

O-160-11

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION 2510844
BY THE FOOTBALL ASSOCIATION LTD TO REGISTER THE TRADE MARKS

Respect 

AND



Respect

AS A SERIES OF TWO, IN CLASSES 16, 18, 19, 25, 26, 28, 35 AND 41, AND
IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 99505
BY LEISUREWEAR INTERNATIONAL LTD

TRADE MARKS ACT 1994

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BACKGROUND AND PLEADINGS

1. On 11th March 2009, The Football Association Ltd of 25 Soho Square, London, W1D 4FA (hereafter “the FA”) applied to register the marks as above in Classes 16, 18, 19, 25, 26, 28, 35 and 41. The goods, the subject of the opposition are in Classes 16, 18 and 25 as follows:

Class 16:

Printed matter all relating to football.

Class 18:

Sports bags, other than shaped to contain specific apparatus used in playing sports.

Class 25:

Clothing, footwear and headgear

2. The application was allocated number 2510844 and was published in the Trade Marks Journal on 5th June 2009, and on 4th September 2009 TMLP LLP of Salbec House, Winders Way, Salford, Manchester M6 6AR (hereafter “TMLP”) lodged an opposition against the goods specified above.
3. On 4th March 2010 a request for substitution of the opponent was served by attorneys acting for Leisurewear International Ltd (hereafter “Leisurewear”), saying there had been a full transfer of ownership from TMLP to Leisurewear on 4th January 2010, which had been recorded on the relevant UK and OHIM registers. Under the normal conditions of a substitution, Leisurewear had had sight of all papers filed to date, stood by the original grounds of opposition and were aware of, and accepted, their liability for costs. In the absence of any issue taken by the FA on the question of substitution, the registry confirmed on 24th May 2010 that Leisurewear were to be treated as the new opponents.
4. Leisurewear has opposed on the sole basis of section 5(2)(b), citing the following earlier marks:

Marks. Filing and registration dates	Goods and services relied upon under section 5(2)(b)
GB 2379134 ('134) RESPECT 27 th November 2004 20 th January 2006	Class 25: Clothing, including belts for wear, headgear, footwear
CTM 5052469 ('469) RESPECT 12 th April 2006 24 th May 2007	Class 16: Paper, cardboard and goods made of these materials, not included in other classes; printed matter, periodical publications; books, photographs; stationery; diaries; adhesives for stationery or household purposes; instructional and teaching material (except apparatus); binders; office requisites; posters; pens; bookmarks; calendars; wrapping paper; notepads; date books; albums; catalogues greeting cards; drawing and writing instruments; card holders. Class 18: Leather and imitations of leather and goods

	<p>made of these materials; trunks and travelling bags; umbrellas, parasols and walking sticks; cases and bags; rucksacks, knapsacks, back packs, shoes bags, sports bags, beach bags, cases for mobile telephones, shoulder belts, belts, straps and bands of leather; bandoliers, boxes, wallets, purses, satchels and luggage; sling bags for carrying infants; wallets; card cases (notecases); key wallets; key cases; purses; umbrellas, parasols and walking sticks; shoulder belts (straps) of leather; parts and fittings for all the aforesaid goods.</p> <p>Class 25:</p> <p>Articles of clothing including belts, gloves, scarves, lingerie, underwear, sportswear, hosiery; footwear; headgear.</p>
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5. In their pleaded case, Leisurewear say the mark applied for combines the word 'RESPECT', in prominent form, with the FA logo. As such the mark reproduces the opponent's mark entirely and only adds a 'small' logo. They say their mark is highly distinctive for the goods in question. As the respective marks share the known dictionary word, RESPECT, then conceptually, this establishes an incontestable similarity or identity. As the respective goods are identical, then, taking all factors into account there is a likelihood of confusion under section 5(2)(b).
6. The FA filed a counterstatement denying a likelihood of confusion, saying there is sufficient overall difference between the respective marks, and in particular, denying that the three lions' device element is merely of secondary importance and that the opponent's mark is highly distinctive. Given the presence of the device element, the FA denies phonetic or conceptual similarity, saying all elements comprise essential elements in any analysis. Even if the respective goods are identical or similar any such identity is offset by the absence of similarity in the marks. Taking all factors into account there is no likelihood of confusion.
7. Evidence has been filed by parties, and insofar as it is factually relevant I shall summarise it below. Both parties request costs. No hearing was requested by either party, but additional submissions have been filed by the FA which I shall take into account in my decision.

Opponent's evidence

8. This takes the form of a witness statement dated 8th April 2010 from Yamin Ibgui, a director of Leisurewear. He says his company designs and arranges the manufacture, distribution and sale of clothing, footwear and headwear, as well as accessory goods such as bags, purses, wallets and promotional items, including printed catalogues. All these goods are branded with the RESPECT mark which was first used in the UK at least as early as 1996.
9. Exhibit YI1 comprises letters from some of his customers, including retailers with a UK wide presence, like T J Hughes and Wilkinsons. These letters are addressed to his company's former solicitors, Keeble Hawson. There is a firm called ICE BLUE RETAIL Ltd based in Hertfordshire who attest to buying RESPECT branded clothing from Leisurewear and its predecessors for 30 months. The letter is dated 23rd March 2006. A company called KIDDIES WORLD, based in Leeds, say they have bought RESPECT branded clothing for 10 years, over which period, they have bought approximately over half a million RESPECT branded items to the value of approximately over one million pounds sterling. T J Hughes has bought RESPECT items for eight years, buying approximately 200,000 garments at a value of approximately £300,000. Wilkinsons have been buying RESPECT items since August 2004 (their letter is dated 26th March 2006) and have bought approximately 624,166 items.
10. Exhibit YI2 comprises copies of purchase orders showing sales to various customers from April 2003 to November 2005. These orders show a wide variety of garment listed, including boys tops and jumpers, swimming trunks, football shirts, jackets, jeans, T-shirts and fleeces. Mr Ibgui estimates that turnover attaching to RESPECT products since 1997 has varied between approximately £500,000 and £4 million.
11. Exhibit YI3 shows examples of labelling used on the RESPECT products. These examples were first used in relation to another separate opposition in March 2006. Consequently the examples date from 2006 or earlier. The first two pages are date stamped 2004. These labels show the word 'RESPECT' in different styles, ranging from heavily stylised graffiti style lettering through to a much plainer and recognisable text. The labels appear as, eg swing tags, woven labels, stickers and so on. The clothing appears to be aimed at a predominantly children's market.
12. Exhibit YI4 comprises 'artwork' sheets, showing examples of current use of the RESPECT mark, in relation specifically to sports clothing such as: socks, tops, t-shirts, track suits and trousers. Some of the items are designated for football specifically. Invariably, the word 'RESPECT' is used in conjunction with either the word 'ENGLAND', and/or the flag of St George.

Applicant's evidence

13. This takes the form of a witness statement dated 16th September 2010 by Dermot Colm Collins, who is Manager of the Football Association Ltd' s 'Respect' Programme. The Respect Programme is a long term programme developed to improve the overall standards of behaviour in football across all levels, from grassroots to professional leagues. He describes the programme as having a nationally recognised identity, specifically designed to ensure a base of registered referees to meet demand. This aim being achieved through a zero tolerance for assaults on referees; that there is an improvement in on field behaviour in particular in the realm of dissent; that parents, spectators and coaches understand what may be acceptable and unacceptable behaviour, and that there is an enjoyable learning environment for children's football.
14. The tools used to further these aims include: agreed codes of conduct, in service training for referees, club packs, spectator designated spectator areas, as well as tools to ensure that captains work with referees to manage behaviour.
15. Within the programme are individual campaigns, such as an: "Are you losing it?" campaign, targeting abusive grassroots players and parents, encouraging disaffected players and supporters to highlight other players and supporters most in need of a 'wake – up call'.
16. He says that the mark devised by the company consists of the word 'RESPECT', together with the device of the three lions crest. The Crest is described as being the company's corporate identity and has been used in connection with its football related activities, including merchandise and services, since as early as 1872.
17. The word 'RESPECT' was chosen as an obvious word to encourage collective responsibility for actions and to encourage the creation of a fair, safe and enjoyable environment to enjoy the game. The word is presented in bold typeface alongside the device.
18. The company has developed a set of rules and guidelines concerning the proper use of the mark. These are distributed to the clubs taking part in the programme. Exhibit DCC1 is a copy of the guidelines, prescribing, for example, the particular form in which the mark can be used. These detailed guidelines say, for example, that the mark should always appear as a two element mark with neither element appearing in isolation and that the aspect of the two elements should not be varied either.
19. The mark was first used in March 2008 in promotional literature distributed throughout the UK and also on a pitch side barrier system. Approximately

15,000 units of this pitch barrier system were sold. From September 2008, the mark was used extensively in club information packs and captains' armbands and has since been applied to promotional items such as: t-shirts, hats, badges, banners, flags, pens, advertising hoardings and the like.

20. Although the programme has only been up and running since March 2008, it has received widespread press coverage and has been identified as 'the behavioural code for football', due in part to the adoption and use of the same word, 'RESPECT', by UEFA, in connection with the marketing and staging of the Champions' League football competition.
21. Products and services under the mark are normally given away free of charge, and as such, it is not possible to provide turnover figures. That said, total advertising and promotional spend for the programme is given as £900,000 in 2008 and £500,000 in 2009.
22. Promotional activities also include: guideline booklets, fair play awards, codes of conduct packs, a captains' guide and dedicated webpage at www.thefa.com/leagues/respect. Specific events have also been used to promote the programme such as Leicester City v Newcastle United on 30th January 2010; Respect and Fair Play Awards 15th May 2010 at the FA Cup Final; various county FA tournaments and festivals; several England matches and a stand at the Grassroots Live Show 4th – 6th June where a stand was present. There is also a free online parent guide to highlight examples of poor behaviour and how it can be improved.
23. In May 2010, the RESPECT Programme won the Sports Industry Award for the best use of PR in a sports related campaign, and it also won a silver award as part of UEFA's "Grassroots Day Awards". Exhibit DCC3 is a press release covering the UEFA awards. High profile support has also been given by HRH Prince William who presented winners with the first ever RESPECT Programme awards, including for the Barclays Premier League and Football Leagues. Exhibit DCC4 is a press release in connection with those awards. Exhibit DCC5 is another press release about the success of the programme, in particular in relation to the recruitment of referees and the reduction in offences against, or involving, referees. This press release is dated February 2010, by which time 60,000 education packs had been sent out and 10,700 people had undertaken the RESPECT parent's course. The programme had by that time gained the support of over 707 different leagues in the UK.
24. The level of awareness of the RESPECT Programme is said to be 89% among those active in grassroots football, and 64% amongst football fans. These figures come from a survey by KantarSport in August 2010 and are exhibited as Exhibit DCC6.

25. Lastly, Mr Collins talks about the level of recognition for the three lions device which, he says, lessens the possibility of likelihood of confusion. He says the FA runs 24 different England teams and 11 competitions. The three lions crest was adopted in England's international match against Scotland in 1872. In 1949, the crown was removed but little has changed in the design since then. In the 1948-49 season the crest was granted by the College of Arms. There is a booklet at Exhibit DCC7 explaining the history of the crest which has also been used by third parties under licence.

Opponent's evidence in reply

26. This takes the form of a witness statement dated 20th November 2010 by Judith Tonner, a trade mark attorney acting for the opponent. It is entirely legal submission and critique in response mainly to criticisms of the opponent's evidence by Mr Collins. As such, I have no need to summarise such evidence from a factual perspective at this stage, nor did I have any need to record Mr Collins' criticisms of the opponent's evidence either, but I shall take both into account in due course.

DECISION

Section 5(2)(b)

27. The opposition is founded upon Section 5(2) (b) of the Act. This reads:

“(2) A trade mark shall not be registered if because –

(a).....

(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.”

28. Both Leisurewear's trade marks qualify for consideration as 'earlier trade marks' in accordance with section 6(1) of the Act. Neither is subject to proof of use requirements under section 6A of the Act, as, at their dates of registration, they were under 5 years old prior to the date of publication of the application. Leisurewear's best case lies with their '469 mark as the specification is broader than the '134 mark, whilst the content of the mark itself is exactly the same. For this reason I intend only to focus on the '469 mark.

29. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the

European Union (“CJEU”) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P* (LIMONCELLO). 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*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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 Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(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*,

(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*,

(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.*,

(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*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) 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 and Adidas Benelux BV*,

(j) 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.*,

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

The average consumer and nature of the purchase

30. The average end consumer for both parties' products, in a notional sense, will be the general public. In the FA's case, they have football related printed matter and sports bags and so the 'public' engaged with those items will be sports inclined; whereas the average consumer for Leisurewear's goods is not necessarily so inclined. Both parties though, have clothing at large. There is complete overlap as far as the identities of the average consumer for both parties are concerned.
31. Both parties' goods are normal, everyday goods. They are goods bought or read from a wide range of outlets.
32. As to the level of attention paid in the relevant purchasing process, plainly for more expensive clothes for special occasions this will be more than relatively inexpensive items bought for everyday use. Even for inexpensive clothing however, consumers are very conscious they are buying personal items and style is very important. On that basis the purchase is a considered one. Sports bags and leather goods are not perhaps bought as regularly as clothing at large, but they are not thereby specialist items, only available through limited outlets and subject to a unique or specialist purchasing

process. The applicant says its products will be bought on impulse (or not even bought at all, as they are given away free of charge) and the opponent's will be a considered purchase. It must be remembered however that I am engaged in a notional assessment which does not take into account the particular marketing strategy that the parties may be engaged in. I will say a little more about this in the context of my overall assessment of likelihood of confusion.

33. These observations into my analysis of likelihood of confusion.

Distinctiveness of the earlier mark

34. Before I undertake a full comparison of the marks, in this case I need to make an assessment of the distinctive character of the earlier mark. This is because the FA's marks are composite marks having more than one element, and it is preferable that I have first assessed the distinctive character of Leisurewear's mark so that this assessment can be fed into my subsequent comparison of marks.

35. An invented word having no derivation from known words is, in its inherent characteristics, very high on the scale of distinctiveness, KODAK being the prime example.



36. The earlier mark is the word 'RESPECT'. This is a known dictionary word. Although it has no obvious connection with the goods for which it is registered; from its dictionary definitions it nonetheless has a laudatory quality about it. Given its laudatory 'feel', I find that it has no more than a moderate level of inherent distinctiveness.

37. Though they have not expressly relied upon it, I need to consider also whether this level of inherent distinctiveness has been enhanced through use. At this point the FA raises a number of technical criticisms of Leisurewear's evidence, saying for example: that it relates to a period well before the date of application of their marks, that it comprises figures which not backed up by invoices, that there is no evidence that the labels or artwork were actually used on goods or that clothes to the particular designs were marketed. I am not persuaded by all of these criticisms; it is inevitable that Leisurewear's evidence for example will predate the date of application and if the director of Leisurewear states in a witness statement that turnover amounts to 'x', and there is no request for cross examination, then the production of invoices does not appear an essential requirement. Likewise, the criticisms of the labels and artwork. The letters from the various retailers also appear to me to constitute sound evidence. That said, what concerns me a little more is the absence of overall context into which the sales figures are put. In other words, there is no market share analysis and the size and range of the retailers, although it includes Wilkinsons and T J Hughes, is not huge. I also have to

say that, although I accept usage on swing tags and labels, it is the case that certain of the evidence, for example, the artwork examples may come across to the average consumer as being use of the word 'RESPECT' in a purely decorative sense. That is to say that use emblazoned in large letters across a T-shirt or sports shirt, would tend to be regarded as decorative, and as such, the casual shopper (rather than purchaser) may not appreciate the trade mark significance of such usage. Finally, there is no evidence of promotion or advertising the mark. All things considered, I do not find that the distinctiveness of the earlier mark has been enhanced through use.]

Comparison of marks

38. The case law makes it clear I must undertake a full comparison (taking account of visual, phonetic and conceptual similarities and dissimilarities), from the perspective of the average consumer. Marks need to be considered in their totalities and overall impression (see authority (k) above in para 29), taking account of distinctive and dominant elements. The relevant marks to be considered are:

Leisurewear's mark	The FA's marks
<p>RESPECT</p>	<p>Respect </p> <p>AND</p> <p></p> <p>Respect</p>

Visual comparison

39. Leisurewear's mark is a single, seven letter dictionary word, 'RESPECT', in plain script and upper case type. The FA's marks comprise two elements; the word 'RESPECT' in bold, with upper and lower case lettering and a slightly

mottled effect, together with an heraldic crest comprising three lions, interspersed with what appear to be floral designs. The heraldic crest is topped with letters spelling out, "The FA". The FA's marks differ in their configuration, with the first mark placing the crest element after the word 'RESPECT' in linear configuration, and the second, placing the crest element above the word 'RESPECT' in vertical configuration. Both elements are equally visible in both the FA's marks, neither one nor the other assuming a clearly 'de minimis' role in either mark. That said, the word RESPECT is larger, relative to the crest device, in the *first*, as compared to the second of the FA's marks and this needs to be recognised. Based on a purely forensic analysis of the similarities and dissimilarities between the respective marks, I find that, visually, the marks are similar to a high degree, sharing as they all do the verbal element, 'RESPECT'. In this regard, the different relative sizes of the word RESPECT in both the FA's marks does not have an impact.

Phonetic comparison

40. Leisurewear's mark will be enunciated, 'RES-PECT'. Both the FA's marks will be enunciated in the same way, 'RES-PECT'. It is possible that with the other verbal element in the FA's marks, being "The FA", their marks will be enunciated or pronounced as "The FA's RES-PECT" but, linguistically, this is unlikely in my opinion, as it is both ungrammatical and depends upon conjoining "The FA", which is inextricably linked the crest device, with the word 'RES-PECT'. Taking the similarities and dissimilarities into account I find that the respective marks are phonetically identical or, if I am wrong about that, then highly similar.

Conceptual comparison

41. By conceptual similarity, it is meant 'semantic' conceptual similarity. 'Respect' is, as I have said, a known dictionary word, having the following meanings¹:

" → *n.*

1. a feeling of deep admiration for someone elicited by their qualities or achievements. • (**respects**) polite greetings.
2. due regard for the feelings or rights of others.
3. a particular aspect, point, or detail.

¹ "respect *n.*" *The Concise Oxford English Dictionary*, Twelfth edition . Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2008. *Oxford Reference Online*. Oxford University Press. Intellectual Property Office. 22 March 2011 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t23.e47950>>

→ v.

1. feel or have respect for.

2. avoid harming or interfering with. • agree to recognize and abide by.”

42. As I understand the thrust of the FA’s argument, it is that their marks, by virtue of the presence of the words, “The FA”, and the crest, both of which they say enjoy a high degree of recognition and reputation, impart a clear conceptual meaning. Assuming there to be such recognition and reputation in the crest and words, ‘The FA’, this will inevitably lead to an association with football in England and respect in the game of football. In contrast, there can be no such linkage or context as far as Leisurewear’s mark is concerned.

43. Whilst I am prepared to accept that the crest device and words, ‘The FA’, will evoke football, and specifically the English football team, amongst a good proportion of relevant consumers, given their longevity of use and exposure, I am far less happy to then conclude there will be conceptual dissonance as a consequence. The fact is that the word ‘RESPECT’ is common to both marks. It is the only component of the earlier mark. In the context of its use on clothing (children’s and sports clothing in particular), it would be my view that, of the various dictionary definitions set out above, the meaning of the word which its isolated use is most *likely* to illicit is the first meaning; that of deep admiration for someone or something. I am aware from my own knowledge and experience of the current currency of the word in the context of youth culture in particular. The word is often used these days as a simple expression of approbation. That said of course, I must be cautious about attributing any particular meaning over and above any other; the word clearly has certain nuances of meaning which the average consumer, even a child, is going to be aware.

44. In terms of those nuances, the FA’s use of the word is plainly intended to illicit the second of the dictionary meanings, being that of ‘due regard to the feelings of others’, notably in their case, referees, other players and supporters. At the date of the application, the fact that the FA’s marks underpin a particular programme aimed at precisely that will also be known to many, but by no means all, average consumers of clothing, sports bags and printed matter relating to football.

45. That said, of course the two meanings I have referred to are not at ‘odds’ with each other; the one invoking ‘admiration’, the other, simply having ‘due regard to’. These two meanings are perhaps at different points of a spectrum, but it is the *same* spectrum because it is the same word, ‘RESPECT’, and the average consumer will not have the benefit of conducting the kind of analysis I am required to do. They will simply be confronted by the same word, ‘RESPECT’, to make of what they will. On a purely notional analysis, if there

is any conceptual 'dissonance', it is only because the FA's marks contain the additional, but independent (of which more later), device element which for many (but not all), will link the word 'RESPECT' to football. No such linkage will be apparent with Leisurewear's mark.

46. In the circumstances, I am bound to find conceptual similarity to a high degree by virtue of the shared and common word, 'RESPECT'.
47. But of course this is not the whole picture, and I must consider the marks as wholes, taking account of distinctive and dominant elements.

Overall similarity of marks

48. The analysis I have done above in paras 34-35 needs now to feed into my overall assessment of similarity of the marks
49. Leisurewear's mark is a single word mark, RESPECT. It only has one element and is not therefore a complex mark. I have already found it to have a moderate level of inherent distinctiveness, as above in paras 34-35.
50. I need to decide whether the word 'RESPECT' can then be said to be distinctive and/or dominant in the FA's later, composite, marks. In this regard, the word RESPECT stands alone in both the FA's marks, without any other, immediately surrounding, verbal context. I do not understand the FA to dispute that their marks comprise *two* distinctly, discernable elements – being the word 'RESPECT' and the crest device (including the words 'The FA').
51. In the first of the FA's marks, it would be my view that both elements, namely the word RESPECT and the crest device, have equal 'dominance', whilst sharing, of course, the same moderately distinctive and 'stand alone' word element, 'RESPECT' as Leisurewear's mark. On that basis I find that, as far as the *first* of the FA's marks is concerned, this is similar to a very high degree.
52. As regards the *second* of the FA's marks, I find that that the word 'RESPECT' plays 'second fiddle', and only a supporting role to the FA's crest device, given especially the positioning of the respective elements and letter size. On that basis, then, and as compared to the first of the FA's marks, I find that the respective marks are similar to a high degree. The impact of these findings will be considered in my overall assessment of likelihood of confusion.

Comparison of the goods

53. The relevant goods to be compared are:

The FA's goods	Leisurewear's goods
<p>Class 16: Printed matter all relating to football.</p> <p>Class 18: Sports bags, other than shaped to contain specific apparatus used in playing sports.</p> <p>Class 25: Clothing, footwear and headgear</p>	<p>Class 16: Paper, cardboard and goods made of these materials, not included in other classes; printed matter, periodical publications; books, photographs; stationery; diaries; adhesives for stationery or household purposes; instructional and teaching material (except apparatus); binders; office requisites; posters; pens; bookmarks; calendars; wrapping paper; notepads; date books; albums; catalogues greeting cards; drawing and writing instruments; card holders.</p> <p>Class 18: Leather and imitations of leather and goods made of these materials; trunks and travelling bags; umbrellas, parasols and walking sticks; cases and bags; rucksacks, knapsacks, back packs, shoes bags, sports bags, beach bags, cases for mobile telephones, shoulder belts, belts, straps and bands of leather; bandoliers, boxes, wallets, purses, satchels and luggage; sling bags for carrying infants; wallets; card cases (notecases); key wallets; key cases; purses; umbrellas, parasols and walking sticks; shoulder belts (straps) of leather; parts and fittings for all the aforesaid goods.</p> <p>Class 25: Articles of clothing including belts, gloves, scarves, lingerie, underwear, sportswear, hosiery; footwear; headgear.</p>

54. There can be no doubt that the goods are identical. In Class 16, Leisurewear has 'printed matter' at large, which would encompass the FA's 'printed matter relating to football'. In Class 18, Leisurewear has 'sports bags', which are identical to the items specified by the FA, albeit that the FA has limited the scope by excluding certain sports bags. In Class 25, Leisurewear's specification is also identical since it has clothing at large (whilst specifically including certain items, there is no restriction or limitation), and also footwear and headgear.

55. I find that the respective goods are identical.

Likelihood of confusion

56. I have found that the respective goods are identical. I have made observations on the respective average consumers, namely that they are also identical and I have found the purchasing process to involve considered purchasing.

57. I have found the respective marks to share a very high overall level of similarity as regards the *first* of the FA's marks, given the equal dominance of the respective elements. As regards the *second* of the FA's marks, I have found that to be similar to a high degree, given the lesser dominance of the word, 'RESPECT', relative to the FA's crest device.

58. Since, in the *second* of the FA's marks, I have recognised the word RESPECT not to have the same, equal, dominance as in the first of the FA's marks I need to consider the possible impact of the CJEU case, C-120/04 *Medion AG v Thomson Multimedia Sales Germany and Austria GmbH* ("*Medion*"), to which I have also referred in para 29. I need to quote from this case at some length:

"30. However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31. In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32. The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.
33. If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.
34. This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely-known mark or commercial name included in the composite sign.
35. Thus, contrary to the intention of the Community legislator expressed in the 10th recital in the preamble to the directive, the guarantee of the earlier mark as an indication of origin would not be assured, even though it still had an independent distinctive role in the composite sign.
36. It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark.
37. Accordingly, the reply to the question posed must be that Article 5(1)(b) of the directive is to be interpreted as meaning that where the goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein. “
59. The *Medion* case needs to be read alongside that of Case C-334/05 *Shaker di Laudato & C. Sas v OHIM* (“*Shaker*”), to which I have also been referred by the FA. In this case it was held that when considering composite marks, it is only permissible to carry out an assessment of similarity solely on the basis of the dominant element when all other components of the complex or composite mark are *negligible*. It is therefore important to recognise that neither the *Medion* nor the *Shaker* cases undermine the legal principle that composite marks need to be assessed with regard to their totalities.

60. Having said that, *Medion* says that, should I identify the 'RESPECT' element as being '*independently distinctive*', in this case within the second of the FA's marks, then, notwithstanding that that element may not be dominant, or otherwise even 'determine' the overall impression of the composite mark, a likelihood of confusion cannot be excluded. To find otherwise, says the Court in *Medion*, would be to undermine the 10th recital of the preamble to the directive which is to ensure that the earlier registered mark is 'protected' so that it may function as a guarantee of origin.
61. In this case, there is no doubt that the 'RESPECT' element in the second of the FA's marks, whilst not being dominant, is '*independently distinctive*'. The crest device and the word 'RESPECT' are two separate, distinct elements; the crest device gives the word 'RESPECT' its 'stamp of authority' and authenticity without varying its meaning, whilst the word tells the consumer that the FA is likely to have endorsed goods or services going under the mark 'RESPECT'. But what is without question is that the two elements in the FA's second mark are independently distinctive; they could exist separately. On that basis, it is the *Medion* case which is apposite as regards the *second* of the FA's marks
62. The *Medion* case alerts me in particular to its directive-based identification of the need to guarantee the function of the earlier mark. It is thus an important recognition that even where an independently, distinctive element within a composite mark is not, of itself, dominant within the composite, it is nevertheless deserving of 'protection'.
63. Needless to say that in making a global assessment, it is not a 'tick box' exercise, whereby if I find more factors in one parties favour, it inevitably wins. All factors must be weighed in the evaluation of likelihood of confusion.
- 64. In all the circumstances, and including my application of the *Medion* case in relation to the second of the FA's marks, I find there is a likelihood of confusion in this case in relation to all goods and in relation to *both* of the FA's marks. In relation to the first of the FA's marks, the RESPECT element is dominant and *Medion* is not therefore apposite.**
65. Having arrived at that conclusion I now want to consider whether there are factors pertaining to the case prior to the *date* of filing which may 'disturb' that finding. For example, the FA say that their goods sold under their mark are distributed free, and also that by the date of filing the fact that their usage was intended to identify a programme of football behaviour was well known. This, in part at least, has enabled the FA to say that there has been no instances of actual confusion.

66. On the question of the particular way (promotional distribution free of charge) in which the FA markets goods under its marks, the European Courts have developed a line of authority resistant to arguments about particular 'marketing activities'. In the case of *C-171/06P T.I.M.E Art v OHIM and Devinlec Developpement Innovation Leclerc*, the CJEU says:

"59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks."

67. Who is to say the FA's usage of their mark would not change at some point? Further, I must bear in mind that the FA has not applied to register the marks for an educational or behavioural improvement programme, but as a trade mark for goods. It is normally to be assumed that an application to register a trade mark for goods indicates an intention to establish a market under the mark for those goods rather than simply to give them away in order to promote some other activity. On that basis, I find that the FA's particular usage of the mark cannot be a 'disturbing' factor in my assessment.

68. This leads me to the broader question of whether the level of awareness of the programme and/or the crest device achieved by the FA prior to the date of application may also be a factor mitigating against likelihood of confusion. For example, the evidence mentions a survey (see para 23 above) which reveals an 89% awareness of the programme among those active in grassroots football, and a 64% awareness amongst football fans. The survey was taken in August 2010 and this is after the date of application and so one has to exercise caution. In addition, the constituents of the survey do not exactly map onto the identity of the respective average consumers who comprise a much broader constituency.

69. Finally, knowledge of the FA's programme and/or crest prior to the date of filing would not, of itself, necessarily mitigate against likelihood of confusion. That is to say, that a consumer who sees products sold under the FA's marks, recognises that it is the FA's crest in the marks and is also aware of the FA's programme, does not thereby draw the conclusion that goods sold under the FA's mark cannot possibly originate from the same undertaking as those of the earlier mark. In its own evidence of the degree of recognition achieved by the crest device, the FA speaks about its links with third parties, meaning its licensing activities. The likelihood is then that the average consumer will see use of the FA's marks as, in some way, being a collaboration between the FA and the owner of the earlier mark. On that basis I do not see that knowledge of either the FA's crest or the 'RESPECT' programme is a factor mitigating against likelihood of confusion.

70. I should also deal briefly with the question whether the applicant's 'concurrent' or 'parallel' use prior to the filing date, as shown in the evidence, has any 'disturbing' impact on my finding of likelihood of confusion. Whilst it is well established that evidence of what is often referred to as "parallel trading" may be a factor which could potentially assist in a determination of this kind, such evidence needs to establish that the respective marks have actually been put to use in the same market, without the consumer being confused regarding economic origin. If such evidence is forthcoming, this can inform the tribunal's decision. Alan Steinfield QC, sitting as a deputy judge of the High Court, in *Fiorelli Trade Mark* [2007] RPC 18 gave weight to an absence of confusion in the marketplace, however, this should be tempered by a number of decisions which express caution about the circumstances in which it is appropriate to give these factors weight (see the Court of Appeal in *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283 at page 291, Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at 809 and the Court of Appeal in *Phones 4U Ltd v Phone 4u. co. uk Internet Ltd* [2007] RPC 5 at paras 42 to 45.) In the first of the above cases Millet LJ stated:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

71. The evidence does not establish to my satisfaction that the respective marks have been put to use in the same market. Far from it. The FA has explained that it makes use of its marks in a 'promotional' manner which suggests they are not sold in the same outlets as those of Leisurewear. In fact, they do not appear to be sold at all. On that basis, I cannot factor in absence of actual confusion in the market place as a factor mitigating against likelihood of confusion.

72. In all the circumstances I find that none of the 'additional' factors identified in this case 'disturb' my finding that likelihood of confusion will arise in relation to all the goods. The opposition is thus totally successful.

Costs

73. Leisurewear has been totally successful in its opposition. Accordingly, it is entitled to a contribution towards its costs and neither party sought costs off the normal scale. In the circumstances I award Leisurewear International Ltd the sum of £1000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Filing fee for opposition - £200

Preparing a statement and considering counterstatement in both
the opposition and the revocation - £300

Preparing evidence - £500

Total £1000

74. I order The Football Association Ltd to pay Leisurewear International Ltd the sum of £1000. The sum should 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 13 day of May 2011

**Edward Smith
For the Registrar,
the Comptroller-General**