

**DECISION
of the First Board of Appeal
of 30 August 2022**

In case R 2204/2021-1

Portal Golf Gestión, S.A.

Calle Serrano 20, 2. Derecha

28001 Madrid

Spain

Applicant / Appellant

represented by José Gabriel Garrido Pastor, C/Velázquez, 110, 28006 Madrid, Spain

v

Augusta National, Inc.

2604 Washington Road

Augusta, Georgia 30904

United States (of America)

Opponent / Defendant

represented by Boekx Trademarks B.V., Leidsegracht 9, 1017 NA Amsterdam, Netherlands

APPEAL relating to Opposition Proceedings No B 3 084 647 (European Union trade mark application No 17 995 602)

THE FIRST BOARD OF APPEAL

composed of G. Humphreys (Chairperson), M. Bra (Rapporteur) and C. Bartos (Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an application filed on 4 December 2018, Portal Golf Gestión, S.A. ('the applicant') sought to register the figurative mark



for the following list of goods and services as limited on 14 February 2019:

Class 9 - Recorded computer programs and computer programs [downloadable software] for golf courses management;

Class 38 - Telecommunication services; communications by optical fibre networks and by computer terminals; information about telecommunication; message sending; electronic messaging; rental of apparatus for transmitting messages, electronic transmission of orders; leasing of access time to a computer database; all the abovementioned services related with golf courses management;

Class 42 - Updating and maintenance of computer software and programs; leasing, hire and rental of computers, computer systems, computer programs and computer software; consulting services in the field of design, selection, implementation and use of computer hardware and software systems for others; creation, updating and adapting of computer programs; provision of on-line support services for computer program users; recovery of computer data; conversion of data and computer programs (other than physical conversions); rental of computer software; consultancy in the field of computers; all the above mentioned services related with golf courses management;

Class 45 - Licensing of intellectual property related with golf courses management.

- 2 The application was published on 27 February 2019.
- 3 On 27 May 2019, Augusta National, Inc. ('the opponent') filed an opposition against the registration of the published trade mark application for all the goods and services pursuant to Article 8(1)(b) and Article 8(5) EUTMR.
- 4 The opposition was based on the following earlier rights:

- a) International registration No 1 076 672

MASTERS

designating the European Union (EU), filed and registered on 27 December 2010 for goods and services in Classes 9, 12, 14, 16, 18, 21, 24, 25, 28, 29, 30, 32, 33, 38, 41 and 43;

- b) International registration No 1 076 679

MASTERS TOURNAMENT

designating the EU, filed and registered on 28 December 2010 for goods and services in Classes 9, 25, 28, 36, 38, 39, 41 and 43.

- 5 The opposition was initially based on all goods and services for which the earlier trade marks were protected. However, on 24 September 2020, the opponent limited the basis of the opposition to the following goods and services, for which it claimed reputation:

Class 9 - Computer programs and computer software for featuring instruction in golf for use in the field of golf and golf tournaments; computer game software for instructional and entertainment purposes pertaining to the game of golf and golf tournaments; video game programs pertaining to the game of golf and golf tournaments; video game programs pertaining to the game of golf and golf tournaments;

Class 38 - Broadcasting sporting events on television, radio, the internet, digital communications networks, and cable; computer-aided electronic transmission and electronic delivery of voice, data, images, and messages in the field of sports, sporting events, sports tournaments, and sports entertainment via computer networks, interactive television, and the internet;

Class 41 - Organizing and conducting golf tournaments; entertainment in the nature of golf tournaments.

- 6 On 2 March 2020, the opponent submitted evidence in support of the reputation of the earlier marks.
- Annex 4A.01: a list of Masters Tournament broadcasters taken from https://en.wikipedia.org/wiki/List_of_Masters_Tournament_broadcasters.
 - Annex 4B.01: an affidavit of the opponent's Senior Director of Business Affairs, dated 27 February 2020.
 - Annex 4B.02: email correspondence between the opponent and Sky Sports regarding the Masters Tournament viewer rates in Italy.

- Annexes 4B.03, 4B.04 and 4B.05: advertisements relating to the opponent’s tournament, namely a French advertisement on Golf+ of CanalSat (undated), a Spanish advertisement on CanalPlus.es of March 2011 and a German advertisement on Sky.de of April 2011.
- Annex 4B.06: an article entitled ‘BBC2 Masters coverage draws above-par audience’ in *The Guardian* of April 2011.
- Annex 4 C: screenshots from golf-related books and novels, namely: ‘The Masters Augusta Revisited: An Intimate View’, by Furman Fisher, Oxmoor House 1976; ‘The Masters: An Illustrated History’, by Dawson Taylor, A.S. Barnes 1981; ‘The Masters Golf Tradition’, by Dawson Taylor, McGraw-Hill Contemporary 1986; ‘Augusta: Home of the Masters Tournament’, by Steve Eubanks, Rutland Press 1997; ‘Masters Memories’, by Cal Brown, Sleeping Bear Press 1999; ‘The Masters’, by Curt Sampson, Random House 1999; ‘Shouting at Amen Corner: Dispatches from the World’s greatest Golf tournament’, by Ron Green, Sports Masters 1999; ‘Making the Masters: Bobby Jones and the Birth of America’s Greatest Golf Tournament’, by David Barrett, Skyhorse 2012; ‘2005 Masters Annual’, ‘2006 Masters Annual’ and ‘2007 Masters Annual’, by Augusta National Golf Club, John Wiley & Sons; ‘A golf story: Bobby Jones, Augusta National and the Masters Tournament’, by Charles Price and Arnold Palmer, Weider publications 2007; ‘The Masters: 101 Reasons to Love Golf’s Greatest Tournament’, by Ron Green Sr.; ‘The 1986 Masters: How Jack Nicklaus Roared Back to Win’, by John Boyette, Globe Pequot Press 2011; ‘Making the Masters: Bobby Jones and the Birth of America’s Greatest Golf Tournament’, David Barret, Skyhorse 2012; ‘The Masters Quiz Book: Sports Trivia’, by Wayne Wheelwright, AUK Authors 2013; ‘2014 Masters Tournament’, by Andy Chao, MangoSteen press 2014; ‘Augusta National & The Masters: The Life and Times’, by Frank Christian, Redbush Entertainment 2014; ‘Masters of Men: Rory McKilroy, Ken Venturi and their epic journey from Augusta to Bethesda’, by Liam Hayes, Arena Sport 2014; ‘The Magnificent Masters: Jack Nicklaus, Johnny Miller, Tom Weiskopf and the 1975 cliffhanger at Augusta’, Di Capo Press 2015; ‘Tales From Augusta’s Fairways: A Collection of the Greatest Masters Stories Ever Told’, by Jim Hawkes, Sports Publishing 2017; ‘Panic at Augusta: Death at the Masters’ (fiction), by Rick K. Hill, Createspace Independent Publishing Platform 2018; ‘The Masters: A Hole By Hole History of America’s Golf Classic’, by David Sowell, University of Nebraska Press 2019; ‘Sundays at The Masters: from Tiger to Phil’, by Tommy A. Phillips, Independent 2019.
- Annex 4D: screenshots from the Facebook page (Annex 4D.01), Instagram page (Annex 4D.02) and YouTube channel (Annex 4D.03) of the mark ‘THE MASTERS’.
- Annex 4E: screenshots, dated 17 December 2019, from the English (Annex 4E.01), Spanish (Annex 4E.02), German (Annex 4E.03), French (Annex 4E.04) and Dutch (Annex 4E.05) Wikipedia pages on the opponent’s

tournament. The pages refer to ‘Masters Tournament’, ‘The Masters’, ‘The Masters tournament’, ‘Masters de golf’ and ‘Masters Tournament’, respectively.

- Annex 4F.01: screenshots, dated 3 December 2019, from Amazon UK, showing the availability of a series of DVDs and videos entitled ‘Highlights of the [year] Masters Tournament’ for 1988-1991, 1997 and 2001-2013.
- Annex 4F.02: screenshots from (i) www.sky.com, with a page on ‘The Masters Official Films’, (ii) iTunes, with a screenshot of the ‘2018 Masters Official Film’ and (iii) www.amazon.co.uk, with a screenshot of ‘Golf: Masters – Augusta National’ referring to ‘highlights from golf’s first Major Championship of 2019, the iconic Masters Tournament held at the Augusta National Golf Club, Georgia’.
- Annex 4G: a selection of press clippings in printed and online media from four EU Member States and the United Kingdom, with partial translations (mainly of the titles of the press clippings).

For the Netherlands

- Annex 4G.01: ‘Woods extents Masters Title’, *de Volkskrant*, 16 April 2002.
- Annex 4G.02: ‘Luiten qualifies for The Masters in Augusta’, *de Volkskrant*, 15 December 2013.
- Annex 4G.03: ‘The Masters as a trendsetter’, *Golf.nl*, 4 April 2017.
- Annex 4G.04: ‘The magic golf course of Augusta National’, *Golf.nl*, 3 April 2018.
- Annex 4G.05: ‘Reed takes the lead at Masters in Augusta’, *NOS Sport*, 7 April 2018.
- Annex 4G.06: ‘US Masters: amateur Saxton did not make it by a little’, *de Volkskrant*, 11 April 2019.
- Annex 4G.07: ‘Tiger wins The Masters!’, *Golf.nl*, 14 April 2019.
- Annex 4G.08: ‘Luiten enjoys a poor start at The Masters’, *NOS Sport*, 9 April 2015.
- Annex 4G.09: ‘The flowers always bloom in Augusta’, *NOS Sport*, 9 April 2015, with a partial translation: ‘Today celebrates the first day of The Masters in Augusta, the first major of the year. Only four Dutchmen ever participated in the worlds’ most important golf tournament’.
- Annex 4G.10: ‘Spieth takes lead in Augusta’s Masters’, *de Volkskrant*, 10 April 2015.

- Annex 4G.11: ‘Youngest participant ever (14) impresses at Masters’, *de Volkskrant*, 12 April 2013.
- Annex 4G.12: ‘Luiten saves the best for last at The Masters’, *de Volkskrant*, 13 April 2014.
- Annex 4G.13: ‘Spectacular comeback: Tiger Woods wins The Masters, eleven years after his last major-win’, *de Volkskrant*, 14 April 2019.
- Annex 4G.14: an empty page.

For France

- Annex 4G.15: ‘Woods re-conquers the world of sport’, Eurosport.fr, 14 April 2019.
- Annex 4G.16: ‘The Masters rejuvenates itself’, *Le Monde*, 4 April 1999.
- Annex 4G.17: ‘Julien Guerrier, still an amateur, discovers The Masters’, *Le Monde*, 4 April 2007: ‘The Masters in Augusta: all professional golf players’ dream’.
- Annex 4G.18: ‘In Augusta, The Masters create a big void: the town of Augusta resembles Paris in August during The Masters Tournament’, *Le Monde*, 4 April 2007.
- Annex 4G.19: ‘The Masters in Augusta: “French golf should follow the same road as tennis”’, *Le Monde*, 7 April 2011.
- Annex 4G.20: ‘As a participant of The Masters, Thomas Levet realizes his ‘biggest dream’, *Le Monde*, 9 April 2003.
- Annex 4G.21: ‘Golf: the surprise victory of Bubba Watson at The Masters in Augusta’, *Le Monde*, 9 April 2012.
- Annex 4G.22: ‘Golf: Sergio García wins The Masters 2017’, *Le Monde*, 10 April 2017.
- Annex 4G.23: ‘Gay Brewer wins The Masters Tournament’, *Le Monde*, 11 April 1967.
- Annex 4G.24: ‘Golf: Masters in Augusta Sandy Lyle all of a sudden’, *Le Monde*, 12 April 1988.
- Annex 4G.25: ‘José Maria Olazabal wins The Masters in Augusta: a green jacket for the “Hidalgo”’, *Le Monde*, 12 April 1994.
- Annex 4G.26: ‘The Masters in Augusta’, *Le Monde*, 12 April 1998.

- Annex 4G.27: ‘Before attacking The Masters, Tiger Woods is more peaceful than ever’, *Le Monde*, 12 April 2002.
- Annex 4G.28: ‘The Masters in Augusta the “green jacket” for Fred Couples’, *Le Monde*, 15 April 1992.
- Annex 4G.29: ‘The left-handed players have their hands on The Masters in Augusta’, *Le Monde*, 14 April 2003.
- Annex 4G.30: ‘Paris-Roubaix, The Masters of Golf, Formula 1: the triumph of the young’, *Le Monde*, 15 April 1997.
- Annex 4G.31: ‘The Masters in Augusta the first grand slam for Scottish player Woosnam’, *Le Monde*, 16 April 1991.
- Annex 4G.32: ‘The Masters, difference above anything else’, *Le Monde*, 16 April 2002.
- Annex 4G.33: ‘Jordan Spieth wins The Masters at 21 years old’, *Le Monde*, 13 April 2015.

For Germany

- Annex 4G.34: ‘Facts surrounding the 81st masters’, *Bild*, 4 April 2017.
- Annex 4G.35: ‘Kaymer celebrates his 10th anniversary at The Masters’, *Bild*, 4 April 2017: ‘The special atmosphere at Augusta National Golf Club is always present’.
- Annex 4G.36: ‘Kaymer: “Augusta has a very special atmosphere”’, *Bild*, 4 April 2017.
- Annex 4G.37: ‘Title defender Spieth invites you to a barbecue’, *Bild*, 6 April 2016: ‘Thursday marks the start of the battle for the most famous jacket in the world of sports ... Augusta is the Mecca of Golf; comparable with Wimbledon in Tennis or the Champions league in Football’.
- Annex 4G.38: ‘Weak opening for German golfers at the Masters in Augusta’, *Bild*, 7 April 2017.
- Annex 4G.39: ‘Dear Tiger Woods’, *Bild*, 8 April 2010; ‘Tomorrow you play The Masters in Augusta, the Wimbledon of Golf’.
- Annex 4G.40: ‘The craziest Golf tournament of the year’, *Bild*, 8 April 2014: ‘It’s the most famous trophy of sports ... the most famous Golf tournament of the world’.
- Annex 4G.41: ‘The three best stories of The Masters’, *Bild*, 10 April 2016.

- Annex 4G.42: ‘Brit Danny Willet wins The Masters in Augusta’, *Bild*, 11 April 2016.
- Annex 4G.43: ‘Tiger-Comeback: Woods in Augusta stronger than ever’, *Bild*, 12 April 2010.
- Annex 4G.44: ‘Kid-caddy’s at US Masters’, *Bild*, 12 April 2014.
- Annex 4G.45: ‘Nobody Immelman wins US-Masters’, *Bild*, 14 April 2008: ‘His victory at the most important golf tournament of the year was his first big triumph this season’.
- Annex 4G.46: ‘Golf hero defeated cancer’, *Bild*, 14 April 2008: ‘Trevor Immelman won in the Cathedral of Golf in Augusta with a three stroke advantage on super star Tiger Woods’.
- Annex 4G.47: ‘Bild explains the Mythical Masters: today marks the start of the most important Golf Tournament of the world’, *Bild*, 6 April 2017: ‘The Cathedral of Golf lies in Augusta. On Thursday the hunt for the most sought-after piece of clothing starts: the legendary Green Jacket’.
- Annex 4G.48: ‘What the Masters winner are served at the Champions Dinner’, *Bild*, 12 April 2019.
- Annex 4G.49: ‘Bernhard Langer returns at the Masters’, *Bild*, 13 April 2019.
- Annex 4G.50: ‘Bild explains Germany’s most unknown sports legend’, *Bild*, 15 April 2014: ‘When Boris Becker won Wimbledon in 1985, Bernhard Langer won in the Golf Mecca that is Augusta’.
- Annex 4G.51: ‘Deceased idol helped Garcia win the Masters’, *Die Welt*, 10 April 2017.

For the United Kingdom

- Annex 4G.52: ‘Justin Rose Still loves the Masters Despite loss in playoff last year’, *The Guardian*, 1 April 2018.
- Annex 4G.53: ‘Rory McIlroy admits he ‘wouldn’t be fulfilled’ without claiming a Masters title’, *The Guardian*, 2 April 2017.
- Annex 4G.54: ‘Ramsay Matches champion’, *The Guardian*, 6 April 2007.
- Annex 4G.55: ‘Masters 2012: Fred Couples grabs share of lead with seven birdies’, *The Guardian*, 6 April 2012.
- Annex 4G.56: ‘Augusta in the spotlight: how the Masters transforms a small Georgia city’, *The Guardian*, 6 April 2017.

- Annex 4G.57: ‘How the man who trod in the new Master’s footsteps Lyle became the lion of Augusta’, *The Guardian*, 11 April 2003.
- Annex 4G.58: ‘Sergio García sets sights on the Open after Masters Triumph’, *The Guardian*, 11 April 2017: ‘Spaniard likens Augusta showpiece to the Champions League’.
- Annex 4G.59: ‘A selection of the best images from the 2008 Masters Tournament at Augusta National Golf Club’, *The Guardian*, 11 April 2008.
- Annex 4G.60: ‘BBC to retain rights to televise Masters after Sky pull out of bidding’, *The Guardian*, 8 July 2010: ‘The BBC is set to hold on to one of its most important events ...’.
- Annex 4G.61: ‘Tiger Woods and Ian Poulter bound up by more than Masters pairing’, *The Guardian*, 7 April 2018.
- Annex 4G.62: ‘Nine banned things golf fans must never do at The Masters’, *The Sun*, 9 April 2019: ‘The Masters might just be the greatest golf tournament of them all’.
- Annex 4G.63: ‘The Masters 2019: Hole by hole guide to Augusta and some memorable moments’, *The Sun*, 11 April 2019.
- Annex 4G.64: ‘The Masters: Why can’t I watch all of it on TV and live stream and what time does Sky Sports program start?’, *The Sun*, 14 April 2019: ‘The Masters is the most exclusive golf competition of the world. So exclusive, in fact, that they don’t allow the entire course to be shown on the first two days of the year’s opening Major’.

For Spain

- Annex 4G.65: an overview of links to several online articles from 2015 to 2019 relating to the opponent’s tournament on www.marca.com.
- Annex 4G.66: a page including an explanation that the website of *El País* contains a separate page containing news and articles relating to the Masters (tournament): https://elpais.com/tag/masters_augusta/a, where hundreds of articles about the tournament can be found, including a screenshot from an article on 6 April 1977.
- Annex 4G.67: an article in *Bloomberg*, dated 11 April 2019, entitled ‘How the Masters Leaves Millions on the Table’.
- Annex 4G.68: an overview of the opponent’s trade marks, including the element ‘MASTERS’ and/or ‘MASTERS TOURNAMENT’.
- Annex 4G.69: an overview from TMview of all the opponent’s registered and filed trade marks within the European Union and its Member States.

- Annex 4H: screenshots of what seemingly are apps for ‘The Masters Golf Tournament’ (Annex 4H.01) and ‘The Masters Tournament’ (Annex 4H.02).
 - Annex 4I.01: advertisements featuring ROLEX and the opponent’s earlier mark in *Le Point* of February 2012 and March 2014, April 2015, April 2016, *Le Temps* of April 2013 and *L’Equipe* of April 2016, as well as documents with regard to ROLEX campaigns between 2012 and 2016, appearing in *Le Temps*, *Le Figaro*, *L’Equipe* French newspapers, and on ‘Canal+’ and ‘Eurosport France’ television channels.
- 7 On 8 May 2020 the applicant filed its observations on the opposition, requesting that it be rejected. It submitted the following documents.
- Annex I: EUTMs that consist of the term ‘MASTER’.
 - Annex II: EUTMs that consist of the term ‘MASTERS’.
 - Annex III: EUTMs that contain the term ‘MASTER’: 100 out of 4 900 search results on 49 pages for the term ‘MASTER’.
 - Annex IV: EUTMs that contain the term ‘MASTER’: 100 out of 515 results for the term ‘MASTERS’.
 - Annex V: trade marks in the EU that consist of the term ‘MASTER’: some of the marks from 12 685 results for the term ‘MASTER’.
 - Annex VI: trade marks in the EU that consist of the term ‘MASTERS’: 261 results.
 - Annex VII: trade marks in the EU that contains the term ‘MASTER’: 29 464 results.
 - Annex VIII: trade marks in the EU that contains the term ‘MASTERS’: 2 974 results.
 - Annex IX: golf players in the EU.
 - Annex X: the EU population.
 - Annex XI: golf courses in the EU.
 - Annex XII: results of a Google search for ‘Masters in Portugal’.
 - Annex XIII: Masters in Lisbon University.
 - Annex XIV: Masters in Porto University.
 - Annex XV: results of a Google search for ‘Masters in Greece’.
 - Annex XVI: Masters in Athens University.

- Annex XVII: Masters in Crete University.
 - Annex XVIII: results of a Google search for ‘Masters in Hungary’.
 - Annex XIX: Masters in Budapest University.
 - Annex XX: a report on ‘Golf around the world’.
 - Annex XXI: Spanish trade mark No 2 159 721 ‘BB MASTER GOLF’.
 - Annex XXII: EUTM No 17 995 603.
 - Annex XXIII: Spanish trade name No 230 004 ‘GOLFSPAIN’.
 - Annex XXIV: Spanish trade mark No 2 333 686 ‘GOLFSPAIN’.
 - Annex XXV: Spanish trade mark No 2 333 687 ‘GOLFSPAIN’.
 - Annex XXVI: Spanish trade mark No 2 333 688 ‘GOLFSPAIN’.
 - Annex XXVII: Spanish trade mark No 2 333 689 ‘GOLFSPAIN’.
 - Annex XXVIII: Spanish trade mark No 2 513 815 ‘GOLFSPAIN’.
 - Annex XXIX: EUTM No 2 251 817 ‘GOLFSPAIN’.
 - Annex XXX: EUTM No 7 387 558 ‘GOLFSPAIN’.
- 8 On 8 May 2020, the applicant requested proof of use of the earlier marks. On 24 September 2020, the opponent submitted several documents as proof of use.
- 9 By decision of 22 October 2021 (‘the contested decision’), the Opposition Division refused the contested EUTM, pursuant to Article 8(5) EUTMR for all the contested goods and services. It gave, in particular, the following grounds for its decision.

Inadmissibility of the request for proof of use

- The filing date of the contested sign is 4 December 2018. Pursuant to Articles 203 and 190(2) EUTMR, the relevant date is the date of publication of the international registration, namely 27 August 2014 for international trade mark registration designating the European Union No 1 076 672 and 3 July 2014 for international trade mark registration designating the European Union No 1 076 679. Therefore, the request for proof of use is inadmissible.

Article 8(5) EUTMR

- The opposition is first examined in relation to earlier mark No 1 076 672 ‘MASTERS’.

Reputation

- The evidence of reputation is solely assessed in relation to ‘entertainment in the nature of golf tournaments’ in Class 41. The opponent was required to prove the reputation of the earlier mark on the filing date of the contested mark (i.e. 4 December 2018).
- The opponent has submitted, inter alia, evidence relating to the United Kingdom (UK) with a view to demonstrating the reputation of the earlier European Union trade marks. It follows from Article 8(5) EUTMR, worded in the present tense, that the conditions for applying it must also be fulfilled at the time of taking the decision. As the UK is no longer a member of the EU, the evidence relating to its territory cannot be taken into account to prove reputation ‘in the EU’. However, the evidence relating to the UK is not totally irrelevant in that it concerns broadcasting of the opponent’s tournament through the national channels of the UK, namely the BBC and Sky. Even though these are UK-based channels, it can be inferred that at least part of the public under analysis, such as its English-speaking part (Ireland and Malta) as well as part of golf enthusiasts have been watching the opponent’s tournament through these UK-based television channels.
- Moreover, the opponent’s evidence contains ample references to the use and recognition of the earlier mark from the perspective of the public, inter alia, in the Netherlands, France, Germany and Spain. The opponent’s tournament is one of four major championships in golf, it has been organised under the earlier mark since the 1940’s over 80 times. Its repute is recognised by the UK-based press, and by the national press in the aforementioned EU Member States, where it is referred to as ‘the world’s most important golf tournament’ (Annex 4G.09 – NOS Sport, 9 April 2015), ‘the Mecca of Golf’, ‘comparable with Wimbledon in Tennis or the Champions league in Football’ (Annex 4G.37 – Bild, 6 April 2016), ‘the Wimbledon of Golf’ (Annex 4G.39 – Bild, 8 April 2010), ‘the most important golf tournament of the year’ (Annex 4G.45 – Bild, 14 April 2008) and ‘the Cathedral of Golf’ (Annex 4G.46 – Bild, 14 April 2008).
- Therefore, it is established that the earlier trade mark has been subject to long-standing and intensive use, inter alia, as the brand name of one of the most famous golf tournaments in the world. Whilst the home of the ‘Masters’ is in the United States, the documents provided by the opponent demonstrate that the earlier mark enjoys a significant spill-over and trans-border reputation from the United States to the European Union at least for entertainment in the nature of golf tournaments.

Comparison of the signs

- The relevant territory is the European Union.

- The elements ‘MASTER’ (in plural ‘MASTERS’) may be understood throughout the European Union, referring, inter alia, to a skilled practitioner of a particular art or activity, or to a postgraduate degree, or as referring to the class of competition in some sports, such as tennis and golf, or even to an English verb, meaning ‘acquire complete knowledge or skill in’. A very significant part of the relevant public, including the public of the anglophone countries and part of the public with close equivalents, such as the Dutch-, French- and German-speaking public (‘Meester(s)’ in Dutch, ‘Maître(s)’ in French and ‘Meister(s)’ in German) will not fail to perceive these meanings, or at least one of them. These elements are, depending on the concrete concept perceived, either non-distinctive or – as their meaning is allusive – weak.
- The applicant’s argument that ‘MASTER(S)’ does not have (any) inherent distinctive character, as it does not directly refer to characteristics of the services in question, namely ‘entertainment in the nature of golf tournaments’, cannot be followed. Moreover, the earlier mark as a whole, must be considered to have at least a minimum degree of inherent distinctiveness. Therefore, the element ‘MASTER(S)’ has at least a minimum degree of inherent distinctiveness.
- Visually, the signs coincide in the letters ‘MASTER’, constituting six out of seven letters of the earlier mark, and the longest and clearly distinguishable verbal element of the contested sign, due to the contrasting colour. They differ in the additional letter ‘S’ of the earlier mark and in the verbal elements ‘i’ and ‘golf’ and the figurative element of the contested mark. In view of the weak distinctiveness of the common element ‘MASTER’, the degree of visual similarity between the signs is low.
- Aurally, the signs coincide in the sounds of the letters ‘MASTER’. They differ in the sounds of the additional letters ‘S’ of the earlier mark (if pronounced), ‘i’ and in the element ‘(.)golf’ (the dot will not necessarily be pronounced) of the contested sign. Since the sound of the additional letter ‘i’ is very short and the element ‘golf’ is non-distinctive, the signs are aurally similar at least to a below-average degree.
- Conceptually, both signs will be associated with (one of) the concept(s) conveyed by the verbal element ‘MASTER(S)’ as explained above. As the signs share a concept that is at best weak, they are conceptually similar to a low degree at best. This finding is not called into question by the possible meanings of the contested sign as a whole, since the concept of ‘master(ing)’ is equally present and unaltered by the additional meanings that could be conveyed by the verbal elements ‘i’ and ‘.golf’.

Link

- The earlier mark is reputed, and the signs are similar to some extent. The risk of injury requires that the relevant public will establish a link (association)

between the signs. In this case, both signs contain the letters (and sounds) ‘MASTER’, which renders them visually and conceptually similar to a low degree, and aurally similar at least to a below-average degree. Moreover, the earlier mark enjoys a long-standing presence on the market of golf tournaments, and recognition among the public under analysis. After the applicant’s limitation, all the contested goods and services specifically relate to golf courses management. There is a clear connection between the services for which the earlier enjoys reputation and the contested goods and services, which relate to the same sport. Therefore, the public targeted by the goods and services concerned overlaps and consists of (potential) golf enthusiasts. The section of the public that is exposed to the earlier reputed mark, which includes (potential) golf enthusiasts in Germany, France, and the Netherlands, can be safely assumed to be, to a large extent, the relevant public for the contested goods. Therefore, the relevant consumers are likely to associate it with the earlier mark (i.e. establish a mental ‘link’ between the signs).

Risk of injury

- Due to the long-standing use of the earlier mark and the similarities between the signs, it is likely that the use of the contested sign in relation to the contested goods and services will bring to mind the earlier sign. Therefore, the applicant will benefit unfairly from the earlier mark’s reputation. It is very probable that the image and the characteristics projected by the earlier mark will be transferred to the contested goods and services marketed under the contested sign, which will receive an unfair ‘boost’ as a result of being linked with the earlier reputed mark in the mind of the relevant consumers. The marketing of the contested goods and services will be facilitated by the opponent’s efforts to date. Therefore, the contested mark could exploit the earlier mark’s power of attraction and the marketing efforts made to promote it over many years and benefit from its reputation.
 - Therefore, the contested trade mark is likely to take unfair advantage of the distinctive character or the repute of the earlier trade mark.
- 10 On 22 December 2021, the applicant filed an appeal requesting that the contested decision be entirely set aside. The statement of grounds of the appeal was received on 22 February 2022 together with Annexes XXXI-XXXVII.
- 11 In its response received on 8 June 2022, the opponent requested that the appeal be dismissed.

Arguments of the parties

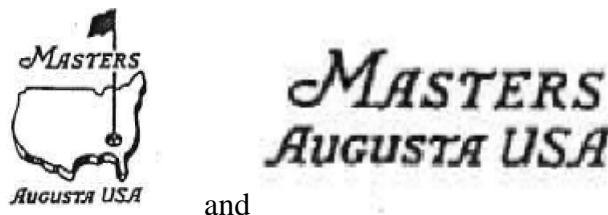
- 12 The arguments raised by the applicant in the statement of grounds of appeal may be summarised as follows.

Distinctiveness of the earlier mark

- The contested decision acknowledged that the term ‘MASTERS’ is very common (thus non-distinctive), but considered that it has at least a minimum degree of inherent distinctiveness, which seems contradictory. Moreover, it was acknowledged that “‘MASTERS’” could also be understood as referring to the highest class of competition or a competition for athletes over a specified age in some sports, such as tennis and golf’, while the earlier mark precisely distinguishes a high-class golf tournament. The trade mark is the name of the service that distinguishes.
- From the definitions provided, in particular from the *Collins Dictionary*, the term ‘MASTER(S)’ has a direct and related meaning to the kind of the opponent’s services in Class 41. When seeing the sign ‘MASTER(S)’ in ‘entertainment in the nature of golf services’, the public will understand it as referring to a competition that gathers the best golf players but will not associate it with the specific competition that takes place in Augusta, US.
- A record of navigation (reliable process accreditation) conducted on 22 February 2022 with the entity Safe Stamper (Annex XXXIIa-d), which includes various browsers in Google, for the terms ‘MASTER’, ‘MASTERS’, ‘MASTERGOLF’, ‘GOLFMASTER’, ‘MASTER GOLF’ and ‘MASTERS GOLF’, gave the following results: ‘MASTERS’, 4,280,000,000 results, the main page of which concerns higher-education courses (Masters); similarly, ‘MASTER’, 4,080,000,000 results, most of which are related to higher-education programs and courses.
- The search on ‘MASTERGOLF’ (or ‘GOLFMASTER’), returned the applicant’s website (www.centronacional.imaster.golf) as the first result, a link to a ‘Master Golf Club’ in Finland is third, a link to a golf-products shop in Andorra called Golf Master Andorra is fourth, and a game called ‘GOLF MASTER 3D’ for golf lessons is fifth. The search on ‘MASTER GOLF’, returns a link to the tournament called ‘ESTRELLA DAMM ANDALUCÍA MASTERS’ in the earliest results, a golf competition in southern Spain. Even when searching ‘MASTER GOLF’ or ‘MASTERS GOLF’, the results that refer to the opponent, only show the figurative signs.
- The result is that ‘MASTER(S)’ is a vague term widely used in the field of golf by various competitors. Its extended use does not permit this term, in itself, to identify a specific business origin. Therefore, it lacks distinctive character.
- More than 94 000 registered trade marks consist of, or contain, the terms ‘MASTER’ or ‘MASTERS’. These terms are clearly generic and incapable, by themselves, of enabling the public to distinguish the goods and services of a particular undertaking. The analysis of use of eight of the registered EUTMs is provided (Annexes I-VIII), which consist of, or contain, the term ‘MASTERS’ and are specifically used in the EU for services of Class 41: EUTMs No 11 859 635, No 18 539 413, No 1 468 230, No 2 333 524,

No 17 058 751, No 9 747 874, No 12 436 432 and No 18 324 597. Moreover, the term ‘MASTERS 1000’ is the name of a recognised tennis competition.

- Although the contested decision did not assess whether the earlier sign ‘MASTERS’ has acquired distinctiveness through its use (extrinsic distinctiveness), this argument is constant in the opponent’s observations. However, all the information and documents provided do not show use of the earlier word mark ‘MASTERS’, but of signs with additional figurative and verbal elements that alter its distinctive character. Some of them consist of internal documents. The use in the EU is not shown. As the UK is not part of the EU anymore, the proof related to this country is irrelevant. The references to ‘Masters’ are accompanied by ‘Augusta’ (Masters Augusta, The Masters in Augusta, Masters d’Augusta, Le Master d’Augusta, Das Masters in Augusta, US Masters in Augusta).
- The opponent failed to prove that the earlier mark ‘MASTERS’ has acquired distinctive character through extensive use, as the signs used significantly differ from the one relied upon in the opposition. The signs actually used by the opponent, which might have acquired distinctive character are



and

Comparison of the signs

- The contested sign, as a whole, has no element that could be considered clearly more dominant than others. Moreover, the earlier word mark ‘MASTERS’ has no dominant element. The verbal elements have a low degree of distinctiveness, as a combination of a letter and common words which are related to the goods and services, but with colours. The figurative element of a circle with different colours has a balanced impact with the verbal elements.
- According to the Office’s Guidelines and Court case-law, the mere coincidence in a generic term devoid of distinctiveness will not lead to a finding of similarity between the signs, especially if one of the signs includes other elements (verbal or figurative) that excludes the possibility of visual similarity (24/05/2012, T-169/10, Toro XL, EU:T:2012:261; 16/12/2015, T-491/13, TRIDENT PURE / PURE et al., EU:T:2015:979; 22/05/2012, T-60/11, Suisse Premium, EU:T:2012:252).
- Consequently, the multicoloured circle, the letter ‘i’ and the verbal element ‘.golf’, added to the term ‘MASTER’, which partly coincides with the term

making up the earlier sign ‘MASTERS’ (which is devoid of distinctiveness), render the signs at stake visually dissimilar.

- Aurally, the signs have different structures (one verbal element ‘MASTERS’ v three verbal elements ‘I-MASTER-GOLF’), which outweigh the partial coincidence of the verbal elements (‘MASTER’/‘MASTERS’). By analogy, the Court found a phonetic dissimilarity between the signs ‘TORRES’ and ‘TORRE MUGA’, given the different structures of the signs and the generic character of the term ‘TORRES’ in the wine sector (11/07/2006, T-247/03, Torre Muga, EU:T:2006:198). Moreover, notwithstanding the coincidence in the letters ‘ARP, the signs ‘CARPO’ and ‘HARPO Z’ were found aurally dissimilar, given their different beginnings and endings (12/10/2004, T-35/03, Carpo, EU:T:2004:295). Given their different structures, beginnings and endings, and the fact that the only near coincidence is in the verbal elements ‘MASTER’/‘MASTERS’, the signs are aurally dissimilar.
- The contested mark is composed of other verbal elements beside the term ‘MASTER’ (‘i’ and ‘golf’). The verbal elements ‘imaster golf’ have no direct meaning, and therefore the combination is fanciful. The verbal element ‘imaster’ also has no meaning. The initial letter ‘i’ could refer to ‘intelligent’, computer science (*informática* in Spanish or *informatique* in French), or as the first-person subject of a verb. The combination of ‘imaster golf’ is arbitrary, although it might refer to something related to skills in golf. Moreover, the contested mark covers goods and services related to software for golf courses, whose main purpose is to assist in the management and administration of golf courses. Therefore, given its nature, it is more likely that the term ‘master’ of the contested EUTM will evoke control over a business rather than the competition organised by the opponent.

Reputation of the earlier trade mark

- None of the evidence proves the reputation of the earlier word mark, but rather proves reputation for the signs



and



- The figurative elements, and the terms ‘AUGUSTA USA’ totally alter the distinctive character of the earlier signs. The terms ‘MASTERS’ and ‘MASTERS TOURNAMENT’ are non-distinctive. This is the reason why, in all the evidence, they are always accompanied at least by the term ‘AUGUSTA’ or a graphic depiction of the US map with a flag on Augusta,

where the competition takes place. For instance, Annex 4G.01-67 and the screenshots from various newspapers from EU Member States never display the term ‘MASTERS’ without a reference to Augusta (the US) or the US Augusta Tournament.

- Even if the opponent’s figurative marks were considered reputed, this does not imply the reputation of this trade mark can be extended to the sign ‘MASTERS’. According to recent case-law, the evidence for the reputation of a sign cannot extend to a different sign (07/07/2021, T-492/20, Leuchten, EU:T:2021:413 § 44, 45).
- None of the evidence submitted in Dutch, French, German, or Spanish has been translated into English (the language of the opposition proceedings).

Link between the trade marks at stake

- When the earlier mark is devoid of distinctive character or weak, if the reputation or similarity of the signs is not strong, it is unlikely that the prohibition laid down in Article 8(5) EUTMR will apply. Where the goods and services designated by the marks target the general public and a specialist public, the fact that members of the specialist public are necessarily part of the general public is not conclusive as to the existence of a link. The fact that a specialist public may be familiar with the earlier mark covering goods or services that target the general public is insufficient to demonstrate that the specialist public will establish a link between the marks at issue.
- The signs are dissimilar. The earlier mark is not the sign shown in the majority of the evidence submitted, and it is not a unique trade mark. The contested decision itself acknowledged that it is a very common term. Moreover, although the marks are both in the sphere of golf, their fields of application are totally unrelated, given their different end users, natures and needs covered.
- While the services ‘entertainment in the nature of golf tournaments’ in Class 41 aim to entertain the public, the goods and services for which protection is sought in Classes 9, 38, 42 and 45 are related to ‘golf courses management’ which aims to assist directors in managing and administrating their golf courses. As their purposes are totally different, their end users will also vary (i.e. golf lovers versus companies that exploit golf courses).
- No golf course manager would link software made for managing their courses with a golf competition. The goods and services are completely unrelated, although both are connected to the sport of golf. The goods and services are so dissimilar that the later mark is unlikely to create any link with the earlier mark in the mind of the consumer.
- The contested decision acknowledged that the public targeted by the contested mark consists of ‘companies that exploit golf courses’ and does not deny that the public targeted by the earlier signs consists of specialist

consumers (golf players and amateurs). Defining the relevant public and its degree of attention is one of the main factors to take into consideration when assessing the link with the earlier mark, as if the relevant public possesses a high degree of attention, it is unlikely that they would create a link in their minds. In considering whether the contested mark takes unfair advantage of the reputation of the earlier mark, the relevant public to be taken into account are the companies that exploit golf courses.

- However, when choosing expensive goods/services, consumers tend to pay a higher degree of attention and seek professional assistance. The contested goods and services are expensive (Annexes XXXIII.a-d, XXXIV.a-c, XXXV.a-e and XXXVI.a-f), as contracts between the applicant and various golf courses are sold for between EUR 1 800 and almost EUR 12 000 for a two-year license. Therefore, the relevant public will pay a higher degree of attention at the time of purchase and will be conscious that the goods and services at issue originate from different companies.
- It is possible that the target public of the contested goods and services may have encountered the reputed competition organised by the opponent. However, even if the consumers overlap, the link will not be automatic. First, the goods and services are completely unrelated (i.e. they have different end users, natures, purposes, and distribution channels, and they are neither in competition nor complementary). Moreover, given that the signs are dissimilar, the degree of distinctiveness of the earlier signs is non-existent. The opponent has not proved that the earlier signs have a reputation. The fields of application are totally separated (although they are related to golf). Finally, the relevant public for the contested mark displays a high degree of attention. Therefore, the link between the signs at stake will not be created.

On risk of injury

- The criteria set by case-law for the assessment of free-riding are not met. Since the signs are dissimilar, the earlier marks are not reputed, nor do they have distinctive character, and there will be no link in the mind of the public targeted by the contested mark. Therefore, it is impossible that the contested mark will take unfair advantage of the non-existent reputation of the earlier marks.
- When there is no link between the marks at issue, according to well established case-law, there cannot be unfair advantage (26/09/2018, T-62/16, PUMA (fig.) / PUMA (fig.) et al., EU:T:2018:604, § 21-23; 08/05/2018, T-721/16, BeyBeni (fig.) / Ray-Ban (fig.) et al., EU:T:2018:264, § 35; 18/06/2009, C-487/07, L'Oréal, EU:C:2009:229, § 41; 28/05/2020, T-677/18, GULLÓN TWINS COOKIE SANDWICH (fig.) / OREO et al., EU:T:2020:229, § 120).
- The applicant owned a Spanish national trade mark No 2 159 721, 'BB MASTER GOLF', acquired in 2002, abandoned in 2010, and given the

modern version of the name of the software, 'MASTER GOLF'. The applicant's software for managing golf courses is older than the application for the abovementioned trade mark.

- Moreover, from the evidence on file (Annex XXXIII.a-d: contracts from 2001 and 2002; Annex XXVII: a contract, dated November 1992, between Carles Beca, author of the software, and the Barberan sports centre), it is obvious that various versions of the 'MASTER GOLF' software for the management and administration of golf courses have peacefully coexisted with the family of trade marks of the opponent without any parasitism.
- The applicant took control over the software 'MASTER GOLF', around 1991 and made significant efforts to create, increase and maintain its own market share and clients (Annexes XXXV-XXXVIII). This is clear from the list of clients who installed the software 'MASTER GOLF' at their own courses since 1991 (i.e. 23 years before the date of publication of the opponent's earlier marks). It is clear that the number of clients (152 active clients before 2018; 95 active clients after 2018) did not rise exponentially after 2018 (the year of application of the contested trade mark). This also proves that the economic efforts of the applicant in advertising was completely independent of the earlier marks. Based on the evidence on file, the application for the contested mark has clearly not taken any unfair advantage of the (non-existent) reputation of the earlier marks.
- In support of its arguments, together with the statement of grounds, the applicant filed the following evidence.
 - Annex XXXI: results in eight English dictionaries for the term 'MASTER'.
 - Annex XXXII: a certificate of a SafeStamper record of navigation in Google for 'MASTER', 'MASTERS', 'MASTERGOLF', 'GOLFMMASTER', 'MASTER GOLF', and 'MASTERS GOLF'.
 - Annexes XXXIII-XXXVI: license and installation contracts for 'MASTER.GOLF' in various clients' golf courses. Parts 1-4.
 - Annex XXXVII: an installation and license contract for 'MASTER.GOLF' software in 1992.
 - Annex XXXVIII: a list of active clients of 'IMASTERGOLF'.

13 The arguments raised by the opponent in response may be summarised as follows.

Comparison of the signs and distinctiveness

- The contested decision correctly found that 'MASTER(S)' does not directly refer to characteristics of the services in question, namely 'entertainment in the nature of golf tournaments'. In a previous decision of 09/01/2020,

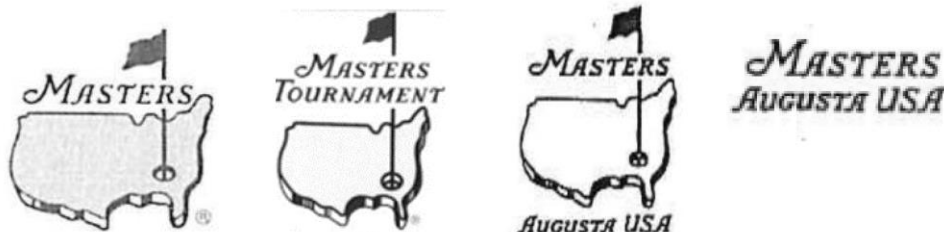
B 2 833 849, ‘MASTERS’ v ‘COURSE MASTER’, the element ‘MASTER(S)’ was also considered inherently distinctive to an average degree.

- It is not appropriate to take account of what may be a low or high degree of distinctiveness of the earlier mark as a whole when assessing the similarity of the signs.
- The applicant contends that ‘MASTERS’ is commonly used for the services at issue (i.e. ‘entertainment in the nature of golf tournaments’), referring to some results of Google searches with various terms that include the element ‘MASTER(S)’ and/or ‘GOLF’. The very few examples given by the applicant are either irrelevant or insufficient to substantiate this argument. The mere existence of marks that consist of the term ‘MASTER’ or ‘MASTERS’ is irrelevant. The applicant has not provided any evidence that these third parties’ marks are actually used. The applicant subsequently analyses eight of the registered EUTMs included in its Annexes I-VIII. These examples do not demonstrate that ‘the term “MASTERS” is devoid of distinctive character for the services protected in Classes 9, 38 and 41, in particular for “entertainment in the nature of golf tournaments”’. None of the examples has any relation or connection to the sport of golf. Five of the marks cited as examples were filed after the relevant filing/notification date of the ‘MASTERS’ mark and therefore do not allow any conclusion regarding the perception of the mark by the public at the relevant time.
- Besides having inherent distinctiveness to an average – but at least minimum – degree, the ‘MASTERS’ mark has acquired distinctiveness and a strong reputation within the European Union (and abroad) for ‘entertainment in the nature of golf tournaments’.
- Although some of the examples of use include additional descriptive terms (e.g. ‘US’ and ‘Augusta’) and/or figurative elements, they all include the ‘MASTERS’ mark. Many examples concern the use of ‘MASTERS’ as a word mark.
- It follows that distinctive character may also be acquired in consequence of the use of the mark as part of another registered trade mark (07/07/2005, C-353/03, Have a break, EU:C:2005:432). There is no requirement for a mark to be used independently in order for it to obtain a sufficient level of distinctive character to be registered as a trade mark. Distinctiveness may be acquired where the mark applied for is part of a larger, composite mark. This means that, contrary to the applicant’s argument, the use of the sign ‘MASTERS’ as part of, inter alia, the following registered marks can also be taken into account to assess the acquired distinctiveness and/or repute of the

‘MASTERS’

word

mark.

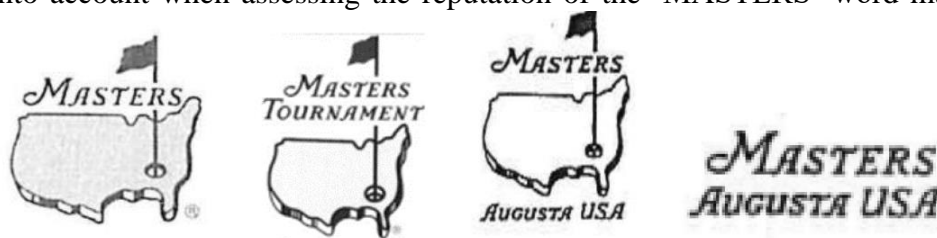


- Contrary to the applicant’s view, the figurative element of the contested application is limited to a simple circle with an outline in several colours. This simple geometrical shape of a rather decorative nature will hardly have any impact on the relevant public. Therefore, the public will pay more attention to the mark’s verbal elements. Furthermore, in general, when verbal elements are similar, and the figurative element has neither a semantic meaning nor striking stylisation, the signs are usually assessed as being similar (23/11/2011, T-483/10, Pukka, EU:T:2011:692).
- Contrary to the applicant’s view, the contested decision did not accept that the relevant public has a high degree of attention. Instead, it correctly held that ‘... looking at the connection between the relevant goods and services, it is important to highlight that under the auspices of Article 8(5) EUTMR, the similarity of the goods and services is not strictly speaking determinant, since it is the association that may be made in the mind of the relevant public whilst weighing in the factors mentioned above’. Moreover, the greater part of this relevant public of millions of ‘sports fans, in particular golf enthusiasts and potential golf enthusiasts’ consists of the public at large, who are assumed to have a low to normal degree of attention rather than a high degree.
- The figurative element of the contested mark is a simple circle, which will hardly have any impact on the relevant public. The public will pay more attention to the mark’s verbal elements. The letter/prefix ‘i’ can mean ‘intelligent’ or refer to information technology (17/10/2018, T-822/17, iGrill, EU:T:2018:693). It is purely descriptive, since the contested mark covers goods and services related to information technology (computers, software and related services). Moreover, the element ‘golf’ is non-distinctive, as the goods and services specifically relate to this sport. In this case, the initial letter ‘i’ is depicted as a light green lower-case letter and has a specific meaning that refers to the nature, or functionalities, of the goods and services, which may, for example, have internet connectivity or be rendered electronically. Therefore, it hardly impacts the aural similarity between the signs.
- The element ‘MASTERS’ has a known relevance and connection to golf. The ‘MASTERS’ mark is associated and/or linked by a substantial part of the relevant public to the world-famous golf tournament organised by the opponent. Since the contested application includes the element ‘GOLF’, this will add to the conceptual similarity of the marks, taking into account the

strong reputation of the ‘MASTERS’ trade mark within the field of golf sports. The signs have at least an average degree of conceptual similarity.

Reputation

- It is established case law that a mark may also acquire a reputation as a result of its use in a different form. This means that the use of ‘MASTERS’ as part of, inter alia, the following registered ‘MASTERS’ marks can also be taken into account when assessing the reputation of the ‘MASTERS’ word mark.



- Clearly, the word ‘MASTERS’ occupies a central position in all the above trade marks and, therefore, plays both a distinct and predominant role.
- Furthermore, the evidence also includes many examples of use of the word mark ‘MASTERS’. Since the earlier mark is a word mark, it also covers all stylised forms, in accordance with established case-law.
- The applicant’s claim that the evidence in Dutch, French, German and Spanish should be disregarded, as it was not translated into English, is unfounded. Pursuant to Article 24 EUTMIR, the opponent has no obligation to submit the translation on its own motion, unless it is requested to do so by the Office, which was not the case here.
- The evidence itself demonstrates abundant use of the ‘MASTERS’ trade mark in all kinds of golf-related publications also produced for those who do not speak Dutch, French, German or Spanish. All titles and citations of all printed and online media evidence were translated into English.

Link between the signs

- There is a clear connection between the opponent’s services for which the earlier mark enjoys reputation and the contested goods and services. Since they relate to the same sport, the relevant public overlaps in that it consists of (potential) golf enthusiasts. When encountering the contested mark, the relevant consumers are likely to associate it with the earlier mark, that is to say, establish a mental ‘link’ between the signs.
- The contested goods and services are used by golf players (i.e. everyday consumers of golf related goods and services). Notwithstanding the limitation for all goods and services to ‘golf courses management’, the specification still refers to a broad category of goods and services that target both everyday consumers (e.g. golf players) and those working in the golf club industry

professionally. Therefore, the relevant consumers may consist of both the public at large (including television viewers, who do not play golf) and golf professionals (operators of golf clubs and golf courses, and businesses involved in the field of golf clothing and equipment).

Unfair advantage taken of the distinctive character or the repute of the earlier marks

- All the applicant’s arguments are clearly unfounded for various reasons: the alleged coexistence does not relate to the contested sign, but to a Spanish trademark No 2 159 721, which was abandoned in 2010 (i.e. before the earlier EUTM ‘MASTERS’ was registered in the EU). The opponent was not aware of this abandoned mark, nor of the alleged use of the unregistered sign ‘MASTER GOLF’ by the applicant (or its legal predecessors) in Spain, until the present proceedings. It has never knowingly tolerated the registration and/or alleged use of this abandoned mark, nor the alleged use of the unregistered sign ‘MASTER GOLF’ in Spain or elsewhere. If the earlier trade mark is an EUTM, the applicant must show coexistence in the entire EU. No such proof was submitted by the applicant either for Spain or for the rest of the EU Member States. For these reasons alone, the applicant’s claims should be rejected.

The applicant’s request

- In the operative part of its appeal observations on page 55, the applicant requests that ‘... the appeal should be upheld and European trade mark application num. 17.995.602 ... should be granted for the goods and services applied for in International Classes 8, 38, 32 and 45 [*sic*]’. However, the contested mark was not filed for Classes 8 and 32, and the applicant does not request the contested mark be allowed for the goods and services in Classes 9 and 42 of the application. Therefore, the appeal should be rejected with regard to these goods and services.

Reasons

- 14 All references made in this decision should be seen as references to the EUTMR (EU) No 2017/1001 (OJ 2017 L 154, p. 1), codifying Regulation (EC) No 207/2009 as amended, unless specifically stated otherwise in this decision.
- 15 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.

Admissibility of new evidence

- 16 The applicant submitted, together with the statement of grounds of the appeal, eight new pieces of evidence (Annexes XXXI-XXXVIII).

- 17 Pursuant to Article 95(2) EUTMR, which is applicable in the present appeal proceedings, the Office may disregard facts or evidence which are not submitted in due time by the parties concerned. That provision grants the Board discretion to decide, while giving reasons for its decision, whether or not to take into account facts and evidence submitted out of time (13/03/2007, C-29/05 P, ARCOL / CAPOL, EU:C:2007:162, § 43).
- 18 In accordance with settled case-law (13/03/2007, C-29/05 P, ARCOL / CAPOL, EU:C:2007:162, § 44; 11/12/2014, T-235/12, Grass in bottle (other), EU:T:2014:1058, § 62 and the case-law cited therein), which is now enshrined in Article 27(4) EUTMDR, the Board of Appeal may accept facts or evidence submitted for the first time before it only where (a) those facts or evidence are on the face of it, likely to be relevant for the outcome of the case and (b) they have not been produced in due time for valid reasons, in particular where they are merely supplementing relevant facts and evidence which had already been submitted in due time, or are filed to contest findings made or examined by the first instance of its own motion in the decision subject to appeal.
- 19 The evidence submitted as Annex XXXI (definitions from eight English dictionaries of the term ‘MASTER’) concerns well-known facts. Annex XXXII contains a certificate of SafeStamper record of navigation in Google for ‘MASTER’, ‘MASTERS’, ‘MASTERGOLF’, ‘GOLFMASTER’, ‘MASTER GOLF’, ‘MASTERS GOLF’, and supports the applicant’s previous arguments. The Board deems it appropriate to admit these documents.
- 20 The remaining pieces of evidence (Annexes XXXIII-XXXVIII) contain license and installation contracts of ‘MASTER.GOLF’ at different clients’ golf courses as well as the list of active clients of ‘imaster golf’. They also support arguments previously made in the opposition proceedings, where the applicant claimed that the relevant public of the conflicting marks differs and that the mark applied for would not take unfair advantage of the repute of the earlier marks. The Board will preliminarily admit these documents and further expand on their relevance in the following assessment on substance.

Scope of the appeal – clerical error

- 21 The opponent claims that the appeal should be rejected with regard to the goods and services in Classes 9 and 42, stressing that in the operative part of its observations the applicant requests that ‘... the appeal should be upheld and European trade mark application num. 17.995.602 ... should be granted for the goods and services applied for in International Classes 8, 38, 32 and 45 [*sic*]’.
- 22 However, the contested EUTM was not filed for Classes 8 and 32. Consequently, the request to maintain the mark in these classes makes no sense. Therefore, it is clear that Classes 8 and 32 were mentioned in the operative part because of a simple clerical error.

- 23 However, the goods and services in Classes 9 and 42 are mentioned consistently throughout the statement of grounds and the applicant's observations. Therefore, it is clear from the appeal and the statement of grounds that the applicant requests that the opposition be rejected in its entirety. This includes the rejection of goods and services in Classes 9 and 42.

Article 8(5) EUTMR

- 24 Under Article 8(5) EUTMR, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for is not to be registered 'where it is identical with, or similar to, the earlier trade mark and is to be registered for goods or service which are not similar to those for which the earlier trade mark is registered, where in the case of an earlier trade mark the trade mark has a reputation in the Community and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.
- 25 It is clear from the wording of Article 8(5) EUTMR that its application is subject to the following conditions: (i) the marks at issue must be identical or similar; (ii) the earlier mark cited in opposition must have a reputation; and (iii) there must be a risk that the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark. Those conditions are cumulative, and failure to satisfy one of them is sufficient to render that provision inapplicable (22/03/2007, T-215/03, Vips, EU:T:2007:93, § 34, 35; 11/07/2007, T-150/04, Tosca Blu, EU:T:2007:214, § 54-55).

Reputation of the earlier marks

- 26 According to the case-law of the Court of Justice, reputation is a knowledge threshold requirement. This implies that it must be principally assessed on the basis of quantitative criteria. In order to satisfy the requirement of reputation, the earlier mark must be known by a significant part of the target public for the goods or services covered by that trade mark (14/09/1999, C-375/97, Chevy, EU:C:1999:408, § 22-23; 25/05/2005, T-67/04, Spa-Finders, EU:T:2005:179, § 34). The requirement of reputation implies a certain degree of knowledge of the earlier trade mark among the public. It is only where there is a sufficient degree of knowledge of that mark that the public, when encountering the later trade mark, may possibly make an association between the two trade marks and that the earlier mark may consequently be damaged (14/09/1999, C-375/97, Chevy, EU:C:1999:408, § 23).
- 27 The contested decision analysed and confirmed the reputation of the earlier mark 'MASTERS' within the European Union. The applicant disagrees with this finding. It contests the use of the mark, arguing that it did not take place within the EU because it was related to the US and broadcast in the UK, which is no longer a part of the EU. It argues further that the word mark 'MASTERS' was not

used as such but always accompanied by the verbal element ‘AUGUSTA’ and often by a figurative element, and emphasises that this changes the distinctive character of the mark. Finally, the applicant contests the admissibility of the items of evidence that are not in English (the language of the proceedings).

- 28 Regarding the applicant’s first argument, the Opposition Division concluded that whilst the home of the ‘Masters’ tournament is in the US, the documents provided by the opponent demonstrate that the earlier mark enjoys a significant spillover and trans-border reputation from the US to the EU at least for ‘entertainment in the nature of golf tournaments’. The Board notes that the Opposition Division acknowledged the reputation mainly on the basis of the evidence provided for the UK. However, the contested decision is based on the convincing reasoning that broadcasting by UK-based channels (BBC and Sky) will be received at least by part of the public under analysis, such as that in the English-speaking part of the EU (Ireland and Malta) as well as by golf enthusiasts who have become used to watching the opponent’s tournament through these UK-based television channels over the years.
- 29 By the same token it can be assumed that the more than 20 books dedicated to the ‘MASTERS’ tournament quoted by the opponent from 1976 to 2019 (Annex 4C) and the DVDs and videos, entitled ‘Highlights of the [year] Masters Tournament’, submitted for 1988-1991, 1997 and 2001-2013 (the availability of which in 2019 was proved by screenshots dated 3 March 2019 from Amazon UK – Annex 4F.01) were also viewed by the public in the English-speaking part of the EU (Ireland and Malta) as well as by English-speaking golf enthusiasts in other EU countries, as they can easily be ordered from any country within the EU.
- 30 Moreover, and most importantly, the evidence submitted by the opponent proves the reputation of the earlier mark – in the sense of a required threshold of knowledge among the relevant public – in several countries of the EU, for example in France, Germany, Italy and the Netherlands.
- 31 In the affidavit by the opponent’s Senior Director of Business Affairs, Ms Casey Coffmann, dated 27 February 2020 and submitted as Annex 4B.01 viewer ratings are specified for Germany (broadcast by SKY DEUTSCHLAND) in 2014-2019 (both for Live Broadcast and for streaming on Sky Go) and for Italy in 2014-2018 and 2019. Without a need to disclose these numbers in detail, the Board notes that they are considerable and, most importantly, stable over the years, with a peak in 2019, not far from the date of the application of the contested EUTM.
- 32 Although this data is provided by an employee of the opponent, it is supported by information originating from third parties and independent sources. For Italy, the opponent provided correspondence coming directly from SKY Italy and confirming the numbers indicated in the affidavit (Annex 4B.02).
- 33 For Germany, the opponent submitted further voluminous evidence consisting of press articles related to the ‘MASTERS’ tournament (Annex 4G.34-51) from 2010 to 2019, which proves the constant interest of the public. Similar evidence consisting of press articles from 1991 to 2019 was submitted for the Netherlands

(Annexes 4G.01-13) and for France (Annexes 4G.15-33). Furthermore, with regard to France, the evidence submitted as Annex 4I.01 contains advertisements featuring 'ROLEX' and the trade mark 'MASTERS' in *Le Point* of February 2012, March 2014, April 2015 and April 2016, *Le Temps* of April 2013 and *L'Equipe* of April 2016. It also contains documents regarding 'ROLEX' campaigns in 2012-2016 appearing in *Le Temps*, *Le Figaro*, and *L'Equipe* (French newspapers) and on the 'Canal+' and 'Eurosport France' television channels.

- 34 These documents refer to the 'Masters' as 'the world's most important golf tournament' (Annex 4G.09), 'the Mythical Masters: today marks the start of the most important Golf Tournament of the world' (*Bild*, 6 April 2017, Annex 4G.47), as 'The craziest Golf tournament of the year', *Bild*, 8 April 2014 (Annex 4G.40) or as the 'biggest dream' of the players ('as a participant of The Masters, Thomas Levet realizes his "biggest dream"', *Le Monde*, 9 April 2003, Annex 4G.20) and put the tournament among other sports events of worldwide importance ('Paris-Roubaix, The Masters of Golf, Formula 1: the triumph of the young', *Le Monde*, 15 April 1997, Annex 4G.30).
- 35 The press articles from France, Germany and the Netherlands show that the mark is very often used alone and the tournament is referred to as 'MASTERS', 'das MASTERS' and 'le Masters' without the addition of the word 'Augusta'. This is already apparent from the titles of the Dutch articles: 'Woods extents Masters Title', *de Volkskrant*, 16 April 2002 (Annex 4G.01); 'The Masters as a trendsetter', *Golf.nl*, 4 April 2017 (Annex 4G.03); 'Tiger wins The Masters!', *Golf.nl*, 14 April 2019 (Annex 4G.07); 'Luiten enjoys a poor start at The Masters', *NOS Sport*, 9 April 2015 and of the German articles entitled 'Kaymer celebrates his 10th anniversary at The Masters'; *Bild*, 4 April 2017 (Annexes 4G.35 and 40) or 'The three best stories of The Masters', *Bild*, 10 April 2016, (Annex 4G.41), which mention 'das MASTERS'. The same is apparent from the press articles submitted for France: 'Sergio Garcia wins The Masters 2017', *Le Monde*, 10 April 2017 (Annex 4G.22), 'Before attacking The Masters, Tiger Woods is more peaceful than ever', *Le Monde*, 12 April 2002 (Annex 4G.27), 'The Masters, difference above anything else', *Le Monde*, 16 April 2002 (Annex 4G.32) and 'Jordan Spieth wins The Masters at 21 years old', *Le Monde*, 13 April 2015 (Annex 4G.33), which mention 'le MASTERS'. Furthermore, the evidence submitted as Annex 4I.01 contains further French articles, like 'McIlroy defie Wood au Masters', *Le Figaro-Homepage*, undated (p. 568 of the BoA file).
- 36 In light of these documents, the applicant's second core argument that the mark is only used as a part of a figurative mark, or accompanied by the word 'AUGUSTA', is simply not accurate. These articles, with different dates over the 30 years preceding the application for the contested mark and related to different EU countries, show the earlier mark 'MASTERS' used as a stand-alone term without any additional (figurative or verbal) elements. The applicant's argument that the evidence for a sign's reputation cannot extend to a different sign is therefore not pertinent.

37 Finally, the applicant refers to a lack of translations of the evidence for the earlier mark's reputation. However, the earlier mark was visible in these documents, despite the use of different languages. The titles of all the documents were translated into the language of the proceedings. The applicant did not request a translation. Furthermore, it is clear from the statement of grounds of appeal, which contains a detailed analysis of almost every piece of evidence submitted by the opponent, that the lack of a translation did not prohibit the applicant from understanding the content of these documents.

38 The findings of the contested decision can be therefore endorsed.

Comparison of the marks

39 Regarding the similarity of the conflicting marks, the infringements referred to in Article 8(5) EUTMR, where they occur, are the consequence of a certain degree of similarity between the trade marks in conflict, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though they do not confuse them (23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 29 et seq.).

40 If there is some similarity, even faint, between the marks, a global assessment must be carried out to ascertain whether, notwithstanding the low degree of similarity, other relevant factors such as the reputation or recognition enjoyed by the earlier mark serve to establish a link between the marks (24/03/2011, C-552/09 P, TiMiKinderjoghurt, EU:C:2011:177, § 53, 66).

41 The signs to be compared are:

<p style="text-align: center;">MASTERS</p> <p style="text-align: center;">MASTERS TOURNAMENT</p>	
<p style="text-align: center;"><i>Earlier marks</i></p>	<p style="text-align: center;"><i>Contested sign</i></p>

- 42 The comparison of the signs will begin with the earlier trade mark ‘MASTERS’, which is an international registration designating the EU. The relevant territory for the comparison is therefore the whole EU.
- 43 Whereas the earlier trade mark is a word mark and consists of one word ‘MASTERS’, the contested sign contains the verbal elements ‘i’, ‘master’ and ‘golf’, the last two separated by a dot. It also contains a figurative element of a ring of various colours placed above the verbal element.
- 44 Visually, the verbal element ‘master’ of the contested sign reproduces six out of seven letters of the earlier mark ‘MASTERS’. This is particularly noticeable because the verbal element ‘master’ is written in black, whereas the elements ‘i’ and ‘golf’ are depicted in green; the use of a different colour catches the attention. Therefore, despite the additional verbal elements and the figurative element in the contested sign, the fact that the central element ‘master’ largely corresponds to the earlier mark will not be overlooked and leads to a visual similarity.
- 45 Phonetically, only the verbal element of the contested sign will be pronounced: ‘i-mas-ter-golf’. The syllables ‘mas-ter’ will be pronounced – according to the rules of the relevant language – in a highly similar way to the earlier mark ‘mas-sters’, with a difference in the ending ‘-s’. In some languages of the EU, like French, this ending will not be pronounced, so the middle syllables of the contested sign and the earlier mark will be perceived identically. Although the relevant public will not ignore the additional first and last syllables of the contested sign, the identity, or at least high degree of similarity, of the pronunciation of the element ‘master’ and of the earlier mark will lead to a phonetic similarity.
- 46 Conceptually, the earlier trade mark can be understood as the plural form of the word ‘master’. This word will be understood by the non-English-speaking public due to its common usage (e.g. in connection with higher education). The public will understand the element ‘master’ in the contested sign as a singular form of the same word. This leads to a conceptual similarity, which will not be excluded by the concepts related to the other elements of the contested sign: ‘i’ and ‘golf’. The letter ‘i’ at the beginning of a word will be understood by the relevant consumers as meaning ‘intelligent’ or ‘information’ and as a general reference to the internet (03/12/2015, T-105/14, iDrive / IDRIVE, EU:T:2015:924, § 75; 16/12/2010, T-161/09, ilink, EU:T:2010:532, § 30; 17/10/2018, T-822/17, iGrill, EU:T:2018:693, § 25). The element ‘golf’ has an understandable meaning. The concept that may be attributed to the letter ‘i’ and the meaning of the word ‘golf’ are related to the majority of the contested goods and services. All of them have a direct relation to golf (‘for golf courses management’). The majority of them are either computer programs and related services (of maintenance, leasing, rental, etc.) or telecommunication services / electronic transmission of messages. Therefore, the concepts related to these verbal elements will not distract the consumers’ attention from the identical concept of the elements ‘master’ and ‘masters’.

- 47 The applicant contests any similarity between the marks. It argues that the words ‘master’ and ‘masters’ are non-distinctive for the relevant goods and services, that there are several registered marks containing these words, and that these terms are commonly used in connection with sports competitions, including golf. Furthermore, the applicant emphasises that although the Opposition Division recognised that the term ‘MASTERS’ is very common (that is non-distinctive), it then stated that it has at least a minimum degree of inherent distinctiveness, which the applicant considers a contradiction.
- 48 Indeed, the reasoning of the contested opposition decision seems to require interpretation when it states that ‘in the Opposition Division’s view, these elements are, depending on the concrete concept perceived, either non-distinctive or – as their meaning is allusive – weak’ and that ‘the Opposition Division disagrees with the applicant’s argument that “MASTER(S)” does not have (any) inherent distinctive character, as it does not directly refer to characteristics of the services in question, namely entertainment in the nature of golf tournaments’.
- 49 The word ‘masters’ has some laudatory connotations derived from the meaning of the noun ‘a master’ and the verb ‘to master’, which reduces its distinctiveness. Nevertheless, the context in which the conflicting trade mark may be encountered on the market has to be taken into account. In the present case, this context is related to golf. Within this context, the public has no reason to relate the term to study programs mentioned in the Annexes XII-XIX submitted by the opponent before the Opposition Division (‘Masters in Portugal’, ‘Masters in Lisbon University’, ‘Masters in Porto University’, ‘Masters in Greece’, ‘Masters in Athens University’, ‘Masters in Crete University’, ‘Masters in Hungary’, ‘Masters in Budapest University’). The fact that master studies are offered does not have a direct descriptive connotation for golf tournaments.
- 50 Even if it can be argued that, in order to participate in any tournament, it is necessary to ‘master’ the relevant field, this fact does not totally exclude the distinctiveness of the earlier mark. In the context of golf, the relevant public will associate the term ‘MASTERS’ with the tournament organised by the opponent based on the long-standing reputation of this tournament. The applicant did not prove that a golf tournament is typically called ‘masters’, but only mentions ‘ESTRELLA DAMM ANDALUCÍA MASTERS’, a golf competition in southern Spain, without any further information about its importance.
- 51 In the statement of grounds of the appeal, the applicant explicitly acknowledges that it is aware that the application of the absolute ground pursuant to Article 7(1)(b) or (c) EUTMR regarding the earlier sign ‘MASTERS’ is not under discussion in the present proceedings. Nevertheless, the whole argument of the applicant advocating the dissimilarity of the signs is based on an allegation of lack of distinctive character and would result in denying any protection of the earlier mark.
- 52 Contrary to the applicant’s argument, a weak degree of distinctive character does not automatically exclude a similarity between the signs. The trade marks must be

compared in their entirety. In the present case, the remaining elements of the contested sign are even weaker than the element ‘masters’. This applies to the verbal element ‘golf’, as all the goods and services are related to golf, according to the express wording of the list after the limitation by the applicant. The element ‘i’ placed at the beginning is commonly used to designate electronic appliances and software. The figurative element of the mark is decorative. The remaining elements of the contested sign are too weak to differentiate the mark to such an extent as to entirely exclude a similarity between them.

- 53 In this respect, the case-law to which the applicant refers (24/05/2012, T-169/10, Toro XL, EU:T:2012:261; 16/12/2015, T-491/13, TRIDENT PURE / PURE et al., EU:T:2015:979; 22/05/2012, T-60/11, Suisse Premium, EU:T:2012:252) concerns the impact of weak elements of the trade mark in the context of the likelihood of confusion. In the comparison of the signs for the purposes of Article 8(5) EUTMR, a lesser degree of similarity might be sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them. If there is some similarity, even faint, between the marks, an examination of the provision of Article 8(5) EUTMR must be carried out to ascertain whether, notwithstanding the low degree of similarity, other relevant factors such as the reputation or recognition enjoyed by the earlier mark serve to establish a link between the marks. For the same reasons, the judgments referred to by the applicant (11/07/2006, T-247/03, Torre Muga, EU:T:2006:198; 12/10/2004, T-35/03, Carpo, EU:T:2004:295) are irrelevant to the present case.
- 54 Since a similarity between the marks was confirmed, it must be assessed whether this similarity will cause the relevant public to establish a link (or association) between them. The fact that for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the latter mark calls the earlier reputed mark to mind is tantamount to the existence of such a link (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 63).
- 55 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case. These factors include: the degree of similarity between the conflicting marks; the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services; the relevant section of the public; the strength of the earlier mark’s reputation; the degree of the earlier mark’s distinctive character, whether inherent or acquired through use; and the likelihood of confusion on the part of the public (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 41).
- 56 In the present case, a combination of several factors will cause the public to make the link. First, the trade marks are similar in the way that the earlier mark is almost entirely reproduced in the contested sign (i.e. in six out of seven letters) and followed by the verbal element ‘GOLF’, which is non-distinctive for the goods and services related to golf. Second, the earlier mark is reputed for the organisation of golf tournaments. Third, the contested goods and services have a

direct relation to golf ('for golf courses management') as expressly stated in the list of goods and services. Therefore, the contested sign will, in the context of the contested goods and services, bring the earlier reputed mark to mind for the relevant consumer. The relevant public will establish a link between the marks.

- 57 Since a similarity which allows the relevant public to make the link between the contested sign and the earlier trade mark 'MASTERS' was confirmed, the examination of the opposition based on this mark will continue.

Risk of injury

- 58 Although the proprietor of the earlier trade mark is not required to demonstrate actual injury to its mark for the purposes of Article 8(5) EUTMR, it must prove that there is a serious risk that such an injury will occur in the future (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 38).
- 59 This condition for applying Article 8(5) EUTMR refers to three separate types of risk, namely that the use without due cause of the mark applied for is detrimental to the earlier mark's distinctive character, is detrimental to the earlier mark's reputation, or takes unfair advantage of the earlier mark's distinctive character or reputation. The first type of risk referred to in this provision occurs where the earlier mark is no longer capable of creating an immediate association with the goods or services for which it is registered and used. It refers to the dilution of the earlier mark through the dispersion of its identity and its hold upon the public mind. The second type of risk referred to occurs where the goods or services covered by the mark applied for may be perceived by the public in such a way that the earlier mark's power of attraction is diminished. The third type of risk referred to is the risk that the image of the reputed mark or the characteristics it projects are transferred to the goods covered by the mark applied for, with the result that the marketing of those goods may be made easier by the association with the reputed earlier mark. Nonetheless, in none of those situations is the existence of a likelihood of confusion between the marks at issue required, since the relevant public simply has to be able to establish a link between them and does not necessarily have to confuse them (29/03/2012, T-417/09, Mercator Studios, EU:T:2012:174 § 40; 22/03/2007, T-215/03, Vips, EU:T:2007:93, § 36-42).
- 60 The applicant's main argument is that when there is no link between the marks at stake, 'the case-law is clear to set down that there cannot be unfair advantage'. However, in the present case, the link between the marks in the mind of the public was confirmed. Therefore, the case-law referred to by the applicant is not applicable.
- 61 The three types of risk mentioned in Article 8(5) EUTMR are separate, so the finding of one is sufficient for the provision to apply. The assessment of the risk of injury is a result of a multi-factor examination. These factors influence each other and must be taken into account in combination. In the present case, the use of the contested mark takes unfair advantage of the distinctive character of the earlier marks as a result of several factors.

- 62 The relevant public, consisting of golf players and golf enthusiasts, will associate the sign ‘MASTERS’ with the most important golf competition globally. The higher the reputation of the earlier mark, the more interest the public will give to the mark associated with that reputation. In the present case, there is a high probability that the image and the characteristics that the earlier mark projects will be transferred to the contested sign and will raise interest in the contested goods and services marketed under the contested sign. This will give the goods marketed under the contested sign an advantage, as they will attract the attention of the public from among all of the possible trade marks for the contested goods and services, bringing to mind the earlier trade mark. In this way, the contested sign will receive an unfair ‘boost’ as a result of being linked to the opponent’s reputed mark in the minds of the relevant consumers. However, this attention would not be due to the applicant’s own efforts but rather to the earlier mark’s power of attraction and the opponent’s marketing efforts to promote it over many years.
- 63 The applicant’s arguments cannot cast doubt on this finding. The argument that there will be no overlap between the relevant public of the earlier mark and that of the contested sign is not convincing. The applicant insists on the professional character of the public to which the contested goods and services are addressed. However, the reputation of the earlier trade mark also extends to (or even attracts in the first place) the public who deal with golf professionally, for example to those involved in the management of golf courses. There is therefore an overlap in the relevant public.
- 64 The goods and services covered by the contested sign are expensive (Annexes XXXIII-XXXVII), and therefore the relevant public will pay a higher degree of attention at the time of its purchase. This argument is related to the possible exclusion of confusion between the marks. It could be relevant for the assessment of the likelihood of confusion pursuant to Article 8(1)(b) EUTMR but does not exclude the application of Article 8(5) EUTMR. Even an attentive public can establish a link between the marks without confusing them. The protection under Article 8(5) EUTMR does not require the existence of a likelihood of confusion (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 58).
- 65 Moreover, the coexistence between the earlier mark and the Spanish trade mark ‘BB MASTER GOLF’ claimed by the applicant is irrelevant to the present case. However, the opponent disputed this coexistence, and the applicant admits that the Spanish trade mark was abandoned in 2010, long before the application for the contested sign. Furthermore, even if confirmed, this coexistence would only concern the territory of Spain, whereas the earlier trade mark is protected throughout the EU.
- 66 Finally, the argument that the number of the applicant’s clients did not rise exponentially after 2018 (the year of application for the contested trade mark) is not conclusive. There may be various reasons – including managerial and economic ones – for the loss of clients declared by the applicant. It has been established that through the association with the earlier mark the contested sign

will catch the public's attention. Therefore, it may give the contested goods and services a certain 'boost' in the sense of an increased interest. Whether this interest leads to a purchase or the conclusion of a contract depends on numerous further circumstances. Therefore, the fact that no more contracts were concluded after the application for the EUTM than before this date does not mean that such a boost in public interest of the public can be excluded.

- 67 The opposition is successful pursuant to Article 8(5) EUTMR and based on the earlier trade mark 'MASTERS'. The appeal must be dismissed.

Costs

- 68 Pursuant to Article 109(1) EUTMR and Article 18 EUTMIR, the applicant, as the losing party, must bear the opponent's costs of appeal proceedings. These consist of the opponent's costs of professional representation of EUR 550.
- 69 As to the opposition proceedings, the Opposition Division ordered the applicant to bear the opponent's representation costs. This decision remains unaffected. The costs of the representation were fixed at EUR 300. The opposition fee paid by the opponent was EUR 320. The total amount for both proceedings is therefore EUR 1 170.

Order

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the applicant to bear the opponent's costs in the appeal proceedings, which are fixed at EUR 550. The total amount to be paid by the opponent in the opposition and appeal proceedings is EUR 1 170.**

Signed

G. Humphreys

Signed

M. Bra

Signed

C. Bartos

Registrar:

Signed

H.Dijkema

