

DECISION OF THE TRADE MARKS REGISTRY

TRADE MARKS ACT 1994

APPLICANT: GUINNESS WORLD RECORDS LIMITED

APPLICATION N^o. 2206365

CLASSES 16, 25, 28 AND 41

AND

OPPONENTS : SARACENS LIMITED AND SARACENS RFC LIMITED

OPPOSITION N^o. 51553



TRADE MARKS ACT 1994

**IN THE MATTER of application N^o: 2206365
by Guinness World Records Limited**

and

**IN THE MATTER of opposition thereto under N^o: 51553
by Saracens Limited and Saracens Rugby Football Club Limited.**

BACKGROUND

Trade mark in issue

1. On 19th August 1999 Guinness World Records Limited, 8 Henrietta Place, London, W1G 0NB United Kingdom applied to register the following device mark:



Specification of goods and services

“Books, magazines, journals and printed inserts; paper, cardboard and stationery, namely, writing paper, folders, notebooks, notepads, memo pads; diaries, calendars, address books; postcards, greeting cards; pencil sharpeners, erasers, rulers, hole punches; pencil boxes and cases; ring binders, prints, posters, almanacs and transfers; writing instruments, namely, pens, pencils, crayons and tops for pencils; wrapping and packaging materials, namely, gift wrap, gift boxes, labels and tags; stickers and sticker albums; party poppers (paper casing with a surprise in the centre designed to make a popping noise when opened); paper bags, plastic carrier bags; playing cards in International Class 16.”

“Articles of clothing, namely, coats, jackets, vests, jeans, sweatshirts, t-shirts, rugby shirts, polo knit tops, swimsuits, pyjamas, night-dresses, boxer shorts, socks, head bands, wrist bands, scarves and belts; headgear, namely, baseball caps and hats; footwear, namely, dress, casual and sports shoes, sneakers and sandals in International Class 25.”

“Toys, games and playthings, namely, board games, balloons, die-cast metal vehicles, kites, miniature trains, model kits, inflatable riding/bounding toys, pogo sticks; playsets/activity sets, plush toys, puzzles, juggling sets; pinball machines; handheld electronic games; sporting equipment, namely, footballs and baseballs, flying discs, ping-pong paddles, skipping ropes, miniature trampolines, exercise bicycles; golfing equipment, namely, golf balls and golf clubs; fishing articles and equipment, namely, fishing rods, tackle and bags and/or boxes therefore; tennis equipment, namely, tennis

rackets and tennis balls; badminton rackets; skis and snowboards, skateboards, surf boards and windsurfing boards; in International Class 28.”

“Entertainment, education, instruction, tutoring and training services in relation to World Record breaking events, sporting events, competitions, games, quizzes, shows, audience participation events and shows; entertainment services provided on-line, by computer or via the Internet; database, on-line and global computer network information services, all relating to education, entertainment, recreation and publishing; production and presentation of television programs, films, radio programs and games; organisation, production and presentation of events for educational, cultural, or entertainment purposes; organisation, production and presentation of competitions, games, quizzes, shows, audience participation events; museum services; publishing services; production and presentation of educational and instructional information; provision of information relating to any of the aforesaid services in International Class 41.”

History

2. Registration is opposed by Saracens Limited (SL) and Saracens RFC Limited, the latter permitting exploitation of the mark by the former. SL are also the proprietors of the following registration No. 2063496, applied for on 23rd March 1996:



for the following goods

Class 9: “Computers, computer software, CD’s, CD ROMs, records, videos, video cassette recorders, electric and electronic scoreboard and timing apparatus and instruments; cameras and photographic apparatus and instruments, calculators, credit cards (encoded), telephones, phone cards but not including any such goods specifically relating to or designated for cyclists or cycling.”

Class 16: “Paper, stationery, printed matter, photographs, plastic bags, wrapping material, periodical publications, calendars; but not including paper napkins but not including any such goods specifically relating to or designated for cyclists or cycling.”

Class 25: “Articles of clothing, but not including suits, dresses, jackets and trousers but not including any such goods specifically relating to or designated for cyclists or cycling.”

Class 28: “Games, toys and playthings; sports games; rugby balls; balls for all sport; card games; electronic games; video games; computer games and computer game cartridges; jigsaw puzzles; flying discs; but not including bags but not including any such goods specifically relating to or designated for cyclists or cycling.”

Hearing

3. The grounds of opposition are given as under ss. 5(2)(b), 5(3) and 5(4)(a) of the Act. They were all denied by the applicants and both parties requested costs. It was recommended by the Registry that no hearing was necessary: neither party requested one, and no written submissions were received. As a result, this decision is based on the evidence filed. Only the opponents submitted such, the applicants relying on submissions made their Counterstatement.

EVIDENCE

Opponents' evidence

4. There are two opponents: Saracens Limited and Saracens RFC Limited. The former is the commercial arm of the latter, and was set up in 1995, taking an assignment of the right to use the Saracens name and device from the rugby club and now manage its commercial and sporting affairs.
5. The large amount of evidence from the opponents, was of varying utility. Of particular importance is that which goes to the notoriety of the opponents' mark: this has significance for all the grounds they plead: marketplace distinction under s. 5(2)(b), 'fame' under s. 5(3) and goodwill under s. 5(4)(a).
6. It is necessary, in my view, to separate the opponents' reputation as a professional English rugby football club from that they possess for other specific activities and goods. The distinction is important and parallels that found for certain celebrities such as rock and pop stars: they may have a reputation for musical entertainment, but none for the merchandising goods (t-shirts, posters, books etc.) sold in their name. Their prominence creates a trade in the latter, but is not based on it – and only in unusual circumstances do they gain a reputation for another trade.
7. Thus, I make a distinction between a 'true' trade in goods or services under a mark regarded as a symbol of the supplier of those goods (ultimately responsible for their quality) and a trade in goods and services under a mark which is tokenistic of some other trade or service. I will call the former genuine trade, the latter merchandising trade. Nevertheless, the distinction can become blurred – the trading activities of some association football clubs may be an example, and is particularly pertinent here.
8. Against this background, I have carefully reviewed the opponents' evidence, and note the following, from the only, but detailed, Statutory Declaration of Mr. Timothy John Lawler, the Managing Director of SL.
9. The first 13 paragraphs of Mr. Lawler's statement establishes only the reputation the opponents have as a famous rugby football club, by way of a description of their distinguished history and reference to various documents, detailing with the same, enclosed as exhibits. However, at paragraph 14, Mr. Lawler states:

“14. In 1996, SL has embarked upon commercial programme for the benefit of SFC and SL and by means of exploitation of the Opponents' Trademark. As a result the Opponents have manufactured and sold to the public a vast array of goods and services under the brand of the Opponents' Trademark. In accordance with the normal practice adopted by most sports clubs, the goods have been sold directly to the public via the

club's official shop, mail order as well as SL's official website located at www.saracens.com."

10. Mr. Lawler refers to a vast range of products, including: programme binders, calendars, clothing (baseball caps, Bronx hats, ties, jackets, sweat shirts, polo shirts, T-shirts, shirts, shorts, scarves; playing kits, body warmers, gloves, rugby jerseys, tracksuits, fleece jackets, rain jackets, leisure shirts), umbrellas, mascots (i.e. plush toys) and souvenirs mugs, stationery key rings, fridge magnets, air fresheners, badges, rucksacks, rugby balls, drink bottles, bags, mouse mats, gift vouchers, flags and pennants, stickers, cuff links and autograph books. I am referred to copies of various merchandise brochures and materials, as well as a print out from the opponents' official website, offering the above mentioned merchandise (Exhibit TL4).
11. In my view, the majority of the material on display falls into the category of merchandising trade: it is based on the opponents fame in the sport of rugby and builds on it. For example, there is no evidence that Saracens RFC have a reputation in the cuddly toy market. The latter example is particularly pertinent: Mr. Lawler refers to 'mascots (i.e. plush toys).' The camel on page 12 of the 1999/2000 Official Merchandise Catalogue (Exhibit TL4) would be bought as a declaration of loyalty to the rugby club; it is a 'mascot', a symbol of the opponents true fame, in the arena of sporting entertainment. Many of the other items must also perform this function - souvenirs mugs, stationery key rings, fridge magnets, air fresheners, badges, rucksacks, rugby balls, drink bottles, bags, mouse mats, gift vouchers, flags and pennants, stickers, cuff links and autograph books – all seem to be tokens of the opponents' sporting fame: it is not a trade in those items *per se*.
12. Not all of the products fall into this category, however. It is clear that the opponents have traded in clothing: see, for example, many of the items in the 1997 – 1998 Catalogue. At the beginning of this document, the introduction by Mr. Peter Deakin (described as Sales and Marketing Director) writes of 'Saracens leisurewear', and labelling of these products supports such a trade under the star and crescent device - it is just possible to discern this device on the neck label of many of these items. – Contrast this with some of the products depicted in a later catalogue (1999/2000), where 'Cotton Oxford' appears in the neck label and will, in my view, be taken as the true mark of trade. It is thus fair to conclude that, before the relevant date, the opponents had some trade in clothing (rugby shirts, t-shirts, jackets etc.). Other material in Exhibit TL4 is past the relevant date. I do not think I can conclude anything about the other items marketed, which are more in the way of typical merchandise – souvenirs - and the like.
13. Even with the sales of clothing, the turnover data is after the relevant date (see Exhibit TL5), and evidence about other activities using the opponents' mark is rather thin. Mr. Lawler refers to the following:
 - 'Organisation and management of sporting events'. Mr. Lawler states that this 'lies at the heart of the Opponents' activity' in particular for rugby matches. He, again, refers to the history of the opponents involvement in rudy union through to their present prominence as a rudy club. This takes the opponents no further: I do not see that it gives them a reputation in the organisation of sporting events in general. The material exhibited at Exhibit TL7 refers only to rugby, and is, anyhow, after the relevant date.
 - 'Provision of training, education and various community services offered under and by reference to the Opponents' Trademark'. There is evidence that the opponents provide 'training' that is not limited to the sport of rugby (see Exhibit TL8a) and the MBA course, however, this material is after the relevant date. The community services and

charity work cited by Mr. Lawler (see, again, Exhibit TL8a) shows clear involvement since 1997. Nevertheless, I'm not sure how much of this amounts to a 'trade' under their mark; if it does, again, it seems to me, that it adds only to their reputation as a rugby club, not as a charitable institution, or as a provider of education and training as such.

- 'Provision of member's club services offered under and by reference to the Opponents' Trademark'. Mr. Lawler refers to various ventures. Again, they seem to me to be provision of these services on the basis of the opponents' prominence as a professional rugby club. I do not see that these activities have any real independent existence from the latter.
- 'Hospitality and sponsorship services offered under and by reference to the Opponents' Trademark'. The material in Exhibit TL10 is referred to, and relates to hospitality services provided to various members' clubs, non-club members and sponsors. Again, I see nothing in this forging a reputation other than that I have already described.

14. I discuss the opponents' reputation in more detail under the 'passing off' ground. However, in summary, I am left with the impression of a famous English rugby club that has sought to maximise its image as such: there has been some trade in clothing that can be regarded as independent of the merchandising trade I have described above, but little else. In my view, the list of 'Recent Achievements' shown in Exhibit TL12 tend to conform this: if the opponents are renowned for anything, it is only for being a rugby club – one with a sense of commercial and community awareness – but I see little before the relevant date that evinces anything else.

15. As will be inferred from that which I stated above, this finding has implications for each of the grounds pleaded. I will consider these as I proceed.

Applicants' evidence

16. None submitted.

LAW

17. Section 5 states, *inter alia*:

“(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.

(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, and

- (b) is to be registered for goods and services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(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

(b)

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

DECISION

The earlier mark: s. 5(2)

18. The case law relevant to s. 5(2)(b) has been set out recently in several decisions of the European Court of Justice (ECJ), in particular: *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] ETMR 1 and *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77, and can be summarised as follows:

(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*, 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;

(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 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.

19. The opponents are the owner of an earlier mark by virtue of s. 6(1) of the Act, i.e., their registration listed at paragraph 2.
20. I stated in paragraph 5 above, that the notoriety of the opponents' mark is an element in all the grounds pleaded. I want to consider this now, for s. 5(2)(b).

Distinctive character

21. The ECJ, in *Sabel* (pages 223 and 224) has the following to say on the issue of distinctiveness and reputation:

“.. Article 4(1)(b) of the Directive does not apply where there is no likelihood of confusion on the part of the public. In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion ‘depends on numerous elements and, *in particular, on the recognition of the trade mark on the market*, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified’. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case

....

...the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, *either per se or because of the reputation it enjoys with the public.*” (Emphasis mine).

Canon confirms this view:

“18. ... the more distinctive the earlier mark, the greater the risk of confusion ... Since protection of a trade mark depends, in accordance with Article 4(1)(b) of the Directive, on there being a likelihood of confusion, marks with a highly distinctive character, either *per se* or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character.”

22. I also note the following from *Dallas Burston Healthcare Ltd's Trade Mark Application* [2001] WL 395219, at paragraph 14:

“In my judgment, I believe what the ECJ had in mind was the sort of mark which by reason of extensive trade had become something of a household name so that the propensity of the public to associate other less similar marks with that mark would be enhanced.”

23. I struggle to accept that, on the evidence I have seen, that ‘average consumers’ (which I take to be the general public) have this level of acquaintance with the opponents. I have no doubt that Saracens RFC are known amongst rugby and sporting circles, but beyond that, as to the knowledge of the general population, I cannot be sure, based on the evidence from Mr. Lawler, that their mark has attained the status given above. I am thus left, for the purposes of s. 5(2)(b), with a *prima facie* comparison of the marks at issue.

24. I note the following comments from the ECJ in *Lloyd*:

‘22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of May 4, 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v. Huber and Attenberger* [1999] E.C.R. I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)’.

25. Some of this material is present, but not all. In particular, I have no information on the knowledge the general public has of the mark: sports, even one such as rugby union, can be of abiding interest to some, but not necessarily all, of the population of a country. I cannot conclude that the mark is a household name in the UK, outside the sport of rugby.
26. Is the mark possessive of an inherent capacity to distinguish? I think I must conclude that it has: it is not a ‘fancy’ (i.e., ‘made up’) mark, but it is arbitrary for the goods and services to which it has been applied. This makes it a mark with a strong inherent capacity to distinguish.

Average Consumer

27. The range of goods and services specified in the application – enveloping goods and services in Classes 16, 25, 28 and 41 – compels a catholic comprehension of the average consumer in this case. That is, consumers at large – not limited to those interested in sport or, in particular, rugby.

Comparison of goods and services

28. Mr. Lawler gives his views of the similarity on the goods at issue on page 13 of his Declaration:

“All of the goods included in the Application in classes 16, 25 and 28 are either identical or confusingly similar to the goods included in the application for the Opponents’ Trademark upon which the Opposition is based.”

29. My own view is not so sweeping, as will be seen, by the following detailed review, which is clearly necessary - the principle in the case law is that a lesser degree of similarity between goods may be offset by a greater degree of similarity between the marks, and *vice versa* (*Canon*, at paragraph 17). It is thus essential to establish which goods are identical, which are merely similar and which are dissimilar. The principles to apply are well established in *Canon* at paragraph 23, reflecting those identified in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (the *Treat* case) at page 296. In *Treat*, Mr. Justice Jacob cited the following as relevant in any consideration of similarity, which I have adapted to the present case:

- the respective uses of the respective goods;
- the respective users;
- the physical nature of the goods;
- the respective trade channels through which the goods reach the market; and
- the extent to which the respective goods are competitive. This inquiry may take into account how those in the trade classify goods.

30. I will detail below (against each of the classes sought by the applicant) which of their goods or services are identical to those covered by the earlier mark, those which are similar, and those which are dissimilar.

Class 16

31. The earlier mark covers a wide range of goods and services in Class 16, including such broad terms such as ‘stationery’ and ‘printed matter’. Many of the items specified by the applicants are therefore subsumed within the specification of the earlier mark, so making them identical goods. The table below details the goods within the applicants’ specification that I have identified as identical, similar or dissimilar. Nevertheless, my findings are not clear cut: I have listed ‘hole punches’ (and ‘ring-binders’?) as identical to ‘stationery’ being embraced within that term; they may be merely similar. Arguably, the *Treat* criteria would find them identical. On the same basis, I have found ‘sticker albums’ similar to stationery:

Applicants' specification	Earlier mark's specification
Identical Goods	
Books, magazines, journals and printed inserts; diaries, calendars, address books; postcards, greeting cards; prints, posters, almanacs and transfers; stickers.	Subsumed within the general term "printed matter".
Paper, cardboard; stationery, namely, writing paper, folders, notebooks, notepads, memo pads; pencil sharpeners, erasers, rulers, hole punches; pencil boxes and cases; ring binders; writing instruments, namely, pens, pencils, crayons and tops for pencils.	Subsumed within the general term "stationery".
Wrapping material, namely, giftwrap.	Wrapping material.
Plastic carrier bags.	Plastic bags.
Similar goods	
Packaging material, namely, gift boxes, labels and tags.	Similar to "wrapping material".
Paper bags.	Similar to "plastic bags".
Sticker albums.	Stationery.
Dissimilar goods	
Party poppers (paper casings with a surprise in the centre designed to make a popping noise when opened); playing cards.	Not similar to anything contained within the earlier mark's specification.

Class 25

32. The earlier mark has coverage for all items of clothing save for suits, dresses, jackets and trousers. This would therefore subsume all of the applicants' Class 25 specification with the exception of the excluded goods. The items that are not subsumed would however be considered to be of a similar nature to goods included in the earlier mark.

Class 28

33. Again, the earlier specification contains a broad term which 'catches' a large amount of the goods specified in the application. In respect of the Class 28 specification I have found that some sporting articles are similar goods to toys, games and playthings, but other sporting articles are not. This follows because some sporting articles can also be considered as playthings - or are at least very similar to toy versions of the particular sporting articles. However, some of the more specialised sporting articles (e.g. fishing rods) cannot be considered as a plaything, nor are they similar to their toy replicas.

34. The table below details the goods within the applicants' specification that are identical, similar or dissimilar to the earlier mark's specification:

Applicants' specification	Earlier mark's specification
Identical Goods	
Toys, games and playthings, namely, board games, balloons, die-cast metal vehicles, kites, miniature trains, model kits, inflatable riding/bounding toys, pogo sticks; playsets/activity sets, plush toys, puzzles, juggling sets; pinball machines; handheld electronic games; skipping ropes; skate boards.	Subsumed by the general terms "Toys, games and playthings".
Football; baseballs; golfballs; tennis balls.	Identical to "balls for all sport".
Flying discs.	Flying discs.
Similar goods	
Ping-pong paddles; miniature trampolines; tennis rackets; badminton rackets; surfboards.	These are considered to be similar to toy/plaything versions of the same products and as such are similar to the general term "toys, games and playthings".
Golf clubs.	As the earlier right covers "balls for all sports" (including golf balls) then golf clubs are a similar product to balls (particularly golf balls).
Dissimilar goods	
Exercise bicycles; fishing rods, tackle and bags and/or boxes therefore; skis and snowboards; windsurfing boards.	These specialist sporting articles are not similar to anything within the earlier mark's specification.

Class 41

35. The applicants' Class 41 specification covers various services primarily related to the organisation of entertainment, competitions, sporting events, quizzes etc. I can see no link between the provision of these services and the goods covered by the earlier mark's specification. I therefore consider all of the services in Class 41 to be dissimilar to the goods covered by the earlier right.

Similarity of marks

36. When considering the question of similarity, I must do so with reference to any visual, aural and conceptual similarities, whilst taking into account the overall impressions created by the marks, bearing in mind their distinctive and dominant components. For ease of reference, I reproduce the marks below:

Applicants' mark



Opponents' mark



37. As to visual similarity, I must conclude that the device elements in the two marks are similar. They both contain a star shaped element and both contain a crescent shaped component. These elements appear in similar positions in each of the marks. The opponents' mark does possess a word element that is not present in the applicant's mark. Whilst this reduces the visual similarity to some extent, I do not believe that the word element dominates the mark, obviating the similarity I have identified. Visually, I consider the marks to be very similar, particularly when the imperfect recollection of the average consumer is taken into account.
38. Aurally, there is arguably less similarity. The applicants' mark will be referred to something like a "star and crescent" mark or a "trailing star" mark. The opponents' mark may well be referred to as a "Saracens" mark. Nevertheless, I consider it possible that the latter would also be described as the "Saracens' star mark". All in all, there is a small degree of aural similarity.
39. Conceptually the marks share similarities. Though the applicants may contend that the crescent in their mark is more akin to a trail following the star, and would be thought of as such, the star is an element in the earlier mark as well. And the relative positions of the device elements are similar. Though the presence of the word "Saracens" diminishes the conceptual similarity, it does not remove it.
40. Overall I must conclude that the marks share strong similarities.

Likelihood of confusion

41. I have found that some goods in the applicants' mark are similar or identical to those specified with the earlier mark, and further that the marks themselves are similar. Further, I have found the latter to be a very distinctive mark for the goods at issue.
42. Against this background, I think I must find confusion in this case: consumers often carry an imperfect picture of a trade mark in their mind and are unable to compare marks side by side – couple this with the distinctiveness of the earlier mark – and I believe that confusion as to the origin of the goods at issue is likely. The opposition is thus, partially, successful under Section 5(2).

Earlier marks, dissimilar goods: s. 5(3)

43. I note the following from the *RARE* trade mark case (BL 0-470-01), where the Hearings Officer, Mr. Alan James, stated:

“51. The purpose and scope of Section 5(3) of the Act has been considered in a number of cases including *General Motors Corp. v Yplon SA (Chevy)* 1999 ETMR 122 and 2000 RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited* 2000 FSR 767 (*Typhoon*), *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42 and *C.A. Sheimer (M) Sdn Bh’s TM Application (Visa)* 2000 RPC 484.

52. The points that come out of these cases are as follows:

- a) ‘Reputation’ for the purposes of Section 5(3) means that the earlier trade mark is known by a significant part of the public concerned by the products or services covered by that trade mark (paragraph 26 of the ECJ’s judgment in *Chevy*);
- b) Protection is only available where the respective goods or services are not similar (paragraph 29 of the Advocate General’s opinion in *Chevy*);
- c) The provision is not intended to give marks ‘an unduly extensive protection’ - there must be actual detriment or unfair advantage (not merely risks) which must be substantiated to the satisfaction of the national court or tribunal (paragraph 43 of the Advocate General’s Opinion in *Chevy* and paragraph 88 of Pumfrey J’s judgment in the *Merc* case);
- d) The provision is not aimed at every sign whose use may stimulate the relevant public to recall a trade mark which enjoys a reputation with them (per Neuberger J in the *Typhoon* case);
- e) The stronger the earlier mark’s distinctive character and reputation the easier it will be to accept that detriment has been caused to it (paragraph 30 of the ECJ’s judgment in the *Chevy* case);
- f) Confusion as to the trade source of the goods or services offered for sale under the later mark is not a necessary condition before there can be detriment, but is one form of detriment (paragraph 88 of Pumfrey J’s judgment in the *Merc* case);
- g) Detriment can take the form of either making the earlier mark less attractive (tarnishing) or less distinctive - blurring (paragraph 88 of Pumfrey J’s judgment in the *Merc* case);
- h) Unfair advantage can take the form of feeding on the fame of the earlier mark in order to substantially increase the marketability of the goods or services offered under the later trade mark (per G Hobbs QC in *Visa* at page 505, lines 10-17).”

44. The first requirement to be met under Section 5(3) is for the earlier trade mark to be identical or similar to the applicants’ mark. I have already found under Section 5(2) that the marks are similar: the opponents mark therefore complies with this condition. The provision also requires that the mark is protected for goods or services which are dissimilar to the goods covered by the applicant’s mark. This is also found, for the following goods and services:

Class 16 “Sticker albums; party poppers (paper casings with a surprise in the centre designed to make a popping noise when opened); playing cards”;

Class 28 “Exercise bicycles; fishing rods, tackle and bags and/or boxes therefore; skis and snowboards; windsurfing boards”; and

Class 41. Services listed.

The opponents' mark must also possess a reputation in the UK for there to be a finding under Section 5(3). Referring to point (a), above, I cannot conclude that the opponents' mark is known by a significant part of the public in respect of the *products or services covered by it*. I do not think the evidence filed demonstrates this. Whilst the playing/organisation of the game of rugby may have qualified, this service is not specified in the opponents' registration. The ground of opposition under Section 5(3) is dismissed.

S. 5(4)(a) - the earlier right

45. The requirements for success under this ground are set out in the decision of Mr Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. In respect of opposition proceedings, the three main elements of the tort of passing off can be summarised as follows:
- (1) that the opponents' goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
 - (2) that there is a misrepresentation by the applicants (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the applicants are goods of the opponents; and
 - (3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicants' misrepresentation.
46. It is clear from the opponents' evidence that they possess goodwill in respect of the playing and organisation of the game of rugby. To reprise the evidence of this, Exhibit TL7 consists of fixture lists and advertisements for rugby matches and season tickets. Though much of the evidence is after the relevant date in these proceedings, I am prepared to accept that the organisation of rugby matches has been carried out by either the rugby club or Saracens Limited since the clubs formation, (larger scale exploitation of the brand would only appear to have commenced in 1996 and has been exploited on an increasing basis since then). Mr. Lawler refers, in his evidence, to the organisation of 'sporting events': this is rather an overblown claim: rugby is the only sport that distinguishes the opponents.
47. I have also found that the opponents goodwill extends – in a limited manner - to certain goods marketed by them before the relevant date, in particular clothing. The latter may intimate some remedy under this tort for these goods at least; however, following my findings under s. 5(2), I do not think this provides the opponents with any more comfort than that they have already discovered.
48. In this regard, I will only direct my attention to the goods and services I listed at paragraph 44, above. I will set out the Class 41 services in full:
- “Entertainment, education, instruction, tutoring and training services in relation to World Record breaking events, sporting events, competitions, games, quizzes, shows, audience participation events and shows; entertainment services provided on-line, by computer or via the Internet; database, on-line and global computer network information services, all relating to education, entertainment, recreation and publishing; production and presentation of television programs, films, radio programs and games;

organisation, production and presentation of events for educational, cultural, or entertainment purposes; organisation, production and presentation of competitions, games, quizzes, shows, audience participation events; museum services; publishing services; production and presentation of educational and instructional information; provision of information relating to any of the aforesaid services in International Class 41.”

49. Does the opponents’ goodwill extend further than my findings so far? Mr. Lawler would claim that it did. He refers to the training, education and community services offered under the mark. Reference is made to the sponsorship and co-organisation of various training courses e.g. in Leisure management and Rugby studies; mention is also made to community training activities (paragraph 18(b) of his Declaration). Exhibits TL8a & b detail some of the various initiatives. Some of these documents are dated after the relevant date, but it is clear that these initiatives did begin prior to the relevant date. In particular I note the following from Mr. Lawler’s Statement, paragraph 18(b), which cites SL’s activities in training, education and charity:

1. Sponsorship and co-organisation of the BA(Hons) Leisure Management and Rugby Studies degree in association with Buckingham Chilterns University College;
2. Foundation Skills (which encourages and develops grassroots participation in sport);
3. Teacher and Coach Education (which develops resources and provides training for people involved in the introduction of sport);
4. Chalk & Talk (a programme using rugby as a vehicle to delivering Key Stage 2 National Curriculum at local schools);
5. Positive Lifestyles (which concentrates on aspects of health and social issues);
6. ‘Fit for Fun’ project; and
7. ‘Ready for Rugby programme’.

Mr. Lawler explains that all these ‘educational / community programmes are promoted by use of the Opponents’ Trademark’.

50. I am referred to Exhibits TL8a and TL 8b. Searching through the material in these Exhibits provides me with little clearly before the relevant date and, anyhow, appears to engender the same comment I made earlier: they promote the opponents’ fame as a rugby club, not a provider of other services outwith this central activity. Consider, for example, the (undated) advertisement for the BA course mentioned: it is sponsored by the opponents, not run by them (Buckinghamshire Chilterns University College are the providers and educators) - the opponents’ involvement is as a ‘modern professional club’, not as a supplier of education.

51. Better is the material relating to the opponents’ community programme: this has operated since 1997. However, though the programme incorporated altruistic motives, these were not unalloyed, as the document in Exhibit TL8a ‘Report to the Community 3’, under the section ‘And so it began..’:

“When Saracens decided to move their playing focus to Watford in the summer of 1997, the whispers immediately began doing the rounds as to the wisdom, forethought and

sanity of such a major relocation. How could rugby survive in a football stronghold where the only sighting of an oval ball usually meant that a puncture needed to be mended? How would a team with an average attendance of 3,400 utilise a 22,000 seater stadium? The decision had to be vindicated by dynamic action within the new area and so the Saracens 'Rugby in the Community Programme' was born.

The groundwork was done by the then, solitary Community Development Officer, Tim Lawler (now Saracens' Managing Director), who put in place a strategy to make Saracens a key resource to the community. With the aim of creating and developing positive partnerships between schools, clubs, children and adults, using Saracens as the source of motivation and stimulation, Tim began on the very doorstep of Vicarage Road Stadium setting off the ripple effect from Watford to encompass south-west Hertfordshire. *Encompassing the values of quality, accessibility and continuity, the programme allowed teachers, coaches and sports leaders, to introduce rugby union to a wide range of youngsters, giving them opportunities to express and improve themselves, whilst utilising the profile of Saracens and their players to enforce the impact. Through partnerships with the local councils, Hertfordshire Education Services and Hertfordshire Rugby Football Union, the original ripple began to swell to the extent that two new Community Development Officers, Hannah Godwin and Simon Ward, were taken on to carry the programme forward.*" (Emphasis mine).

It is fair to say that many of the activities included in the work of the 'Saracens Foundation' was not wholly directed at rugby alone, but that was the focus; see also from the above document:

"Foundation Skills - encouraging and developing grassroots participation in sport, particularly rugby

Teacher & Coach Education - working in partnership with other agencies to develop resources and training for those people involved in the introduction of sport

Chalk & Talk - an educational programme using rugby as a vehicle to deliver elements of the Key Stage 2 National Curriculum, thus creating a link between the home of Saracens and local schools

Positive Lifestyles - working with other agencies to promote positive messages relating to health and social issues and enforced by the profile of professional sportsmen".

Though maths, English, Geography etc. are skills incorporated within these projects, these all rest on a structure founded by opponents' business as a professional rugby club.

52. What am I to conclude from this material? There has been some significant involvement in the community local to the Rugby club before the relevant date; this involvement is very much rugby centred, but incorporates education in general, and some charity work. I have concluded that the opponents have a goodwill as a professional rugby club; I think I can also conclude that they, before the relevant date, have developed a goodwill as a rugby club with a significant commitment to their local community, that is, a rugby club with a conscience.

53. I do not think that this has created, in the words of Mr. Lawler, a reputation for education, community services and charity *per se*. The perception I have is that these activities have extended from – and expanded – the opponents’ reputation as a rugby club. The pages in Exhibit TL8a are unhelpfully unnumbered, but one titled ‘Community Quotes’ from ‘Report to the Community 3’ contains several quotes, for which the following are typical extracts:

“Thank you to Saracens who helped the school introduce rugby to the staff and children.”

“..for the boys to be able to look back in the years to come and say ‘I’ve played at the Saracens ground’ is something I am very envious of’.”

“.. you have been instrumental in raising the profile of rugby and developing the links with rugby in the local community.”

“ The current enthusiasm for rugby evident amongst these children (now year 5), owes much to their initial visits to Vicarage Road..”

54. Much the same conclusions can be made of Mr. Lawler’s reference to what he terms “member club services” which are offered to companies or private persons. Examples of these membership club services are shown in exhibit TL9; again, they seem to be orientated around rugby matches and items promoting Saracens RFC.
55. Mr Lawler also mentions hospitality and sponsorship services, which are clearly offered under the mark. Details of these are contained in Exhibit TL10. A list of current club sponsors who pay “considerable” amounts of money to the club are shown at Exhibit TL11. This material is undated; more importantly, it shows the attractive force of the opponents goodwill bringing in custom: and the essence of that force? Their reputation as a rugby club.
56. Thus, I believe, the opponents are left with a very significant goodwill, but a very specific one. Turning to the case law, though a ‘common field of activity’ (*McCulloch v May* [1947] 65 RPC 58) is no longer a requirement in passing off, clearly the similarity of the trade(s) in question is a factor which must be considered (*Annabel’s (Berkeley Square) Ltd. v Schock* [1972] RPC 838) when determining confusion in respect of passing off. - Consumers are more likely to assume a connection or be confused where trades are closely related or the same. Against this, there is the case of *Lego System Aktielskab and Another v Lego M. Lemelstrich Limited* (FSR 1983 155), where the plaintiffs were manufacturers of the famous building bricks and succeeded in a passing-off action against an old established Israeli company which manufactured irrigation equipment, including garden sprays and sprinklers constructed wholly or substantially of brightly coloured plastic material. But here there was at least a tenuous link between the products insofar as both sets of goods were made from similar materials. Further, there was substantial evidence of likely confusion in that case.
57. It seems to me, as far as the applicants’ services in Class 41 are concerned, despite the opponents’ goodwill, I do not believe that misrepresentation is likely outside the arena of rugby football. An exclusion on this basis will, in my view, exclude the risk of passing off by the applicants. To that extent, this ground succeeds. Following my findings under the s. 5(2)(b) ground, I do not see that confusion is likely for the goods remaining in Classes 16 and 28.

Conclusion

58. For the application to proceed, the applicants must amend their specification of goods and services to the following:

Class 16 “Sticker albums; party poppers (paper casings with a surprise in the centre designed to make a popping noise when opened); playing cards”;

Class 28 “Exercise bicycles; fishing rods, tackle and bags and/or boxes therefore; skis and snowboards; windsurfing boards”; and

“Entertainment, education, instruction, tutoring and training services in relation to World Record breaking events, sporting events, competitions, games, quizzes, shows, audience participation events and shows; entertainment services provided on-line, by computer or via the Internet; database, on-line and global computer network information services, all relating to education, entertainment, recreation and publishing; production and presentation of television programs, films, radio programs and games; organisation, production and presentation of events for educational, cultural, or entertainment purposes; organisation, production and presentation of competitions, games, quizzes, shows, audience participation events; museum services; publishing services; production and presentation of educational and instructional information; provision of information relating to any of the aforesaid services in International Class 41; excluding any of the above relating to the sport of rugby.”

If the applicants do not file a TM21 within one month of the end of the appeal period for this decision restricting the specification as set out above the application will be refused in its entirety.

59. As to costs, the opponents have had some success, but I do not believe that it is enough, in the context of the width of the grounds they pleaded, to register a costs award. I decline to make any such award in this matter.

Dated this 21 Day of January 2003.

**Dr W J Trott
Principal Hearing Officer
For the Registrar.**