

O/1092/22

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO. 3662420
BY SKINS GOLF LTD
TO REGISTER AS A SERIES OF TRADE MARKS:

Skins Golf
SKINS GOLF

IN CLASSES 24, 25 AND 28

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 430416
BY SYMPHONY HOLDINGS LIMITED

Background and pleadings

1. On 30 June 2021, Skins Golf Ltd (“the applicant”) applied to register **Skins Golf** and **SKINS GOLF** as a series of trade marks in the UK, under number 3662420. As the only difference between the marks is the use of different letter cases, I will refer to them in the singular (“the contested mark”) unless it becomes necessary to distinguish between them. The contested mark was published in the Trade Marks Journal for opposition purposes on 22 October 2021. Registration is sought for the following goods:

Class 24: Golf towels.

Class 25: Golf shirts; Golf clothing, other than gloves; Sweaters; Polo sweaters; Golf trousers; Golf shorts; Hats; T-shirts.

Class 28: Golf gloves; Golf tees; Golf ball markers; Golf divot repair tools.

2. On 21 January 2022, Symphony Holdings Limited (“the opponent”) filed a notice of opposition. The opposition is brought under section 5(2)(b)¹ of the Trade Marks Act 1994 (“the Act”) and is directed against all the goods of the application.

3. In support of its claim the opponent relies upon the following marks:



UK trade mark number: 3702990²

Filing date: 23 April 2020

Priority date: 23 October 2019

(“the first earlier mark”)

¹ The opponent originally sought to rely upon additional grounds, namely, s.5(3) and s.5(4)(a). However, within its written submissions dated 20 June 2022, the opponent withdrew reliance on the same. Its claim is now based solely on s.5(2)(b).

²On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 59 of the Withdrawal Agreement between the UK and EU, applications for EUTMs made before the end of the transition period that had received a filing date can form the basis of a UK application with the same filing date as the corresponding EUTM, provided they were filed within 9 months of the end of the transition period. The applicant’s EUTM number 18229934 was filed at the EUIPO on 23 April 2020, whereas its UK application was filed on 28 September 2021. Accordingly, the UK application was given the same filing date as its EUTM i.e. 23 April 2020, and the same priority date, 23 October 2019.



UK trade mark number: 3702951³

Filing date: 23 April 2020

Priority date: 23 October 2019

("the second earlier mark")



UK trade mark number: 3702859⁴

Filing date: 23 April 2020

Priority date: 23 October 2019

("the third earlier mark")

4. For the purposes of the opposition, the opponent relies upon the goods and services of its earlier marks as set out in the Annex to this decision.

5. Given the respective filing dates, the opponent's marks are earlier marks, in accordance with section 6 of the Act. However, as they have not been registered for five years or more at the filing date of the application,⁵ they are not subject to the proof of use requirements specified within section 6A of the Act. Consequently, the opponent

³ Under Article 59 of the Withdrawal Agreement, as set out above, this UK application, having been filed on 28 September 2021, was given the same filing and priority dates as its EUTM number 18229928.

⁴ Under Article 59 of the Withdrawal Agreement, as set out above, this UK application, having been filed on 28 September 2021, was given the same filing and priority dates as its EUTM number 18228572.

⁵ All three earlier marks are pending registration in the UK as they are currently subject to ongoing opposition proceedings.

may rely upon all of the goods and services for which the earlier marks are registered without having to establish genuine use.

6. In its notice of opposition, the opponent essentially argues that the respective goods and services are either identical or similar and that the competing marks, all sharing the word “Skins”, are similar, giving rise to a likelihood of confusion, including the likelihood of association.

7. The applicant filed a counterstatement denying the claims made by the opponent. It also sought to require the opponent to demonstrate proof of use of the earlier marks; however, as noted above, proof of use is not relevant in these proceedings.

8. The opponent is professionally represented by Keltie LLP, whereas the applicant represents itself. Both parties were given the option of an oral hearing, though neither asked to be heard on this matter. Neither party elected to file evidence. However, both parties filed written submissions during the evidence rounds. Whilst I do not intend to summarise these, I have taken them into consideration and will refer to them as and where appropriate during this decision. This decision is taken following a careful perusal of the papers.

9. 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 Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark case law.

Decision

Section 5(2)(b)

10. Sections 5(2)(b) and 5A of the Act read as follows:

“5(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”.

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

Case law

11. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods and services

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

“In assessing the similarity of the goods or services concerned, [...] all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

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

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

14. In *Gérard Meric v Office for Harmonisation in the Internal Market ('Merici')*,⁶ the General Court (GC) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut 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”.

15. For the purposes of considering the issue of similarity of goods or services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

16. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that ‘complementary’ means:

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

17. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of

⁶ Case T-133/05

examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. (as he then was), sitting as the Appointed Person, noted in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes”,

whilst on the other hand:

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

18. The goods and services to be compared are those in paragraph 1 and the Annex to this decision.

Class 24

19. The applicant’s term “golf towels” and the opponent’s term “golf clothing” differ in nature and method of use as one is to be worn and the other is used for cleaning dirty golf clubs. The intended purpose of the goods overlap insofar as both are used whilst participating in golf, however, I accept this is relatively limited. The goods are likely to reach the market through the same trade channels and sold at the same sports/golfing stores; they may also be produced by the same manufacturers. Furthermore, the goods will be targeted at the same users. The goods are not complementary as, although the respective goods are both used when playing golf, golf towels are not indispensable or important to golf clothing, or vice versa. Neither are the goods competitive in nature as the need for golf clothes cannot be satisfied by the purchase of a golf towel. Taking everything into account, I find that the goods are similar to between a low and medium degree.

Class 25

Golf clothing, other than gloves; T-shirts

20. The applicant's above terms have direct counterparts in the opponent's specifications. As such, I find that they are identical.

Golf shirts; Golf trousers; Golf shorts

21. The applicant's above terms are encompassed by the opponent's broader term "Golf clothing, other than gloves" and, therefore, I find that the respective goods are *Merix* identical.

Sweaters; Polo sweaters

22. The applicant's above terms could include goods for use in golf and, as such, they fall into the opponent's broader term "golf clothing, other than gloves". However, if I am wrong, the applicant's above terms are also encompassed by the opponent's broader term "clothing". Consequently, either way, I find that the goods are *Merix* identical.

Hats

23. "Hats" are included within the opponent's broader term "Headwear". Accordingly, the goods are *Merix* identical.

Class 28

Golf gloves

24. The opponent's term "golf clothing" and applicant's goods "golf gloves" differ in nature and method of use as golf gloves are used specifically to cover the hands. The intended purpose overlaps to the extent that they are both items to be worn when playing golf but differ in that clothing is for covering the body, whereas golf gloves are not only to cover the hands but to provide grip and protection whilst participating in the game. The goods are likely to be offered within the same retail outlets and may be produced by the same manufacturers. Furthermore, consumers would expect golfing

stores to offer both golf clothes and golf gloves. Users will also be the same. However, the goods are not competitive in nature, as golf gloves are not a sufficient substitute for golf clothing, or vice versa. Neither are the goods complementary, as they are not important or essential to the use of one another as required by the case law. Accordingly, I find that the goods are similar to between a low and medium degree.

Golf tees; Golf ball markers; Golf divot repair tools.

25. The applied-for terms above can be described as golf equipment. I consider that these goods and the opponent's "golf clothing" differ in nature and method of use as one is for wearing whilst the others are for use whilst playing golf. However, the intended purpose overlaps to the extent that the goods are required for the sport of golf. The trade channels are likely to overlap as retailers selling golfing equipment also offer golf clothing. Users will be the same. Furthermore, the goods are not complementary as golf equipment is not indispensable or important to the use of golf clothing. Overall, I am of the opinion that the goods are similar to between a low and medium degree.

26. I have also considered the other goods and services relied upon across the specifications of the earlier marks and none puts the opponent in a more favourable position.

The average consumer and the nature of the purchasing act

27. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

28. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

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

29. I find that the average consumer of the goods at issue will be the general public, particularly those with an interest in golf. The cost of the goods will range in price but, overall, they are likely to be fairly inexpensive. On average, consumers are likely to purchase these goods rather frequently. I find that the purchasing process is likely to be more casual than careful, however, consideration will be given to cost, quality, materials used and the durability of the goods. Taking the above factors into account, I find that consumers will demonstrate an average level of attention in respect of these goods. The goods are likely to be obtained by self-selection from the shelves of retail outlets, particularly golf stores, their online equivalents or through a retail catalogue. Overall, I am of the view that visual considerations would dominate the purchasing process. However, I do not discount aural considerations entirely as it is possible that the purchasing of these kinds of goods would involve discussions with sales assistants.

Comparison of the marks

30. It is clear from *Sabel BV v. Puma AG*⁷ that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, Case C-591/12P, that:


⁷ Case C-251/95, paragraph 23

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

31. It would therefore be wrong to artificially dissect the trade 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 they create.

32. It is my view that the first earlier mark represents the opponent’s best case. I note that the class 25 specifications of all three earlier marks contain the same goods. Moreover, the second and third earlier marks contain additional figurative elements which appear to render them less similar to the contested mark. Consequently, my assessment will focus upon the first earlier mark, returning to consider the other earlier marks only if it becomes necessary to do so.

33. The respective trade marks are shown below:

First earlier mark	Contested mark
	Skins Golf SKINS GOLF

Overall impressions

34. The first earlier mark is a figurative mark and comprises the word “SKINS” in a stylised font with an incomplete letter “K”. In my opinion, some consumers will not identify the letter “K” within the word and will, instead, perceive it as a device. However, at least a significant proportion of consumers will identify the letter “K” within the word, notwithstanding it being incomplete and stylised, especially as consumers will naturally try to identify words that they can understand. In my view, the overall impression lies predominately in the word “SKINS”. The stylisation, whilst still contributing, plays a lesser role in the overall impression.

35. As for the contested mark, it is in word-only format and encompasses the words “Skins Golf/SKINS GOLF”. In my view, the word “Golf/GOLF” has little trade mark significance given that it is entirely and directly descriptive of the kind and intended purpose of the goods in question. Even for the goods that are not worded specifically as relating to golf, such as polo sweaters and hats, these terms are broad enough to include those for use in golf. Therefore, the word “Golf/GOLF” will play a minimal role in the overall impressions.⁸ The overall impression of the mark lies overwhelmingly in the word “Skins/SKINS”.

Visual comparison

36. The competing marks are similar as the word “Skins/SKINS” is found at the beginning of both marks, a position which is generally considered to have more of an impact on UK consumers.⁹ However, the respective marks differ in that the contested mark is in a word-only format whereas the earlier mark is presented in a stylised font. In particular, the letter “K” is highly stylised and appears incomplete. Furthermore, the contested mark contains the additional word “Golf/GOLF” which is not replicated within the earlier mark. Whilst I acknowledge the second mark in the applicant’s series is presented in title case, this is not a significant difference, as registration of word-only marks provides protection for the word itself, irrespective of whether it is

⁸ *Metamorfoza d.o.o. v EUIPO*, Case T-70/20, paragraph 57

⁹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

presented in upper or lower case. Taking into account the overall impressions, I find that the competing marks are visually similar to a medium degree.

Aural comparison

37. As noted above, at least a significant proportion of consumers will identify the word “SKINS” in the earlier mark despite the stylisation of the letter “K”. Therefore, the earlier mark consists of one syllable i.e. “SKINS”, whereas the contested mark comprises two syllables i.e. “SKINS GOLF”. Despite the word “Golf/GOLF” in the contested mark being descriptive, it is my view that consumers may still pronounce it. As a result, the competing marks share an identical syllable in the word “Skins/SKINS”, with the difference resulting from the second word in the contested mark. Consequently, I find that there is between a medium and high degree of aural similarity between the marks.

Conceptual comparison

38. The applicant contends that “Our brand, Skins Golf, invokes the idea of our products having different designs, aesthetics, feel and look. The popularity and familiarity of the term “Skins” in the context of its meaning as an ‘Aesthetic Look’ has increased amongst consumers of online gaming goods and services in recent years (see image 1 for definition). Image 1¹⁰ contains the following definition “SKIN means Aesthetic Look in an online gaming context. The term SKIN can apply to the look or feel of a player, a game’s environment, or even hardware equipment (such as consoles or control pads). Changing a SKIN means changing the aesthetic look of something; it doesn’t usually affect the game play.”¹¹ Although I accept that some individuals such as online gamers may understand the word “skin” to mean the look or feel of a player or game’s environment, there is no evidence to establish that this would be the case for the average consumer of the goods in question. Furthermore, I have not been pointed to any understanding of skins within a golfing context that the average consumer might have. As such, I consider it unlikely that the word “Skins/SKINS” will be understood by consumers in the manner argued by the

¹⁰ This image/definition appears to derive from the website www.cyberdefinitions.com

¹¹ Applicant’s written submissions, paragraph 3

applicant. Rather, in my view, the word “SkinsSKINS” will be recognised by the average consumer as the plural of its dictionary definition “the natural outer layer that covers a person, animal, fruit, etc.”¹² The additional word “Golf/GOLF” in the contested mark will be understood as referring to the outdoor game in which players use a club to try to hit a small ball into a series of small holes in as few hits as possible. As noted above, this will be perceived as a descriptive reference to the kind and intended purpose of the goods, e.g. golf gloves and clothing for use in golf. Overall, the competing marks conceptually overlap in the meaning conveyed by the shared word “Skins/SKINS”. They differ in that the contested mark provides an additional concept, i.e. that associated with the word “Golf/GOLF”. Taking all of the above into account, I find that the competing marks are conceptually similar to a medium degree.

Distinctive character of the earlier mark

39. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does

¹² <https://dictionary.cambridge.org/dictionary/english/skin>

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).”

40. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. Dictionary words which do not allude to the goods will be somewhere in between. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion, the more distinctive the earlier mark, the greater the likelihood of confusion.

41. Further, although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use (nor was it required to do so). Consequently, I have only the inherent position to consider.

42. Within its submissions, the opponent argues that the mark has no meaning in relation to the goods and services in question.¹³

43. However, the applicant disputes the distinctiveness of the opponent’s mark claiming that the opponent’s products are intended to be worn as a second skin to the wearer.¹⁴

44. The first earlier mark is figurative and comprises the word “SKINS” in stylised format with an incomplete letter “K”. However, in my opinion at least a significant proportion of consumers will immediately identify the letter when viewing the mark as a whole. I disagree that the word “SKINS” will be perceived in relation to clothing as

¹³Opponent’s written submissions, paragraph 14

¹⁴ Applicant’s written submissions, page 3.

a second skin, particularly as there is no evidence in support of this. The word skin is dictionary defined as “the natural outer layer that covers a person, animal, fruit, etc.”¹⁵ Therefore, consumers will understand “SKINS” as a plural of its dictionary definition and unrelated to the goods in the specification of the first earlier mark. The distinctiveness of the mark lies predominantly in the word “SKINS,” however, the stylisation also contributes to the distinctiveness of the mark. Overall, I consider that the first earlier mark possesses at least a medium degree of inherent distinctive character.

Likelihood of confusion

45. Whether there is a likelihood of confusion must be assessed globally, taking into account a number of factors. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods, and vice versa. It is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be aware of the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

46. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

47. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C. (as he then was), 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

¹⁵ <https://dictionary.cambridge.org/dictionary/english/skin>

process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

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

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

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

48. These examples are not exhaustive but provide helpful focus.

49. I have found that the applicant’s goods are either identical or similar to between a low and medium degree to the goods of the first earlier mark. I have found that the average consumer of the goods will be the general public, particularly those interested

in golf, who will pay an average level of attention. I have found that the purchasing process will be largely visual, however, I have not discounted aural considerations. The overall impression of the first earlier mark is dominated by the word “SKINS”, while the stylisation plays a lesser role. The overall impression of the contested mark predominantly lies in the word, “SKINS/Skins”, with the word “GOLF/Golf” playing a lesser role. I have found that the first earlier mark and the contested mark are visually and conceptually similar to a medium degree and aurally similar to between a medium and high degree. I have also found that the first earlier mark possesses at least a medium degree of inherent distinctive character.

50. I recognise that, throughout this decision, I have focused upon the significant proportion of consumers who immediately perceive the first earlier mark as the word “SKINS”, i.e. those who identify the letter “K” as such. Whilst I acknowledge that there may be other consumers who do not perceive the first earlier mark in this way due to the heavy stylisation of the letter “K”, in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation*,¹⁶ Kitchin LJ (as he then was) stated that if a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement. Although this was in the context of infringement, the same approach is appropriate when considering a claim under section 5(2) of the Act.¹⁷ It is not, therefore, necessary for me to find that all, or even a majority of, consumers will be confused. The question is whether there is a likelihood of confusion amongst a significant proportion of the public displaying the characteristics attributed to an average consumer.

51. The marks differ in length as the first earlier mark consists of one word whereas the contested mark consists of two words. The competing marks are found in different formats. The first earlier mark is a figurative mark, which will be perceived by a significant proportion of average consumers as the word “SKINS” in a stylised font with an incomplete letter “K”, whilst the contested mark is in word-only format. However, in my opinion, taking into account the overall levels of similarity between the marks, those differences are likely to be insufficient to distinguish between the competing marks. As discussed above, the last word in the contested mark, i.e. “Golf/GOLF” is purely

¹⁶ [2016] EWCA Civ 41, paragraph 34

¹⁷ *Soulcycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch)

descriptive of the kind and intended purpose of goods which are to be used whilst playing golf. As a result, consumers may misremember whether the distinctive word “Skins/SKINS” is followed by a descriptor of the goods. The stylisation in the earlier mark, although contributing to the overall impression of the mark, may also be misremembered by consumers. The marks coincide in the identical word “Skins/SKINS”, which dominates the overall impression and distinctiveness of the respective marks. Furthermore, this overlapping element is found at the beginning of the marks, a position to which the attention of the consumer is usually directed. The word “Skins/SKINS” also leads to an aural and conceptual overlap between the competing marks. In my judgement it is highly likely that consumers, paying an average level of attention during the purchasing process, would misremember the marks for one another and fail to recall the presentational differences and whether the mark is accompanied by a descriptive reference to the goods. Consequently, in my view there is a likelihood of direct confusion.

52. In the event I am wrong about direct confusion, I will now go on to consider indirect confusion. I bear in mind that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.¹⁸

53. For golfing goods, the word “Golf/GOLF” would be seen by consumers as directly descriptive. Given that the competing marks share the common element “Skins/SKINS”, the contested mark is likely to be perceived as a brand extension, sub brand or variant mark of the first earlier mark relating to golfing goods or golfing clothing, even where consumers pay an average degree of attention during the purchasing process. Furthermore, it is my view that the presentational differences created by the stylisation of the word “SKINS” in the first earlier mark and the word-only format of the contested mark will also be viewed as a sub brand or variant mark, given the distinctiveness of the word “Skins/SKINS” for the goods relied upon. As such, I find that there is a likelihood of indirect confusion. In my view, this finding extends to those goods in the application which are not specified as being related to golf; this is because goods such as “T-shirts; Sweaters; Polo sweaters; Hats” will encompass golf

¹⁸ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

clothing and may also be used for this purpose, i.e. the word “Golf/GOLF” will still be perceived as descriptive.

54. As I have found a likelihood of confusion in relation to all of the applied-for goods based upon the first earlier mark, it is not necessary to go on to consider the opponent’s reliance on the other earlier marks. In the circumstances, consideration of the second and third earlier marks does not take the opponent’s claim any further.

Conclusion

55. The opposition under section 5(2)(b) of the Act has succeeded in its entirety. However, the first earlier mark is not yet registered, being the subject of unresolved opposition proceedings. Therefore, this decision is provisional pending the outcome of those proceedings and can only be confirmed once the first earlier mark is registered.

56. Although the status of the first earlier mark will be monitored, the opponent is hereby directed to inform the Tribunal when the status of the first earlier mark is resolved. I will then consider the matter further, taking written submissions from the parties if necessary, and issuing a supplementary decision which will also deal with the matter of costs. The appeal period will run from the date of the supplementary decision.

Dated this 12th day of December 2022

Sarah Wallace
For the Registrar

Annex

Goods of UK trade mark application no. 3702990 (First earlier mark)

Class 25: Apparel (clothing, footwear, headgear); Athletic clothing; Clothing; Clothing for sports; Clothing for swimming; Golf clothing (other than gloves); Headbands (clothing); Jackets (clothing); Ladies clothing; Men's clothing; Pants (clothing); Ski clothing (other than for protection against injury); Smart clothing (clothing which incorporates digital components); Sports clothing (other than golf gloves); Tennis clothing; Thermal clothing (not specifically adapted for protection against accident or injury); Waterproof clothing; Women's clothing; Athletics footwear; Footwear; Footwear for sport; Sports footwear; Headwear; Sports headgear (other than helmets); Underwear; Overcoats; Leisure wear; Sports jackets; Jumpers (pullovers); Jumpers (sweaters); Sports jumpers; Sports jerseys; Athletics vests; Vests; Shirts; Sports shirts; T-shirts; Bike pants; Long pants; Pantsuits; Ski pants; Sweat pants; Track pants; Trousers; Athletics shorts; Gym shorts; Shorts; Swimming shorts; Pyjamas; Dressing gowns; Bath robes; Swimwear; Wetsuits for surface watersports; Wetsuits for surfing; Half length tights; Tights; Socks; Sports socks; Body stockings; Stockings; Support stockings, other than for surgical use; Sweat-absorbent stockings; Bandanas (neckerchiefs); Baseball shirts; Tracksuits.

Goods and services of UK trade mark application no. 3702951 (Second earlier mark)

Class 25: Apparel (clothing, footwear, headgear); Athletic clothing; Clothing; Clothing for sports; Clothing for swimming; Golf clothing (other than gloves); Headbands (clothing); Jackets (clothing); Ladies clothing; Men's clothing; Pants (clothing); Ski clothing (other than for protection against injury); Smart clothing (clothing which incorporates digital components); Sports clothing (other than golf gloves); Tennis clothing; Thermal

clothing (not specifically adapted for protection against accident or injury); Waterproof clothing; Women's clothing; Athletics footwear; Footwear; Footwear for sport; Sports footwear; Headwear; Sports headgear (other than helmets); Underwear; Overcoats; Leisure wear; Sports jackets; Jumpers (pullover); Jumpers (sweaters); Sports jumpers; Sports jerseys; Athletics vests; Vests; Shirts; Sports shirts; T-shirts; Bike pants; Long pants; Pantsuits; Ski pants; Sweat pants; Track pants; Trousers; Athletics shorts; Gym shorts; Shorts; Swimming shorts; Pyjamas; Dressing gowns; Bath robes; Swimwear; Wetsuits for surface watersports; Wetsuits for surfing; Half length tights; Tights; Socks; Sports socks; Body stockings; Stockings; Support stockings, other than for surgical use; Sweat-absorbent stockings; Bandanas (neckerchiefs); Baseball shirts; Tracksuits.

Class 35: Discount services (retail, wholesale, or sales promotion services); Retail services connected with the sale of surgical and medical garments, compression garments, therapeutic compression garments, stockings, elastic supports, including elastic supports for stabilising injured areas of the body, clothing, footwear, headgear, including clothing for men, women, children and babies, clothing for sports including football, gymnastics, cycling, golf and skiing, clothing for motorists and travellers, underwear including compression underwear, outerwear, overcoats, leisure clothing, jackets, jumpers, pullovers, sports jerseys, vests, shirts, t-shirts, pants, trousers, shorts, pyjamas, dressing gowns, bath robes, swimwear including bathing trunks and bathing suits, thermal clothing, wetsuits, waterproof clothing, wrist bands, shoes and boots including football shoes and boots, gymnastic shoes, other sports shoes and boots, socks, tights, bandannas and headbands, padded clothing, including padded clothing for men, women, children and babies, padded clothing for sport, sports guards including shin pads, knee pads and elbow pads, bags, including bags of leather and imitation leather, athletic bags, beach bags, backpacks, handbags, hydration packs, knapsacks, luggage, purses, wallets, key cases, satchels, shoulder bags, sports

bags, including all-purpose sports bags, ball bags, bottle bags, boot bags, cricket bags, duffle bags, draw-string bags, football bags, gear bags, gym bags, holdalls, kit bags, team bags and travelling bags; Retail services (by any means), in relation to surgical and medical garments, compression garments, therapeutic compression garments, stockings, elastic supports, including elastic supports for stabilising injured areas of the body, clothing, footwear, headgear, including clothing for men, women, children and babies, clothing for sports including football, gymnastics, cycling, golf and skiing, clothing for motorists and travellers, underwear including compression underwear, outerwear, overcoats, leisure clothing, jackets, jumpers, pullovers, sports jerseys, vests, shirts, t-shirts, pants, trousers, shorts, pyjamas, dressing gowns, bath robes, swimwear including bathing trunks and bathing suits, thermal clothing, wetsuits, waterproof clothing, wrist bands, shoes and boots including football shoes and boots, gymnastic shoes, other sports shoes and boots, socks, tights, bandannas and headbands, padded clothing, including padded clothing for men, women, children and babies, padded clothing for sport, sports guards including shin pads, knee pads and elbow pads, bags, including bags of leather and imitation leather, athletic bags, beach bags, backpacks, handbags, hydration packs, knapsacks, luggage, purses, wallets, key cases, satchels, shoulder bags, sports bags, including all-purpose sports bags, ball bags, bottle bags, boot bags, cricket bags, duffle bags, draw-string bags, football bags, gear bags, gym bags, holdalls, kit bags, team bags and travelling bags; Wholesale services (by any means), in relation to surgical and medical garments, compression garments, therapeutic compression garments, stockings, elastic supports, including elastic supports for stabilising injured areas of the body, clothing, footwear, headgear, including clothing for men, women, children and babies, clothing for sports including football, gymnastics, cycling, golf and skiing, clothing for motorists and travellers, underwear including compression underwear, outerwear, overcoats, leisure clothing, jackets, jumpers, pullovers, sports jerseys, vests, shirts, t-shirts, pants, trousers, shorts, pyjamas, dressing gowns, bath robes, swimwear including bathing trunks and

bathing suits, thermal clothing, wetsuits, waterproof clothing, wrist bands, shoes and boots including football shoes and boots, gymnastic shoes, other sports shoes and boots, socks, tights, bandannas and headbands, padded clothing, including padded clothing for men, women, children and babies, padded clothing for sport, sports guards including shin pads, knee pads and elbow pads, bags, including bags of leather and imitation leather, athletic bags, beach bags, backpacks, handbags, hydration packs, knapsacks, luggage, purses, wallets, key cases, satchels, shoulder bags, sports bags, including all-purpose sports bags, ball bags, bottle bags, boot bags, cricket bags, duffle bags, draw-string bags, football bags, gear bags, gym bags, holdalls, kit bags, team bags and travelling bags; Demonstration of goods; Demonstration of goods for advertising purposes; Demonstration of goods for promotional purposes; Presentation of goods on communication media, for retail purposes; The bringing together, for the benefit of others, a variety of goods (excluding the transport thereof), namely, surgical and medical garments, compression garments, therapeutic compression garments, stockings, elastic supports, including elastic supports for stabilising injured areas of the body, clothing, footwear, headgear, including clothing for men, women, children and babies, clothing for sports including football, gymnastics, cycling, golf and skiing, clothing for motorists and travellers, underwear including compression underwear, outerwear, overcoats, leisure clothing, jackets, jumpers, pullovers, sports jerseys, vests, shirts, t-shirts, pants, trousers, shorts, pyjamas, dressing gowns, bath robes, swimwear including bathing trunks and bathing suits, thermal clothing, wetsuits, waterproof clothing, wrist bands, shoes and boots including football shoes and boots, gymnastic shoes, other sports shoes and boots, socks, tights, bandannas and headbands, padded clothing, including padded clothing for men, women, children and babies, padded clothing for sport, sports guards including shin pads, knee pads and elbow pads, bags, including bags of leather and imitation leather, athletic bags, beach bags, backpacks, handbags, hydration packs, knapsacks, luggage, purses, wallets, key cases, satchels, shoulder bags, sports bags, including all-purpose sports bags,

ball bags, bottle bags, boot bags, cricket bags, duffle bags, draw-string bags, football bags, gear bags, gym bags, holdalls, kit bags, team bags and travelling bags enabling customers to conveniently view and purchase the goods; Promotion of goods and services through sponsorship of sports events; Sponsorship (promotion and marketing services); Advertising.

**Goods and services of UK trade mark application no. 3702859
(Third earlier mark)**

Class 25: Apparel (clothing, footwear, headgear); Athletic clothing; Clothing; Clothing for sports; Clothing for swimming; Golf clothing (other than gloves); Headbands (clothing); Jackets (clothing); Ladies clothing; Men's clothing; Pants (clothing); Ski clothing (other than for protection against injury); Smart clothing (clothing which incorporates digital components); Sports clothing (other than golf gloves); Tennis clothing; Thermal clothing (not specifically adapted for protection against accident or injury); Waterproof clothing; Women's clothing; Athletics footwear; Footwear; Footwear for sport; Sports footwear; Headwear; Sports headgear (other than helmets); Underwear; Overcoats; Leisure wear; Sports jackets; Jumpers (pullovers); Jumpers (sweaters); Sports jumpers; Sports jerseys; Athletics vests; Vests; Shirts; Sports shirts; T-shirts; Bike pants; Long pants; Pantsuits; Ski pants; Sweat pants; Track pants; Trousers; Athletics shorts; Gym shorts; Shorts; Swimming shorts; Pyjamas; Dressing gowns; Bath robes; Swimwear; Wetsuits for surface watersports; Wetsuits for surfing; Half length tights; Tights; Socks; Sports socks; Body stockings; Stockings; Support stockings, other than for surgical use; Sweat-absorbent stockings; Bandanas (neckerchiefs); Baseball shirts; Tracksuits.

Class 35: Discount services (retail, wholesale, or sales promotion services); Retail services connected with the sale of surgical and medical garments, compression garments, therapeutic compression garments, stockings,

elastic supports, including elastic supports for stabilising injured areas of the body, clothing, footwear, headgear, including clothing for men, women, children and babies, clothing for sports including football, gymnastics, cycling, golf and skiing, clothing for motorists and travellers, underwear including compression underwear, outerwear, overcoats, leisure clothing, jackets, jumpers, pullovers, sports jerseys, vests, shirts, t-shirts, pants, trousers, shorts, pyjamas, dressing gowns, bath robes, swimwear including bathing trunks and bathing suits, thermal clothing, wetsuits, waterproof clothing, wrist bands, shoes and boots including football shoes and boots, gymnastic shoes, other sports shoes and boots, socks, tights, bandannas and headbands, padded clothing, including padded clothing for men, women, children and babies, padded clothing for sport, sports guards including shin pads, knee pads and elbow pads, bags, including bags of leather and imitation leather, athletic bags, beach bags, backpacks, handbags, hydration packs, knapsacks, luggage, purses, wallets, key cases, satchels, shoulder bags, sports bags, including all-purpose sports bags, ball bags, bottle bags, boot bags, cricket bags, duffle bags, draw-string bags, football bags, gear bags, gym bags, holdalls, kit bags, team bags and travelling bags; Retail services (by any means), in relation to surgical and medical garments, compression garments, therapeutic compression garments, stockings, elastic supports, including elastic supports for stabilising injured areas of the body, clothing, footwear, headgear, including clothing for men, women, children and babies, clothing for sports including football, gymnastics, cycling, golf and skiing, clothing for motorists and travellers, underwear including compression underwear, outerwear, overcoats, leisure clothing, jackets, jumpers, pullovers, sports jerseys, vests, shirts, t-shirts, pants, trousers, shorts, pyjamas, dressing gowns, bath robes, swimwear including bathing trunks and bathing suits, thermal clothing, wetsuits, waterproof clothing, wrist bands, shoes and boots including football shoes and boots, gymnastic shoes, other sports shoes and boots, socks, tights, bandannas and headbands, padded clothing, including padded clothing for men, women, children and babies, padded clothing for sport, sports guards including shin pads, knee pads and

elbow pads, bags, including bags of leather and imitation leather, athletic bags, beach bags, backpacks, handbags, hydration packs, knapsacks, luggage, purses, wallets, key cases, satchels, shoulder bags, sports bags, including all-purpose sports bags, ball bags, bottle bags, boot bags, cricket bags, duffle bags, draw-string bags, football bags, gear bags, gym bags, holdalls, kit bags, team bags and travelling bags; Wholesale services (by any means), in relation to surgical and medical garments, compression garments, therapeutic compression garments, stockings, elastic supports, including elastic supports for stabilising injured areas of the body, clothing, footwear, headgear, including clothing for men, women, children and babies, clothing for sports including football, gymnastics, cycling, golf and skiing, clothing for motorists and travellers, underwear including compression underwear, outerwear, overcoats, leisure clothing, jackets, jumpers, pullovers, sports jerseys, vests, shirts, t-shirts, pants, trousers, shorts, pyjamas, dressing gowns, bath robes, swimwear including bathing trunks and bathing suits, thermal clothing, wetsuits, waterproof clothing, wrist bands, shoes and boots including football shoes and boots, gymnastic shoes, other sports shoes and boots, socks, tights, bandannas and headbands, padded clothing, including padded clothing for men, women, children and babies, padded clothing for sport, sports guards including shin pads, knee pads and elbow pads, bags, including bags of leather and imitation leather, athletic bags, beach bags, backpacks, handbags, hydration packs, knapsacks, luggage, purses, wallets, key cases, satchels, shoulder bags, sports bags, including all-purpose sports bags, ball bags, bottle bags, boot bags, cricket bags, duffle bags, draw-string bags, football bags, gear bags, gym bags, holdalls, kit bags, team bags and travelling bags; Demonstration of goods; Demonstration of goods for advertising purposes; Demonstration of goods for promotional purposes; Presentation of goods on communication media, for retail purposes; The bringing together, for the benefit of others, a variety of goods (excluding the transport thereof), namely, surgical and medical garments, compression garments, therapeutic compression garments, stockings, elastic supports, including elastic supports for stabilising

injured areas of the body, clothing, footwear, headgear, including clothing for men, women, children and babies, clothing for sports including football, gymnastics, cycling, golf and skiing, clothing for motorists and travellers, underwear including compression underwear, outerwear, overcoats, leisure clothing, jackets, jumpers, pullovers, sports jerseys, vests, shirts, t-shirts, pants, trousers, shorts, pyjamas, dressing gowns, bath robes, swimwear including bathing trunks and bathing suits, thermal clothing, wetsuits, waterproof clothing, wrist bands, shoes and boots including football shoes and boots, gymnastic shoes, other sports shoes and boots, socks, tights, bandannas and headbands, padded clothing, including padded clothing for men, women, children and babies, padded clothing for sport, sports guards including shin pads, knee pads and elbow pads, bags, including bags of leather and imitation leather, athletic bags, beach bags, backpacks, handbags, hydration packs, knapsacks, luggage, purses, wallets, key cases, satchels, shoulder bags, sports bags, including all-purpose sports bags, ball bags, bottle bags, boot bags, cricket bags, duffle bags, draw-string bags, football bags, gear bags, gym bags, holdalls, kit bags, team bags and travelling bags enabling customers to conveniently view and purchase the goods; Promotion of goods and services through sponsorship of sports events; Sponsorship (promotion and marketing services); Advertising.