

O-160-04

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO. 2304070 IN THE NAME OF
NORTH AMERICAN SOCCER LEAGUE MERCHANDISE LIMITED**

AND

**IN THE MATTER OF
OPPOSITION THERETO UNDER NO. 91336 IN THE NAME OF
THE OLD FASHIONED FOOTBALL SHIRT CO LIMITED**

Trade Marks Act 1994

In the matter of application No. 2304070

in the name of North American Soccer League Merchandise Limited

And

In the matter of opposition thereto

under No. 91336 in the name of

The Old Fashioned Football Shirt Co Limited

Background

1. On 29 June 2002, North American Soccer League Merchandise Limited applied to register a trade mark in Class 25 in respect of the following specification of goods:

Articles of sports clothing and articles of leisure clothing for adults and children; headwear, caps and hats; jackets and coats; jerseys, jumpers, sweaters and sweatshirts; shirts, polo shirts and T-shirts; tracksuit tops and tracksuit bottoms; trousers; skirts and dresses; shorts; socks; shoes, training shoes and footwear; bags.

2. The mark is as follows:



3. On 18 December 2002, The Old Fashioned Football Shirt Co Limited filed notice of opposition based on the following grounds:

1. **Under Section 5(4)(a)** by virtue of the law of passing off,
2. **Under Section 3(1)(b)** because the mark is devoid of distinctive character,
3. **Under Section 3(1)(c)** because the mark consists exclusively of a sign or indication which serves in the trade to designate the kind, quality, geographical origin or other characteristics of the goods.

4. The applicants filed a counterstatement in which they deny the grounds on which the opposition is based.

5. Both sides ask that an award of costs be made in their favour.

6. Both sides filed evidence in these proceedings. The matter came to be heard on 5 April 2004, when the applicants were represented by Ms Mary Vittoria of Her Majesty's Counsel, instructed by Weightman Vizards, Solicitors. The opponents were represented by Mr Hugo Cuddigan of Counsel, instructed by Marks & Clerk, their trade mark attorneys.

Opponents= evidence

7. This consists of a Witness Statement dated 7 July 2003 from Alan James Finch, Managing Director of The Old Fashioned Football Shirt Co Limited (TOFFS) a position he has held since its incorporation on 19 May 1998. Mr Finch says that from 1991 he had traded as a partnership under the same name.

8. Mr Finch describes his company's business as the distribution, marketing and sale of replica historic playing jerseys and shirts of well known national and international football teams which are sold as fashion or leisure-wear. He states that none of the shirts are replicas of current playing kit.

9. Mr Finch says that the business was originally carried out by the partnership and transferred to TOFFS in May 1998. He refers to exhibit AJF1, which consists of official brochures dating from 1995/96, depicting various historical football shirts including examples stated to be from the New York Cosmos. In all but one instance the badges on the shirt cannot be clearly seen. Where the image is clear enough to see the badge it can be seen to be circular in shape, a football at its centre, three arcs radiating out to the right from the upper part of the football and the word COSMOS in an arc on the left. Although this is in the 2002 catalogue and potentially after the relevant date, it contains the statement "Welcome to the 2002 TOFFS catalogue which will take us through to The World Cup. This I know took place from the end of May 2002 so the catalogue must pre-date the relevant date.

10. Mr Finch says that the shirts are sold through his company's shop in Newcastle-Upon-Tyne, the Sports Scene shop in London, via their Internet web-site, mail-order catalogues and advertisements placed in the sports media, copies of which he shows as exhibit AJF2. This consists of copies of three copies of a publication entitled Eurposport the frontispiece stating "The fabled soccer traders..."@, dating from July/August 1996, November/December 1996 and

Spring 1997. Inside there are advertisements for New York Cosmos football shirts. Mr Finch says that his company sells approximately 75% of its goods via their web-site, and also makes wholesale sales to numerous football clubs for resale to the public from club merchandise shops.

11. Mr Finch gives details of his company's turnover for the period prior to the relevant date. This amounts to some £5,166,000 of which he says some 75% relates to the UK. He does not say so, but I would assume that as he later gives figures specifically relating to sales of New York Cosmos shirts, these figures are for total sales.

12. Mr Finch says that historic jerseys from the North American Soccer League (NASL) are an important part of his company's range. He gives his understanding that the New York Cosmos were one of the most well known and successful in this league, at various times having had internationally acclaimed footballers on their playing staff, and were one of the few, if not the only US football club to play against leading European clubs. Mr Finch says that in 1986, the NASL was dissolved and the New York Cosmos ceased trading, and that to his knowledge there has been no action to maintain either the goodwill of the league or the club.

13. Mr Finch recounts his company launching its range of New York Cosmos jerseys in 1996. He refers to exhibit AJF3 which consists of pages taken from a catalogue endorsed as dating from 1997, and the company's website, both depicting inter alia, shirts for the New York Cosmos, the logo being the same as that described in paragraph 9 above. Exhibit AJF4 consists of a copy of a sheet dated 29 February 1996, instructing Peter Wright Designs Limited relating to the production of COSMOS logos to be affixed to the jerseys.

14. Mr Finch says his company has continuously sold New York Cosmos replica jerseys since 1996, although only from 23 November 1998 in respect of the UK, a date confirmed by an order listing shown as exhibit AJF5. He goes on to give estimates of sales of New York Cosmos replica jerseys in the years 1997-8 through to 2001-2002, which amount to £10,000 per annum in the first two years, £15,000 thereafter. Exhibit AJF6 consists of copies of documentation relating to sales, inter alia, of NY Cosmos jerseys, under the name of TOFFS, the earliest dating from July 1997.

15. Mr Finch says that his company promotes its goods via catalogues sent to customers, through its website, www.toffs.com, advertisements placed in magazines such as World Soccer, Shoot and 90 Minutes, posters placed in public locations and by attendance at exhibitions such as The Football Show at the NEC in Birmingham. Exhibit AJF7 consists of examples all promoting TOFFS. There is no mention of New York Cosmos. Exhibit AJF8 consists of a CD containing a television advertisement by British Telecom that featured TOFFS.

16. Mr Finch gives details of his company's expenditure on promoting its products in the UK in the years 1996 through to November 2002, although not specifically in respect of New York Cosmos. He says that to the best of his knowledge his is the only company within the UK that has traded in replica historic jerseys over such a period of time and have built up a substantial reputation and goodwill in such goods.

17. Mr Finch goes on to comment on the counterstatement filed by the applicants, namely, that although their search into use of New York Cosmos did show that the opponents were trading in replica jerseys, at the time that the applicants were incorporated TOFFS had been actively trading in such goods. He refers to the sale of New York Cosmos shirts on two other websites, stating that due to his company's extensive reputation he understands that his company is the most recognised outlet for replica, and in particular, New York Cosmos shirts.

18. Mr Finch says that by virtue of its extensive reputation and goodwill in replica historic jerseys, and in particular, jerseys bearing the New York Cosmos logo, members of the public would associate his business with such goods and also the New York Cosmos trade mark. He accepts that his company does not have a reputation in football clubs; that when the public think of Real Madrid or Arsenal they do not think of TOFFS, but will do so when they think of replica jerseys of such clubs.

19. Mr Finch denies that the opposition has been brought in bad faith, saying that his company has been selling New York Cosmos jerseys since 1996, and also other jerseys from the NASL. Exhibit AJF9 consists of copies of sheets dating from 1996-1998 instructing Peter Wright Designs Limited relating to the production of NASL badges. Mr Finch says that this shows that his company intended the replica New York Cosmos jerseys to form part of a range of NASL soccer league jerseys, but did not commence the sale of the New York Cosmos jerseys due to the applicants' intention to produce a range of competing goods.

Applicants' evidence

20. This consists of a Witness Statement dated 9 October 2003, from Steve Ellis, a Director and 50% shareholder of North American Soccer League Merchandising Limited, a company incorporated on 25 May 2002 which he says was to manufacture, distribute and sell NASL merchandise, specifically articles of clothing.

21. Mr Ellis says that the products of his company are sold under the NASL name which appears on either the label or a separate badge or logo, and under these umbrella marks merchandise bearing the names California Surf, LA Aztecs and New York Cosmos. Mr Finch says that his company has registered these marks in various jurisdictions outside of the UK.

22. Mr Ellis disputes that the opponents have any reputation or goodwill in the name New York Cosmos, saying that it conducts its business under the name TOFFS, and it is in this name that any reputation or goodwill subsists. He asserts that it is preposterous to suggest that anyone buying a New York Cosmos shirt would believe it to be a TOFFS shirt.

23. Mr Ellis counters that he believes the opposition has been brought in bad faith, saying that prior to the opposition the opponents had launched unsuccessful opposition proceedings in the name of Alan Finch, and that prior to this Mr Finch had telephoned his company's solicitors to seek permission for TOFFS to sell New York Cosmos shirts on its website, and only launched the opposition because the parties could not reach agreement.

Opponents= evidence in reply

24. This consists of a Witness Statement dated 23 December 2003, from Alan James Finch.

25. Mr Finch comments on the lack of detail relating to the applicants= trade in New York Cosmos (and other NASL) merchandise. He refutes the assertion that TOFFS does not own the goodwill in the name New York Cosmos, saying that Mr Ellis acknowledges that his company=s business is promoted under the umbrella or house mark TOFFS alongside subsidiary marks such as COSMOS. Mr Finch repeats his claim that due to his company=s extensive reputation and goodwill in historic football jerseys, members of the public will associate such goods from the North American Soccer league with his company.

26. Mr Finch refutes the assertion that the opposition has been made in bad faith. He outlines the circumstances that led to his filing of the opposition his contact with the registered proprietors= solicitors. He concludes saying that as evidenced by exhibit AJF9, his company had decided to trade in replica jerseys prior to his contact with the applicants= solicitors.

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

Decision

28. Turning first to the ground under Section 3(1)(b) and (c). Those sections reads as follows:

A3,-(1) The following shall not be registered-

(b) trade marks which are devoid of distinctive character,

(c) trade marks which consist exclusively of a sign or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods orof rendering of services, or other characteristics of goods or services,

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.@

29. As the opponents have stated, the applicants have not filed any evidence that they have used the trade mark, so the proviso cannot apply in this case.

30. Mr Cuddigan put the opponents= position in the following way:

A...it is instructive that in its own evidence the applicant states:

AThe products of the company are sold under the (North American Soccer League Merchandising Limited) name which appears on such articles of clothing either on the label or a separate badge or logo.@

This is to be expected. The name New York Cosmos is not being used to describe whoever is guaranteeing the quality of the goods, it is simply a reference to what is perceived as a glamorous and defunct club. As such it is wholly without distinctive character.@

31. Mr Cuddigan referred me to the decision of Aldous L.J in *Phillips v Remington* [1999] RPC 809 in which he said:

AThe requirement under Section (Article) 3(1)(b) is that the mark must have a distinctive character to be registrable. Thus, it must have a character which enables it to be distinctive of one trader's goods in the sense that it has a meaning denoting the origin of the goods.@

32. He stated that this harked back to the old law of trade marks, and the prohibition against the registration of signs which other traders might honestly wish to use, stating that this is an approach which has recently found support in the ECJ case of *Campina Melkunie v Benelux-Merkenbureau* (Case C-265/00):

A35. The Court has recognised that Article 3(1)(c) of the Directive pursues an aim that is in the public interest, which requires that signs, and indications descriptive of the characteristic of goods and services in respect of which registration is sought may be freely used by all. That provision therefore prevents such signs or indications from being reserved to one undertaking alone because they have been registered as trade marks. (See Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-27779, paragraph 25, *Linde*, paragraph 73 and *Libertel*, paragraph 52).

36. That public interest requires that all signs or indications which may serve to designate characteristics of the goods or services in respect of which registration is sought remain freely available to all undertakings in order that they may use them when describing the same characteristics of their own goods. Therefore, marks consisting exclusively of such signs or indications are not eligible for registration unless Article 3(3) of the Directive applies.@

33. Mr Cuddigan argued that the opponents' use of New York Cosmos, and that made by two internet traders, tshirtgrill.com and football365.com referred to in the evidence showed this to be such a case. He also contended that the reason why the sign applied for is devoid of distinctiveness is the very reason that other traders want to use it; it is descriptive and conveys the meaning that the goods are displaying an allegiance or affection to a football club. He considered there to be a distinction with the *Arsenal v Reed* case [2003] 2 All ER 865 because the mark was registered and actively being used in the jurisdiction as a guarantee of origin by a trading football club.

34. In relation to the ground under Section 3(1)(b), Ms Vittoria also referred me to *Phillips v Remington*, saying that in that case it was stated that Adistinctive character@ means that the mark must be capable of identifying the product as originating from a particular undertaking and thus distinguishing it from those of other undertakings.

35. Referring to *West t/a Eastenders v Fuller Smith & Turner plc* [2003] FSR 44, Ms Vittoria stated that Sections 3(1)(b) and (c) are not designed to exclude from registration marks that merely possess an indirect connotation, asserting that the name of a defunct American football team when used in connection with clothing is not devoid of distinctive character. Ms Vittoria went on to say that the purpose of the prohibition against registration as trade marks of exclusively descriptive signs or indications is that they cannot fulfil the function of identifying the undertaking that marketed them (*Proctor & Gamble v OHIM* [2002] RPC 17) and that for registration to be precluded all of the elements must have a descriptive meaning (*OHIM v Wm Wrigley Jr & Co. AGO* [2003] ETMR 87). Ms Vittoria submitted that the mark applied for does not consist exclusively of signs or indications that have any reference to a characteristic of the goods for which registration is sought, and that as shown in *Arsenal Football Club v Reed* [2001] RPC 46, the fact that a sign may be used in a non-trade mark way, such as to show an allegiance to a football team, does not automatically render it as non-distinctive.

36. Ms Vittoria also cited Geoffrey Hobbs QC sitting as the Appointed Person in the *AD2000* trade mark case [1997] RPC 168 at 174 in which he stated:

A...The proviso to section 3(1)(b) deals with immaturity: Athe sign in question is not incapable of distinguishing goods or services of one undertaking from those of other undertakings, but it is not distinctive by nature and has not become distinctive by nurture.@

37. As there is no evidence of use by the applicants I have to agree with Mr Cuddigan when he says that this proviso cannot apply in this case.

38. The opponents' objection under Section 3(1)(b) and (c) is that the mark for which registration is sought is no more than a badge of allegiance to the New York Cosmos football club, is a sign that is, and should be free for use by all traders. In *Arsenal Football Club Plc v Reed* [2001] RPC 922, Laddie J stated (at paragraph 68):

AI have come to the conclusion that Mr Roughton's alternative argument also fails. He says that any trade mark use of the Arsenal signs is swamped by their overwhelming acquired meaning as signs of allegiance to the football team. Therefore they are not and have never been distinctive. He says that this argument applied with particular force to the word AARSENAL@. I think this fails on the facts. I do not see any reason why use of these signs in a trade mark sense should not be capable of being distinctive. When used, for example, on swing tickets and neck labels, they do what trade marks are supposed to do, namely act as an indication of trade origin and would be recognized as such. There is no evidence before me which demonstrates that when so used that they are not distinctive of goods made for or under the license of AFC. The fact that the signs can be used in other, non-trade mark, ways does not automatically render them non-distinctive.@

39. In *Tottenham Hotspur Plc v Patricia Hard O=Connell and Michael O=Connel* (BL0/024/03), Professor Ruth Annand, sitting as the Appointed Person noted:

The ECJ confirmed in *Arsenal Football Club Plc v Matthew Reed*, Case C-206/01, 12 November 2002 that distinctive character subsists when a sign enables the consumer to distinguish goods and services of the applicant and the applicant is in turn able to guarantee to the consumer the quality of products bearing that sign. The fact that the consumer might be motivated to buy the product to show support for his or her football team does not detract from that distinctive character.

40. It is clear from this that the fact that a sign may serve as a badge of allegiance does not in, and of itself mean that it is lacking in distinctive character. Depending on the manner in which they are used, the emblems of a football club are equally capable of functioning both as a badge of origin and as a focus of allegiance.

41. The evidence relating to use by tshirtgrill.com and football365.com lacks the detail needed to be of any use and even combined with the opponents' use goes nowhere near to establishing that the mark applied for is a sign which may serve in the trade to designate a characteristic of the goods for which registration is sought. Nor is there anything that persuades me this is a sign that should be kept free for use by all and sundry. If any party considers that the registration of this mark impinges upon their rights, this is a matter to be dealt with under the provisions of Section 5. The objections under Section 3(1)(b) and (c) are dismissed accordingly.

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

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

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

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

43. The opponents contend that they would succeed in an action for passing off against the applicants should their mark be used in the United Kingdom. A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd - v - Borden Inc* [1990] RPC 341 and *Erven Warnik BV - v - J. Townsend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of 'passing off', and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that;

To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.@

44. The opponents say that they first used the trade mark NEW YORK COSMOS in 1996, although in respect of the UK, the date of first use is established as being 23 November 1998 (exhibit AJF5). They claim estimated annual sales of New York Cosmos replica jerseys in the years 1997-8 through to 2001-2002, of between , 10,000 and , 15,000 per annum, which is modest to say the least. However, they have around three and a half years use prior to the relevant date in these proceedings which seems ample time in which to establish a reputation and goodwill. Ms Vittoria was critical of the lack of detail relating to the opponents= promotional activities, and I would have to agree. There are no figures relating to the number of catalogues issued, posters or advertisements placed etc, and specifically in relation to the New York Cosmos logo the information is non-existent. Accordingly, I would have to say that I am not in a position to accept that the opponents promotion of the mark has contributed to their claim to a reputation or goodwill.

45. The evidence shows the use to have been as a description for various football jerseys that are replicas of those worn by the NEW YORK COSMOS football team, and some of its famous players. Each of these shirts bore a badge with a football at its centre, three arcs radiating out to the right from the upper part of the ball, and the word COSMOS in an arc on the left, contained within a circular-shaped border. Trade appears to have been with retailers connected to the sporting goods industry, and also members of the public, presumably with an interest in football. However, they have targeted at least some of their promotional activities at the public at large and I would say that if the opponents have accrued any reputation and/or goodwill, it rests mainly with the former, and to a lesser extent, also the latter of these groups.

46. The mark applied for is what would generally be described as a composite mark, having a circular-shaped border with the device of a football at its centre, three arcs radiating out from the top of the ball to the right hand side, and the words NEW YORK COSMOS in an arc on the left. Apart from some minor variations in the colouring of the arcs in the opponents= version, and the applicants= use of the full title of the football club, there is little material difference in the respective marks, which is hardly surprising given that both are obviously derived from the original NEW YORK COSMOS team badge. The application in my view encompass the replica jerseys that the opponents have been selling in connection with the NEW YORK COSMOS name. The specification of goods is not restricted in any way so as to indicate any demarcation in the respective fields of activity, or the persons to whom the goods are likely to be retailed, and notionally must be considered to be the same. Nor do I see any reason why the applicants should differ in their marketing and retailing activities; they are just as likely to trade via catalogues, the Internet and advertisements.

47. It seems to me that given these similarities, if the opponents have a goodwill and/or reputation in their COSMOS logo, there must be a finding of misrepresentation, and that this will lead to damage.

48. Mr Finch claims that his company is the most recognised outlet for replica shirts in general, and NEW YORK COSMOS in particular. In answer, Ms Vittoria cited the following

passage from *Reckitt & Colman Products Ltd - v - Borden Inc*

The law of passing off can be surmised in one short general proposition - no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying get-up (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or service are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services.

49. Ms Vittoria stated that this showed that in an allegation of passing-off it is not enough to be the best known amongst a number of traders using similar signs. The question is whether the sign is, or could be distinctive of them (TOFFS) in selling their NEW YORK COSMOS replica jerseys. Ms Vittoria went on to say that the distinctiveness must be established by the trader showing that they have used the sign to denote the origin of their goods, or in other words, have used it in a trade mark sense.

50. I do not believe that I need expend too much time on the first of these points, other than to say that I agree with Ms Vittoria's assessment. Being the best known does not establish that a sign is recognised as distinctive of the opponent's goods. Mr Finch may well be correct when he says that his company is the best known (although there is no evidence to support this claim), but best known for what? The answer appears to be for replica historic jerseys, not the team emblems placed upon them.

51. It is in the second of Ms Vittoria's points that the real substance of this question lays. In any claim to passing-off based on the use of a given mark, it is necessary for the opponent to be able to show that the mark has, through that use, become distinctive to the public as denoting his goods. This was clearly stated by Jenkins L.J. in *Oertli v Bowman* [1957] RPC 388:

It is, of course essential to the success of any claim in respect of passing-off based on the use of a given mark or get-up that the plaintiff should be able to show that the disputed mark or get-up has become by user in this country distinctive of the plaintiff's goods so that the use in relation to any goods of the kind dealt in by the plaintiff or that mark or get-up will be understood by the trade and the public in this country as meaning that the goods are the plaintiff's goods. The gist of the action is that the plaintiff, by using and making known the mark or get-up in relation to his goods, and thus causing it to be associated or identified with those goods, has acquired a quasi-proprietary right to the exclusive use of the mark or get-up in relation to goods of that kind, which right is invaded by any person who, by using the same or some deceptively similar mark or get-up in relation to goods not of the plaintiff's manufacture, induces customers to buy from him goods not of the plaintiff's manufacture as goods of the plaintiff's manufacture, thereby diverting to himself orders intended for and rightly belonging to the plaintiff.

52. Ms Vittoria pointed to the fact that the neck labels of the jersey's shown in the opponent's catalogues are marked TOFFS, saying that this is to be expected because TOFFS is the mark

or sign used to denote the trade origin of the goods, and that there is no evidence that the opponents have used NEW YORK COSMOS insignia in a trade mark sense.

53. The evidence shows that the opponents have not been using either New York Cosmos or their COSMOS logo in any other way than as a description of, or an adornment to replica historic jerseys. These are, as Ms Vittoria says, sold under the name of The Old Fashioned Football Shirt Company Limited, or TOFFS, and in my view it is in these names that any goodwill or reputation subsists. To take the position that through the use shown, the opponents have built a reputation or goodwill in New York Cosmos or the COSMOS logo would raise the question of whether they have acquired any reputation or goodwill in the myriad of other insignia used upon the jerseys that they have sold. It surely cannot be that through this trade the opponents have acquired rights in the names and badges of Manchester United, Real Madrid, Port Vale, Cardiff City or any of the other football clubs whose jerseys they have replicated and sold. Mr Finch quite sensibly accepts that his company has no rights in the names of football clubs such as Arsenal, so why should the position be any different in the case of New York Cosmos? I see no reason why the New York Cosmos football club should be regarded any differently simply because it is defunct.

54. I therefore come to the position that the opponents have not established that they possess any goodwill or reputation in either New York Cosmos or the COSMOS logo, or any similar sign, and consequently there can be no misrepresentation or damage. The plain fact is that in the absence of any competing or prior right, the sign was there for the taking and the applicants got there first. The ground under Section 5(4)(a) is dismissed accordingly.

55. The opposition having failed on all grounds, I order the opponents to pay the applicants the sum of , 2,750 as a contribution towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of June 2004

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