

**O/677/21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3387522  
BY CGLMC LIMITED**

**TO REGISTER:**

**HOGAN'S ALLEY**

**AS A TRADE MARK IN CLASSES 14, 16, 18, 21, 25, 28, 30, 32, 33,  
35, 36, 41, 43 & 45**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO  
UNDER NO. 416868 BY  
PERRY ELLIS INTERNATIONAL EUROPE LIMITED**

## BACKGROUND AND PLEADINGS

1. Ben Hogan (1912-1997) was a renowned US golfer. About that there is no dispute. During his career, he won 68 professional golf tournaments and held 9 major championship titles, including the 1953 Open Championship which took place at Carnoustie in Scotland.<sup>1</sup> In each of his rounds at the tournament, he took a particularly high-risk approach to the sixth hole, which, according to the applicant, from then on became known as “Hogan’s Alley”. An official naming ceremony was held in 2003. Also in 1953, Mr Hogan began to commercialise his name by founding the Ben Hogan Golf Company which specialised in the production of golf clubs.

2. The company that owns the Carnoustie Championship Course, CGLMC Limited (“the applicant”), applied to register **HOGAN’S ALLEY** as a trade mark in the United Kingdom on 28 March 2019. The application was accepted and published on 5 April 2019 in respect of goods and services in Classes 14, 16, 18, 21, 25, 28, 30, 32, 33, 35, 36, 41, 43 and 45.

3. The application was opposed by the owner of the intellectual property rights of the Ben Hogan brands, Perry Ellis International Europe Limited (“the opponent”). The opposition is based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) and concerns the following goods and services in the application:

### Class 14

*Badges of precious metal; Bracelets; Clocks; Coins; Cufflinks; Jewellery; Jewellery chains; Key rings and key chains; Medals; Metal badges for wear [precious metal]; Medallions; Rings [jewellery]; Scale models [ornaments] of precious metal; Tie pins; Trophies coated with precious metal alloys; Trophies of precious metals; Watches.*

### Class 16

*Books; Golf scorecards; Golf scorecard holders; Golf yardage books; Photographs; Printed matter; Printed publications; Printed teaching materials; Stationery.*

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<sup>1</sup> Exhibit SJ1.

Class 18

*Bags; Bags for sports clothing; Cane [sic]; Backpacks; Briefcases; Golf bag tags of leather; Golf umbrellas; Hand bags; Handbags, purses and wallets; Luggage; Parasols; Rucksacks; Shoulder bags; Sports bags; Suitcases; Umbrellas; Umbrella covers; Walking sticks; all of the aforementioned goods principally marketed at golfers or golf fans.*

Class 21

*Flasks; Liqueur flasks.*

Class 25

*Clothing, headgear and footwear; Belts [clothing]; Gloves; Golf caps; Golf footwear; Golf pants, shirts and skirts; Golf shirts; Golf shoes; Golf shorts; Golf skirts; Golf trousers; Jackets; Knitwear; Leisurewear; Polo shirts; Shirts; Socks; Sports clothing; Sports clothing [other than golf gloves]; Sports shirts; Sweat shirts; T-shirts; Waterproof clothing; all of the aforementioned goods principally marketed at golfers or golf fans.*

Class 28

*Articles for playing golf; Bag stands for golf bags; Caddie bags for golf clubs; Covers (shaped-) for golf bags; Fitted protective covers specially adapted for golf clubs; Golf bags; Golf bag carts; Golf bag trolleys; Golf bags with or without wheels; Golf balls; Golf ball markers; Golf ball retrievers; Golf clubs; Golf club bags; Golf club covers; Golf club grips; Golf club heads; Golf club head covers; Golf club shafts; Golf gloves; Golf irons; Golf mats; Golf practice apparatus; Golf putters; Golf tees; Golf tee bags; Handles for golf clubs; Toys, games, playthings and novelties.*

Class 35

*Advertising; Business administration; Business management; Marketing; Online advertisements; Retail services relating to umbrellas, luggage, clothing, footwear and headgear principally marketed at golfers and golf fans; Retail services relating to software, jewellery, photography, printed matter, drinking flasks, towels, glassware, golf clubs, golf balls, toys, games; Consultancy, information and advisory services relating to all of the aforesaid services.*

Class 41


*Aerial photography; Arrangement of professional golf tournaments; Entertainment in the nature of golf tournaments; Entertainment services relating to the playing of golf; Fitting*

*of golf clubs to individual users; Golf caddie services; Golf courses; Golf fitness instruction; Golf tuition; Organisation of golf competitions; Golf driving range services; Conducting of professional golf competitions; Organisation of golf tournaments; Providing golf facilities; Rental of golf equipment; Consultancy, information and advisory services relating to all of the aforesaid services.*

4. Under section 5(2)(b), the opponent is relying on the following marks:

Mark	Goods and Services Relied On
<p>EUTM No. 013313721<sup>2</sup></p> <p><b>BEN HOGAN</b></p> <p>Application date: 30 September 2014. Registration date: 2 November 2015.</p>	<p><u>Class 8</u> <i>Handyman tool sets for gift sets.</i></p> <p><u>Class 9</u> <i>Phone chargers for gift sets.</i></p> <p><u>Class 15</u> <i>Harmonicas for gift sets.</i></p> <p><u>Class 16</u> <i>Stationery; Pens for gift sets; Golf record book for gift sets.</i></p> <p><u>Class 18</u> <i>Umbrellas for gift sets; coolie bags for gift sets.</i></p> <p><u>Class 21</u> <i>Hip flasks for gift sets; shoe polish sets consisting of brushes and shoe polish for gift sets; water bottles for gift sets; wash bags for gift sets; coffee flasks for gift sets.</i></p> <p><u>Class 24</u> <i>Hankies for gift sets.</i></p>

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

Mark	Goods and Services Relied On
	<u>Class 28</u> <i>Chess sets for gift sets.</i>
EUTM No. 015530736  <b>BEN HOGAN</b>  Application date: 10 June 2016. Registration date: 6 October 2016.	<u>Class 25</u> <i>Clothing, in particular clothing marketed to golfers or golf fans; parts and fittings of all the aforesaid goods included in the class.</i>
UKTM No. 3161211    Application date: 25 April 2016 Registration date: 26 August 2016.	<u>Class 25</u> <i>Clothing, headwear and footwear principally marketed to golfers or golf fans.</i>
EUTM No. 001672591  <b>BEN HOGAN</b>  Application date: 24 May 2000 Registration date: 23 October 2001.	<u>Class 28</u> <i>Sporting articles for use in playing golf; golf balls; golf bags.</i>
UKTM No. 1142877  <b>BEN HOGAN</b>  Application date: 29 October 1980. Registration date: 29 October 1980.	<u>Class 25</u> <i>Articles of golfing sports clothing.</i>  <u>Class 28</u> <i>Articles for sports and games, namely for golf.</i>

5. The opponent claims that “HOGAN’S” is the dominant element of the contested mark which is highly similar to its earlier marks and that the goods and services opposed are identical and/or similar to the goods covered by those earlier marks. It asserts that, in view of this similarity, there exists a likelihood of confusion on the part of the public, which includes a likelihood of association with the earlier marks.

6. In addition, the opponent claims that the likelihood of confusion is increased by the fact that the earlier marks refer to a renowned golfer, Ben Hogan, and have an

enhanced distinctive character both inherently and as a result of the use that has been made of them.

7. Under section 5(3), the opponent is relying on UKTM No. 3161211, which it claims has a reputation for *Clothing and headwear principally marketed to golfers or golf fans*, and UKTM No 1142877, which it claims has a reputation for all the goods covered by the mark.

8. The opponent asserts that use of the contested mark in relation to the opposed goods and services would take unfair advantage of, and be detrimental to, the distinctive character and very strong reputation of the earlier marks. In particular, it claims that:

- The earlier marks have a reputation for high quality, craftsmanship and excellence in the field of golf, and that the contested sign would take unfair advantage of this reputation by attempting to ride on the coat-tails of the earlier marks in order to benefit from their power of attraction, reputation and prestige, and to exploit the marketing effort expended by the opponent in order to create and maintain the image of the marks;
- Use of the contested mark in relation to the opposed goods and services would dilute the distinctive character of the earlier marks and weaken their ability exclusively and immediately to identify the opponent's goods; and
- Use of the contested mark in relation to goods and services of a different standard or quality to the goods provided by the opponent would also be detrimental to the reputation of the earlier marks, leading to a loss of customers and investment for the opponent.

9. The applicant filed a defence and counterstatement denying the claims made. In particular, it denies that the first word of the contested mark is the dominant element of that mark. It contends that the goods and marks are not similar and so there is no likelihood of confusion. In addition, it claims that its use of the contested mark predates the opponent's use of the marks on which it is relying. It put the opponent to proof of use of EUTM No. 1672591 and UKTM No. 1142877 for the goods relied upon.

10. The applicant denies that the marks relied upon under section 5(3) have a reputation for the goods claimed and denies a likelihood of confusion.

11. The matter came to be heard by me via a videolink on 30 June 2021. The opponent was represented by Rachel Wilkinson-Duffy of Baker McKenzie and the applicant by Kirsty Stewart of Thorntons Law LLP.<sup>3</sup>

## **Evidence and Submissions**

11. The opponent filed evidence in the form of a witness statement from Sara Jove dated 10 January 2020, accompanied by 13 exhibits. Ms Jove is the Senior Vice President of Sales of Perry Ellis International, Inc., the parent company of the opponent, and had held that position for approximately seven years. Her evidence goes to the use and reputation of the earlier marks.

12. The applicant filed the evidence listed below. Except where noted, the evidence goes to the knowledge among the golfing community of the term “Hogan’s Alley” and its association with the Championship Course at Carnoustie.

- A witness statement from Michael Wells dated 13 March 2020, accompanied by 38 exhibits. Mr Wells is the Chief Executive of CGLMC Limited and had held this position for 2 years. He states that he has been “immersed” in the sports marketing and event management industry for over 20 years. His evidence goes to the use of the contested mark by the applicant;
- A witness statement from David MacKeseey dated 3 March 2020, accompanied by 4 exhibits. Mr MacKeseey is the official club Historian at the Diablo Country Club in California. His evidence goes to the use of the term “Hogan’s Alley” in connection with the Carnoustie course;
- A witness statement from Paul Levy dated 13 March 2020, accompanied by 1 exhibit. Mr Levy is the Honorary President of the Professional Golfers’ Association of America;

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<sup>3</sup> The opponent had been represented by Boulton Wade Tennant throughout much of these proceedings.

- A witness statement from Trevor Williamson dated 6 March 2020. Mr Williamson is the Champion and Ambassador of CGLMC Limited and has been associated with the company for 30 years. He states that his role centres on the promotion of the contribution the applicant has made to the game of golf;
- A witness statement from Paul Lawrie OBE dated 11 March 2020. Mr Lawrie is a professional golfer who won the 1999 Open Championship at the applicant's championship course and was involved in the official 2003 naming ceremony held at that course in relation to the sixth hole;
- A witness statement from John Philp dated 11 March 2020. Mr Philp, who has now retired, was the Links Superintendent with the applicant from 1985;<sup>4</sup>
- A witness statement from Alan Fenton dated 12 March 2020. Mr Fenton says that he has played golf at Carnoustie since 1958 and is a past Captain of the Carnoustie Golf Club;
- A witness statement from Archie Paton dated 12 March 2020. Mr Paton is the Chief Executive Officer of Openside Sports Limited and has over 20 years' experience in international sports marketing and management;
- A witness statement from Fred Popp dated 13 March 2020. Mr Popp is a management consultant who specialises in "brand growth strategy for top-tier sports rights holders";
- A witness statement from David Valentine dated 13 March 2020. Mr Valentine is the owner, and a director, of Simpsons Golf Shop Limited in Carnoustie and has been involved with this business since 2013. He has also held a number of senior positions in local government with Angus Council;<sup>5</sup> and
- A witness statement from Patricia A Sawers dated 13 March 2020. Ms Sawers is the Lord Lieutenant of Angus and, for the past 6 years, the Chair of CGLMC Limited. She states that she has been on the Board of the applicant for 11 years and her family has a long history with it.

13. The applicant also filed written submissions dated 13 March 2020.

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<sup>4</sup> He does not say when he retired but states that he held the position "for many years".

<sup>5</sup> Carnoustie is located in Angus.



14. I shall refer to the evidence and submissions in more detail where appropriate during the course of my decision.

## **DECISION**

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

## **Legislation**

16. Sections 5(2)(b) and 5(3) of the Act are as follows:

“2. A trade mark shall not be registered if because –

...

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

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

3. A trade mark which –

(a) is identical with or similar to an earlier trade mark,

[...]

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

17. An “earlier trade mark” is defined in section 6(1) of the Act<sup>6</sup> as:

“(a) a registered trade mark, international trade mark (UK), a European Union trade mark or international trade mark (EC) 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,

(b) a European Union trade mark or international trade mark (EC) which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired,

(ba) a registered trade mark or international trade mark (UK) which –

(i) has been converted from a European Union trade mark or international trade mark (EC) which itself had a valid claim to seniority within paragraph (b) from an earlier trade mark, and

(ii) accordingly has the same claim to seniority, or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.”

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<sup>6</sup> This is the legislation as it was in force at the commencement of the proceedings.

18. The registrations upon which the opponent relies qualify as earlier trade marks under the above provision. Three of the marks were registered within the five years before the application date of the contested mark and so are not subject to proof of use and the opponent is therefore entitled to rely on all the goods for which EUTM Nos 015530736 and 013313721 and UKTM No. 3161211 stand registered.

19. EUTM No. 0101672591 and UKTM No. 1142877 completed their registration procedures over five years before the application date for the contested mark and are therefore subject to the proof of use set out in section 6A of the Act. The applicant, as I have already noted, requested that the opponent provide such proof.

### **Proof of Use**

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

“(1) This section applies where

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

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

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

(1A) In this section ‘the relevant period’ means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

(a) use of a trade mark includes use in a form (the 'variant form') differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

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

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

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be

treated for the purposes of this section as if it were registered only in respect of those goods or services.”

21. The goods for which proof of use is required are shown below:

<b>Mark</b>	<b>Goods</b>
EUTM No. 0101672591	Sporting articles for use in playing golf; golf balls; golf bags.
UKTM No. 1142877	Articles of golfing sports clothing. Articles for sports and games, namely for golf.

22. Neither party had made submissions on proof of use in their skeleton arguments and so I invited them at the hearing to clarify their position. For the opponent, Ms Wilkinson-Duffy submitted that the evidence showed use of all the relevant goods, apart from footwear.

23. I had the following exchange with Ms Stewart for the applicant:

*THE HEARING OFFICER: There are a couple of points that I would like to clarify on the 5(2) issue. The first is the table at 14, which is the comparison of the goods and services.*

*MS STEWART: Is that in our own skeleton argument or where, Madam?*

*THE HEARING OFFICER: I am sorry. I beg your pardon. It is at page 14 of your skeleton. I asked the opponent about the Class 28 goods and the question of proof of use, am I to take it, from your inclusion of all the goods within this table, that you accept that the opponent may rely on them?*

*MS STEWART: With the exception – I should have mentioned it – of the footwear, which was specifically mentioned by the opponent. I do not think there is any challenge in terms of those.<sup>7</sup>*

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<sup>7</sup> Transcript, pages 37-38.

24. The parties therefore agreed that the opponent could rely on all the goods set out in paragraph 21 above, with the exception of *Footwear*. However, I do not consider that *Footwear* would fall within the ordinary and general meaning of the term *Articles of golfing sports clothing*. The opponent may therefore rely on all the goods for which the earlier marks are registered for the purposes of the opposition under section 5(2)(b).

### **Section 5(2)(b)**

25. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation 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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- b) the matter must be judged through the eyes of the average consumer of the goods or services in question. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their mind, and whose attention varies according to the category of goods or services in question;
- c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

- d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks and vice versa;
- h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; and
- k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### ***Comparison of goods and services***

26. It is settled case law that I must make my comparison of the goods and services on the basis of all relevant factors. These may include the nature of the goods and

services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. Goods and services are complementary when

“... there is a close connection between them in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”<sup>8</sup>

27. The goods and services to be compared are shown in the table below. As four of the marks are identical, I have combined them into a single table.

Earlier goods/services	Contested goods/services
<u>Class 8</u> <i>Handyman tool sets for gift sets (EUTM No. 15530736)</i>	
<u>Class 9</u> <i>Phone chargers for gift sets (EUTM No. 15530736)</i>	
	<u>Class 14</u> <i>Badges of precious metal; Bracelets; Clocks; Coins; Cufflinks; Jewellery; Jewellery chains; Key rings and key chains; Medals; Metal badges for wear [precious metal]; Medallions; Rings [jewellery]; Scale models [ornaments] of precious metal; Tie pins; Trophies coated with precious metal alloys; Trophies of precious metals; Watches.</i>

<sup>8</sup> *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82.



Earlier goods/services	Contested goods/services
<p><u>Class 15</u>  <i>Harmonicas for gift sets (EUTM No. 15530736).</i></p>	
<p><u>Class 16</u>  <i>Stationery; Pens for gift sets; Golf record book for gift sets (EUTM No. 15530736)</i></p>	<p><u>Class 16</u>  <i>Books; Golf scorecards; Golf scorecard holders; Golf yardage books; Photographs; Printed matter; Printed publications; Printed teaching materials; Stationery.</i></p>
<p><u>Class 18</u>  <i>Umbrellas for gift sets; coolie bags for gift sets (EUTM No. 15530736)</i></p>	<p><u>Class 18</u>  <i>Bags; Bags for sports clothing; Canes; Backpacks; Briefcases; Golf bag tags of leather; Golf umbrellas; Hand bags; Handbags, purses and wallets; Luggage; Parasols; Rucksacks; Shoulder bags; Sports bags; Suitcases; Umbrellas; Umbrella covers; Walking sticks; all of the aforementioned goods principally marketed at golfers or golf fans.</i></p>
<p><u>Class 21</u>  <i>Hip flasks for gift sets; shoe polish sets consisting of brushes and shoe polish for gift sets; water bottles for gift sets; wash bags for gift sets; coffee flasks for gift sets. (EUTM No. 15530736)</i></p>	<p><u>Class 21</u>  <i>Flasks; Liqueur flasks.</i></p>
<p><u>Class 24</u>  <i>Hankies for gift sets. (EUTM No. 15530736)</i></p>	
<p><u>Class 25</u>  <i>Clothing, in particular clothing marketed to golfers or golf fans; parts and fittings</i></p>	<p><u>Class 25</u>  <i>Clothing, headgear and footwear; Belts [clothing]; Gloves; Golf caps; Golf</i></p>

Earlier goods/services	Contested goods/services
<p><i>of all the aforesaid goods included in the class (EUTM No. 13313721)</i></p> <p><i>Clothing, headwear and footwear principally marketed to golfers or golf fans (UKTM No. 3161211).<sup>9</sup></i></p> <p><i>Articles of golfing sports clothing. (UKTM No. 1142877)</i></p>	<p><i>footwear; Golf pants, shirts and skirts; Golf shirts; Golf shoes; Golf shorts; Golf skirts; Golf trousers; Jackets; Knitwear; Leisurewear; Polo shirts; Shirts; Socks; Sports clothing; Sports clothing [other than golf gloves]; Sports shirts; Sweat shirts; T-shirts; Waterproof clothing; all of the aforementioned goods principally marketed at golfers or golf fans.</i></p>
<p><u>Class 28</u></p> <p><i>Chess sets for gift sets (EUTM No. 15530736)</i></p> <p><i>Sporting articles for use in playing golf; golf balls; golf bags (EUTM No. 1672591)</i></p> <p><i>Articles for sports and games, namely for golf (UKTM No. 1142877)</i></p>	<p><u>Class 28</u></p> <p><i>Articles for playing golf; Bag stands for golf bags; Caddie bags for golf clubs; Covers (shaped -) for golf bags; Fitted protective covers specially adapted for golf clubs; Golf bags; Golf bag carts; Golf bag trolleys; Golf bags with or without wheels; Golf balls; Golf ball markers; Golf ball retrievers; Golf clubs; Golf club bags; Golf club covers; Golf club grips; Golf club heads; Golf club head covers; Golf club shafts; Golf gloves; Golf irons; Golf mats; Golf practice apparatus; Golf putters; Golf tees; Golf tee bags; Handles for golf clubs; Toys, games, playthings and novelties.</i></p>
	<p><u>Class 35</u></p> <p><i>Advertising; Business administration; Business management; Marketing; Online advertisements; Retail services relating to umbrellas, luggage, clothing, footwear and headgear principally marketed at golfers and golf fans; Retail services relating to software, jewellery, photography, printed matter, drinking flasks, towels, glassware, golf clubs,</i></p>

<sup>9</sup> This is the stylised word mark.

Earlier goods/services	Contested goods/services
	<i>golf balls, toys, games; Consultancy, information and advisory services relating to all of the aforesaid services.</i>
	<u>Class 41</u> <i>Aerial photography; Arrangement of professional golf tournaments; Entertainment in the nature of golf tournaments; Entertainment services relating to the playing of golf; Fitting of golf clubs to individual users; Golf caddie services; Golf courses; Golf fitness instruction; Golf tuition; Organisation of golf competitions; Golf driving range services; Conducting of professional golf competitions; Organisation of golf tournaments; Providing golf facilities; Rental of golf equipment; Consultancy, information and advisory services relating to all of the aforesaid services.</i>

28. In *Gérard Meric v OHIM*, Case T-133/05, the General Court (“GC”) stated that:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”<sup>10</sup>

29. I remind myself that, under section 5(2)(b), I must consider the applicant’s goods as they are described in the specification and any fair use that may be made of the contested mark, and then compare those terms to the specifications of the earlier marks. With this in mind, I shall go through the contested goods (and services),

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<sup>10</sup> Paragraph 29.

grouping them together where this is appropriate, following the guidance given by Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *SEPARODE Trade Mark*.<sup>11</sup>

#### *Class 14*

30. Ms Stewart submitted that there is no similarity between these goods and any of the goods on which the opponent is relying. At the hearing, I asked Ms Wilkinson-Duffy to clarify her client's position. She said:

"In relation to these, we would say that it is clear from the evidence that the use is golf-related. So a necklace, for example, that has 'HOGAN'S ALLEY' on the pendant or a watch that somehow has a golf ball and 'HOGAN'S ALLEY' attached to it. The trophies which are, obviously, going to be in the context of a sporting product. Again, to the extent that these are not limited to exclude these goods for golfing purposes or, potentially, being golfing merchandise, we would say, even more so than the services, that they are a natural extension of a brand that offers clothing, apparel and sporting articles, such as golf clubs, golf balls and the like."<sup>12</sup>

31. The contested *Badges of precious metal, Bracelets, Cufflinks, Jewellery, Jewellery chains, Metal badges for wear [precious metal], Medallions, Rings [jewellery]* and *Tie pins* are all items of jewellery or ornaments that are used to adorn the person. In *Compagnie des montres Longines & Anor v OHIM*, Case T-505/12, the GC rejected the argument that jewellery and watches were similar to clothing (which is covered by some of the earlier marks), on the grounds that the nature, intended purpose and method of use of the goods at issue were different and the goods were not in competition or complementary. Even if the applicant's goods had a golfing theme, this would not be enough on its own to find similarity. There are no other goods within the opponent's specifications that are, to my mind, any closer, and so I find that *Badges of precious metal, Bracelets, Cufflinks, Jewellery, Jewellery Chains, Metal badges for*

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<sup>11</sup> See paragraph 5.

<sup>12</sup> Transcript, page 19.

wear [*precious metal*], *Medallions*, *Rings [jewellery]* and *Tie pins* are dissimilar to the opponent's goods.

32. On the same basis, I also find that *Clocks*, *Coins*, *Key rings and key chains* and *Scale models [ornaments] of precious metal* are dissimilar to the opponent's goods.

33. I turn now to *Medals*, *Trophies coated with precious metal alloys* and *Trophies of precious metals*. These goods are used to commemorate events or reward achievement, sometimes in connection with sporting activities. There is no evidence to show that they share the same trade channels with any of the earlier goods, and the nature, intended purpose and method of use are different. They are not in competition and are not complementary. I find them to be dissimilar to the earlier goods.

#### *Class 16*

34. The applicant's *Stationery* also appears in the specification for the earlier EUTM No. 15530736, and is therefore identical.

35. The contested *Books*, *Printed matter* and *Printed publications* are broader categories that include the earlier *Golf record books for gift sets*. Following *Meric*, I find them to be identical.

36. Ms Stewart admitted that the applicant's *Golf scorecards*, *Golf scorecard holders* and *Golf yardage books* were similar to the opponent's *Golf record books for gift sets*, but submitted that the similarity was low. *Golf scorecards* and *Golf scorecard holders* have similar purposes and methods of use and the same users, being designed for the golfer to keep a record of their performance around the course. The trade channels are shared. There may be a degree of competition. I find the goods to be similar to at least a medium degree.

37. *Golf yardage books* are used to give the golfer information about particular holes so that they can more effectively set up their shot. Exhibit MW31 contains an example from the yardage book for the applicant's Championship Course. They are similar in nature to the opponent's goods but a different method of use, as they are read and not

designed to be written in. There is no competition, although there will be some shared trade channels. I find that *Golf yardage books* are similar to a low degree to the opponent's *Golf record books for gift sets*.

38. *Photographs* are printed matter that can be used as decoration or as a record of a particular event, place or person. There may therefore be a very slight overlap in purpose with the opponent's *Golf record books*, although I note that the applicant's goods are not restricted to the subject matter of golf. There may also be a degree of similarity in the nature of *Photographs* and some of the goods covered by the opponent's *Stationery* (cards, paper, etc.), and some shared trade channels. However, I do not find these similarities to be particularly strong. The goods are not in competition, nor do I find them to be complementary. On balance, I find that the goods are dissimilar. However, if I am wrong in this, I would find there to be only a very low degree of similarity.

39. *Printed teaching materials* are used by people who want to learn a subject or skill and those who are teaching them. There may be some overlap in trade channels with the opponent's *Golf record book for gift sets* or *Stationery*, and the physical nature of the goods is similar, but the purposes are different. There is no competition, nor are they complementary. Overall, I find that the goods are dissimilar.

#### *Class 18*

40. Ms Stewart admitted that there was identity or a high degree of similarity between the applicant's *Golf umbrellas, Parasols, Umbrellas* and *Umbrella covers* and the opponent's *Umbrellas for gift sets*. I agree that *Golf umbrellas, Parasols* and *Umbrellas* are identical and find that *Umbrella covers* are highly similar on the basis of complementarity.

41. She also submitted that there was a low degree of similarity between the applicant's *Bags* and the opponent's *Coolie bags for gift sets*. This time, I do not agree. *Bags* is a broad category that encompasses the opponent's goods, which are bags designed to keep food and drink cool, and so, applying *Meric*, I find them to be identical.

42. *Bags for sports clothing* are sold through the same trade channels to similar users as the opponent's *Articles of golfing sports clothing*. The intended purpose is different, as the opponent's goods are designed to cover the body while the applicant's are intended to transport clothing and equipment for use in sporting activities. They are not in competition but there is a degree of complementarity, as the goods are used together and the average consumer would expect to find them produced and marketed by the same undertaking. I find that *Bags for sports clothing* are similar to a high degree to *Articles of golfing sports clothing*.

43. I now turn to the applicant's *Sports bags* and note that the specification for earlier trade mark EUTM No. 1672591 contains the term *Golf bags* in Class 28. In my view, the average consumer would understand the opponent's term to refer to a bag for holding golf clubs, and it would therefore conform to the dimensions of a set of clubs and be likely to contain compartments so that the clubs do not rattle around while the bag is being used. The applicant's goods are more general bags, designed for transporting clothing, footwear and equipment and usable for a number of different sports. They are likely to be made from similar materials and sold through the same trade channels. I find *Sports bags* to be highly similar to *Golf bags*.

44. *Backpacks, Briefcases, Hand bags, Handbags, purses and wallets, Luggage, Rucksacks, Shoulder bags* and *Suitcases* are specific types of bags in which the user will carry a range of items. In *Gitana SA, v OHIM*, Case T-569/11, the GC stated that:

"Moreover, in respect of the relationship between the 'goods in leather and imitations of leather' in Class 18 covered by the trade mark sought and the goods in Class 25 covered by the earlier mark, it is apparent also from settled case-law that the 'goods in leather and imitations of leather' include clothing accessories such as 'bags or wallets' made from that raw material and which, as such, contribute, with clothing and other clothing goods, to the external image ('look') of the consumer concerned, that is to say coordination of its various components at the design stage or when they are purchased. Furthermore, the fact that those goods are often sold in the same specialist sales outlets is likely to facilitate the perception by the relevant consumer of the close connections between them and support the

impression that the same undertaking is responsible for the production of those goods. It follows that some consumers may perceive a close connection between clothing, footwear and headgear in Class 25 and certain 'goods made of these materials [leather and imitations of leather] and not included in other classes' in Class 18 which are clothing accessories. Consequently, clothing, shoes and headgear in Class 25 bear more than a slight degree of similarity to a category of 'goods made of these materials [leather and imitations of leather] and not included in other classes' in Class 18 consisting of clothing accessories made of those materials (see, to that effect, *PiraÑAM diseño original Juan Bolaños*, paragraph 42 above, paragraphs 49 to 51; *exē*, paragraph 42 above, paragraph 32; and *GIORDANO*, paragraph 42 above, paragraphs 25 to 27)."<sup>13</sup>

45. I consider that *Hand bags, Handbags, purses and wallets* and *Shoulder bags* can all be described as clothing accessories and I find that they are similar to the opponent's Class 25 goods to no more than a medium degree. Both the opponent's and the applicant's goods are to be marketed to golfers and golf fans.

46. I do not consider that the average consumer would think that *Backpacks, Briefcases, Luggage, Rucksacks* and *Suitcases* are clothing accessories. *Luggage* and *Suitcases* are predominantly used when travelling to hold all the items that the user would need during their time away from home, while *Briefcases* are generally used by business and professional people in a work context. They are unlikely to share the same trade channels as the opponent's goods. The *coolie bags* are more commonly sold with items for picnics or other outdoor leisure activities. The nature of the goods is different, as the opponent's bags contain insulating material. The goods are not in competition, nor are they complementary. I find that *Briefcases, Luggage* and *Suitcases* are dissimilar to the opponent's goods.

47. *Backpacks* and *Rucksacks* are less formal than *Briefcases, Luggage* and *Suitcases*, and are made of lighter material as they are designed to be transported on

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<sup>13</sup> Paragraph 45.



the person. I consider there to be some overlap in trade channels with the opponent's *coolie bags for gift sets* as all the goods will be sold in stores and on websites dedicated to outdoor pursuits. There will also be an overlap in users and the coolie bags may come in the form of a backpack. I find that the goods are similar to a medium degree.

48. *Canes* and *Walking sticks* are simple products, made, for example, from wood or plastic, used by an individual to help them be more mobile. There may be an overlap in trade channels with the opponent's *Umbrellas*, but the goods differ in purpose and nature. They are not in competition or complementary. I find *Canes* and *Walking sticks* to be dissimilar to the opponent's goods.

49. *Golf bag tags of leather* are attached to the opponent's *Golf bags*, which are essential for their use. There will be some overlap in trade channels and in my view the average consumer would expect the tags to be produced and marketed by the same undertaking as the bags. I find that the goods are similar to a medium degree.

#### *Class 21*

50. Ms Wilkinson-Duffy submitted in her skeleton that the applicant's *Flasks* and *Liqueur flasks* were identical to the opponent's Class 21 goods (*Hip flasks for gift sets*), although at the hearing she said that they were highly similar. Ms Stewart admitted that there was some similarity.

51. As *Flasks* is a broader category that would include the opponent's goods, I find, following *Meric*, that they are identical.

52. The average consumer would understand the term *Hip flask* to refer to the size of the flask, rather than to its contents. They may also expect it to have a particular shape. However, the nature and purpose of the goods is the same (to hold liquid) and they are likely to share the same trade channels. There will be a degree of competition. I find that *Liqueur flasks* are highly similar to *Hip flasks for gift sets*.

### Class 25

53. Ms Stewart accepted that the applicant's Class 25 goods were identical to the opponent's Class 25 goods.

### Class 28

54. Ms Stewart accepted that the applicant's Class 28 goods were identical to the opponent's Class 28 goods, or at least highly similar. All the goods except for *Toys, games, playthings and novelties* are encompassed by the broader categories *Sporting articles for use in playing golf* or *Articles for sports and games, namely for golf* found in the opponent's specifications. *Toys, games, playthings and novelties* is itself a broader category that includes the opponent's *Chess sets for gift sets*. Following *Meric*, I find the goods to be identical.

### Class 35

55. The contested services include retail services relating to a variety of goods. In *Oakley, Inc. v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use from 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.

56. In *Tony Van Gulck v Wasabi Frog Ltd*, BL O/391/14, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, reviewed the law concerning the comparison of retail services and goods. He said:

“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 applies 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."<sup>14</sup>

57. However, on the basis of the European courts' judgments in *Sanco SA v OHIM* (Case C-411/13 P) and *Assembled Investments (Proprietary) Ltd v OHIM* (Case T-105/05), upheld on appeal in *Waterford Wedgwood Plc v Assembled Investments (Proprietary) Ltd* (Case C-398/07 P), 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).

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<sup>14</sup> Paragraph 9.

58. It is clear from this case law that where the applicant's retail services are to be compared to the opponent's goods, the retail services will be different in nature, purpose and method of use from those goods. Despite these differences, where there is some complementarity and shared trade channels, retail services *may* be similar to goods. It is equally clear that complementarity alone will not suffice for a finding of similarity, where from the consumer's point of view, the retail services of the applicant would not normally be offered by the same undertaking as the goods. Furthermore, I note that I must not treat the retail services as goods, although consideration of the retail services normally associated with the opponent's goods should be made.

59. At the hearing, Ms Stewart submitted that:

"In relation to Class 35, the retail services element, the opponent has listed a range of goods which it states would be similar in terms of retail services. To the extent that we have admitted that there is identity or similarity in respect of those goods themselves in the other classes, we would admit that, therefore, there is a degree of similarity for retail services for those particular products. But for the other products where we have not submitted that there is any similarity, we would again submit that there is no similarity in terms of the retail services there."<sup>15</sup>

60. It follows that she admits that *Retail services relating to umbrellas, ... clothing, footwear and headgear principally marketed at golfers and golf fans* and *Retail services relating to ... drinking flasks, ... golf clubs, golf balls, toys, games* are similar to the opponent's goods. I shall therefore turn my attention to the remaining retail services, beginning with those relating to *Luggage*.

61. I recall that I found *Luggage* to be dissimilar to the opponent's goods and, in particular, that they were unlikely to share the same trade channels. It follows, then, that *Retail services relating to luggage* will not be supplied alongside any of the opponent's goods and that there is no complementarity between them. I find that they are dissimilar.

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<sup>15</sup> Transcript, pages 30-31.

62. I shall compare the applicant's *Retail services relating to software* to the opponent's *Stationery*. There may be some shared trade channels, as retailers selling software, such as office suppliers, may also sell stationery. However, I do not consider there to be any complementarity between the opponent's goods and the applicant's services. I find them to be dissimilar.

63. There may also be some shared trade channels for the applicant's *Retail services relating to jewellery* and the opponent's *Pens for gift sets*. Again, though, I do not consider there to be any complementarity and so find the goods and services to be dissimilar.

64. Turning now to the contested *Retail services relating to photography*, I recall that I found that there were some shared trade channels with the opponent's *Golf record books for gift sets*. As above, though, I do not consider that the goods and services are complementary, and so find them to be dissimilar.

65. Earlier in my decision, I found that the applicant's *Printed matter* was a broader term that included the opponent's *Golf record books for gift sets*, and therefore could be considered identical. The goods are indispensable for the supply of the associated *Retail services relating to printed matter*. However, in my view the average consumer would not expect a retailer of printed matter, such as books, newspapers or magazines, to be responsible for the production of the goods that they sell, and so I find that the services and goods are dissimilar.

66. The final retail services concern *Towels* and *glassware*. These would be sold in general homeware stores or websites, which may also sell the opponent's *Coolie bags* and *Hip flasks*, so there could be some shared trade channels. I do not find any complementarity. The goods and services are, in my view, dissimilar.

67. The remaining services in this class can be described as services for business. They are *Advertising, Business administration, Business management, Marketing, Online advertisements* and *Consultancy, information and advisory services relating to all the aforesaid services* [including the retail services]. The purpose, users, trade

channels and nature of these services are different from those of any of the opponent's goods. They are not in competition, nor are they complementary.

68. At the hearing, Ms Wilkinson-Duffy submitted:

“To the extent that there is a genuine intention by the applicant to use [the contested mark] for these services, which of course, was declared when the application was filed, I would submit, in the context of the evidence that has been submitted, that it is obvious that all of these services must be focused on the golfing world. To the extent that they are going to be offering third parties advertising or business administration or business management services, they are going to be doing that in the context of putting themselves out as being professionals in that area for golfing purposes. In that context, we would say that there is clearly similarity to a trade mark that has a reputation, and in the context of likelihood of confusion an enhanced distinctiveness. Therefore, we would say that they may not be highly similar but they are certainly similar.”<sup>16</sup>

69. As Ms Wilkinson-Duffy rightly noted earlier, the contested specification does not limit the services to those related to golf. I must make my comparison on the basis of the ordinary and natural meaning of the words the applicant has chosen: see *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraph 12, and *Sky Plc & Ors v Skykick UK Ltd & Anor* [2020] EWHC 990 (Ch), paragraph 56. I find that *Advertising, Business administration, Business management, Marketing, Online advertisements and Consultancy, information and advisory services relating to all the aforesaid services* [including the retail services] are dissimilar to the opponent's goods. Even if they were limited to services directed to the golfing community, I would make the same finding. I will return to the questions of enhanced distinctiveness and reputation later in my decision.

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<sup>16</sup> Transcript, page 18.

## Class 41

70. *Aerial photography* involves the provision of photography services through technology such as drones. It is used by companies or individuals who want to promote their businesses or specific events with aerial images, or pursue it as a hobby. It is different in nature and intended purpose from any of the opponent's goods and does not share any trade channels with them. Consequently, there is no competition. I consider there to be no complementarity. I find *Aerial photography* to be dissimilar to the opponent's goods.

71. The rest of the Class 41 services are closely connected to golf. I shall take *Arrangement of professional golf tournaments; Entertainment in the nature of golf tournaments; Entertainment services relating to the playing of golf; Organisation of golf competitions; Conducting of professional golf competitions* and *Organisation of golf tournaments* as a group. The users of these services are the same as the users of the opponent's *Sporting articles for use in playing golf* or *Articles for sports and games, namely for golf*. The nature is different, as are the purpose and method of use. The goods are indispensable for provision of the services: without the goods, the competitions and tournaments cannot take place. However, in my view the average consumer is unlikely to assume that they are the responsibility of the same undertaking given the differences in nature. Consequently, I do not find them to be complementary and to my mind the services are dissimilar to the opponent's goods.

72. The opponent's goods also include the more specific golf clubs. The applicant's *Fitting of golf clubs to individual users* would be aimed at the same public who buy golf clubs, which are indispensable to the delivery of the service. In my view, the average consumer would assume that the same undertaking is responsible for producing and fitting the golf clubs. I find the services to be similar to a medium degree to the opponent's goods.

73. *Golf caddie services* will be provided at golf courses and consist of individuals carrying the bags of golfers and giving them support and advice, for example about the course. The nature and method of use are different from those of the opponent's *Sporting articles for use in playing golf*, although they have the same users and may

share some trade channels, with both the services and the goods likely to be offered for sale at large golf resorts. The goods are essential for use of the services, but I do not consider that the average consumer would assume that they are the responsibility of the same undertaking, given the differences in nature. I find that the goods and services are dissimilar.

74. In my view, the same rationale applies to *Golf courses; Golf fitness instruction; Golf tuition; Golf driving range services; Providing golf facilities*. I find them to be dissimilar to the opponent's goods.

75. The applicant's *Rental of golf equipment* is dependent on the opponent's *Sporting articles for use in playing golf* and I consider that the average consumer would assume that the services and goods are the responsibility of the same undertaking. They are aimed at the same users and have the same purpose. I find them to be similar to a medium degree.

76. The final services to be considered are *Consultancy, information and advisory services relating to all of the aforesaid services*. These would be used by the providers of those services, but also potential and current customers of the opponent's *Sporting articles for use in playing golf*, so there is some overlap in users. The nature is different, as is the method of use, but there may be a slight overlap in trade channels. In my view there is no complementarity between these services and the goods. Overall, I find them to be dissimilar.

### *Summary*

77. I summarise my findings in the table below:

<b>Identical</b>	<u><i>Class 16</i></u> <i>Books; Printed matter; Stationery.</i>
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	<p><u>Class 18</u> Bags; Golf umbrellas; Parasols; Umbrellas; all of the aforementioned goods principally marketed at golfers or golf fans.</p> <p><u>Class 21</u> Flasks.</p> <p><u>Class 25</u> Clothing, headgear and footwear; Belts [clothing]; Gloves; Golf caps; Golf footwear; Golf pants, shirts and skirts; Golf shirts; Golf shoes; Golf shorts; Golf skirts; Golf trousers; Jackets; Knitwear; Leisurewear; Polo shirts; Shirts; Socks; Sports clothing; Sports clothing [other than golf gloves]; Sports shirts; Sweat shirts; T- shirts; Waterproof clothing; all of the aforementioned goods principally marketed at golfers or golf fans.</p> <p><u>Class 28</u> Articles for playing golf; Bag stands for golf bags; Caddie bags for golf clubs; Covers (shaped -) for golf clubs; Covers (shaped -) for golf bags; Fitted protective covers specially adapted for golf clubs; Golf bags; Golf bag carts; Golf bag trolleys; Golf bags with or without wheels; Golf balls; Golf ball markers; Golf ball retrievers; Golf clubs; Golf club bags; Golf club covers; Golf club grips; Golf club heads; Golf club head covers; Golf club shafts; Golf gloves; Golf irons; Golf mats; Golf practice apparatus; Golf putters; Golf tees; Golf tee bags; Handles for golf clubs; Toys, games, playthings and novelties.</p>
<b>Highly similar</b>	<p><u>Class 18</u> Bags for sports clothing; Sports bags; Umbrella covers.</p> <p><u>Class 21</u> Liqueur flasks.</p>

<p><b>Similar to a medium degree</b></p>	<p><u>Class 16</u> Golf scorecards; Golf scorecard holders.</p> <p><u>Class 18</u> Backpacks; Hand bags; Handbags, purses and wallets; Rucksacks; Shoulder bags; all of the aforementioned goods principally marketed at golfers or golf fans.</p> <p><u>Class 35</u> Retail services relating to umbrellas, clothing, footwear and headgear principally marketed at golfers and golf fans; Retail services relating to drinking flasks, golf clubs, golf balls, toys, games.</p> <p><u>Class 41</u> Fitting of golf clubs to individual users; Rental of golf equipment.</p>
<p><b>Similar to a low degree</b></p>	<p><u>Class 16</u> Golf yardage books.</p>
<p><b>Dissimilar</b></p>	<p><u>Class 14</u> Badges of precious metal; Bracelets; Clocks; Coins; Cufflinks; Jewellery; Jewellery chains; Key rings and key chains; Medals; Metal badges for wear [precious metal]; Medallions; Rings [jewellery]; Scale models [ornaments] of precious metal; Tie pins; Trophies coated with precious metal alloys; Trophies of precious metals; Watches.</p> <p><u>Class 16</u> Photographs; Printed teaching materials.</p> <p><u>Class 18</u> Canes; Briefcases; Luggage; Suitcases; Walking sticks; all of the aforementioned goods principally marketed at golfers or golf fans.</p>

	<p><u>Class 35</u>  <i>Advertising, Business administration; Business management; Marketing; Online advertisements; Retail services relating to luggage principally marketed at golfers and golf fans; Retail services relating to software, jewellery, photography, printed matter, towels, glassware; Consultancy, information and advisory services relating to all the aforesaid services.</i><sup>17</sup></p> <p><u>Class 41</u>  <i>Aerial photography; Arrangement of professional golf tournaments; Entertainment in the nature of golf tournaments; Entertainment services relating to the playing of golf; Golf caddie services; Golf courses; Golf fitness instruction; Golf tuition; Organisation of golf competitions; Golf driving range services; Conducting of professional golf competitions; Organisation of golf tournaments; Providing golf facilities; Consultancy, information and advisory services relating to the aforesaid service.</i><sup>18</sup></p>
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78. In *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA, Lady Justice Arden stated that:

“... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”<sup>19</sup>

79. The opposition under section 5(2)(b) fails with respect to all goods and services which I found to be dissimilar to the opponent’s goods.

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<sup>17</sup> Including all Class 35 services in the application.

<sup>18</sup> Including all Class 41 services in the application.

<sup>19</sup> Paragraph 49.

## ***Average consumer and the purchasing process***

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

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”<sup>20</sup>

81. Both parties are agreed that the average consumer is a golfer, golf fan or an individual familiar with the game of golf. Ms Wilkinson-Duffy submitted that they would pay an average degree of attention during the purchasing process, while Ms Stewart considered that attention would be average to high. Where the goods and services involve a considerable outlay and would have an effect on the consumer’s performance, I consider that they would pay a slightly higher than average degree of attention. The goods that in my view fall into this category are *Golf clubs*, *Golf irons*, and *Golf putters*. For the remaining goods and services, I find that attention would be average.

82. When the average consumer is deciding which goods or services to buy, the process will, to my mind, be predominantly a visual one. They will see the marks in retail outlets, on websites and in printed advertising. Some of the goods, such as clothing and bags, may also prominently display the marks, so the consumer would see them when used by others. I do not discount the aural element, as word-of-mouth recommendations may be made and the assistance of sales staff may be sought when making some purchases, for example of equipment.

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<sup>20</sup> Paragraph 60.


### **Comparison of marks**

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

“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”<sup>21</sup>

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

85. The respective marks are shown below:

<b>Earlier marks</b>	<b>Contested mark</b>
BEN HOGAN 	HOGAN'S ALLEY

86. The earlier marks consist of the name of an individual. As BEN is a relatively common first name in the UK, I do not doubt that this is how the average consumer who plays or enjoys golf will understand the marks. Although Ms Stewart submitted

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<sup>21</sup> Paragraph 34.

that the first name would be dominant, as identifying the particular HOGAN that the mark relates to, and Ms Wilkinson-Duffy submitted that the surname would be dominant, in my view the average consumer would see the mark as a unit, and a significant proportion of them would recognise the name as that of a particular golfer. I find that the overall impression of the earlier word marks lies in the words BEN HOGAN as a unit. In the case of the stylised mark, the stylisation makes only a minor contribution to the overall impression of that mark.

87. The contested mark consists of the words HOGAN'S ALLEY. The possessive nature of the first word results in the mark hanging together as a unit. The overall impression of the mark lies in that unit, seen to refer to a place belonging to, or associated with, someone called Hogan.

#### *Visual and aural comparison*

88. All the marks consist of two words, one of which is a form of HOGAN, although that word comes first in the contested mark and last in the earlier marks. Ms Wilkinson-Duffy submitted that the order of the words did not affect the assessment of visual and aural similarity. Ms Stewart conceded that the shared element HOGAN may lead to some similarity between the marks, but that this would be, at best, at a low level. I agree with Ms Stewart. I found that the average consumer would understand both the earlier marks and the contested marks as units, rather than seeing HOGAN as dominant. In my view there is a low level of visual similarity between the contested mark and the earlier word mark. I also agree with Ms Stewart that the stylisation of UKTM No. 3161211 means that there is a slightly lower level of visual similarity between this mark and the contested mark.

89. The earlier marks have three syllables, while the contested mark has four. Two of these are shared, although as I have already noted they take up different positions in the marks. I find the marks to be similar to a low degree.

### *Conceptual comparison*

90. Ms Wilkinson-Duffy submitted that the contested mark shared with the earlier marks a connection to the golfer Ben Hogan. Ms Stewart submitted that the contested mark referred to a historic event in 1953 and was conceptually synonymous with the applicant's Championship golf course, rather than with the golfer.

91. The applicant has filed a considerable number of witness statements purporting to show that the golfing community associates the contested mark with the applicant. I agree with Ms Wilkinson-Duffy that the applicant's evidence shows that the 6<sup>th</sup> hole at the Championship course at Carnoustie is linked to Mr Hogan. There is a plaque and the caddies inform visitors of the connection.<sup>22</sup> In my view, there will be a group of consumers who know the history of The Open in 1953 and Mr Hogan's achievements. For these consumers, some of the conceptual content of the applicant's mark will be shared with the earlier marks. I find the marks to be conceptually similar to between a medium and high degree for these consumers.

92. There may be a group of consumers who are aware of the name of the sixth hole at the Carnoustie Championship Course, but do not know about Ben Hogan. For these consumers, and those who do not know about either the course or the golfer, there is no conceptual similarity. They will see the contested mark as denoting a place, with "ALLEY" suggesting narrowness. "HOGAN", on the other hand, will have no meaning.

### ***Distinctive character of the earlier marks***

93. In *Lloyd Schuhfabrik Meyer*, the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from

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<sup>22</sup> Witness statement of Trevor Williamson, paragraph 7.

those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Alternberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered, the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark, the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking, and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

94. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. While it is the case that some consumers will recognise “BEN HOGAN” as the name of a former golfer, this is at the most mildly allusive to the purpose for which the golf-related goods will be put and so inherently distinctive to a low to medium degree. For the remaining goods, as no evidence has been provided on whether “HOGAN” is a common, or uncommon, surname in the UK, I consider that the earlier marks are inherently distinctive to a medium degree. They would also be inherently distinctive to a medium degree for all the goods to those consumers who are not aware of Ben Hogan as a golfer.

95. The opponent claims that the distinctiveness of the earlier marks has been enhanced through use. Ms Stewart submitted that such a claim was not supported by the evidence.

96. I remind myself that it is use and promotion in the UK that is significant for my assessment. In her witness statement, Ms Jove states that clothing has been sold under the marks since 2015 in Asda and TK Maxx. Between 2015 and 2019, 350,000



items of apparel were sold. This figure breaks down as follows: 22,250 (2015), 125,000 (2016), 140,750 (2017), 48,500 (2018) and 39,750 (2019). Turnover for the period was £2,572,000.<sup>23</sup> These figures do not differentiate between types of clothing, or whether they are for general or sports wear.

97. I have been given no information on the size of the general or golf-related clothing markets in the UK. I am in no doubt that the former is a very large market. Whether the figures quoted above represents a reasonable share of the market may depend on whether the clothing is general-purpose or specific to golf. Exhibit SJ7 contains some screenshots from the Wayback Machine showing the mark used on, and in relation to, clothing described as being “carefully crafted for the everyday golfer” and containing features such as moisture wicking, water repelling fabric and sun protection.<sup>24</sup> However, there is no evidence that these websites are directed at the UK market or even that the goods can be purchased online.

98. Exhibits SJ9a and SJ9b contain printouts from the Asda website made on 1 September 2020. They show items described as “Golf Polo Shirts” formerly on sale for £3 (reduced from £6) or £7 (reduced from £8) but are marketed under the heading “Men’s T-shirts”, which suggests that they are marketed to the general T-shirt buying public. Some of these contain reviews dating from 2 years previously, showing that they were offered for sale during the relevant period.<sup>25</sup> As they were offered for sale on the website, they would have been available throughout the United Kingdom. I cannot see whether they bear the earlier mark in its plain or stylised form.

99. Ms Jove provides no specific evidence on how these items are marketed in the UK. While she refers to the social media activity of the brand and gives figures for followers on Instagram, Facebook and Twitter, she does not say how many of these are based in the UK.

100. Taking the evidence as whole, I do not consider that it is sufficient to show that the inherent distinctiveness of the earlier marks has been enhanced through use for

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<sup>23</sup> Paragraphs 29 and 30.

<sup>24</sup> Page 88.

<sup>25</sup> Pages 164-167.

the Class 25 goods. The sales figures represent a small share of the general clothing market and there is no marketing evidence to show that the items sold in the UK were primarily directed towards golfers and golf enthusiasts. I shall now turn to the Class 28 goods.

101. The company Ben Hogan founded in 1953 started out making golf clubs. Production stopped in 2008, but Ms Jove states that by then the brand had become popular “around the world” and there remained a strong collectors’ market.<sup>26</sup> No evidence has been filed to support this assertion. In 2014, it was announced that the BEN HOGAN name would again be used for golf clubs and the products were launched at the 2015 PGA Merchandise Show in Orlando, Florida.<sup>27</sup>

102. Ms Jove says that golf equipment and accessories, including golf clubs, golf bags, backpacks and duffel bags, were first sold in the UK in August 2017. Between that date and December 2019, UK turnover was approximately \$126,000, although it is not clear which goods were sold.<sup>28</sup> Exhibit SJ8 contains a collection of reviews from the UK Trustpilot site, dating from 26 October 2018 to 25 March 2019, and a series of articles from various websites, some of which are undated while the others were updated in 2015 and 2018. Of these websites, it appears that some are US-focused as prices are given in dollars. I also note that one of the Trustpilot reviews refers to the goods being shipped to the purchaser’s home in Germany.<sup>29</sup> I cannot therefore assume that all these reviews relate to sales to UK customers. The only products that are mentioned are golf clubs, although links are shown to reviews of bags and golf balls on the 2015 articles. Exhibits SJ12a and SJ12b contain printouts from the Ben Hogan website. Many of these are undated. Those that are come from 2014 to 2018 and show golf clubs and bags for sale. As with the Class 25 goods, there is no evidence of how the goods are marketed beyond the website and social media accounts.

103. At the hearing, Ms Wilkinson-Duffy responded to the criticisms made by the applicant of the evidence on promotion and marketing:

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<sup>26</sup> Witness statement of Sara Jove, paragraph 5.

<sup>27</sup> See paragraphs 10 and 11, and Exhibits SJ4 and SJ6.

<sup>28</sup> Paragraphs 23 and 31.

<sup>29</sup> Page 112.

“... To some extent, a historical brand like this does not require the same amount of investment in marketing as something that consumers need to be educated about. There is an element of maintaining that market share, of course, through ensuring that people remember the brand is being re-launched, that they are aware of that and reminded of the historical reputation that it has. But it does not require the same sort of extensive marketing figures.”<sup>30</sup>

104. In the current proceedings, though, I have no evidence on the promotion of the brand to the relevant UK public in the years leading up to the relaunch of the golf clubs and nothing on the level of awareness of that same public.

105. The evidence shows that golf clubs (and possibly other golfing equipment) were being sold in the UK for about eighteen months before the date of application for the contested mark. Even if I were to assume that all the turnover figure related to this period, it is still, in my view, a fairly low figure, particularly considering the prices at which golf clubs sell. Exhibit SJ8 shows one club retailing at £99 and another at £599.<sup>31</sup> Taking the evidence as a whole, I find that the opponent has not shown that the distinctiveness of the marks has been enhanced through use in relation to the Class 28 goods.

106. No other goods are shown in the evidence as being sold in the UK in the period leading up to the application for the contested mark.

### ***Conclusions on likelihood of confusion***

107. There is no scientific formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services or vice versa. It is necessary for me to take

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<sup>30</sup> Transcript, page 7.

<sup>31</sup> Pages 126-140.

account of the distinctive character of the opponent's marks, the average consumer and the nature of the purchasing process for the contested goods and services. In doing so, I must be aware that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them they have in their mind.

108. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

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

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)."

109. I also bear in mind the comments of Mr James Mellor QC (as he then was), sitting as the Appointed Person, in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17:

"... I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: 'Taking account of the common element in the context of the later mark as a whole.' (my emphasis)."<sup>32</sup>

110. At the hearing, Ms Stewart submitted that there was so little similarity between the marks that this would offset any similarities between the goods and services. I found that the marks had a low degree of visual and aural similarity and a medium to high degree of conceptual similarity for a group of consumers who would associate both marks with the golfer Ben Hogan. The visual and aural differences between the marks are, in my view, sufficient for the average consumer not to mistake one for the other, and so I find that there is no likelihood of direct confusion.

111. Turning now to indirect confusion, I note that the contested mark does not fall within any of Mr Purvis's categories in *LA Sugar* but also that his list was not exhaustive. As this is a global assessment involving the interdependency principle, I must consider all the relevant factors.

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<sup>32</sup> Paragraph 81.4.

112. At this point, I will say more about the average consumer. At the hearing, Ms Wilkinson-Duffy submitted that a large proportion of the relevant public would be aware of the BEN HOGAN trade mark and its reputation. Such a scenario should more properly be considered under section 5(3). I am prepared to accept that a significant proportion of relevant consumers would be aware of the golfer Ben Hogan, but that is not the same thing as being aware of the earlier marks.

113. Where the goods and services are identical or highly similar, I consider that the average consumer who knows about Ben Hogan the golfer would assume that both marks belong to the same or economically connected undertakings. In my view, a significant proportion of the relevant public would think that these are two sub-brands from the same company. In my view, this proportion would be significant enough to warrant the intervention of this tribunal: see *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, paragraph 34. I find that there is a likelihood of indirect confusion for the goods and services where I found there to be identity or a high degree of similarity.

114. This includes footwear, which is only covered by UKTM No. 3161211, the stylised mark. Although the visual similarity between this mark and the contested mark is slightly lower than the visual similarity between the plain word marks and the contested mark, this difference is not, to my mind, large enough to counteract the identity of the goods.

115. Where the goods and services are similar to a medium degree, use of the contested mark would at most, in my view, call to mind the earlier mark, but the average consumer would not in my view be likely to assume that the opponent, or an entity connected with it, is responsible for the supply of the services, given the low level of visual similarity between the marks. Mere association is not enough for a likelihood of confusion.

116. Ms Stewart submitted that even where the goods and services were identical or similar, there could still be no likelihood of confusion, because of the existing goodwill and reputation of the applicant. She asserted that the contested mark had been used by the applicant since 1953, and that such use predates the earlier marks.

117. In *Victoria Plum Ltd v Victorian Plumbing Ltd* [2016] EWHC 2911 (Ch), Carr J considered the CJEU's judgment in *Budejovicky Budvar NP v Anheuser-Busch Inc.*, Case C-482/09, and the Court of Appeal's judgments in that case and in *IPC Media Ltd v Media 10 Ltd* [2014] EWCA Civ 1403, and stated that a defence of honest concurrent use could, in principle, defeat an otherwise justified claim of trade mark infringement (and, by analogy, opposition). Having reviewed the case law the judge stated that:

"The case law to which I have referred establishes the following principles:

- i) Where two separate entities have co-existed for a long period, honestly using the same or closely similar names, the inevitable confusion that arises may have to be tolerated.
- ii) This will be the case where the trade mark serves to indicate the goods or services of either of those entities, as opposed to one of them alone. In those circumstances, the guarantee of origin of the claimant's trade mark is not impaired by the defendant's use, because the trade mark does not denote the claimant alone.
- iii) However, the defendant must not take steps which exacerbate the level of confusion beyond that which is inevitable and so encroach upon the claimant's goodwill."

118. Ms Wilkinson-Duffy countered that the use shown in the evidence could not be described as trade mark use. I agree. The contested mark has been used in connection with a particular hole on a particular golf course. I cannot see that it is used to denote the origin of goods and services to consumers. The applicant's evidence falls short of what would be required to mount a successful honest concurrent use defence.

## **Outcome**

119. The section 5(2)(b) ground succeeds with respect to the following goods and services:

### Class 16

*Books; Printed matter; Printed publications; Stationery.*

### Class 18

*Bags; Bags for sports clothing; Golf umbrellas; Parasols; Sports bags; Umbrellas; Umbrella covers; all of the aforementioned goods principally marketed at golfers or golf fans.*

### Class 21

*Flasks; Liqueur flasks.*

### Class 25

*Clothing, headgear and footwear; Belts [clothing]; Gloves; Golf caps; Golf footwear; Golf pants, shirts and skirts; Golf shirts; Golf shoes; Golf shorts; Golf skirts; Golf trousers; Jackets; Knitwear; Leisurewear; Polo shirts; Shirts; Socks; Sports clothing; Sports clothing [other than golf gloves]; Sports shirts; Sweat shirts; T-shirts; Waterproof clothing; all of the aforementioned goods principally marketed at golfers or golf fans.*

### Class 28

*Articles for playing golf; Bag stands for golf bags; Caddie bags for golf clubs; Covers (shaped -) for golf clubs; Covers (shaped -) for golf bags; Fitted protective covers specially adapted for golf clubs; Golf bags; Golf bags carts; Golf bag trolleys; Golf bags with or without wheels; Golf balls; Golf ball markers; Golf ball retrievers; Golf clubs; Golf club bags; Golf club covers; Golf club grips; Golf club heads; Golf club head covers; Golf club shafts; Golf gloves; Golf irons; Golf mats; Golf practice apparatus; Golf putters; Golf tees; Golf tee bags; Handles for golf clubs; Toys, games, playthings and novelties.*



120. The opposition under section 5(2)(b) fails with respect to the following goods and services:

Class 14

*Badges of precious metal; Bracelets; Clocks; Coins; Cufflinks; Jewellery; Jewellery chains; Key rings and key chains; Medals; Metal badges for wear [precious metal]; Medallions; Rings [jewellery]; Scale models [ornaments] of precious metal; Tie pins; Trophies coated with precious metal alloys; Trophies of precious metals; Watches.*

Class 16

*Golf scorecards; Golf scorecard holders; Golf yardage books; Photographs; Printed teaching materials.*

Class 18

*Cane; Backpacks; Briefcases; Golf bag tags of leather; Hand bags; Handbags, purses and wallets; Luggage; Rucksacks; Shoulder bags; Suitcases; Walking sticks; all of the aforementioned goods principally marketed at golfers or golf fans.*

Class 35

*Advertising; Business administration; Business management; Marketing; Online advertisements; Retail services relating to umbrellas, luggage, clothing, footwear and headgear principally marketed at golfers and golf fans; Retail services relating to software, jewellery, photography, printed matter, drinking flasks, towels, glassware, golf clubs, golf balls, toys, games; Consultancy, information and advisory services relating to all of the aforesaid services.*

Class 41

*Aerial photography; Arrangement of professional golf tournaments; Entertainment in the nature of golf tournaments; Entertainment services relating to the playing of golf; Fitting of golf clubs to individual users; Golf caddie services; Golf courses; Golf fitness instruction; Golf tuition; Organisation of golf competitions; Golf driving range services; Conducting of professional golf competitions; Organisation of golf tournaments; Providing golf facilities; Rental of*

*golf equipment; Consultancy, information and advisory services relating to all of the aforesaid services.*

### **Section 5(3)**

121. The relevant case law for section 5(3) can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L'Oréal SA & Ors v Bellure & Ors* (Case C-487/07) and *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09). The law appears to be as follows:

- a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.
- b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.
- c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon*, paragraph 29, and *Intel*, paragraph 63.
- d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods and/or services, the extent of the overlap between the relevant consumers for those goods and/or services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.
- e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or that there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68. Whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

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

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 on the earlier mark; *L'Oréal*, 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 proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation; *Interflora*, paragraph 74, and the court's answer to question 1 in *L'Oréal*.

122. The marks upon which the opponent is relying are as follows:

Marks	Goods for which reputation is claimed
UKTM No. 3161211    Application date: 25 April 2016 Registration date: 26 August 2016.	<u>Class 25</u> <i>Clothing and headwear principally marketed to golfers or golf fans.</i>
UKTM No. 1142877  <b>BEN HOGAN</b>  Application date: 29 October 1980. Registration date: 29 October 1980.	<u>Class 25</u> <i>Articles of golfing sports clothing.</i>  <u>Class 28</u> <i>Articles for sports and games, namely for golf.</i>

### **Reputation**

123. In *General Motors Corp v Yplon SA*, Case C-375/97, the CJEU held that:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or services marketed, either the public at large or a more specialised public, for example traders in a specific sector.

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

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

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the

market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking in promoting it.

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

124. Ms Stewart submitted that the evidence filed by the opponent was not sufficient to show that the earlier marks had a reputation in the UK. In her skeleton argument, Ms Wilkinson-Duffy submitted that:

"While the Applicant has attempted to artificially separate the clear reputation of Ben Hogan as a golfing individual and the reputation of the trade mark BEN HOGAN, these two are inextricably intertwined. Furthermore, the criticism of the turnover and sales provided in the Witness Statement of Sara Jove is not merited, as BEN HOGAN branded products are renowned for their high quality and are not intended for mass production. The correct market context must be taken into account in the assessment of reputation."<sup>33</sup>

125. However, under section 5(3), the reputation must be in the goods and/or services for which the earlier marks have been registered: see *Tulliallan Burlington Ltd v EUIPO*, Case T-123/16, paragraph 27. The factors I must take into account when assessing the claim to reputation are highly similar to those that were relevant when I considered the claim to enhanced distinctiveness. The question here is whether a significant proportion of the relevant public for clothing aimed at golfers or golf fans and for articles for playing golf knows the earlier marks. As these are both UKTMs, it is the relevant public in the UK that I must consider.

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<sup>33</sup> Paragraph 25.

126. While I agree with Ms Wilkinson-Duffy that turnover figures and sales volumes are not the only relevant factors. I do consider that they are small and the goods have not been available in the UK for a long period of time. Ms Jove states that clothing was first sold in the UK in 2015 and golfing equipment and accessories in 2017, periods of four and two years respectively before the relevant date which is the date of application for the contested mark. Ms Wilkinson-Duffy made much of the heritage aspects of the earlier marks and referred to the collectors' market mentioned by Ms Jove, but there is no documentary evidence to corroborate the existence of such a market in the UK.

127. Neither is there evidence of the activities undertaken to promote the marks. It is possible for marks to have a significant reputation and small volumes of sales, but there must be some means of educating the public about the mark, whether through advertising, brand ambassadors, or other promotional activity. The social media posts occasionally mention brand ambassadors<sup>34</sup> but there is no indication that such activity has built a reputation in the UK, particularly as the number of UK followers of those accounts is unclear and there is no other evidence of the brand ambassadors' activities.

128. I find that the opponent has not shown that the earlier marks have a reputation in the UK. The section 5(3) opposition fails.

## **FINAL REMARKS**

129. The applicant had offered to exclude the following goods from Classes 18 and 28 respectively of the contested application: *Coolie bags for gift sets* and *Chess sets for gift sets*. The terms in the applicant's specification would then read as follows:

### *Class 18*

*Bags ... all of the aforementioned goods principally marketed at golfers or golf fans; not including coolie bags for gift sets.*

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<sup>34</sup> See, for example, the tweet on page 264 of Exhibit SJ13a.

Class 28

*Toys, games, playthings and novelties, not including Chess sets for gift sets.*

Even if those terms were excluded, the applicant's specification would still cover goods that are highly similar to *Coolie bags* and *Chess sets*, and I note that I found there to be a likelihood of indirect confusion under section 5(2)(b) of the Act for those contested goods that were highly similar to any of the opponent's goods. Therefore, I am not persuaded that the proposed amendment to the specification would produce a different outcome for the applicant.

**CONCLUSION**

127. The partial opposition has partially succeeded under section 5(2)(b) of the Act and, subject to any successful appeal, the contested mark will proceed to registration for the following goods and services:

Class 14

*Badges of precious metal; Bracelets; Clocks; Coins; Cufflinks; Jewellery; Jewellery chains; Key rings and key chains; Medals; Metal badges for wear [precious metal]; Medallions; Rings [jewellery]; Scale models [ornaments] of precious metal; Tie pins; Trophies coated with precious metal alloys; Trophies of precious metals; Watches.*

Class 16

*Golf scorecards; Golf scorecard holders; Golf yardage books; Photographs; Printed teaching materials.*

Class 18

*Cane; Backpacks; Briefcases; Golf bag tags of leather; Hand bags; Handbags, purses and wallets; Luggage; Rucksacks; Shoulder bags; Suitcases; Walking sticks; all of the aforementioned goods principally marketed at golfers or golf fans.*

Class 30

*Coffee; Confectionery; Tea*

Class 32

*Beers; Non-alcoholic beverages.*

Class 33

*Alcoholic beverages (except beers), but in so far as whisky and whisky based drinks are concerned, only Scotch Whisky and Scotch Whisky based drinks produced in Scotland; Wines.*

Class 35

*Advertising; Business administration; Business management; Marketing; Online advertisements; Retail services relating to umbrellas, luggage, clothing, footwear and headgear principally marketed at golfers and golf fans; Retail services relating to software, jewellery, photography, printed matter, drinking flasks, towels, glassware, golf clubs, golf balls, toys, games; Consultancy, information and advisory services relating to all of the aforesaid services.*

Class 36

*Fundraising and sponsorship; Consultancy, information and advisory services relating to all of the aforesaid services.*

Class 41

*Aerial photography; Arrangement of professional golf tournaments; Entertainment in the nature of golf tournaments; Entertainment services relating to the playing of golf; Fitting of golf clubs to individual users; Golf caddie services; Golf courses; Golf fitness instruction; Golf tuition; Organisation of golf competitions; Golf driving range services; Conducting of professional golf competitions; Organisation of golf tournaments; Providing golf facilities; Rental of golf equipment; Consultancy, information and advisory services relating to all of the aforesaid services.*

Class 43

*Bar services; Catering services for conference centres; Provision of conference, exhibition and meeting facilities; Providing food and drink in restaurants and bars; Rental of conference rooms; Restaurants; Restaurant services; Restaurant*



*services incorporating licensed bar facilities; Serving of alcoholic beverages; Consultancy, information and advisory services relating to all of the aforesaid services.*

*Class 45*

*Licensing of intellectual property rights; Consultancy, information and advisory services relating to all of the aforesaid services.*

**COSTS**

128. Both parties have enjoyed some measure of success in this partial opposition, with the honours being roughly even. Consequently, I order each party to bear its own costs.

**Dated this 17th day of September 2021**

**Clare Boucher  
For the Registrar  
Comptroller-General**