

TRADE MARKS ACT 1938

IN THE MATTER OF TRADE MARK Application

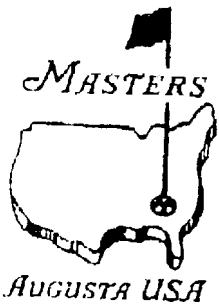
Nos: 1459735, 1459736, 1459917 and 1459918 to register trade marks in the name of Augusta National Incorporated

5 **AND IN THE MATTER OF Opposition**

Nos: 44618, 44616, 44647 and 44615 by The Masters Golf Company Limited.

Decision

10 Augusta National, Inc., 2604 Washington Road, Augusta, Georgia, 30904, USA applied on 27th March 1991 to register the marks shown for the goods indicated here:

Application and (opposition numbers)	Mark	Goods
15 1459735 (44618)	<i>MASTERS AUGUSTA USA</i>	Clothing and footwear for men and women; men's and women's golf gloves, golf shoes, t-shirts, collared shirts, sweaters, jackets, coats, pants, shorts, rain-suits, neckties, hats, sun visors, scarfs, belts and socks; all included in Class 25
1459736 (44616)		Sporting goods in connection with the game of golf; golf bags, golf bag covers, golf balls, golf clubs, golf club covers, golf ball markers and divot repair tools; games, all relating to the game of golf; all included in Class 28.
1459917 (44647)		Clothing and footwear for men and women; men's and women's golf gloves, golf shoes, t-shirts, collared shirts, sweaters, jackets, coats, pants, shorts, rain-suits, neckties, hats, sun visors, scarfs, belts and socks; all included in Class 25
20 1459918 (44615)		Sporting goods in connection with the game of golf; golf bags, golf bag covers, golf balls, golf clubs, golf club covers, golf ball markers and divot repair tools; games, all relating to the game of golf; all included in Class 28.

The Masters Golf Company, Bristol, oppose registration of the marks under the opposition numbers shown, and consolidated in these proceedings. Their grounds were indicated as being based on s 11 and s 12(1) of the Act. They also ask the Registrar to refuse the applications in exercise of her discretion. The applicants deny these grounds and both parties ask for their costs.

The opponents applied on 24 October 1995 for registration the following mark No. 2042251:



for 'Sporting articles, parts and fittings for the aforesaid goods; all for use in the game of golf'. This application is opposed by the applicants in this case under opposition No. 45190. The applicants are also the proprietors of the marks shown in the Annex to this decision.

5 A Hearing took place on 10 January 2000, with Mr Stacey of Messrs. Baron and Warren appearing for the applicants, and Mr Harrison of Messrs. Jordan and Sons appearing for the opponents. By the time this matter came to be heard, the Trade Marks Act 1938 had been repealed by Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act, however, I must continue to apply
10 the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provision of the old law.

The Evidence

15 The opponents' evidence consists of a Statutory Declaration by Darren Paul Evans, Director of the Masters Golf Company Limited, dated 5 March 1997, accompanied by four exhibits (DEP 1 to 4) and a further Declaration, consisting of evidence in reply to the applicants' evidence, also by Mr Evans, dated 5th October 1998.

The applicants' evidence consisted of the following:

20	Statutory Declaration by James Maxwell Stacey, dated 17 April 1998.	JMS 1	Further Declaration by Mr Stacey, dated 9 th January 1995	Exhibits Augusta 1 to 7.
		JMS 2		
		JMS 3	Declaration by James E Johnston Jr Assistant Secretary/Treasurer of Augusta International Inc.	Exhibits AUG 1 to 3.
		JMS 4		

The second Declaration of Mr Stacey and that of Mr Johnston were previously submitted to the Registry, to secure acceptance of their marks, before these opposition proceedings commenced.

25 After a careful consideration of the evidence, I have decided not to include a detailed formal summary. Rather I will refer to those parts of it that are relevant to the grounds pleaded.

The Decision

Section 11 of the Act reads as follows:

5 ‘11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.’

In opposition proceedings it is normal to apply the following tests, from the *Smith Hayden & Co Ltd's Application* (1946) 63 RPC 101 as adapted by Lord Upjohn in *Bali Trade Mark* [1969] 14 RPC 496. In this instance, the test reads as:

10 **(Under s 11)** ‘Having regard to the user of the THE MASTERS plus device mark is the tribunal satisfied that the marks applied for, MASTERS AUGUSTA USA and MASTERS AUGUSTA USA plus device, if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?’

15 An opposition under Section 11 based upon earlier use cannot be launched if the opponent has not established priority against the applicants’ mark. If this priority is established by use, that must be before the date of application of the applicants’ mark and, if the applicants have use prior to the application, the opponents’ use must antedate that.

20 Let me say first of all that I believe the applicants’ best hope in this case lies with their application date of 27 March 1991. That is, I do not believe they have established user for their marks in relation to the goods for which they are seeking registration before that date. In his first declaration dated 17 April 1998 Mr Stacey for the applicant, referring to the Masters Augusta Golf tournament, states:

25 ‘It is important to bear in mind the heritage of the tournament in that it dates from 1934 and is the only Grand Slam or “Major” golf tournament which is consistently played on the same golf course. The other tournaments within this group also consist of The US Open, The British Open and the US PGA, all of which are played on different courses each year. The tournament which adopted the name The MASTERS in 1935 has developed to the extent that it is now recognised as by far the most important and prestigious of the world’s premier golfing tournaments. Many would argue that the name of The Masters, within the field of golf in its widest context, is uniquely associated with the tournament in question and therefore the Applicants.’

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In his exhibit JMS2 Mr Stacey includes extracts from the tournament Journal issued by the Applicants for 1991 which sets out the heritage of the tournament.

35 There is little doubt that the Applicants have a significant reputation in their marks for golf tournaments. It is a moot point, however, as to whether this reputation extended to the goods for which they are seeking registration in 1991. At the Hearing, Mr Stacey referred me to the direct link between sporting clubs and the organisers of sporting events with merchandising ‘spin-offs’ and he said:

‘I would point to major football clubs the various national rugby and football associations and the organisers of the football world cup to name but a few, in each instance goods such as clothes and sporting articles are marketed under the various brands involved’.

5 Mr Harrison, for the opponents, was doubtful that such a link had been established in this case, and stated:

10 ‘I would submit that we do not have that sort of connection at all..... if the British public were to see merchandise appearing here in the UK at least under the trade mark THE MASTERS, and maybe also under the trade mark which involved Augusta USA, I would argue that there is not sufficient connection here in the UK with that position over in the States. There is not that same sort of connection there would be with a UK football club on its own local territory’.

I think I agree. Though the applicants enclose a great deal of evidence (Exhibit AUG2 of Mr Johnsons’ declaration) there is nothing to suggest that any of these products have ever been sold in the UK. Mr Johnson states at paragraph 4 of is declaration:

15 ‘With regard to the products listed, I confirm the above items are offered for sale in the USA and to citizens in the United Kingdom. I further confirm that sales have been made to United Kingdom citizens and organisations primarily by means of a filling written requests. Requests are received from United Kingdom citizens for such articles which are thereafter despatched to the United Kingdom. In addition, United Kingdom citizens from a sizeable
20 contingent amongst visitors to The Masters/Augusta USA Golf Tournament. These visitors purchase items from the golf club sales facilities for use back in the United Kingdom’.

25 Commenting on this evidence, Mr Harrison was of the view that this was nothing more than an assertion of sales to United Kingdom citizens, unsupported by evidence. He pointed out that there was no identification of any UK citizens, no specific records exhibited of any sales, even though Mr Johnson states that sales were made primarily by fulfilling written requests. In short, there is no material demonstrating that the products indicated were sold to UK citizens. Further - also observed by Mr Harrison - there is no evidence that the products were offered for sale even in the United States before the relevant date.

30 At the hearing Mr Stacey referred me to the *Pete Waterman Limited v CBS (UK) Limited* [1993] EMLR 27. He said that this case shows a trade mark proprietor could enjoy a UK goodwill in a mark, even if there is no active business in the conventional sense being conducted within the United Kingdom. This may or may not be so, but, I do not think it helps
35 the applicants’ position one way or another as they have not demonstrated to my satisfaction user of their mark on the products for which they seek registration before the 27 March 1991. It follows from this that if the applicants are to win on the Section 11 ground, the opponents must also be unable to show user of their mark before that particular date.

In his declaration Darren Paul Evans for the opponent states:

40 ‘The trade mark “The Masters Golf Company & Device” was first used during the latter part of 1990, as a result of a merger of the businesses of Mike Evans Sports and A W Sports’.

He refers to Exhibit DPE1 which consists of a letter, dated 21 December 1990, addressed to the suppliers of both businesses informing them of the change. In this letter the opponents say they offer a comprehensive range of golf products and accessories to golf professionals and specialist golf shops. Their mark, shown on page 2, is clearly displayed on the letter, with the addition below of the words 'Golf Company'.

This Exhibit also contains an article which appeared in the February 1991 edition of 'Pro-Shop Europe', which appears to be a golf trade magazine. This says that 'The Masters Golf Company Limited was launched on 1 January this year and offers a comprehensive package for accessories'. Further on the article states: '..the product range majors on golf accessories, head covers, trolleys, bags, gloves, hats, practice balls and equipment, many items of which will feature the new Master's "M" logo. In addition there is a comprehensive range of clubs and putters. Once again fully branded.' Other evidence in Exhibit DPE 1 are 2 invoices, both of which are dated 17 January 1991. One invoice is for £241.18 of goods and the other is for £172.94 and the sales were made to a golf club in Nottingham and to a shop in Stone in Staffordshire. The goods are golfing equipment, including golf gloves.

This to me is clear evidence of first use, and in my view is enough for the opponents to win their case. At the hearing Mr Harrison stated:

'..although the use prior to the filing date of the application amounts to an agreed minimum about 4 months, it seems to be acknowledged that our use started at the beginning of 1991. That 4 months is not just 4 months starting from scratch... it is 4 months of use which is a continuation of the merger of two existing businesses. It is 4 months during which, or even prior to which, information was sent out to suppliers as to the position. It is 4 months during which the position has been commented on in the journal "Pro-Shop". This ... is a very rapid establishment of continued business under the new trade mark'.

It seems to me that the opponents have established first user of the mark. In his consideration of s 11 in *Bali*, Lord Upjohn stated:

'It is not necessary in order to find that a mark offends against section 11 to prove that there is an actual probability of deception leading to a passing off or .. an infringement action. It is sufficient if the result of the registration of the mark will be that a number of persons will be caused to wonder whether it might not be the case that the two products come from the same source. It is enough if the ordinary person entertains a reasonable doubt, but the court has to be satisfied not merely that there is a possibility of confusion, it must be satisfied that there is a real tangible danger of confusion if the mark which is sought to register is put on the register'.

I think that in view of the similarities between the marks at issue such a danger exists. In coming to this view, I note that the word 'Masters' may not be distinctive of golf tournaments, as the evidence suggests (see paragraph 7 of Mr Evan's second declaration). However, it is not descriptive of the goods at issue. The absence of any evidence of commercial sales of merchandise in the UK prior to the relevant date by the applicants increases the likelihood, in my view, that use of their mark would cause the relevant public to wonder whether there is a trade connection with the opponents.

The opponents have made their case and, as I see no reason to exercise the Registrar's discretion, all four applications are refused.


At the Hearing opponents contended that they had pleaded s 12(3), not s 12(1). In view of the above finding, I do not need to consider this matter and refrain from doing so.

- 5 The opponents are successful, and are entitled to an award of costs. I order the opponents to pay to them £1840. This sum is to be paid within one month the expiry of the appeal period or within one month of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of June 2000

10 **Dr W J Trott**
Principal Hearing Officer
For the Registrar
the Comptroller-General

ANNEX

Mark	Number	Date	Goods
<i>MASTERS AUGUSTA USA</i>	1460759	09.04.1991	Pre-recorded films and video tapes; teaching apparatus; all of the aforesaid goods pertaining to the game of golf; all included in Class 9
	1459732	27.03.1991	Books, programmes, journals and manuals, all pertaining to the game of golf and to golf tournaments; golf score cards, pairing sheets; posters, calendars, stationery and playing cards; writing instruments; paper weights; instructional and teaching material (except apparatus); all of the aforesaid goods relating to or depicting the game of golf; all included in Class 16
	1459733	27.03.1991	Umbrellas; garment, travel, sport and tote bags; wallets, billfolds; identification tags for golf bags; attache cases and brief cases; ladies' handbags and purses; all included in Class 18
	1459734	27.03.1991	Small domestic utensils and containers; drinking glasses, cups and mugs; plastic cups and mugs; pewter mugs; ornamental glass, plastic cups and mugs; pewter mugs; ornamental glass, plastic and wooden decorative table accessories; glassware, porcelain and earthenware; all included in Class 21.
	1459737	27.03.1991	Production of television programmes and video recordings; all relating to the Augusta Masters Golf Tournament; all included in Class 41.
 <i>MASTERS AUGUSTA USA</i>	1459914	27.03.1991	Books, programmes, journals and manuals, all pertaining to the game of golf and to golf tournaments; golf score cards, pairing sheets; posters, calendars, stationery and playing cards; writing instruments; paper weights; instructional and teaching material (except apparatus); all of the aforesaid goods relating to or depicting the game of golf; all included in Class 16
	1459915	27.03.1991	Umbrellas; garment, travel, sport and tote bags; wallets, billfolds; identification tags for golf bags; attache cases and brief cases; ladies' handbags and purses; all included in Class 18.
	1459919	27.03.1991	Production of television programmes and video recordings; all relating to the Augusta Masters Tournament; all included in Class 41.
	1460764	09.04.1991	Pre-recorded films and video tapes; teaching apparatus; all the aforesaid goods pertaining to the game of golf; all included in Class 9.

5 The Registrations disclaim exclusive use, separately, of the 'Masters' and 'Augusta USA', the devices of a golf flag and map of the USA.