

**IN THE MATTER OF APPLICATION NUMBER 2010739
IN THE NAME OF RICON-RIBEIRAO CONFECÇÕES TEXTÉIS, LDA
TO REGISTER A TRADE MARK IN CLASS 3**

And

**IN THE MATTER OF OPPOSITION THERETO BY
THE FOOTBALL ASSOCIATION PREMIER LEAGUE LIMITED**

**IN THE MATTER OF application number 2010739
in the name of Ricon-Ribeirao Confeccoes Texteis, LDA
to register a trade mark in Class 3**

And

**In the matter of opposition thereto by
The Football Association Premier League Limited**

Background

On 10 February 1995, Ricon-Ribeirao Confeccoes Texteis, LDA filed an application to register a trade mark in Classes 3, 18 and 25 in respect of the following goods:

- Class 3** Soaps, perfumery, essential oils, cosmetics, hair lotions.
- Class 18** Furs, travel bags, hand bags, umbrellas, parasols, walking sticks.
- Class 25** Shirts, suits, blazers, trousers, ties, boxer shorts, braces, tights, T-shirts, polo shirts, shorts, skirts, blouses, lingerie, hosiery, jackets, coats, waistcoats, hats, neckties, articles of underclothing,; pyjamas, night-dresses, sleeping garments, negligees, dressing gowns, jumpers, cardigans, pullovers, sweaters, overalls, swimming costumes, dresses, dungarees, over-trousers, boots, shoes, sandals, slippers, tops, caps, scarves, robes, capes, aprons, jeans, socks, leg-warmers, dancewear, wrist-bands, gloves, mittens, belts,; all included in Class 25.

The mark applied for is as follows:



On 6 November 1996, The Football Association Premier League Limited filed notice of opposition, in which they say they are the proprietors, inter alia, of trade mark nos. 1502037, 1502032 and 2005393, details of which can be found in an annex to this decision. The grounds of opposition are in summary:

- 1. Under Section 5(2)** because the mark applied for is similar to the opponent's earlier trade marks and is for goods identical or similar to those covered by the earlier trade marks, as a result there exists a likelihood of confusion on the part of the public which includes a likelihood of association.
- 2. Under Section 5(4)(a)** because the opponents have used their trade mark since 1991, and use of the trade mark applied for being confusingly similar to the opponent's trade marks on or in relation to the goods for which protection is sought is liable to be prevented by the laws of passing off.
- 3. Under Section 3(6)** because of the conduct of the applicants and/or the nature of the mark and/or such use as has already been made of it.

The applicants filed a counterstatement in which they deny the grounds on which the opposition is based. Both sides request that an award of costs be made in their favour.

Both sides filed evidence in these proceedings. The matter came to be heard on 1 May 2001, when the applicants were represented by Mr Onslow of Counsel, instructed by Marks & Clerk, their trade mark attorneys, the opponents by Mr Chacksfield of Counsel, instructed by Forrester Ketley & Co, their trade mark attorneys.

Opponent's evidence

This consists of a Statutory Declaration dated 23 April 1998 and comes from Michael Foster, Company Secretary of The Football Association Premier League Limited, a position he has held since 27 May 1992. Mr Foster confirms that the facts in his Declaration have been told to him, are from his own knowledge or have been taken from the records of his company to which he has full access.

Mr Foster sets out the details of the three trade marks relied upon in the Statement of Case, and refers to another trade mark, number 1502036. He refers to exhibits MF1 and MF2, which consist of copies of the advertisements relating to these trade marks published in the Trade Marks Journal. He goes on to detail what he sees as the similarities between

his company's LION and that of the application, namely, the raised tail and forepaw and that both face left.

Mr Foster says that the announcement about the formation of The FA Premier League was made in April 1991 although there had been a suggestion of the name and the mark in the media some weeks prior to that date, referring to the considerable media interest in the formation of the league. He says that in October 1991 a decision was made to give the league a separate personality through incorporation, although it traded as an unincorporated association from April 1991 through to 27 May 1992 on which date it was incorporated. Mr Foster refers to exhibit MF3, which consists of a collection of press articles from 1991 referring to the formation of the Premier League although no mention is made or examples given of the opponent's LION trade mark. One article from 9 April 1991 edition of the Daily Express has two badges; that of The Football League and an unspecified badge, both of which depict lions with the features (raised tails and forepaw and facing left) referred to by Mr Foster.

Mr Foster refers to exhibit MF4, which consists of a copy of a publication entitled The Official Premier League Yearbook 1992 – 1993, the front of which bears the opponent's trade mark referred to in the grounds of opposition. The exhibit also has two pages numbered as 4 and 5 which depict two other versions of the opponent's LION trade mark, although it is not clear that these were part of the publication. There is no indication of any product being available under the mark other than the yearbook.

Mr Foster goes on to say that his company has licensed the use of their trade marks, referring to exhibit MF5 which consists of examples of licensing agreements, and in particular, to an agreement with Umbro UK Limited for the supply of kit to Premier League referees and linesmen. The licences include:

Grandreams Limited for two years from 27 June 1994. Lists the licenced products as various activity type books, colouring pens and annuals. Permits use of approved forms of the opponent's trade mark.

Umbro UK Limited dated as 1995 for the supply of Umbro kit to Premier League referees and linesmen. Permits use of approved forms of the opponent's trade mark.

Citizen watches effective from 1 August 1993, appointing the company as official timer and sponsor of The Premier League. Permits use of approved forms of the opponent's trade mark.

Beecham Group plc dated 22 December 1992, appointing the company as official supplier of sport drinks and sponsor of The Premier League. Permits use of approved forms of the opponent's trade mark.

Merlin Publishing International PLC dated 3 August 1994, for the manufacture and distribution of football and other sport cards, stickers and sticker albums bearing the opponent's marks, club logos and players images. Permits use of approved forms of the opponent's trade mark.

Bass Brewers Limited dated 8 September 1993, relating to that company's sponsorship of The Premier League. Permits use of approved forms of the opponent's trade mark.

The remainder of the licences are either dated after the relevant date, or appear to be drafts. Mr Foster says that it is not possible to supply turnover figures attributable to sales under his company's trade marks, but that his company receives income from the following licensees:

Mitre Sports International Limited to provide footballs to the Premier League matches and to use his company's trade marks on footballs for sale. £775,000 (min) annually.

Smithkline Beecham Drinks UK for use of the mark on containers of Lucozade who are also able to say that they are official suppliers to the F.A. Premier League. £220,000 annually

Merlin Publishing International plc to produce stickers (and albums for the stickers) bearing the photographic images of players, each sticker and album bearing the trade mark. Said to amount to in excess of 50 million stickers each season.

United Biscuits (UK) Limited for use of the mark in connection with crisps known as The FA Premier League Crisps. £100,000 annually

Corinthian Marketing plc for use of the trade marks on display stands for caricature figurines of Premier League players endorsed The FA Premier League Collection.

Grandreams Limited for use of the mark on football annuals and sound books. £20,000 (min)

Claremont Garments Limited for a range of clothing and luggage for supply to Marks & Spencer. The agreement allows the use of his company's trade marks and to say that they are sold with the endorsement "The Premier League Product Collection". £162,270 in the quarter ending 31 December 1996

BSkyB and the BBC for use of the trade marks in the programme credits, which in the first season attracted some 200 million viewers. A further 50,000 videos of matches have been sold.

Mr Foster continues saying that his company does not itself advertise but is often promoted by others such as the licensees and the media, and by way of example he refers to exhibit MF6. The exhibit consists of a large collection of press articles dating from April 1992 relating to events affecting The Premier League and its clubs. Whilst the exhibit clearly supports the contention that The Premier League have massive exposure, and no doubt a reputation to match, there is not one representation of the opponent's LION trade mark on any of the 300 plus pages of the exhibit.

Mr Foster says that his company has sold merchandise throughout the United Kingdom. He gives his opinion that any person seeing the LION device in their trade mark or the words Premier League would associate them with his company, and concludes his Declaration saying that he considered that at the time of filing the applicants would have been aware of his company's trade marks.

Applicant's evidence

This consists of two Statutory Declarations, dated 24 December 1998 and 24 March 1999, made by Vivienne Lloyd Coleman, a trade mark agent with Marks & Clerk, the applicant's representatives in these proceedings.

Turning first to the Declaration dated 24 December 1998. Ms Coleman begins by referring to the applicant's LION mark and the two versions of the trade marks relied upon by the opponents; a LION wearing a crown with a raised fore paw resting on a football and a raised tail, and the same image with the words PREMIER LEAGUE below. Details of the marks cited in the statement of case and other similar or identical marks applied for or registered by the opponents are shown as exhibit VLC1.

Ms Coleman goes on to refer to the results of a search of the trade marks register for marks consisting of or incorporating LIONS, a selection of which are shown as exhibits VLC2, VLC3 and VLC4. The exhibits show there to be a number of such marks on the trade marks register, some in a similar pose to that of the opponent's LION, but in many cases the figures are stylised, some to the extent of being unrecognisable as LIONS. Ms Coleman makes particular reference to those comprising exhibit VLC4, which contains details of marks for stylised and heraldic LIONS registered by football, rugby and other sports clubs, and also by many businesses.

Ms Coleman refers to the ex-parte examination of the application in suit, noting that two registrations were raised as official objections under Section 5, and subsequently waived because of the state of the register. Details of the relevant correspondence relating to the

examination can be found as exhibit VLC5. She goes on to refer to the differences in respective LIONS, namely, no crown or football in the applicant's mark, the manner in which the LIONS are shown, and to the fact that some of the opponent's marks include the words PREMIER LEAGUE.

Ms Coleman goes to the Statutory Declaration by Michael Foster, noting that the press cuttings provided to substantiate the adoption of the mark by the opponents in 1991 do not show the trade mark. She comments on the Licensing Agreements asserting that in all but two cases they involve goods that are not similar to those of the application, that the agreement with UMBRO to provide kit to officials is not sale to the public, that there is no copy of the agreement with Claremont Garments Limited by which to assess the use, but in any event, the existence of licences or royalty payments does not prove use of the mark. Ms Coleman notes that Mr Foster does not specify the merchandise referred to in paragraph 17 of his Declaration, and that in her view paragraphs 18 and 19 are opinion or speculation. She concludes this Declaration saying that there are differences in the respective LIONS and that the state of the register suggests that the opponents cannot claim to have a monopoly in the device of a LION.

Ms Coleman's second Statutory Declaration is dated 24 March 1999. She begins by saying that her clients have informed her that they intend to use the trade mark in respect of up-market goods in their own boutiques or in concessions in department stores, referring to brands that she considers comparable. She refers to exhibit VLC1 which consists of a letter dated 12 March 1999 from the applicants outlining the nature of the products to be sold under the brand, and enclosing two undated photographs, and three catalogues dating from spring/summer 1997 and summer/winter 1998. The photographs are of the exterior of the applicant's premises in Portugal and show a men's clothing shop with the name DECENIO and a small logo which may be the mark applied for, but this is not clearly the case. The catalogues show a range of outer clothing for men, and to a lesser extent, women, available under the name DECENIO and the device of a LION passant, the device also being used on its own.

Ms Coleman next refers to the investigations carried out by Farncombe International Limited into the use of LION marks, the results being shown as exhibit VLC2. The exhibit includes:

- S undated leaflet for jewellery sold under the name Elizabeth Duke and the device of a LION passant.
- S table listing traders that use a LION device and the goods that it is used in connection with, and details of contacts with various organisations.

- S details of a LION rampant used on the club badge and in connection with merchandise available from Aston Villa Football club, all dating from well after the relevant date.
- S an undated extract from the members directory for the British Footwear Association, the cover bearing a LION passant.
- S Royal coat of arms containing, inter alia, a LION rampant.
- S prints taken on 7 January 1999 from the web sites of Caledonian McBrayne ferries, Peugeot, Chelsea Football club, Norwich City Football club, The Scottish Football Association and Scottish Rugby Union showing these to use a LION rampant.
- S print taken on 13 January 1999 from the web site of Church's English shoes showing them to use a LION rampant.
- S details of a LION rampant on the club badge and in connection with merchandise available from Dundee United Football club, Glasgow Rangers Football club and Southend United Football club (including a print from their web sites) all either undated or dated after the relevant date.
- S prints taken on 6 and 7 January 1999 from the web sites of The English Cricket Board and Real Soccer fans respectively, showing that the ECB and the England Football Team use three LIONS passant in their badges.
- S details of products available from a company Geared For Travel who use a LION passant logo, all either undated or dated after the relevant date.
- S print taken on 13 January 1999 from the web site of Lion PVC Products Limited showing them to use the head of a LION.
- S extract from British Footwear Association members directory showing use of a LION passant by Lionheart Footwear.
- S print taken on 7 January 1999 from the web site of London Scottish Football club showing them to use a LION rampant in their badge.
- S brochure showing use of a LION rampant on the club badge and in connection with merchandise available from Middlesbrough Football Club, which can be dated as being from after the relevant date.

- S print taken on 7 January 1999 from the web site of Royal Doulton Company showing them to use a LION passant in their company logo.
- S print taken on 31 December 1998 from the web site of Sunderland Football club showing them to use two LIONS rampant in their badge.
- S print taken on 6 January 1999 from the web site of The British Olympic Association showing them to use a stylised LION passant.
- S print taken on 7 January 1999 from the web site of Otimums Designs showing a logo of a LION rampant noted as “English Schools Approved”.

The remainder of the exhibit does not show use of a recognisable LION.

Ms Coleman makes particular reference to the fact that the British Footwear Association use the device of a lion in its promotional literature, and as a client of the opponent’s trade mark attorneys they must be aware of this and see no difficulty.

Ms Coleman goes on to refer to her own investigations at a local department store which revealed that LION devices having some of the features referred to by Mr Foster are being used in respect of china products. Details of these marks are shown as exhibit VLC3, which consists of a photograph of the underneath of an item of china, and details of two trade mark registrations owned by Royal Doulton (UK) Limited, all depicting a LION passant.

Ms Coleman goes on to say that she also conducted a company and internet search on The Football Association, The Football League and The FA Premier League, noting that The Football Association holds one preference share in The FA Premier League and that they both operate from the same offices but have different registered addresses. Ms Coleman says that The Football League appears to be an autonomous body but operates under the jurisdiction and within the framework of The Football Association governing body. She continues saying that The Football Association Premier League was formed at the end of the 1991/2 season when the first division clubs resigned from the Football League to form their own “Premier” league.

Ms Coleman notes that all three bodies operate in football and are the registered proprietors of trade marks containing or consisting of LION devices. She refers to exhibit VLC4 which contains details of three trade mark registrations incorporating one or more LIONS,(in different classes) owned by The Football League Limited, The Football Association Premier League Limited and The Football Association Limited, and details of the history and organisation (shareholder and directors lists, etc) of these companies.

Ms Coleman says that a LION is extensively used in heraldry in a variety of poses, and she refers to exhibit VLC5, which consists of information on heraldic LIONS taken from The Wordsworth Complete Guide to Heraldry, 1996 edition. The exhibit shows numerous images of LIONS including a LION PASSANT having the raised fore-paw, style of tail and pose looking left referred to by Mr Foster as being features of the opponent's mark.

She says that heraldic LIONS also appear on school uniforms and the like, an example of which she shows as exhibit VLC6. The exhibit consists of a cloth badge bearing the image of a beast, but not necessarily a LION. Ms Coleman explains why she believes the image of a LION may be popular with traders. She refers to the fact that LIONS have been used in hallmarking for several centuries, referring to exhibit VLC7 which consists of a pamphlet on hallmarking produced by the Department of Trade & Industry, which details the history of hallmarking and the hallmarks used including a LION PASSANT with a raised fore-paw and tail. Ms Coleman concludes this Declaration by saying that she believes the opponents are not entitled to exclusive rights in the device of a LION.

Opponent's evidence in reply

This consists of a Statutory Declaration dated 23 March 2000 by Richard Craig Scudamore, Chief Executive of The Football Association Premier League Limited, a position he has held since 8 November 1999. He confirms that the facts contained within the Declaration have either been told to him, are of his own knowledge or have come from the records of his company.

Mr Scudamore goes to the Declarations by Vivienne Lloyd Coleman, the Trade Mark Attorney representing the applicants in these proceedings. He refers to the similarities in the stance and features of the respective LIONS. He says that his company's LION device is extremely well known and has been licensed, referring in particular to the agreement with Claremont Garments Limited, speculating on the way they are likely to use the mark on the goods.

Mr Scudamore refers to Ms Coleman's search of the trade mark register, noting, inter alia, that there are a few with the LION in an identical pose, many have other elements and that some are not in the classes in which the application has been made. He says why the fact that his company's trade marks were not raised as objections under Section 5 is immaterial and that in his opinion the differences are not sufficient to eliminate the possibility of confusion, particularly taking into account imperfect recollection.

Mr Scudamore accepts that the press cuttings exhibited by Mr Foster do not show his company's trade mark and confirms that the public did not see the mark until 1992. He asserts that his company's trade mark is well known and that evidence of licensing is relevant, referring to exhibits RCS1 and RCS2 which he says shows actual use of the mark in respect of the relevant goods. The exhibits consist of three photographs of items of

outer clothing, printed matter, board games, a football and a chocolate bar, all seeming to bear the opponent's LION trade mark (although not clearly so in all cases), but as there is no way of dating them they cannot be taken as showing use prior to the relevant date. He reiterates the assertion made by Michael Foster, that the public would associate the LION device whether with, or without the words THE PREMIER LEAGUE, with his company, making reference to the extent of the media coverage, sales of merchandise bearing the trade mark and its use on football strips worn by players and as replica strips sold in shops.

Mr Scudamore comments on the uncertainty of the applicant's intended use of the mark and that exhibit VLC1 shows that it used in such a small size that it could easily be mistaken for the opponent's trade mark. He dismisses the findings of Ms Coleman's investigations into the use of LIONS as irrelevant and immaterial and goes on to say why he considers some of the instances mentioned by Ms Coleman to be so.

The final Statutory Declaration is dated 25 September 2000, and comes from Sarah Jane Leno, a trade mark attorney employed by Forrester Kelley & Co, the opponent's representatives in these proceedings.

Ms Leno comments on the Declaration made by Vivienne Coleman, and in particular, to Ms Coleman's assertion that paragraph 18 of Michael Foster's Declaration (in which he refers to the likely effect of media coverage on the recognition of his company's trade mark) is opinion with no evidence to support. She goes on to refer to the exposure of the opponent's mark through broadcasting of Premier League matches, and to the contractual arrangements, in particular with BSkyB. A copy of the agreement with Sky Sports is shown as exhibit SJL1 and refers to regular weekly broadcasting of Premier League football matches and highlights, and the use of the trade mark in the opening and closing titles, trailers, promotional materials and results services.

Ms Leno refers to exhibit SJL2 and SJL3, which consist of details of broadcasts of Premier League football matches, inter alia, in the United Kingdom. The exhibit includes audiences figures for Sky broadcasts relating to Premier League football matches for August 1999 to May 2000 (after the relevant date) and the number of times on which the opponent's logo appears on screen, stating this as "massive".

Ms Leno refers to the use of the opponent's logo by Carling who are the sponsors of the Premier League, exhibit SJL4 giving examples of such use. The exhibit includes:

- S a copy of a newsletter with each page headed CARLING F.A. PREMIERSHIP BULLETIN with the opponent's LION device contained within a football. The newsletter is marked as ISSUE No 2 and refers to the 2000/2001 football season so clearly originates after the relevant date, and it is not clear whether the reference to the issue number means that this is the second issue in that season, or in totality.

- S two photographs depicting the CARLING F.A. PREMIERSHIP manager and player of the month for August 2000, after the relevant date.
- S 3 extracts from national newspapers published in September 2000 (after the relevant date) relating to results, events and a competition.
- S copy of the Ipswich Town v Sunderland match programme for 26 August 2000, after the relevant date.
- S compact disc containing electronic images of, inter alia, the CARLING F.A. PREMIERSHIP logo. There is nothing by which to date the CD.
- S two copies of a leaflet listing the fixtures for matches in the CARLING F.A. PREMIERSHIP for the 2000/2001 season, after the relevant date.

That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

Turning first to the grounds under Section 5(2). That section reads as follows:

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

An earlier trade mark is defined in Section 6 of the Act as follows:

6.- (1) In this Act an “earlier trade mark” means –

a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 2, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schufabrik Meyer & Co. GmbH v Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*, paragraph 23; 15 (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to 30 mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 29.

The opponents rely on three trade marks, one for the device of a LION, and two for the same device but with the words PREMIER LEAGUE underneath. I propose to conduct the comparison based on the device mark without the words, for if the opponents fail in this they would be in no better position in respect of the other two other marks incorporating the words PREMIER LEAGUE.

The opponents refer to three specific aspects of the mark applied for which they say are similar to their earlier mark, namely, that the tail and right front forepaw are raised in the same manner and that both LIONS face to the left. Whilst in any comparison it is inevitable that particular elements of a mark will be referred to, and should be if they are the distinctive and dominant components, it is clear that the comparison must be made on the basis that the average consumer normally perceives a mark as a whole, and that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks.

The respective marks are clearly LIONS, an animal which in my view would be known to most people, who, if they have not seen one in real life, are likely to have done so in books, on television or the like. Given that the respective marks are based on an existing animal and are not solely a product of the imagination, it is not surprising that there are similarities. However, as indicated in the Sabel trade mark case, where trade marks consist of an image with little imaginative content, this similarity of concept is not, in itself sufficient to conclude that there will be confusion, and I would go so far as to say that the less imaginative content, the closer a mark will have to be for there to be a finding of similarity. However, where features of the image portrayed in a trade mark have been subjected to a degree of interpretation or stylisation, similarity in respect of these features in a later mark is likely to be regarded as a strong factor in any assessment of the likelihood of confusion.

Both marks have some degree of stylistic interpretation, be it in the manner in which they are represented or in the use of additional elements, but there can be little doubt that they will be seen as and referred to as LION marks. The applicant's mark is a reasonably true-to-life representation whereas in the opponent's mark the LION is depicted wearing a crown with a football placed beneath a raised forepaw being more of a characterisation and having a more modern look than the applicant's more traditional heraldic style of LION. All of this in my view has a diminishing effect on the visual and conceptual similarity.

Turning to the respective goods. The opponent's earlier mark is registered in Class 25 for a range of goods that are self evidently identical in all respects, ie, customer, channels of trade, etc, to the items of outer clothing, and similar to the items of underclothing covered by Class 25 of the application. In respect of the goods covered by Classes 3 and 18, I look to the guidance of Jacob J. in the TREAT trade mark case (1996 RPC 281) in which he set out the following factors as being relevant when assessing the similarity of the

respective goods or services:

- (a) the respective users.
- (b) the respective uses.
- (c) their physical nature.
- (d) the respective channels of trade through by which reach the market
- (e) in the case of self-serve consumer items, whether they are or are likely to be found on the same or different shelves.
- (f) the extent to which they are competitive (and whether they are in the same or different trade sectors).

Class 3 of the application covers soaps, perfumery, essential oils, cosmetics and hair lotions, all everyday items that I would say are more than likely to be used, and bought by the same consumers that would purchase the opponent's clothing. Such goods are quite clearly different in their uses and physical nature. From my own knowledge I know that some well known trade marks established on what would be termed as "designer label" clothing are also used on a range of complementary fashion items such as perfumery and toiletries. But this is not the case in respect of clothing manufacturers at large, and I do not consider that the relevant consumer would expect this to be the case in respect of a trade mark established and centred around the game of football. Whilst there is evidence that football clubs trade in a range of merchandise, including clothing, it does not establish that this was the case at the relevant date, and what there is shows this trade to be focussed at promoting the football club to its fans. There is no evidence that football associations have ever traded in such a way.

The goods in both cases are likely to be obtained by self selection, but no matter how they are obtained, they will clearly be found in different parts of the stores, and by virtue of their differences in nature (clothing usually being hung on rails) on different shelves. I do not see how the respective goods could be considered competitive and apart from the instance cited above, would be considered as being in different trade sectors. Consequently, I find the goods covered by Class 3 of the application not to be similar.

Class 18 of the application covers furs, travel bags, hand bags, umbrellas, parasols and walking sticks, and again, but perhaps with the exception of furs, are all items that are more than likely to be used by and bought by the same consumers. I exclude furs because in Class 18 these would be an unfinished or semi-finished product for further manufacture and most unlikely to be available to, let alone purchased by, the consumer at large. Goods such as bags and umbrellas clearly have different uses to clothing and although capable of

being made of essentially the same materials, are different in nature. In all cases the goods are likely to be available for self selection by the consumer.

From my own experience I know that it is not unusual for traders in clothing to also trade in complementary fashion items. Handbags are often sold as a matching accessory to particular styles of clothing, as are umbrellas which are matched to overcoats, scarves, gloves and hats, and consequently, may well be displayed alongside one another, and although I am not aware that this is the case in respect of walking sticks, there is no reason why they could not be sold in shops selling, for example, outdoor type clothing. I have already mentioned that in my view the respective goods may well share the same channel of trade at the retail end, and I see no reason why this should not be the case in respect of the manufacturing and wholesaling stages. At best I would consider the goods to be complementary and not in any way competitive. Taking all of this into account, I take the view that the goods covered by Class 18 of the application (other than furs and walking sticks) could in some instances be regarded as an accessory to items of clothing, but I do not consider that this is sufficient to conclude that they are similar to such goods.

The opponent's trade mark is clearly distinctive in its own right. It has had the benefit of massive exposure, primarily through the medium of television, such that there can be few consumers, even amongst those with little interest in football, that will not have heard of The Premier League. Fewer are likely to have seen or would be able to recognise the opponent's LION (solus) as the badge of that organisation, but this would still be likely to represent a substantial proportion of the public.

Whilst there can be little doubt that the opponents have a significant reputation, this is very much centred around football, and it may well be that in respect of football kits (players or officials), footballs and the like, that the public, on seeing the applicant's mark may bring to mind the opponents, but even this is by no means certain. The opponents say that through the licenses granted to various manufacturers, their LION mark will have become known and associated in the minds of the public with a trade in a range of goods, but there is little that can be attributed to having taken place prior to the relevant date, and what there is lacks the detail to be of much assistance in gauging the extent of any likely reputation.

I know from experience that a trade in merchandise does take place, but as clearly shown by the evidence, this is targeted at supporters who wish to show allegiance to a particular club or country, but in all cases, still very much focussed on football. There is no evidence that the opponents or any of the other football associations customarily trade in clothing, or indeed any other goods, and consequently, I do not see that there will be an expectation of this from the consumer. It seems to me that any reputation subsists in the name THE PREMIER LEAGUE (with or without the LION) and in respect of the game of football and items related to that game, and that the opponent's mark has a football beneath its raised paw serves to emphasise this connection. I do not, therefore, consider that the use

the opponents have made of their mark has accrued a reputation that adds to its distinctive character such that it warrants exceptional protection.

Taking all of the above into account and adopting the “global” view advocated in the cases I have cited, I come to the conclusion that whilst the respective marks may well be referred to as LION marks, and have some conceptual and visual similarities insofar as they are both LIONS, the differences are such that the marks cannot be regarded as being similar simply because they share some features. Put simply, they look quite different. The goods may well be the same in respect of Class 25, but I would consider that the difference in the marks is such that even allowing for this identity and the extent of the opponent’s reputation, a consumer on seeing the applicant’s mark may recall that the opponents mark also has a LION, but will not be deceived or confused into believing that the goods are those of the opponent or an organisation linked to them. It follows that the opponents would be in no better a position in respect of dissimilar goods. Accordingly the ground under Section 5(2)(b) fails.

Turning to the ground under Section 5(4)(a). That section reads as follows:

5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an earlier right in relation to the trade mark.

The opponent’s confirmed that the basis of their objection was under the law of passing off. Mr Geoffrey Hobbs QC sitting as the Appointed Person in the *Wild Child* (1998 RPC 455) set out a summary of the elements of an action for passing off. The necessary elements are said to be as follows:

- (a) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (b) that there is a misrepresentation by the defendant (whether or not intentional leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

Section 5(4)(a) of the Act offers protection to the goodwill and reputation built up by a trader through the use of a sign. I have already highlighted the weakness of the opponent's claim to a reputation within the United Kingdom and they are in no better a position with respect to goodwill. From the evidence it appears that they have only used a mark in the form in which it is registered, and having found the marks to be different I do not see how there can be misrepresentation. Consequently, I am unable to find that the opponents will suffer damage by the applicants' use of the mark in respect of the goods they seek to protect and the objection under Section 5(4)(a) fails.

The final ground is under Section 3(6). That section reads as follows:

3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

The wording used in the statement of case suggests that they believe that the applicants are using a very similar trade mark to their own and are using it in such a way so as to deceive the public and derive some benefit from their reputation.

In my view the onus in an allegation of bad faith rests firmly with the opponents, and if they are to stand any chance in a claim that the trade mark applied for is theirs and not the applicant's they will have to establish that, at the relevant date, their mark was well known, in the United Kingdom, to the point that the applicant must have known it belonged to them, or that they would have known through some other circumstances, for example, a trade connection.

Whilst I do not doubt that at the relevant date the opponent's mark had a reputation, I have no evidence that the applicants were aware of this. Even if I were to accept that the opponent's reputation is such that this would have been a probability, the evidence of their use is insufficient for me to be able to conclude that they had traded to the extent that another trader in similar goods is likely to have been aware of their use, much less that this awareness extended to the possibility that an organisation very much centred on football may use their LION logo as a badge of origin in the course of a trade in goods, or that they had registered the logo for such use. Consequently, I find the ground under Section 3(6) fails.

The opposition having failed on all grounds I order the opponents to pay the applicants the sum of £635 as a contribution towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 03 day of December 2001

**Mike Foley
for the Registrar
The Comptroller General**

Annex A: Order a copy