

BLO/278/20

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3228245
IN THE NAME OF PRADEEP P PATEL & VIJAY BHUWAD
FOR THE TRADE MARK:**

SURREY GOLFERS

AND

**OPPOSITION THERETO UNDER NO. 413151
BY SURREY GOLFERS LIMITED**

Background and pleadings

1. On 2 May 2017, Pradeep P Patel and Vijay Bhuvad (“the applicants”) applied to register the trade mark **SURREY GOLFERS** under number 3227245 (“the contested mark”). The application was published for opposition purposes on 20 April 2018 in respect of the following services:

Class 41: Sports services; organising sporting events; arranging sporting events; provision of golfing facilities; organising of golfing tournaments; organisation of rounds of golf; entertainment services relating to the playing of golf; golf courses; golf tuition; entertainment services.

2. The application is opposed by Surrey Golfers Limited (“the opponent”). The opposition is based upon s. 5(4)(a) of the Trade Marks Act 1994 (“the Act”) and is directed against all of the services in the application. The opponent claims that it has used the sign shown below in respect of “sporting and cultural activities. Golf and golfing services, events and competitions. Provision of playing times at golf clubs” in the county of Surrey since 2007:



The opponent claims that use of the contested mark would be “infringing on the reputation and goodwill of the business established by us in 2007”, causing misrepresentation and damage.

3. The applicants filed a counterstatement in which they deny the grounds of opposition and requested evidence of the opponent’s claimed goodwill. They claim that they have

used “SURREY GOLFERS” since 2009 in respect of various sporting, golfing and entertainment services.

4. Both parties filed evidence. A hearing was held before me, by videoconference, on 6 April 2020. The opponent was represented by Jamie Muir Wood of Counsel, instructed by Trade Mark Wizards Limited. The applicant was represented by Heather Lawrence of Counsel, instructed by Dolleymores.

Case management

5. After the conclusion of the evidence rounds, the opponent sought permission to cross-examine Pradeep Patel. A Case Management Conference (“CMC”) was held before me on 24 January 2020 to discuss the matter. In a letter of the same date, I refused the opponent’s request for cross-examination for the reasons reproduced below:

“I acknowledge the opponent’s concern that Mr Patel’s evidence will be accepted at face value if cross-examination is refused. However, whilst refusing cross-examination would mean that the opponent cannot allege that Mr Patel’s evidence is untruthful, it does not preclude the opponent from making appropriate submissions as to the weight it should be afforded, as Mr Muir Wood appeared to accept. I also bear in mind that the thin documentary evidence on both sides might result in narrative evidence taking on more significance and that cross-examination might be more appropriate, or even necessary, in such a situation. However, to be appropriate, cross-examination must be relevant to the determination of the issue and I am not satisfied that that is the case here. It is accepted by the parties that this opposition hinges on who owned the goodwill. The relevant question appears to be whether the goodwill vested in the club itself, or whether in one of these individuals, and on what basis either of these individuals (but particularly the opponent) asserts his personal ownership of any goodwill. In these

circumstances, I am not persuaded that cross-examination of Mr Patel on his relationship with Mr Ganatra, or whether one of these men had a greater role in the club than the other, would assist me in determining the key issue. Taking all of the above into account, my decision is that cross-examination should be refused”.

Evidence

6. I have read all of the evidence but will summarise only the relevant material.

Opponent's evidence

Mr Ganatra's evidence

7. This consists of the two witness statements of Sandeep Ganatra and the witness statements of Frank Greco, Simon Capanda and Kuang Lee.

8. Mr Ganatra is “a shareholder, person with overall control of and the sole director” of the opponent company. He states that, in 2007, he bought a corporate membership in his personal name at Selsdon Park Hotel and Golf Club in Croydon; emails concerning the purchase are provided.¹ He invited other players to use his membership on days when he was not playing.² His evidence is that in 2007 he and three colleagues were the only subscribers, though the documentary support is an email which appears to have been solicited for proceedings and is hearsay.³ Mr Ganatra also provides an email concerning the 2008 renewal of his Selsdon Park membership.⁴ In 2009, two corporate memberships were purchased, by Abbotcone Limited and Tulshi ICT Limited (Mr Patel's company: Ganatra 2, §10).⁵ It is not entirely clear how many players were involved at this time: Mr Ganatra says there were approximately sixty but the documentary

¹ Ganatra 1, §§11-15 and exhibit SG-2; SKG1 to Ganatra 2.

² Ganatra 1, §§14-15

³ Ganatra 2, §8 and SKG4.

⁴ SKG5.

⁵ Ganatra 1, §16.

evidence suggests that in March 2009 there were forty-two at most.⁶ Mr Ganatra states that he negotiated similar deals with other golf clubs in the area, without remuneration, for the benefit of the group.⁷

9. Mr Ganatra accounts for the choice of name as follows:

“19. [...] The initial suggestion for the name was Sandy Golfers as I was recognised as the founder. However, I suggested that another name, perhaps South London Golfers be used but the group wanted to recognise my concept and were keen to recognise that by using my initials (SG) in the name.

20. To make the group more inclusive, I suggested Surrey Golfers, as most of the members and courses we played were in Surrey. We decided on this name of Surrey Golfers and a logo was chosen, primarily by myself and Mr Patel to accompany the name and the website was under development”.

10. Mr Ganatra’s evidence is that he contracted Mr Patel to design a logo for “Surrey Golfers”; an email dated 2008 refers to a “sample logo” but the logo itself is not shown.⁸ Mr Ganatra says he had regular email and telephone contact with Mr Patel, it seems in 2009, “regarding progress and issues when they arose” and concerning a website for the group, which became “Surrey Golfers”.⁹ He says that Mr Patel was his IT equipment and services provider.¹⁰ The website was paid for in 2009 by Mr Ganatra, with “the balance taken from fees generated through selling membership of the group”.¹¹ This arrangement, it is said, continued and Mr Patel invoiced expenses for the website and email hosting.¹²

⁶ See SKG7.

⁷ Ganatra 1, §17.

⁸ Ganatra 2, §6 and SKG2.

⁹ Ganatra 1, §§18-20.

¹⁰ Ganatra 2, §9.

¹¹ Ganatra 1, §21.

¹² Ganatra 1, §22.

11. Emails dated 2009, 2011 and 2015 between Mr Ganatra and Mr Patel (and others whose names are redacted) are in evidence.¹³ Mr Patel tells Mr Ganatra that “after speaking to some of our guys” there are a number of suggestions, including on the fees that members should pay. Mr Patel suggests a website, which he will set up. Mr Ganatra responds positively, saying “you and me have done a great job of this and will coordinate throughout 09 which I don’t mind”, proposing fees which will cover the costs of the website and hosting. He indicates Mr Patel can “send this onto the guys if they want to mull it over”. Another email from Mr Patel to Mr Ganatra and others, dated 4 April 2009, discusses the payments by “Vijay” and “Pradeep” to Farleigh and Selsdon golf clubs, thanks “Bhirenbhai” for compiling the rules and outlines points yet to be decided.

12. An email dated 12 October 2015 contains the following statement: “no one person owns Surrey Golfers and its bank balance but **all members** of Surrey Golfers own Surrey Golfers and its bank balance” [original emphasis].¹⁴ In an email also of 12 October 2015 Mr Patel states “I didn’t want to come across I own [sic] Surrey Golfers”.¹⁵

13. The club had a number of group leaders but Mr Ganatra was not one, he says by choice.¹⁶ However, he states that he oversaw the daily activities of the club and was involved in decision-making and the continued expansion of the golf clubs with which the group had an arrangement.

14. Minutes of Group Leader meetings and AGMs between April 2013 and May 2016, said to have been drafted by Mr Ganatra, are exhibited.¹⁷ I note, however, that at least one is attributed to “Pankaj” (p. 36) and that Mr Ganatra cannot have authored another because it records a discussion which appears to have taken place after he had left (pp. 45-46). Mr Ganatra is not identified as present in the majority of the minutes. He is mentioned as making a suggestion at the 2014 AGM regarding membership numbers

¹³ SKG7-SKG9; SKG11-SKG13.

¹⁴ SKG13.

¹⁵ SKG15.

¹⁶ Ganatra 1, §§24-26.

¹⁷ SG-4.

and is among several members thanked for helping negotiate with clubs (p. 28); he is also listed as “in attendance” at an emergency group leaders’ meeting in May 2015, although his attendance is put down to a “mix up in the communication” (p. 45). The minutes record “he requested if he could make a presentation to the meeting” and that the points he raised were left for consideration by the group leaders, only one of which was adopted (pp. 46, 49). He is also recorded as participating in what appears to be a general discussion about the waiting list at the 2016 AGM (p. 62).

15. The minutes show various motions put to and approved by members at the AGMs, such as agreement of the previous year’s AGM minutes and accounts (p. 37), membership fees (pp. 27-28, 38) and the acceptance of new members/applicants on the waiting list (p. 27). The minutes also show that a range of matters, such as insurance cover, golf lessons (p. 17) and organisation of the club’s annual “golf day” (p. 18) were handled by members other than Mr Ganatra. Signatories on the club’s bank account were given as “Pradeep” and “Pankaj” in 2013 (p. 22), with Bhiren Patel added in 2016 (p. 71). I note that Mr Ganatra and Mr Bhuvad went to a golf club to negotiate a deal, though I also note that “Pankaj” was going to investigate a possible deal with another club (p. 23). It is apparent that group leaders made decisions collectively, delegating responsibility for following up to individuals, as necessary. These include issues such as increasing the number of tees/not renewing arrangements at a given club (p. 24), plans to control who can play at certain courses (p. 31), admission of new members/waiting list fees (p. 31) and discipline (pp. 35, 36, 43-44, 45). All of the group leaders have access to the group’s accounts (pp. 30, 32, 42). It is mentioned in the minutes that the group has no formal constitution (for example, p. 65) and there is a discussion concerning the chairing of the annual meeting, from which it appears that there is no agreed chairperson (p. 65).

16. On 20 March 2017, Mr Ganatra had a meeting with a group leader and Mr Patel, who advised him that an email would be sent to members the following day, which Mr Ganatra duly received.¹⁸ The email contains new terms and conditions for members,

¹⁸ Ganatra 1, §30 and SG-5.

which appear to have been agreed at a group leaders' meeting on 17 March. The deadline for response is 4 April 2017. Vijay Bhuwad and Pradeep Patel (i.e. the applicants) are described as "the founding Chairmen of SG" and members are notified that they have "assumed control of SG". The principles on which the association will be run are outlined. It is said that "SG is neither a society nor a club" and that governance will be in the hands of the applicants. "The IP rights of the website" are said to be wholly owned by Pradeep Patel and his company.

17. Mr Ganatra describes the further breakdown of his relationship with the applicants and the formation of his company.¹⁹ He states that a second meeting took place on 23 March 2017, where he was offered a position with the "new owners" of the club by Mr Bhuwad and it was suggested to him that if he did not agree to the new arrangements he could start his own club. Mr Ganatra states that documents were removed from the website and forums suspended but that he contacted members by email. He incorporated the opponent company on 27 March 2017.²⁰ He states that from 1 May 2017 he was no longer a member of the group.

18. An assignment document dated 27 April 2019 is provided which confirms the purported assignment of goodwill in the business carried on under the name SURREY GOLFERS from Mr Ganatra to the opponent on 27 March 2017.²¹

Other witnesses for the opponent

19. Mr Greco's evidence is that he, Mr Ganatra, Mr Capanda and Mr Lee played golf together using 2-for-1 vouchers. The four men divided the costs of a corporate membership at Selsdon Park. Mr Greco states that, in 2008, Mr Bhuwad and Mr Patel joined the group. Surrey Golfers was formed in 2009.

¹⁹ Ganatra 1, §33-37.

²⁰ SG-5.

²¹ SG-7. The exhibit is, in fact, headed SG-6. For reasons which will become apparent, this matters not.

20. Mr Capanda gives similar evidence about the purchase of a corporate membership in 2007, the cost of which was borne between himself, Mr Greco, Mr Ganatra and Mr Lee. He too says Mr Bhuwad and Mr Patel joined in 2008 and that Surrey Golfers was formed in 2009, when it had around 32 members.

21. Mr Lee gives evidence that the Surrey Golfers concept did not exist before he took membership at Selsdon Park in 2007. He too states that the cost was split four ways, between himself, Mr Ganatra, Mr Capanda and Mr Greco.

Applicant's evidence

22. This consists of the two witness statements of Pradeep Patel, one of the applicants.

23. Mr Patel states that he and Mr Bhuwad have used the contested mark since 2009 in connection with a club which facilitates access to golf clubs for its members.²² He claims that he and Mr Bhuwad created the concept and original club in 2007 and that they have managed the club and maintained its accounts.²³ He denies that Mr Ganatra was the originator of the idea and that he played an important role in the club.²⁴ Instead, Mr Patel states that Mr Ganatra was invited to join by Mr Bhuwad.²⁵ He also denies that Mr Ganatra's access to the website was blocked by either himself or Mr Bhuwad.²⁶

24. Evidence is provided of the purchase of the domain name associated with the club and an archive print of the website.²⁷ Mr Patel states that he developed the software for the club's website and that the costs of programming, enhancing, maintaining and hosting the website were charged to the club at cost.²⁸ There are also undated prints of

²² Patel 1, §§6, 13.

²³ Patel 1, §§6, 13, 27.

²⁴ Patel 1, §§19-20, 24

²⁵ Patel 1, §20.

²⁶ Patel 1, §27.

²⁷ PP1 to Patel 1.

²⁸ Patel 1, §26.

the website and examples of membership cards (and a related invoice to Surrey Golfers), which show the words “Surrey Golfers” in a stylised form.²⁹

25. Invoices from golf clubs dated between March 2013 and May 2017 are in evidence.³⁰ “Surrey Golfers” is in the address of all of these, though Mr Patel is named on some. Mr Patel says that he and Mr Bhuwad negotiated these deals.³¹

26. Mr Patel gives annual turnover figures from 2009 to 2017, rising from £19,280 in 2009 to £359,187 in 2017, though his evidence is that it is a non-profit organisation.³²

27. It is Mr Patel’s evidence that new rules were needed in 2017 to manage the large membership and that the proposed new rules were approved by 89% of members (though elsewhere there is evidence that puts the figure at 97% of the previous year’s members).³³ Mr Patel also gives evidence about Mr Ganatra’s actions during and following the breakdown of his relationship with the applicants/the club, including the email Mr Ganatra sent to members. I have read all of this evidence but do not need to record it. The applicants’ subsequent letter to members is in evidence.³⁴ I note that it describes “Surrey Golfers” as “an association of its members” and a “membership association” and that it is said that if a member leaves “the rights which belong to Surrey Golfers will remain with the remaining members”.

Section 5(4)(a)

28. Section 5(4)(a) states:

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

²⁹ PP2 and PP3 to Patel 1.

³⁰ PP4 to Patel 1.

³¹ Patel 1, §13.

³² Patel 1, §§14, 9, 12.

³³ Patel 1, §§28-30 and PP2 to Patel 2.

³⁴ PP2 to Patel 2.

(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, or

(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”.

29. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, HHJ Clarke, sitting as a Deputy Judge of the High Court stated that:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)”.

30. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act and concluded as follows:

“43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made’.”

31. In order to succeed under this ground, use of the contested trade mark must have been capable of being restrained as at the date of application, i.e. 2 May 2017. Use before that date might, however, be relevant to determining the senior user at common law and the respective rights of the parties. I will return to this point if necessary.

Goodwill

32. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

“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”.

33. To clear the first hurdle, the opponent must show that it owned a protectable goodwill at the relevant date. Goodwill is to be distinguished from a name, in which there is no independent property right.³⁵ The same applies to the “concept” of the group. The fact that Mr Ganatra (or the applicants) came up with either would not of itself establish the property right needed to sustain an objection in passing off.

³⁵ If authority be needed, see *I N Newman Limited v Richard T Adlem* [2005] EWCA Civ 741 at [22].

34. There appears to be no dispute between the parties that goodwill subsisted from at least 2009. Given the parties' apparent acceptance that goodwill may subsist in the golf club at issue, not least because of their competing claims to its ownership, and the not insignificant levels of turnover shown in Mr Patel's evidence, I am prepared to accept that at least from 2009 there was a protectable goodwill in a club providing golf course tee times to its members and that "Surrey Golfers" was distinctive of that club. There is no evidence that either party owned a protectable goodwill prior to 2009. The applicants' evidence on the point amounts to an unsupported assertion from Mr Patel that he and Mr Bhuvad created the club in 2007. Mr Ganatra's evidence is little better, though I prefer it to that of Mr Patel: his claim to have first purchased a corporate membership for the mutual benefit of himself and some friends in 2007 finds some support in the emails provided and in the witness statements of Mr Capanda, Mr Greco and Mr Lee (there was no request for these witnesses to be cross-examined). However, the purchase of one corporate membership and a playing arrangement between four friends falls a long way short of establishing that there was goodwill sufficient for a passing-off action. Moreover, the evidence shows that the idea of a website was first mooted in 2009.³⁶ Mr Ganatra's evidence is that the website and naming of the group went hand in hand, as a consequence of which it appears that neither the earlier sign nor the contested mark was used before 2009. I find that there was no goodwill associated with the sign "SURREY GOLFERS" before 2009.

35. I have not overlooked the fact that the pleaded sign is the phrase "SURREY GOLFERS LIMITED", with other non-distinctive wording and a stylised presentation. There is no evidence that the sign relied upon has been used: the evidence only shows use of "SURREY GOLFERS". Given that the phrase "SURREY GOLFERS" is non-distinctive, I have reservations that the use of that phrase on its own would constitute use of the earlier sign. However, for reasons which will become apparent, it is not necessary for me to express a concluded view on this point.

³⁶ SKSG7-SKG8.

36. I turn next to whether either of the parties, and if so which, can lay claim to the goodwill of the “SURREY GOLFERS” club. In *CLUB SAIL Trade Mark*, O/074/10, Geoffrey Hobbs QC, sitting as the Appointed Person, made the following remarks about unincorporated associations:

“26. This opens up the appeal to the extent that I am now required to determine the competing claims of the parties to proprietorship of the goodwill of the business appertaining to the signs in issue. Before doing so, I make the general observation that goodwill can be and frequently is built up and acquired by means of economic activities carried out collectively. By using the word ‘collectively’ I am intending to refer to all of the various ways in which alliances may be formed between and among individuals or corporate bodies in pursuit of shared interests and objectives. It is appropriate in this connection to refer to the following observations in the judgment of the Court of Appeal delivered by Hughes LJ in *R v. L(R) and F(J)* [2008] EWCA Crim. 1970; [2009] 1 Cr. App. R 16 :

Unincorporated associations

11. There are probably almost as many different types of unincorporated association as there are forms of human activity. This particular one was a club with 900-odd members, substantial land, buildings and other assets, and it had no doubt stood as an entity in every sense except the legal for many years. But the legal description “unincorporated association” applies equally to any collection of individuals linked by agreement into a group. Some may be solid and permanent; others may be fleeting, and/or without assets. A village football team, with no constitution and a casual fluctuating membership, meeting on a Saturday morning on a rented pitch, is an unincorporated association, but so are a number of learned societies with large fixed assets and detailed constitutional structures. So too is a fishing association and a

trade union. And a partnership, of which there are hundreds of thousands, some very large indeed, is a particular type of unincorporated association, where the object of the association is the carrying on of business with a view to profit.

12. At common law, an unincorporated association is to be distinguished from a corporation, which has a legal personality separate from those who have formed it, or who manage it or belong to it. The most numerous species of corporation is the limited liability company, but there are of course other types, such as chartered professional associations, local government bodies and indeed bishops. At common law, as the judge succinctly held, an unincorporated association has no legal identity separate from its members. It is simply a group of individuals linked together by contract. By contrast, the corporation, of whatever type, is a legal person separate from the natural persons connected with it.

13. This is an apparently simple legal dichotomy duly learned by every law student in his first year. But its simplicity is deceptive. It conceals a significantly more complicated factual and legal position.

14. As to fact, many unincorporated associations have in reality a substantial existence which is treated by all who deal with them as distinct from the mere sum of those who are for the time being members. Those who have business dealing with an unincorporated partnership of accountants, with hundreds of partners world-wide, do not generally regard themselves as contracting with each partner personally; they look to the partnership as if it were an entity. The same is true of those who have dealings with a learned society, or a trade union, or for that

matter with a large established golf club. Frequently, as Lord Phillips of Worth Matravers C.J. pointed out in *R. v. W. Stevenson & Sons (a partnership and others)* [2008] EWCA Crim. 273; [2008] 2 Cr. App. R. 14 (p.187) (at [23]) third parties will simply not know whether the organisation being dealt with is a company or some form of unincorporated association.

15. As to the law, it no longer treats every unincorporated association as simply a collective expression for its members and has not done so for well over a hundred years. A great array of varying provisions has been made by statute to endow different unincorporated associations with many of the characteristics of legal personality. [...].

The judgment in that case related to the operation of the general rule that in any enactment passed after 1889 the word '*person*' includes '*a body of persons corporate or unincorporate*' unless the contrary intention appears: Section 5 and Sch. 1, Interpretation Act 1978 .

27. I consider that the starting point for the purposes of analysis in the present case is the general proposition that the goodwill accrued and accruing to the members of an alliance such as I have described is collectively owned by the members for the time being, subject to the terms of any contractual arrangements between them: *Artistic Upholstery Ltd v. Art Forma (Furniture) Ltd* [2000] FSR 311 at paragraphs 31 to 40 (Mr. Lawrence Collins Q.C. sitting as a Deputy High Court Judge). When members cease to be members of an ongoing alliance they cease to have any interest in the collectively owned goodwill, again subject to the terms of any contractual arrangements between them; see, for example, *Byford v. Oliver (SAXON Trade Mark)* [2003] EWHC 295 (Ch); [2003] FSR 39 (Laddie J.); *Mary Wilson Enterprises Inc's Trade Mark Application (THE SUPREMES Trade Mark)* BL

O-478-02 (20 November 2002); [2003] EMLR 14 (Appointed Person); Dawnay Day & Co Ltd v. Cantor Fitzgerald International [2000] RPC 669 (CA) ; and note also the observations of Lord Nicholls of Birkenhead in Scandecor Development AB v. Scandecor Marketing AB [2001] UKHL 21; [2002] FSR 7 (HL) at paragraphs [42] to [44]. This allows the collectively owned goodwill to devolve by succession upon continuing members of the alliance down to the point at which the membership falls below two, when ‘the last man standing’ becomes solely entitled to it in default of any other entitlement in remainder: see, for example, VIPER Trade Mark (BL O-130-09; 13 May 2009) (Appointed Person, Professor Ruth Annand)”.

37. There is only limited evidence showing how the club was set up. Mr Patel and Mr Ganatra appear to have been important figures in the arrangements (I note Mr Ganatra’s comment that he and Mr Patel “have done a great job”). Mr Ganatra has provided various exchanges between himself and Mr Patel but others, whose emails have been redacted, also appear to have been included.³⁷ Mr Patel indicates that the suggestions in his email are the result of consultations with “some of our guys” and Mr Ganatra accepts that his response can be passed on to these individuals for their consideration. Matters in which these other individuals had an input included fees and rules for members: “Bhirenbhai” has by 4 April 2009 compiled the rules which Mr Patel has forwarded to the members “without Sandy’s [Mr Ganatra’s] and Vijay’s consent”. Mr Muir Wood submitted that these emails show Mr Patel seeking approval from Mr Ganatra on key issues. I do not think that they establish that Mr Ganatra had sole responsibility for the club: they strike me as discussions among equals who are setting up a group for the mutual benefit of the participants. Mr Ganatra was an important member in the club but he does not appear to have had a greater say than, at least, Mr Patel or Vijay (presumably Mr Bhuwad). In addition, the corporate memberships in 2009 were not purchased by Mr Ganatra but by two companies, neither of which appears to be under his control. Although Mr Ganatra says that he paid for the original website, his

³⁷ SKG2, SKG7-SKG9.

own documentary evidence shows that he suggested membership fees at a level which would cover the website and web hosting costs.³⁸

38. As far as evidence of the allocation of the goodwill goes, there is no clear evidence of the rules which were put in place in 2009 to govern the relationships between the members of the club. There is some indication that they concerned matters such as fees and standards of behaviour but there is nowhere in the evidence a complete set of the rules of the association. There is also no detailed evidence concerning the contractual relationships which were put in place with the various golf clubs where the association purchased tee times.

39. There does not appear to have been any material alteration of the status of the group before March 2017. Whilst I note, for example, Mr Patel's claim to have managed the group and that there is some evidence that Mr Patel compiled the accounts, I also bear in mind that neither he nor the applicants jointly were exclusive signatories on the bank account. Other decisions appear to have been made collectively by the group leaders or to have been put to the membership at large, including decisions on audits and approval of the accounts, whilst responsibility for activities such as the annual "golf day" and negotiations with golf clubs were shared among different members. Mr Ganatra's presence is not recorded in the majority of the minutes in evidence and, where it is, it does not suggest that his role was more than that of an ordinary member of the group. In fact, the emails of October 2015 (SKG13 and SKG15) indicate that, at that date, both Mr Patel and Mr Ganatra believed the group to be owned by its members.

39. Taken as a whole, the evidence suggests a collaborative approach to the setting up of the association in 2009 and a similar collaborative approach to its organisation since then. So far as I can tell from the evidence, the group was in 2009 and remained at least until March 2017 an unincorporated association with no contractual or other arrangements governing the relationships between its members. There is no evidence

³⁸ SKG8.

of a provision which would assign the goodwill amongst the members in a particular way and this is not a case where the members of the group operated in concert but as independent traders, where each may have acquired a discrete interest in the name and reputation of the group. The evidence does not, in my view, show that Mr Ganatra would be perceived by the relevant public as personally responsible for the club and its activities, even in 2009, or that the goodwill would devolve to his sole benefit by some other method. I find that the members of the association were the collective owners of the goodwill. As a member of the association Mr Ganatra would have had an interest in the collective goodwill and, as such, would have been entitled to bring proceedings in passing off against a third party for the protection of his proprietary interest in the collectively owned goodwill. The claim is, however, put on the basis that Mr Ganatra personally owned the goodwill of the association. As I have found that Mr Ganatra did not personally own the goodwill, and as the purported assignment to the opponent depends on his personal ownership of the goodwill, the opposition must fail.

40. However, even if Mr Ganatra had brought the claim on the basis that he owned the goodwill collectively with the other members, he was, by the relevant date, no longer a member of the association. Although there appears to have been a significant change of rules in March 2017, there is no evidence that there was a realisation or division of assets on dissolution of the group. Mr Ganatra left the group on 1 May 2017 and he was not thereafter entitled to claim rights of proprietorship in relation to the collectively owned goodwill in the “Surrey Golfers” club.³⁹ At the relevant date (5 May 2017), he was not the proprietor of an earlier right and had no standing to bring the claim.⁴⁰ The passing off claim fails.

41. In view of what I consider to be very clear findings on the opponent’s ownership of the goodwill, there is no need for me to consider whether the applicants’ claim to the goodwill would survive the application of the same law.

³⁹ See *Peter Byford v Graham Oliver, Steven Dawson (SAXON Trade Mark)*, [2003] EWHC 295 (Ch), 2003 WL 270748 and *CLUB SAIL Trade Mark*.

⁴⁰ A trade mark application may only be refused on a ground mentioned in s. 5 of the Act if the objection is brought in opposition proceedings by the proprietor of the earlier mark or right: *The Trade Marks (Relative Grounds) Order 2007*, s. 2.

Conclusion

42. The opposition has failed. Subject to appeal, the application will proceed to registration.

Costs

43. The applicants have been successful and are entitled to an award of costs. Ms Lawrence submitted that off-scale costs are appropriate, to compensate the applicants for the delays in regularising the notice of opposition and the request for cross-examination of Mr Patel. I asked Ms Lawrence to explain the detriment to the applicant and she complained of the inconsistencies in the evidence, and between the evidence and the pleadings, submitting that costs had been increased for the applicant because of the way the case has been conducted from the outset.

44. Tribunal Practice Notice (“TPN”) 4/2007 indicates that costs off the scale are available “to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour”. There was a delay of almost four months between the filing of the notice of opposition and it being served on the applicant. That is clearly not an ideal state of affairs. However, the opponent was unrepresented when it filed its first amended TM7 and it did comply with the deadline even though the resulting form was deemed inadmissible. Additional time was allowed for the second amended TM7 because Mr Ganatra had been away and because, having seen the tribunal’s letter, he wished to seek professional advice. The opponent also requested additional time during the evidence rounds, as did the applicant.

45. Having considered the conduct of proceedings, it is my view that costs off the scale are not appropriate in this instance. Whilst there has been some delay, there is no evidence that the delays were a deliberate tactic and the length of time is not such as would warrant off-scale costs without a clearer explanation from the applicant of the prejudice suffered. The evidence was not excessive, nor obviously irrelevant. There are

inconsistencies in the evidence and pleadings but I do not think that these amount to abusive behaviour on the part of the opponent, nor that they would have required excessive time to consider. As for the CMC, I consider this to be a legitimate attempt by the opponent to request cross-examination and I do not judge off-scale costs appropriate.

46. The relevant scale is contained in TPN 2/2016. I bear in mind that the evidence on both sides was relatively light. I do not consider a separate award for the CMC to be appropriate, as the issue was fairly well balanced. The main hearing itself lasted a little over an hour, which is reflected in the award. Costs are awarded to the applicants on the following basis:

Considering the notice of opposition and filing the counterstatement:	£200
Considering the other party's evidence and filing evidence:	£500
Preparing for and attending hearing:	£600
Total:	£1,300

47. I order Surrey Golfers Limited to pay Pradeep P Patel and Vijay Bhuvad the sum of **£1,300**. This sum is to be paid within two months of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of May 2020

**Heather Harrison
For the Registrar
The Comptroller-General**