

**IN THE MATTER OF APPLICATION NUMBER 2144430A  
IN THE NAME OF HALE LEISURE LTD  
TO REGISTER A TRADE MARK IN CLASS 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NUMBER 48546  
BY FUTBOL CLUB BARCELONA**

**IN THE MATTER OF application number 2144430A  
in the name of Hale Leisure Ltd  
to register a trade mark in Class 42**

**And**

**In the matter of opposition thereto under number 48546  
by Futbol Club Barcelona**

### **Background**

On 8 September 1997, Hale Leisure Ltd filed an application to register as a series of two, the trade mark BARCA, and the same word in a stylized form, in Classes 42, and in respect of the following goods:

Café, bar and restaurant services

By an application dated 1 December 1997 the trade mark application was divided into two separate applications, becoming numbers 2144430A and 2144430B. The opposition stands against number 2144430A which is for the mark BARCA.

On 11 May 1998, Futbol Club Barcelona filed notice of opposition in which they say they are the proprietors of the following community trade mark application:

<b>Number</b>	<b>Mark</b>	<b>Class</b>	<b>Specification</b>
198598	BARCA		

The grounds of opposition are in summary:

- 1. Under Section 56(1)** because at the date of application the opponent's mark was well known and entitled to protection under the Paris Convention.
- 2. Under Section 5** because the services applied for are identical or similar to the goods and services and the mark applied for is identical or similar to the opponent's mark.
- 3. Under Section 5(3)** to the extent that the services applied for are not identical or similar to the goods and services for which the opponent's earlier mark is protected and the mark applied for is identical or similar.
- 4. Under Section 5(4)(a)** by virtue of the law of passing off.
- 5. Under Section 3(3)(b)** because the mark applied for is of such a nature as to deceive the public by suggesting a connection with the opponents or the city of Barcelona.
- 6. Under Section 3(6)** because the application was made in bad faith.

The opponents also ask that the application be refused in the exercise of the registrar's discretion or judgment, but as the registrar does not have the power to refuse an application that satisfies the provisions of the Act, I do not intend to consider this request further.

The applicants filed a counterstatement in which they deny the grounds on which the opposition is based. Both sides request that an award of costs be made in their favour. Neither side wished to take up the offer of a hearing, electing instead to file written submissions and have a decision from the papers.

### **Opponent's evidence**

This consists of an Affidavit dated 18 May 1999 and comes from Roberto Tendero, Director in charge of the Marketing Department of Futbol Club Barcelona, a position he has held for at least 20 years. Mr Tendero confirms that the information in his Affidavit comes from his personal knowledge or from the records of the club.

Mr Tendero says that the opponent was founded as a professional club in 1899 and has become one of the worlds most successful. He mentions the trophies the team won and refers to exhibit RT1 which consists of an extract from a publication listing, inter alia, the trophies won by Barcelona since 1909. He says that from his own personal knowledge he knows that for many years his club has been known by the name BARCA, (its name in the Catalan language) and is known as such in Spain and throughout the world, including the United Kingdom, an assertion that he repeats throughout his Affidavit.

Mr Tendero refers to exhibits RT2 and RT3, both of which show references to BARCA. However exhibit RT2 originates from after the relevant date and as it casts no light back to the time prior to the application being made is of no assistance in determining the issues. It is also inconclusive as to its origin in that it cannot be said to have been available within, or even to persons from the United Kingdom. Exhibit RT3 consists of an extract from Collins Spanish-English, English-Spanish Dictionary showing BARCA to be the Spanish word meaning Barcelona Football Club, but as no date of publication of this edition is given it does not clearly establish this to have been the position at the relevant date.

Mr Tendero mentions matches that his club has played against teams in the United Kingdom, in particular, two against Manchester United in September 1998 which Mr Tendero says had been heavily reported in the UK press, examples of which are shown at exhibit RT4. The exhibit consists of copies of articles that appeared in national daily newspapers in November 1998, using the word BARCA as a reference to Barcelona Football Club, but as these are dated over a years after the date of application they do not establish that BARCA was used in such a way at the relevant date.

Mr Tendero refers to exhibit RT5 which consists of extracts from his clubs website taken in September 1998 and May 1999. The exhibit refers to BARCA as the football club that has the highest number of members (105,000) worldwide, including an unspecified number in the United Kingdom, which also has a supporters club chaired by Mr Bonaventura Alsina who lives in London.

Mr Tendero says that his club has a mailing service whereby fans and supporters can purchase publications and other items produced by his club, although gives no specific details. He continues saying that his club further promotes its activities through a range of publications, magazines and CD-ROMs, exhibit RT6 consisting of a selection of these. The exhibit consists of CD's and CD-Rom's, one entitled BARCA TOTAL, ENCICLOPEDIA MULTIMEDIA and DEL FC BARCELONA, referring, inter alia, to WEMBLEY 1992 and EL BARCA DEL 2000 (1997-1999). The covers, inner sleeve and disc label are all in Spanish, there is no means by which to ascertain the date of issue or whether they were ever available in the United Kingdom. One disc has a price tag from a shop in Madrid. The exhibit also includes:

S copies of the September and November 1998 editions of a Spanish language magazine entitled BARCA, the letters page of the September 1998 edition containing a letter from a person in Scotland and referring to Barcelona's appearance at the European Cup final at Wembley in 1992. Unlike some of the others, this letter does not refer to BARCA. Whilst the letter could be taken as an indication that the magazine is available in the United Kingdom, this is not certain, or that it was so at the relevant date.

S A publication entitled EI SIGNIO DEL BARCA recording 100 years (of the football club) in images. The only date that could relate to its publication can be found on an inside page which refers to Depsito legal M-13.008-1998 which would seem to place the date of publication some time in 1998, which would accord with the historical data contained in the publication which goes up to the 1997-98 season. The publication contains many references to BARCA in

the text but none of the accompanying photographs that would have provided historical evidence show this name so does not establish use of BARCA other than at the date of publication. There is no indication that the publication was ever available in the United Kingdom, be it prior to, at or after the relevant date.

Mr Tendero says that his club further promotes its activities by selling merchandise under the mark BARCA, and he goes on to list various items although gives no corroborative evidence.

Mr Tendero refers to his club making an application to register BARCA as a trade mark at the OHIM, details of which he shows as exhibit RT7. The exhibit consists of a print in Spanish, for Community Mark 198598, the earlier mark relied upon in the Statement of Grounds, and goes on to say why he considers the mark applied for is likely to be confused with this mark. He refers to the Statutory Declarations of Sharon Sillitoe and Kenneth John Friar (summarised later) saying that he believes these support his conclusions that BARCA is well known within the United Kingdom. He introduces exhibit RT8, which consists of a:

- S Declaration dated 4 December 1998 by Holly Roper-Curzon, Intellectual Property Director of The Football Association Premier League Limited, in which Ms Roper-Curzon states that the Association declares that the football team Barcelona, winners of the 1997-98 Spanish League, is also known in England with the designation BARCA. Ms Roper-Curzon but does not say how the Association knows this fact, to whom the name is well known nor that it was so at the relevant date.
- S letter dated 27 May 1998 (and translation thereof) from Editorial Escudo de Oro, S.A, certifying that his company is the publisher of a publication entitled TODO, an edition of which contains an image of the stadium of Barcelona Football Club, popularly known as BARCA.
- S certificate 21 May 1998 (and translation thereof) from Sheena Campbell-Foyle, President of the British Chamber of Commerce, based in Barcelona certifying that the trade marks BARCA, BLAUGRANA and FOOTBALL CLUB BARCELONA are well known. Ms Campbell-Foyle but does not say on what basis she makes the statement, that it is well known in the United Kingdom, nor that it was well known at the relevant date.

### **Applicant-s evidence**

This consists of an Affidavit and two Statutory Declarations. The Affidavit is dated 19 November 1999 and comes from Aiden Joseph Clancy, a Director of Hale Leisure 1995 Ltd since its formation in 1995. He says that the applicants are part of a group of companies which develops and operates bars, inter alia, BARCA which is a bar and restaurant operated by Newlight Limited.

Mr Clancy gives details of the history of the BARCA club, referring to exhibit AJC1 which consists of various press extracts relating to Castlefield in Manchester and the opening of the

BARCA bar, and one from a media company noted as being from Yellow Pages 1998/99 referring to Mick Hucknell as a part owner of BARCA (with the accent below the A@).

He recounts a visit to Barcelona with an architect to obtain ideas for the architectural design and layout for the bar, saying that BARCA was chosen as the name for the club because it is the historical name for Barcelona and reflected the ideas and influences architecturally that they wished to incorporate within the bar which is located in Catalan Square. He also says that the association with boats is relevant because the bar is located next to the canal. He refers to exhibit AJC3 which consists of an article noted as being from 13 June 1997 edition of a publication, said to be The Manchester Evening News referring to the BARCA as the shortened version of Barcelona (the city). He also refers to exhibit AJC4 which consists of features dating from 1998-1999 relating to BARCA and BARÇA, in Manchester.

Mr Clancy says that the restaurant had originally been a Spanish restaurant but had diversified into Mediterranean cuisine. He refers to exhibit AJC5 consisting of menus from the bar showing the logo version of the trade mark removed from this application, and referring to the bar both as BARCA and BARÇA, and press articles relating to or mentioning the bar in the same manner.

Mr Clancy says that BARCA is part of a chain of bars named after cities; Prague V, Berlin and a boat named BARCA II, exhibit AJC6 consisting of press articles relating to the opening of these bars. He says that the name BARCA was first considered in December 1995, started trading on 20 May 1996, and is now well established. He refers to exhibit AJC7 which consists of articles and features from 1998-1999 relating to the BARCA/BARÇA bar in Manchester.

Mr Clancy goes to the Declaration by Mr Tendero (shown as exhibit AJC8), in particular to the assertion by Mr Tendero that BARCA refers to Barcelona Football Club. He says this is not true, referring to exhibits AJC 9 and AJC10, which consists of extracts from The Williams Spanish & English Dictionary and The Oxford English Dictionary (1989) both of which show BARCA to be various types of boats. Neither exhibit contains an entry for BARÇA. He next refers to exhibit AJC11 which consists of an extract from an Internet site B.A.R.C.A relating to operators and nautical activities in the Mediterranean, which Mr Clancy asserts confirms the boating influence, as does the name of the ship-bar BARCA II and the location of the BARCA bar next to the canal.

Mr Clancy makes some comments with regard to there being no evidence of confusion between the bar and the football club, stating that the bar does not sell any merchandise. He goes to exhibit AJC13 which consists of photographs of the interior and exterior of his company's bar, noting that the emphasis is Spanish, drawing an association with the city of Barcelona, but not the football club or anything to do with football.

Next is a Statutory Declaration dated 18 February 2000 by Victoria Gregory, Chief Executive of Marketing Manchester.

Ms Gregory gives her views on the value of a partnership between Manchester and Barcelona, commenting on the naming of a Catalan Square in Manchester and the restaurant BARCA.

The final Statutory Declaration is dated 18 February 2000, and comes from Richard Leese, Leader of Manchester City Council.

Mr Lees recounts how, and why in 1992, Manchester City Council agreed to the name Catalan Square for part of a newly developed area of the city, referring to the emergence of BARCA which he says is one of the most popular and best loved bar/restaurants in Manchester. He says the exterior of BARCA is often used to convey the image of the new Manchester, and that like the square, BARCA honours the city after which it is named.

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### **Opponent-s evidence in reply**

This consists of 6 Statutory Declarations. One Statutory Declaration, dated 1 June 2001 from Richard Mark Hiddleston, a solicitor and trade mark attorney with Clifford Chance, a position he has held for 3 years. The Declaration contains no evidence of substance being directed at rectifying a clerical error in the other 5 Declarations and their exhibits. The headings of these documents referred to opposition number 48547 rather than the correct number 48546. Mr Hiddleston confirms that the heading in each case should have referred to opposition number 48546.

Turning first to a Statutory Declaration dated 23 October 2000 from Richard Mark Hiddleston. Mr Hiddleston confirms that the information set out in his declaration is from his own personal knowledge and the records and files of his firm.

Mr Hiddleston says that to ascertain the significance of BARCA/BARÇA amongst the public in the United Kingdom he conducted a straw-poll by e-mail, the wording of which is shown as exhibit RMH1, and the results shown as exhibit RMH2. Mr Hiddleston says that the recipients of the mail were all employees of the London office of Clifford Chance, and that no explanation was given to the recipient nor any indication that the firm were acting for Barcelona Football Club. The mails were sent on 20 October 2000, stating that the firm (Clifford Chance) were handling a matter related to BARCA, and posed the question "What does the word BARCA or BARÇA mean to you?". The email asked those for whom it had some meaning to mail him details of what.

Mr Hiddleston states that 284 replies (later said to be 287) were received, of which he says:

- S 168 (59%) saw the word(s) as referring to or signifying Barcelona Football Club
- S 30 (10.5%) gave the only significance of BARÇA as referring to the city
- S 46 (16%) gave the significance of BARÇA to be that of a ship or boat,
- S 6 referred to BARÇA as signifying a bar in Manchester.

Mr Hiddleston says that a further 37 replies were received indicating that the respondents had no idea of the meaning, or gave other possible meanings for the word BARÇA. He says that

the straw-poll supports the conclusions that the significance of BARÇA in the United Kingdom is that of a nickname for Barcelona Football Club.

On my review of the straw-poll, at best some 136 respondents clearly identified BARCA/BARÇA as being related to the opponents which nonetheless is a significant proportion of the respondents. However, Mr Hiddleston does not say how many people were asked to participate in the poll so it is not therefore possible to gauge the real significance of the results. It may also be material that the survey was taken some 3 years after the relevant date in these proceedings, and whilst it is likely that their long-term success had created this awareness prior to the relevant date, I am reluctant to infer this. I also have some reservations as to how representative, on examination, a firm of London based solicitors will be found to be when compared to the demographic base of the public at large; I have no evidence to assist me.

Mr Hiddleston goes on to refer to exhibits RMH3 and RHM4 which consists of the results of searches for newspaper articles, RMH 3 being a synopsis of articles that have appeared in national and regional newspapers, and exhibit RMH4 being copies of articles that relate to the Barcelona Football team. Many do not mention BARCA, but of those that do, do so in relation to the football club. The earliest reference to the football club is entry 255 from the 2 November 1993 edition of The Guardian. However, the earliest reference to BARCA can be found at entry 276 which is an extract from the 10 August 1992 edition of The Guardian, using BARCA as a reference to the city having hosted the Olympic Games.

Mr Hiddleston refers to the Declaration by Mr Clancy, in particular, the evidence relating to the applicant's use of the mark, noting that there is no indication of the scale of the applicant's use prior to the relevant date, and that exhibits AJC3 - AJC5 all relate to the period after the relevant date. He goes to Mr Clancy's statement that the opponents have no reputation for the services covered by the application and that there is no overlap between the services of the application and the earlier mark relied upon by the opponents. Mr Hiddleston says that the services covered by Class 41 of the opponent's earlier mark must be considered similar, there being a clear connection between entertainment, and for example, night club services, the provision of musical entertainment, dancing facilities, all of which could be provided at the applicant's premises.

Mr Hiddleston goes on to refer to the Canon trade mark case in which the European Court of Justice stated that in considering the likelihood of confusion, the inherent or acquired distinctive character is directly relevant, Mr Hiddleston saying that the results of the straw-poll and number of references in UK newspapers to BARCA in relation to the football club shows them to have established a substantial reputation.

Mr Hiddleston refers to the Statutory Declarations of Richard Leese and Victoria Gregory, who both say that they believe BARCA to be the name of the city of Barcelona, and to the Declaration by Mr Clancy in which he relied upon a newspaper article in the Manchester Evening News that had referred to BARCA as being the shortened version of Barcelona. Mr Hiddleston comments that neither the Declarants nor the writer of the newspaper article make it clear why they consider BARCA to be a reference to the city of Barcelona, and that exhibit RT3 makes it clear that this is not, in fact, the case.

Next is a Statutory Declaration dated 19 December 2000 which comes from Francesc Xavier Canals Santero, a qualified linguist working for Inter-Com Translations in London. Mr Santero says that he is a Spanish citizen born in the province of Barcelona. He confirms that he is fluent in the Catalan, Spanish and English languages.

Mr Santero says that from his own personal knowledge he can confirm that the word BARÇA is derived from the name of Barcelona Football Club in the Catalan language and that the only significance of the word to him in either the Catalan or Spanish language would be as the nickname or alternative name for that club. Mr Santero says that he can confidently state that to a native born Spanish or Catalan speaker, the term BARÇA would signify Barcelona football club and not Barcelona city in general.

The next Statutory Declaration is dated 8 January 1999 and comes from Kenneth John Friar, Managing Director of Arsenal Football Club, a position he has held for some 15 years. Mr Friar confirms that he has approximately 49 years experience of the management of football, and that the information set out in his Declaration comes from his own personal knowledge.

Mr Friar says that he is aware of the name BARÇA as referring to, or as an alternative name for Futbol Club Barcelona. He refers to exhibit KJF1 which consists of details of trade mark number 2144430A, the application that is the subject of these proceedings, saying that if he saw a restaurant or bar trading under the name BARÇA in the United Kingdom he would believe that it was in some way connected with the opponents.

The final Statutory Declaration is dated 22 January 1999 and comes from Sharon Sillitoe, Marketing Manager of Wimbledon Football Club, a position she has held for 4 years. Ms Sillitoe confirms that she has approximately 9 years experience in the world of football, and that the information set out in her Declaration comes from her own personal knowledge.

Ms Sillitoe says that she is aware of the name BARÇA as referring to, or as an alternative name for Futbol Club Barcelona. She refers to exhibit SS1 which consists of details of trade mark number 2144430A saying that she believes there would be a danger of confusion with the opponents if the applicants were to use the name BARÇA in relation to a restaurant or bar in the United Kingdom.

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

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## **Decision**

The opponents filed written submissions in which they say that they do not intend to rely upon Section 3(6) and I therefore do not need to give that ground any further consideration. The written submissions advance arguments in support of grounds stated to be Section 5(2)(b), Section 5(3), Section 5(4)(a) and Sections 5(6)(1) and 6(1)(c). There is no mention of Section 3(3)(b) nor any arguments in support, but for the avoidance of doubt I will include that section in this decision.

Turning first to consider the ground under Section 3(3)(b). The opponent's objection is that the mark applied for would suggest to the public that there is a connection with the opponents,

the city of Barcelona or with Spain. Turning first to the question of deception through the mark being associated with the opponents. It is my understanding that Section 3 of the Act is concerned with the question of whether the mark itself has the inherent capacity to distinguish, and is not concerned with any conflict or possible confusion with the rights of other traders which are catered for in Section 5 of the Act.

The opponents also contend that the public will be deceived because the mark suggests a connection with Barcelona or Spain, but even if it does, so what? Section 3(3)(b) refers to marks which are of such a nature as to deceive the public, for instance, as to the nature, quality or geographical origin of the goods or services. Assuming that the public recognise BARCA as denoting Barcelona, the most they may well expect is that the restaurant serves Spanish cuisine. I cannot imagine any sensible person would be deceived into believing that the services originate from Barcelona or Spain. Consequently, this ground is dismissed.

Turning next to the grounds under 5(2)(b). That section reads as follows:

**5.-(2)** A trade mark shall not be registered if because **B**

(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.

An earlier trade mark is defined in Section 6 of the Act as follows:

**6.-(1)** In this Act an earlier trade mark means **B**

(a) a registered trade mark, international trade mark (UK) or Community trade mark 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,

(b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application was entitled to protection under the Paris Convention as a well known trade mark.

In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 2, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schufabrik Meyer & Co. GmbH v Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG*, paragraph 41; the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 29.

The opponents rely on one earlier trade mark, for the mark BARÇA which is registered with the Community Trade Mark Office under number 198598.

The applicant's mark BARCA and the opponent's mark BARÇA differ only in respect of the accent under the letter C, and if they are not absolutely identical in appearance, they are all but so. The aural and conceptual similarity may be influenced by whether the person encountering the marks has any knowledge of the Spanish or Catalan languages. There is no specific evidence as to how the word BARÇA would be pronounced, the only clue being one of the CDs forming part of exhibit RT6 which seemed to show that it would sound similar to BARSSA. However, other than to those conversant with the Spanish or Catalan languages the accent is unlikely to affect the pronunciation, and consequently, the respective marks will sound the same when

spoken.

To my mind the evidence shows that if BARCA/BARÇA has any conceptual significance to the person viewing it, be it the name of the city, football club or boat, it will do so whether or not the accent is used under the letter C. If they have no significance, both are likely to be seen as invented words although it is possible that the accent in BARÇA may provoke the thought that that version may be a foreign rather than an invented word.

The opponent's earlier mark is not registered in respect of the same services, so the question is whether the services, and of course the goods for which it is registered would be deemed to be similar. In determining this question I look to the guidance of Jacob J. in *British Sugar Plc v James Robertson & Sons Ltd* (1996) RPC 281 and in the judgement of the European Court of Justice in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C- 39/97 case. With these cases in mind I propose to consider the question of similarity by a consideration of the following factors:

- (a) The nature of the goods or services;
- (b) The end-users of the goods or services;
- (c) The way in which the goods or services are used
- (d) Whether the respective goods or services are competitive or complementary. This may take into account how those in trade classify goods and the trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) In determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account.

In paragraph 9 of his Declaration Mr Hiddleston, referring to the Declaration of Mr Clancy, says

AI submit that the opponent's CTM application (now registration) No 198598, in particular covers entertainment services in Class 41, which contrary to the conclusions of Mr Clancy must be considered similar services to those covered by the subject application. There is indeed a clear connection between these services and those covered by the subject application since for instance the term "entertainment services" would include, among other services, night club services, the provision of musical entertainment, dancing facilities, all of which I believe could be provided at the applicant's premises and should be considered services similar to those covered by the subject application.

In essence Mr Hiddleston is relying solely on Class 41 of the opponent's earlier mark which in my mind is a realistic approach, for if the opponents cannot succeed in respect of the services in that class, they will be in no better position with regard to the goods classes. However, Mr Hiddleston does not compare the services covered by the application with those of the opponent's earlier mark, but rather the services that the applicants may be capable of providing at their premises. The wording of Section 5(2)(b) makes it clear that the question, or at least part of it, is whether the services (or goods) for which a mark is sought to be registered are identical with or similar to those for which the earlier trade mark is protected, and in determining that question in these proceedings it is appropriate to keep in mind the decision in *Avnet v Isoact* (1999 FSR) in which Jacob J said that specifications of services are inherently less precise than goods and should be studied carefully and not given wide interpretation.

Mr Hiddleston is right when he says that entertainment services can, and in my experience, are provided in cafés, bars and restaurants, and likewise, food and drink may be provided at venues that are primarily for entertainment, but that is not necessarily so. I would not regard such services to be the same in nature. The respective services are not limited so as to be aimed at a particular or restricted sector of a market, nor specialised in any way, and I see no reason why the end users should not be the same. The services are clearly provided in different ways, one for example being rendered for the purpose of sensory or intellectual stimulation with no product, the other is primarily one of nourishment. One may be provided as an adjunct to the other and in that respect may be considered complementary, but not in competition.

The opponents claim a substantial reputation in the name BARÇA/BARCA in the United Kingdom which, they say, has been built through matches reported by the British media, circulation of a club magazine and their web site. Then there are many articles that have appeared in the media using one or other of these names in connection with Barcelona Football Club prior to the relevant date, but only relating to football, and primarily, events affecting the club such as the results of matches, the signing or transfers of new players, etc. There is no evidence that prior to the relevant date the opponents have ever used the name in relation to the services covered by the opposed application, entertainment services at large, or any service outside of football, be it in the United Kingdom or Spain, nor that football clubs in the United Kingdom provide such services. It is also worth noting that evidence also shows instances, the earliest shown in the evidence amongst them, where the name BARÇA/BARCA is used as a reference to the city of Barcelona.

As a measure of the extent of their reputation Mr Hiddleston conducted a straw-poll. Before looking at the methodology used and results of the straw-poll, it is appropriate to look at the *Imperial Group Plc v Phillip Morris Ltd* (1984) case, RPC 293, in which Mr Justice Whitford made a number of observations in relation to survey evidence, advising that if it is to have any validity or carry any weight at all, evidence of the following factors would be necessary:

1. the way in which the interviewees were selected in order to establish whether the survey covered a relevant cross-section of the public,
2. must give the fullest disclosure of exactly:

- i. how many surveys were carried out,
  - ii how the surveys were conducted,
  - iii the total number interviewed,
3. the totality of all answers given must be disclosed and made available,
4. the party carrying out the survey must not direct the person answering the question into a field of speculation upon which that person would never have embarked had the question not been put,
5. it may be necessary that the exact answers given, and not a digest or an abbreviation of the exact answer should be recorded.

Mr Justice Whitford concluded that in the absence of this information he felt it impossible to draw any reliable inference that the answers given are representative of those that would be given by the entire population.

Setting aside the fact that it was conducted some time after the relevant date, the survey or straw-poll appears to have failed to meet a number of the requirements above. Mr Hiddleston confirms that the survey was completed by sending an e-mail to everyone employed at the London office of his firm. Whilst I have no difficulty with the method used, as I have already said, I have some reservations as to how representative of the public at large those asked would be. As far as I am aware, apart from a technical glitch, only one survey was carried out, and whilst it is known how many responses were received it is not known how many people were asked. Mr Hiddleston has made available all of the e-mails sent in reply, therefore giving the actual, and not a summary of the responses, and although I may consider him to have been a little flexible in his interpretation of the responses he considers to support BARÇA/BARCA being a name the respondent associated with the opponents, they clearly showed a degree of recognition.

The question 'What does the word BARÇA/BARCA mean to you' used in the survey could be said to prime the person being asked to the possibility that it does have a meaning, and consequently, give rise to the very speculation Whitford J said should be avoided, but it is not obviously leading. I have some concern that having sent what is an unusual email, that in an enclosed environment such as an office, colleagues in casual conversation may discuss the mail and the results tainted by those who knew of one or more of possible meanings for BARÇA/BARCA telling those who did not.

Although Mr Hiddleston gives the total number of responses received, he does not say how many people were canvassed, so although a significant number of those who responded associated BARÇA/BARCA with the opponents, we do not know what proportion of those who were asked this figure actually represents. For this, and the other reasons I have given, I do not consider that the survey provides assistance in establishing the reputation of the opponents at the time it was conducted, let alone at the relevant date.

There is a letter from letter dated 27 May 1998 (and translation thereof) from Editorial Escudo de Oro, S.A, certifying that his company is the publisher of a publication entitled TODO, an

edition of which contains an image of the stadium of Barcelona Football Club, popularly known as BARCA, but what does this say about how well known the name BARÇA/BARCA is in the United Kingdom and whether the connection will be made with the football club

In their Declarations, Holly Roper-Curzon, Intellectual Property Director of The Football Association Premier League Limited says that the football team Barcelona is also known in England with the designation BARCA. Mr Kenneth Friar, the Managing, the Director of Arsenal Football Club, and Sharon Sillitoe, Marketing Manager of Wimbledon Football Club also confirm that they are aware of the name BARÇA as referring to, or as an alternative name for Futbol Club Barcelona and go on to say that if they saw a restaurant or bar trading under the name BARÇA in the United Kingdom they would believe, or possibly be confused into believing it was in some way connected with the opponents. It could well be that Ms Roper-Curzon, Mr Friar and Ms Sillitoe are aware of the connection between BARCA and Barcelona Football Club because they are in the same industry, and consequently, cannot be taken as being representative of the public at large.

A certificate from Sheena Campbell-Foyle, President of the British Chamber of Commerce, based in Barcelona attests that the trade marks BARCA, BLAUGRANA and FOOTBALL CLUB BARCELONA are well known. The certificate does not say how Ms Campbell-Foyle knows this to be the case, whether she is referring to the marks being well known in the United Kingdom, nor that they were well known at the relevant date.

In his Declaration Mr Santero, a qualified linguist, says that from his own personal knowledge he can confirm that the word BARÇA is derived from the name of Barcelona Football Club in the Catalan language and that the only significance of the word to him in either the Catalan or Spanish language would be as the nickname or alternative name for that club. This seems somewhat at odds with other evidence, particularly the news articles, but as he says, he is giving an opinion from his own personal knowledge. He goes on to say that to a native born Spanish or Catalan speaker, the term BARÇA would signify Barcelona football club and not Barcelona city in general, but of course, the relevant public is not composed of native born Spanish or Catalan speakers.

Although Mr Hiddleston does not specifically offer up these individuals as expert witnesses, through their connection with the football industry or their expertise in language they may be regarded as such. In the LOADED case (SRIS O/45500), Mr Simon Thorley QC sitting as the Appointed Person said that weight can only be attached to an expert's opinion when it is an opinion based on the expert's experience and is explained in enough detail so that the court can understand why the expert holds that opinion and can judge how much weight it can be given.

Reference was made to the decision in *The European Limited v The Economist Newspaper Limited* (1998 (FSR) 283. For the reasons I have given, both in my decision above and also in my summary of their evidence, I consider that the evidence of Ms Roper-Curzon, Mr Friar, Ms Sillitoe, Ms Campbell-Foyle and Mr Santero lacks the necessary detail to be given much, if any weight.

The opponents also rely on the existence of their Internet site, which I accept may be accessed by persons in the United Kingdom. However, in the 800-FLOWERS case, (2000) FSR 607, Mr Justice Jacob said:

The mere fact that websites can be accessed anywhere in the world does not mean, for trade mark purposes, that the law should regard them as being used everywhere in the world.

To be of any assistance, internet evidence would, at the very least require details of use of the site by persons in the United Kingdom. But even with such evidence (and there is none in this case) considerable care would have to be exercised in the interpretation of the bare facts. It may well be the site came up in the results of an unrelated search, and the person did not take much, if any cognisance of its contents.

In summary, I come to the view that to those engaged in the football industry, or interested in sports, particularly football, the name BARÇA/BARCA may be seen as being a reference to Barcelona Football Club, and that they may well have established a reputation in this name in the United Kingdom, but only in respect of a football team. Extending this to the criteria set out above for determining the similarity or otherwise of the respective services, I take the view that they are not similar.

There is also the fact that the applicants have been using their trade mark for some 16 months prior to the relevant date, and has been widely publicised and referred to in the media without any apparent confusion or suggestion that the restaurant may have a connection with Barcelona Football team. The association of Mick Hucknell with the premises has added to its profile in the media. Mr Hiddleston does highlight that much of the applicant's evidence post dates the relevant date, but his own evidence (exhibit RMH3) has a reference dating back to May 1996 which I consider must relate to use of BARÇA/BARCA by the applicants. Although parallel use will not in itself save an application, it is a relevant consideration.

Adopting the global approach advocated, I come to the view that the similarity in the respective marks may cause some consumers, primarily the football aficionado, to recall the opponents, but I see no reason why this would lead them to speculate whether the applicant's and/or their services are in some way connected with the opponents. It may well be that football clubs provide café, bar and restaurant services within their grounds (although there is no evidence of this) but there is no suggestion that even the premier clubs in the United Kingdom provide such services at a location divorced from the stadium, and I see no reason why the consumer should be confused into believing that a football club from Spain has set up a restaurant in the United Kingdom, or is in some way linked. Accordingly, the ground under Section 5(2)(b) fails.

The opponents also claim that the mark that they have registered as a Community trade mark is entitled to protection under Section 56(1) as a well known mark. Their registration clearly constitutes an earlier mark and the opponents appear to satisfy the criteria to invoke that section. That a mark may be well known is not the end of the matter; the question is, well known for what purpose. The answer to this is, I believe, to be found in Section 56(2) which says:

- (2) The proprietor of a trade mark which is entitled to protection under the Paris Convention as a well known trade mark is entitled to restrain by injunction the use in the United Kingdom of a trade mark which, or the essential part of

which, is identical or similar to his mark, in relation to identical or similar goods or services, where the use is likely to cause confusion.

As with the previous ground, Section 56 requires, at the very least, similarity of mark and services, but also that the mark to be well known in the United Kingdom to the extent that there is a likelihood of confusion. I do not see how the opponents can be in any better a position under this section than they were under Section 5(2)(b) and this ground is also dismissed.

Turning to the ground under Section 5(3). That section reads as follows:

**5(3)** A trade mark which -

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

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

I have already concluded that the marks are all but identical, and that the application covers a range of different services. In *Pfizer Ltd v Euro Food-Link (UK) Ltd* ((ChD) [1999] 22(4) IPD 22039) Mr Simon Thorley QC sitting as a Deputy High Court Judge said:

"What is necessary is that the trade mark proprietor should prove the required reputation and should then satisfy the Court that the defendants use of the sign is:

- (a) without due cause; and
- (b). takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark."

I have already given my views on the extent of the opponent's reputation in the United Kingdom as shown by the evidence, in effect, that if they are known under the name BARÇA/BARCA, it is in respect of a football team, not for a trade in any particular goods or the provision of any services. There is no evidence that football clubs, be it in the United Kingdom or elsewhere provide café, bar or restaurant services at a location divorced from the stadium, and as I see no reason why the consumer would assume a connection between a football club and premises providing such services. This being the case, I am unable to see how the applicants could derive any advantage, let alone unfair, or how the applicant's use could be detrimental to the reputation of the opponent's mark; it will be just as distinctive as it ever was. Setting aside the question of due cause®, on my reading the evidence does not establish that at the relevant date the opponents had built a reputation within the United Kingdom to the extent that if another

trader were to use the same or a closely resembling mark in respect of dissimilar goods, that the distinctive character or repute of their mark would suffer, or that any benefit will be derived by the other user. The use of the name could, just as easily be taken as a reference to the city of Barcelona, particularly by those who have little or no interest in football, and consequently, the ground under Section 5(3) fails.

Finally there is the ground under Section 5(4)(a). That section reads as follows:

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

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

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

Mr Geoffrey Hobbs QC sitting as the Appointed Person in the *Wild Child* (1998 RPC 455) set out a summary of the elements of an action for passing off. The necessary elements are said to be as follows:

- (a) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (b) that there is a misrepresentation by the defendant (whether or not intentional leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

To the above I add the comments of Pumfrey J in the *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenmy Gary Stringer* (a partnership) case, in which he said:

There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirement of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.

Section 5(4)(a) of the Act offers protection to the goodwill and reputation built up by a trader through the use of a sign. I have already highlighted the weakness of the opponent's claim to a reputation within the United Kingdom, and they are in no better a position with respect to goodwill. The evidence relating to the extent of use is nebulous, being primarily reports in the media relating events in the history of the football club. There is no evidence relating to the extent of any trade in goods or services. Consequently, I do not see how I can find that they will suffer damage by the applicant's use of the mark in respect of the services that they seek to protect and the objection under Section 5(4)(a) also fails.

The opposition having failed on all grounds, the applicants are entitled to an award of costs. The opposition was founded upon a wide range of grounds, one of which was abandoned at a late stage, but all of which have failed. There opponents also filed a substantial amount of evidence which must have required a significant amount of effort, and consequently expense to be incurred by the applicant in its review. I therefore consider that an award at the upper end of the scale is appropriate and I order the opponents to pay the applicants the sum of , 770 as a contribution towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 28<sup>th</sup> day of March 2002**

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