



ОБЩЕСОЮЗНА ЕВРОПЕЙСКИЯ СУД  
TRIBUNAL GENERAL DE LA UNION EUROPEA  
TRIBUNAL EUROPSKÉ UNIE  
DIEU EUROPÆISCHE UNIONS REJ  
GERICHT DER EUROPÄISCHEN UNION  
BORDOVALZING DUTKONELT  
ΓΕΝΙΚΟ ΔΙΚΑΣΤΗΡΙΟ ΤΗΣ ΕΥΡΩΠΑΪΚΗΣ ΕΝΩΣΗΣ  
GENERAL COURT OF THE EUROPEAN UNION  
TRIBUNAL DE L'UNION EUROPÉENNE  
CORTI GHINEARALTA AN ACINTAIS BORTAINT  
CORTI SUD EUROPEE FINTIUT  
TRIBUNALE DELL'UNIONE EUROPEA

FIROPOS NAVENTIBAS VISPARERA DIFSA  
EUROPOS SAJUNGOS BENDRASIS TEISMAS  
AZ EURÓPAI ÉRTŐ TÖRVÉNYSZÉKE  
IE-CORTI GENERALI TAL-UNIONE EWROPEA  
KIECHT VAN DE EUROPESE UNIE  
SAD UNII EUROPEJSKIEJ  
TRIBUNAL GERAL DA UNIÃO EUROPEIA  
TRIBUNALET UNIUNIE EUROPENE  
VSECHENÝ SUD EUROPSKÉ UNIE  
SPLOŠNO SODISČE EVROPSKE UNIE  
EUROPAIS UNIONIN YLEINEN TUOMIOISTUIN  
EUROPEISKA UNIONENS TRIBUNAL

## JUDGMENT OF THE GENERAL COURT (Sixth Chamber)

15 November 2023 \*

(EU trade mark – Opposition proceedings – Application for EU figurative mark  
imaster.golf – International registration of the earlier word mark MASTERS –  
Relative ground for refusal – Article 8(5) of Regulation (EU) 2017/1001 –  
Repute – Similarity – Link – Unfair advantage – Lack of due cause – Article 95(2)  
of Regulation 2017/1001)

In Case T-677/22,

**Portal Golf Gestión, SA**, established in Madrid (Spain), represented by J. Garrido  
Pastor, lawyer,

applicant,

v

**European Union Intellectual Property Office (EUIPO)**, represented by  
D. Stoyanova-Valchanova and V. Ruzek, acting as Agents,

defendant,

the other party to the proceedings before the Board of Appeal of EUIPO,  
intervener before the General Court, being

**Augusta National, Inc.**, established in Augusta, Georgia (United States),  
represented by H. Koenraad, lawyer,

THE GENERAL COURT (Sixth Chamber),

composed of M.J. Costeira (Rapporteur), President, P. Zilgalvis and E. Tichy-  
Fisslberger, Judges,

Registrar: V. Di Bucci,

\* Language of the case: English.

having regard to the written part of the procedure,

having regard to the fact that no request for a hearing was submitted by the parties within three weeks after service of notification of the close of the written part of the procedure, and having decided to rule on the action without an oral part of the procedure, pursuant to Article 106(3) of the Rules of Procedure of the General Court,

gives the following

### **Judgment**

- 1 By its action based on Article 263 TFEU, the applicant, Portal Golf Gestión, SA, seeks annulment of the decision of the First Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 30 August 2022 (Case R 2204/2021-1) ('the contested decision').

### **Background to the dispute**

- 2 On 4 December 2018, the applicant filed an application for registration of an EU trade mark in respect of the following figurative sign:



- 3 The mark applied for covers goods and services in, following the restriction made in the course of the proceedings before EUIPO, Classes 9, 38, 42 and 45 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, corresponding, for each of those classes, to the following description:
  - 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’.
- 4 On 27 May 2019, the intervener, Augusta National, Inc., filed a notice of opposition to registration of the mark applied for in respect of the goods and services referred to in paragraph 3 above.
- 5 The opposition was based, in particular, on the international registration designating the European Union No 1076672 of the word mark MASTERS, registered on 27 December 2010, for the goods and services in, following restriction, Classes 9, 38 and 41, for which a reputation is claimed, corresponding, for each of those classes, to the following description:
- 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 The grounds relied on in support of the opposition were those set out in Article 8(1)(b) and Article 8(5) of Regulation (EU) 2017/1001 of the European

Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1).

- 7 On 22 October 2021, the Opposition Division upheld the opposition on the basis of Article 8(5) of Regulation 2017/1001.
- 8 On 22 December 2021, the applicant filed a notice of appeal with EUIPO against the decision of the Opposition Division.
- 9 By the contested decision, the Board of Appeal dismissed the appeal and upheld the decision of the Opposition Division, on the ground that the mark applied for would take unfair advantage of the reputation in several EU countries of the earlier mark MASTERS for the services of ‘entertainment in the nature of golf tournaments’ in Class 41.

### **Forms of order sought**

- 10 The applicant claims that the Court should:
  - annul the contested decision;
  - allow registration of the mark applied for in respect of all the goods and services covered;
  - change the decisions on costs in favour of the intervener issued by the Opposition Division and the Board of Appeal;
  - order EUIPO to pay the costs.
- 11 EUIPO contends that the Court should:
  - dismiss the application;
  - order the applicant to pay the costs in the event of a hearing.
- 12 The intervener contends that the Court should:
  - dismiss the application;
  - order the applicant to pay the costs.

### **Law**

- 13 In support of the action, the applicant relies on a single plea in law, alleging infringement of Article 8(5) of Regulation No 2017/1001.
- 14 The applicant challenges, in essence, the findings of the Board of Appeal concerning the relevant public, the reputation of the earlier mark, the distinctive

character of the earlier mark, the comparison of the signs at issue, the link between those signs and the existence of an unfair advantage.

- 15 Under Article 8(5) of Regulation 2017/1001, upon opposition by the proprietor of a registered earlier trade mark within the meaning of paragraph 2, the trade mark applied for is not to be registered where it is identical with, or similar to, an earlier trade mark, irrespective of whether the goods or services for which it is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered, where, in the case of an earlier EU trade mark, the trade mark has a reputation in the European Union or, 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.
- 16 For an earlier trade mark to be afforded the broader protection under Article 8(5) of Regulation No 2017/1001, a number of conditions must, therefore, be satisfied. First, the earlier trade mark which is claimed to have a reputation must be registered. Secondly, the earlier trade mark and the mark applied for must be identical or similar. Thirdly, the earlier trade mark must have a reputation in the European Union, in the case of an earlier EU trade mark, or in the Member State concerned, in the case of an earlier national trade mark. Fourthly, the use without due cause of the mark applied for must lead to the risk that unfair advantage might be taken of the distinctive character or the repute of the earlier trade mark or that it might be detrimental to the distinctive character or the repute of the earlier trade mark. As those conditions are cumulative, failure to satisfy one of them is sufficient to render that provision inapplicable (see judgment of 31 May 2017, *Alma – The Soul of Italian Wine v EUIPO – Miguel Torres (SOTTO IL SOLE ITALIANO SOTTO il SOLE)*, T-637/15, EU:T:2017:371, paragraph 29 and the case-law cited).
- 17 As regards, more particularly, the fourth of the conditions of application of Article 8(5) of Regulation 2017/1001, that condition refers to three separate types of risk. The first type of risk referred to arises where the earlier mark is no longer capable of arousing immediate association with the goods for which it is registered and used. It refers to the dilution of the earlier mark by the dispersion of its identity and its hold upon the public mind. The second type of risk occurs where the goods or services covered by the mark applied for may appeal to the public's senses in such a way that the earlier mark's power of attraction is diminished. The third type of risk concerns the risk that the image of the mark with a reputation or the characteristics which it projects are transferred to the goods covered by the mark applied for, with the result that the marketing of those goods is made easier by that association with the earlier mark with a reputation. It should, however, be emphasised that in none of those cases is it necessary that there be a likelihood of confusion between the marks at issue; the relevant public only has to be able to establish a link between them and does not necessarily have to confuse them (see, to that effect, judgment of 22 March 2007, *Sigla v OHIM –*

*Elleni Holding (VIPS)*, T-215/03, EU:T:2007:93, paragraphs 36 to 42 and the case-law cited).

***The relevant public***

- 18 The applicant submits that the Board of Appeal contradicted itself in the assessment of the relevant public. On the one hand, it recognised that the disputed goods and services were related to ‘golf courses management’ and hinted that the relevant public was ‘attentive’. On the other, it held that the relevant public consisted of ‘golf players and golf enthusiasts’. In accordance with the case-law, the relevant public to be considered is the public covered by the mark applied for, in the present case being the public consisting in companies that use golf courses, as has been established by the Opposition Division.
- 19 EUIPO and the intervener dispute the applicant’s arguments.
- 20 It should be noted at the outset that, first, the public to be taken into account in order to determine whether registration of the mark applied for may be declared invalid pursuant to Article 8(5) of Regulation 2017/1001 varies depending on the type of injury alleged by the proprietor of the earlier trade mark (see, to that effect, judgment of 27 November 2008, *Intel Corporation*, C-252/07, EU:C:2008:655, paragraph 33).
- 21 First, the existence of injury consisting of detriment to the distinctive character or the repute of the earlier mark must be assessed by reference to average consumers, who are reasonably well informed and reasonably observant and circumspect of the goods or services for which that mark is registered (judgment of 27 November 2008, *Intel Corporation*, C-252/07, EU:C:2008:655, paragraph 35).
- 22 Secondly, the existence of an injury consisting of unfair advantage taken of the distinctive character or the repute of the earlier mark must be assessed by reference to average consumers, who are reasonably well informed and reasonably observant and circumspect of the goods or services for which the later mark is registered (see, to that effect, judgment of 27 November 2008, *Intel Corporation*, C-252/07, EU:C:2008:655, paragraph 36).
- 23 Secondly, the existence of a link between the conflicting marks, on which the abusive conduct envisaged by Article 8(5) of Regulation No 2017/1001 is based, assumes that the sections of the public concerned by the goods and services for which the marks are registered is the same or ‘overlaps’ to a certain extent (see judgment of 9 March 2012, *Ella Valley Vineyards v OHIM – HFP (ELLA VALLEY VINEYARDS)*, T-32/10, EU:T:2012:118, paragraph 23 and the case-law cited).
- 24 In the present case, the Board of Appeal found, in essence, in paragraphs 62 to 64 of the contested decision that the relevant public consisted in, with regard to the goods and services at issue, golf professionals and golf enthusiasts, displaying a

high level of attention. The Board of Appeal stated, in paragraph 42 of that decision, that the relevant territory was, taking into account the earlier mark, the European Union as a whole.

- 25 In that regard, it should be noted that, like the Board of Appeal, the goods and services for which the earlier mark was registered concern the field of golf and are intended for, in view of their nature, golf enthusiasts and golf professionals. The goods and services covered by the mark applied for concern the field of golf and, more specifically, golf courses management. They are not, by contrast, intended for, in the light of their nature, golf professionals.
- 26 Therefore, it must be concluded that the sections of the public, comprising consumers concerned by the goods and services covered by the marks at issue, ‘overlap’ according to the case-law cited in paragraph 23 above, in that they consist of golf professionals.
- 27 Furthermore, the contradiction claimed by the applicant concerning the assessment of the relevant public is based on an incomplete reading of the contested decision. Although it is true that the Board of Appeal stated in paragraph 62 of the contested decision that the relevant public consisted of golf players and golf enthusiasts, by contrast it stated in paragraph 63 that the reputation of the earlier mark extended also to the public who were involved in golf professionally, such as persons involved in golf courses management, and that therefore there was an overlap between the marks with regard to the relevant public.
- 28 Accordingly, since the Board of Appeal included golf professionals in the relevant public, and, in particular, persons involved in golf courses management, the complaint of the applicant must be rejected as unfounded.

### ***Reputation of the earlier mark***

- 29 The applicant claims that, in essence, the reputation of the earlier mark in respect of the services of ‘entertainment in the nature of golf tournaments’ is not established in view of the items of evidence adduced by the intervener. In that regard, it submits that, first, the statement of the Board of Appeal that the term ‘masters’ covers ‘the most important golf tournament of the world’ is based on its own knowledge. That statement therefore contradicts Article 95 of Regulation 2017/1001. Secondly, the reputation of the earlier mark is based mainly on the items of evidence adduced for the United Kingdom and the United States. It follows clearly from the case-law that the States in which the reputation is to be demonstrated must form part of the territory of the European Union. Thirdly, the statement of the Board of Appeal that any consumer of the European Union could easily access Amazon UK is incorrect, since, when during an attempt to connect to Amazon, the consumer is redirected to the website of his or her country. Annexes 4C and 4F should therefore be rejected. Fourthly, the information contained in Annex 4B, regarding viewer ratings in Germany and Italy, first, come

from an employee of the intervener and, secondly, are not supported by any official source. Fifthly, the documents submitted by the intervener do not demonstrate that the earlier mark is known as such by the relevant public. That earlier mark is often associated with other terms.

- 30 EUIPO and the intervener dispute the applicant's arguments.
- 31 According to the case-law, in order to satisfy the requirement of reputation, a mark must be known to a significant part of the public concerned by the goods or services covered by that mark. In examining that condition, it is necessary to take into consideration all the relevant facts of the case, in particular the market share held by the earlier mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it. There is, however, no requirement for that mark to be known by a given percentage of the relevant public or for its reputation to cover all the territory concerned, so long as that reputation exists in a substantial part of that territory (see judgment of 12 February 2015, *Compagnie des montres Longines, Francillon v OHIM – Staccata (QUARTODIMIGLIO QM)*, T-76/13, not published, EU:T:2015:94, paragraph 87 and the case-law cited).
- 32 The reputation of an earlier mark must be established as at the filing date of the application for the contested mark (see judgment of 16 October 2018, *VF International v EUIPO – Virmani (ANOKHI)*, T-548/17, not published, EU:T:2018:686, paragraph 103 and the case-law cited).
- 33 In that regard, it must be noted at the outset that, contrary to what the applicant claims, the Board of Appeal did not determine the reputation of the earlier trade mark relying mainly on the items of evidence adduced for the United Kingdom and the United States. The applicant's claim is based on an erroneous reading of paragraph 28 of the contested decision. Although in that paragraph the Board of Appeal agreed however that the reasoning of the Opposition Division – according to which broadcasting by channels based in the United Kingdom (BBC and Sky) are received by at least part of the relevant public under analysis, such as the English-speaking public of the EU (Ireland and Malta), as well as by golf enthusiasts used to watching the tournament of the intervener through those television channels based in the United Kingdom over the years – was convincing, it found therein that the Opposition Division had recognised the reputation of the earlier mark mainly on the basis of items of evidence adduced for the United Kingdom.
- 34 The finding of the Board of Appeal that the items of evidence adduced by the intervener were sufficient to establish, at the date of the application for registration of the mark applied for, the existence of a reputation of the earlier trade mark in the European Union for the services of 'entertainment in the nature of golf tournaments' in Class 41, for golf enthusiasts, is essentially based, as is apparent from paragraphs 29 to 35 of the contested decision, on the documents



submitted by the intervener in relation to Germany, France, Italy and the Netherlands.

- 35 In particular, the intervener submitted, first, a large number of press and magazine articles in relation to its golf tournament and on which the ‘masters’ element of the earlier mark clearly appeared. Those extracts, which come from well-known newspapers and magazines, such as *Bild* in Germany, *El País* in Spain, *Le Monde* in France and *de Volkskrant* in the Netherlands, and that relate to a period from 1967 to 2019, present, in essence, the golf tournament of the intervener as being the most important and most famous in the world. In the present case, they enable the existence of significant media coverage of the intervener’s tournament under the earlier mark at the date of the application for registration of the mark applied for to be established.
- 36 It is also apparent that, contrary to what the applicant claims, the finding of the Board of Appeal, in paragraph 62 of the contested decision, that the ‘masters’ is ‘the most important golf competition globally’, is not based on its own knowledge, but on press and magazine articles submitted by the intervener, and in particular on extracts contained in Annexes 4G 09 and 4G 47 of the EUIPO case file.
- 37 Secondly, the intervener submitted a statement under oath of its Senior Director of Business Affairs, which set out the numbers of television viewers of its tournament in Germany and Italy for the years from 2014 to 2019. Those numbers, the reliability of which has not been disputed by the applicant, underline the increasing and growing importance, during those years, of television viewers for that tournament. Those numbers are, with regard to Italy, supported by the emails of the Italian broadcaster of the tournament.
- 38 Thirdly, the intervener submitted several screenshots of books, published between 1975 and 2019, on the ‘masters’. It also submitted screenshots of pages from the website Wikipedia relating to its tournament, in English, Spanish, German, French and Dutch, entitled respectively ‘Masters Tournament’, ‘The Masters’, ‘The Masters Tournament’, ‘Masters of Golf’ and ‘Masters Tournament’. Those screenshots are dated 17 December 2019.
- 39 Fourthly, the intervener submitted copies of advertisements that appeared in French newspapers and magazines between 2012 and 2016 and upon which the earlier mark was clearly visible.
- 40 It follows from the foregoing that the items of evidence adduced by the intervener, when taken together, demonstrate that, at the relevant date, the earlier mark was known by the concerned public as being the name of one of the most famous golf tournaments in the world. Those documents allow for, at the very least, the presupposition that the public concerned was aware of the earlier mark for the services of ‘entertainment in the nature of golf tournaments’, although, in a part of those services, the earlier mark does not appear separately, but together with the

word elements ‘the’, ‘usa’, ‘augusta’ and ‘tournament’ or figurative elements representing the map of the United States, a hole and a flag.

- 41 In that latter regard, it must be recalled that the proprietor of a registered mark may, in order to make out proof of the particular distinctive character and reputation of that mark, rely on evidence of its use, as part of another registered mark and reputation, provided that the relevant public continues to perceive the goods at issue as originating from the same undertaking (see judgment of 14 September 2022, *Itinerant Show Room v EUIPO – Save the Duck (ITINERANT)*, T-416/21, not published, EU:T:2022:560, paragraph 83 and the case-law cited). As is apparent from the case file, the intervener is also the holder, for the services at issue, of EU marks and international registrations including the word element ‘masters’ and the word or figurative elements referred to in paragraph 40 above.
- 42 Furthermore, it should be noted that, contrary to what the applicant claims, those word and figurative elements do not change the distinctive character of the earlier mark. Negligible elements are involved, by reason of, first, their lack of distinctive character, taking account of their descriptive character, either of the place where the intervener’s tournament takes place, or of the necessary accessories for playing golf, and, secondly, their lack of a dominant nature, having regard to their secondary position.
- 43 Accordingly, the fact that, in some documents, the earlier mark was represented by those word or figurative elements does not prevent taking them into account for the purpose of assessing the reputation of the earlier mark.
- 44 In addition, although it is true that, as the applicant states, the existence of the reputation must be assessed by taking into consideration, in particular, the market share held by the mark, how intensive, geographically widespread and long-standing the use of the mark has been and the amount invested by the undertaking in promoting the mark, it is, however, necessary to bear in mind that that list is illustrative only. Therefore, it cannot be required that proof of the reputation of a mark pertains to all those elements (judgment of 26 June 2019, *Balani and Others v EUIPO – Play Hawkers (HAWKERS)*, T-651/18, not published, EU:T:2019:444, paragraphs 23 and 24). Consequently, contrary to what the applicant claims, the intervener was not obliged to adduce evidence relating to all of those elements in order to establish the reputation of the earlier mark. In any event, it was found in paragraph 40 above that the evidence submitted by the intervener was sufficient to establish the reputation of the earlier mark within the meaning of Article 8(5) of Regulation 2017/1001.
- 45 The Board of Appeal did not therefore make any error of assessment in finding that, taken as a whole, the items of evidence adduced by the intervener were sufficient to demonstrate, on the relevant date, a reputation of the earlier trade mark in the European Union for the services of ‘entertainment in the nature of golf tournaments’ in Class 41.

- 46 That finding is not called into question by the applicant's other arguments.
- 47 First, the applicant submits that it is impossible for the European public not from the United Kingdom to connect to Amazon UK, since the website automatically redirects the user to the website of his or her country, with the result that Annexes 4C and 4F should be disregarded.
- 48 In that regard, first, it should be noted that, in Annexes 4C, Annexes 4C13, 4C16 and 4C20 are the screenshots of the 'amazon.de' website, with the result that they cannot, in any event, be disregarded. Secondly, it was noted in paragraph 34 above that the reputation of the earlier mark was essentially established on the basis of items of evidence adduced by the intervener relating to Germany, Spain, France, Italy and the Netherlands. It follows that the applicant's argument must, in any event, be rejected as unfounded.
- 49 Secondly, the applicant submits that the information concerning the numbers of viewers in Germany and in Italy, included in the statement of the Senior Director of Business Affairs of the intervener, should have been supported by official viewing rating sources and not by emails of suppliers of the intervener.
- 50 In that regard, suffice it to note that neither Regulation 2017/1001, nor Commission Delegated Regulation (EU) 2018/625 of 5 March 2018, supplementing Regulation (EU) 2017/1001 and repealing Delegated Regulation (EU) 2017/1430 (OJ 2018 L 104, p. 1), does not contain a provision relating to the type of evidence that is required to prove the reputation of a mark. In addition, the information contained in those emails are not disputed by the applicant. It follows that the applicant's arguments must be rejected as unfounded.

***Lack of distinctive character of the term 'masters' for the services of 'entertainment in the nature of golf tournaments'***

- 51 The applicant criticises, in essence, the Board of Appeal for considering that the term 'masters' had a weak inherent distinctive character, whereas it is undeniably descriptive of the services at issue and that, accordingly, it is devoid of distinctive character. In addition, the earlier mark is purely a word mark, with no typographical, graphical or colour elements.
- 52 EUIPO and the intervener dispute the applicant's arguments.
- 53 It should be noted at the outset that, by its line of argument, the applicant seeks in reality to question the validity of the earlier mark, since the characterisation of the word element 'masters' as descriptive or generic of the services at issue amounts to a denial of the distinctive character of the earlier mark.
- 54 In opposition proceedings, it is not possible to find, with regard to an earlier mark, an absolute ground for refusal, such as the lack of distinctive character, provided for in Article 7(1)(b) of Regulation 2017/1001 (see judgment of 29 April 2015,

*Hostel Tourist World v OHIM – WRI Nominees (HostelTouristWorld.com)*, T-566/13, not published, EU:T:2015:239, paragraph 35 and the case-law cited).

- 55 It follows that, in the context of the application of Article 8(5) of Regulation 2017/1001, it is necessary to acknowledge to a certain degree the distinctive character of the earlier mark relied on in support of the opposition to the registration of the EU mark. (see judgment of 29 April 2015, *HostelTouristWorld.com*, T-566/13, not published, EU:T:2015:239, paragraph 37 and the case-law cited).
- 56 Therefore, assuming that an earlier national mark is in fact descriptive in respect of some of the goods or services for which it was registered and that its protection leads to improper monopolisation of the descriptive indication at issue, such a consequence must be remedied not by an application of Article 8(5) of Regulation 2017/1001 but by invalidity proceedings (see judgment of 29 April 2015, *HostelTouristWorld.com*, T-566/13, not published, EU:T:2015:239, paragraph 35 et the case-law cited).
- 57 It follows that the complaint of the applicant must be rejected as being ineffective, since it cannot be considered in the present action that the earlier mark has a generic or descriptive character or that it is devoid of any distinctive character.

***The comparison of the signs at issue***

- 58 According to the case-law, two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects (see judgment of 10 March 2021, *Kerry Luxembourg v EUIPO – Ornua (KERRYMAID)*, T-693/19, not published, EU:T:2021:124, paragraph 48 and the case-law cited).
- 59 The marks to be compared are as follows:
- the mark applied for is the composite mark:



- the earlier mark is the word mark MASTERS.

***The failure to determine the degree of similarity of the signs at issue***

- 60 The applicant claims that the Board of Appeal failed to set out in the contested decision the degree of similarity of the signs at issue.
- 61 EUIPO and the intervener dispute the applicant's arguments.

- 62 In that regard, suffice it to note that, according to the case-law, when the Board of Appeal confirms a decision of the Opposition Division in its entirety, as in the present case, and given the continuity in terms of function between the Opposition Divisions and the Boards of Appeal, to which Article 71(1) of Regulation 2017/1001 attests, that decision, together with its statement of reasons, forms part of the context in which the Board of Appeal's decision was adopted, which is known to the parties and enables the Court to carry out in full its judicial review as to whether the Board of Appeal's assessment was well founded (see judgment of 25 October 2012, *riha v OHIM – Lidl Stiftung (VITAL&FIT)*, T-552/10, not published, EU:T:2012:576, paragraph 19 and the case-law cited).
- 63 Although it is true that the Board of Appeal did not expressly specify in the contested decision the degree of similarity of the signs at issue, the Opposition Division, by contrast, stated in its decision that the signs are, from a visual point of view, similar to a low degree, from a phonetic point of view, similar to a below-average degree and, from a conceptual point of view, at best, similar to a weak degree. That assessment of the Opposition Division is, moreover, included in paragraph 9 of the contested decision.
- 64 Accordingly, that decision and that statement of reasons of the Opposition Division, that was implicitly but necessarily confirmed by the Board of Appeal in paragraphs 44 and 45 of the contested decision, formed part of the context in which the decision of the Board of Appeal was adopted.
- 65 The applicant's complaint must therefore be rejected as unfounded.

*The failure to take account of the different structure of the signs at issue and the dominant elements of the mark applied for*

- 66 The applicant submits that, in the comparison of the signs at issue, the Board of Appeal did not take account of the different structure of the signs at issue or the importance and existence of dominant elements in the mark applied for, which are essential for the overall assessment of the similarity of the signs. Nor did it refer to the differences between the distinctive elements of the mark applied for.
- 67 In particular, the applicant submits that, first, the contested decision does not refer to the existence of dominant elements in the mark applied for. The Board of Appeal ignored the case-law, stating, on the one hand, that the element 'master' is 'particularly noticeable', although it is a term with a weak distinctive character and, on the other, that the figurative elements of the mark applied for are decorative although they have a central position and form part of the dominant element. It submits that, in any event, the mark applied for does not consist of a dominant element. Secondly, the comparison and assumed similarity of the signs at issue is simply based on the coincidence of the terms 'masters' and 'master', whereas the signs had a completely different structure, which should have led the Board of Appeal to conclude that they are different. Thirdly, the Board of Appeal did not take account of the differences between the distinctive elements of the

mark applied for, since the weak distinctive character of the ‘master’ element would have the effect of making clear the significance of the differences with the other distinctive elements of the mark applied for.

- 68 EUIPO and the intervener dispute the applicant’s arguments.
- 69 In that regard, it should be noted that, in the first place, the present complaints are based on an erroneous reading of the contested decision.
- 70 As regards the complaint that the Board of Appeal did not take account of the different structure of the signs at issue, in paragraph 43 of the contested decision, the Board of Appeal pointed out that, while the earlier mark was a word mark comprising the word ‘masters’ only, the mark applied for was a figurative mark comprised of the word elements ‘i’, ‘master’ and ‘golf’, the latter two separated by a dot, and a figurative element representing a ring of different colours placed above those word elements. In paragraph 44 of the contested decision, the Board of Appeal found that, from a visual point of view, the word element ‘master’ of the mark applied for reproduced six of the seven letters of the earlier mark. The Board of Appeal found that it was all the more noticeable that the word element ‘master’ of the mark applied for was written in black, while its elements ‘i’ and ‘golf’ were written in green and that the use of a different colour attracted attention. Therefore, the Board of Appeal held that, notwithstanding the additional word elements and the figurative element of the mark applied for, the fact that the central element ‘master’ largely corresponds to the earlier mark could not be ignored and results in similarity from a visual point of view.
- 71 As regards the complaints that the Board of Appeal did not take account of the differences between the distinctive elements of the mark applied for and its dominant elements, in paragraph 52 of the contested decision, the Board of Appeal recalled that the marks had to be compared in their entirety and that, contrary to what the applicant states, a weak degree of distinctive character did not automatically exclude a similarity between the signs. The Board of Appeal also specified that, in the present case, although the word element ‘master’ of the mark applied for was distinctive to a weak degree, its other elements, namely the word elements ‘i’ and ‘golf’ and the figurative element, that were respectively descriptive of the goods and services at issue and decorative, were even less so. Those elements were too weak to differentiate the signs at issue to such an extent as to entirely exclude a similarity between them.
- 72 It follows that, contrary to what the applicant claims, the Board of Appeal, in its assessment of the similarity of the signs at issue, took account of, in a precise manner, the different structure of the signs at issue in its assessment of their similarity. It specified that the earlier mark was a word mark comprising a single element, while the mark applied for was a figurative mark comprising several word elements. It also took account of the distinctive and dominant elements of the mark applied for, since it found that, with regard to the elements of which that mark consists that are distinctive to a weak degree, it had to be compared in its

entirety. The Board of Appeal thus took the view that, like the applicant, the mark applied for was not comprised of a dominant element.

- 73 In the second place, it should be noted that the applicant's line of argument is based on two mistaken premises.
- 74 First, the applicant errs in taking the view that, where the structure of the signs at issue is different, the comparison leads to the conclusion of a lack of similarity.
- 75 It should be noted, first of all, that there is nothing to prevent a determination as to whether there is any similarity between a word mark and a figurative mark, since the two types of mark have graphic form capable of creating a visual impression (see, to that effect, judgment of 19 May 2011, *PJ Hungary v OHIM – Pepekillo (PEPEQUILLO)*, T-580/08, EU:T:2011:227, paragraph 75 and the case-law cited).
- 76 Furthermore it should be noted that where a word mark and a figurative mark bearing word elements are compared, the question that arises is whether the signs have in common either a word element or a significant number of letters in the same position. In that regard, it was recalled in paragraph 58 above that two marks are similar where, from the point of view of the relevant public, they are at least partly identical as regards one or more relevant aspects.
- 77 Secondly, the applicant errs in taking the view that the fact that the common element is not distinctive or distinctive to a weak degree is sufficient to establish that that element is negligible in the overall impression conveyed by the signs at issue. It is only where the non-coinciding elements of the signs at issue have a distinctive character greater than that of the common element that the latter has a reduced significance in the overall impression conveyed by the signs at issue and, therefore, in the assessment of their similarity.
- 78 In addition, if, owing to their weak, or even very weak, distinctive character, descriptive elements of a trade mark are not generally regarded by the public as being dominant in the overall impression conveyed by that mark, that does not mean, however, that the descriptive elements of a mark are necessarily negligible in the overall impression conveyed by that mark (see, to that effect, judgment of 10 March 2021, *KERRYMAID*, T-693/19 P, not published, EU:C:2021:124, paragraph 55 and the case-law cited).
- 79 In the third place, it should be noted that the applicant's line of argument relating to the dominant elements of the mark applied for is lacking in clarity, since, in paragraph 39 of the application, the applicant criticises the Board of Appeal for not making reference to the existence of dominant elements in the mark applied for, but the applicant submits, in paragraph 40, that the mark applied for does not contain any dominant element, as the applicant already claimed before the Board of Appeal.

- 80 Having regard to the foregoing, the applicant's complaints must be rejected as being unfounded.

*The similarity of the conflicting signs*

– *Visual similarity*

- 81 The applicant submits, in essence, that the signs are different from a visual point of view, taking account of their different structures, the coincidence in a non-distinctive element and the visual significance, by reason of the size, position and uniqueness of the figurative element of the mark applied for.
- 82 EUIPO and the intervener dispute the applicant's arguments.
- 83 In paragraph 44 of the contested decision, the Board of Appeal found that the word element 'master' of the mark applied for reproduced six of the seven letters of the earlier mark. The Board of Appeal found that it was all the more noticeable that the word element 'master' of the mark applied for was written in black, while its elements 'i' and 'golf' were written in green and that the use of a different colour attracted attention. It therefore found that notwithstanding the additional verbal elements of the mark applied for and its figurative element, the fact that the central element 'master' largely corresponds to the earlier mark would not be ignored and would result in similarity from a visual point of view.
- 84 In that regard, as pointed out in paragraph 58 above, two marks are similar where, from the point of view of the relevant public, they are at least identical in part as regards one or more relevant aspects.
- 85 In addition, where the sole component of the mark applied for is included in its entirety within the earlier mark, the signs at issue are partially identical in such a manner as to create a certain impression of visual similarity on the part of the public (see judgment of 5 October 2020, *X-cen-tek v EUIPO – Altenloh, Brinck & Co. (PAX)*, T-847/19, not published, EU:T:2020:472, paragraph 101 and the case-law cited).
- 86 In the present case, it should be noted that, like the Board of Appeal, first, except for the final letter 's', the earlier mark MASTERS is entirely included in the mark applied for. Furthermore, the common word element 'master' is clearly recognisable and visible in the mark applied for, having regard to its central position and different colour to those of the other elements of which that mark consists.
- 87 Moreover, although it is true that the signs at issue have differences that relate to the additional word elements of the mark applied for, namely 'i' and 'golf', and its figurative element, namely a circle with a multi-coloured contour, those differences do not however lead to the applicant's conclusion that the signs are different.



- 88 As the Board of Appeal correctly found, in paragraph 52 of the contested decision, those elements are too weak to differentiate between the signs at issue to such an extent as to entirely exclude a similarity between them.
- 89 First, the additional word elements ‘i’ and ‘golf’, taking account of the distinctive character to a weak degree of the first and the descriptiveness of the goods and services of the second, are not more distinctive than the common word element ‘master’.
- 90 Secondly, the figurative element, consisting in a mere circle with a multi-coloured contour, is not capable of distracting attention from the word elements. In that regard, it should be noted that where a trade mark is composed of verbal and figurative elements, the former are, in principle, more distinctive than the latter, because the average consumer will more easily refer to the goods in question by quoting their name than by describing the figurative element of the trade mark (see judgment of 28 September 2022, *G-Core Innovations v EUIPO – Coretransform (G CORELABS)*, T-454/21, not published, EU:T:2022:591, paragraph 37 and the case-law cited).
- 91 That finding was not called into question by the judgment of 11 November 2009, *Frag Comercio Internacional v OHIM – Tinkerbelle Modas (GREEN by missako)* (T-162/08, not published, EU:T:2009:432), cited by the applicant, since, apart from the fact that the lawfulness of the decisions of EUIPO must be assessed solely on the basis of Regulation 2017/1001, as interpreted by the EU Courts and not on the basis of a previous decision-making practice, the factual circumstances of the cases are different. In the case cited by the applicant, the signs at issue were two figurative marks, and the common word element was illegible.
- 92 The Board of Appeal did not therefore make an error of assessment in finding that the common word element ‘master’ results in similarity from a visual point of view between the signs at issue, which was classified, correctly, by the Opposition Division, as weak, as noted in paragraphs 63 and 64 above.

– *Phonetic similarity*

- 93 The applicant submits that the mark applied for comprises four syllables, ‘i’, ‘mas’, ‘ter’, ‘golf’, whereas the earlier mark is only comprised of two syllables ‘mas’ and ‘ters’. The applicant adds that the beginning and end of the signs are also different. Therefore, the signs at issue are different.
- 94 EUIPO and the intervener dispute the applicant’s arguments.
- 95 In paragraph 45 of the contested decision, the Board of Appeal found that only the word element ‘imaster.golf’ of the mark applied for will be pronounced. The Board of Appeal added that the syllables ‘mas’ and ‘ter’ are pronounced – according to the rules of the relevant language – in a very similar way to the way in which the earlier mark ‘masters’ will be pronounced, with a difference in the

ending ‘s’. It stated that, in certain EU languages, such as French, that ending is not pronounced, with the result that the middle syllables of the mark applied for and the earlier mark are perceived in the same way. It therefore found that, even if the relevant public does not overlook the first and last additional syllables of the mark applied for, the identity or, at the very least, the high degree of similarity of pronunciation of the element ‘master’ will result in similarity from a phonetic point of view.

- 96 In that regard, although it is true that, in their pronunciation, the signs at issue are distinguished by their number of syllables, two for the earlier mark and four for the mark applied for, by reason of the additional word elements, ‘i’ and ‘golf’, placed at the start and end of the mark applied for, they coincide, however, in the common word element ‘master’. Therefore, the phonetic identity of the signs at issue relates to all of the earlier mark, except for the final letter ‘s’, which, as pointed out by the Board of Appeal, is not pronounced in some EU languages, and two of the four syllables of which the mark applied for consists.
- 97 The Board of Appeal did not therefore make any error of assessment in finding that the common word element ‘master’ results in similarity from a phonetic point of view between the signs at issue, which was classified, correctly, by the Opposition Division, as having a lower than average degree of distinctive character, as noted in paragraphs 63 and 64 above.
- 98 Furthermore, that finding is not called into question by the judgment of 11 July 2006, *Torres v OHIM – Bodegas Muga (Torre Muga)* (T-247/03, not published, EU:T:2006:198), cited by the applicant, since, in addition to the fact that the lawfulness of the decisions of EUIPO must be assessed solely on the basis of Regulation 2017/1001, as interpreted by the EU Courts, and not on the basis of a previous decision-making practice, the signs at issue are different.

– *Conceptual Similarity*

- 99 The applicant submits that the signs at issue are different from a conceptual point of view. The applicant claims to that effect, that the word combination ‘imaster.golf’ of the mark applied for is invented and has a sufficiently distinctive character. It evokes, indirectly, the idea of effective and intelligent management of golf courses. By contrast, the earlier mark, that is linked to a golf competition, is understood as a competition intended for the best players. In addition, it submits that, according to EUIPO Guidelines, depending on the circumstances of the particular case, the marks that coincide in a non-distinctive element may be found to be different from a conceptual point of view when one of them is accompanied by meaningful distinctive elements, which is the case for the mark applied for.
- 100 EUIPO and the intervener dispute the applicant’s arguments.
- 101 In paragraph 46 of the contested decision, the Board of Appeal stated that, in essence, the earlier mark might be understood as the plural form of the word

‘master’, which is understood by the non-English-speaking public by reason of its common use as being related to higher education, for example. It also stated that the public would understand the element ‘master’ of the mark applied for as a singular form of the same word. It therefore found that it results in, by reason of the identical concepts of the elements ‘master’ and ‘masters’ of the signs at issue, similarity from a conceptual point of view, which will not be excluded by the concepts linked to the other elements of the mark applied for, ‘i’ and ‘golf’, that will be understood as a reference to the internet and to golf respectively.

- 102 In that regard, it should be recalled that, even if the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, the fact remains that, when perceiving a word sign even within a composite mark, he or she will break it down into word elements which, for him or her, suggest a concrete meaning or which resemble words known to him (see judgment of 23 April 2015, *Iglotex v OHIM – Iglo Foods Group (IGLOTEX)*, T-282/13, not published, EU:T:2015:226, paragraph 84 and the case-law cited.)
- 103 It should be noted that, in the present case, first of all, the word combination ‘imaster.golf’ of the mark applied for does not have a clear meaning – to that effect, the applicant specifies in its pleadings that that word combination evokes indirectly a concept – and breaks down into three word elements, ‘i’, ‘master’ and ‘golf’, which are probably identified and understood by the relevant public by reason of their clear meaning, such as that stated by the Board of Appeal in paragraph 46 of the contested decision and recalled in paragraph 101 above.
- 104 Next, it was noted in paragraph 86 above that the common word element ‘master’ is clearly recognisable and visible in the mark applied for, taking account of its central position and different colour to those of the other elements of which that mark consists.
- 105 Lastly, it was stated in paragraph 88 above that the Board of Appeal had found rightly that the word elements ‘i’ and ‘golf’ of the mark applied for had a distinctive character less than that of the element ‘master’, contrary to what the applicant claims, to differentiate the signs at issue to such an extent as to entirely exclude any similarity between them.
- 106 Therefore, it must be held that the similarity from a conceptual point of view between the signs at issue is weak.
- 107 The Board of Appeal did not therefore make any error of assessment in finding that the common word element ‘master’ results in a conceptual similarity between the signs at issue, which was classified, correctly, by the Opposition Division, at most, as weak, as noted in paragraph 63 above.

***The absence of any link between the marks at issue***

- 108 The applicant submits that the Board of Appeal erred in law when it concluded, solely on the basis of the reputation of the earlier mark, the similarity of the signs, goods and services, that the relevant public would establish a link between the marks. The Board of Appeal does not take account of the lack of distinctive character of the earlier mark, its absence of uniqueness, the nature of the relevant public and its level of attention. The applicant submits, in essence, in that regard, that, first, the likelihood that the use of the mark applied for is detrimental to the distinctive character of the earlier mark is non-existent, given that the use of the term ‘masters’ is of long standing on the market. Secondly, the relevant public, taking into account its high degree of attention, does not establish a link between the marks. Thirdly, the goods and services are completely unrelated, even though both are somehow connected to golf. It is therefore unlikely that the consumer will make a link between the marks.
- 109 EUIPO and the intervener dispute the applicant’s arguments.
- 110 In that regard, it should be borne in mind that, according to case-law, the types of injury referred to in Article 8(5) of Regulation No 207/2009, where they occur, are the consequence of a certain degree of similarity between the earlier and later marks, by virtue of which the relevant section of the public makes a connection between those two marks, that is to say, establishes a link between them even though it does not confuse them. In the absence of such a link in the mind of the public, the use of the mark applied for is not likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark (see judgment of 4 October 2017, *Gappol Marzena Porczyńska v EUIPO – Gap (ITM) (GAPPOL)*, T-411/15, not published, EU:T:2017:689, paragraphs 182 and 183 and the case-law cited).
- 111 The existence of such a link between the marks at issue must be assessed globally, taking into account all factors relevant to the circumstances of the case. Those factors include the degree of similarity between the marks at issue, the nature of the goods or services for which the marks at issue are registered, including the degree of closeness or dissimilarity between those goods or services, and 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 existence of a likelihood of confusion in the mind of the public (see judgment of 10 October 2019, *McDreams Hotel v EUIPO – McDonald’s International Property (mc dreams hotels Träumen zum kleinen Preis!)*, T-428/18, not published, EU:T:2019:738, paragraph 30 and the case-law cited).
- 112 In paragraph 56 of the contested decision, the Board of Appeal took the view that, in the present case, the similarity between the signs at issue, the reputation of the earlier trade mark for organising golf tournaments and the direct link with golf of

the goods and services at issue made it possible that the relevant public might reasonably establish a link between the marks.

- 113 In that regard, first, it was found in paragraphs 92, 97 and 107 above that the common word element ‘master’ results in similarities from visual, phonetic and conceptual point of views between the signs at issue.
- 114 Secondly, it was found in paragraph 45 above that the earlier mark enjoyed a reputation within the European Union for its services of ‘entertainment in the nature of golf tournaments’ falling within Class 41.
- 115 Furthermore, it should be recalled that, where proof of the reputation of a mark has been made out, it is irrelevant to prove the inherent distinctive character of that mark in order to obtain a finding that it has distinctive character (see judgment of 1 March 2018, *Shoe Branding Europe v EUIPO – adidas (Position of two parallel stripes on a shoe)*, T-629/16, EU:T:2018:108, paragraph 135 and the case-law cited). It is apparent that, as found in paragraphs 54 to 57 above, the applicant’s argument that the contested decision makes no mention at all regarding the fact that the earlier mark lacks distinctive character is irrelevant.
- 116 The same applies to the applicant’s argument that the contested decision makes no mention regarding the fact that the earlier mark is not unique, since that condition is not included in the conditions that, recalled in paragraphs 15 and 16 above, must be satisfied for Article 8(5) of Regulation 2017/1001 to apply.
- 117 Thirdly, it was noted in paragraph 25 above that the goods and services at issue all have a link with golf, in particular with golf courses management, as the Board of Appeal rightly noted in the contested decision.
- 118 In any event, it follows from Article 8(5) of Regulation 2017/1001 that its application is not subject to the condition that the goods and services covered by the signs at issue are identical or similar. Consequently, the applicant’s argument that the goods and services are so unrelated that the later mark is unlikely to generate the necessary link in the mind of the consumer with the earlier mark is irrelevant.
- 119 Fourthly, it was noted in paragraph 24 above that the relevant public comprised of, in relation to the goods and services at issue, golf professionals and golf enthusiasts, with a high level of attention, having regard to the expensive nature of those goods and services. It was found in paragraph 26 above that the sections of the public comprised of consumers concerned by the goods and services covered by the marks at issue ‘overlap’ according to the case-law referred to in paragraph 23 above, in that they consist of golf professionals.
- 120 The applicant submits, referring to the judgments of 19 May 2015, *Swatch v OHIM – Panavision Europe (SWATCHBALL)* (T-71/14, not published, EU:T:2015:293), of 26 September 2018, *Puma v EUIPO – Doosan Machine Tools (PUMA)* (T-62/16, EU:T:2018:604), and of 28 May 2020, *Galletas Gullón v*

*EUIPO – Intercontinental Great Brands (gullón TWINS COOKIE SANDWICH)* (T-677/18, not published, EU:T:2020:229), that, taking account of its high level of attention, the relevant public will not establish a link between them.

- 121 It has been observed in paragraph 111 above that the existence of a link between the marks at issue must be subject to an overall assessment, taking into account all factors relevant to the circumstances of the case. As pointed out correctly by EUIPO, the question whether the relevant public will establish a link between the marks must be resolved in light of the facts and circumstances of each case, which must be weighed up, which is, moreover, specified in paragraph 33 of the judgment of 19 May 2015, *SWATCHBALL* (T-71/14, not published, EU:T:2015:293), cited by the applicant. Accordingly, those references to cases in which the consideration of factors led to a different result, by reason of the circumstances specific to each, are not relevant for the purposes of the present assessment. It follows that the Board of Appeal cannot be reasonably criticised for concluding that, in light of the circumstances of the present case, even an attentive public might establish a link between the marks without confusing them.
- 122 In the light of the foregoing considerations and the case-law recalled in paragraph 111 above, the existence of a likelihood of association between the marks at issue cannot be disregarded. Assuming that the goods and services at issue only have a reduced degree of proximity, in the light of their different assumed purpose, nature and intended use, as the applicant argues, they relate nevertheless to golf. Therefore, it is highly improbable that the public referred to by the mark applied for, namely golf professionals, such as persons managing and administering golf clubs, are equally not aware of the earlier mark, given its reputation for the services of ‘entertainment in the nature of golf tournaments’. The Board of Appeal did not therefore make any error of assessment in finding that, in the circumstances of the present case, the relevant public was likely to establish a connection between the marks.

### ***The lack of an unfair advantage***

- 123 The applicant submits that the finding of the Board of Appeal that the mark applied for has the image and characteristics of the earlier mark not only fails to state the reasons and factual or theoretical elements on which it is based, but also is in direct contradiction with the case-law. In particular, it claims that the Board of Appeal contradicted itself when it assessed the relevant public, first, by recognising that the goods and services were linked to ‘golf courses management’ and that the relevant public was ‘attentive’ and, secondly, by stating that the relevant public was comprised of ‘golf players and golf enthusiasts’. The applicant also submits that it demonstrated, by uninterrupted commercial and economic use of the terms ‘master golf’ in the European Union between 1991 and 2022, by means of in particular the Spanish national mark BB MASTER GOLF, that there wasn’t any actual or potential risk of benefitting from the reputation or distinctive character of the earlier mark.

- 124 EUIPO and the intervener dispute the applicant's arguments.
- 125 In that regard, it must be recalled that, as a preliminary point, the concept of taking unfair advantage of the distinctive character or the repute of the earlier mark, called 'parasitism', does not pertain to the detriment caused to the mark but to the advantage taken by the third party of the use of the identical or similar contested mark. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear riding on the coat-tails of the mark with a reputation (see judgment of 27 October 2016, *Spa Monopole v EUIPO – YTL Hotels & Properties (SPA VILLAGE)*, T-625/15, not published, EU:T:2016:631, paragraph 61 and the case-law cited).
- 126 The risk of unfair advantage being taken of the distinctive character or the repute of the earlier trade mark occurs where the relevant public, without necessarily confusing the commercial origin of the product or service in question, is attracted by the mark applied for itself and will buy the product or service covered by it on the ground that it bears that mark, which is similar to an earlier mark with a reputation (see judgment of 27 October 2016, *SPA VILLAGE* (T-625/15, not published, EU:T:2016:631, paragraph 62 and the case-law cited).
- 127 It has been acknowledged by the case-law that the proprietor of the earlier mark is not required to demonstrate actual and present harm to his or her mark. The proprietor must only adduce prima facie evidence of a future risk, which is not hypothetical, of unfair advantage or of detriment. Such a conclusion may be established, in particular, on the basis of logical deductions made from an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case (see judgment of 6 July 2012, *Jackson International v OHIM – Royal Shakespeare (ROYAL SHAKESPEARE)*, T-60/10, not published, EU:T:2012:348, paragraph 53 and the case-law cited).
- 128 In order to determine whether the use of the contested sign takes unfair advantage of the distinctive character or the repute of the earlier trade mark, it is necessary to undertake a global assessment, taking into account all factors relevant to the circumstances of the case, which include the strength of the mark's reputation and the degree of distinctive character of the mark, the degree of similarity between the marks at issue and the nature and degree of proximity of the goods or services concerned (see judgment of 6 July 2012, *ROYAL SHAKESPEARE* (T-60/10, not published, EU:T:2012:348, paragraph 54 and the case-law cited).
- 129 In paragraph 62 of the contested decision, the Board of Appeal found, in essence, that, given the reputation of the earlier mark, it was very likely that the image and characteristics projected by the mark are transferred to the mark applied for and give rise to an interest for the goods and services covered by that mark. The mark applied for will enjoy, therefore, according to the Board of Appeal, an unfair 'boost', by reason of its link with the earlier mark in the mind of the relevant

consumers. That attention would not be due to the efforts of the applicant but rather to the attractiveness of the earlier mark and the marketing efforts of the intervener promoting its mark over many years.

- 130 In that regard, first, the view was taken in paragraph 122 above that it was highly improbably that the public referred to by the mark applied for was not aware of the earlier mark, given its reputation for the services of ‘entertainment in the nature of golf tournaments’. It was thus concluded that the Board of Appeal had correctly considered that, in the circumstances of the present case, the relevant public was likely to establish a connection between the marks.
- 131 Secondly, it must be recalled that, although the signs at issue only had overall a weak degree of similarity, that similarity arose, however, from the presence in the mark applied for of the common word element ‘master’, which, excluding the final letter ‘s’, corresponded to the earlier mark in its entirety.
- 132 Thirdly, it was noted in paragraph 27 above that the contradiction claimed by the applicant regarding the assessment of the relevant public was based on an incomplete reading of the contested decision. Although it is true that the Board of Appeal stated in paragraph 62 of the contested decision that the relevant public consisted in golf players and golf enthusiasts, by contrast it stated in paragraph 63 that the reputation of the earlier mark extended also to the public who were involved in golf professionally, such as persons involved in golf courses management, and that there was an overlap between the marks in the relevant public.
- 133 The Board of Appeal did not therefore make any error of assessment in finding that there was, in the present case, *prima facie*, a future risk, which is not hypothetical, that the applicant take unfair advantage of the reputation of the earlier mark, a reputation resulting from the activities, efforts and investments achieved by the intervener.
- 134 Therefore, the fact that the applicant cannot take unfair advantage of the reputation of the earlier mark, since it coexisted for more than 20 years with the Spanish national mark BB MASTER GOLF, is ineffective, since it is common ground that that mark was not used since 26 May 2010, the date of its revocation, that is to say, before the registration of the earlier mark, and that, in any event, that coexistence only related to Spain, and not the European Union as a whole, the territory in which the earlier mark was protected (see, to that effect, judgment of 10 March 2021, *KERRYMAID*, T-693/19 P, not published, EU:C:2021:124, paragraph 160 and the case-law cited).
- 135 Lastly, the applicant did not put forward before the Board of Appeal any due cause on which to base the use of the mark applied for, although it was for the applicant to do so.



- 136 The Board of Appeal did not therefore make any error of assessment in finding that the opposition was well founded within the meaning of Article 8(5)(b) of Regulation 2017/1001.
- 137 In the light of all the foregoing considerations, the action must be dismissed in its entirety, without there being any need to give a ruling on the admissibility of the second and third heads of claim of the applicant.

### **Costs**

- 138 Under Article 134(1) of the Rules of Procedure of the General Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.
- 139 Since the applicant has been unsuccessful, it must be ordered to pay the costs incurred by the intervener, in accordance with the form of order sought by the latter.
- 140 By contrast, since EUIPO has requested that the applicant be ordered to pay the costs only in the event that a hearing is convened, EUIPO should be ordered, in the absence of a hearing, to bear its own costs.

On those grounds,

THE GENERAL COURT (Sixth Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders Portal Golf Gestión, SA to bear its own costs and to pay those incurred by Augusta National, Inc.;**
- 3. Orders the European Union Intellectual Property Office (EUIPO) to bear its own costs.**

Costeira

Zilgalvis

Tichy-Fisslberger

Delivered in open court in Luxembourg on 15 November 2023.

V. Di Bucci

M. van der Woude

Registrar

President

