O/175/19

TRADE MARKS ACT 1994

TRADE MARK APPLICATIONS 3222844 & 3222850

BY ESPORTS PREMIER LEAGUE LIMITED

AND EGAMES GROUP LIMITED

TO REGISTER TRADE MARKS IN CLASS 41

AND

OPPOSITIONS 409864 & 409805

BY THE FOOTBALL ASSOCIATION PREMIER LEAGUE LIMITED

AND

TRADE MARK REGISTRATIONS 2147888 & 2422847

IN THE NAME OF THE FOOTBALL ASSOCIATION PREMIER LEAGUE LIMITED

AND

APPLICATIONS 501841 & 501844

BY INTERNATIONAL MANAGEMENT GROUP LIMITED

TO REVOKE THE TRADE MARKS FOR NON-USE

Background and pleadings

1. These consolidated proceedings include oppositions 409805 and 409864 by The Football Association Premier League Limited ("the FA") to trade mark applications 3222850 and 3222844. These applications were filed on 4th April 2017 by Egames Group Limited and Esports Premier League Limited, respectively, to register the trade marks shown below.

3222950

3222844

2. Egames Group Limited and Esports Premier League Limited are related companies.

3. The applicants seek to register the marks in relation to *Entertainment; sporting and cultural activities; organisation and regulation of competitions; organisation and regulation of video gaming competitions; none of the aforesaid services relating to association football* in class 41.

4. The FA formally relies on 8 earlier trade marks, all of which were said to be similar to the opposed marks and registered for the same or similar goods/services. The FA

claims that there is a likelihood of confusion on the part of the public. Additionally, the FA claim that the earlier marks have a reputation, and that use of the opposed marks would, without due cause, take unfair advantage of, and/or be detrimental to, the reputation or distinctive character of the earlier marks. The FA further claims that, having regard to its goodwill and reputation under 'Premier League', use of the opposed marks would be contrary to the law of passing off.

5. The FA therefore says that registration of the opposed marks would be contrary to sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").

6. At the hearing described below, the opponent accepted that for reasons of procedural economy it is only necessary to deal with the grounds of opposition based on ss.5(2)(b) and 5(3) in relation to two of its earlier trade marks[1]. These are UK2147888 and UK3148844. The former is a word-only mark consisting of the words PREMIER LEAGUE. The latter is the figurative trade mark shown below.

7. Both marks are registered in class 41. 2147888 covers, inter alia, *services relating to sports' events and matches; all relating to the promotion of Association football.* 3148844 covers, inter alia, *organisation of competitions [education or entertainment].* 2147888 was registered in 1997. To rely on this trade mark in the oppositions, s.6A of the Act requires the FA to show that it put the mark to genuine use in the five-year periods ending on the dates that trade marks 3222844 and 3222850 were published for opposition purposes, i.e. 5th April 2012 to 4th April 2017 and 15th April 2012 to 14th April 2017, respectively. 3148844 was only registered in 2016. Therefore, the 'proof of use' provisions do not apply to this mark.

8. The applicants filed counterstatement denying the grounds of opposition. I note that the counterstatements:

---

[1] It being accepted that these marks represent the opponent's best case under ss.5(2)(b) and 5(3), and the s.5(4)(a) ground adding nothing to the s.5(2)(b) ground.

- Denied that the 3222844 mark includes the words ‘PREMIER LEAGUE’ (because PREMIER and LEAGUE are presented either side of the word ESPORTS);
- Denied that PREMIER LEAGUE is the dominant and distinctive element of the 3222844 mark;
- Claimed that PREMIER LEAGUE is inherently non-distinctive and in common usage to denote top level competition;
- Admitted that ESPORTS is descriptive of competition video gaming;
- Claimed that esports are classified as a game rather than a sport;
- Denied that the EGAMES is descriptive in the 3222850 mark (in contrast to esports in the 3222844 mark);
- Claimed that EGAMES denotes a particular competition run by the International E-games Committee;
- Denied that the presence of PREMIER LEAGUE in the 3222850 mark creates any similarity between that mark as a whole and the FA’s earlier marks;
- Denied that PREMIER LEAGUE is the dominant and distinctive element of the 3222850 mark;
- Put the FA to proof of use of trade mark 2147888;
- Put the FA to proof that its earlier marks have acquired enhanced distinctiveness and reputation through use, as claimed;
- Denied that there is a likelihood of confusion between the opposed marks and the FA’s earlier marks;
- Denied that use of the opposed marks will cause the public to make a link with the FA’s earlier marks;
- Denied that use of the opposed marks will take unfair advantage of, or be detrimental to, the reputation and/or distinctive character of the earlier marks.

9. International Group Management Limited is another company in the same group of companies as the applicants for trade marks 3222844 and 3222850. On 23rd October 2017 it applied to revoke the FA’s trade marks UK2147888 and UK2422847 for non-use. Trade mark 2147888 is one of the two marks the FA relies on in the

oppositions described above. Trade mark UK2422847 is another of the 8 earlier marks relied on in the opposition proceedings. However, in the light of the FA's position at the hearing described below, I no longer need to deal with it in that context.

10. The applicant for revocation claims that the 2147888 and 2422847 marks have not been put to genuine use and should be revoked in full under s.46(1)(a) or (b) of the Act. Revocation is sought with effect from 7th April 2012 or, failing that, from 7th April 2017 or 23rd October 2017.

11. For the sake of convenience, from here on I will refer to all three applicants collectively as "the applicants".

12. The FA filed counterstatements denying the grounds for revocation and asserting that the marks had been used, or that there were proper reasons for non-use.

The evidence

13. The FA's evidence consists of a witness statement by Tom Greenwood, the 'Head of Partnership Activation' at the FA (with 5 exhibits), a witness statement by Sophie von Zeppelin, a Commercial Lawyer at the FA (with 53 exhibits) and two witness statements by Matthew McAleer, a trade mark attorney at Lane IP (with 24 exhibits). Mr McAleer's second statement was made in reply to the applicants' evidence. This consists of a witness statement by Chester King (with 5 exhibits). Mr King is a director of all three of the applicants, and the Global Board Director of International Group Limited, which owns the applicants.

The Hearing

14. On 22nd May 2018, I issued a decision on behalf of the Registrar in which I upheld an opposition brought by the FA against trade mark application 3193656[2].

---

[2] See BL O/314/18

That application was filed by International Group Management Limited, one of the applicants in these proceedings. This was the mark at issue in those proceedings.

15. The trade mark was sought to be registered in relation to *organisation and regulation of video gaming competitions; none of the aforesaid services relating to association football* in class 41. Although they also cover broader descriptions of services, the services at issue in the earlier proceedings are again at issue in these opposition proceedings.

16. In the previous proceedings, I found that use of the mark shown at paragraph 14 was likely to cause confusion with, and/or take unfair advantage of the reputation of, the FA's trade mark 2147888 (PREMIER LEAGUE). I therefore held that registration of the mark would be contrary to ss.5(2)(b) and 5(3) of the Act. It was common ground in the earlier proceedings that trade mark 2147888 was entitled to protection, and that it had acquired a reputation, in relation to *services relating to sports' events and matches; all relating to association football or the Football Association Premier League.* Specifically, the organisation and regulation of such events and matches. On the other hand, I rejected similar grounds of opposition based on earlier trade mark 3148844[3] because I did not consider that mark was sufficiently similar to trade mark 3193656 to be likely to cause confusion, or for use of the latter mark to give rise to any of the conditions covered by s.5(3) of the Act.

17. At the earlier hearing, both sides were represented by counsel. The current proceedings were heard on 21st January 2019. As before, the FA was represented by Simon Malynicz QC, instructed by Lane IP. However, on this occasion the applicants decided not to be present, or to make written submissions in lieu of attendance.

[3] See paragraph 6 above

18. At the hearing, Mr Malynicz accepted that neither of the marks covered by the current oppositions are the same as the mark in the earlier opposition. However, he submitted that the evidence in the earlier opposition was similar to the evidence before me and he relied on my findings in the earlier opposition about earlier trade mark 2147888[4]. According to Mr Malynicz, the reasons I gave for upholding the FA's opposition to the applicants' earlier filed application also apply to the current trade marks.

19. As regards the applications for revocation of trade marks 2147888 and 2422847, Mr Malynicz's broad position was that the evidence showed genuine use of the marks in relation to some of the defended goods/services, but he accepted that no use of the marks had been shown in relation to the remainder of the registered specifications of goods/services.

20. I will return to the oppositions later in my decision. It is convenient to start by examining the applicants' application to revoke the FA's trade marks 2147888 and 2422847 for non-use.

The applications for revocation

21. The relevant parts of s.46 of the Act state that:

> "(1). The registration of a trade mark may be revoked on any of the following grounds-
>
> > (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

[4] This included my finding that there was no likelihood of confusion between the trade mark shown at paragraph 14 above and the FA's earlier trade mark 3184484: see paragraph 7 of Mr Malynicz's skeleton argument.

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c)...

(d)...

(2) For the purpose of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made: Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) -

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date."

22. Section 100 is also relevant. It provides that:

"If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

23. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*[5]*,* Arnold J. summarised the case law on genuine use of trade marks like this.

"217. *The law with respect to genuine use*. In *Stichting BDO v BDO Unibank Inc [2013] EWHC 418 (Ch), [2013] FSR 35 I* set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark [2010] RPC 28* at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV [2003] ECR I-2439* , Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA [2004] ECR I-1159* and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV [EU:C:2012:816], [2013] ETMR 16* on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

[5] [2016] EWHC 52

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word "genuine", other language versions use words which convey a somewhat different connotation: for example, "ernsthaft" (German), "efectivo" (Spanish), "sérieux" (French), "effettivo" (Italian), "normaal" (Dutch) and "sério/séria" (Portuguese). As the Court of Justice noted in Ansul at [35], there is a similar difference in language in what is now recital (9) of the Directive.

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetzky-Orden v Bundesvereinigung Kameradschaft 'Feldmarschall Radetzky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice:

Ansul at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

24. The specifications of registered trade marks 2147888 and 2422847 are shown in annex A.

25. As already noted, earlier trade mark 2147888 is the words PREMIER LEAGUE. Trade mark 2422847 consists of the following series of two marks.

26. The minor variation in colour makes no possible difference to the distinctive character of the marks. Therefore, for present purposes the marks can be treated as a single trade mark. I will proceed accordingly.

27. There are three relevant 5-year periods - 7th April 2007 to 6th April 2012, 7th April 2012 to 6th April 2017 and 23rd October 2012 to 22nd October 2017. However, under s.46(3) of the Act, genuine use in the most recent period would be sufficient to defeat the applications for revocation. Conversely, showing genuine use of the marks in the earlier periods, but not in the most recent period, would result in the applications for revocation succeeding. Therefore, I will focus mainly on whether the evidence shows use of the marks in the most recent period. If not, I will consider the position in the earlier periods, but only to determine an appropriate date for revocation.

28. Basing himself on the CJEU's judgment in *Colloseum Holdings AG v Levi Strauss & Co.*[6], Mr Malynicz submitted that use of the mark(s) shown at paragraph 25 above should also be taken as use of the word mark PREMIER LEAGUE. I

[6] Case C-12/12

accept that submission for the reasons given in paragraphs 50 and 51 of my decision of 22nd May 2018. The FA relies on the evidence of Sophie von Zeppelin to show that it has put the marks at issue to genuine use. The relevant evidence appears to be as follows.

Class 9

29. Ms von Zeppelin's evidence is that EA Sports has used a trade mark corresponding to the 2422847 mark from at least as early as September 2011, under licence, in relation to a computer game called FIFA. The mark was applied to the front cover of the version of the game sold in the UK. It also appears on screen when the game is played[7]. According to Ms von Zeppelin, around 2.5m to 3m units of the game were sold in the UK each year between 2012 and 2017. I find that this represents genuine use of the 2422847 mark and, by extension, the 2147888 mark. I find that an appropriate description of the use is 'computer games software' in class 9.

30. Ms von Zeppelin claims that the PREMIER LEAGUE mark *"has been used in relation to a number of mobile applications ("apps") for iOS and Android users in the UK."* She says that *"The Fantasy Premier League was a downloadable paid for app for the Fantasy Premier League game which allowed players to manage their team as well as providing result and scores updates."* The app cost $1.99 to download and raised around half a $million in the 2014/15 and 2015/16 seasons. This appears to be worldwide income. The appannie.com website shows that the app was ranked first in the UK in downloads on two dates in July 2015[8]. I find that this represents genuine use of the word mark PREMIER LEAGUE, in the UK, in relation to computer software for use in relation to football games. There is no evidence of corresponding use of the 2422847 mark.

31. Ms von Zeppelin also gives evidence about the use of PREMIER LEAGUE AWAY DAYS, PREMIER LEAGUE CREATING CHANCES, PREMIER LEAGUE

[7] See exhibit SZ40
[8] See exhibit SZ25 at page 246 of the evidence

GET IN and PREMIER LEAGUE – OFFICIAL APP in relation to software apps which provide information to users about:

(i) Facilities and statistics for fans visiting football grounds for away matches;
(ii) The Premier League's 2012 Creating Chances community programme;
(iii) Accessibility guidance and maps to help fans gain access to football grounds;
(iv) Live updates, fixtures, statistics and player profiles relating to PREMIER LEAGUE matches and teams.

32. These all appear to be free-to-download apps. Ms von Zeppelin does not provide download figures in her statement. However, it appears from exhibits SZ26 – 29 to her statement that some of these apps were widely downloaded in the UK.

33. In *Antartica Srl v OHIM, The Nasdaq Stock Market, Inc.*[9], the CJEU held that:

> "29. It is sufficient to note in that respect that, even if part of the services for which the earlier mark is registered are offered by The Nasdaq Stock Market free of charge, that does not of itself mean that that commercial company will not seek, by such use of its trade mark, to create or maintain an outlet for those services in the Community, as against the services of other undertakings."

34. Whether the provision of such free software apps represents genuine use of PREMIER LEAGUE in relation to computer software of this kind therefore turns on whether the use was intended "*to create or preserve an outlet for the goods… that bear the mark."* If these apps were intended to create a market share for software apps then the fact that they were given away free would not prevent the use of PREMIER LEAGUE from being genuine use of the 2147888 mark. On the other hand, if the use was only intended to promote Premier League football, or the Premier League as an organisation, then this would not be genuine use of the mark

[9] Case C-320/07P

in relation to software apps. Have carefully considered the possibilities, I have decided that the use in question was not intended to create a market share for software apps. Unlike in the *NASDAQ* case, the FA does not appear to trade in information about football, some of which is charged for and some provided for free. The use in this case appears to have been purely intended to promote the core services provided under the Premier League trade mark. i.e. football as a sport and as entertainment. The use in question is therefore more similar in nature to the use examined in *Silberquelle.* In that case the CJEU found that genuine use is not established where:

> "20. .....promotional items are handed out as a reward for the purchase of other goods and to encourage the sale of the latter."
>
> 21. In such a situation, those items are not distributed in any way with the aim of penetrating the market for goods in the same class. In those circumstances, affixing the mark to those items does not contribute to creating an outlet for those items or to distinguishing, in the interest of the customer, those items from the goods of other undertakings."

35. For the reasons given above, I find that the use of PREMIER LEAGUE in relation to free-to-download software apps does not constitute genuine use of the 2147888 trade mark. I note that there is no evidence of corresponding use (or any use) of the composite mark 2422847 in relation to software apps.

36. Ms von Zeppelin claims that the FA *"also produce and sell CDs/DVDs of season reviews and goals of the season through Premier League Productions and examples of these are seen at Exhibit SZ42."* This is the entirety of her evidence on this point. There is therefore no narrative witness evidence as to the date(s) of such use, the volume of products sold, the amount spent promoting such products, or the geographical spread of these sales. The relevant part of exhibit SZ42 consists of four pages downloaded from the website of Amazon on 18th February 2018, i.e. after the relevant periods. The first page shows that a triple DVD set was offered for sale under the title 'Premier League Classic Matches'. I can just about make out the 2422847 mark on the front cover of the DVD set. However, the product was on sale

for 87p because it was previously used. It follows that it is not possible to discern when this product was first placed on the market. The second page also shows a three DVD box set on sale on Amazon, again on 22nd February 2018. The 2422847 mark is visible on the cover of the box set. The title of the set is 'Greatest Goals of the Premier League' 1992 – 2007. This suggests that the product was first marketed around 10 years ago. It is true that it was still on sale on Amazon for £35.67 in 2018. However, I note that the seller was Amazon US.

37. The third page shows that a DVD called 'Review of the Season 2004/2005' was offered for sale on Amazon in 2018 for £8.59. The seller of this product was a UK company. There was *"Only I left in stock."* I cannot make out either of the trade marks at issue on the DVD itself[10]. The fourth page shows another DVD called 'Skill Factor' on sale on Amazon in 2018 for £18.19. It bears the 2422847 mark. The DVD dates from 2008 and is described as a US Import. The seller is Amazon US.

38. This evidence gives the impression that the FA used to sell DVDs, but they provide no concrete evidence that any were placed on the UK market with the consent of the FA, under the marks at issue, at least in the most recent relevant period. At the hearing, Mr Malynicz drew my attention to the last page of exhibit SZ33. This shows that a Blu-Ray DVD entitled 'We are Premier League' was offered for sale for £18. Other pages in the same exhibit appear to come from a web archive showing the website of AFC Bournemouth as at 13th April 2016, i.e. in the most recent relevant period. However, the page showing the Blu-Ray DVD has "Winners 2017" on the back cover, indicating that it is not from the same download. It is not clear where it comes from, or when. Ms von Zeppelin's statement says that this is an example of merchandise produced by Premier League clubs bearing the PREMIER LEAGUE marks, which would have been sold in-store or online. However, she does not provide any details about when these sales occurred, and she does not even mention CDs/DVDs.

[10] I can see a mark with a silhouette of a lion, but not the Lion in the 2422847 mark. Also, the word beneath this lion appears to be BARCLAYS.

39. In *Awareness Limited v Plymouth City Council*[11], Mr Daniel Alexander Q.C. as the Appointed Person stated that:

> "22. The burden lies on the registered proprietor to prove use.......... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

40. Taking this guidance into account, I find that the FA's evidence is not sufficient to show that either of the marks at issue were used in the UK, with its consent, in the most recent relevant period, in relation to CDs/DVDs.

Class 14

41. Only the 2147888 mark is registered in class 14. The FA relies on Ms von Zeppelin's evidence of sales of merchandise by Premier League clubs to support the registration of the 2147888 mark in relation to badges and cups in class 14. Exhibit SZ33 shows PREMIER LEAGUE used in relation to a cup marked "*2015/16 season.*" However, the 'cup' shown is not a trophy-style product, which may be classified in class 14 alongside other goods of precious or semi-precious metals, but a china mug. Mr Malynicz submitted that the use should be accepted as relevant to the registration of the marks in class 14, even though china mugs do not fall in this class.

[11] Case BL O/236/13

In this respect he relied on the judgment of Carr J. in *Pathway IP Sarl v Easygroup Ltd*[12]*.* After considering the judgment of the Court of Appeal in *Altecnic Ltd's Application*[13], the judgments of Arnold J in *Omega 1*[14] and *Omega 2*[15], as well as the CJEU's judgment in *IP Translator*[16], Carr J. said that:

> "79. I have reached the provisional view, in the light of the respondent's arguments, that it is appropriate to use class number as an aid to interpretation of the specification where the words used in the specification lack clarity and precision. This applies to granted registrations as well as to applications, and therefore applies in the context of infringement actions and revocation claims. My reasons for reaching this conclusion are set out below.
>
> 80. Of course, in many cases, it will be unnecessary to use the class number in this way, as the words chosen in the specification will be sufficiently clear and precise. Indeed, in the present case, I consider that the disputed phrase "provision of office facilities" is sufficiently clear and precise, so that its ordinary and natural meaning can be ascertained without reference to the class number."

42. It is important to note that:

(i) the judge's decision was 'provisional' indicating that he did not think that the matter was clear cut;

(ii) the guidance is to consider the class number only where the meaning of the disputed term is not sufficiently clear and precise;

(iii) where a term is sufficiently clear and precise on its face, the fact that the term covers goods/services that may also (or should have been) registered in

[12] [2018] EWHC 3608 (Ch)
[13] [2001] EWCA Civ 1928
[14] [2010] EWHC 1211 (Ch)
[15] [2012] EWHC 3440 (Ch)
[16] Case C-307/10

other classes is irrelevant to the scope of protection afforded to the term, or to questions of use of the mark in relation to those goods/services;

(iv) Where the term is not sufficiently clear and precise, the class number may be relied on to construe the scope of protection, i.e. to narrow the meaning of the term to goods/services in the class concerned.

43. Applying these principles, Carr J. decided that *rental of office equipment* in class 35 had been correctly construed as covering only rental services proper to class 35. This meant that use of the mark in relation to rental of photocopying machines was relevant because such services were proper to class 35. However, use in relation to rental of office furniture was irrelevant because those services did not fall in that class. By contrast, the judge decided that *provision of office facilities* was sufficiently clear and precise that it was unnecessary to resort to the class number to construe the meaning of the words. Therefore, the mark covered the provision of office facilities, irrespective of whether such services fell in class 35.

44. I find that the word 'cups' is not sufficiently clear and precise to identify a specific category or sub-category of commercial products. As the facts in this case show, it could mean a cup made from precious or semi-precious metal for use as a trophy, or a china cup for use as a drinking vessel. Although both can be described as 'cups', they are very different products. The term 'cups' (as with *rental of office equipment* in *Pathway IP Sarl v Easygroup Ltd* and *valves* in *Altecnic*) is therefore too broad in meaning to clearly and precisely identify a specific product (or service) for a particular purpose. In these circumstances, it is necessary to rely on the class number to construe the meaning of the description 'cups' in the specification of the 2147888 mark. China cups are proper to class 21 rather than class 14. Consequently, the possible use of the mark in relation to china mugs is of no assistance to the FA in relation to the registration of its mark in class 14.

45. Exhibit SZ33 also provides an example of AFC Bournemouth offering a pin badge for sale in April 2016 bearing the 2422847 and 2147888 marks. The badge cost £3.50. Ms von Zeppelin does not expressly say that the mark was used with the consent of the FA. However, given that it was used by a Premier League club, I am

prepared to infer as much. Again, the evidence leaves a lot to be desired. However, I am prepared to accept that this shows use of the marks at issue in relation to badges in the most recent relevant period. I infer that this is an example of more widespread use of the mark in relation to badges sold by Premier League clubs. I therefore accept that this shows genuine use of the 2147888 mark in relation to badges. The badges that fall in class 14 are those made of precious or semi-precious metals. The badge shown in the evidence is obviously not made from such metals. In the light of the guidance from *Pathway IP Sarl v Easygroup Ltd,* this would not usually matter. This is because the meaning of 'badges' is sufficiently clear and precise that I do not need to resort to the class number to understand exactly what 'badges' are. However, in this case the class 14 specification of the 2147888 mark includes the restriction "all included in class 14." Therefore, the wording of the specification itself means that the use of the mark in relation to goods classified in other classes is irrelevant[17]. In these circumstances, the judgment in *Pathway IP Sarl v Easygroup Ltd* makes no difference. It follows that the use shown of the 2147888 mark in relation to *badges* of common metal is of no assistance to the FA's defence of the registration of that mark in class 14. I will, however, take this use into account in relation to the registration of the mark in class 26, which is the appropriate class for the badge shown in the evidence.

Class 16

46. Ms von Zeppelin states that Merlin Topps produce the official Premier League sticker and trading card collections/games. These are sold throughout the UK. She does not provide any sales figures, but exhibit SZ41 contains images of the 'Premier League Official Sticker Collection albums for each year between 2005 and 2018. I note that the word mark PREMIER LEAGUE appears on all the album covers. The 2422847 mark also appears on the covers of the albums from 2011 to 2016. It is not clear (because she does not explain) what Ms von Zeppelin means when she says that the word mark has also been used in relation to 'games'. I suspect she means the 'game' of collecting the stickers to go in each year's album.

[17] The matter must be assessed at the time of the application for registration

47. I find that the evidence is (just) sufficient to establish genuine use of the 2147888 and 2422847 marks in relation to 'stickers' and 'albums' in class 16.

Classes 25/26

48. The FA relies on:

(i) The use of the words PREMIER LEAGUE and related logo marks in relation to player and replica football shirts sold to the public *"throughout the relevant period*;*"*
(ii) The use of PREMIER LEAGUE and the logo marks in relation to the 'Premier League Players Kit Scheme', through which football kits are provided to schools and youth organisations to encourage children to get active;
(iii) The use of the 2422847 mark (and therefore also the PREMIER LEAGUE word mark) on referees' kits, which the FA partly funds.

49. Although Ms von Zeppelin says that replica football shirts bearing the PREMIER LEAGUE marks are sold to the public, she does not provide any sales figures, or state where, when or how these sales occur. The pictures she provides as examples at exhibit SZ45 merely show professional footballers wearing shirts bearing logos including the words PREMIER LEAGUE. There is no evidence that the goods are sold to such footballers. This does not show use of the marks at issue to create or preserve a market for the goods. It is not therefore genuine use of the marks in relation to clothing.

50. According to exhibit SZ46, the purpose of the 'Premier League Players Kit Scheme' is to encourage children to take part in sport. The kits are funded by donations from players at Premier League clubs. This is a million miles from use of the marks to create a market for the goods. It is not genuine use either.

51. The same criticism applies to the use of the PREMIER LEAGUE mark on referees' kits. There is no evidence that the goods are sold to referees or anyone

else. This use has nothing to do with creating a market for clothing. It is not genuine use either.

52. Mr Malynicz submitted that if the use on referees' kits was not use in relation to clothing, then it was use in relation to decals for use on clothing, which fall within *badges and emblems* for which the 2147888 mark is registered in class 26. There is no evidence that the logos on referees' kits are decals. Further, even if they are, this submission suffers from the same defect as the argument relating to clothing; namely, there is no evidence that the use was intended to, or did, create a market for decals. Consequently, this is not genuine use of the 2147888 mark in relation decals either.

53. I conclude that no evidence has been provided showing genuine use of the 2147888 or 2422847 marks in relation to clothing (or decals). Only the 2147888 mark is registered in class 26. As explained in paragraph 45 above, there is evidence of use of the 2147888 mark in relation to *badges* in class 26.

<u>Class 28</u>

54. According to Ms von Zeppelin, Nike has been the official manufacturer of PREMIER LEAGUE footballs since 2001. However, this does not assist the FA because the application of the marks to footballs for use at Premier League matches (as opposed to footballs offered for sale) does not show that the marks were used to create a market for footballs.

55. Ms von Zeppelin also says that replica footballs bearing the PREMIER LEAGUE marks have been sold online and in sports stores throughout the UK. However, she does not say <u>when</u> these sales occurred or provide any further information indicating the volume of sales. Exhibits SZ37 is said to comprise print outs from UK retailers evidencing the sale of replica footballs. In fact, three of the six pages making up this exhibit are copies of pages from Nike's website showing that it produced footballs bearing the 2422847 mark (and therefore also the 2147888 mark) for use in the 2012/13 and 2018/19 seasons. The other three pages in this exhibit are historical pages from the website of JD Sports. They show that footballs bearing the 2422847

mark were offered for sale in the UK on 13th February 2010, 3rd April 2011 and 27th January 2012. These offers for sale pre-date the second and third relevant periods in these proceedings. No explanation has been provided as to why it has not been possible to show offers for sale of replica footballs bearing the marks after January 2012. There is therefore no cogent evidence of use of the marks after January 2012 to create or preserving a market for footballs. This means that the FA has failed to show genuine use of the marks in the most recent relevant period.

Class 41

56. In the earlier proceedings, and based on similar evidence, it was common ground that the FA had shown genuine use of the PREMIER LEAGUE word mark in relation to *services relating to sports' events and matches; all relating to the promotion of Association football* in class 41. This includes the organisation and regulation of Association football events and matches. Although the relevant periods are different in these proceedings, the core business of the FA has not changed. I therefore find that the evidence shows genuine use of the 2147888 mark in relation to the services set out above.

57. The 2422847 mark has been used on a substantial scale in relation to the same services during the most recent relevant period[18]. The limitation "*all relating to the promotion of Association football*" is not necessary to stay within the existing specification of trade mark 2422847. However, I find that the description *"services relating to sports' events and matches"* is too broad (and vague) to be a fair description of the services for which use has been shown. Therefore, the qualifying words *"all relating to Association football"* remain necessary for the surviving specification to accord with the average consumer's perception of the use shown[19].

58. The 2422847 mark is also registered in class 41 in relation to, *inter alia*:

[18] See, for example, exhibits SZ6 (television advertising) and SZ13 (archival pages from the FA's website)

[19] See the summary of the applicable law by Carr J. in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

"Education; providing of training; entertainment; sporting and cultural activities; information relating to sporting events provided on-line from a computer database or the Internet; electronic games services provided by means of the Internet; training services and organisation of competitions and sporting events; officiating at sports contests."

59. *Services relating to sports' events and matches; all relating to the promotion of Association football* is covered by the broad description *sporting and cultural activities*. However, the latter description covers many other services for which no use has been shown. I find that the former description is a fair description of the use shown of the 2422847 mark. The same use, including the use shown on referee kits, is sufficient to justify the retention of *officiating at sports contests, organisation of competitions and sporting events* and *entertainment* [services]. However, the latter description of services is so broad that to fairly reflect the use shown, and to accord with the perception of the use by average consumers, the term *entertainment* must be qualified by "....*provided through the organisation of sporting competitions and events."*

60. Ms von Zeppelin's evidence is that the FANTASY PREMIER LEAGUE game is available online. Between June 2009 and June 2017, the number of members registered to play the game grew from around 2m to over 4m. Around a third of these members were from England. Entry to one version of the game, called the Ultimate Fantasy Premier League, cost £5 per team. This gaming competition ran between 2013 – 2016[20]. The 2422847 mark was also used in relation to this online game[21]. The game is plainly related to the downloadable app mentioned earlier, for which a charge was levied. The nature of the use shown is therefore commercial use intended both to promote the FA's core services and to create a share of the market for online games. I therefore find that the FA has established genuine use of its 2422847 mark in relation to *electronic games services provided by means of the Internet*[22].

[20] See exhibit SZ22
[21] See exhibits SZ21 and 22
[22] The 2147888 mark is not registered for such services

61. The 2147888 and the 2422847 marks are also registered in class 41 in relation to *educational services, training services and facilities; all relating to the promotion of Association football* and *education, providing of training, information relating to sporting events provided on-line from a computer database or the Internet,* respectively.

62. Although it has undoubtedly provided information about football via its website and various reports, there is no evidence that the FA has used the marks at issue to create or preserve a <u>market</u> for *information relating to sporting events provided on-line from a computer database or the Internet.* This is because the purpose of the information provided appears to have been purely to promote Association football and the FA's core services of organising and regulating Association football events and matches.

63. At the hearing, Mr Malynicz sought to persuade me that the FA had made genuine use of the marks in relation to educational services and training materials. In this connection, my attention was drawn to paragraphs 20 and 50 of Ms von Zeppelin's statement. In paragraph 20 of her statement, Ms von Zeppelin describes the establishment of a website called kids.getonwiththegame.com, which she says included entertainment and educational information, teaching materials and games. Again, this is all very vague. There is a just one page in the related exhibit SZ20 which <u>may</u> show use of the 2422847 mark within the most recent relevant period[23]. The page is entitled 'Teachers Users Guide' and relates to the availability of a 'Get On With the Game' education pack. The 2422847 appears at the top and the bottom of the webpage. This 'education pack' appears to constitute training material of sorts, but there is no evidence that any attempt was made to create a market for such goods within the most recent relevant period, let alone one for educational or training <u>services</u>.

64. In paragraph 50 of her statement, Ms von Zeppelin describes the FA's community projects. She says that:

---

[23] See page 213 of the evidence. The date on the copy in evidence is too indistinct to be sure that it from within the relevant period.

> "The activities focus not only on promoting and nurturing young sporting talent, but also on creating opportunities for disabled people, providing enterprise education to inspire young people, and providing free educational resources (including mathematics, English and physical education) to schools across the UK, all under the PREMIER LEAGUE marks, including the PREMIER LEAGUE and LION logo."

According to Ms von Zeppelin, these activities constitute "*education; providing of training, entertainment, sporting and cultural activities, education information"* (as services).

65. It is not possible to discern from Ms von Zeppelin's high-level statement exactly which education and training <u>services</u> the FA has provided to whom under the marks, or when, or on what scale. Many businesses provide community funding to local schools etc. This does not mean that they are providing services, even on a charitable basis. It is apparent from exhibit SZ30 to Ms Zeppelin's statement that the FA funds, or co-funds, certain sporting activities in schools and sports clubs. But providing funding is not providing the same as providing services under the marks at issue. The closest the evidence gets to establishing the provision of an education/training <u>service</u> is a reference on a page entitled 'Delivering Sport in Schools' to the fact that there were 125k primary school children in 'Premier League School Sports sessions in 2014/15'[24]. The text on the same page refers to *"Running PE lessons across the country"* in connection with the *"Premier League's aims to build a sporting habit for life and create more opportunities to play in competitive football matches."* However, it is not clear where this page comes from. Mr von Zeppelin herself says nothing at all about the FA running PE lessons under the marks. It would have been easy for her to have given evidence about this service and provided some basic information about it. In my view, this evidence is simply too vague and nebulous to establish that the FA provided education and/or training services under the marks within the relevant periods.

---

[24] See page 270 of the evidence in exhibit SZ30

Outcome of the revocation applications

66. I find that the FA has established genuine use of the 2147888 mark within the most recent relevant period in relation to the following goods/services:

> Class 9: Computer games software, all relating to Association football or the Football Association Premier League; all included in Class 9
> Class 16: Stickers; albums; all relating to Association football or The Football Association Premier League; all included in Class 16
> Class 26: Badges, all relating to Association football; all included in Class 26
> Class 41: Services relating to sports' events and matches; all relating to the promotion of Association football; all included in Class 41

67. The 2147888 mark will be revoked for non-use in relation to the remainder of the goods/services for which it is registered.

68. In accordance with s.46(6)(b) of the Act, the revocation will, except for footballs in class 28, take effect as from 7th April 2012. The revocation of the mark for footballs will take effect as from 7th April 2017.

69. I find that the FA has established genuine use of the 2422847 mark within the most recent relevant period in relation to the following goods/services:

> Class 9: Computer games software
> Class 16: Stickers; albums
> Class 41: Services relating to sports' events and matches, all relating to Association football; officiating at sports contests; organisation of competitions and sporting events; entertainment provided through the organisation of sporting competitions and events; electronic games services provided by means of the Internet

70. The 2422847 mark will be revoked for non-use in relation to the remainder of the goods/services for which it is registered.

71. In accordance with s.46(6)(b) of the Act, the revocation will, again except for footballs in class 28, take effect as from 7th April 2012. The revocation of the mark for footballs will take effect as from 7th April 2017.

The FA's oppositions 409805 & 409864 to applications 3222850 & 3222844 by Egames Group Limited and Esports Premier League Limited

72. In the light of the position of the opponent at the hearing, it is only necessary to consider the opposition to trade mark applications 3222850 and 3222844 under ss.5(2)(b) and 5(3) of the Act based on earlier trade mark 2147888[25].

73. Section 5(2)(b) of the Act is as follows:

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

Comparison of services

74. The respective services are shown below.

UK2147888	Contested marks
Services relating to sports' events and matches; all relating to the promotion of Association football; all included in Class 41.	Entertainment; sporting and cultural activities; organisation and regulation of competitions; organisation and regulation of video gaming competitions; none of the aforesaid services relating to association football.

[25] See paragraph 18 above and footnotes 1 & 4

For the reasons given above, I find that the FA has shown that it made genuine use of the 2147888 mark in relation to the services at issue in the periods 5th April 2012 to 4th April 2017 and 15th April 2012 to 14th April 2017. Consequently, the requirements of s.6A of the Act are satisfied.

75. In my earlier decision, I considered the similarity between the services covered by the 2147888 mark and those covered by application 3193656, which were:

> "Organisation and regulation of video gaming competitions, none relating to association football."

76. After considering the evidence, which in this respect was almost the same as the evidence filed in this case, I decided that:

> "60. The respective services are similar to some degree in nature, both involving the organisation and regulation of competitive events and matches. The parties disagree as to whether 'esports' is a game or a sport. I do not think it matters. Video gaming competitions are clearly different to soccer competitions, even if the former includes soccer games. The purpose of the respective services is similar in that both are intended to encourage and promote (albeit different kinds of) live competitive matches and events. The method of use of the services is not the same. The applicant's services are more of an online activity than playing or watching soccer. However, there is some similarity of use because soccer is also watched online (or via TV screens) and the evidence shows that the applicant's services are capable of being played in front of live audiences. The services are not really in competition. Nor are they complementary in the sense described in the case law. However, the evidence shows that there is a likely to be a significant overlap in the end users of the respective services. Overall, I consider that there is a medium degree of similarity between the respective services."

77. I find that the same applies to the similarity between the services covered by the 2147888 mark and *organisation and regulation of video gaming competitions; none of the aforesaid services relating to association football* in the current applications.

78. The remaining descriptions of services, namely *Entertainment; sporting and cultural activities; organisation and regulation of competitions; none of the aforesaid services relating to association football* are broader descriptions of services, all of which are wide enough to cover *organisation and regulation of video gaming competitions; none of the aforesaid services relating to association football.* The broader descriptions of services can therefore be regarded as identical to the narrower description of services for present purposes[26]. It follows that my finding that the respective services are similar to a medium degree applies to all the services covered by the contested marks.

<u>The average consumer and the selection process</u>

79. In my earlier decision I found that:

> "55. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*[27]. I see no reason to believe that the relevant average consumer of the services at issue will pay an exceptionally high or low degree of attention when selecting a service provider. Therefore, I find that the relevant average consumer will pay a normal or average degree of attention when selecting the services at issue.
>
> 56. When I asked him about it, Mr Malynicz suggested that the applicant's services are likely to be selected from advertisements, including online advertisements. I agree that this will be the primary means through which such services are selected. However, I consider it likely that video gaming competitions are also likely to be the subject of word of mouth recommendations from players and watchers of such events. Therefore, the way that the marks look will have most bearing on the likelihood of confusion, but the way that they sound will also have some (albeit less) impact."

[26] See *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05
[27] Case C-342/97

80. These findings also apply to the current proceedings.

Distinctive character of the earlier mark

81. In the earlier proceedings I found that:

> “63. The applicant says that PREMIER LEAGUE means ‘top league’ and is therefore descriptive of the services of any sporting competition. The opponent does not appear to strongly dispute that the words are prima facie descriptive, but argues that the mark has become highly distinctive through use. In this connection, the opponent disputes that the applicant has shown widespread use of the same name by third parties in the UK prior to the relevant date.
>
> 64. I accept that the evidence shows that the opponent’s PREMIER LEAGUE is very well known in the UK. I also accept that the evidence does not show widespread generic use of the name by third parties in the UK. However, certain apparently descriptive uses, such as SCOTTISH PREMIER LEAGUE (football) and INDIAN PREMIER LEAGUE (cricket) were likely to be widely known to sports fans in the UK at the relevant date. It is true that the latter is known as an overseas competition, but even this sort of use will have helped to prevent the ordinary meaning of ‘premier league’ from being entirely displaced by its acquired meaning as one of the opponent’s trade marks. I therefore find that, at the relevant date, absent any clear indication to the contrary, UK consumers would have regarded the words PREMIER LEAGUE as designating the opponent’s football competition in England and Wales. However, I do not accept that the mark was so strongly distinctive of trade origin that it would have triggered a connection with the opponent irrespective of other indications, such as the geographical coverage of the football league (i.e. SCOTTISH) and/or the type of competition (i.e. cricket). I therefore find that although the earlier mark had a strong reputation at the relevant date it was only distinctive of the opponent to a medium degree.”

82. The evidence filed in these proceedings is very similar to the evidence filed in the earlier proceedings. I reach the same findings.

Comparison of the marks

83. The marks are shown below.

Earlier mark	Contested marks
PREMIER LEAGUE	3222844 PREMIER ESPORTS LEAGUE 3222850 eGAMES PREMIER LEAGUE

Comparison with the '844 mark

84. The '844 mark is similar to the contested mark in the earlier opposition proceedings. After comparing the mark shown in paragraph 14 above to the FA's PREMIER LEAGUE word mark, I found as follows:

> "69. The applicant accepts that the word 'esports' is purely descriptive. It must therefore be less distinctive than Premier League, which is at least capable of acquiring distinctive character as a trade mark. However, as ESPORTS is the first word in the contested mark it will not be overlooked or missed when the

contested mark is seen or verbalised. The inclusion of the word ESPORTS in the contested mark therefore distinguishes the look and sound of the marks to some extent, despite its purely descriptive significance. The marks are more similar to the ear than to the eye because the device element of the contested mark makes no contribution to the sound of that mark. Overall, I find that the marks are visually similar to a medium degree and aurally similar to a medium to high degree.

70. The letter ‘e’ is commonly used to mean ‘electronic’, e.g. email, e-forms. The meanings of ‘sports’, ‘premier’ and ‘league’ are obvious. Therefore, the words ‘esports’ and ‘premier league’ are, according to their ordinary meanings, descriptive of ‘electronic sports’ and ‘top level league’, respectively. In my view, the words in the contested mark convey the idea of a top-level league composed of players or teams competing through electronic sports. The concept of a ‘top level league’ in the earlier mark is the same concept that is present in the contested mark. Further, the association between sports and ‘league’ are reflected in the ordinary meaning of the word ‘esports’. I therefore find that the marks are conceptually similar to a medium to high degree.”

85. Mr Chester’s evidence is that after the FA opposed the earlier application the applicants decided to file applications that were further away from PREMIER LEAGUE. According to Mr Chester, the ‘844 mark does not include the word string ‘Premier League’ because the words in the mark would be naturally read as ‘Premier Esports League’.

86. At the hearing, Mr Malynicz submitted that the order of the words in the ‘844 mark was ambiguous. He accepted that some consumers would see the words as PREMIER ESPORTS LEAGUE. However, he argued that the close proximity of the words ‘Premier’ and ‘League’ around the left-hand side of the roundel would lead other consumers to read (and say) the words in the mark as ESPORTS PREMIER LEAGUE. The wide exposure of the name PREMIER LEAGUE to the public would further increase the likelihood of consumers joining those words together.

87. I agree that some average consumers would see (and say) the ‘844 mark as PREMIER ESPORTS LEAGUE, but I find that a significant proportion of average consumers would see (and say) it as ESPORTS PREMIER LEAGUE (or PREMIER LEAGUE ESPORTS). Mr Malynicz reminded me that there is no single meaning rule[28]. It is therefore appropriate to attach some weight to the reaction to the ‘844 mark of average consumers who see the words as ESPORTS PREMIER LEAGUE.

88. I find that to this section of average consumers the marks are visually similar to a medium degree, and aurally and conceptually similar to a medium to high degree.

89. To those consumers who see (and say) the ‘844 mark as PREMIER ESPORTS LEAGUE, I find that the marks are visually, aurally and conceptually similar to a low degree. This is because the mark would not appear to include the specific word combination PREMIER LEAGUE. However, even to this group of consumers, the words PREMIER and LEAGUE would be a discernible feature of the ‘844 mark, even when separated by the word ESPORTS.

90. I have considered whether the fact that PREMIER and LEAGUE are separately disclaimed in the 2147888 mark makes any difference to this finding. I have concluded that it does not. This is because the FA’s claim depends on the combination of the words PREMIER and LEAGUE. Both those words appear in the ‘844 mark. The disclaimer does not mean that the FA’s rights in the 2147888 mark are limited to the use of the words PREMIER and LEAGUE immediately next to one another.

Comparison with the ‘850 mark

91. Mr Chester’s evidence is that ESPORTS is generic for competitive video games played online or live, but EGAMES is not. Rather, he claims that EGAMES is distinctive an international esports competition he established in 2015. In this connection, he points out that the EGAMES logo (i.e. the ‘850 without the words PREMIER LEAGUE) is already registered for the services at issue. Mr Chester also

[28] *Soulcycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch)

points out that PREMIER LEAGUE is presented in a smaller font to EGAMES, which he considers dominates the ‘850 mark.

92. At the hearing, Mr Malynicz submitted that even if ‘egames’ is not a generic term (like ‘esports’), it is descriptive of electronic games. I accept this submission. ‘Games’ is obviously descriptive of gaming competitions. And as I noted in my earlier decision, the letter ‘e’ is commonly used and understood to mean ‘electronic’ as in ‘email’. I also note that Mr McAleer’s second witness statement includes an exhibit showing that ‘egames’ is listed in PC Mags encyclopaedia of terms as a generic term meaning *“any amusement or recreation using a stand-alone video game, desktop computer or the Internet with one or more players[29].”* I therefore find that ‘EGAMES’ is descriptive of *organisation and regulation of video gaming competitions.* Therefore, I do not accept that EGAMES is the distinctive and dominant element of the ‘850 mark. Admittedly, that word appears in larger font than the words PREMIER LEAGUE. And *prima facie* PREMIER LEAGUE describes a top league. However, the evidence shows that those words can acquire a trade mark character through use to denote a particular league, and that they have in fact acquired such a meaning in relation to the FA’s services. I find that the words PREMIER LEAGUE make a more-than-negligible contribution to the identity of the ‘850 mark. Further, the presentation of those words in a different font and colour to EGAMES reinforces the impression that those words constitute an independent element of the ‘850 mark.

93. Mr Malynicz submitted that the device element of the ‘850 mark is a banal geometric shape with little distinctive character. I disagree. In my view, the device is not banal. It is distinctive to an average degree.

94. Comparing the marks as wholes, I find that they are visually similar to a low degree. The device element will not be verbalised when the mark is spoken. Consequently, the ‘850 mark will be articulated as EGAMES PREMIER LEAGUE. The marks are therefore more similar to the ear than they are to the eye. I find that they are aurally similar to a medium degree. Both marks bring to mind a top league. Leaving to one side the reputation of the FA’s earlier mark, the natural meaning

[29] See exhibit MM24

conveyed by the ‘850 mark is an ‘electronic games top league’. The ‘electronic games’ meaning conveyed by EGAMES has no counterpart in the FA’s mark. The meanings conveyed by the marks are therefore partly the same. Consequently, I find that the inherent meanings of the marks are conceptually similar to a medium degree.

<u>Likelihood of confusion between the ‘844 mark and the earlier mark</u>

95. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when

all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

96. As in the earlier opposition proceedings, I find that even after allowing for imperfect recollection, the differences between the marks as wholes, when combined with the difference between the respective services, are sufficient to avoid a likelihood of direct confusion, i.e. one mark being mistaken for the other.

97. However, I again have more difficulty in ruling out the likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc.*[30]*,* Mr Iain Purvis Q.C. as the Appointed Person noted that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark."

98. Given that:

(i) The device element of the '844 mark makes only a small contribution to the visual impact it will make on consumers (and none to the aural or conceptual impacts);
(ii) The word 'esports' is purely descriptive of the services covered by the '844 mark;
(iii) The words Premier League are distinctive (through use) to a medium degree of the FA's services relating to the organisation and regulation of association football;

- there appears to be a likelihood of indirect confusion.

99. The applicant in the earlier proceedings put forward three answers to this, which are repeated by the current applicants. Firstly, that services relating to association

[30] Case BL-O/375/10

football have been excluded. Secondly, that 'esports' is a game not a sport. Thirdly, that video games based on football are not a popular amongst players of esports.

100. In my earlier decision I found that point two was irrelevant, and that the evidence did not establish point three. The applicants' evidence in this case goes no further than the evidence it filed in the earlier proceedings. I accept the FA's evidence that football-based video games were a category of video games of interest to UK video gamers at the relevant date in these proceedings, i.e. 4th April 2017. In the earlier opposition, I concluded that:

> "..the presence of the words PREMIER LEAGUE in the contested mark would have lead a significant proportion of average UK consumers to expect the services provided under that mark to include video gaming competitions based on the type of association football organised and regulated by the opponent. In these circumstances, average consumers would regard the words PREMIER LEAGUE as indicating that there is an economic connection between the users of the marks. The inclusion of the words ESPORTS (and/or the device element) in the contested mark would not have been sufficient to counter this impression."

101. I reach the same conclusion in these proceedings in relation to the '844 mark. In this connection, I note that in paragraph 34(v) of the judgment of Kitchin L.J. in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation*[31], he said that there will be trade mark infringement where, having regard to the perception and expectations of average consumers, the "*court concludes that a significant proportion of the relevant public is likely to be confused."* This applies equally to opposition proceedings under s.5(2) of the Act. My finding that a <u>significant proportion</u> of average consumers are likely to suffer from [indirect] confusion is therefore fatal to the application to register the '844 mark.

[31] [2016] EWCA Civ 41

Likelihood of confusion between the '850 mark and the earlier mark

102. I have carefully considered whether the difference between the words 'esports' and 'egames', as well as the greater distinctiveness of the device element of the '850 mark, should cause me to reach a different conclusion to the one I have reached about the '844 mark.

103. I find that the use of the word 'egames' instead of 'esports' will not make much difference to the perception of average consumers of the applicants' services. Both words are descriptive. It might be said that 'esports' points more strongly to the possibility of a football-based gaming competition than 'egames'. However, the applicants' position is that 'esports' is a generic term describing electronic video games. The fact that football-based electronic games are familiar to users of video games is also relevant in this respect. In these circumstances, the less pointed reference to a sporting connection will not be enough to avoid the words PREMIER LEAGUE indicating a connection to games based on Association Football regulated by the FA.

104. I accept the inclusion of the distinctive device in the '850 mark makes some difference. It further reduces the likelihood of direct confusion. However, I do not consider that the presence of the device when the '850 mark is seen will avoid the likelihood of indirect confusion. This is because neither the device, nor the words EGAMES, are sufficient to prevent a significant proportion of average consumers from believing that the presence of the words PREMIER LEAGUE indicates that the applicants' video gaming competitions are based on PREMIER LEAGUE football. These consumers may wrongly assume that the applicants have a licence, or consent, to use the FA's trade mark in relation to their services. The fact that these consumers may subsequently discover that the applicants' services do not relate to association football does not cure the confusion that will already have occurred and attracted consumers to those services.

Conclusion on the s.5(2)(b) grounds of opposition to trade marks 3222844 and 3222850

105. The s.5(2)(b) ground of opposition based on earlier mark 2147888 succeeds.

The s.5(3) ground of opposition

106. Section 5(3) states:

> "(3) A trade mark which-
> (a) is identical with or similar to an earlier trade mark, 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 European Union trade mark or international trade mark (EC), in the European Union) 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."

107. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* [1999] ETMR 950, Case 252/07, *Intel,* [2009] ETMR 13, Case C-408/01, *Addidas-Salomon,* [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora.* The law appears to be as follows.

> a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24.*
>
> (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; G*eneral Motors, paragraph 26.*
>
> (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63.*

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68;* whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79.*

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77.*

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74.*

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction,

the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).*

108. In my previous decision, I found that the 2147888 mark had a strong reputation with the public, and that the mark at paragraph 14 above would be linked to the earlier mark. I held that:

> "105. In the field of association football, PREMIER LEAGUE means the competition organised and regulated by the opponent. The evidence shows that the earlier mark has a strong reputation in that context. It is undoubtedly the sort of reputation capable of attracting numerous soccer fans to goods and services that are perceived as being related to PREMIER LEAGUE soccer. In my view, the inclusion of those words as a prominent feature of the contested mark in relation to a video gaming competition that <u>could</u> be based wholly or partly on soccer games, is sufficient to take advantage of the reputation of the earlier mark. The absence from the contested mark of any effective indication that the services provided under it are related to something other than association football makes the advantage gained unfair."

109. I reach similar findings in relation to trade marks 3222844 and 3222850. I find that the advantage gained from the use of those marks would be unfair, even if the public did not believe that the users of the marks at issue have a licence, or consent, from the proprietor of the PREMIER LEAGUE mark. This is because the use of the '844 and '850 marks would still attract consumers to the applicants' services on the back of the reputation of the PREMIER LEAGUE trade mark. And this is likely to economically benefit the applicants' without paying any financial compensation to the FA.

110. For the reasons given at paragraphs 106 to 110 of my previous decision, I find that the applicants do not have due cause to use the contested marks.

111. It follows that the opposition under s.5(3) also succeeds.

Outcome of the oppositions

112. The oppositions have succeeded. The applicants' trade mark applications will be refused.

Costs

113. Mr Malynicz submitted that the revocation applications resulted in a 'score draw'. On that basis, he accepted that the FA could not expect an award of costs in relation to the revocation proceedings. However, in the expectation that the FA's oppositions would succeed, he submitted that an award of costs was appropriate. He suggested that the applicants should have expected to lose the oppositions after failing in the earlier opposition case and that a reasonable applicant would have withdrawn the current applications. Instead, the applicants persisted with their applications, forcing the FA to incur the cost of a hearing.

114. I find that the applicants have been mostly successful in the revocation applications.

115. The FA has succeeded in the oppositions. However, I do not accept that it was unreasonable for the applicants to persist with their applications in the light of my earlier decision. The marks I have considered in these proceedings are different to the mark I considered in my earlier decision. The fact that I have ultimately reached the same conclusions does not mean that the applicants should have expected this to be a foregone conclusion. It was not.

116. I find that both parties have had a reasonable degree of success. I therefore order the parties to bear their own costs.

Dated 3 April 2019

Allan James
For the Registrar

Annex A

Trade mark 2147888

Class 9: Sound and/or video recordings; tapes; cassettes; compact discs; films; slides; video recorders; video cassettes; games adapted for use with television receivers; coin/counter-operated games; computer software; data processing apparatus; electric and electronic score boards; photographic and cinematographic apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; parts and fittings for all the aforesaid goods; all relating to Association football or the Football Association Premier League; all included in Class 9.

Class 14: Chronological and chronometric instruments; clocks and watches; tea plates, tea services, tea caddies, tea pots, goblets, cutlery, trays, vases and urns, salt and pepper pots, napkin holders and napkin rings, all made wholly or principally of precious metals and their alloys or coated therewith; jewellery and precious stones; trophies, ornaments, figurines, models, badges and brooches, cups, tie clips, tie pins, medals and medallions, all relating to Association football; all included in Class 14.

Class 16: Paper, notepaper, greetings cards, transfers, decalcomanias, cardboard; posters; stickers; trading cards; labels; wrapping and packaging materials; printed matter; periodical publications; newspapers; books; photographs; stationery; vehicle stickers; artists' materials; instructional and teaching materials; ordinary playing cards; all relating to Association football or The Football Association Premier League; all included in Class 16.

Class 25: Articles of outerclothing; footwear; headgear; all included in Class 25.

Class 26: Badges and emblems; buttons; buckles and tie-pins; brooches; ribbons; embroidery; textile smallwares; all relating to Association football or The Football Association Premier League; all included in Class 26.

Class 28: Games and playthings; gymnastic and sporting articles; all relating to Association football or The Football Association Premier League; all included in Class 28.

Class 41: Educational services; training services and facilities; services relating to sports' events and matches; all relating to the promotion of Association football; all included in Class 41.

Class 42: Bar services

Trade mark 2422847

Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers; calculating machines, data processing equipment and computers; fire-extinguishing apparatus; magnetic and magnetically encoded cards; programmable cards; smart cards; cards for bearing data; credit, charge, debit and/or cash cards; prepayment cards; cheque guarantee cards; apparatus for processing; apparatus for processing card transactions and data relating thereto and for payment processing; cash registers; apparatus for verifying data on magnetically encoded cards; sound and/or video recordings; tapes; cassettes; compact discs; films; slides; video recorders; video cassettes; video discs; DVDs; games adapted for use with television receivers; computer games; computer software; screensavers; publications in electronic format; data processing apparatus; electric and electronic scoreboards; photographic and cinematographic apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; telecommunications apparatus, equipment and accessories; protective clothing and protective footwear; parts and fittings for all the aforesaid goods.

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; travellers cheques; cardboard and plastic cards; money orders, money drafts; cheques; booklets; posters; bookmarks; flags, banners; paper; cardboard; note-paper transfers; decalcomanias; labels; wrapping and packaging materials; printed matter; trading cards, periodical publications; newspapers; books; photographs; albums; stationery; pens, pencils, rulers, pencil cases, writing paper; car tax disc holders; stickers; vehicle stickers; artists' materials; writing and drawing instruments; greeting cards; instructional and teaching material; calendars; diaries; address books; folders; files; writing instruments of precious metal; cheque book holders.

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; keycases; purses; bags; handbags, boot bags; holdalls; luggage; trunks and travelling bags; suitcases; rucksacks; backpacks; sporting bags; wallets; credit card holders; briefcases; card cases; luggage labels; walking sticks; parasols; umbrellas; belts, strips.

Class 25: Clothing; footwear; headgear.

Class 28: Games and playthings; gymnastic and sporting articles not included in other classes; toys; games; playthings; board games; hand-held, self-contained

games apparatus; gymnastic and sporting articles; footballs; balls; bags adapted for carrying sporting articles and apparatus; miniature replica football kits; sponge hands in the nature of novelties; darts and flights therefor, balloons; coin/counter operated games; ordinary playing cards.

Class 35: Advertising; business management; business administration; office functions; advertising and promotional services; marketing; display services for merchandising; compilation, production and dissemination of advertising matter; business planning; assistance and management services; business administration services; office functions; management assistance services; business investigations and surveys; business relocation services; bookkeeping and accounting services; tax assessment preparation; preparation and completion of income tax returns; provision of information relating to tax; tax consultancy and planning services; business consultancy and advisory services; provision of information relating to accounts; provision of statements of account; registration, administration and secretarial services for companies; document reproduction services; data processing services; computerised record keeping, accounting and database management services; compilation of data relating to goods for purchase; making and compilation of surveys over the Internet for use in market research; consultancy, information and advisory services relating to all the aforegoing; retail services connected with the sale of scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, automatic vending machines and mechanisms for coin operated apparatus, cash registers, calculating machines, data processing equipment and computers, fire-extinguishing apparatus, magnetic and magnetically encoded cards, programmable cards, smart cards, cards for bearing data, credit, charge, debit and/or cash cards, prepayment cards, cheque guarantee cards, apparatus for processing, apparatus for processing card transactions and data relating thereto and for payment processing, cash registers, apparatus for verifying data on magnetically encoded cards, sound and/or video recordings tapes, cassettes, compact discs, films, slides, video recorders, video cassettes, video discs, DVDs, games adapted for use with television receivers, computer games, computer software, screensavers, publications in electronic format, data processing apparatus, electric and electronic scoreboards, photographic and cinematographic apparatus and instruments, apparatus for recording, transmission or reproduction of sound or images, telecommunications apparatus, equipment and accessories, protective clothing and protective footwear, parts and fittings for all the aforesaid goods, paper, cardboard and goods made from these materials, printed matter, book binding material, photographs, stationery, adhesives for stationery or household purposes, artists' materials, paint brushes, typewriters and office requisites (except furniture), instructional and teaching material (except apparatus), plastic materials for packaging, printers' type, printing blocks, travellers cheques, cardboard and plastic cards, money orders, money drafts, cheques, booklets, posters, bookmarks, flags, banners, paper, cardboard, note-paper transfers, decalcomanias, labels, wrapping and packaging materials, printed matter, trading cards, periodical publications, newspapers, books, photographs, albums, stationery, pens, pencils, rulers, pencil cases, writing paper, car tax disc holders, stickers, vehicle stickers, artists' materials,

writing and drawing instruments, greeting cards, instructional and teaching material, calendars, diaries, address books, folders, files, writing instruments of precious metal, cheque book holders, leather and imitations of leather, and goods made of these materials, animal skins, hides, trunks and travelling bags, umbrellas, parasols and walking sticks, whips, harness and saddlery, key cases, purses, bags, handbags, boot bags, holdalls, luggage, trunks and travelling bags, suitcases, rucksacks, backpacks, sporting bags, wallets, credit card holders, briefcases, card cases, luggage labels, walking sticks, parasols, umbrellas, belts, strips, clothing, footwear, headgear, games and playthings, gymnastic and sporting articles, toys, games, playthings, board games, hand-held, self-contained games apparatus, gymnastic and sporting articles, footballs, balls, bags adapted for carrying sporting articles and apparatus, miniature replica football kits, sponge hands in the nature of novelties, darts and flights therefor, balloons, coin/counter operated games, ordinary playing cards, vehicle badges, buckles, busts, figurines, hooks, key rings and key fobs, keys, cups, memorial plates and plaques, ornaments, monuments, signs, money boxes, number plates, statues and statuettes, ferrules for walking sticks, works of art, all made wholly or principally of metal, bronzes, parts and fittings for all the aforesaid goods, common metal and their alloys and articles made there from common metals and their alloys, metal building materials, transportable buildings of metal, materials of metal for railway tracks, non-electric cables and wires of common metal, ironmongery, small items of metal hardware, pipes and tubes of metal, safes, goods of common metal, ores, precious metals and their alloys and goods in precious metals or coated therewith, jewellery, precious stones, horological and chronometric instruments, gems, watches, wristwatches, watch straps, clocks, stopwatches, pendulums, brooches, pins (jewellery), team and player trading pins (jewellery), tie clips and tie pins, cufflinks, commemorative medals, commemorative cups, commemorative plates, tankards, trophies, statues and sculptures, tea pots, ashtrays and cigarette cases, coins, medals and badges for clothing, medallions not of precious metal, alarm clocks, bracelets, buckles of precious metal, watch chains, jewellery chains, earrings, pin badges, key rings, textile and textile goods, flags, not made of paper, bath linen, bed covers, curtains of textile or plastic, sleeping bag sheet liners, bean bag covers, fabric for use in the manufacture of bags, fibre fabrics for use in the manufacture of bags, quilt bags, handkerchiefs, tea towels, textile wall hangings, bar towels, pennants, napkins and tablecloths, braids, tassels, brooches for clothing, decorative pins and badges not made of precious metal, hair bands, hair pins, pins of non precious metal, cords for clothing (straps), lace and embroidery, ribbons and braid, buttons, hooks and eyes, pins and needles, meat, fish, poultry and game, prepared meals and snacks, preserved, dried, frozen and cooked fruits and vegetables, jams, eggs, preserves, potato crisps, processed peanuts, pistachios, cashews, salted nuts, meat extracts, jellies, fruit sauces, milk and milk products, edible oils and fats, non medicated confectionery, chocolate based confectionery, frozen confectionery, chilled desserts, snack foods, prepared meals and snacks, sauces, condiments, coffee, tea, cocoa, preparations made from cereals, bread, pastry and confectionery, crisps made of cereals or potato flour, salad dressings, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, ices, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, spices, ice, non alcoholic beverages, beers, mineral and aerated waters, fruit drinks and fruit juices, isotonic drinks, syrups and other preparations for making beverages, alcoholic beverages, alcopops, wine, spirits, via electronic commerce and the bringing together for the benefit of others of football merchandise

by mail order or telecommunications (excluding the transport thereof) enabling customers to conveniently view and purchase these goods; rental of advertising space; arranging and administration of exhibitions; organising of draws and competitions for promotional and advertising purposes.

Class 38: Telecommunication services; telecommunication of information; multimedia telecommunications; telecommunications services relating to electronic commerce; Internet communication services; electronic mail services; receipt and/or delivery of messages, documents and other data by electronic transmission; receipt and/or delivery of messages, documents and other data via the Internet; provision of electronic communication links; providing access to computer servers, databases and networks; providing access to the Internet; provision of telecommunications connections and access to the Internet and/or databases; telecommunication access services; Internet portal services; providing access to the websites of others; broadcasting via television or over the Internet; pay-per-view television, video-on-demand; video-text and teletext transmission services; mobile telephony and mobile communication services including but not limited to such by way of global systems for mobile communications (GSM), universal mobile telecommunications systems (UMTS), general packet radio services (GPRS), wireless local area network (WLAN) devices and technologies, broadcasting or transmission of data visual images, sound, graphics and other information by mobile telephony and/or cable programme services, communications by cable or fibre optics; information and advisory services relating to the foregoing.

Class 41: Education; providing of training; entertainment; sporting and cultural activities; information relating to sporting events provided on-line from a computer database or the Internet; electronic games services provided by means of the Internet; training services and organisation of competitions and sporting events; arranging and conducting seminars, conferences, exhibitions and symposia relating to football and other sporting activities; officiating at sports contests; provision of sports facilities; entertainment services relating to sport; production of radio and television programmes, production of videotapes; provision of online electronic publications, publication of electronic books and journals; provision of publications on the Internet; provision of publications available by way of mobile telephony including but not limited to such by way of global systems for mobile communications (GSM), universal mobile telecommunication systems (UMTS), general packet radio services (GPRS), wireless local area network (WLAN) and technologies; archive library services.

Class 43: Services for providing food and drink; temporary accommodation; bar, restaurant and café services; sports bar services; catering services.