or sales outside the tournaments, lead me to find that Ryder Cup has not shown a reputation for these goods.

Link

292. In assessing whether the public will make the required mental link between the marks, I must take account of all relevant factors, which were identified by the CJEU in *Intel* at paragraph 42 of its judgment. I shall consider each of them in turn.

The degree of similarity between the conflicting marks

293. Earlier in my decision, I found that the marks are visually and aurally similar to a low degree, and that if there is any conceptual similarity it is very low.

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

294. I have compared the marks under section 5(2)(b), but had a longer list of earlier goods and services that I could use for that comparison. The only earlier service here is the *Running of golf tournaments*.

295. I have already found SRL's ... *sporting ... activities; organisation of sporting ... events and activities; organisation of golf events; organisation of sports competitions; arranging contests* to be identical to *Running of golf tournaments*. I also found that *Information services concerning sports events ...; issuing of tickets for events; reservation of entry tickets to sports ... events; ticket reservation services for sporting ... events* were similar to the services for which the earlier mark has a reputation. The following services I found to be similar to a low degree: *Rental of advertising space at golf events; Radio or television coverage of sports events; entertainment services in connection with sports events; entertainment services in the form of live and delayed broadcast of sports events; provision of information relating to golf courses, including global positioning system ("GPS") information, for determining distances on golf*

courses and for accessing of relevant data and statistics related thereto; hospitality services (entertainment); organisation of training and instruction for the game of golf.

296. SRL's *Computer software for use in accessing, updating, manipulating, modifying, organizing, storing, backing up, synchronizing, transmitting and sharing data, documents, files, information and multimedia content relating to golf courses, the game of golf, golf instruction and golf competitions via a global computer network and via any other communications networks; range finders; laser range finders; distance recording apparatus; cameras for recording and analysing golf swings; golf simulators; apparatus for recording, transmission, processing and reproduction of sound, images or data relating to golf* will be targeted towards the same users as Ryder Cup's golf tournaments. However, the purpose, method of use, trade channels and nature of the goods and services are different. They are neither in competition nor complementary. Weighing all these factors, I consider that a shared user base is not sufficient for me to find similarity. Nevertheless, I note that these are all golf-related goods.

297. In my view, the same rationale applies in respect of *Golf equipment and golf accessories, including golf clubs, golf grips, golf balls, golf gloves, golf tees, golf club head covers.*

298. I find no similarity between the *Running of golf tournaments* and the remaining goods and services.

The strength of the earlier mark's reputation

299. I am satisfied from the evidence of viewing figures and press coverage that the RYDER CUP mark has a huge reputation in the EU for the *Running of golf tournaments*. It is likely to be particularly strong for individuals who play or are interested in golf, but the degree of coverage suggests that the reputation will still be sizeable among the general public.

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

300. Earlier in my decision, I found that "RYDER" would be perceived by the consumer as a surname. The two words hang together and would be understood to refer to a sports trophy or competition. In my view, the inherent distinctiveness of the mark "RYDER CUP" would be at a medium level, but the degree of use that has been made of the mark has enhanced that inherent distinctiveness to a very high level for the *Running of golf tournaments*.

Whether there is a likelihood of confusion

301. I found there to be no likelihood of confusion under section 5(2)(b).

Is there a link?

302. It does not follow that the relevant public will not make a mental link between the marks where there is no likelihood of confusion. In my view, the reputation and distinctiveness of the earlier mark are so large among the public interested in golf that there will be a link where the goods and services are related to golf. This is the section of the public that is most likely to know about Samuel Ryder and his connection with the Ryder Cup. I consider that there will be a link in the mind of the public were the contested marks to be used for the following goods and services:

Class 9

Computer software for use in accessing, updating, manipulating, modifying, organizing, storing, backing up, synchronizing, transmitting and sharing data, documents, files, information and multimedia content relating to golf courses, the game of golf, golf instruction and golf competitions via a global computer network and via any other communications networks; Range finders; laser range finders; distance recording apparatus; cameras for recording and analysing golf swings; golf simulators; apparatus for recording, transmission, processing and reproduction of sound, images or data relating to golf.

Class 28

Toy golf sets; golf equipment and golf accessories, including golf clubs, golf grips, golf balls, golf gloves, golf tees, golf club head covers, golf bags, shafts.

Class 35

Advertising services relating to golf equipment and golf events; rental of advertising space at golf events; retail services in relation to ... golf games, ... toy golf sets, ... golf equipment, golf accessories; the bringing together, for the benefit of others, of a variety of goods namely ... golf games, ... toy golf sets, ... golf equipment, golf accessories, enabling consumers to conveniently compare and purchase those goods.

Class 41

Organisation of golf events; provision of information relating to golf courses, including global positioning system ("GPS") information, for determining distances on golf courses and for accessing of relevant data and statistics related thereto; issuing of tickets for ... golf sports events; organisation of training and instruction for the game of golf.

303. In addition, the specifications include broader terms that include golf-related goods and services. My finding of a link extends to the following:

Class 9

Software; downloadable software; computer software; computer software platforms; computer software applications; downloadable smart phone applications; application software; software and applications for mobile devices; game software; video game programmes; virtual reality software; downloadable electronic publications; audiovisual teaching apparatus.

Class 28

Games, toys and playthings; video game apparatus; computer games apparatus; electronic games; sports games; handheld electronic games; board games; sports games; sporting articles and equipment.

Class 35

Promotion of sports competitions and events; promotion of goods and services through sponsorship of sports events; advertising for sports events; retail services in relation to ... sporting articles and equipment ...; the bringing together, for the benefit of others, of a variety of goods namely ... sporting articles and equipment ..., enabling consumers to conveniently compare and purchase those goods.

Class 41

Providing of training; sporting ... activities; radio or television coverage of sports events; organisation of sporting ... events and activities; organisation of exhibitions; organisation of sports competitions; arranging contests; entertainment services in connection with sports events; entertainment services in the form of public viewing of live and delayed broadcast of sports events; information services concerning sports events ...; issuing of tickets for events, including ... sports events; reservation of entry tickets to sports ... events; ticket reservation services for ... sporting ... events.

304. When the later mark is encountered for goods and services not related to golf, I consider that it is not likely that the earlier mark would be brought to the mind of the relevant consumer for those services. I have already noted that Samuel Ryder was mentioned twice in the video. However, there are few other references in the articles and other material targeted towards the public that has been adduced in the voluminous evidence. Therefore, I am not persuaded that a significant proportion of the relevant public for the following non-golf related goods and services would be aware of Samuel Ryder or his connection with the Ryder Cup. "Ryder" is not one of the most common surnames in the UK: it is not "Smith" or "Jones". However, neither is it particularly unusual. Given the distance between Ryder Cup's services and the following goods and services for SRL and the low degree of similarity between the marks, I consider that the public is unlikely to think there is a link for the following goods and services:

Class 9

Sunglasses and spectacles; cords, frames, lenses and cases for use with spectacles; earphones; earphones and headsets for mobile telephones; cases adapted for mobile phones; headphones.

Class 14

Precious metal and their alloys; jewellery, precious and semi-precious stones; horological and chronometric instruments; pins (jewellery); brooches (jewellery); tie pins; tie clips; amulets (jewellery); rings (jewellery); earrings; bracelets (jewellery); key rings (trinkets or fobs); novelty key holders; cufflinks; necklaces (jewellery); sculptures; statuettes of precious metal; figurines (statuettes) of precious metal; jewellery; medals; commemorative medals of precious metal, medallions (jewellery); medallions not of precious metal; coins; semi-precious stones; gems (precious stones); horological and chronometric instruments including watches; clocks; wristwatches; electric clocks; pendulums (clock), stopwatches, watch straps.

Class 35

Rental of advertising space on the internet; business administration; business management; office functions

Class 41

Education; ... cultural activities; organisation of ... cultural events and activities; information services concerning ... entertainment; audio and video recording services; distribution of sound and images recordings via the internet; reservation of entry tickets to ... entertainment events; ticket reservation services for entertainment ... and cultural events

305. This leaves a few goods and services that require further analysis. I shall begin with the Class 25 goods, which are identical for the word and signature marks and different for the figurative mark. Ryder Cup has provided me with no evidence to suggest there are items of clothing, footwear and headgear specifically for golf, beyond golf shoes and golfing gloves, the latter of which is covered by the Class 28 specification. The remaining Class 25 goods shown in the evidence are jackets, tops,

caps, etc. that would be worn by a member of the general public. I can accept that a significant proportion of the relevant public for golf shoes would make a link between the marks. My finding must extend, then, to the general terms *Footwear*, *Shoes* (figurative mark only) and *Sports shoes* that include golf shoes. In relation to the rest of the goods, I do not consider that the relevant public would make the link between the marks.

306. The next group of services is *Advertising, marketing and promotional services; promotion of goods and services of third parties; television advertising; radio advertising; advertising via the internet*, all in Class 35. These are broader terms that include services in respect of which I found a link. I therefore extend my findings in paragraphs 302 and 303 to these services.

307. I move on to *Advertising, sponsorship (promotion and marketing services) and business management of a professional video gaming sports team and persons who participate in competitions and events for computer games; advertising, sponsorship (promotion and marketing services) of competitions and events for computer games*. Ryder Cup has made several references to golf e-sports in its annexes comparing the parties' goods and services, but has provided no evidence to substantiate its assertions that these are available. Nevertheless, I consider that these terms would cover teams and events relating to golf computer games and it is likely that there would be at least some overlap in the relevant public. I find that there will be a link in the mind of a proportion of this public.

308. These findings extend to the *Organisation of Electronic sports and video gaming events, tournaments and competitions and education, provision of training, sporting and cultural activities all relating to the professional video gaming industry* in Class 41.

309. The final Class 35 services comprise a range of retail services. These would include the retail services offered by Ryder Cup and the goods offered could all be related to golf. For example, I consider it likely that a retail service aimed at golfers would sell clothing as well as golf equipment and accessories. Therefore, I find that there is a link with respect to these services.

310. I now come to *Charitable fund raising services*. I accept that these may be provided in the context of golf tournaments, but they may equally be provided in relation to any activity. The question is whether, if the average consumer of Ryder Cup's services saw the contested figurative mark used for *Charitable fund raising services*, they would think there is a connection with the RYDER CUP mark. I remind myself that the degree of visual, aural and conceptual similarity between the figurative mark (which is the relevant one here) and the earlier mark is very low. Given the distance between the services, I find that there would not be a link.

311. *Entertainment and Hospitality services (entertainment)* in Class 41 include *Entertainment services in connection with sports events*. I therefore extend my findings in paragraph 303 to these services.

312. The final group of services is *Electronic publication; publication of printed matter and printed publications; publication of magazines, calendars, books, leaflets, posters; providing on-line publications; non-downloadable electronic publications*. I think it is reasonable to note that the publishing industry consists of undertakings that publish material covering a wide variety of different topics and genres and others that specialise in particular areas. It is not unlikely that a publisher might specialise in the publication of books and other material related to golf or sports as a whole. I find that there would be a link in relation to these services.

Damage

313. Ryder Cup claims that damage will occur in one of three ways. The first is that the public would be led to believe that the goods and services are the responsibility of the same undertaking or economically linked undertakings. Essentially, this is an argument that there will be indirect confusion on the part of the public. I found no likelihood of confusion and so I will say no more about this claim.

314. Secondly, Ryder Cup claims that SRL would benefit, through use of the contested marks, from the investment in and promotion of the earlier RYDER CUP mark, and thus gain an unfair advantage. Unfair advantage means that consumers are more likely to buy the goods and services of the contested mark(s) than they would otherwise

have been if they had not been reminded of the earlier marks. In *L'Oréal*, the CJEU said:

“As regards the concept of ‘taking unfair advantage of the distinctive character or the repute of the trade mark’, also referred to as ‘parasitism’ or ‘free-riding’, that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It 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.”¹⁰⁴

315. Mr Fiddes submitted that:

“... the Opponent [RCE] has failed to establish the link or how the Applicant [SRL] would take benefit from the Opponent’s reputation, in making use of the marks in issue to generate revenue for their charitable purposes.”¹⁰⁵

316. Praying in aid the intention of SRL to use the marks for charitable purposes does not assist it under this ground. I must consider the fair and notional use of the marks that have been applied for. Should the marks be registered, SRL would be able to use it for both charitable and purely commercial purposes. The intention of the applicant for a trade mark may be of relevance, but the case law states that a finding of unfair advantage can be made if that is the objective effect of the contested mark(s), even if there is no proof that the applicant intended to take unfair advantage of the earlier mark’s reputation: see *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch), paragraph 80.

317. In *Aktieselskabet af 21. november 2001 v OHIM*, Case C-197/07 P, the CJEU stated that:

¹⁰⁴ Paragraph 41.

¹⁰⁵ Skeleton argument, page 19.

“22. With regard to the appellant’s argument concerning the standard of proof required of the existence of unfair advantage taken of the repute of the earlier mark, it must be noted that it is not necessary to demonstrate actual and present injury to an earlier mark; it is sufficient that evidence be produced enabling it to be concluded prima facie that there is a risk, which is not hypothetical, of unfair advantage or detriment in the future (see, by analogy, concerning the provisions of Article 4(4)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), Case C-252/07 *Intel Corporation* [2008] ECR I-0000, paragraph 38).

23. In the present case, it is clear that the Court of First Instance, in paragraph 67 of the judgement under appeal, properly established the existence of an unfair advantage within the meaning of Article 8(5) of Regulation No 40/94 in correctly considering that it had available to it evidence enabling it to conclude prima facie that there was a risk, which was not hypothetical, of unfair advantage in the future.”

318. The message that is imparted to the relevant public by Ryder Cup’s mark is one of excellence in golf. This is a quality that is relevant and desirable in relation to the goods and services where I found a link, as these are all, or include, goods and services connected to golf. I find that unfair advantage is made out.

319. As unfair advantage has been made out for the goods and services where I found there to be a link, I shall not consider the remaining claims.

320. Mr Fiddes submitted that use of the contested mark by SRL was not without due cause and that his clients were entitled to register the trade mark “*for the reasons that they have set out*”.¹⁰⁶ These reasons relate to the desire to protect the name and legacy of Mr Samuel Ryder. In *Leidseplein Beheer BV v Red Bull*, Case C-65/12, the CJEU said that:

¹⁰⁶ Transcript, page 45.

“43. In a system for the protection of marks such as that adopted, on the basis of Directive 89/104, by the Benelux Convention, however, the interests of a third party in using, in the course of trade, a sign similar to a mark with a reputation must be considered, in the context of Article 5(2) of that directive, in the light of the possibility for the user of that sign to claim ‘due cause’.

44. Where the proprietor of the mark with a reputation has demonstrated the existence of one of the forms of injury referred to in Article 5(2) of Directive 89/104 and, in particular, has shown that unfair advantage has been taken of the distinctive character or the repute of that mark, the onus is on the third party using a sign similar to the mark with a reputation to establish that he has due cause for using such a sign (see, by analogy, Case C-252/07 *Intel Corporation* [2008] ECR I-8823, paragraph 39).

45. It follows that the concept of ‘due cause’ may not only include objectively overriding reasons but may also relate to the subjective interests of a third party using a sign which is identical or similar to the mark with a reputation.

46. Thus, the concept of ‘due cause’ is intended, not to resolve a conflict between a mark with a reputation and a similar sign which was being used before that trade mark was filed or to restrict the rights which the proprietor of that mark is recognised as having, but to strike a balance between the interests in question by taking account, in the specific context of Article 5(2) of Directive 89/104 and in the light of the enhanced protection enjoyed by that mark, of the interests of the third party using that sign. In so doing, the claim by a third party that there is due cause for using a sign which is similar to a mark with a reputation cannot lead to the recognition, for the benefit of that third party, of the rights connected with a registered mark, but rather obliges the proprietor of the mark with a reputation to tolerate the use of the similar sign.

...

60. Consequently, it follows from all of the foregoing considerations that the answer to the question referred is that Article 5(2) of Directive 89/104 must be interpreted as meaning that the proprietor of a trade mark with a reputation may be obliged, pursuant to the concept of 'due cause' within the meaning of that provision, to tolerate the use by a third party of a sign similar to that mark in relation to a product which is identical to that for which that mark was registered, if it is demonstrated that that sign was being used before that mark was filed and that the use of that sign in relation to the identical product is in good faith. In order to determine whether that is so, the national court must take account, in particular, of:

- how that sign has been accepted by, and what its reputation is with, the relevant public;
- the degree of proximity between the goods and services for which that sign was originally used and the product for which the mark with a reputation was registered; and
- the economic and commercial significance of the use for that product of the sign which is similar to that mark.”

321. The difficulty for SRL is that it has been established that it had not used the signs in trade, as it had been a dormant company from the date of its incorporation. It cannot, therefore rely on due cause.

322. The oppositions under section 5(3) succeed in relation to the following goods and services:

Class 9

Software; downloadable software; computer software; computer software platforms; computer software applications; downloadable smart phone applications; application software; software and applications for mobile devices; game software; video game programmes; virtual reality software; Computer software for use in accessing, updating, manipulating, modifying, organizing,

storing, backing up, synchronizing, transmitting and sharing data, documents, files, information and multimedia content relating to golf courses, the game of golf, golf instruction and golf competitions via a global computer network and via any other communications networks; downloadable electronic publications; Range finders; laser range finders; distance recording apparatus; cameras for recording and analysing golf swings; golf simulators; audiovisual teaching apparatus; apparatus for recording, transmission, processing and reproduction of sound, images or data relating to golf.

Class 25

Word and signature marks: *Footwear; sports shoes.*

Figurative mark: *Footwear; shoes; sports shoes.*

Class 28

Games, toys and playthings; video game apparatus; computer games apparatus; electronic games; sports games; handheld electronic games; board games; toy golf sets; sports games; sporting articles and equipment. golf equipment and golf accessories, including golf clubs, golf grips, golf balls, golf gloves, golf tees, golf club head covers, golf bags, shafts.

Class 35

Advertising, marketing and promotional services; promotion of sports competitions and events; promotion of goods and services through sponsorship of sports events; promotion of goods and services of third parties; television advertising; radio advertising; advertising via the internet; advertising services relating to golf equipment and golf events; advertising for sports events; rental of advertising space at golf events; advertising, sponsorship (promotion and marketing services) and business management of a professional video gaming sports team and persons who participate in competitions and events for computer games; advertising, sponsorship (promotion and marketing services) of competitions and events for computer games; retail services in relation to clothing, footwear, headgear, games, toys and playthings, video game apparatus, computer games apparatus, electronic games, sports games, golf games, handheld electronic games, board games, toy golf sets, sporting articles

and equipment, golf equipment, golf accessories; the bringing together, for the benefit of others, of a variety of goods namely clothing, footwear, headgear, games, toys and playthings, video game apparatus, computer games apparatus, electronic games, sports games, golf games, handheld electronic games, board games, toy golf sets, sporting articles and equipment, golf equipment, golf accessories, enabling consumers to conveniently compare and purchase those goods.

Class 41

Providing of training; entertainment; sporting ... activities; radio or television coverage of sports events;¹⁰⁷ organisation of sporting ... events and activities; organisation of golf events; organisation of exhibitions; organisation of sports competitions; arranging contests; organisation of Electronic sports and video gaming events, tournaments and competitions; education, provision of training, sporting and cultural activities all relating to the professional video gaming industry; entertainment services in connection with sports events; entertainment services in the form of public viewing of live and delayed broadcast of sports events; information services concerning sports events ...; provision of information relating to golf courses, including global positioning system ("GPS") information, for determining distances on golf courses and for accessing of relevant data and statistics related thereto; issuing of tickets for events, including golf sports events; reservation of entry tickets to sports ... events; ticket reservation services for ... sporting ... events; hospitality services (entertainment); organisation of training and instruction for the game of golf; electronic publication; publication of printed matter and printed publications; publication of magazines, calendars, books, leaflets, posters; providing on-line publications; non-downloadable electronic publications

323. The oppositions under section 5(3) fail in respect of the following goods and services:

¹⁰⁷ In the case of the figurative mark, the term is *Radio or television coverage of sports events, namely radio or television reporting of sports events.*

Class 9

Sunglasses and spectacles; cords, frames, lenses and cases for use with spectacles; earphones; earphones and headsets for mobile telephones; cases adapted for mobile phones; headphones.

Class 14

Precious metal and their alloys; jewellery, precious and semi-precious stones; horological and chronometric instruments; pins (jewellery); brooches (jewellery); tie pins; tie clips; amulets (jewellery); rings (jewellery); earrings; bracelets (jewellery); key rings (trinkets or fobs); novelty key holders; cufflinks; necklaces (jewellery); sculptures; statuettes of precious metal; figurines (statuettes) of precious metal; jewellery; medals; commemorative medals of precious metal, medallions (jewellery); medallions not of precious metal; coins; semi-precious stones; gems (precious stones); horological and chronometric instruments including watches; clocks; wristwatches; electric clocks; pendulums (clock), stopwatches, watch straps.

Class 25

Word and signature marks: Clothing, headgear; coats; jackets; hats; caps; shirts; headbands; sweatshirts; skirts; bandanas; gloves; waterproof clothing; underwear; socks; trousers; shorts; pyjamas; t-shirts.

Figurative mark: Clothing; headgear; articles of outer clothing; sportswear; leisurewear; training clothing; tracksuits; training pants; sweatshirts; sweatpants; jackets; coats; waterproof clothing; anoraks; shirts; tops; t-shirts; polo shirts; vests; knitwear; jerseys; pullovers; sweaters; hooded tops; cardigans; waistcoats; pants; shorts; ties; socks; gloves; mittens; scarves; wristbands; headbands; boots; sandals; slippers; training shoes; hats; caps; sun visors; belts; aprons; uniforms; articles of clothing, footwear and headgear for babies and children; bibs; baby boots.

Class 35

Rental of advertising space on the internet; business administration; business management; office functions.

Class 36

Charitable fund raising services.

Class 41

Education; ... cultural activities; organisation of ... cultural events and activities; information services concerning ... entertainment; audio and video recording services; distribution of sound and images recordings via the internet; reservation of entry tickets to ... entertainment events; ticket reservation services for entertainment ... and cultural events

Section 5(4)(a)

324. Section 5(4)(a) of the Act states that:

“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 or 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 4(A) is met

...”

325. Subsection 4(A) is as follows:

“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.”

326. Ryder Cup is relying on two signs: **RYDER CUP** and **SAMUEL RYDER CLUB**. The first of these puts Ryder Cup in no better a position than its claims under sections 5(2)(b). Although 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, in the light of the Court of Appeal’s decision in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, that the difference between the legal tests will produce different outcomes. I believe that to be the case here. Therefore, I shall focus on the **SAMUEL RYDER CLUB** sign.

327. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341, HL, Lord Oliver of Aylmerton described the ‘classical trinity’ that must be proved in order to reach a finding of passing off:

“First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.”¹⁰⁸

328. *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:

¹⁰⁸ Page 406.

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as 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 are 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

329. In *Maier & Anor v ASOS plc & Anor* [2015] EWCA Civ 220, Kitchin LJ said;

“... Under the English law of passing off, the relevant date for determining whether a claimant has established the necessary reputation or goodwill is the date of the commencement of the conduct complained of (see, for example, *Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] RPC 429). The jurisprudence of the General Court and that of OHIM is not entirely clear as to how this should be taken into consideration under Article 8(4) (compare, for example, T-114/07 and T-115/07 *Last Minute Network Ltd* and Case R 784/2010-2 *Sun Capital Partners Inc*). In my judgment the matter should be addressed in the following way. The party opposing the application or the registration must show that, as at the date of application (or the priority date, if earlier), a normal and fair use of the [contested] trade mark would have amounted to passing off. But if the [contested] trade mark has in fact been used from an earlier date then that is a matter which must be taken into account, for the opponent must show that he had the necessary goodwill and reputation to render that use actionable on the date that it began.”¹⁰⁹

330. SRL has made no use of the contested mark before the application date, which is 16 July 2019 in the case of Application Nos 3414361 and 3414350 and 28 July 2020 in the case of Application No. 3516813. These are therefore the relevant dates for the purposes of assessing the claim under section 5(4)(a).

Goodwill

331. Ryder Cup claims to have used the sign **SAMUEL RYDER CLUB** throughout the UK since 2017 for *Provision of hospitality services at golf events*.

¹⁰⁹ Paragraph 165.

332. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages 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. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates.”¹¹⁰

333. I remind myself of the summary of the evidence that I made earlier in this decision.¹¹¹ The services themselves were provided in France. However, there is evidence to show that some of the customers were UK-based and the undertaking responsible for organising the Ryder Cup golf tournament in Europe is based in the UK. RCE does not state the total value of the hospitality packages sold.

334. In *Smart Planet Technologies, Inc. v Rajinda Sharma (Recup Trade Mark)*, BL O/304/20, Mr Thomas Mitcheson QC, sitting as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After doing so, he concluded that:

“.. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that

¹¹⁰ At [224].

¹¹¹ Paragraphs 60-61.

there would be substantial damage on the basis of the misrepresentation relied upon.”¹¹²

335. Although the use of the sign in the UK had not been particularly longstanding by the relevant date, the nature of the business must be borne in mind. The events at which the services are supplied are not frequent, every-day occurrences. Rather, they are high-profile, large sporting tournaments that are run every few years. Nevertheless, the evidence shows a single use in France in 2018 and two uses in the US in 2008 and 2016 and so I am not persuaded that Ryder Cup has demonstrated that it has sufficient goodwill in the UK for me to find that there would be substantial damage on the basis of the misrepresentation relied upon.

336. The oppositions fail under section 5(4)(a).

OUTCOME

337. Opposition No. 417800 to Application No. 3414361 is partially successful.

338. Opposition No. 417801 to Application No. 3414361 is wholly successful.

339. Opposition No. 417802 to Application no. 3414350 is partially successful.

340. Opposition No. 417803 to Application No. 3414350 is wholly successful.

341. Opposition No. 422368 to Application No. 3516813 is partially successful.

342. Opposition No. 422302 to Application No. 3516813 is wholly successful.

343. The application for a declaration of invalidity against UKTM No. 3409719 has failed. The UKTM will remain registered.

¹¹² Paragraph 34.

344. Registration is refused for Applications Nos 3414361, 3414350 and 3516813 in their entirety.

COSTS

345. Ryder Cup has been successful in these proceedings. At the hearing, Ms McFarland for Ryder Cup requested that the parties be given the opportunity to make detailed submissions on costs following the issue of the substantive decision. Mr Fiddes was in agreement.

346. I therefore give Ryder Cup 14 days from the date of this decision to file written submissions on costs. SRL will then have 14 days from the receipt of those submissions to file its response. I will then consider both sets of submissions and issue a costs decision. At that point, I will set the appeal period.

Dated this 20th day of July 2023

Clare Boucher
For the Registrar,
Comptroller-General

Annex A: Specification of Application No 3414361

Class 9

Software; downloadable software; computer software; computer software platforms; computer software applications; downloadable smart phone applications; application software; software and applications for mobile devices; game software; video game programmes; virtual reality software; computer software for use in accessing, updating, manipulating, modifying, organizing, storing, backing up, synchronizing, transmitting and sharing data, documents, files, information and multimedia content relating to golf courses, the game of golf, golf instruction and golf competitions via a global computer network and via any other communications networks; downloadable electronic publications; sunglasses and spectacles; cords, frames, lenses and cases for use with spectacles; earphones; earphones and headsets for mobile telephones; cases adapted for mobile phones; headphones; Range finders; laser range finders; distance recording apparatus; cameras for recording and analysing golf swings; golf simulators; audiovisual teaching apparatus; apparatus for recording, transmission, processing and reproduction of sound, images or data relating to golf.

Class 25

Clothing, footwear, headgear; coats; jackets; hats; caps; shirts; headbands; sweatshirts; skirts; bandanas; gloves; waterproof clothing; underwear; socks; trousers; shorts; pyjamas; sports shoes; t-shirts.

Class 28

Games, toys and playthings; video game apparatus; computer games apparatus; electronic games; sports games; handheld electronic games; board games; toy golf sets; sports games; sporting articles and equipment; golf equipment and golf accessories, including golf clubs, golf grips, golf balls, golf gloves, golf tees, golf club head covers, golf bags, shafts.

Class 35

Advertising, marketing and promotional services; promotion of sports competitions and events; promotion of goods and services through sponsorship of sports events; promotion of goods and services of third parties; advertising services relating to golf

equipment and golf events; advertising for sports events; television advertising; radio advertising; advertising via the internet; rental of advertising space on the internet; rental of advertising space at golf events; business administration; business management; office functions; Advertising, sponsorship (promotion and marketing services) and business management of a professional video gaming sports team and persons who participate in competitions and events for computer games; advertising, sponsorship (promotion and marketing services) of competitions and events for computer games; Retail services in relation to clothing, footwear, headgear, games, toys and playthings, video game apparatus, computer games apparatus, electronic games, sports games, golf games, handheld electronic games, board games, toy golf sets, sporting articles and equipment, golf equipment, golf accessories; the bringing together, for the benefit of others, of a variety of goods namely clothing, footwear, headgear, games, toys and playthings, video game apparatus, computer games apparatus, electronic games, sports games, golf games, handheld electronic games, board games, toy golf sets, sporting articles and equipment, golf equipment, golf accessories, enabling consumers to conveniently compare and purchase those goods; the aforementioned services all available via any communications media.

Class 41

Education; providing of training; entertainment; sporting and cultural activities; radio or television coverage of sports events; organisation of sporting and cultural events and activities; organisation of golf events; organisation of exhibitions; organisation of sports competitions; arranging contests; organisation of Electronic sports and video gaming events, tournaments and competitions; education, provision of training, sporting and cultural activities all relating to the professional video gaming industry; entertainment services in connection with sports events; entertainment services in the form of public viewing of live and delayed broadcast of sports events; information services concerning sports events or entertainment; audio and video recording services; distribution of sound and images recordings via the internet; Provision of information relating to golf courses, including global positioning system ("GPS") information, for determining distances on golf courses and for accessing of relevant data and statistics related thereto; issuing of tickets for events, including golf sports events; reservation of entry tickets to sports or entertainment events; ticket reservation services for entertainment, sporting and cultural events; hospitality services (entertainment);

organisation of training and instruction for the game of golf; electronic publication; publication of printed matter and printed publications; publication of magazines, calendars, books, leaflets, posters; providing on-line publications; non-downloadable electronic publications; the aforementioned services all available via any communications media.

Annex B: Specification of Application No. 3414350

Class 9

Software; downloadable software; computer software; computer software platforms; computer software applications; downloadable smart phone applications; application software; software and applications for mobile devices; game software; video game programmes; virtual reality software; computer software for use in accessing, updating, manipulating, modifying, organizing, storing, backing up, synchronizing, transmitting and sharing data, documents, files, information and multimedia content relating to golf courses, the game of golf, golf instruction and golf competitions via a global computer network and via any other communications networks; downloadable electronic publications; sunglasses and spectacles; cords, frames, lenses and cases for use with spectacles; earphones; earphones and headsets for mobile telephones; cases adapted for mobile phones; headphones; Range finders; laser range finders; distance recording apparatus; cameras for recording and analysing golf swings; golf simulators; audiovisual teaching apparatus; apparatus for recording, transmission, processing and reproduction of sound, images or data relating to golf.

Class 14

Precious metals and their alloys; jewellery, precious and semi-precious stones; horological and chronometric instruments; pins (jewellery); brooches (jewellery); tie pins; tie clips; amulets (jewellery); rings (jewellery); earrings; bracelets (jewellery); key rings (trinkets or fobs); novelty key holders; cufflinks; necklaces (jewellery); sculptures; statuettes of precious metal; figurines (statuettes) of precious metal; jewellery; medals; commemorative medals of precious metal, medallions (jewellery); medallions not of precious metal; coins; semi-precious stones; gems (precious stones); horological and chronometric instruments including watches; clocks; wristwatches; electric clocks; pendulums (clock), stopwatches, watch straps.

Class 25

Clothing, footwear, headgear; coats; jackets; hats; caps; shirts; headbands; sweatshirts; skirts; bandanas; gloves; waterproof clothing; underwear; socks; trousers; shorts; pyjamas; sports shoes; t-shirts.

Class 28

Games, toys and playthings; video game apparatus; computer games apparatus; electronic games; sports games; handheld electronic games; board games; toy golf sets; sports games; sporting articles and equipment; Golf equipment and golf accessories, including golf clubs, golf grips, golf balls, golf gloves, golf tees, golf club head covers, golf bags, shafts.

Class 41

Education; providing of training; entertainment; sporting and cultural activities; radio or television coverage of sports events; organisation of sporting and cultural events and activities; organisation of golf events; organisation of exhibitions; organisation of sports competitions; arranging contests; organisation of Electronic sports and video gaming events, tournaments and competitions; education, provision of training, sporting and cultural activities all relating to the professional video gaming industry; entertainment services in connection with sports events; entertainment services in the form of public viewing of live and delayed broadcast of sports events; information services concerning sports events or entertainment; audio and video recording services; distribution of sound and images recordings via the internet; Provision of information relating to golf courses, including global positioning system ("GPS") information, for determining distances on golf courses and for accessing of relevant data and statistics related thereto; issuing of tickets for events, including golf sports events; reservation of entry tickets to sports or entertainment events; ticket reservation services for entertainment, sporting and cultural events; hospitality services (entertainment); organisation of training and instruction for the game of golf; electronic publication; publication of printed matter and printed publications; publication of magazines, calendars, books, leaflets, posters; providing on-line publications; non-downloadable electronic publications; the aforementioned services all available via any communications media.

Annex C: Specification for Application No. 3516813

Class 25

Clothing; footwear; headgear; articles of outer clothing; sportswear; leisurewear; training clothing; tracksuits; training pants; sweatshirts; sweatpants; jackets; coats; waterproof clothing; anoraks; shirts; tops; t-shirts; polo shirts; vests; knitwear; jerseys; pullovers; sweaters; hooded tops; cardigans; waistcoats; pants; shorts; ties; socks; gloves; mittens; scarves; wristbands; headbands; shoes; boots; sandals; slippers; sports shoes; training shoes; hats; caps; sun visors; belts; aprons; uniforms; articles of clothing, footwear and headgear for babies and children; bibs; baby boots.

Class 28

Games, toys and playthings; video game apparatus; computer games apparatus; electronic games; sports games; handheld electronic games; board games; toy golf sets; sports games; sporting articles and equipment; golf equipment and golf accessories, including golf clubs, golf grips, golf balls, golf gloves, golf tees, golf club head covers, golf bags, shafts.

Class 36

Charitable fund raising services.

Class 41

Education; providing of training; entertainment; sporting and cultural activities; radio or television coverage of sports events, namely radio or television reporting of sports events; organisation of sporting and cultural events and activities; organisation of golf events; organisation of exhibitions; organisation of sports competitions; arranging contests; organisation of electronic sports and video gaming events, tournaments and competitions; education, provision of training, sporting and cultural activities all relating to the professional video gaming industry; entertainment services in connection with sports events; information services concerning sports events or entertainment; audio and video recording services; distribution of sound and images recordings via the internet; provision of information relating to golf courses, including global positioning system ("GPS") information, for determining distances on golf courses and for accessing of relevant data and statistics related thereto; issuing of tickets for events,

including golf sports events; reservation of entry tickets to sports or entertainment events; ticket reservation services for entertainment, sporting and cultural events; hospitality services (entertainment); organisation of training and instruction for the game of golf; electronic publication; publication of printed matter and printed publications; publication of magazines, calendars, books, leaflets, posters; providing on-line publications; non-downloadable electronic publications; the aforementioned services all available via any communications media.

Anne D: Specification of UKTM No. 3409719

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 and golf matches; 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; spectacles; cases and cords for sunglasses; visors; mobile phone accessories; mobile phone cases; mouse mats; computer game programs; encoded or magnetic credit cards, debit cards and affinity cards/

Class 14

Jewellery; horological and chronometric instruments; cufflinks; trophies made of precious metals and their alloys.

Class 16

Printed publications; books, magazines, newsletters; printed programmes; stationery; printed photographs; posters; albums; paper party decorations; art prints; greeting cards.

Class 18

Bags; trunks and travelling bags; suitcases; handbags; wallets; purses; toiletries bags; briefcases; umbrellas, parasols and walking sticks.

Class 21

Household or kitchen utensils and containers; glassware, porcelain and earthenware; cups; mugs; flasks.

Class 25

Clothing; footwear; headgear.

Class 28

Games and playthings; sporting articles; golf equipment; golf balls, golf bags, golf clubs, golf tees, head covers for golf clubs; hand held computer games; playing cards; soft toys; decorations for Christmas trees.

Class 41

Entertainment services; corporate hospitality (entertainment); sporting activities; organisation of golf tournaments and golf competitions; golf training and golf coaching; providing access to, and information on, golf training and coaching; publication of magazines, programmes and other printed matter relating to golf, golf tournaments and golf competitions; providing non-downloadable electronic publications in relation to golf, golf tournaments and golf competitions.

Class 43

Hotel services; restaurant services; bar and café services; hospitality services (food and drink).