

O/1210/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003917135
BY MODERN GOLF LTD. TO REGISTER:

MODERN  GOLF

AS A TRADE MARK IN CLASSES 16, 18, 25, 28, 35 & 41

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 443193 BY
TOPGOLF CALLAWAY BRANDS CORP.

BACKGROUND AND PLEADINGS

1. On 30 May 2023, Modern Golf Ltd. (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK (“the applicant’s mark”). The applicant’s mark was published on 23 June 2023 and registration is sought for the following goods and services:

Class 16: Gift cards.

Class 18: All-purpose athletic bags; backpacks; duffel bags; golf umbrellas.

Class 25: Golf caps; golf cleats; golf hats; golf jackets; golf pants; golf shirts; golf shorts; golf skirts; golf trousers; caps; visors being headwear; vests; wind resistant jackets; pullovers; sportswear; women's sportswear; causal clothing; sweaters; wind shirts; polo shirts; hats; skorts; sleeveless polo shirts; golf shoes; athletic apparel; athletic footwear; golf footwear; golf knickers; golf wear.

Class 28: Golf club head covers; golf bag covers; golf bag tags; golf bag trolleys; golf ball markers; golf ball retrievers; golf club heads; golf club shafts; golf driving practice mats; golf flags; golf practice nets; golf putting practice mats; golf tee markers; golf training equipment; golf ball spotters; golf putters; golf mats; golf tee bags; golf training aids; golf bags; golf balls; golf club grips; golf gloves; golf clubs; golf divot repair tools; golf putting aids; golf tees.

Class 35: Retail store and online retail services connected with the sale of, all-purpose athletic bags, backpacks, duffel bags, golf umbrellas, golf caps, golf cleats, golf hats, golf jackets, golf pants, golf shirts, golf shorts, golf skirts, golf trousers, caps, visors being headwear, vests, wind resistant jackets, pullovers, sportswear,

women's sportswear, causal clothing, sweaters, wind shirts, polo shirts, hats, skorts, sleeveless polo shirts, golf shoes, athletic apparel, athletic footwear, golf club head covers, golf bag covers, golf bag tags, golf bag trolleys, golf ball markers, golf ball retrievers, golf club heads, golf club shafts, golf driving practice mats, golf flags, golf practice nets, golf putting practice mats, golf tee markers, golf training equipment, golf ball spotters, golf putters, golf mats, golf tee bags, golf training aids, golf bags, golf balls, golf club grips, golf clubs, golf divot repair tools, golf footwear, golf gloves, golf knickers, golf putting aids, golf tees, golf wear.

Class 41: Organization and coordination of an indoor golf league; providing indoor and outdoor golf facilities; entertainment services; arrangement of golf tournaments; entertainment in the nature of golf tournaments; entertainment services in the nature of providing indoor golf training simulator services; golf fitness instruction; golf lessons; golf clinics; providing golf facilities; providing news and information on the sport of golf; rental of golf equipment; fitting of golf clubs; golf instruction.

2. On 22 September 2023, the applicant's mark was opposed by Topgolf Callaway Brands Corp. ("the opponent"). The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). Under the section 5(2)(b) and 5(3) grounds of opposition, the opponent relies on the following trade marks:

MODERN GOLF

UK registration no. 3866255

Filing date 10 January 2023; registration date 29 September 2023

Partial priority claimed: 29 July 2022 (Jamaica)

Relying on all goods and services, namely:

Class 18: Backpacks; Brief bags; Briefcases; Carryalls; Handbags; Haversacks; Hip sacks; Luggage; Satchels; Suitcases; Umbrellas; All-purpose carrying bags; Attaché cases; Backpacks compatible with personal hydration systems, sold empty; Backpacks with rolling wheels; Belt bags; Book bags; Bum bags; Carry-all bags; Carry-on bags; Carrying cases; Clutch bags; Courier bags; Duffel bags; Duffel bags for travel; Fitted protective covers for travel bags, namely, luggage, backpacks and travel bags; Grip bags; Gym bags; Hiking bags; Leather bags; Messenger bags; Overnight bags; Overnight suitcases; Roll bags; Ruck sacks; Shoe bags for travel; Shoulder bags; Small backpacks; Small suitcases; Travel baggage; Travel bags; Travel cases; Travelling bags; Waist bags; Weekend bags; Wheeled bags; Wheeled duffel bags; Wheeled tote bags; Wallets; Purses; Tote bags; Daypacks; Pack bags; Hiking rucksacks; Hiking sticks; Garment bags; Alpenstocks.

Class 25: Beanies; Boxer shorts; Underwear; Undergarments; Parkas; Clothing, namely, parkas, underwear, bathing suits, bathing trunks, swimwear, beachwear, leotards, unitards; Belts.

Class 35: Business management; business administration; office functions; business management and consultancy services; Retail store services relating to camping equipment; On-line retail store services relating to camping equipment.

("the opponent's first mark");

LEADER IN MODERN GOLF

UK registration no.3866265

Filing date 10 January 2023; registration date 29 September 2023

Partial priority claimed: 29 July 2022 (Jamaica)

Relying on all goods and services, being identical to those relied upon under the first mark.

("the opponent's second mark");

CALLAWAY MODERN GOLF

UK registration no. 3866336

Filing date 10 January 2023; registration date 19 May 2023

Partial priority claimed: 29 July 2022 (Jamaica)

Relying on all goods and services, namely:

Class 18: Bags; Backpacks; Brief bags; Briefcases; Carryalls; Handbags; Haversacks; Hip sacks; Holdalls; Luggage; Satchels; Suitcases; Umbrellas; All-purpose athletic bags; All-purpose carrying bags; All-purpose sport bags; Athletic bags; Attaché cases; Backpacks compatible with personal hydration systems, sold empty; Backpacks with rolling wheels; Bags and holdalls for sports clothing; Bags for sports; Belt bags; Book bags; Bum bags; Carry-all bags; Carry-on bags; Carrying cases; Clutch bags; Courier bags; Duffel bags; Duffel bags for travel; Fitted protective covers for travel bags, namely, luggage, backpacks and travel bags; Golf umbrellas; Grip bags; Gym bags; Hiking bags; Leather bags; Messenger bags; Overnight bags; Overnight suitcases; Roll bags; Ruck sacks; Shoe bags for travel; Shoulder bags; Small backpacks; Small suitcases; Sport bags; Travel baggage; Travel bags; Travel cases; Travelling bags; Waist bags; Weekend bags; Wheeled bags; Wheeled duffel bags; Wheeled tote bags; Wallets; Purses; Tote bags; Daypacks; Pack bags; Hiking rucksacks; Hiking sticks; Garment bags; Alpenstocks.

Class 25: Clothing; Beanies; Hats; Headwear; Headwear, namely, beanies, hats, caps, and visors; Visors being headwear; Cap visors; Caps with visors; Footwear; Bottoms as clothing; Outerwear; Outerwear, namely, coats, jackets, hoodies, vests, sweaters, hats, pants, gloves, mittens, and scarves; Tops as clothing; Boxer shorts; Underwear; Undergarments; Shirts; Boots; Coats; Parkas; Pullovers; Shoes; Vests; Fleece jackets; Half-boots; Heavy jackets; Knit jackets; Knitted gloves; Lace boots; Long jackets; Outdoor gloves; Outer jackets; Quilted vests; Rainproof jackets; Trekking boots; Waterproof jackets and pants; Wind-jackets; Wind-resistant vests; Winter boots; Clothing, namely, pullovers, sweaters, sweatshirts, shirts, blouses, t-shirts, polo shirts, jackets, parkas, anoraks, coats, windcheaters, vests, pants, shorts, underwear, bathing suits, bathing trunks, swimwear, beachwear, leotards, unitards; waterproof clothing, namely, windproof and waterproof jackets, vests, weatherproof jackets, fleece jackets, fleece pullovers, fleece sweaters; Belts.

Class 28: Sporting articles and equipment; Golf balls; golf bags; bag stands for golf bags; golf ball pitching machines; caddie bags for golf clubs; golf club hoods; covers for golf bags; covers for golf clubs; divot repair tools for golf; golf bags, with or without wheels; golf bag trolleys; golf ball markers; golf ball retrievers; golf ball spotters; golf club covers; golf club grips; golf club head covers; golf club heads; golf club shafts; golf clubs; golf gloves; golf irons; golf mats; golf practice apparatus; golf practice nets; golf putters; golf swing alignment apparatus; golf tee bags; golf tees; golf training aids; grips for golf clubs; handles for golf clubs; pitch mark repair tools for golf; putting cups; putting discs for indoor putting practice; putting mats for indoor putting practice; golf flags; stands for golf bags; stands specially adapted for holding golf club.

Class 35: Advertising, publicity, promotion services; market research; dissemination of advertising; publicity and promotion services; business management; business administration; office functions; business management and consultancy services; Retail clothing boutique services in relation to clothing; Retail clothing store services in relation to clothing; Retail store services relating to golf clubs, golf balls, golf bags, golf equipment, sports equipment, apparel, men's apparel, women's apparel, kids apparel, clothing accessories, footwear, headwear, eyewear, bags, sport bags, backpacks, luggage, outdoor and travel equipment, camping equipment, and outdoor and travel accessories; On-line retail store services relating to golf clubs, golf balls, golf bags, golf equipment, sports equipment, apparel, men's apparel, women's apparel, kids apparel, clothing accessories, footwear, headwear, eyewear, bags, sport bags, backpacks, luggage, outdoor and travel equipment, camping equipment, and outdoor and travel accessories.

Class 41: Fitting of golf clubs to individual users; Entertainment services; Education and training services; Providing entertainment information via the internet in the field of golf; providing non-downloadable videos in the field of golf via a website; entertainment in the nature of golf tournaments and games; conducting workshops and seminars in the field of golf; golf courses; golf driving range services; golf instruction; providing golf facilities; rental of golf equipment; entertainment services, namely, arranging and conducting of golf competitions; golf club services; providing recreational and amusement facilities; Film and video production; Entertainment services, namely, providing online interactive games; Providing entertainment information via

the internet in the field of sports, video games, entertainment, literature, arts, current events and popular culture; on-line journals, namely, blogs in the field of sports, entertainment, lifestyle, food and popular culture; Arranging, organizing, conducting, and hosting social entertainment events; Entertainment services, namely, arranging, organizing, and conducting special events at sports venues; Entertainment services, namely, organizing, arranging, and conducting an array of social entertainment events rendered live and recorded for the purpose of distribution through broadcast media.

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

DRIVING THE COURSE TO MODERN GOLF

UK registration no. 3866300

Filing date 10 January 2023; registration date 19 May 2023

Partial priority claimed: 29 July 2022 (Jamaica)

Relying on all goods and services, being identical to those relied upon under the third mark.

("the opponent's fourth mark").

3. Under the section 5(2)(b) ground, the opponent claims that the marks at issue are similar and that the goods and services are identical or similar. Further, the opponent claims that its marks enjoy an enhanced degree of distinctive character due to the use made of them. In light of this, the opponent's position is that there is a risk of confusion and/or association between the marks.
4. Turning to the section 5(3) ground, the opponent claims that its marks enjoy a reputation as a result of the use made of them in the UK. The opponent's position is that due to the similarity of the marks, the consumer will invariably associate the applicant's mark with the opponent's marks. As a result, it is claimed that use of

the applicant's mark, without due cause, would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the opponent's marks.

5. Lastly, under the section 5(4)(a) ground, the opponent relies on the unregistered sign 'MODERN GOLF'. The opponent claims to have used this sign throughout the UK since August 2022 in respect of the following:

“Software; printed matter; photographs; gift cards; bags; backpacks; clothing; footwear; headgear; sports equipment; golf equipment; golf clubs; golf balls; golf accessories; retail services relating to the aforementioned goods; promotional services relating to golf; commercial services; entertainment services; sporting services; training; education; providing golf facilities; sporting services relating to golf; virtual golf services; driving range services.”

6. As a result of the use of the sign on the above goods and services, the opponent claims to enjoy a protectable goodwill in its sign and, as such, argues that use of the applicant's mark would misrepresent to consumers that the contested goods and services originate from, or are at least associated with, or approved by, the opponent. It is claimed that this misrepresentation would cause damage to the opponent.
7. The applicant filed a counterstatement denying the claims against it.
8. The applicant is represented by Barker Brettell LLP and the opponent is represented by Abion UK Limited. Only the opponent filed evidence. No hearing was requested and only the applicant filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.
9. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the

Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

10. The opponent's evidence came in the form of the witness statement of Joe Doyle-Ward dated 15 August 2024. Mr Doyle-Ward is a Trade Mark Attorney at the opponent's representative firm. His statement is accompanied by five exhibits, being JDW1 to JDW5, and was adduced in order to prove that the opponent's marks and sign enjoy reputation and goodwill, respectively.

11. I do not intend to summarise the opponent's evidence in full here (or the applicant's submissions, for that matter). However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

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

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

“(2) A trade mark shall not be registered if because-

(a) [...]

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

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

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

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

14. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.

[...]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

15. Given their earlier filing dates, all of the opponent’s marks qualify as earlier trade marks under the above provisions. None of the opponent’s marks completed their registration processes more than five years prior to the filing date of the applicant’s mark. As a result, the opponent’s marks are not subject to the use provisions meaning that the opponent is entitled to rely on all of the goods and services for which its marks are registered and which it has identified in the notice of opposition.

16. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (“OHIM”)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the

imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

17. The applicant's goods and services are set out at paragraph 1 above whereas the opponent's goods and services are set out at paragraph 2.

18. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

"Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

20. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

21. I have submissions from the applicant in respect of the goods and services comparison. Having considered these, it is noted that the applicant has conceded some similarity between its own goods and services and the goods and services in the opponent’s third and fourth marks’ specifications. I will deal with this further below. The most notable point to take from the submissions, however, is that the applicant claims that the goods and services for which the opponent’s first and second marks are protected are dissimilar to its own goods and services on the basis that the applicant’s goods and services relate specifically to golf, whereas the opponent’s do not. On this point, the applicant refers to the fact that the

opponent's first and second marks were refused registration for golf related goods due to their descriptive nature. As such, it is claimed that the opponent's goods and services under this mark cannot cover those used in relation to golf. While I note that the opponent's first and second marks were refused for golf related goods and services by the IPO upon initial examination,¹ the goods and services for which it stands registered are not limited in any way. As such, and because the present assessment I must make is a notional one based on the terms as they appear before me, I am entitled to treat the opponent's goods and services as including those that may be used whilst playing golf or might be provided in the field of golf. For example, while some goods in the opponent's first and second marks (such as those that relate to swimwear) will not be used in relation to golf, I see no reason why 'beanies' in class 25 cannot reasonably be said to cover beanies to be worn whilst playing golf.

22. Given the differing specifications across the opponent's marks and the concession as to similarity in relation to the goods and services in the opponent's third and fourth marks only, I will conduct my comparison by looking at the applicant's specification against the opponent's specifications separately, albeit grouping them accordingly. I will begin with the opponent's first and second marks.

The opponent's first and second marks

Class 16

23. The sole term in class 16 of the applicant's specification is "gift cards". While I appreciate that a range of undertakings offer gift cards, I am not convinced that this means that gift cards are automatically similar to the other goods or services offered by those undertakings. If this were the case, then "gift cards" would be similar to such a wide variety of terms that it would offer an unduly broad scope of

¹ The decisions confirming this outcome are provided in Annex 1 of the applicant's written submissions.

protection. In the present case, I see no obvious reason why the goods or services in classes 18, 25 and 35 in the opponent's first and second mark's specifications would share any material degree of overlap with "gift cards" to the point that it would give rise to a meaningful degree of similarity between them. As such, I find them to be dissimilar.

Class 18

24. In respect of the present specifications, I note that they all include the term "backpacks" and "duffel bags". As such, I find that these terms are self-evidently identical. Also in respect of the present class, I note that the applicant's specification includes the term "all-purpose athletic bags" whereas the opponent's specifications include "all-purpose carrying bags". I consider that the opponent's term can be used to carry athletic gear and, therefore, I see no reason why it cannot be classified as an athletic bag. As such, I find that the opponent's term encompasses the applicant's term meaning that these goods are identical under the principle outlined in *Meric*. Lastly, I note that the applicant's specification includes the term "golf umbrellas" which are encompassed by the opponent's broader term of "umbrellas". Therefore, I also find that these goods are identical under the principle outlined in *Meric*.

Class 25

Hats.

25. Plainly, "beanies" (which appear in the opponent's first and second marks' specifications) are types of hats. As a result, I find that these goods are identical under the principle outlined in *Meric*.

Golf hats.

26. I see no reason why the above terms cannot cover hats worn whilst playing golf in cold conditions. Given that the opponent's first and second mark's specifications include the term "beanies", I find that these goods are identical under the principle outlined in *Meric*, be that because the opponent's good falls within the applicant's, or vice versa.

Golf caps; caps; visors being headwear.

27. In the context of the opponent's "beanies" being capable of being golf beanies, I consider that the above goods are similar to the opponent's. I say this because while the natures of the goods differ, they share the same method of use in that they are worn on the head. As for purpose, I consider that there is some overlap here in that the goods are all worn to protect the wearer from the elements, be that the bright sun or cold weather. In respect of trade channels, I consider that an undertaking responsible for golf caps or visors will also sell golf beanies and such goods will be found in close proximity in stores or in the same sections of websites. Both parties' goods will be sought by the same user to enable them to play across all seasons meaning that they overlap in user also. The goods are not complementary and neither are they competitive. In my view, the aforementioned overlaps are sufficient to give rise to a medium to high degree of similarity.

Golf pants; golf shorts; golf skirts; golf trousers; skorts.

28. On the basis that golf wear can include golf trousers, I find that all of the above goods can be worn with a belt. As the opponent's first and second marks' specifications includes the term "belts", it is this good that I will compare with the above. While the nature, method of use and purpose of these goods differ, I am of the view that there is a degree of overlap in trade channels and user. I say this because an undertaking that sells the above goods is also likely to sell belts to

wear with the same. Further, the goods are likely to be found in close proximity to one another in larger stores or will all be sold by specialist golf retailers. The user will overlap on the basis that someone who wears the applicant's goods is also likely to wear a belt. Lastly, there is a degree of complementarity to these goods as belts are used to hold the user's trousers, skirts, shorts or shorts up meaning that they are important to one another. I consider that the relationship between the said goods is likely to lead the consumer to believe that they originate from the same undertaking.² As a result, I find that these goods are similar to between a low and medium degree.

Golf knickers.

29. In considering the above term, I am of the view that they cover a more traditional style of trouser that is worn whilst playing golf. As such, and despite the use of the term 'knickers', they are not a type of underwear or undergarment. As a result, I am of the view that as a type of golf trouser, the findings I have made in the preceding paragraph can apply directly to the above term in that the goods are similar to between a low and medium degree with "belts" in the opponent's first and second marks' specifications.

Golf wear.

30. I consider that the above can cover belts and beanies worn for playing golf. As such, I find that the above term is sufficiently broad enough to cover the term of "belts" and "beanies" in the opponent's first and second marks' specifications. Therefore, these goods are identical under the principle outlined in *Meric*. However, if I am wrong to interpret the above term in this way, then it can still plainly cover golf trousers meaning that the reasoning set out at paragraph 28 above is applicable here resulting in a finding that if the opponent's goods are not identical

² *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

to the above, then it is similar to the opponent's term "belts" to between a low and medium degree.

Golf jackets; golf shirts.

31. In respect of the first term listed above, I note that the opponent's first and second marks' specifications includes "parkas". However, these are larger winter coats and I do not consider that these are commonly worn whilst golfing. As such, I do not consider that the above goods share any similarity with the opponent's terms of "parkas" or "clothing, namely, parkas". That being said, in considering the above alongside the terms "beanies" and "belts" in the opponent's first and second marks' specifications, I do consider that there is some degree of overlap. I say this because whilst the goods differ in nature, method of use and purpose, I see no reason why an undertaking that provides golf jackets and shirts would not also provide golf beanies or golf belts, both of which are covered by the opponent's terms. Such goods may not necessary be found next to each other in stores, however, they will all be offered by specialist golfing retailers and even in larger sports retailers, they are likely to be in the same section. Additionally, the user of these goods will overlap on the basis that someone seeking a golf jacket is also likely to also purchase a beanie to wear whilst playing golf. Overall, I consider that these overlaps are such that they give rise to a finding that these goods are similar to a low degree.

Vests.

32. While a vest can be worn as a type of outerwear, it is also commonly used as a type of undergarment worn under a t-shirt or a jumper, for example. Therefore, I consider that it falls within the term "undergarments", which is in the opponent's first and second marks' specifications. These goods are, therefore, identical under the principle outlined in *Meric*.

Wind resistant jackets.

33. The above term is very broad and, in my view, can cover an incredibly wide range of jackets as many of them are purported to be wind resistant. This broad interpretation will cover “parkas”, being a term in the opponent’s first and second marks’ specifications. As such, I find that as the applicant’s term encompasses the opponent’s, these goods are identical under the principle outlined in *Meric*.

Sportswear; women's sportswear; athletic apparel.

34. The above terms are very broad and, in my view, will cover goods such as “swimwear”, “leotards” and “unitards” (all of which appear in the opponent’s first and second marks’ specifications) that will be used in sporting/athletic events such as competitive swimming, amateur wrestling or gymnastics. As a result, I find that the above goods encompass the opponent’s goods meaning that they are identical under the principle outlined in *Meric*.

Casual clothing.

35. Clearly, the above term is meant to be read as ‘casual’ clothing and I will consider it as such. Casual clothing is very broad and can cover any type of clothing worn casually. This can include the opponent’s terms of “beanies”, “parkas” and even “undergarments” (on the basis that a vest is, technically, an undergarment but can also be worn casually). As a result, I find that these goods are identical under the principle outlined in *Meric*.

Polo shirts; sleeveless polo shirts.

36. The opponent’s first and second marks’ specifications include the term “clothing, namely [...] beachwear”. Upon the plain reading of this term, it will clearly cover goods like swimming trunks. However, I am of the view that it will also cover other

items of clothing that someone may wish to wear to the beach, whether they intend to swim or not. On this point, I do not consider this extends to any type of clothing as, technically, someone may go to a beach during the winter and wear rainproof gear. This is not the plain reading of the term but, I am of the view that it can reasonably be construed as covering goods such as shorts, various types of t-shirts, sarongs, vests, coverups and beach dresses, for example.³ I consider it reasonable to conclude that beachwear will cover the above terms of the applicant. As such, I find that these goods are identical under the principle outlined in *Meric*.

Sweaters; wind shirts; pullovers.

37. While I do not consider that the opponent's first and second marks' specifications include goods that are identical to the above goods, I do consider that they include some similar goods. In my view, the similar terms are "beanies", "parkas", "clothing, namely [...] beachwear" and "undergarments". All of these terms will be worn on the body for the purpose of protecting the user from the elements. As such, there is a degree of overlap in purpose, albeit not a particularly compelling one. In addition, I am of the view that an undertaking that provides the above goods of the applicant is also likely to provide a range of other types of clothing and this includes the opponent's goods. On this point, I appreciate that these goods will not necessarily be found in close proximity to one another in stores. The user will also overlap to a degree on the basis that the consumer of these goods will be the general public at large. The goods are not competitive in nature and neither are they complementary. I appreciate that the aforementioned overlaps are not direct, however, I am of the view that they are sufficient to give rise to a finding that these goods are similar to a low degree.

³ In reaching this finding, I do not consider that this to be a liberal interpretation of the term that results in it becoming fuzzy or imprecise, as per *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch)

Golf cleats; golf shoes; athletic footwear; golf footwear.

38. I note that throughout the comparison of the parties' class 25 goods, I have found an overlap in trade channels between clothing items that were broad enough to cover those worn for golf and those specifically designated as being worn for golf. However, while I considered this appropriate for clothing goods, I note that the opponent's first and second marks' specifications do not include any footwear goods. I am of the view that to construe similar overlaps here would be a step too far. As such, I am not willing to find that there is a sufficient overlap in trade channels between the opponent's clothing goods and the above. I say this because it is not obvious to me that a provider of beanies or belts (that can be used for golfing) would also produce and sell the above footwear goods and I have nothing before me to suggest otherwise.⁴ On this point, I accept that the parties goods, in this context, will be found in the same retail environments. However, they will not be found within close proximity of one another and I do not consider it sufficient to find a meaningful overlap on that basis alone. While there is an overlap in user between such goods, all other factors differ. For example, the goods do not overlap in nature, method of use or purpose and neither are they complementary or competitive with each other. Overall, I am not convinced that there is any meaningful degree of similarity between these goods. They are, therefore, dissimilar.

Class 28

Golf club head covers; golf bag covers; golf bag tags; golf bag trolleys; golf ball markers; golf ball retrievers; golf club heads; golf club shafts; golf driving practice mats; golf flags; golf practice nets; golf putting practice mats; golf tee markers; golf training equipment; golf ball spotters; golf putters; golf mats; golf tee bags; golf training aids;

⁴ I appreciate that larger clothing brands may also sell footwear goods but I am not convinced that this is necessarily the case when it comes to specific golfing brands.

golf bags; golf balls; golf club grips; golf gloves; golf clubs; golf divot repair tools; golf putting aids; golf tees.

39. The opponent's first and second marks' specifications do not include any goods in class 28. Instead, I consider that the best comparator in those marks' specifications is its clothing goods, namely "beanies" and belts". I consider these goods the closest terms on the basis that, as above, I have found that they can be used whilst golfing. Plainly, the goods differ in nature, method of use and purpose. Further, I see no reason to find that they are competitive or complementary with each other. As for trade channels, I am of the view that while some large undertakings may sell both golf clothing and golf equipment, I have nothing before me to suggest that it is common in the trade. Such goods may be sold via the same golf specialist retailers; however, this is insufficient by itself to find any meaningful overlap here. If it were then large sporting goods and clothing undertakings would be afforded far too broad a scope of protection. Lastly, in respect of user, I accept that someone who buys the above goods is also likely to buy a beanie or a belt for use whilst playing golf. However, this alone is not sufficient to find any meaningful degree of overlap between these goods. As a result, I find that these goods are dissimilar.

Class 35

40. In considering the applicant's class 35 services (all of which being retail services), I consider that the best option for the opponent in respect of its first and second marks lies in its goods.⁵ I take this approach because, as per the case of *Oakley, Inc v OHIM*, Case T-116/06 (at paragraphs 46 to 57), even though retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

⁵ I appreciate that the opponent's first and second marks do include some retail services but these relate to camping equipment. However, the goods covered by the parties' retail services are so distinct that any overlaps would, in my view, be fleeting.

41. In addition to the above, I refer to the case of *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, wherein Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services versus goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

42. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*, Case C-411/13P and *Assembled Investments (Proprietary) Ltd v. OHIM*, Case T-105/05, at paragraphs [30] to [35] of the judgment, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd* Case C-398/07P, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

Retail store and online retail services connected with the sale of, all-purpose athletic bags, backpacks, duffel bags, golf umbrellas, golf caps, [...] golf hats, [...] vests, wind resistant jackets, [...] caps, visors being headwear, [...] sportswear, women's sportswear, casual clothing, [...] polo shirts, hats, [...] sleeveless polo shirts [and] athletic apparel.

43. Taking into account the case law referenced above and the fact that I have found either identity or higher degrees of similarity in respect of the goods covered by the above services in my class 25 and 18 comparison above, I find that the above services are similar to a medium degree with the opponent's class 25 and 18 goods. For the avoidance of doubt, I do so because I consider that these goods and services overlap in trade channels and user and share a complementary relationship in the way expressed by the case law.

Retail store and online retail services connected with the sale of [...] golf jackets, golf pants, golf shirts, golf shorts, golf skirts, golf trousers, [...] pullovers, [...] sweaters, wind shirts, skorts [and] golf wear.

44. Again, bearing in mind the case law cited above, I accept that the above services overlap in user and trade channels with the class 25 goods in the opponent's first and second marks' specifications. However, the degree of complementarity is lacking due to the lack of importance between the above services and the goods relied upon. As a result, I find that the above services are only similar to a low degree with the opponent's goods.

Retail store and online retail services connected with the sale of golf cleats [...] golf shoes [...] athletic footwear [...] golf club head covers, golf bag covers, golf bag tags, golf bag trolleys, golf ball markers, golf ball retrievers, golf club heads, golf club shafts, golf driving practice mats, golf flags, golf practice nets, golf putting practice mats, golf tee markers, golf training equipment, golf ball spotters, golf putters, golf mats, golf tee bags, golf training aids, golf bags, golf balls, golf club grips, golf clubs, golf divot repair tools, golf footwear, golf gloves, golf knickers, golf putting aids, golf tees.

45. Given that I have found the goods covered by the above retail services to be dissimilar to the opponent's goods in its first and second marks' specification, I find that these services are also dissimilar.

Class 41

Organization and coordination of an indoor golf league; providing indoor and outdoor golf facilities; entertainment services; arrangement of golf tournaments; entertainment in the nature of golf tournaments; entertainment services in the nature of providing indoor golf training simulator services; golf fitness instruction; golf lessons; golf clinics; providing golf facilities; providing news and information on the sport of golf; rental of golf equipment; fitting of golf clubs; golf instruction.

46. I see no reason why any of the above terms would share any overlaps with the opponent's goods or services in classes 18, 25 and 35. As such, and without

anything in evidence to suggest otherwise, I find that these services are dissimilar to the opponent's goods and services in its first and second marks' specifications.

The opponent's third and fourth marks

47. As set out above, the applicant has conceded that some of its goods and services are identical and similar to the goods and services in the opponent's third and fourth marks' specifications. While noted, the applicant has not identified which it considers identical or which it considers to be similar, or to what degree. I will bear in mind these concessions; however, they are not particularly helpful as I am still required to conduct a full comparison to determine which goods are identical and which are similar (and to what degree).

Class 16

48. The opponent's third and fourth marks' specifications are not registered for "gift cards" and following the same reasons set out at paragraph 23 above, I consider these goods dissimilar.

Class 18

49. All of the terms in the applicant's specification (being "all-purpose athletic bags", "backpacks", "duffel bags" and "golf umbrellas") appear in the opponent's third and fourth marks' specifications. Such goods are, therefore, self-evidently identical.

Class 25

Golf caps; golf cleats; golf hats; golf jackets; golf pants; golf shirts; golf shorts; golf skirts; golf trousers; caps; visors being headwear; vests; wind resistant jackets; pullovers; sportswear; women's sportswear; casual clothing; sweaters; wind shirts;

polo shirts; hats; skorts; sleeveless polo shirts; golf shoes; athletic apparel; athletic footwear; golf footwear; golf knickers; golf wear.

50. The opponent's third and fourth marks' specifications include the terms "clothing", "footwear" and "headwear". None of these are limited in any way and can, therefore, cover all of the above goods of the applicant. They are, therefore, identical under the principle outlined in *Meric*.

Class 28

Golf club head covers; golf bag covers; golf bag tags; golf bag trolleys; golf ball markers; golf ball retrievers; golf club heads; golf club shafts; golf driving practice mats; golf flags; golf practice nets; golf putting practice mats; golf tee markers; golf training equipment; golf ball spotters; golf putters; golf mats; golf tee bags; golf training aids; golf bags; golf balls; golf club grips; golf gloves; golf clubs; golf divot repair tools; golf putting aids; golf tees.

51. All of the above terms are different types of articles or equipment for use whilst playing golf. So whilst the opponent's third and fourth marks' specifications include various types of goods that are the same as those listed above, I am of the view that instead of listing which goods are self-evidently identical with each other, I consider it suitable to simply set out that the opponent's term of "sporting articles and equipment" is broad enough to cover any and all of the above terms of the applicant. These goods are, therefore, identical under the principle outlined in *Meric*.

Class 35

Retail store and online retail services connected with the sale of, all-purpose athletic bags, backpacks, duffel bags, golf umbrellas, golf caps, golf cleats, golf hats, golf jackets, golf pants, golf shirts, golf shorts, golf skirts, golf trousers, caps, visors being

headwear, vests, wind resistant jackets, pullovers, sportswear, women's sportswear, casual clothing, sweaters, wind shirts, polo shirts, hats, skorts, sleeveless polo shirts, golf shoes, athletic apparel, athletic footwear, golf club head covers, golf bag covers, golf bag tags, golf bag trolleys, golf ball markers, golf ball retrievers, golf club heads, golf club shafts, golf driving practice mats, golf flags, golf practice nets, golf putting practice mats, golf tee markers, golf training equipment, golf ball spotters, golf putters, golf mats, golf tee bags, golf training aids, golf bags, golf balls, golf club grips, golf clubs, golf divot repair tools, golf footwear, golf gloves, golf knickers, golf putting aids, golf tees, golf wear.

52. The above term covers the retail (be that online or in store) of golfing equipment, bags, clothing and various types of bags. Such services are, in my view, identical (be that self-evidently or under the principle outlined in *Meric*) to the opponent's services, being the following:

“Retail clothing store services in relation to clothing; Retail store services relating to golf clubs, golf balls, golf bags, golf equipment, sports equipment, apparel, men's apparel, women's apparel, kids apparel, clothing accessories, footwear, headwear, eyewear, bags, sport bags, backpacks, luggage, outdoor and travel equipment, camping equipment, and outdoor and travel accessories; On-line retail store services relating to golf clubs, golf balls, golf bags, golf equipment, sports equipment, apparel, men's apparel, women's apparel, kids apparel, clothing accessories, footwear, headwear, eyewear, bags, sport bags, backpacks, luggage, outdoor and travel equipment, camping equipment, and outdoor and travel accessories.”

Class 41

Providing golf facilities; providing indoor and outdoor golf facilities; golf instruction; golf fitness instruction; golf lessons; golf clinics; rental of golf equipment; entertainment services; fitting of golf clubs.

53. All of the above terms are identical, be that either self-evidently or under the principle outlined in *Meric* with the terms “providing golf facilities”, “golf instruction”, “rental of golf equipment”, “entertainment services” and “fitting of golf clubs to individual users “in the opponent’s third and fourth marks’ specification.

Organization and coordination of an indoor golf league; arrangement of golf tournaments; entertainment in the nature of golf tournaments.

54. While the term “entertainment services, namely, arranging and conducting of golf competitions” in the opponent’s third and fourth marks’ specifications are categorised as ‘entertainment services”, it still covers arranging and conducting of golf tournaments, of which an indoor golf league would also be. Further, golf tournaments are plainly golf competition. As such, I find that the opponent’s term encompasses the above services of the applicant and, therefore, I find that they are identical under the principle outlined in *Meric*.

Entertainment services in the nature of providing indoor golf training simulator services.

55. As an entertainment service, the above can be said to fall within the term “entertainment services” in the opponent’s third and fourth marks’ specifications. Alternatively, if the above term is treated as a service for the provision of a golf facility, then it falls within the opponent’s term of “providing golf facilities”. Either way, the above services are identical under the principle outlined in *Meric* with the opponent’s terms.

Providing news and information on the sport of golf.

56. The above term of the applicant can, in my view, cover the provision of an online resource such as a journal or a blog in relation to golf. As such, I see no reason

why it does not cover the same services as those covered by the opponent's terms of "providing entertainment information via the internet in the field of sports" and "on-line journals, namely, blogs in the field of sports" in its third and fourth marks' specifications. As a result, I find that these services are identical, be that either self-evidently or under the principle outlined in *Meric*.

Conclusion of the goods and services comparison

57. In light of the fact that confusion under the present ground may only exist where goods and services are similar,⁶ the reliance upon the first and second marks may only proceed in relation to the goods and services that I have found to be identical or similar. I do not intend to set out all of those goods and services here but will bear this in mind going forward and will discuss it further, if necessary, at the conclusion of the present ground. As for the opponent's reliance upon its third and fourth marks, this may proceed under the present ground in respect of all bar one terms in the applicant's specification. That term is "gift cards".

The average consumer and the nature of the purchasing act

58. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well

⁶ See *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

59. For the most part, the goods and services will be selected by the general public at large, which includes a sub-set of the public that plays golf. That being said, some of the organisational services will be selected by business users looking to put on sporting or golfing events. In terms of the goods at issue, these will be available at retailers, be that physical (including general or more specific sport or golf retailers) or online. In stores, the goods will be placed on shelves or racks where they will be self-selected by consumers. Online, the consumers will select the goods after viewing images of them on websites. As for the services, regardless of who is selecting them, they are likely to be available from the provider directly. In physical premises, they will be viewed on pamphlets or placards. If selected online, the consumer will view the services on a menu or a list. In terms of the selection process for both the goods and the services, I consider that it will be primarily visual, though I do not discount the aural component playing a role via word of mouth recommendations or discussions with sales assistants.

60. The goods and services selected by the member of the general public vary in nature meaning that the frequency and cost of selection will also vary. For example, golf gloves are likely to be selected with a higher degree of frequency and at a lower cost than golf clubs which will be selected rather infrequently and are likely to be a relatively expensive purchase. In terms of the level of attention paid, this too will vary as, again, golf gloves are more casual purchases where the consumer is likely to focus on the size and material of the glove whereas, for golf clubs, the consumer will give consideration to factors such as suitability, materials, loft and advertised distance. Further, golf clubs may also be selected after fittings with golf professionals. In my view, the goods and services selected by the general public

will generally attract a medium degree of attention,⁷ though I appreciate some may be lower as they are likely to be more casual selections. Lastly, I turn to the services selected by the business user. These will relate to the organisation of events so will require consideration as to the format of the event, its location and capacity, any security needs/issues and availability of public transport or parking. Such services are likely to be more considered than those selected by the general public so will, in my view, attract a higher than medium degree of attention (though not outright high).

Distinctive character of the opponent's marks

61. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested

⁷ On this point, I appreciate that the considerations for golf clubs are rather numerous and may come after fittings. However, I do not consider that this necessarily equates to any higher degree of attention because, in short, the considerations given are still relatively ordinary.

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).”

62. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of marks can be enhanced through use, and I note that the opponent has pleaded that due to the use of its marks, they enjoy an enhanced degree of distinctive character. I will, therefore, consider whether the opponent’s evidence is sufficient to give rise to a finding that the distinctiveness of the opponent’s marks has been enhanced through use. Before doing so, I will consider the inherent position.

63. The applicant’s submissions in respect of the distinctiveness of the opponent’s marks is that the words ‘MODERN GOLF’, when used on golf related goods or services, are descriptive and non-distinctive. This is on the basis that when the opponent’s first mark was applied for, the UKIPO refused registration on the basis that it was objectionable under section 3(1)(b) and (c) of the Act.⁸ While this is noted, proceedings before the Tribunal are not bound to reach the same findings as those reached at the examination stage. On this point, I note, for example, that it is entirely possible for a trade mark to be deemed acceptable during examination but, upon the raising of an opposition or an invalidation, it can be found to be entirely non-distinctive and refused registration or invalidated before the Tribunal. As a result, the assessment I must make here is to be based on my own assessment and interpretation of the opponent’s marks. Further, I remind myself

⁸ A copy of this decision is provided at Annex 1 of the applicant’s submissions.

of the case of *Formula One Licensing BV v OHIM*, Case C-196/11P wherein the CJEU set out that a registered trade mark must have at least some distinctive character. Therefore, even if it could be said at this stage that 'MODERN GOLF' in the opponent's first mark was descriptive for some of the goods/services at issue,⁹ I am still required to afford it some distinctive character.

64. In considering the opponent's first mark, being 'MODERN GOLF', I am of the view that it will be viewed as a unitary phrase which will readily be understood as a reference to golf as it is played in the present day, as opposed to golf in the more traditional sense. For those goods and services that are unrelated to golf (such as leotards or any of the services in the opponent's class 35 services, for example), this mark will have no connection to the same. For those goods and services, the mark will plainly not be descriptive or allusive to the same but neither is it particularly remarkable. As such, I find that the opponent's first mark is inherently distinctive to a medium degree. However, this cannot be said to be the case where some of the goods at issue can be said to be worn or used whilst playing golf (being "beanies", "belts" and "umbrellas", for example). In such circumstances, the reference to the game of golf is clearly allusive in that it references the fact that the goods may be worn or used whilst playing golf.¹⁰ Further, it may also be considered laudatory on the basis that consumers will view it as a reference to the fact that the undertaking responsible for the mark is at the forefront of advancing technology for golf. While these perceptions of the mark all point to the fact that the phrase 'MODERN GOLF' is on the lower end of the scale of distinctiveness, I do not consider that they point to the fact that the opponent's mark is outright descriptive. I say this because while I appreciate that 'modern golf' will carry a readily identifiable concept, consumers will not necessarily understand how this directly

⁹ On this point, there is no scenario wherein 'MODERN GOLF' can be said to be descriptive on goods such as beachwear or services such as the retail of camping equipment.

¹⁰ While I appreciate that the rules of golf and the products used to play golf have adapted over time, I am not aware that 'MODERN GOLF' is a type of golf played in the sense that it is a known variant of the same. On this point, I am not aware that 'MODERN GOLF' would be viewed in a similar way to how Rugby Sevens is viewed as a variant of Rugby Union, for example. As such, I am not satisfied that 'MODERN GOLF' describes goods that are worn (or played, for that matter) during the game of 'modern golf' on the basis that no such variant exists.

relates to the goods or services at issue in the sense that it describes them. For example, if the mark was viewed on clothing that can be worn whilst playing golf, I do not consider that consumers would think that it directly describes that but, instead, is simply a mark that has allusive/laudatory qualities. As a result, I find that when the opponent's first mark is viewed on goods that are capable of being used whilst playing golf, its inherent distinctiveness sits at a lower (but not outright low) degree.

65. In respect of the opponent's second mark, being 'LEADER IN MODERN GOLF', I am of the view that the same findings reached above apply here, namely that the mark is inherently distinctive to a medium degree on goods/services unrelated to golf and to a lower (but not outright low) degree on goods that can relate to golf. In respect of the latter point, I find that this is because while the addition of 'LEADER IN' will be noticed, the overall phrase contained in the mark still has allusive qualities when viewed on golfing related goods. In addition, I consider the addition of 'LEADER IN' will further emphasise the laudatory nature of the mark on the basis that the undertaking responsible for it professes to a 'leader' in the field of modern golf.

66. Turning to the opponent's third mark, being 'CALLAWAY MODERN GOLF', I am of the view that regardless of whether it is viewed on goods/services that directly relate to golf or not, it is the word 'CALLAWAY' that will dominate the distinctive character of the mark. This word will be understood as an unknown word with no obvious meaning and, therefore, attracts a high degree of inherent distinctive character. As for the words 'MODERN GOLF', they will be understood in the same way as outlined above. Despite the goods and services at issue here being more directly related to golf, 'MODERN GOLF' will still only be allusive and laudatory in a similar sense to that I have described above. Again, consumers will not necessarily understand how the idea of 'modern golf' directly relates to the goods or services at issue in the sense that it directly describes them. Further, it is laudatory in the sense that the club uses 'modern' technology but, in my view, that

is a rather vague reference without any obvious meaning as it does not necessarily describe the materials or technology actually used. For the avoidance of doubt, where this mark is viewed on goods/services that do not directly relate to golf, the words 'MODERN GOLF' will not be allusive or laudatory but, as above, they are still relatively unremarkable. In considering the mark as a whole, I find that consumers will see it as a reference to a house brand, being 'CALLAWAY' and a secondary branding, being 'MODERN GOLF'. So, while I accept that 'MODERN GOLF' is lower in distinctive character, it will still be noticed and it still contributes to the distinctiveness of the mark as a whole, though I appreciate not to a material degree. Overall, I find that the distinctive character of this mark as a whole is inherently high but most of this distinctiveness derives from the element 'CALLAWAY'.

67. Lastly, the opponent's fourth mark is 'DRIVING THE COURSE TO MODERN GOLF'. Much like the opponent's second mark, this is a unitary phrase and the distinctiveness lies in the mark as a whole. While it is a relatively long mark, the understanding of the phrase still heavily relates to the idea of 'MODERN GOLF' and, given that the specification at issue relates to golf, this mark will have both allusive and laudatory qualities as has been the case with the marks above. Overall, the inherent distinctiveness of this mark sits on the lower end of the scale, albeit not outright low.

68. In considering the pleaded claim that the opponent's marks enjoy a degree of enhanced distinctive character, I turn to the evidence of Mr Doyle-Ward. The evidence begins by discussing the size of the opponent's 'CALLAWAY' brand. It is clear from this that the opponent operates a very large business under the 'CALLAWAY' branding. For example, the global revenue between quarter two of 2021 and quarter two of 2022 stood at \$202.1 million. I note that the financial results are outlined in a press release dated 4 August 2022.¹¹

¹¹ JDW2

69. In terms of the 'MODERN GOLF' brand, the opponent has provided a press release dated 24 August 2022 regarding the fact that the opponent was changing its name from 'Callaway Golf Company' to its present name.¹² The purpose of the rebrand was to reflect the opponent's leadership in the larger, more dynamic and inclusive 'MODERN GOLF' ecosystem. While this is noted, the article does not indicate any actual intention to use 'MODERN GOLF' as an indicator of origin on goods or services and, instead, refers to the modern golf as an ecosystem, whatever that may be. In addition, I note that the article sets out that the ticker symbol on the New York Stock Exchange for the opponent would change from 'ELY' to 'MODG' to reflect the opponent's leadership position in the modern golf ecosystem. Again, this is not actual trade mark use and, further, it relates to the New York Stock Exchange and there is nothing to suggest how this impacts upon the UK consumer. Even if such an article was to demonstrate that the opponent was intending to use 'MODERN GOLF' as an actual trade mark on its goods and services, it is simply a corporate press release and is not demonstrative of any actual use of the opponent's marks in relation to the relevant goods and services.

70. There is an additional press release provided which sets out a partnership between the opponent and VISA.¹³ There is mention of 'Modern Golf' in this press release but, again, it does not particularly reflect any actual use but simply refers to a 'dynamic and inclusive ecosystem' that includes both on-course and off-course golf. Additionally, the press release is dated 20 June 2024, being a year after the relevant date so it is of no assistance here even if it were the case that it contained any actual evidence of use of the marks on goods and services.

71. Lastly, I note that the opponent has provided screenshots of its own website which include reference to 'MODERN GOLF'.¹⁴ The screenshots appear to have been

¹² JDW3

¹³ JDW4

¹⁴ JDW5

captured in August 2024, being after the relevant date for these proceedings. Additionally, the range of marks shown at the footer of the website do not include 'MODERN GOLF' but other brands such as 'TOPGOLF', 'CALLAWAY', and 'ODYSSEY'. Further, the website is a '.com' website and there is nothing to suggest its reach amongst UK consumers.

72. In short, the evidence falls far short of the threshold for proving that the opponent's marks enjoy an enhanced degree of distinctive character. The entirety of the evidence stems from a number of press releases and a print out from the opponent's website, none of which actually show use of the marks on the goods and services relied upon. Further, there is no information provided as to any turnover stemming from use of the opponent's marks and neither is there any evidence of advertising expenditure or examples of marketing efforts. As a result, the inherent position applies to all marks. On this point, I do wish to point out that while the evidence briefly confirms that the opponent is a large brand, there is nothing sufficiently solid provided in evidence to demonstrate any actual level of use that can be attribute to the 'CALLAWAY' brand itself in relation to the goods or services relied upon under the opponent's third mark which, of course, includes reference to the 'CALLAWAY' branding. Even so, the inherent position for that mark is already high.

Comparison of the marks


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

74. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

76. The respective trade marks are shown below:

The opponent's marks	The applicant's mark
<p>MODERN GOLF ("the opponent's first mark");</p>	<p>MODERN  GOLF</p>
<p>LEADER IN MODERN GOLF ("the opponent's second mark")</p>	
<p>CALLAWAY MODERN GOLF ("the opponent's third mark")</p>	
<p>DRIVING THE COURSE TO MODERN GOLF ("the opponent's fourth mark")</p>	

77. I have submissions from the applicant as to the similarity of the marks. While these are noted, I do not intend to reproduce them in full here. However, I do wish to discuss the fact that the applicant's position is that, on golf and sport related goods/services, the words 'MODERN GOLF' in the opponent's first and second marks are not capable of being compared with the applicant's mark.¹⁵ Further, in discussing the comparison between the applicant's mark and the opponent's third and fourth marks, the submissions entirely ignore the words 'MODERN GOLF' and the applicant reaches a finding of dissimilarity due to the presence of the words 'CALLAWAY' in the third mark and 'DRIVING THE COURSE TO' in the fourth. Such an approach has been taken on the basis that on golf or sport related goods/services, the words 'MODERN GOLF' are entirely non-distinctive. While I have found 'MODERN GOLF' to be allusive and laudatory in relation to golf related goods and services, it is not outright descriptive and neither is it entirely lacking in distinctive character. Therefore, the approach suggested by the applicant is not applicable here. In respect of this point and the applicant's submissions generally, I appreciate that while 'MODERN GOLF' sits on the lower end of the scale for distinctiveness, it is not invisible in the marks as wholes and is, therefore, to be afforded the appropriate weight in the following comparisons.

Overall impression

78. The applicant's mark is a figurative mark that consists of the words 'MODERN GOLF' in a standard black typeface. Between these words is a circular device element in green. In the centre of this device is a number of green lines scattered in random directions within the circle itself. While noted, the device element is a fairly banal circular device so is, in my view, entirely unremarkable. As consumers tend to focus on parts of marks that can be read, I find that the overall impression of the applicant's mark will be dominated by the words with the device playing a lesser role. On this point, I do not consider that the mark can be said to be

¹⁵ Though it does submit that these marks do share degrees of similarity when compared on goods/services unrelated to golf or sports.

dominated by the device element¹⁶ as (1) it is fairly banal and (2), even on golfing related goods/services, the words 'MODERN GOLF' are not descriptive to the point that they could be said to be entirely lacking in distinctiveness.

79. The opponent's marks are all word only marks. The first consists of the words 'MODERN GOLF'. There are no other elements that contribute to the overall impression the mark, which lies in the words themselves. The second mark consists of the words 'LEADER IN MODERN GOLF'. Given that these words form a unitary phrase, I do not consider that consumers will dissect the mark in such a way to separate out 'MODERN GOLF' from 'LEADER IN', regardless on whether the mark is shown on golf or sport related goods/services. As such, I find that because consumers will view this mark as a unitary phrase, its overall impression lies equally across all four words. The third mark consists of the word 'CALLAWAY MODERN GOLF'. The words 'MODERN GOLF' will play a lesser role regardless of what goods/services the mark is viewed on. This is because for some goods/services, they are allusive/laudatory whereas on others, they form a relatively unremarkable phrase when compared to the unique nature of the word 'CALLAWAY'. This means that the word 'CALLAWAY' will dominate the overall impression of the mark. Lastly, its fourth mark consists of the words 'DRIVING THE COURSE TO MODERN GOLF'. For the same reasons set out when discussing the second mark, I find that consumers will view this mark as a unitary phrase meaning that its overall impression lies across all six words equally.

Visual comparison

80. I note that, in its submissions, the applicant claims that the words 'MODERN GOLF' in its mark are presented in a unique font which adds to the smart and sophisticated style of the mark. While noted, the typeface used is standard and hardly unique. On this point, I remind myself that the opponent's marks are word only marks and,

¹⁶ Which can be said to be the case when words in a mark are descriptive. See, for example, the decision of Dr Brian Whitehead, sitting as the Appointed Person, in the case of *eco cable* (BL O/0654/25)

therefore, they may be used in any standard typeface. As such, they can be presented in the same typeface as that used by the opponent. While I remind myself that I am not to compare the marks on this basis,¹⁷ I raise this here to demonstrate that the typeface used in the applicant's mark is not a point of visual distinction between the marks at issue.

81. In comparing the applicant's mark with the opponent's first mark, I find that the presence of the identical words 'MODERN GOLF' are a considerable point of similarity between them. While the device element in the applicant's mark will be noticed, I am of the view that its impact is not such that it will draw consumers away from the shared use of 'MODERN GOLF' to a significant degree. As a result, I find that these marks are visually similar to a high degree.

82. Turning to the opponent's second and fourth marks, I consider that I can deal with these together. I do so because they are both unitary phrases (albeit different in length) that include the words 'MODERN GOLF' at their ends. As above, these words appear identically as the sole verbal element of the applicant's mark. While this is a point of similarity between the marks, the additional elements, being the device in the applicant's mark and the words that precede 'MODERN GOLF' in the opponent's marks, have no counterpart in the opposing marks. Bearing in mind the overall impressions of these marks and reminding myself that beginnings of marks (being where the opponent's marks differ) have bigger impacts than their ends,¹⁸ I find that these marks are visually similar to between a low and medium degree.

83. Lastly, in considering the opponent's third mark against the applicant's mark, I note that they also share the words 'MODERN GOLF'. The marks differ in the presence of the word 'CALLAWAY' at the beginning of the opponent's mark. While I have set out above that the beginnings of marks tend to have more impacts than the ends,

¹⁷ See the decision of the Appointed Person in *HERNO S.p.A. v Miss Sparrow Ltd*, BL O/954/22, paragraphs 23 and 34

¹⁸ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

I remind myself that the points of difference here stem from just one word. As a result, I do not consider this point to be as compelling as I deemed it in my comparison in the preceding paragraph. Lastly, while I cannot ignore the fact that the word 'CALLAWAY' plays the greater role in the opponent's mark, this does not mean that the words 'MODERN GOLF' will be overlooked. Overall, I find that these marks are visually similar to a medium degree.

Aural comparison

84. Aurally, the opponent's first mark and the applicant's mark are identical. As for the opponent's second and third marks, these will be pronounced in full and both consist of six syllables, the last three being identical to the applicant's mark. In my view, bearing in mind what I have said about the beginnings of marks having more impact, I consider that regardless of their role in the respective marks, the identical presence of the words 'MODERN GOLF' are such to find the marks aurally similar to a medium degree. Lastly, the opponent's fourth mark consists of eight syllables and, again, the last three syllables are identical to the entirety of the applicant's mark. In comparing these marks, I am of the view that the additional two syllables present in the opponent's fourth mark (when compared with the opponent's second and third marks) are such that they reduce the aural similarity of these marks to between a low and medium degree.

Conceptual comparison

85. I have set out above that 'MODERN GOLF' will be understood as a unitary phrase which will readily be understood as a reference to the modern game of golf, as opposed to golf in the more traditional sense. This is the sole concept that will be derived from the applicant's mark and the opponent's first mark. As such, I find that these marks are conceptually identical. For the avoidance of doubt, this applies even if the marks are viewed on goods or services that relate to golf and where they do not.

86. The opponent's second mark is 'LEADER IN MODERN GOLF'. As above, this will be viewed as a unitary phrase that will be understood as a statement claiming that the person/undertaking saying it is a leader in modern golf, implying that they are at the forefront of advancing the game of golf. This is laudatory and while it is not an identical concept to that carried by the applicant's mark, the idea behind the reference to 'MODERN GOLF' across them both is sufficient to find that these marks are conceptually similar to a medium degree. I turn now to the opponent's fourth mark on the basis that it carries a similar concept to that of its second. I say this because the concept behind 'DRIVING THE COURSE TO MODERN GOLF' carries essentially the same meaning as the second mark in that it refers to an implication that the statement relates to a person/undertaking that is leading (or 'driving') in modern golf. This is laudatory and while it is not the same concept as that of the applicant's mark, the reference to 'MODERN GOLF' is such that it gives rise to a finding that these marks are conceptually similar to a medium degree.

87. Lastly, I turn to the opponent's third mark which is 'CALLAWAY MODERN GOLF'. 'CALLAWAY' has no obvious meaning and while I am conscious that consumers do not dissect marks, the elements 'CALLAWAY' and 'MODERN GOLF' will be viewed as independent elements, as opposed to forming a unitary meaning. This is on the basis that the mark, when viewed as a whole, will be viewed as a reference to a house brand, being 'CALLAWAY' with 'MODERN GOLF' being viewed as a second branding (such as a sub-brand). While 'CALLAWAY' acts as a point of conceptual neutrality due to its lack of meaning, it will still take away from the identical concept of 'MODERN GOLF', therefore rendering the marks conceptually similar to a medium degree.

Likelihood of confusion

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

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

89. I have found the goods and services at issue to be identical or similar to varying degrees, including low. That being said, I remind myself that some of the applicant's goods and services are dissimilar to the goods and services of the opponent's first and second marks' specifications. The average consumer base is formed of members of the general public and business users who will select the goods via primarily visual means (though not discounting an aural component). In terms of the level of attention, I have found that the general public will pay either a lower or a medium degree of attention, depending on what goods/services are selected. As for the business users, I have found that these will pay a higher than medium degree of attention, though this will not extend to high. In respect of the similarity of the marks, I have found the applicant's mark is:

- a. Visually similar to a high degree and aurally and conceptually identical with the opponent's first mark;
- b. Visually similar to between a low and medium degree and aurally and conceptually similar to a medium degree with the opponent's second mark;

- c. Visually, aurally and conceptually similar to a medium degree with the opponent's third mark; and
- d. Visually and aurally similar to between a low and medium degree and conceptually similar to a medium degree with the opponent's fourth mark.

90. I found the opponent's first and second marks to be inherently distinctive to a lower (but not outright low)¹⁹ or medium degree, depending on what goods/services they are viewed on. As for the opponent's third mark, I have found this to be inherently distinctive to a high degree overall, though the high level of distinctiveness of this mark derives from the distinguishing element 'CALLAWAY'. Lastly, I found the opponent's fourth mark to be inherently distinctive to a lower degree (but not outright low). In respect of the distinctive character of the marks, I confirm that I have given due consideration to the decision of Ms Emma Himsworth K.C., as the Appointed Person, at paragraph 44 in the case of *Face2FaceHR Partners Limited v Peninsula Business Services Limited*, O/0368/23, wherein she summarised the correct approach when assessing the likelihood of confusion where the only common element between the marks in issue has no or low distinctiveness. However, in the present case, while the distinctiveness of the common element sits at a lower degree of distinctiveness for some of the goods relied upon, it is not outright low and neither is it non-distinctive. As a result, I do not consider that the guidance set out in this case is directly applicable here.

91. Taking all of the above factors into account and bearing in mind the principle of imperfect recollection, I am of the view that the opponent's first mark and the applicant's mark will be directly confused for one another. Even where the distinctiveness of the opponent's mark is on the lower end of the scale, it lies solely in the 'MODERN GOLF' element which appears as the sole verbal element in the applicant's mark. I do not consider that consumers will pay enough attention to the device element in the applicant's mark, regardless of the distinctiveness of the

¹⁹ On this point, I remind myself that a weak distinctive character does not preclude a likelihood of confusion. See *L'Oréal SA v OHIM*, Case C-235/05 P

words 'MODERN GOLF', to the point that it would be used to accurately recall or recollect the marks for one another. I say this particularly because the opponent's first mark has no contrasting device element upon which any recollection can be pinned. Consequently, I consider that the applicant's mark and the opponent's first mark will be directly confused for one another. Further, I consider that confusion would occur regardless of the level of attention paid or the level of similarity between the goods and services at issue.

92. In respect of the remaining marks of the opponent, I do not consider that they would be directly confused. I say this because the differences between them would not be overlooked and, therefore, consumers would be able to accurately recall and remember the marks for one another.

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

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

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

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

94. While the above examples in *L.A. Sugar* are noted, they are not intended to be treated as an exhaustive list of the only instances whereby indirect confusion occurs.

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

96. In considering the opponent's first mark, I am of the view that in the event consumers notice the differences between the marks, they will still consider them to come from the same or economic connected undertakings. Even where the words 'MODERN GOLF' are lower in distinctive character, I fail to see how consumers will believe that the identical use of those words, with the only difference coming in a fairly banal circular device element, would give rise to a belief that the marks originated from a separate undertaking. In my view, again despite the lower distinctive nature of 'MODERN GOLF' on golfing related goods (on the basis that the terms are broad enough to cover goods used for golf), consumers will believe that the marks are alternate marks from the same undertaking, albeit used in different contexts. For example, the word only mark may be used in promotional materials or on swing tags whereas the figurative mark of the applicant is the one used on packaging or emblazoned on goods themselves. As a result, I find that there exists a likelihood of indirect confusion between the parties' marks, even where they are viewed on lowly similar goods/services and in circumstances where a higher degree of attention is paid.

97. In respect of the opponent's remaining marks, I consider it necessary to turn to consider the *Medion*²⁰ principle, the correct approach to which was set out by Arnold J. (as he then was) in the case of *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch). In that case, the judge 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.

²⁰ *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04

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 meanings 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.”

98. In considering the above in respect of the opponent’s second and fourth marks, I remind myself that they will be perceived as units and, therefore, the *Medion* principle does not apply to them. In respect of these marks and looking at the issue of indirect confusion generally, I appreciate that the shared use of the words ‘MODERN GOLF’ will be noticed. However, I see no reason to conclude that

consumers will believe that the marks originate from the same or economically linked undertakings. In short, there is no obvious reason why the differences between the marks would be viewed as logical indicators of sub-brands or brand extensions. Therefore, I do not consider that there exists a likelihood in respect of these marks, regardless of whether the goods/services are selected with a relatively low degree of attention or where the marks are viewed on identical goods or services.

99. I turn now to the opponent's third mark. I have set out above that this will be perceived as two independent elements, being 'CALLAWAY' and 'MODERN GOLF'. The former will be viewed as the house brand, the latter as a reference to the secondary branding. 'CALLAWAY' is the dominant and most distinctive element of the mark. While that may be the case, the question here is whether the mark, when viewed as whole, will be perceived as a composite mark which consists of two signs. In my view, whilst 'MODERN GOLF' may be of a lower degree of distinctiveness, it still retains a distinctive significance and will be viewed as independent of the significance of the whole of the mark. I say this because it is clearly a signifier of a sub-brand of 'CALLAWAY' that focuses on goods/services that relate to the game of golf with an allusion to the fact that they utilise modern technologies. On this point, I do not consider it necessarily prohibitive to reach this finding solely because 'MODERN GOLF' is inherently weaker in distinctiveness, especially when compared to 'CALLAWAY'. This is on the basis that, as far as I am aware, it is not uncommon for indicators of sub-brands to be on the lower end of the scale of inherent distinctiveness but still be perceived in such a way.

100. In light of the above, I am of the view that it is reasonable to conclude that there are instances where consumers would believe that the opponent would omit the word 'CALLAWAY' from its third mark. For example, consumers may expect to see reference to both the house and secondary brandings on packaging or in promotional materials but on the actual goods/services themselves, it is entirely logical for the secondary branding to be shown independently. Therefore, if the

consumer viewed 'CALLAWAY MODERN GOLF' on packaging or on a swing tag and then saw the applicant's mark emblazoned on the front of the actual goods, it would believe that the opponent had merely dropped the reference to 'CALLAWAY' and was focusing more so on its secondary branding. In reaching this conclusion, I remind myself that a weaker distinctive character does not preclude a likelihood of confusion and whilst I appreciate that the common element is inherently weaker in distinctiveness, the words appear identically across both parties' marks.²¹ As a result, I find that consumers would think that the marks at issue originated from the same or economically linked undertakings. Consequently, even bearing in mind the case law I have referred to at paragraph 95 above, I find that there exists a likelihood of indirect confusion between these marks. Given the presence of the identical words 'MODERN GOLF', this finding applies regardless of the level of attention paid and the similarity of the goods/services at issue.

101. As a result of the above, I find that the opposition under section 5(2)(b) succeeds against all but one term in the applicant's mark (being "gift cards"). I will now proceed to discuss the remaining grounds briefly.

Section 5(3)

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

"5(3) A trade mark which –

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the

²¹ As set out above, the words are presented in a standard typeface in the applicant's mark and, as a word only mark, the opponent's mark is capable of being presented in an identical manner meaning that this difference in stylisation is not a point of distinction between the marks.

later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

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

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

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *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/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph

68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

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

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

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

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

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

104. I can deal with this ground briefly. I say this because the evidence of the opponent has been summarised above when considering the issue of an enhanced degree of distinctive character. I do not intend to reproduce that here but I remind myself that the opponent's evidence fell far short of proving that the opponent's marks enjoy any degree of enhanced distinctiveness. I appreciate that the test for reputation differs from that for enhanced distinctiveness. However, it is common in proceedings before the Tribunal that, when all factors are equal, the outcomes of these assessments mirror one another. In the present case, the relevant date and relevant territory for the issue of a reputation are identical to those for an enhanced distinctive character. As a result, I find that the outcome of the assessment for reputation is the same as that reached above when considering enhanced distinctiveness. As such, I find that the opponent's evidence is insufficient for a finding that it enjoyed a reputation in any of its marks as at the relevant date. Without a reputation, there can be no link or any subsequent damage. Therefore, the opponent's section 5(3) ground fails at the first hurdle.

Section 5(4)(a)

105. Section 5(4)(a) of the Act states as follows:

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

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

aa)...

b) ...

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

106. Subsection (4A) of section 5 of the Act states:

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

107. Much like the section 5(3) ground above, I consider that I can deal with this ground briefly. Even though the test for the existence of goodwill is far less onerous than the ones conducted above for enhanced distinctiveness and reputation, I consider that the evidence filed is still insufficient. I say this because goodwill stems from trading activities and, in proceedings before the Tribunal, there must be customers in the UK for a protectable level of goodwill to exist.²² In the present case, the evidence does not demonstrate any trading activity whatsoever, let alone anything stemming from use of the sign in the UK. As set out above, the evidence is simply a collection of press releases with nothing pointing to any actual use on the goods and services for which goodwill is claimed. Without a protectable level of goodwill in its sign, the opponent is unable to satisfy that there exists a misrepresentation or any subsequent damage. As a result, the present ground fails at the first hurdle.

²² See paragraphs 47 and 52 of *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others*, [2015] UKSC 31

CONCLUSION

108. Despite its section 5(3) and 5(4)(a) grounds failing in their entirety, the opposition succeeded against all but one of the applicant's terms under the section 5(2)(b) ground. As a result, the applicant's mark is, subject to any successful appeal of my decision, refused registration for all goods and services, save for "gift cards" in class 16. The applicant's mark may, therefore, proceed to registration for this term.

COSTS

109. While the applicant's mark may proceed to registration for one term, the opponent has enjoyed the overall degree of success in these proceedings. It is, therefore, entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. I do not consider it necessary to reduce the costs award to reflect the fact that the applicant succeeded in defending one term. However, the evidence filed was of so little assistance that I consider it necessary to reduce the level of costs awarded for that task below the level set out in the aforementioned scale. In the circumstances, I award the opponent the sum of £650 as a contribution towards its costs. The sum is calculated as follows:

Preparing a notice of opposition and considering a counterstatement:	£250
Filing evidence:	£200
Official fees:	£200
Total:	£650

110. I hereby order Modern Golf Ltd. to pay Top Golf Callaway Brands Corp. the sum of £650. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 23rd day of December 2025

A COOPER

For the Registrar