

O/0304/22

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3714962
BY JACK DOYLE CLOTHING LIMITED
TO REGISTER THE TRADE MARK:**



IN CLASS 12

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 430896
BY VOLKSWAGEN AKTIENGESELLSCHAFT**

Background and pleadings

1. On 27 October 2021, Jack Doyle Clothing Limited (“the applicant”) applied to register the trade mark displayed on the cover page of this decision in the UK, under trade mark number **3714962** (“the contested mark”). The contested mark was published in the Trade Marks Journal for opposition purposes on 12 November 2021. Registration is sought for the following goods:

Class 12: Golf trolleys; Motorized golf trolleys; Trolleys; Trolleys [vehicles]; Electric trolley buses; Two-wheeled trolleys; Trolleys [mobile carts]; General purpose trolley; Electrically powered trolleys; General purpose trolleys; Golf carts [vehicles]; Golf cars [vehicles]; Motorized golf carts; Motorized golf carts [vehicles].

2. On 7 February 2022, **Volkswagen Aktiengesellschaft** (“the opponent”) filed a notice of opposition. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all the goods of the application. The opponent relies upon its comparable UK trade mark number **900751909**,¹ **GOLF** (“the earlier mark”) to support its claim. The earlier mark was filed 19 February 1998 and became registered on 14 April 1999 in respect of goods and services in classes 4, 7, 12, 27, 28 and 37, of which the following goods in class 12 are relied upon for the purpose of this opposition:

Class 12: Vehicles (except golf carts); parts of vehicles; apparatus for locomotion by land, air or water.

3. Given the respective filing dates, the opponent’s mark is an earlier mark, in accordance with section 6 of the Act. As it had been registered for more than five years at the filing date of the application, it is subject to the proof of use requirements specified within section 6A of the Act. However, the applicant did not request that the

¹ On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result of the opponent’s EUTM number **751909** being registered as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and the original EUTM filing date remains.

opponent prove genuine use.² Consequently, the opponent may rely upon all of the goods identified in class 12.

4. In its notice of opposition, the opponent argues that the respective goods are either identical or highly similar and that the marks are highly similar, giving rise to a likelihood of confusion.

5. The applicant filed a counterstatement denying the ground of opposition. It denied that the marks are similar and as such claims that there is no likelihood of confusion between the marks. In relation to the goods, the applicant is silent on whether they are similar or not.

6. The opponent is professionally represented by WP Thompson, 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, the opponent 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. The applicant has not filed any written submissions. This decision is taken following a careful perusal of the papers.

7. 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)

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

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

[...]

² Section 7, Form TM8

(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

9. 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

10. In *Gérard Meric v Office for Harmonisation in the Internal Market ('Merici')*,³ the General Council ("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".

11. The goods to be compared are those outlined in paragraphs 1 and 2 of this decision.

12. The word 'locomotion' is defined as "the ability to move and the act of moving from one place to another".⁴ The applied-for goods are all particular examples of vehicles or apparatus to facilitate the movement of goods or people, including golf equipment and golfers. As such, they are encompassed within the opponent's broad term, "apparatus for locomotion by land, air or water", which does not include any golf related exceptions. Accordingly, I find that the goods are *Merici* identical.

The average consumer and the nature of the purchasing act

13. 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

³ Case T-133/05

⁴ <https://www.collinsdictionary.com/dictionary/english/locomotion>

according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

14. 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. 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.”

15. The average consumer of the goods at issue in these proceedings is likely to be members of the general public that play golf. The price of the goods is likely to vary depending on the nature and type but is typically likely to be at the higher end of the scale. Overall, the goods are typically not purchased frequently, and the purchasing of the goods is likely to follow a measured thought process; it will not be merely casual. The general public will consider factors such as cost, product specifications, practicality and reliability when selecting the goods. The average consumer may conduct research before purchasing the goods as they will wish to ensure that they are making an informed choice. In addition, they may also engage in conversations with sales advisors to make sure that they have the correct product. Overall, the level of attention of the general public would be above average. The goods are typically sold by brick-and-mortar retail establishments, where the goods will be purchased after a visual inspection of the goods. Alternatively, the goods can be purchased from their online equivalents, where they are likely to be purchased after viewing information on the internet. Overall, I am of the view that the purchasing process would be predominantly visual in nature. 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 representatives or word of mouth recommendations.

Distinctive character of the earlier mark

16. 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 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

17. 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.

18. 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. Consequently, I have only the inherent position to consider.

19. The earlier mark is a word-only mark which comprises the word “GOLF”. The word will be understood as referring to the outdoor sport where players use a club to try to hit a ball into a series of holes in as few hits as possible. Therefore, consumers will perceive the word “GOLF” as highly suggestive of the intended purpose of the goods relied upon, i.e. locomotive apparatus that could be used for golf, such as, golf carts and golf buggies. The distinctiveness of the mark clearly lies in the word “GOLF”, and, overall, I consider that the earlier mark possesses a low degree of inherent distinctive character.

Comparison of the marks

20. It is clear from *Sabel BV v. Puma AG*⁵ 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:

“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.”

⁵ Case C-251/95, paragraph 23

21. 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.

22. The respective trade marks are shown below:

Earlier mark	Contested mark
<p data-bbox="371 869 628 949">GOLF</p>	

Overall impressions

23. The earlier mark is a word-only mark that comprises the word “GOLF” with no other components. As such, the overall impression lies in the word “GOLF”.

24. As for the contested mark, it is a figurative mark, and encompasses the word “Golfcad” in standardised font with the letter “G” appearing in green and the remainder of the word in blue. Above the word element is a large golf ball device depicted in white and blue; a green semi-circle is present across the center of the golf ball. In my view, the overall impression lies in the word “Golfcad”, and the device in equal measure due to the size of the device.

Visual comparison

25. The competing marks are similar to the extent that the word “Golf” is found at the beginning of the verbal element of both marks (a position which is generally

considered to have more of an impact on UK consumers).⁶ However, the respective marks differ in length as the contested mark contains the additional letters “cad” which are not replicated in the earlier mark. Furthermore, whilst normal and fair use allows the earlier mark to be presented in any colour, the colour combination used in the contested mark is not standard as the letter “G” appears in green with the remaining letters in blue, which creates a point of visual difference. Moreover, although the contested mark is a figurative mark, the font is in standard typeface, as such there is not a significant difference in font when compared with the earlier word-only mark. The contested mark also includes a large golf ball positioned above the word, “Golfcad” presented in white and blue, with a green semi-circle located across the center of the golf ball device; this device is not replicated in the earlier mark. Taking into account the overall impressions, I find that the competing marks are visually similar to a low degree.

Aural comparison

26. In my view, consumers will not attempt to articulate the device element in the contested mark, as such, it comprises two syllables, i.e. “GOLF-CAD”, whilst the earlier mark consists of one syllable, i.e. “GOLF”. As a result, the competing marks share an identical syllable in the word “Golf”, with the difference resulting from the letters “cad” in the contested mark. Consequently, I find that there is a medium degree of aural similarity between the marks.

Conceptual comparison

27. The word “Golf” appears in both marks and will be understood as having the same meaning, i.e. referring to the outdoor sport in which players use a club to try to hit a ball into a series of small holes. When considering the goods at issue and the mark as a whole, the additional letters “cad” in the contested mark may be understood as alluding to the word caddie. Traditionally, a golf caddie is someone that carries a player’s golf clubs around a golf course and assists them during the game. However, a caddie may also be understood referring to a caddie cart which is a vehicle or wheeled device used for carrying around golfing equipment and/or golfers. The golf

⁶ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

ball device found in the contested mark simply reinforces the concept of golf. Although both marks refer to characteristics of the goods, the earlier mark refers to the sport itself, whilst the contested mark alludes to a golf caddie/cart. I accept there is a conceptual overlap in the meaning of the word "Golf", however, the additional meaning associated with the letters "cad" in the contested mark is not present in the earlier mark. Consequently, I find that the marks are conceptually similar to a medium degree.

Likelihood of confusion

28. 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.

29. 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.

30. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis K.C., as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for

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

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

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

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

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

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

39. I have found that the respective goods are identical, and that the average consumer of the goods will be golf playing members of the general public, who will pay an above average level of attention. I have found that the purchasing process will

be largely visual, however, I have not discounted aural considerations. The word “GOLF” dominates the overall impression of the earlier mark, whereas the word “Golfcad” and the figurative element co-dominate the overall impression of the contested mark. I have found that the earlier mark and the contested mark are visually similar to a low degree, and aurally and conceptually similar to a medium degree. I have also found that the earlier mark possesses a low level of inherent distinctive character.

40. I acknowledge that both marks contain the identical word “Golf” at the beginnings of their respective marks, a position where the attention of consumers is usually directed. However, the marks differ in length as the contested mark contains the additional letters “cad” attached to the word “golf”. The contested mark is also a figurative mark which includes a device element of a golf ball in white and blue with a green semi-circle around its centre. Furthermore, although the wording within both marks appears in standardised typeface, the contested mark contains an unusual colour pattern with the first letter in green and the remaining letters in blue. There are numerous visual differences between the marks that will not, in my view, be overlooked by consumers paying an above average degree of attention. These are of heightened importance given that I have found the purchasing process to be predominantly visual in nature.⁷ Aurally, the number of syllables differ in the earlier mark compared to the contested mark and, although the first syllable is identical, the difference generated by the additional syllable within the contested mark creates enough variance for the consumer to aurally distinguish between the marks. Although the marks overlap conceptually, I consider this to be outweighed by the visual and aural differences between the marks. Furthermore, this identity exists in words that are highly suggestive of the kind and intended purpose of the goods. I remind myself that weak distinctive character of an earlier mark does not preclude a likelihood of confusion.⁸ However, in *Whyte and MacKay*⁹ the court stated that “[...] if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.” This point

⁷ *Quelle AG v OHIM*, Case T-88/05

⁸ *L’Oréal SA v OHIM*, Case C-235/05 P

⁹ *Whyte and Mackay Ltd v Origin Wine UK Ltd* [2015] F.S.R. 33.

was taken further in *Nicoventures*¹⁰ where Justice Birss stated “[...] in particular having regard to the low degree of distinctiveness about the features these two marks have in common, even taking into account imperfect recollection the differences in the two marks will take on a greater significance for the average consumer that they might otherwise.” In my opinion, the shared element, i.e. the identical word, “golf”, is weak in distinctiveness in the context of the goods. This will lead consumers to have a greater awareness of the differences between the marks. It is my view that, despite the similarity created by the commonality of the word “Golf”, it is unlikely that the competing marks will be mistaken or misremembered for one another. Rather, the aforementioned differences are likely to be sufficient to enable consumers to differentiate between them. Therefore, in my judgement, taking all the above factors into account, the differences between the competing trade marks are likely to enable consumers, paying an above average level of attention, to avoid mistaking the marks for one another, even when factoring in the principles of imperfect recollection and interdependency. As a result, I find that there is no likelihood of direct confusion, even in relation to goods that are identical.

41. That leaves indirect confusion to be considered. 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.¹¹

42. Furthermore, in *Liverpool Gin*¹², Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (Case BL O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

¹⁰ *Nicoventures Holdings Ltd v The London Vape Company Ltd* [2017] EWHC 3393

¹¹ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

¹² *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

43. As explained above, consumers will recognise the common word “Golf”. However, they are words that are lowly distinctive and highly suggestive of the kind and intended purpose of the goods. In *Purity*,¹³ Mr Philip Harris, sitting as the appointed person, said that “The point about weak distinctiveness is that consumers will be less likely, depending on context, to jump to the conclusion the term is functioning in a distinct, origin indicative way.” I certainly consider that to be the case here for goods which could include golf related vehicles. I do not believe that consumers will assume that the applicant and the opponent are economically linked undertakings on the basis of the competing trade marks; I am unconvinced that consumers would assume a commercial association or licensing arrangement between the parties, or sponsorship on the part of the opponent, merely because of the shared word “golf”. This word is not so strikingly distinctive in relation to golfing vehicles that consumers would assume that only the opponent is using them in a trade mark. To the contrary, I have found these words to be low in distinctive character. Moreover, the differences between the competing marks are not conducive to any logical brand extensions, adding all the additional elements from the contested mark would change the overall impression of the mark to such an extent that it would not be identified as related to the earlier mark. It is my view that the similarities between the marks are likely to be seen as purely coincidental; the common use of the word “Golf” will be attributed to different undertakings merely using similar suggestive messaging for vehicles that include those relating to golf. In my opinion, this remains the case even in relation to goods that are identical. Therefore, I find that there is no likelihood of indirect confusion.

Conclusion

44. The opposition under section 5(2)(b) of the Act has failed. Subject to any appeal, the application will proceed to registration in the UK.

Costs

45. The applicant has been successful, and is therefore, entitled to a contribution towards its costs. As the applicant has not instructed professional representatives, it

¹³ *Purity Wellness Group LTD v The Stockroom Kent*, BL O/115/22

was invited by the Tribunal by email dated 6 December 2022 to indicate whether it intended to make a request for an award of costs, including accurate estimates of the number of hours spent on a range of given activities relating to defending the proceedings. However, I note that the applicant was not provided with a cost proforma. As a result, I am unable to deal with the issue of costs at this stage.

46. A copy of the cost proforma will be provided to the applicant upon the issuance of this decision. The applicant is hereby invited to file a completed cost proforma to the Tribunal within 14 days of the date of this decision. Once this is received, or following the expiry of the 14 days, I will issue a supplementary decision dealing with the issue of costs.

Dated this 27th day of March 2023

Sarah Wallace
For the Registrar