

O/0826/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

**IN THE MATTER OF APPLICATION NO. 4100565
IN THE NAME OF FOX SOCCER ACADEMY LTD
TO REGISTER THE FOLLOWING SERIES OF TRADE MARKS:**

**FOX SOCCER ACADEMY
Fox Soccer Academy**

**AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 451555
BY MICHAEL APPIAH-KUSI**

AND

**IN THE MATTER OF REGISTRATION NO. 3987955
IN THE NAME OF FOX SOCCER ACADEMY LTD
FOR THE TRADE MARK:**



**AND AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. 508600
BY MICHAEL APPIAH-KUSI**

BACKGROUND AND PLEADINGS

1. On 17 September 2024, Fox Soccer Academy LTD (“FSA”) applied to register **FOX SOCCER ACADEMY** and **Fox Soccer Academy** as a series of trade marks, under no. 4100565 (“FSA’s word mark”).¹ Details were published for opposition purposes on 27 September 2024. Registration is sought for *sports coaching; sports training services; football academy services; information, advisory and consultancy services relating to the aforesaid services* in class 41.

2. On 20 December 2024, Michael Appiah-Kusi opposed FSA’s word mark under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. For the purposes of his claims under sections 5(2)(b) and 5(3), Mr Appiah-Kusi relies upon the following trade marks:

(i) **FOXES CLUB**

UK registration no. 3039660

Filing date: 28 January 2014

Registration date: 18 April 2014

Class 41: Provision of sports coaching and sports education for children aged 16 years or younger.

(“the ‘660 mark”)

(ii) **FOXES**

UK registration no. 3056972

Filing date: 24 May 2014

Registration date: 14 November 2014

¹ Although the application is for a series of two trade marks, the only difference between them is their capitalisation. In this decision, I will refer to them in the singular, unless it becomes necessary to distinguish between them.

Class 41: Provision of sports coaching and sports education for children aged 16 years or younger, none relating to angling.

("the '972 mark")



(iii)

UK registration no. 4030357

Filing date: 24 March 2024

Registration date: 21 June 2024

Class 16: Printed matter; photographs; stationery; stickers; instructional and teaching materials; paper or plastic bags; plastic, paper and cardboard materials for packaging; printed publications; books; magazines; newsletters; periodicals; brochures; booklets; pamphlets; manuals; journals; leaflets; greeting cards; advertising and promotional material; catalogues; letter openers; pencil sharpeners; pencils, pens; clips; paper trays; letter trays; desk mats; mouse mats; pads; card indices; writing cases; writing sets; index cards; telephone and address books; agendas; diaries; calendars; posters; printed patterns for clothing; display materials; decals and bumper stickers; booklets for sale with audio and/or audiovisual recordings.

Class 25: Clothing; footwear; headgear; t-shirts; polo shirts; shirts; sweatshirts; rugby shirts; football shirts; sports shirts; sleeveless tops; vests; jerseys; leggings; trousers; tracksuits; joggers; shorts; hooded tops; fleeces; caps; baseball caps; beanies; woollen hats; visors; training shoes; sports shoes; running shoes; socks; boots; gilets; tabbards; tank tops; facemasks; jackets;

cagoules; waterproof clothing; insulated clothing; clothing for training; corporate uniforms; underwear; pyjamas; swimwear, none of the aforesaid for use in fishing and angling.

Class 35: Business assistance relating to franchising; business advice relating to franchising; franchising services providing business assistance; franchising services providing marketing assistance; business advertising services relating to franchising; business management assistance in the field of franchising; business promotion; advertising and promotion services; sales promotion for others; distribution of promotional material; administration of sales promotion incentive programs; administration of loyalty programs and schemes; arranging and conducting of promotional events; promotion of goods and services for others; distribution of advertising, marketing and promotional material; promotion of goods and services through sponsorship; providing a directory of third party web sites to facilitate business transactions.

Class 41: Education; providing of training; entertainment; sporting and cultural activities; organisation of sporting activities; organisation of sporting events; organisation of sporting competitions; organisation of events; leisure services; recreation services; tuition in recreational pursuits; ticket reservation and booking services for recreational and leisure events; fitness and exercise instruction; exercise and fitness classes; supervision of physical exercise; instruction in group exercise; provision of exercise facilities; booking of exercise facilities; club education services; club entertainment services; provision of club recreation facilities; club services [entertainment or education]; provision of club sporting facilities.

("the '357 mark")

4. In his statement of grounds, Mr Appiah-Kusi contends that FSA's word mark is similar to each of his marks and that the parties' goods and services are identical or similar. On this basis, he submits that there is a likelihood of confusion.

5. Under section 5(3), Mr Appiah-Kusi claims that each of his marks enjoys a reputation in the UK in respect of all their goods and services. He submits that use of FSA's word mark, without due cause, would take unfair advantage of, and be detrimental to, the repute and distinctive character of his marks. He also claims that the relevant public will mistakenly believe there is an economic connection between the users of the competing marks.

6. As for section 5(4)(a), Mr Appiah-Kusi claims that he has goodwill in relation to which he has used the signs **FOXES** and **FOXES FC** throughout the UK since 11 December 2009. The signs are said to have been used in connection with *sports classes; sports teaching; sports camps; the operation of football teams; football tuition; football events*. Mr Appiah-Kusi argues that use of FSA's word mark would constitute passing off.

7. FSA filed a counterstatement denying the grounds of opposition. In addition to submitting that the parties' marks are *"sufficiently distinguishable such that confusion in the market place is unlikely"*, FSA contends that *"the marks have happily co-existed for several years without any instances of confusion arising"*. It also denies that use of its word mark constitutes actionable passing off.

8. FSA is also the registered proprietor of the trade mark displayed below, under no. 3987955 ("FSA's figurative mark"). It was filed on 5 December 2023 and became registered on 8 March 2024 for *sports coaching* in class 41.



9. On 21 February 2025, Mr Appiah-Kusi made an application for a declaration of invalidity in respect of FSA's figurative mark. The application is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Act.

10. For the purposes of his claims under sections 5(2)(b) and 5(3), Mr Appiah-Kusi relies upon the following trade marks:

(i) The '660 mark, as outlined above.

(ii) The '972 mark, as outlined above.

(iii) **FOXES SPORTS**

UK registration no. 3056973

Filing date: 24 May 2014

Registration date: 10 October 2014

Class 41: Provision of sports coaching and sports education for children aged 16 years or younger.

("the '973 mark")

11. In his statement of grounds, Mr Appiah-Kusi claims that FSA's figurative mark is similar to each of his marks and that the parties' services are identical or similar, such that there is a likelihood of confusion.

12. Under section 5(3), Mr Appiah-Kusi claims that each of his marks enjoys a reputation in the UK in respect of all their services. He submits that use of FSA's figurative mark, without due cause, would take unfair advantage of, and be detrimental to, the repute and distinctive character of his marks. He also claims that the relevant public will mistakenly believe there is an economic connection between the users of the competing marks.

13. Turning to section 5(4)(a), Mr Appiah-Kusi claims that he has goodwill in relation to which he has used the signs **FOXES**, **FOXES FC** and the figurative sign displayed

below (“the figurative FOXES FC sign”) throughout the UK since 2009. The signs are said to have been used *“in relation to the provision of sports related services, including sports coaching and education services”*. Mr Appiah-Kusi argues that use of FSA’s figurative mark would constitute passing off.



14. FSA filed a counterstatement denying the grounds of invalidation. In addition to submitting that the parties’ marks *“are not confusingly similar”*, FSA contends that *“the marks have happily co-existed for several years without any instances of confusion arising”*. It also denies that use of its figurative mark would be a misrepresentation or that Mr Appiah-Kusi would be caused any damage.

15. The parties filed evidence in both proceedings, which were thereafter consolidated under rule 62(1)(g) of the Trade Marks Rules 2008. A hearing was requested and held before me, by video conference, on 6 July 2026. Mr Appiah-Kusi was represented by Jamie Watt of Harper Macleod LLP. FSA was represented by Emma Pallister of Mathys & Squire LLP.

RELEVANCE OF EU LAW

16. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

EVIDENCE AND SUBMISSIONS

17. Mr Appiah-Kusi's evidence in chief is given in two witness statements; one in his own name and one from his professional representative, Mr Watt. Mr Watt's statement is accompanied by 24 exhibits (JW1-JW24). Mr Watt provides the majority of Mr Appiah-Kusi's evidence of use. Mr Appiah-Kusi adds details of revenue and marketing spend.

18. FSA's evidence is given in the witness statement of Christian Fuchs, together with nine exhibits (CF1-CF9). Mr Fuchs is the founder and director of FSA. He provides use of FSA's marks and seeks to distinguish the parties' respective businesses. FSA filed written submissions alongside Mr Fuchs' evidence.

19. Mr Appiah-Kusi filed evidence in reply in the form of a second witness statement from Mr Watt and three further exhibits (JW25-JW27). Mr Watt responds to Mr Fuchs' evidence regarding apparent differences between the parties' respective businesses.

20. I have taken all the evidence and submissions into account in reaching my decision and will refer to them below where necessary.²

DECISION

21. An 'earlier trade mark' is defined in section 6 of the Act, the relevant part of which states:

6(1) In this Act an "earlier trade mark" means-

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

² For the avoidance of doubt, I have reviewed the evidence filed by each party in both proceedings prior to their consolidation. However, since the filings were the same, I have only listed one set of filings.

22. Section 6A of the Act reads as follows:

“6A(1) This section applies where-

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

- (a) within the relevant period the earlier trade mark has 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, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

- (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or

not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) 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.

[...]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects-

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration)."

23. The relevant parts of section 47 of the Act read as follows:

"47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless-

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if-

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which

the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes-

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) 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.

[...]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

[...]

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

24. Mr Appiah-Kusi’s marks qualify as earlier trade marks in accordance with the above provisions.

25. In respect of the opposition, the ‘660 and ‘972 marks had completed their registration processes more than five years before the filing date of FSA’s word mark. As such, they are subject to the use provisions set out above. The ‘357 mark had not

completed its registration process more than five years before that date and, therefore, the use provisions do not apply.

26. As for the invalidation, all three of Mr Appiah-Kusi's marks had completed their registration processes more than five years before the date on which the application was filed. Accordingly, they are subject to the use provisions set out above.

27. In its counterstatements, FSA indicated that it would require Mr Appiah-Kusi to provide proof of use of his marks where applicable. Accordingly, I must first consider whether, or the extent to which, there has been genuine use of the '660, '972 and '973 marks.

28. In accordance with the provisions set out above, the relevant period for this assessment in respect of the opposition is the five-year period ending with the filing date of FSA's word mark, i.e. 18 September 2019 to 17 September 2024. In respect of the invalidation, there are two relevant periods. These are (i) the five-year period ending with the filing date of the application for invalidation, i.e. 22 February 2020 to 21 February 2025, and (ii) the five-year period ending with the filing date of FSA's figurative mark, i.e. 6 December 2018 to 5 December 2023.

Proof of use

29. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009]

ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], 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], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised 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]; *Ferrari* at [32].

(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]; *Gözze* at [37], [40]; *Ferrari* at [32].

(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]; *Ferrari* at [33].

(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]."

30. Moreover, section 100 of the Act states 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.”

31. I am also guided by *Awareness Limited v Plymouth City Council*, BL O/236/13, in which Daniel Alexander QC, sitting 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.”

32. Furthermore, in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, BL O/404/13, Geoffrey Hobbs QC, sitting as the Appointed Person, stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

The evidence

33. Mr Watt says that Mr Appiah-Kusi is the beneficial owner and director of various companies, including Foxes Club Franchising Limited. Mr Appiah-Kusi is said to organise, provide and operate sports classes, sports teaching, sports camps, football tuition, football events and football teams through this company. A printout from Companies House confirms that the company was incorporated on 11 December 2009; Mr Appiah-Kusi is listed as its sole director.³ Mr Watt says that Mr Appiah-Kusi

³ Exhibit JW22

licenses his marks to this company, which engages in franchising; the franchisees are also licensed Mr Appiah-Kusi's marks. Amongst those licensed by Mr Appiah-Kusi's business is The Little Foxes Club Limited. A printout from Companies House shows that the company was incorporated on 12 March 2012.⁴ Mr Watt provides a printout from the foxesclub.com website.⁵ The website features a function for enquiring about becoming a franchisee. There is use of Foxes Club in plain font and in the style of the '357 mark. The printout is not dated. Also provided is a printout of The Foxes Club franchisor profile page on the BFA website (an organisation which showcases opportunities in UK franchising).⁶ There is use of Foxes Club in plain font and in the style of the '357 mark. The printout is not dated. However, it says that Foxes Club joined in 2019, has been in business for over 18 years, and offers weekly classes, holiday camps, a five-a-side league, a football academy, sports parties and school services for children. The Foxes Club was listed as a success story in *What Franchise* magazine on 31 March 2022, featured in a further *What Franchise* article on 2 April 2022, and featured in the BFA's magazine in December 2024.⁷

34. Mr Watt says that the business of Mr Appiah-Kusi and his licensees has generated substantial revenue and that substantial sums have been spent on marketing. He provides figures in respect of Foxes Club Franchising Limited and The Little Foxes Club Limited. In his own statement, Mr Appiah-Kusi gives more specific figures for these companies, namely:

Year	Revenue (£)	Marketing spend (£)
2021	2,186,486.78	34,687.06
2022	1,900,974.75	84,142.30
2023	2,263,800.27	214,538.70
2024	2,471,479.28	198,569.50
Total	8,822,741.08	531,937.56

⁴ Exhibit JW23

⁵ Exhibit JW23

⁶ Exhibit JW23

⁷ Exhibits JW8, JW15 and JW21

35. It is not clear what specific services generated this revenue. For instance, it is not clear whether the revenue included franchising fees or only revenue from the services relied upon. Mr Watt also provides financial summaries for the two aforementioned companies, obtained via company information provider Beauhurst,⁸ but these show no turnover for 2019, 2020, 2021, 2022 or 2023.

36. Mr Watt exhibits printouts of the foxesclub.com website.⁹ There is use of 'FOXES CLUB' in the style of the '357 mark. There is also information about sports classes, holiday camps and football teams for children. However, none of the printouts is dated and Mr Watt says that they are of the "*current website*", i.e. how it looked at the date of his statement (25 March 2025 and/or 10 July 2025). I do note that, under the academy teams' section, it says that "[s]ince 2009, Foxes FC has been leading the grassroots game. As well as being a Nike Partner Club and Junior Premier League club, we're 3 Star England Football Accredited". Mr Watt has also included a printout of the FOXES CLUB online store on kitlocker.com.¹⁰ There are links for Foxes FC and Foxes Club. However, the printout is not dated.

37. Further website evidence is provided, which was obtained through the internet archive, Wayback Machine.¹¹ This includes the following:

(i) A printout from thelittlefoxesclub.com, dated 5 July 2012, containing information about sports classes for children. The mark used is theLittleFoxesclub.com. There is also a reference to fixtures and results for foxes fc;

(ii) A printout from thelittlefoxesclub.com, dated 12 June 2015, containing information about sports classes for children. It says that its "*coaches work with 3,000 children across London every week*". The mark used is theLittleFoxesclub.com. There is also use of FOXES FC in a very similar form to the figurative FOXES FC sign;

⁸ Exhibit JW24

⁹ Exhibit JW1

¹⁰ Exhibit JW1

¹¹ Exhibit JW2

(iii) A printout from thelittlefoxesclub.com, dated 19 December 2018. There is information about sports classes for children. The mark used is The Little Foxes Club. There is also reference to competitive football teams under Foxes FC;

(iv) A printout from thelittlefoxesclub.com, dated 17 September 2021. There is information about sports classes for children, as well as reference to competitive football under Foxes FC. There is also an image of children in kit adorned with a FOXES FC badge. This is very similar to the figurative FOXES FC sign;

(v) Printouts from thelittlefoxesclub.com, dated 20 March 2023, 30 March 2023 and 26 May 2024. These show sports classes for children being offered under the mark The Little Foxes Club. There is also reference to the competitive football club Foxes FC.

38. Additional printouts from the Foxes Club website are provided, showing the offering of football camp, football academy and football tour services.¹² However, the printouts are not dated. Mr Watt says they were obtained on or around 16 July 2025.

39. In addition to the website evidence, Mr Watt provides the following evidence from social media:¹³

(i) Printouts from the Foxes Club Facebook page. It has 823 followers and was created on 1 April 2011. The printouts are not dated;

(ii) Printouts from The Foxes Club Instagram page. It has 274 followers. The printouts are not dated, though I note that there were posts on 18 June 2024 and 28 June 2024 which include a reference to The Foxes Club. The former also shows use of FOXES CLUB in the style of the '357 mark. There is also a post about FOXES FIVES (a five-a-side football league); this is possibly from July 2024, though the date has been cut off;

¹² Exhibits JW25-JW27

¹³ Exhibits JW3, JW7, JW11 and JW22

(iii) Printouts from The Little Foxes Club Instagram page. It has 1,138 followers. The printouts are not dated. The account informs users that The Little Foxes Club has “*relaunched with a fresh new look*”, signposting users to its new page: the account discussed at point (ii) above. I note that there are posts about the launch of the Instagram page (25 June 2018), FOXES FC presentation day (24 June 2019) and TEAM FOXES branded kit (16 August 2023);

(iv) Printouts from The Foxes Club LinkedIn page. It has 3,000 followers. The printouts are not dated, though I note a post which states that the Foxes FC academy had become an accredited partner of Nike for the forthcoming 2024/25 season. A post about this on the Foxes FC Academy Instagram page is dated 18 November 2024;

(v) A printout from Mr Appiah-Kusi’s LinkedIn page. This shows use of FOXES CLUB in plain font and in the style of the ‘357 mark. The printout is not dated, but the profile states that the business was founded in 2007.

40. Mr Watt also provides evidence regarding the branding of Mr Appiah-Kusi’s business.¹⁴ It comprises articles in *Creative Boom*, dated 26 September 2024, and *Design Week*, dated 7 October 2024. They discuss how a Bath-based studio created a “*new brand for The Foxes Club*”, “*formerly known as The Little Foxes Club*”. The business is described as “*one of the UK’s biggest play-programme providers*”, “*one of London’s leading providers of sports classes, camps and academies for kids*” and “*a market leader in delivering community-based children’s play programmes, holiday camps and football academies*”. The rebrand appears to have been a move towards the style of the ‘357 mark, to unite the children’s play activities side of the business (The Little Foxes Club) with the football academy (Foxes FC). Also included are printouts from the studio’s website (thisaway.co) about the rebrand.¹⁵ The printouts are not dated but contain much the same information as the articles regarding the rebrand. It also says that The Little Foxes Club began in 2007, whilst Foxes FC started in 2009. Mr Watt has also provided a LinkedIn post from the franchise director of The

¹⁴ Exhibits JW4 and JW5

¹⁵ Exhibit JW6

Foxes Club, who also appears to be a coach at Chelsea FC.¹⁶ It seems that this individual discussed the rebrand in the December 2024 edition of *What Franchise*. In addition, the rebrand featured in an article on the website of the World Brand Design Society on 17 September 2024.¹⁷

41. In addition, Mr Watt provides printouts from the website and Facebook page of Middlesex FA,¹⁸ in which they congratulated Foxes FC for renewing its England Football Accreditation and moving up to being a Three-Star Accredited Club. The announcement on the website and the post on Facebook both appear to have been on 18 December 2024. Also included in the evidence is a post on LinkedIn by The Foxes Club and printouts from the foxesclub.com website; these explain that only 4% of grassroots clubs in England achieve three-star accreditation.¹⁹ Foxes FC is also listed on The Coaches Link website (along with a figurative mark very similar to the figurative FOXES FC sign), but the printout is not dated.²⁰

42. I note that Little Foxes (Chiswick, Kensington and Knightsbridge) was promoted in an article in *SW Londoner*, dated 11 February 2024 and entitled “*Activities and sports for children and young people this half-term*”.²¹ The Little Foxes Club has also been listed on checkaclub.co.uk since 27 June 2023.²² Moreover, information about The Foxes Club is shown in a printout from the website of the Royal Borough of Kensington and Chelsea.²³ In addition to plain font, the words FOXES CLUB are presented in the style of the ‘357 mark. The information was last updated on 10 February 2025, but the copyright notice is given as 2023. Furthermore, Foxes Club and Foxes FC were both listed on richmondtwickenhamfamilyhub.com on 13 September 2024; the page has had 2,119 views.²⁴ Little Foxes football club classes which took place weekly from 28 July 2023 to 1 September 2023 were promoted on the Brent Cross Town website.²⁵

¹⁶ Exhibit JW10

¹⁷ Exhibit JW20

¹⁸ Exhibit JW9

¹⁹ Exhibit JW12

²⁰ Exhibit JW13

²¹ Exhibit JW14

²² Exhibit JW16

²³ Exhibit JW17

²⁴ Exhibit JW18

²⁵ Exhibit JW19

Assessment

The opposition

43. Mr Appiah-Kusi is required to demonstrate genuine use of FOXES CLUB (the ‘660 mark) and FOXES (the ‘972 mark) between 18 September 2019 and 17 September 2024. I recognise that an assessment of genuine use is a global assessment which involves looking at the evidential picture as a whole.²⁶ The evidence suggests that Mr Appiah-Kusi has been providing sports-related services to children through his business for a number of years. His business has also been listed as a franchisor on the BFA website since around the beginning of the relevant period and is described as, *inter alia*, a market leader. Nevertheless, the assessment is forensic and stringent.²⁷ Genuine use cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the mark on the market concerned.²⁸

44. Firstly, turnover figures have been provided which show that two companies connected with Mr Appiah-Kusi’s business generated a maximum of around £8.8 million during the relevant period.²⁹ On the face of it, this is not an insignificant sum. However, the information surrounding the turnover figures is vague. In particular, they are global in nature. As Phillip Johnson, sitting as the Appointed Person, explained in *W Sternoff LLC v Peter Kertels*, BL O/0984/25:

“26. Where global sales figures are provided for multiple goods sold under one trade mark this is not going to be evidence of use for any of those goods. The sales could all be in relation to good A or all in relation to good B or a split between the two. This is why particularisation is so important as without it the figures provide no evidence of use for either good A or good B. The same applies where the same good is sold under trade mark A and trade mark B.

²⁶ *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, Case T-415/09

²⁷ *W Sternoff LLC v Peter Kertels*, BL O/0984/25, paragraph 15

²⁸ *easyGroup*, paragraph 107

²⁹ I say maximum because the figures include a sum for the whole of 2024, and I note that the relevant period ends in September of that year. This means that some of the turnover may have been after the end of the relevant period.

27. Evidence of sales is only useful for establishing genuine use where it sets out the sales revenue for a particular and identified good (or service) and it is clear that that good or service is sold under the trade mark. Only where there is only one good being sold and it is sold under only one trade mark can global figures be sufficient.”

45. From the figures provided, it is not possible to discern the proportions of the turnover which can be attributed to each of the marks relied upon. In addition, although the services relied upon are focused, there is no way of knowing whether all of the figures given were solely generated through the provision of those services, or whether some were generated through Mr Appiah-Kusi’s franchising operation; this has not been adequately explained, and the financial summaries do not cast any light on this. There is also no evidence of the size of the relevant market which would assist with contextualising the turnover.

46. Moreover, a maximum of around £532,000 is said to have been spent on marketing during the relevant period.³⁰ Again, this is not an insignificant sum. However, there is no indication of how that overall sum has been spent. Neither is there any direct evidence of any marketing or advertising having been conducted during the relevant period.

47. I note that there is no direct evidence of any actual sales under the marks during the relevant period. For instance, Mr Appiah-Kusi has provided no sales invoices, order confirmations, agreements or membership subscriptions regarding the services offered under his marks. This is evidence that would have been easy for Mr Appiah-Kusi to provide if it existed.

48. Actual use of the marks relied upon is also very limited. Much of the website evidence is either undated or from outside the relevant period. Four printouts are provided of thelittlefoxesclub.com website from during the relevant period. However, there is no information about how many visits the website had from UK internet users

³⁰ As above, the figures include a sum for the whole of 2024. Some of the marketing spend may have been after the end of the relevant period.

at any time during the relevant period. Therefore, whilst I acknowledge that sports-related services appear to have been offered through the website, it is not possible to ascertain the extent to which UK consumers were exposed to the marks in this way.

49. Much of the evidence from social media is also undated. Of the dated evidence, I note that there were posts referencing The Foxes Club and FOXES CLUB in June 2024 on The Foxes Club Instagram page. However, no information has been provided as to how many of the 274 followers (which is, itself, a very low number) followed the page during the relevant period. The level of engagement on the posts was also very low. There is also a post on The Little Foxes Club Instagram page from August 2023 showing TEAM FOXES branded kit. However, again, there is no information as to how many of the 1,138 followers (which is, itself, a low number) followed the page during the relevant period. The level of engagement on the post was also extremely low (zero likes and four comments).

50. The evidence shows that FOXES FC became an accredited partner of Nike and a three-star accredited club with the Football Association. The evidence which details the Nike accreditation is undated. It was in advance of the 2024/25 football season, but there is no evidence of when exactly the partnership commenced and whether this was before the expiry of the relevant period. The accreditation with the FA appears to be a significant achievement. However, the evidence detailing this is either undated or from December 2024, i.e. after the end of the relevant period.

51. The rebranding of Mr Appiah-Kusi's business from The Little Foxes Club to The Foxes Club seems to have gained some traction, appearing in several articles. However, only one of the articles was published during the relevant period: the World Brand Design Society website, on the very last day of the relevant period. There is no information about how widely this website is known amongst average consumers in the UK or how many visits this website/article received during the relevant period.

52. Mr Appiah-Kusi's business was also promoted through several third-party websites. However, this evidence is limited in a number of ways. Firstly, they largely appear to target consumers in London. This is not fatal to Mr Appiah-Kusi's case (London being an extremely populous part of the UK), but it does suggest that use has

not been particularly widespread, geographically. More pertinently, no information about readership or website visits during the relevant period has been provided in respect of *SW Londoner*, Check a Club, Kensington and Chelsea, or Brent Cross Town. I note that The Foxes Club was listed on Richmond Twickenham Family Hub during the relevant period, and that a page views figure is visible in the evidence. However, it has had a small number of page views (around 2,000) and, in addition, this is likely to reflect the position at the date on which it was obtained. As this information is not given, I infer that the figure is correct as of the date of Mr Watt's statement (either 25 March 2025 or 10 July 2025). On this basis, combined with the listing being dated only four days before the end of the relevant period, most of the views are likely to have been from after the relevant period. Finally, I note that the FOXES CLUB business appeared in *What Franchise* and the BFA's magazine during the relevant period. These appear to be national publications. However, no circulation figures have been provided. I have no way of knowing how widely known or read these publications are.

53. Taking the evidence as a whole, I am not satisfied that Mr Appiah-Kusi has demonstrated use in a sufficiently solid manner for me to conclude that the marks were used to create or maintain a market for the services relied upon during the relevant period. In my view, although the evidence certainly establishes that services have been offered, it falls short of demonstrating genuine use.

The invalidation

54. Mr Appiah-Kusi is required to demonstrate genuine use of FOXES CLUB (the '660 mark), FOXES (the '972 mark) and FOXES SPORTS (the '973 mark) between (i) 6 December 2018 and 5 December 2023 and (ii) 22 February 2020 and 21 February 2025.

55. Firstly, at the hearing Mr Watt did not refer me to any instances of the FOXES SPORTS mark appearing in the evidence. I have been unable to identify any evidence of services being provided under that mark. It has not been established that this mark has been put to genuine use in either of the required relevant periods.

56. As for the FOXES and FOXES CLUB marks, I have already assessed the evidence and found that it was insufficient for the purposes of establishing genuine use between 18 September 2019 and 17 September 2024. In terms of the first relevant period under consideration here, the position is even weaker. The only evidence which clearly falls within this relevant period comprises turnover and marketing spend figures for 2021 to 2023; printouts from thelittlefoxesclub.com dated 19 December 2018, 17 September 2021, 20 March 2023 and 30 March 2023; posts on The Little Foxes Instagram page dated 24 June 2019 and 16 August 2023; printouts from the Brent Cross Town and Check a Club websites; and the articles in *What Franchise* dated 31 March 2022 and 2 April 2022. The printouts from the Kensington and Chelsea website may also have been from within the relevant period since it has a 2023 copyright notice, though there is no way of knowing whether the listing existed during the relevant period. The turnover and marketing spend figures are lower than those for the period already considered and the issues already discussed regarding the vague and unparticularised nature of those figures remain. Again, there is no evidence of any marketing or advertising activities having been conducted during this relevant period and no direct evidence of any actual sales. No information has been provided regarding the number of visits any of the websites received from UK internet users. The Little Foxes Club Instagram account had a small number of followers, and I am unable to determine how many of those followed the account during the relevant period. The level of engagement on the posts was also very low (19 likes and three comments, zero likes and four comments, and 12 likes and one comment, respectively). Nor has any evidence been provided regarding the circulation of *What Franchise*. I again acknowledge that there has been some use of the marks. However, taking the evidence as a whole, I do not consider it to be sufficiently solid or specific to conclude that they have been used to create or maintain a market for the services relied upon. Therefore, I find that genuine use has not been established for the period between 6 December 2018 and 5 December 2023.

57. Since section 47 of the Act requires genuine use within both five-year periods, and I have found that Mr Appiah-Kusi has not demonstrated this within the earlier five-year period, he has failed to satisfy the use requirements. However, for the sake of completeness, I record here that I do not consider the evidence to be sufficient in respect of the five-year period between 22 February 2020 and 21 February 2025

either. Although more of the evidence falls within this period, the fundamental difficulty is that the evidence remains insufficiently specific and solid to demonstrate the extent of use. Whilst all the turnover and marketing figures are relevant here, the aforementioned concerns regarding their vague and unparticularised nature are equally applicable. There is no evidence of any marketing or advertising activities being conducted in this relevant period and no direct evidence of any sales either. I acknowledge that more of the website evidence can be relied upon for this relevant period; however, it remains the case that there is no evidence regarding the number of visits any of the websites received from UK internet users. The social media evidence is also limited for this relevant period, notwithstanding there being more of it. The Instagram pages of The Foxes Club and The Little Foxes Club both had a small number of followers, and there is no indication as to how many of those followed the pages during the relevant period. The posts dated within the relevant period also had a small level of engagement. The evidence about the rebrand all falls within this relevant period. However, no circulation figures have been provided for any of the publications which discuss the matter. Similarly, there are no visitor figures for the websites. In addition, the extent to which such publications and websites would have been known to the average consumer (rather than, say, design professionals) is not clear. The evidence pertaining to the partnership with Nike and becoming a three-star accredited club with the FA is applicable in full to this relevant period and, as I have said previously, the latter (in particular) appears to be a significant achievement. However, in my view, this is not sufficient alone to counter all of the issues with the evidence as a whole and, as significant as they may be, they still do not specifically or solidly demonstrate that the marks have been used to create or maintain a market for the relied upon services during the relevant period.

Conclusion

58. Mr Appiah-Kusi has failed to demonstrate genuine use of the '660 and '972 marks for the purposes of the opposition. As such, his claims under sections 5(2)(b) and 5(3) against FSA's word mark may only proceed based on his reliance upon the '357 mark, which was not subject to the use requirements.

59. Mr Appiah-Kusi has failed to demonstrate genuine use of the ‘660, ‘972 and ‘973 marks for the purposes of his application for invalidation. Therefore, and as he has no other earlier marks to rely upon, his claims under sections 5(2)(b) and 5(3) against FSA’s figurative mark must fail.

Opposition based upon section 5(2)(b)

Legislation and case law

60. Sections 5(2)(b) and 5A of the Act state 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.”

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

61. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor* [2025] UKSC 25:

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater 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; and

(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.

Comparison of goods and services

62. In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated, at paragraph 23, that:

“In assessing the similarity of the goods or services concerned, [...] all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

63. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the relevant factors identified by Jacob J (as he then was) for assessing similarity also included the users of the goods and services and the trade channels through which they reach the market.

64. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“GC”) stated that ‘complementary’ means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers

may think that the responsibility for those goods lies with the same undertaking.”

65. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for them lies with the same (or an economically connected) undertaking.

66. In *Gérard Meric v OHIM*, Case T-133/05, the GC stated that:

“29. [...] goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

67. To my mind, FSA’s *sports coaching; sports training services; football academy services* are encompassed by Mr Appiah-Kusi’s *education, providing of training and sporting [...] activities* in class 41 of the ‘357 mark. These services are to be regarded as identical in accordance with the principle in *Meric*.

68. FSA’s *information, advisory and consultancy services relating to the aforesaid services* do not have the same nature, method of use or intended purpose as Mr Appiah-Kusi’s *education, providing of training and sporting [...] activities*. This is because FSA’s services involve the provision of information and advice relating to the sports services, rather than the sports services themselves. Neither are the respective services in competition. Nevertheless, they are likely to share users. Moreover, they are likely to reach the market through shared trade channels and be provided by the same undertakings. The respective services are also complementary; the sports services are indispensable to the provision of information and advice about those

services, and consumers are likely to believe that responsibility for both lies with the same undertaking. Taking all of this into account, I find that there is a medium degree of similarity between the respective services.

Average consumer

69. As the authorities indicate, I must determine who the average consumer is for the parties' services and how they are likely to be selected. The average consumer is deemed to be reasonably well informed, observant and circumspect.³¹ In *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, Arnold LJ explained that:³²

- (i) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
- (ii) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;
- (iii) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;
- (iv) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

³¹ *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited* [2014] EWHC 439 (Ch)

³² Approved by the Supreme Court in *Iconix* (cited above).

(v) The average consumer's level of attention varies according to the category of goods or services in question; and

(vi) The average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

70. The average consumer of the services at issue is likely to be a member of the general public. The services are likely to be purchased relatively frequently for ongoing sports coaching. The cost may vary but, overall, the services are likely to be relatively inexpensive. When selecting the services, the average consumer is likely to consider factors such as the range of services offered, the reputé of the coaches, previous outcomes and the location of the provider. I agree with Ms Pallister to the extent that, for some consumers, selection of the services would be a very considered purchase. It would be an important choice for some consumers, given that it may have an impact on their own training and careers. However, that does not, in my view, apply across the board. The parties' services are quite broad and also cover more casual sports coaching services. Overall, whilst the level of attention is likely to vary, it is my view that the average consumer will demonstrate between a medium and high level of attention during the purchasing process.³³ The services are likely to be purchased directly from the provider, after viewing information in brochures or on websites. As such, the purchasing process is likely to be predominantly visual in nature. However, I do not discount aural considerations, particularly considering the role that word-of-mouth recommendations may play.

³³ I acknowledge the decision referred to by Ms Pallister in support of her argument that the average consumer would exhibit a high level of attention (BL O/0133/26), but I am not bound by it.

Distinctive character of the earlier mark

71. In *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*, Case C-342/97, the CJEU stated that:

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

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

72. Registered trade marks possess varying degrees of inherent distinctive character. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

73. The ‘357 mark is figurative and consists of the word FOXES in a basic, white typeface atop a black and white device which is reminiscent of a fox’s head. The word FOXES is an ordinary word which will be readily understood as referring to the name of the animal (plural). Whilst the device also provides a contribution, it is my view that

the distinctive character of the mark predominantly lies in the word. Not only are word elements usually more distinctive than figurative ones,³⁴ but here the device merely acts as a surround or background to the word and reinforces its meaning. Overall, I find that the ‘357 mark possesses a medium level of inherent distinctive character.

74. The distinctiveness of a mark can be enhanced by virtue of the use made of it. However, having carefully considered the evidence in its entirety, I am not satisfied that the distinctive character of the ‘357 mark had been enhanced through use at the relevant date of 17 September 2024.

75. Firstly, I cannot find any instances of the mark as registered in the evidence. There are some uses of FOXES CLUB, FOXES FC and FC (solus) in the style of the ‘357 mark, i.e. presented on the same fox head background device, but I am not convinced that use of such signs is capable of enhancing the distinctive character of the word FOXES solus on the fox head background device. Even if it was, the evidence containing such use is limited in a number of ways. Much of it is either undated or is from after the relevant date. This includes the printouts from the Foxes Club, Kit Locker and BFA websites,³⁵ the printouts from Facebook, Twitter and Instagram,³⁶ the evidence about the rebrand,³⁷ the article in the BFA’s magazine,³⁸ the evidence regarding Foxes FC’s three-star accreditation,³⁹ and Mr Appiah-Kusi’s LinkedIn profile.⁴⁰

76. That leaves a post on Instagram dated 18 June 2024,⁴¹ social media posts about the partnership with Nike (which, at best, could be from before the relevant date by virtue of referring to the 2024/25 season),⁴² a printout from the Kensington and Chelsea website (which, at best, could be from before the relevant date due to the 2023 copyright notice),⁴³ a printout from the Richmond Twickenham Family Hub

³⁴ *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, paragraph 15

³⁵ Exhibits JW1, JW23, and JW25-JW27

³⁶ Exhibits JW3 and JW11

³⁷ Exhibits JW4-JW6

³⁸ Exhibit JW8

³⁹ Exhibits JW9 and JW12

⁴⁰ Exhibit JW22

⁴¹ Exhibit JW3

⁴² Exhibits JW7 and JW11

⁴³ Exhibit JW17

website,⁴⁴ and an article on the World Brand Design Society website dated 17 September 2024.⁴⁵ This evidence is far too thin to support a finding that the distinctive character of the ‘357 mark had been enhanced at the relevant date. It also has its own issues. For instance, the social media evidence has a very low level of engagement. Moreover, there is no information about how many UK visitors most of the websites had before the relevant date. The exception to this is the Richmond Twickenham Family Hub website. This had around 2,000 page views. This is a small number, and I infer that this was correct as of the date of Mr Watt’s statement, meaning that the number of views before the relevant date is likely to have been smaller still. This is particularly the case, given that the listing is dated 13 September 2024, i.e. four days before the relevant date. As for the article on the World Brand Design Society website, in addition to there being no visitor statistics, there is no information indicating how widely this website is known amongst average consumers in the UK.

77. Furthermore, as previously explained, it is not possible to determine the proportions of the turnover figures which can be attributed to each mark Mr Appiah-Kusi relies upon in these proceedings, including the ‘357 mark. A similar issue is faced by the marketing spend figures, and there is also no direct evidence of any marketing or advertising activities having been conducted prior to the relevant date. Finally, there is no direct evidence of any sales under the ‘357 mark prior to the relevant date.

Comparison of trade marks

78. It is clear from *Sabel BV v Puma AG*, Case C-251/95, that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. This case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. In *Bimbo SA v OHIM*, Case C-591/12P, the CJEU stated, at paragraph 24, that:

⁴⁴ Exhibit JW18

⁴⁵ Exhibit JW20

“[...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

79. Therefore, it would be wrong to artificially dissect the marks. However, it is necessary to take into account the distinctive and dominant components of the marks, and to give due weight to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

80. The marks to be compared are as follows:

The ‘357 mark	FSA’s word mark
	FOX SOCCER ACADEMY Fox Soccer Academy

81. The ‘357 mark is figurative and comprises the word FOXES, in a basic, white typeface, atop a black and white fox head device. The overall impression of the mark is dominated by the word FOXES. This is because it is the most distinctive element, and the eye is naturally drawn to elements of marks which can be read.⁴⁶ The fox head device acts as a surround or background for the word and reinforces its meaning. As such, whilst it also provides a contribution, it plays a lesser role in the overall impression.

82. FSA’s word mark is a series of two word-only marks: FOX SOCCER ACADEMY and Fox Soccer Academy. The single registered mark consists of the words

⁴⁶ *Wassen International Ltd v OHIM*, Case T-312/03

themselves, not the particular use of capitalisation shown in each manifestation.⁴⁷ The overall impression of the mark is dominated by the word FOX. It appears at the beginning of the mark, a position which tends to have more impact.⁴⁸ Moreover, it is the most distinctive word. The words SOCCER ACADEMY also provide a contribution but play a much lesser role. This is because they are descriptive or strongly allusive of the services at issue.

83. Visually, the competing marks are similar insofar as their respective dominant elements, i.e. FOXES and FOX, are highly similar. The typeface used in the '357 mark does not create any material difference between the competing marks; not only is it a basic typeface which is, ultimately, unremarkable, but notional and fair use of FSA's word mark would cover use of the words in the same font. The competing marks are visually different in that FSA's word mark contains additional words which have no counterpart in the '357 mark, namely SOCCER ACADEMY. This makes FSA's mark significantly longer than the verbal elements of the '357 mark. The '357 mark also has the fox head device which is not replicated in FSA's word mark. However, I bear in mind that these differing elements play lesser roles in the respective overall impressions. In light of all this, I find that there is a medium degree of visual similarity between the competing marks.

84. The average consumer will make no attempt to articulate the fox head device. The words in the competing marks will be given their ordinary English pronunciation. At the hearing, Mr Watt argued that the average consumer is unlikely to pronounce FSA's word mark in its entirety, abbreviating it to FOXES. Whilst I disagree that the average consumer would abbreviate FSA's mark to FOXES, it is possible that they would refer to it in shortened form as FOX, since the words SOCCER ACADEMY are descriptive or strongly allusive.⁴⁹ However, for reasons that will become apparent, I will proceed on the basis that all the words in FSA's word mark will be pronounced. The competing marks are aurally similar in that their respective first syllables, i.e. FOX, are identical. The competing marks aurally differ in all other respects, and FSA's word mark is

⁴⁷ See *Thomas Pink Limited v Victoria's Secret UK Limited* [2014] EWHC 2631 (Ch), paragraph 104

⁴⁸ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

⁴⁹ See the comments of Phillip Johnson, sitting as the Appointed Person, in *Enrich International Ltd v Onyinye Udokporo*, BL O/1141/25, paragraphs 13-18.

significantly longer than the '357 mark. However, bearing in mind my assessment of the respective overall impressions, I find that there is between a medium and high degree of aural similarity between the competing marks.

85. The word FOX in FSA's word mark will be readily understood by the average consumer as referring to the animal. The words SOCCER ACADEMY will be perceived in combination as a reference to part of a football club or team which is concerned with training young players. The word FOXES in the '357 mark will be readily understood as a reference to the animal (plural). As a stylised representation of a fox's head, the device introduces no new concept but reinforces the meaning conveyed by the word. In his skeleton argument, Mr Watt argued that the competing marks are conceptually identical because they both *"convey to consumers that by purchasing the sports coaching services they will be able to acquire the attributes of cunning, speed, and stealth associated with foxes. The marks convey to prospective consumers that by purchasing the services [...] they will gain the "cunning of a fox" or become "as wily as a fox"."* I disagree. To arrive at such a conclusion would, to my mind, involve a level of analysis which is not typically undertaken by the average consumer when encountering trade marks. The competing marks are conceptually similar in that they both refer to the same animal (albeit one in singular and the other in plural). In her skeleton argument, Ms Pallister submitted that FOX is a well-known surname in the UK. Whilst I am aware of its use as a surname and consider it possible that the word could be seen as such (though I note that no evidence of how common a surname it is has been provided), I do not consider this to represent a point of significant conceptual difference between the competing marks. This is because, even if it were perceived as a surname by some average consumers, the meaning conveyed by the word remains the name of the animal. In any event, it is my view that at least a significant proportion of average consumers would not see the word as a surname and would, instead, simply see it as the name of the animal. The competing marks differ in that FSA's word mark conveys an additional concept which is not replicated by the '357 mark, that of a football academy. However, these words play a much lesser role in the overall impression of FSA's mark, being descriptive or allusive of the services at issue. Overall, I find that there is between a medium and high degree of conceptual similarity between the competing marks. This finding applies irrespective of whether FOX in FSA's mark is perceived as a surname.

Likelihood of confusion

86. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the competing marks may be offset by a greater degree of similarity between the respective services, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the '357 mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be mindful that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

87. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related.

88. Earlier in this decision, I concluded as follows:

- The parties' class 41 services are identical or similar to a medium degree;
- The average consumer is a member of the general public, who will demonstrate between a medium and high level of attention during the purchasing process;
- The purchasing process is predominantly visual in nature, though aural considerations have not been excluded;
- The '357 mark possesses a medium level of inherent distinctive character, which has not been enhanced through use;

- The overall impression of the ‘357 mark is dominated by the word FOXES, while the fox head device plays a lesser role;
- The overall impression of FSA’s word mark is dominated by the word FOX, whereas the words SOCCER ACADEMY play a much lesser role;
- The competing marks are visually similar to a medium degree, and aurally and conceptually similar to between a medium and high degree.

89. Before proceeding with the global assessment, I note that Mr Fuchs says that the *“inspiration for the name for Fox Soccer Academy is taken from [his] family name”* and that *“Fuchs’ is the German word for ‘fox’”*. In support, he has provided a German-English dictionary extract, which shows that ‘fuchs’ is, indeed, German for ‘fox’.⁵⁰ Whilst this is noted, I must clarify that this will have no impact on whether there is a likelihood of confusion. This is because the average consumer is unlikely to be aware of Mr Fuchs’ intentions when creating the mark. Moreover, given that FOX is itself an ordinary dictionary word with a widely known meaning, the average consumer would have no reason to further analyse it, having immediately recognised it as the name of the animal.

90. I also note that Mr Fuchs claims that FSA *“targets a very different market sector”* than Mr Appiah-Kusi, namely *“professional football training and coaching”*. He says that *“members of [FSA’s] football academy would not be members of [Mr Appiah-Kusi’s] Foxes Club and/or The Little Foxes Club and vice versa”*. On this basis, Mr Fuchs intimates that there is no likelihood of confusion. Whilst these comments are noted, I must clarify that any apparent differences between the actual services provided by the parties are not relevant to the assessment which follows. This is because it is necessary to consider all the circumstances in which FSA’s word mark might be used if it were registered.⁵¹ Even though Mr Fuchs has suggested the ways in which the mark will be used, and has provided some evidence of use, my assessment must take into account the services in the specification of FSA’s word

⁵⁰ Exhibit CF1

⁵¹ *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06

mark and whether there is any potential conflict with the services in the specification of the '357 mark. In addition, the '357 mark had not been registered for five years at the filing date of FSA's word mark, meaning that the former is entitled to protection against a likelihood of confusion with the latter based upon its notional use for all the services listed in the register. As Laddie J explained in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41:

"22. [...] It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place".

91. Turning to the global assessment, I acknowledge that the competing marks share highly similar words, namely FOX and FOXES, and that these words dominate the respective overall impressions. Further, I accept that, where not identical, the services are moderately similar. It is also the case that the '357 mark is moderately distinctive and the competing marks are at least moderately similar overall. Nevertheless, taking all the above factors into account, it is my view that the differences between the competing marks are likely to be sufficient for the average consumer, paying at least a medium level of attention, to distinguish between them and avoid mistaking one for the other. Whilst the difference between the singular and plural forms of the word FOX and the presence of the descriptive or strongly allusive words SOCCER ACADEMY may not be accurately recalled, to my mind, the difference created by the device element in the '357 mark will be. Although it plays a lesser role in the overall impression, it is unlikely to be overlooked or misremembered. Accordingly, even taking

into account the principles of imperfect recollection and interdependency, I find that there is no likelihood of direct confusion, even in relation to identical services.

92. That leaves indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Iain Purvis QC, sitting as the Appointed Person, explained 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.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

93. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach.⁵² However, indirect confusion has its limits; such a finding should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark.⁵³ It has also been emphasised that there must be a proper basis for finding indirect confusion.⁵⁴

94. Imperfect recollection is not only applicable to direct confusion; it is also relevant when considering indirect confusion.⁵⁵ In this connection, it is my view that, whilst the average consumer will discern some difference between the competing marks, it is highly likely that the dominant words FOX and FOXES will be misremembered or inaccurately recalled as one another. Although the word FOXES is not strikingly distinctive, I am of the view that it is sufficiently distinctive for confusion to occur. Having perceived FOXES and FOX as the same word, the average consumer is likely to perceive the differences between the competing marks as indicating a sub-brand or brand extension. For instance, FSA’s word mark is likely to be perceived as the FOX/FOXES variant in plain wording which includes an informative reference as to the services offered under the mark (SOCCER ACADEMY), whereas the ‘357 mark is likely to be seen as the FOX/FOXES variant with additional decorative matter (the fox head device). Even if the words FOX and FOXES are not mistaken for one another, it is my view that the differences between the competing marks are still likely to be perceived as indicating a sub-brand or brand extension, whereby FSA’s word mark will be seen as the full name of the brand and the ‘357 mark as a shortened ‘nickname’ for the team with additional decorative matter. Taking all of this into account, I am satisfied that the average consumer, even paying a higher level of attention, is likely

⁵² As was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, paragraph 12.

⁵³ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

⁵⁴ *Liverpool Gin Distillery*, paragraph 13.

⁵⁵ As was confirmed by Simon Clark, sitting as the Appointed Person, in *Rituals International Trademarks B.V. v Natsal, Inc.*, BL O/0116/26.

to assume a commercial association between the parties on the basis of the competing marks. Consequently, I find that there is a likelihood of indirect confusion.

95. I note that Mr Fuchs says that, since FSA's first use of its word mark, there have been no known instances of confusion with Mr Appiah-Kusi's business and "*over ten years of peaceful coexistence*" despite both parties operating in the UK. His evidence is that FSA is a specialised professional soccer development academy which has been trading in the UK under its word mark since 2016. He says that FSA provides coaching and training services in London, Leicester and Manchester, and offers scholarships for players aged 16-19 with academies in the former two locations. He also says that FSA has worked with Derby University since 2019, forming a partnership whereby students of FSA can obtain qualifications from the university. In support, Mr Fuchs provides the following:

(i) Printouts of the foxsoccer.academy website, obtained via the Wayback Machine and dated 8 September 2018, 3 December 2020, 12 June 2021, 21 May 2023 and 22 November 2024.⁵⁶ These show use of the word mark in connection with FSA's football academy and coaching services. Although there are references to the UK and what appears to be an option to access a UK-specific website, the website appears to be a global one.

(ii) Printouts from the Fox Soccer Academy UK Facebook account, showing consistent posts between 5 November 2016 and 24 July 2024.⁵⁷ The level of engagement is low, but the posts do contain details of football academy services, schedules, events, summer camps and matches in London, Leicester and Manchester.

(iii) Printouts from the Fox Soccer Academy X (formerly Twitter) account,⁵⁸ showing posts dated 2 April 2019, 9 November 2019, 27 July 2020, 4 May 2022 and 31 May 2023. Again, the level of engagement is low, but the posts provide

⁵⁶ Exhibit CF2

⁵⁷ Exhibit CF3

⁵⁸ Exhibit CF4

details of football summer camps, academy services and tournaments in Leicester and London.

(iv) Details about FSA's 'Pro for a Day' football tournament events, held on 29 May 2023 and 26 May 2024 at King Power Stadium (Leicester).⁵⁹ Also included are posts from the Fox Soccer Academy UK social media channels promoting the events.

(v) Brochures and presentations promoting the coaching services offered by FSA in Leicester and London for the 2017/18 and 2021/22 seasons,⁶⁰ and FSA's coaching manual for 2017 which contains details of the camps based in Leicester and Bracknell.⁶¹

(vi) A selection of invoices sent to UK companies, councils, schools and universities connected with FSA's coaching services.⁶² They are from December 2019, January 2020, April 2022, November 2022 and June 2024.

(vii) A contract between FSA and Derby University, signed in March 2020, regarding their agreement to collaborate for the purposes of recruiting students to a foundation degree qualification aimed at students wishing to pursue a career in the football/coaching industry.⁶³ FSA is described as a soccer academy.

96. In *Victoria Plumb Ltd v Victorian Plumbing Ltd* [2016] EWHC 2911 (Ch), Carr J considered the CJEU's judgment in *Budejovický Budvar NP v Anheuser-Busch Inc. (Budweiser)*, Case C482/09, and the Court of Appeal's judgments in that case and in *IPC Media Ltd v Media 10 Ltd* [2014] EWCA Civ 1403, and stated that a defence of honest concurrent use could, in principle, defeat an otherwise justified claim of trade mark infringement where the two parties had been using the same or closely similar

⁵⁹ Exhibit CF5

⁶⁰ Exhibit CF6

⁶¹ Exhibit CF7

⁶² Exhibit CF8

⁶³ Exhibit CF9

names honestly for a long time and the guarantee of origin of the claimant's trade mark was not impaired by the defendant's use.

97. The *Budweiser* case had demonstrated that honest concurrent use may be relevant in cancellation proceedings, and I can see no reason why it would not be relevant in opposition proceedings. Nevertheless, the CJEU noted that the circumstances of that particular case were exceptional. Its answer to the third question put to it was as follows:

“In the light of the foregoing, the answer to the third question is that Article 4(1)(a) of Directive 89/104 must be interpreted as meaning that the proprietor of an earlier trade mark cannot obtain the cancellation of an identical later trade mark designating identical goods where there has been a long period of honest concurrent use of those two trade marks where, in circumstances such as those in the main proceedings, that use neither has nor is liable to have an adverse effect on the essential function of the trade mark which is to guarantee to consumers the origin of the goods or services.”

98. Whether the exceptional circumstances referred to by the CJEU in *Budweiser* apply in a particular case is, ultimately, a question of fact. Whilst I acknowledge Mr Fuchs' evidence of FSA's use of its word mark in the UK, I do not consider the evidence in these proceedings sufficient to establish that the businesses have coexisted for a long period of time. This is predominantly due to the aforementioned issues with the evidence of use of the '357 mark. I have found a likelihood of indirect confusion between the '357 mark and FSA's word mark. There is no evidence at all of the '357 mark as registered, and the evidence relating to other signs in the style of the '357 mark is extremely limited. In the context of the marks at issue, I find that the evidence falls a long way short of what would be required to mount a successful honest concurrent use defence.

99. Moreover, whilst I acknowledge that the absence of actual confusion can be a relevant factor in the global assessment of the likelihood of confusion,⁶⁴ it has not

⁶⁴ See, for example, *easyGroup Limited v Easyfeetstore OÜ & Ors* [2026] EWHC 767 (IPEC)

carried any material weight in the present case. In *Roger Maier and Another v ASOS* [2015] EWCA Civ 220, Kitchen LJ stated that:

“80. [...] the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

100. On the basis of the evidence before me, I do not consider there to have been any real opportunity for confusion to occur between FSA’s word mark and the ‘357 mark. As previously outlined, there is no evidence at all of the ‘357 mark as registered, and the evidence relating to other signs in the style of the ‘357 mark is extremely limited.

Conclusion

101. Mr Appiah-Kusi’s claim under section 5(2)(b) in the opposition is successful.

Opposition based upon section 5(3)

Legislation and case law

102. Section 5(3) of the Act states:

“(3) A trade mark which-

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 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”.

103. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected”.

104. The relevant case law can be found in the following judgments of the CJEU: *General Motors*, Case C-375/97, *Intel*, Case 252/07, *Adidas-Salomon*, Case C-408/01, *L’Oréal v Bellure*, Case C-487/07, *Marks and Spencer v Interflora*, Case C-323/09, and *Environmental Manufacturing LLP v OHIM*, Case C-383/12P. 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; *General 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-Salomon, 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* and *Environmental Manufacturing, paragraph 34*.

(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 on the earlier mark; *L'Oréal 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'Oréal v Bellure*).

105. The conditions of section 5(3) are cumulative. Firstly, Mr Appiah-Kusi must show that the '357 mark is similar to FSA's word mark.⁶⁵ Secondly, Mr Appiah-Kusi must show that his mark has achieved a level of knowledge, or reputation, amongst a significant part of the public. Thirdly, Mr Appiah-Kusi must establish that the public will make a link between the marks, in the sense of the '357 mark being brought to mind by FSA's word mark. Finally, assuming the foregoing conditions have been met, section 5(3) requires that one or more types of damage claimed by Mr Appiah-Kusi will occur. It is not necessary for the purposes of section 5(3) that the goods and services are similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

106. The relevant date for the assessment under this ground is the filing date of FSA's word mark, namely 17 September 2024.

⁶⁵ On the basis of my findings at paragraphs 80-85, this condition is clearly satisfied.

Reputation

107. In *General Motors*, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

108. I have already found that the evidence is not sufficient for the purposes of establishing that the distinctive character of the ‘357 mark had been enhanced by the relevant date. Whilst I acknowledge that reputation and enhanced distinctive character are different, the nature, factors, and evidence used to prove them are the same.⁶⁶ For the same reasons as given previously, I am not satisfied that the evidence demonstrates that the ‘357 mark had a reputation in the UK at the relevant date. Without a qualifying reputation, Mr Appiah-Kusi’s claim cannot proceed.

⁶⁶ *O2 Worldwide Limited v CX02.COM (UK) Limited*, BL O/393/19, paragraph 39

Conclusion

109. Mr Appiah-Kusi's claim under section 5(3) in the opposition is dismissed.

Opposition and invalidation based upon section 5(4)(a)

110. Section 5(4)(a) of the Act states as follows:

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

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

111. Subsection (4A) of section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

112. In *Discount Outlet v Feel Good UK* [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

Relevant date

113. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Daniel Alexander QC, sitting as the Appointed Person, stated as follows:

“42. [...] it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: “date of commencement of the conduct complained of”. If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

“Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the

applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.””

114. In *Smart Planet Technologies, Inc. v Rajinda Sharma*, BL O/304/20, Thomas Mitcheson QC, sitting as the Appointed Person, pointed out that “*the start of the behaviour complained about*” is not the same as the date that the user of the applied-for mark acquired the right to protect it under the law of passing off. Rather, it is the date that the user of that mark committed the first external act about which the other party could have complained (if it knew about it) as an act of actual or threatened passing off. Typically, this will be the date when first offer was made to market relevant goods or services under the mark. However, it could also be the date the first public-facing indication was made that sales were proposed to be made under the mark in future. If the user of the applied-for mark was not passing off at the time such use commenced (usually because no-one else had acquired a protectable goodwill under a conflicting mark at that time), they will not normally be passing off by continuing to use the mark.

115. The prima facie relevant dates are the filing dates of FSA’s marks, namely 5 December 2023 for its figurative mark and 17 September 2024 for its word mark. However, FSA’s case is that it has been trading in the UK since 2016. Mr Fuchs’ evidence shows use of FSA’s marks in the UK, with the first public-facing use of both marks being in a Facebook post on 5 November 2016.⁶⁷ Accordingly, I will first consider the position at that date (“the earlier relevant date”), before considering the position at the prima facie relevant dates if it becomes necessary to do so.

⁶⁷ Exhibit CF3

Goodwill

116. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (at 223-224):

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

117. Goodwill arises from trading activities. I have already summarised the evidence. Very little of it predates the earlier relevant date. I note that Foxes Club Franchising Limited and The Little Foxes Club Limited were incorporated in 2009 and 2012, respectively, and that there is reference to Foxes FC being in operation since 2009. There are also printouts from thelittlefoxesclub.com, dated 5 July 2012 and 12 June 2015, featuring use of foxes fc and theLittleFoxesClub.com in plain font, as well as the figurative FOXES FC sign. However, no information has been provided regarding the number of visits the website received from UK internet users at any time before the earlier relevant date. The evidence suggests that the Facebook account was created before the earlier relevant date (in April 2011), though there is no evidence of how many followers the account had at the earlier relevant date. In addition to the issues with the limited evidence of use from before the earlier relevant date, there are no turnover figures from before that date or any direct evidence of sales. There are no marketing spend figures or any direct evidence of such activities being conducted before that date. Whilst I acknowledge that there is no requirement for any particular pieces of evidence to be filed, it is difficult to properly ascertain the extent of Mr Appiah-Kusi's trading activities or customer base on the basis of the evidence before me. In my view, whilst there was clearly some commercial activity prior to the earlier relevant date, I am not satisfied that the evidence is sufficient to establish that Mr Appiah-Kusi had generated protectable goodwill in the UK at that date. As he has not established that he had the necessary goodwill to render FSA's use actionable on the date that it began, his claims under this ground must fail.

118. Whilst I acknowledge that what happens after the date on which the behaviour complained of started is not irrelevant, the evidence does not suggest that FSA's activity ceased or materially changed between that point and the prima facie relevant dates.⁶⁸ In the circumstances, it is not necessary to go on to consider the position at the prima facie relevant dates.

Conclusion

119. Mr Appiah-Kusi's claims under section 5(4)(a) in the opposition and invalidation are dismissed.

OVERALL OUTCOMES

120. The opposition to FSA's word mark has been successful. Subject to any appeal against this decision, registration of FSA's word mark (application no. 4100565) will be refused.

121. The application for invalidation of FSA's figurative mark has failed. Subject to any appeal against this decision, FSA's figurative mark (registration no. 3987955) will remain registered.

COSTS

122. Both parties have achieved what I regard as a roughly equal measure of success. As such, I direct that both parties should bear their own costs.

Dated this 11th day of September 2026

James Hopkins
For the Registrar

⁶⁸ See, for example, the comments of Thomas Mitcheson QC, sitting as the Appointed Person, in *TWG Tea Company Pte Ltd v Mariage Frères, Société anonyme*, BL O/349/16.