

BL O/940/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3356558

BY WORLD GOLF GROUP LIMITED

TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 25, 28, 38 & 41:

**WORLD
GOLF
SERIES**

AND

OPPOSITION THERETO

UNDER NO. 415799

BY PGA TOUR INC.

Background and pleadings

1. On 27 November 2018, World Golf Group Limited ('the applicant') applied to register the trade mark shown on the cover page of this decision. The application was accepted and then subsequently published for opposition purposes in the Trade Marks Journal on 14 December 2018. Registration is sought for the following goods and services:

Class 25	<i>Clothing; footwear; headgear.</i>
Class 28	<i>Sporting articles and equipment; Games; Playthings; Bags adapted for sporting articles.</i>
Class 38	<i>Broadcast services; Telecommunications.</i>
Class 41	<i>Education, entertainment and sport services; Publishing and reporting; Information services for education, entertainment and sports; Information services for publishing and reporting.</i>

2. On 14 March 2019, the application was opposed by PGA Tour Inc. ('the opponent') under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). The opponent relies on two earlier marks under sections 5(2)(b) and 5(3), namely:

- UK registration 2534546 for the mark **WORLD GOLF CHAMPIONSHIPS** which was filed on 16 December 2009 and which completed its registration procedure on 15 April 2011. The mark is registered for the following services:

Entertainment services, namely, organizing and conducting a series of professional golf competitions to be held at various locations throughout the world, in International Class 41



Class 25: *Men's, women's and children's clothing.*

Class 28: *Sporting goods.*

Class 41: *Entertainment services, organizing a series of professional golf competitions to be held at various locations throughout the world.*

3. Under section 5(4)(a) of the Act, the opponent relies on the use of the sign **WORLD GOLF CHAMPIONSHIPS** since 1999; the opponent states that the sign has been used in the UK since then in relation to:

“Entertainment services, namely, organizing and conducting golf competitions; entertainment services namely, providing televised and other media broadcast golf competitions; entertainment services, namely, golf competitions.”

4. The opponent also relies on the following mark under section 5(2)(b) only:

- EUTM 7223316 for the mark **WORLD GOLF TOUR** which was filed on 10 September 2008 (with a priority date of 22 August 2008 stemming from a US application) and which completed its registration procedure on 29 September 2010. The mark is registered for:

Class 41: *Entertainment services, namely, providing an online interactive game.*

This ground is directed against the following of the applicant’s services only: *Entertainment and sport services; Information services for education, entertainment and sports* in class 41.

5. The applicant filed a defence and counterstatement, denying the grounds of opposition. It put the opponent to proof of genuine use of the three earlier marks relied upon. This stems from the fact that each of the earlier marks had been registered for more than five years as of the filing date of the applied for mark, with the consequence that the proof of use provisions contained in section 6A of the Act are applicable.

6. Only the opponent filed evidence during the proceedings. Neither side requested a hearing. The opponent did, however, file written submissions in lieu of a hearing. During the proceedings, the opponent has been represented by Dolleymores, the applicant by Stobbs.

7. It should be noted that after filing its defence and counterstatement, the applicant sought the invalidation of the opponent's earlier UK mark, WORLD GOLF CHAMPIONSHIPS. Its grounds for seeking invalidation were based on descriptiveness/lack of distinctiveness. The opponent defended the invalidation lodged against its earlier mark. The invalidation was then consolidated with the opposition proceedings the subject of this decision. However, I make no further reference to the invalidation part of the proceedings because the applicant elected not to file evidence in relation to either set of proceedings, following which the Tribunal wrote to the parties to express the view that the absence of evidence in the invalidation proceedings meant that those proceedings should be struck out through want of evidence. The applicant was given an opportunity to challenge that view, but it did not do so, so the claim was duly struck out.

The evidence

8. As already stated, only the opponent filed evidence. I do not intend to provide a stand-alone evidence summary, but will, instead, draw from the evidence, as and when relevant, during the course of this decision. I will, however, map out below who has given evidence, and about what.

9. Evidence has been given by Mr Daniel Navarro, the opponent's Vice President and Assistant General Counsel. He provided two witness statements, the first is dated 5 September 2019, with 12 exhibits, DN1 to DN12; the second is dated 28 July 2020, with 6 further exhibits, DN13 to DN18. His evidence is largely about the golf tournament that the opponent runs. For context, he states that the opponent "began the WORLD GOLF CHAMPIONSHIPS series of tournaments in 1999 which comprises an annual series of four golf tournaments for professional golfers" which "attract the world's elite professional golfers and have prize money purses that are similar to the

most prestigious tournaments in the golfing calendar”. Including by way of his exhibits, Mr Navarro gives evidence about:

- The history of the tournaments and prize money that can be earned from them (Exhibits DN1 & 2), extracts from its own website about the tournaments (Exhibit DN17) and articles about the tournaments from third party websites (Exhibit DN18).
- Information about the licenses it approves for the broadcast of the tournaments, its licensees, and, in particular, its UK licensee SKY TV (and Sky’s related business, Now TV), plus details of claimed use of the WORLD GOLF CHAMPIONSHIPS marks via such medium (Exhibits DN3, 4, 5, 6, 7 & 8). Also provided is evidence about other platforms on which Sky Sports can be viewed (Exhibit DN16).
- Information about the use of the WORLD GOLF TOUR mark in relation to online computer games (Exhibits DN9-12).
- Evidence about the opponent’s UK registration for the words WORLD GOLF CHAMPIONSHIPS and the fact that it was accepted on the basis of acquired distinctiveness (use which he says has continued since acceptance). He also provides the evidence filed in support of that acceptance (Exhibit DN13 – see below), the application’s hearing report (Exhibit DN14) and the draft advertisement for its inclusion in the Trade Marks Journal (Exhibit DN15).

10. As detailed above, Mr Navarro’s Exhibit DN13 contains the evidence filed in support of the UK registration of WORLD GOLF CHAMPIONSHIPS. As such evidence has been filed under cover of a witness statement in these proceedings, it can also be taken into account. The evidence was given on 10 March 2010 by Mr Richard D. Anderson, the opponent’s then Executive Vice President/Chief Legal Officer. There are also nine Exhibits, A-I, which cover:

- Details of 2010 events that took place in the US and China (Exhibit A).

- Photographs from an event in the UK that took place in 2006 (Exhibit B).
- Details of events for the years 2004, 2006, 2007 & 2008 and projected TV viewing figures for the events (Exhibit C).
- Various press articles which feature the name “World Golf Championships” between 2001 and 2010 (Exhibit D).
- Facebook pages (including a fan page) relating to the World Golf Championships.
- Details about the opponent’s own website for the World Golf Championships, and its PGA Tour website which references the same (Exhibits G & H).
- Details of the opponent’s other WORLD GOLF CHAMPIONSHIPS trade marks outside the UK (Exhibit I).

Section 5(4)(a) of the Act – the law of passing-off

11. I find it convenient to start with the ground of opposition under section 5(4)(a), which reads:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

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

(aa)

(b)...

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

Subsection (4A) of Section 5 states:

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

12. The three elements which the opponent must show are well-known: goodwill; misrepresentation leading to deception or a likelihood of deception; and, damage resulting from the misrepresentation¹. In a case where the contested mark is unused, the relevant date is the date when the application was made for the contested mark². Here the mark is unused, or more accurately, I take it to be unused because there is no claim or evidence of prior use. The relevant date is, therefore, 27 November 2018.

Goodwill

13. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

¹ *Discount Outlet v Feel Good UK* [2017] EWHC 1400 (IPEC), Her Honour Judge Melissa Clarke, sitting as a deputy judge of the High Court.

² *Advanced Perimeter Systems Limited v Multisys Computers Limited* [2012] R.P.C. 14, Mr Daniel Alexander QC, sitting as the Appointed Person.

14. The opponent relies on the use of the sign **WORLD GOLF CHAMPIONSHIPS** in relation to, essentially, entertainment services in the nature of: i) golf competitions, including the organizing and conducting thereof, and ii) televised (and other media) broadcast golf competitions. This is, thus, where the opponent's claim to goodwill is made.

15. The opponent's written submissions do not focus particularly on goodwill, although I bear in mind what it has said in terms of its assessment of the evidence for proof of use of the earlier marks relied upon under sections 5(2)(b) and 5(3). In that respect, it focuses mostly on the evidence relating to television broadcast, although it does also note that UK nationals have taken part in the tournaments.

16. I have only touched briefly on the evidence so far. Having considered the evidence in detail, I consider it clear that the opponent has operated the golfing competition named the **WORLD GOLF CHAMPIONSHIPS** since 1999, albeit in conjunction with other global professional golf tour operators (see the witness statement of Mr Anderson). It appears to be the overarching name given to a number of professional golf tournaments, which combine to form the **WORLD GOLF CHAMPIONSHIPS**. Whilst it may not be as well-known as the golfing majors, from the evidence that has been placed before the Tribunal, including:

- the information about its history,
- the various press articles (notwithstanding that some were dated before 2010, and with the more recent ones being dated after the application in suit was filed),
- the licenses to broadcast the competition, and,
- the commentary of the witnesses,

it appears to be a reasonably well-known competition on the global golfing scene, attracting high profile professional golfers. The gap in the dates of the articles mentioned above is symptomatic of the dating of Mr Anderson's witness statement in 2010 and the more contemporaneous articles provided by Mr Navarro, rather than any

hiatus in the running of the competition. That said, Mr Navarro's evidence could have been better had he provided more articles from before the relevant date.

17. I also accept from the totality of the evidence that the competition is reasonably well-known in the UK. Many of the articles presented in evidence are from UK publications, plus there is evidence of the broadcasting of the competition in the UK by SKY TV. It would have been better if Mr Navarro had provided actual viewing figures for the competitions. However, there are viewing projections in the evidence of Mr Anderson which are quite significant (although I continue to bear in mind that Mr Anderson's evidence was given some time ago), and the totality of the evidence paints the picture of a significant competition in the golfing field being consistently broadcast by one of the pre-eminent sports broadcasters in the UK.

18. Notwithstanding what I have said above, knowledge does not necessarily equate to a protectable goodwill in the UK. It is established law that a claimant must have a business, with customers, in the jurisdiction of the UK. In *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others*, [2015] UKSC 31, Lord Neuberger (with whom the rest of Supreme Court agreed) stated (at paragraph 47 of the judgment) that:

“I consider that we should reaffirm that the law is that a claimant in a passing off claim must establish that it has actual goodwill in this jurisdiction, and that such goodwill involves the presence of clients or customers in the jurisdiction for the products or services in question. And, where the claimant's business is abroad, people who are in the jurisdiction, but who are not customers of the claimant in the jurisdiction, will not do, even if they are customers of the claimant when they go abroad.”

And later , at paragraph 52:

“As to what amounts to a sufficient business to amount to goodwill, it seems clear that mere reputation is not enough, as the cases cited in paras 21-26 and 32-36 above establish. The claimant must show that it has a significant goodwill, in the form of customers, in the jurisdiction, but it is not necessary

that the claimant actually has an establishment or office in this country. In order to establish goodwill, the claimant must have customers within the jurisdiction, as opposed to people in the jurisdiction who happen to be customers elsewhere. Thus, where the claimant's business is carried on abroad, it is not enough for a claimant to show that there are people in this jurisdiction who happen to be its customers when they are abroad. However, it could be enough if the claimant could show that there were people in this jurisdiction who, by booking with, or purchasing from, an entity in this country, obtained the right to receive the claimant's service abroad. And, in such a case, the entity need not be a part or branch of the claimant: it can be someone acting for or on behalf of the claimant."

19. The claimant in that case did not have any goodwill in the UK that would give it the right to prevent B SkyB from using the name "NOW TV" in relation to its internet protocol TV service. This was because the customers for Starbucks' broadcasting services under the name NOW were based in Hong Kong. The services could not be bought here. The fact that the service was sometimes accessed via the internet by Chinese speakers in the UK did not mean that Starbucks had customers here. See also the judgments of the Court of Appeal in *Budweiser* [1984] F.S.R. 413 at 463 and *Hotel Cipriani SRL and Others v Cipriani (Grosvenor Street) Limited and Others*, 2010 EWCA Civ 110 (CA).

20. The above guidance is important in this case because the golf tournament itself is not generally held in the UK. Whilst there is evidence that one event took place in 2006 at The Grove (in Hertfordshire), the rest appear to have taken place in other jurisdictions, many in the US. I will come back to the 2006 event shortly, but in terms of the events which took place in other jurisdictions, there is no evidence to show how it attempted to gain UK customers for the golf competition per se, including organizing and conducting it. For example, there is no evidence showing how it has gone about attracting entities in the UK to attend the events, either by way of viewing or participating. In its submissions, the opponent highlights that the event attracts professional golfers who are British in nationality. However, this, in and of itself, is not sufficient. Even if a professional golfer constituted a "customer" of the opponent in the sense of that word, there is no evidence as to whether those customers even reside

in the UK, and no clear evidence to show the manner in which they availed themselves of that custom. Therefore, whilst there are different considerations in relation to entertainment via the broadcast of televised golf competitions, I find there is insufficient evidence to hold that there is a protectable goodwill in the UK in association with the competition itself (including its arrangement and conducting of it).

21. In reaching the above finding, I have borne in mind the single event held in the UK in 2006. However, there is very little detail about the event itself, in terms of who/how many attended, either to watch or to play. Notwithstanding this flaw in the evidence, it is unlikely to assist anyway. Given the ostensibly overseas nature of business associated with the golf competition itself, the distant (in proximity to the relevant date) holding of the event, and its one-off nature, my finding is that the evidence is not sufficient to show that a sufficient number of potential customers at the relevant date will recall the event in 2006, furthermore, even for those that do, that distant one-off event would more likely be seen as merely a temporary excursion of the opponent's overseas business as opposed to something which created a protectable goodwill in the UK.

22. Matters are, in my view, different in relation to the televised (and other media) broadcast golf competition. As I have touched on above, and whilst the evidence could have been better focused, I am prepared to accept that a sufficient (and reasonably significant) number of people in the UK will have watched events that form part of the WORLD GOLF CHAMPIONSHIPS via its broadcast on Sky (and NowTV). The licensing of the broadcast rights to Sky and the subsequent broadcasting will have created a protectable goodwill in the UK by way of such viewers availing themselves of the broadcast, even though that might be part of an overall subscription to the channel. My finding is that there is a protectable goodwill in the UK for that aspect of the business, and any goodwill will be owned by the opponent given the licensing arrangements it has in place.

Misrepresentation

23. In *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd. (1941) 58 R.P.C. 147 at page 175* ; and *Re Smith Hayden's Application (1945) 63 R.P.C. 97 at page 101.*”

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

24. It is the opponent's customers, or potential customers, that must be deceived³.

25. Whilst I accept that the evidence shows that the name WORLD GOLF CHAMPIONSHIPS is distinctive of the opponent's business (connected with the television broadcasting of the golf competition), there is no getting away from the fact that the words used in that name are inherently weak. In that respect, I note the

³ See *Neutrogena Corporation and Another v Golden Limited and Another*,1996] RPC 473

guidance in *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] 63 RPC 39, where Lord Simonds stated that:

“Where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.”

26. The above represents an important consideration in this case. I must also consider the proximity between the fields of activity, and the proximity of the mark sought to be registered compared to the name associated with the opponent’s goodwill.

27. In relation to the proximity between the fields of activity, there is a clear overlap, or at least a partial one. The goods and services sought to be registered by the applicant are:

Class 25	<i>Clothing; footwear; headgear.</i>
Class 28	<i>Sporting articles and equipment; Games; Playthings; Bags adapted for sporting articles.</i>
Class 38	<i>Broadcast services; Telecommunications.</i>
Class 41	<i>Education, entertainment and sport services; Publishing and reporting; Information services for education, entertainment and sports; Information services for publishing and reporting.</i>

28. The fields of activity are the same or highly similar in relation to the class 38 services (which would cover broadcast of a golf tournament) and the entertainment services in class 41 (which could be by way of entertainment in the form of a televised golf competition). For sporting services (which could relate to the operation of a golf tournament) there is a reasonable overlap given the synergy between sport, and the fact that it is commonly televised. This is less of an overlap with goods in classes 25

and 28, however, these are goods that could form merchandising activity and they could all relate in some way to golf. Finally, the services such as education, and the publishing/information services in class 41, have, in my view, the least clear overlap in their fields of activity. There may be some small overlap though, for example, with the potential for approved golf tuition being operated by the business responsible for the WORLD GOLF CHAMPIONSHIPS. I note that in the opponent's section 5(2)(b) submissions, reference is made to tuition sometimes being part of the broadcast of its competition, but there is no evidence about this, and I do not think that can be regarded as common/obvious knowledge.

29. In terms of the proximity between the name associated with the opponent's goodwill and the trade mark sought to be registered, there is some overlap on a visual, aural and conceptual level, as they both begin with the words WORLD GOLF. However, that similarity is reduced, at least visually and aurally, by the difference in the final word CHAMPIONSHIPS/SERIES. The stylisation of the applied for mark is also quite striking, something which creates a further visual difference.

30. I come to the conclusion that despite the overlap in the fields of activity, the combination of i) the inherent weakness of the words that are used in the respective name/mark, and ii) the differences that exist between the name/mark, is sufficient to prevent a substantial number of the opponent's customers (or potential customers) from being misled into thinking that the applicant's goods and services are those of the opponent. Consequently, it follows that no damage will ensue. I should add, I would have come to the same conclusion had the protectable goodwill in the UK extended to the golf competition itself, and not just its television broadcast, for the same/similar reasons.

31. The ground under section 5(4)(a) is dismissed.

Section 5(2)(b) of the Act

32. Section 5(2)(b) of the Act states:

“5(2) A trade mark shall not be registered if because –

(a) ...

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

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

33. The following principles are derived from the decisions of the CJEU⁴ 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 C120/04; *Shake di L. Laudato & C. Sas v OHIM*, Case C-334/05P; and *Bimbo SA v OHIM*, Case C-591/12P

The principles:

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

⁴ 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.

(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.

34. Whilst I keep in mind that the law, legal principles and the legal tests applicable to section 5(4)(a) of the Act are different to those under section 5(2)(b), it is difficult to envisage why the opponent would succeed under section 5(2)(b) in circumstances where it has failed under section 5(4)(a), particularly when I have found some goodwill in the UK, and particularly when one is considering the earlier marks that comprise/contain the words WORLD GOLF CHAMPIONSHIPS. However, I nevertheless set out my findings below. I will begin with the two earlier marks that contain/comprise the words WORLD GOLF CHAMPIONSHIPS, returning to the earlier WORLD GOLF TOUR mark later.

35. Both earlier marks are subject to the proof of use provisions contained in section 6A of the Act, which read:

“(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)

(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 Community.

(5A)

(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.”

36. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

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

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

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13];

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

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

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

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

38. The onus is on the opponent, as the proprietor of the earlier marks, to show use because section 100 of the Act states:

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

39. The relevant period, as per section 6A(1A), is 28 November 2013 to 27 November 2018.

Earlier mark 2534546

40. One of the earlier marks, for the plain words WORLD GOLF CHAMPIONSHIPS, is a UK registration which covers the following services only:

Entertainment services, namely, organizing and conducting a series of professional golf competitions to be held at various locations throughout the world, in International Class 41

41. The use of the word “namely” has the effect of limiting the services to only those things that are named, i.e. the organising and conducting of professional golf

competitions. It, thus, does not cover entertainment services in the nature of television programmes featuring golf competitions. In relation to passing-off, I have already commented on the jurisdictional nature of the competition per se, and that the evidence was insufficient to show that its business had UK customers. Whilst of course the legal test in relation to whether genuine use has been made is a different test, I nevertheless come to the same finding. The evidence is insufficient to show that genuine use in the UK has been made, in the sense of being viewed as warranted to maintain or create a share in the UK market for the services at issue.

42. Even if I am wrong on that, and genuine use in the UK has been made, I would still have rejected the opposition on the basis of this ground/mark. Briefly stated, my views on the matter are that:

- The opponent's services are identical to the applied for entertainment and sports services in class 41 on the basis of the principle outlined in *Meric*⁵. They are also reasonably similar⁶ to the applied for class 38 services given the clear link (and key complementary⁷ relationship) between broadcasting/televised entertainment of golf, and the golf competition itself.
- On the tests for similarity applicable to section 5(2)(b), I do not, though, regard the goods in classes 25 or 28 to be similar given the differences in nature, purpose, method of use, primary trade channels, with only a weak level of complementarity. If I am wrong on that, any similarity is very low. I note that the opponent's submissions said little about the similarity with the goods under

⁵ See *Gérard Meric v Office for Harmonisation in the Internal Market*

⁶ When assessing the similarity between goods/services in this decision, I have borne in mind the guidance in *Canon*, Case C-39/97, and in *Treat* [1996] R.P.C. 281

⁷ When considering complementarity in this decision, I have borne in mind the guidance in *Kurt Hesse v OHIM*, Case C-50/15 P and in *Boston Scientific Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

section 5(2)(b). In terms of the other services in class 41, they are only low in similarity at best, again given the differences in nature and purpose.

- The overall impression⁸ of the opponent's mark is based upon the combination of the three words of which it comprises. The same can be said about the applied for mark, although its stylisation also plays a reasonable role. I do not accept the opponent's submission that WORLD GOLF plays more of a role in the overall impressions compared to CHAMPIONSHIPS/SERIES – the average consumer is likely to see all of the words as weak ones, not just the final ones in the marks.
- There is a degree of visual similarity on the basis that both marks contain the words WORLD GOLF, but there are differences on account of the different last words and the stylisation in the applied for mark. This equates to a low to medium degree of visual similarity. Aurally, the marks are closer (similar to a medium degree) because the stylisation does not impact upon this assessment. Conceptually, they are highly similar as both relate to some form of global golf competition.
- Whilst the earlier mark will be reasonably well known, particularly amongst average consumers who have an interest in golf, it still has a very low starting point of distinctiveness, albeit one which will have been enhanced through use. That said, the average consumer will still recognise that the words that make up the mark (and those that make up the applied for mark) are weak. Furthermore, the evidence does not show that the words WORLD GOLF per se are particularly associated with the opponent. In reaching these views on distinctiveness of the earlier mark, I have borne in mind the guidance in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97.

⁸ In assessing the marks' overall impressions, I have borne in mind Case C-591/12P, *Bimbo SA v OHIM*

- For average consumers⁹ (both professional golfers and members of the public), paying what I regard as a reasonable (but not high) degree of attention¹⁰, the differences between the marks are sufficient to avoid them being directly confused, notwithstanding, as the opponent mentions, imperfect recollection. In a similar way to the assessment under section 5(4)(a), they will recognise and recall that the words which make up the respective marks are weak and will note the differences, even between the verbal elements WORLD GOLF SERIES/WORLD GOLF CHAMPIONSHIPS. Having noted such differences there is, further, no likelihood of indirect¹¹ confusion. The opponent submits that the exchange of SERIES for CHAMPIONSHIPS will indicate a slight [brand] variation. I do not agree. The average consumer will put the commonality of the words WORLD GOLF down to the fact that both entities are simply operating a golf-based competition on a global level, and that the difference between SERIES/CHAMPIONSHIPS will simply be taken as a differently named competition.

Earlier mark 1210038



⁹ The relevance and attributes of the average consumer are explained in *Lloyd Schuhfabrik Meyer*, Case C-342/97 and *Hearst Holdings Inc*

¹⁰ I note that the opponent considered that the goods/services could be of low cost and/or quality so the level of care and attention would be low to moderate at best, however, whilst I accept that there could be some variance due to these factors, the attention will generally be reasonable and will not be materially lower than that.

¹¹ A helpful explanation of indirect confusion is given in *L.A. Sugar Limited v By Back Beat Inc*

Class 25: *Men's, women's and children's clothing.*

Class 28: *Sporting goods*

Class 41: *Entertainment services, organizing a series of professional golf competitions to be held at various locations throughout the world.*

44. For reasons that follow, this earlier mark puts the opponent in no better position. In terms of genuine use, the evidence is lacking in detail regarding the goods in classes 25 and 28. In relation to class 41, the specification is not limited just to the organisation of a golf tournament per se, but also includes entertainment services at large, which would cover entertainment by way of a televised golf competition. In terms of the evidence filed, it does not support genuine use (in the EU) for the organisation of a golf competition, for much the same reason as the first earlier mark; the evidence lacks detail of the organisation of competitions within the EU.

45. However, I accept that the genuine use position is stronger in relation to entertainment by way of a televised golf competition. This is because of the evidence in relation to the licences to broadcast the golf competition, not only in the UK, but in various EU countries. As I have already said, whilst the evidence could have been better, I am satisfied that, at the very least, the name WORLD GOLF CHAMPIONSHIPS has been genuinely used in relation to such services¹².

46. I bear in mind that the mark I am considering is the figurative mark, not the name per se. The use of the name per se would not count as an acceptable variant of the figurative mark in accordance with cases such as *Nirvana* (BL O/262/06), given that the absence of the figurative component in use would clearly alter the distinctive character of the registered figurative mark. That said, the evidence does show some examples of the figurative mark. The evidence is not, however, well focused. It shows around 10 examples of the figurative mark predominantly by way of screen shots/photographs of television broadcasts, with the mark either used by the broadcaster or appearing in the broadcasted content. The dating of the documents is

¹² Entertainment by way of televised golf would represent a fair specification for such use.

vague e.g. “2013 or 2015 to date”. Sometimes the evidence has simply been contemporaneously presented. There is, though, at least one example from 2017 which can be placed within the relevant period. All that said, I come to the view that, on the balance of probabilities, the figurative mark has also been genuinely used during the relevant period for a fair specification as per footnote 12 above.

47. As stated, though, in paragraph 44, the opponent is, in my view, in no stronger position to succeed in terms of the existence of a likelihood of confusion. This is because the goods/services assessment is similar to that given in relation to the first earlier mark, but with the marks actually being less visually similar given that WORLD GOLF CHAMPIONSHIPS play a lesser role in the overall impression, and the different forms of stylisation/configuration result in only a low degree of visual similarity. Thus, for much the same reasons as I have given regarding the first earlier mark, there is no likelihood of either direct or indirect confusion.

Earlier mark 7223316

48. The earlier mark consists of the words WORLD GOLF TOUR and is registered for:

Class 41: *Entertainment services, namely, providing an online interactive game.*

49. In terms of genuine use, the use appears to be quite distinct from any use connected with the WORLD GOLF CHAMPIONSHIPS marks. Mr Navarro states in his witness statement that WORLD GOLF TOUR is an online virtual golf game “released for beta testing in 2008 and the trade mark WORLD GOLF TOUR has been used for the game since its release”. An undated Wikipedia entry is provided with the name of the game included. The game is described as an online multiplayer virtual golf game. In the rest of the Wikipedia entry, the acronym WGT is used. Mr Navarro also provides (undated) screenshots from the game. There are, again, frequent references to WGT, but there are at least two uses of WORLD GOLF TOUR. From the text, it appears that the game is free to play. There are also some extracts from the Internet archive tool WaybackMachine, which show that the website www.wgt.com has been updated

many times, including during the relevant period. Archives pages are provided from 2008 (before the relevant period) and July 2017 (during the relevant period) both of which show WORLD GOLF TOUR at the top of the page. Data is provided showing that at some point in 2013 there were 1,685,609 users of the WORLD GOLF TOUR game in the UK; whereas at some point in 2018 there were 386,953 UK users.

50. Again, the evidence could have been better. However, whilst actual use that can be clearly placed within the relevant period is limited, the evidence does show that there is a continuity of use of the words WORLD GOLF TOUR as the name of an online golf game. Even if the users in the UK have been falling, there is nothing to suggest that there were no users of the game between the points in time when the user data was provided. The fact that the game is free does not matter – the nature of the use is the type of use warranted to create or maintain a share of the relevant market. I consider genuine use has been made, albeit, on the basis of the use shown, in relation to one type of game, I consider a fair specification for such use to be:

Class 41: *Entertainment services, namely, providing an online interactive golf game.*

51. However, in terms of whether there is a likelihood of confusion, I will briefly set out my views because there is, again, an overlap in terms of assessment with the other grounds/marks.

- In terms of the similarity of services (the opponent only opposes *entertainment and sport services; Information services for education, entertainment and sports*) there is a clear overlap with entertainment on the basis set out in *Meric*. There is much less similarity (low at best) in relation to sport services, as whilst both could relate to golf, one is in a gaming environment, the other the actual sport, so the nature and purpose differ, as do the trade channels, and any competitiveness or complementarity is weak. Whilst there may be a medium degree of similarity with information services relating to entertainment, there is either no, or only a low level, of similarity between information services relating to education and sports due, again, to the different inherent nature and purpose,

no trade channel overlap, and no meaningful competitiveness or complementarity.

- In terms of the marks, the analysis I have made between the applied for mark and the WORLD GOLF CHAMPIONSHIPS word only mark is equally applicable here, varied to reflect the different make-up of the marks.
- In terms of distinctiveness, again, the earlier mark is inherently weak, but the use of the mark with potential UK users in the hundreds of thousands will have enhanced this to some extent.
- Notwithstanding that I am considering the position through the different prism of an online golf game, the same outcome applies in that the differences between the marks combined with the nature of the words used in them, means that for the average consumer (including members of the general public) there is no likelihood of either direct or indirect confusion.

Outcome under section 5(2)(b)

52. There is no likelihood of confusion in respect of any of the earlier marks relied upon. The opposition under these grounds is dismissed.

Section 5(3) of the Act

53. Section 5(3) states:

“(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 (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

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

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

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

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

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

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that

this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

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

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the 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 (*Marks and Spencer v Interflora, paragraph 74* and the court's answer to question 1 in *L'Oreal v Bellure*).

55. The opponent relies on the two earlier marks which comprise/contain the words WORLD GOLF CHAMPIONSHIPS. In relation to the plain word mark, I have already found that the earlier mark has not been genuinely used in the UK in relation to the services for which it is registered. That, therefore, is the end of the matter in relation to that mark.

56. I have, though, found genuine use of the EUTM figurative mark in relation to the fair specification set out in footnote 12 above. However, in terms of the required

reputation, the earlier mark, including its figurative nature, must be known by a significant part of the relevant public. I consider the opponent falls at this hurdle. I have already touched upon the fact that the opponent's evidence could have been better in showing the use of the figurative mark (see para 46 above). Whilst I have found it to meet the genuine use test, I am not satisfied that the evidence establishes that the figurative mark has a reputation. More detail should (and could) have been provided to show how often and in what manner the figurative mark is displayed. I am left with an underwhelming impression in terms of the resonance of the mark with a significant part of the relevant public. A significant part of the relevant public will recognise the words, but not necessarily the figurative nature of the mark. Given this, the ground under section 5(3) fails.

57. In case of appeal, I will give some brief views in the event that I was wrong to have concluded that the figurative mark lacks the requisite reputation and, further, if I was wrong to have concluded that the word mark had not met the genuine use test (and that it also had a reputation for its services). In those circumstances, my view would have been that whilst there is some similarity (as I have assessed earlier) between the marks, and that there are some clear overlaps between the services, the required link would not be made. This is because the relevant public will just see the use of the words WORLD GOLF in the applied for mark (and the use of the whole mark itself) as simply allusive language indicating a global golf competition featuring a series of events. Members of the relevant public would not bring to mind the separate competition/trade mark WORLD GOLF CHAMPIONSHIPS.

58. Even if there was a bringing to mind, I do not consider that any of the heads of damage would arise. There is no unfair advantage on account of the use of the common words at the beginning of each mark, which merely send allusive messages. Although the opponent submits that there can be no co-incidence that the first two words are the same, this is not how I see matters. Indeed, this strikes me as more of an example of fair competition than unfair advantage. I should also add that, from the opponent's submissions, its position in so far as unfair advantage is concerned is based on the existence of an economic link between the parties; given my findings under section 5(2)(b), this argument is bound to fail. There is no tarnishing, as I see no negative connotations that would potentially arise. Finally, in terms of dilution, the

opponent submits that the potential shared use of WORLD GOLF means the relevant public may no longer rely on its mark to guarantee origin. Again, I do not agree. The WORLD GOLF CHAMPIONSHIPS name will continue to perform its distinguishing function in the same way as it would have before, irrespective of the existence of another competition called WORLD GOLF SERIES. Given this, I would have refused the grounds of opposition even if my findings in paragraph 55/56 are held to be wrong.

Conclusion

59. The grounds of opposition have all failed. Therefore, subject to appeal, the application may proceed to registration.

60. I should add that towards the end of the proceedings the opponent contacted the Tribunal to inform it that despite the status of EUTM 7223316 being shown as cancelled on the EUIPO website, this was in fact not the case, as the evidence rounds were to be re-opened. However, given that none of the earlier marks have led to the opposition being upheld, I need not investigate this further.

Costs

61. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 2/2016. I award costs to the applicant as a contribution towards the costs of the proceedings on the following basis:

Considering the statement of case and filing a counterstatement	£300
Considering the opponent's evidence	£500
Total	£800

62. I, therefore, order PGA Tour Inc., to pay World Golf Group Limited, the sum of £800. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 30th day of December 2021

Oliver Morris

For the Registrar,

The Comptroller General