

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NOS. 1506369 & 1506370
IN THE NAME OF KONAMI CO LIMITED
FOR A TRADE MARK IN CLASSES 9 & 28**

AND

**IN THE MATTER OF OPPOSITION NOS. 43616 & 43613
BY THE FOOTBALL ASSOCIATION PREMIER LEAGUE LIMITED**

**IN THE MATTER OF APPLICATION NOS. 1560369 & 1506370
IN THE NAME OF KONAMI CO LIMITED
FOR A TRADE MARK IN CLASSES 9 & 28**

AND

**IN THE MATTER OF OPPOSITION NOS. 43616 & 43613
BY THE FOOTBALL ASSOCIATION PREMIER LEAGUE LIMITED**

BACKGROUND

Konami Co Limited applied to register trade marks under the provisions of the Trade Marks Act 1938 (as amended) on 10 July 1992. The applications were subsequently converted to ones to be determined under the provisions of paragraph 11 of Schedule 3 of the Trade Marks Act 1994 when that Act came into force. The applications are thus dated 31 October 1994 and both are for the term KONAMI PREMIER SOCCER. Number 1506370 was accepted for a specification of goods as follows:

“Toys, games and playthings; electronic amusement apparatus adapted for use with liquid crystal displays; program memory cartridges for electronic amusement apparatus adapted for use with liquid crystal displays; games adapted for use with dot matrix liquid crystal displays; all relating to or simulating the game of soccer; all included in Class 28.”

Number 1560369 was accepted for a specification of goods falling into Class 9 as follows:

“Television and video apparatus and instruments; electrical, electronic and video amusement apparatus adapted for use with any of the foregoing; electrical and electronic amusement apparatus; printed and electronic circuits for television and video game machines; computers; computer programmes; tapes, discs, cards, wire and filaments, all being magnetic or encoded and for bearing recorded data; hardware and firmware memory devices including plug-in cartridges; parts and fittings for all the aforesaid goods; all relating to or simulating the game of soccer.

On 30 November 1995 Forrester Ketley & Co, on behalf of the Football Association Premier League Limited filed Notice of Opposition to these applications. The grounds of opposition are, in summary:

1. Under Section 5(2) because the applicants’ trade mark is similar to the following trade marks of the opponent:

<u>No.</u>	<u>Trade Mark</u>	<u>Class</u>	<u>Goods</u>
1502029	PREMIER LEAGUE	28	Games and playthings; gymnastic and sporting

1502034

28



articles; all relating to Association football or The Football Association Premier League; all included in Class 28

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

2. Under Section 5(4)(a) because the applicants' trade mark is confusingly similar to the opponents' trade mark such that use by the applicants of their trade mark would be prevented by the law of passing off.
3. Under Section 3(6) because the applications were made in bad faith.

Both sides filed evidence and the matter came to be heard on 20 May 1999 when the applicants were represented by Mr Arthur Ashton, of Counsel, instructed by Marks & Clerk. The opponents' were represented by Mr Tom Moody-Stuart, of Counsel, instructed by Forrester Ketley, their trade mark attorneys.

Though these cases were not consolidated the same issues, the same evidence and the same considerations are involved. Hence, the deliberations and decision covers both applications.

Opponents' Evidence

This consists of a Statutory Declaration by Mr Richard Nicholas Parry dated 28 August 1996. Mr Parry is Chief Executive of the Football Association Premier League Limited. The facts contained in the declaration are from his own knowledge or from the opponents' records.

Mr Parry says that the intention to form the Football Association Premier League was announced in April 1991. There was significant media interest in the matter because it represented the biggest change in the structure of professional football for 100 years - a new Premier League comprising England's leading 20 clubs. Press cuttings from a number of newspapers and dated April 1991 are exhibited. It was decided later in 1991 to give this new league a separate personality through incorporation. This was because one of the aims of forming the new league was to generate increased revenue through sponsorship and licencing.

Mr Parry states that products were sold under the PREMIER LEAGUE and PREMIER LEAGUE & LION device trade marks by the opponents and examples the Premier League Year Book (15,000 copies sold in 1992/93) and an embroidered badge and lapel badge (10,000 sold in 1993/94). The trade marks have also been licenced by authorised users in respect of goods falling within Classes 9, 14, 16, 18, 25, 26, 28, 29, 32 and services falling within Class 41. Examples of licence agreements are exhibited.

Mr Parry goes on to state that he is unable to provide the turnover figures attributable to sales made under the above trade marks, but says that Mitre Sports Limited pays the opponent £300,000 to use them and to be allowed to provide footballs at all Premier League football matches. Smith Kline Beecham plc pay the opponent some £220,000 to use the trade marks on their products and to describe themselves as "official suppliers to the F.A. Premier League". Other examples are also provided by Mr Parry.

The opponents', says Mr Parry, do not themselves engage in advertising but as already exemplified the trade marks are promoted on others products. Finally, he states that he is not aware of any other person or entity entitled to use the PREMIER LEAGUE and PREMIER LEAGUE & LION device trade marks in the classes for which the opponents have licensed use. In his view any person seeing the applicants' trade marks would associate them with the opponents.

Applicants' evidence

This consists of Statutory Declarations by Thomas Farrand and David Robert Thompson. The Statutory Declaration by Mr Farrand is dated 14 April 1997. He is a registered trade mark agent with Marks & Clerk, the applicants trade mark attorneys.

Mr Farrand states that the only overlap between the applicants and the opponents trade marks is in respect of the word PREMIER. In his experience this word is in common usage as a laudatory or descriptive term in relation to all goods and services and in support of this provides the results of a search of the trade marks register which reveals 168 registrations (across a range of classes) which consist of or contain the word PREMIER. Further, he states that the opponents have no monopoly over the word PREMIER in relation to soccer and produces a copy of a page from The Independent on Sunday of 13 April 1997 which lists football results for the professional and leading part-time amateur leagues in England and Scotland. He draws attention to twelve leagues which incorporate the word PREMIER in their title.

Mr Farrand further declares that agreements exhibited by Mr Parry refer to “the F A marks” but the definition does not include the term PREMIER LEAGUE. It is Mr Farrand’s view that the term PREMIER LEAGUE is used descriptively throughout these agreements.

The Statutory Declaration by Mr Thompson was dated 14 May 1997. He simply exhibits a copy of a Statutory Declaration by Mr Akihiko Nagata of Konomi Co Limited dated 12 May 1997. Mr Akihiko Nagata is the Senior General Manager of the applicant’s Development Division; has access to the Company’s records and is conversant with the English language.

Mr Akihiko Nagata says the trade mark KONAMI PREMIER SOCCER has been used in the United Kingdom on coin operated video games since January 1993. The annual value of sales under the trade mark is £400,000 and they have been promoted and exhibited in trade publications (some of which are exhibited) and events. He is not aware of any instances of confusion between his company’s trade marks and those of his opponents.

Opponents’ evidence in reply

This consists of a Statutory Declaration dated 11 February 1998 by Peter Lawrence Oppenheim Leaver, of Queens Counsel, Chief Executive of the Association Premier League. Having read the applicants’ evidence he notes that the applicants’ use of their trade marks commenced after the introduction of the Premier League; the use shown is of the term PREMIER SOCCER and not KONAMI PREMIER SOCCER; the prominence given to the word PREMIER in the trade magazine exhibited by Mr Akihito Nagata leads, in his view, to an association with the Premier League.

Mr Leaver goes on to state that he is aware that there are other trade marks on the register which incorporate or consist of the word Premier. The opponents have, he says, opposed each application which appeared to take advantage of their trade marks. Insofar as the number of football leagues which incorporate the term ‘Premier’ Division, Mr Leaver considers that the public can differentiate between the PREMIER LEAGUE and other Premier Divisions.

Finally, he states that the term “FA Trade Marks” in the various agreements exhibited earlier refers to the Football Association Limited’s Trade Marks and not those belonging to the Football Association Premier League Limited.

That concludes my review of the evidence.

DECISION

The grounds of opposition are based first of all on Section 5(2) of the Act which states:

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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.

The term ‘earlier trade mark’ is defined in Section 6(1), which states:

6.-(1) In this Act an “earlier trade mark” means-

- (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.

The opponents registered trade marks are earlier trade marks under the provisions of 6(1)(a).

Both sides referred to the guidance provided by the European Court of Justice in the matter of confusion in the *Sabel BV v Puma AG* (1998 RPC 199) and *Canon Kabushiki v Metra Goldwyn Mayer Inc.* (1999 RPC 117).

The relevant sections of the first case are as follows:

Where it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion “depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified”. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - “... there exists a likelihood of confusion on the part of the public...” - shows that the perception of marks in the mind of the average consumer of

the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

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

and in respect of the second case the relevant statements are as follows:

19. It follows that, for the purposes of Article 4(1)(b) of the Directive, registration of a trade mark may have to be refused, despite a lesser degree of similarity between the goods or services covered, where the marks are very similar and the earlier mark, in particular its reputation, is highly distinctive.

22. It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar. Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar.

23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.

24. In the light of the foregoing, the answer to be given to the first part of the question must be that, on a proper construction of Article 4(1)(b) of the Directive, the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion.

26. There is a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive where the public can be mistaken as to the origin of the goods or services in question.

The opponents submitted that the trade marks the subject of the applications were confusingly similar to their earlier registrations in respect of both the trade marks and the goods covered by the specifications. In addition, because of the distinctive character of their trade marks and the reputation the opponents had in them through their licensing operations the likelihood of confusion was heightened. The applicants submitted that the respective trade marks were not

similar nor were the respective goods and that in any event the opponents reputation in the goods covered by the registration was not established.

First of all, insofar as the respective specification of goods is concerned, I have to hold that the goods covered by the specification of application number 1506370 (Class 28) is covered by the specification of the opponents' registrations; they are therefore the same goods. And taking into account their nature, end users and their method of use some of the applicants' goods covered by the specification of application number 1560369 (Class 9). In particular the electronic video games could be regarded as similar to those of the opponents in this case because each has restricted their specification to goods relating to soccer. I go on to consider the respective trade marks.

The applicants' trade mark consists of the words KONAMI PREMIER SOCCER whilst the opponents trade marks consists of the words PREMIER LEAGUE and those words together with the lion device. There are, in my view, some significant differences between the applicants' and the opponents' trade marks. The former consists of what appears to be an invented word (KONAMI) which could also be seen as a 'house mark' together with the words PREMIER and SOCCER, neither of which are particularly distinctive in character - the word PREMIER (as Mr Farrand points out in his evidence on behalf of the applicant) is either a laudatory or descriptive term and the word SOCCER relates to the goods. The opponents trade marks also contain the word PREMIER, which lacks distinctive character for the same reasons as before, and the word LEAGUE which, on the basis also of Mr Farrand's evidence, lacks distinctive character for any of the goods covered by the specifications. (I make no comment however on the combination of the two words). The second of the opponents' registrations contains, in addition to the words, the lion device.

Prima facie I do not believe that the public at large would be confused as to the origin of the goods if and when they encountered these trade marks. The word KONAMI is such a strong element in the applicants' trade mark that it is, I believe, the element which would be first seen and remembered. And because it is so striking by comparison with the less distinctive other elements (PREMIER AND SOCCER) and by comparison with both the opponents' trade marks. The trade mark KONAMI PREMIER SOCCER is not likely to be confused, in my view, with the opponents trade marks, even if as a result of the common element, the word PREMIER, a small number of people might recollect the opponents' trade mark if they saw the applicants' trade mark and vice versa.

That, however, is not the end of the matter because the opponents claim a reputation in their trade marks such that the likelihood of confusion between them and the applicants' trade mark is heightened. This stems from their licensing activities which extend well beyond the goods covered by their registrations. The applicants claim that the opponents' reputation is much more limited and that it relates only to its role as the organisers of the Premier League soccer tournament. And even if the licencing arrangements are taken into account their reputation extends only to videos (Class 9) and toy figures (Class 28) insofar as the registrations are concerned.

In CORGI 1999 RPC 549 Geoffrey Hobbs QC acting as the Appointed Person said:

"... I am not persuaded that it is right for the purposes of Section 5 of the Act to

assimilate objections based on an 'earlier trade mark' with objections based upon an earlier right protected by the law of passing off."

and

"I therefore consider that in a case where more than one objection has been put forward under Section 5 of the Act it is necessary to test each objection separately by measuring the evidence offered in support of it against the requirements of the statute."

Taking this into account it seems to me that in considering the opponents' objection under Section 5(2) and their claim to a reputation in their earlier trade marks such that the likelihood of confusion is heightened I must only consider the reputation insofar as it extends to the goods of their registrations (and the goods of the applications). In my view the opponents' evidence of a reputation insofar as the goods in Class 9 and Class 28 are concerned is negligible to say the least. There is no evidence of actual use or of reputation on the part of the opponents in relation to any of the goods of either of their registrations, apart from one area of Class 28 (on the assumption, as Mr Ashton pointed out that a licence covering amongst other things figures related to toys of some description). The Licences exhibited do not show that others have under the opponents' trade marks, been selling goods falling under the specifications of either of the two earlier trade marks. In the circumstances, I have to find that the opponents have not established a reputation in either of their trade marks in respect of any of the goods covered by these registrations such that my earlier findings that the respective trade marks are not similar should be put aside.

In reaching this view I have taken account of Mr Moody Stuart's submission that if a proprietor of a registered trade mark has a reputation for licensing, albeit not for licensing in relation to the goods covered by the registration, and that it has a reputation in respect of something connected with the applicants trade mark (in this case soccer) then those facts should be enough to establish reputation in the context of Section 5(2). I do not consider that they are. The mere fact that a proprietor grants licenses is not evidence that the public perceive that the proprietor has a reputation for licensing and on the evidence provided by the opponents I am unable to infer that. Also, the fact that the applicants have 'endorsed' others products ie 'Mitre' footballs and 'Lucozade' drinks does not add anything to the argument in support of a reputation in terms of the goods for which the opponents trade marks are registered.

In the circumstances, having considered the matter globally and all the factors placed before me I find that the applicants' trade mark is not confusingly similar to those of the opponents' trade marks and the opposition based upon Section 5(2) is dismissed.

I turn to the ground of opposition based upon Section 5(4) of the Act which states:

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

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

- (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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.”

No reference is made to any rule of law other than passing off. Mr Geoffrey Hobbs QC set out the basis an action for passing off in WILD CHILD Trade Mark 1998 RPC 455:

"A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd v Borden Inc [1990] RPC 341 and Erven Warnink BV v J Townend & Sons (Hull) Ltd [1979] ACT 731 is (with footnotes omitted) as follows:

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

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

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

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

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

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

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

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

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

The opponents must first of all establish that they have a reputation or goodwill. In my view they have done so insofar as the organisation and provision of premier league soccer for public entertainment is concerned. They have also established that they licence their trade marks but the evidence shows that this use is in the nature of endorsing products, and extends primarily to the lion device trade mark. These endorsements are in relation to goods which are both directly (footballs) and indirectly (non-alcoholic drinks) related to the services for which the opponents have an established reputation. However, in relation to all sporting activities it seems to me that it is in the nature of sponsorship, endorsement and licencing that they cover goods and services which need not be related to the actual sport or sporting event involved. Thus the opponents in this case can, it seems to me, reasonably claim that the respective fields of activities in which they and the applicants operate could be associated. It is not beyond the realms of possibility, for example, that the opponents would wish to endorse games and amusement arcade equipment which feature the game of soccer and involve matches between teams in the PREMIER LEAGUE. Thus a link between the applicants and the opponents activities can be established.

And if I was to compare the use of the opponents trade marks with notional use of the trade mark the applicants have sought to register that would be the case.

The next point to be determined is whether there is any similarity between the respective signs. I have already concluded under Section 5(2) that the respective trade marks (as applied for and as registered) are not similar. Thus there should be no different finding under Section 5(4). However, in this case I have the benefit of some evidence of claimed use by the applicants of their trade mark in the publication exhibited by Mr Nagata. This shows that the trade mark actually promoted by the applicants is PREMIER SOCCER, the word KONAMI is not shown alongside or in close proximity to the other words, see below.

**NEW
PCB**

**PREMIER
SOCCER**

**Watch your earnings
shoot to the top of
the league with this
blockbusting
football game**

KONAMI (UK) LIMITED
Television House, 269 Field End Road,
Eastcote, Ruislip, Middlesex,
England HA4 9LS.
Tel: (+44) 081-429 2446.
Fax: 081-429 2069.
Telex: 883978 KONAMI G

Thus it seems to me that I should undertake a comparison between the trade mark the applicants say they have used (PREMIER SOCCER) and the trade mark actually used by the

opponents, (the words PREMIER LEAGUE together with the lion device).

In my view there is a similarity in that each contains the word PREMIER as a dominant element (on the basis that words speak louder than devices) and the second word in the respective trade marks is associated with the game of association football. Indeed, it seems to me that if members of the general public who were familiar with the game of football and the PREMIER LEAGUE were to come across the applicants' trade mark (used in the form shown in the publication) then they would be given cause to wonder if the goods were connected with or endorsed by the opponents. In reaching this view I take account of the submissions made to me in relation to *The European v The Economist Newspapers Ltd* 1989 ETMR 307 and *GRANADA* 1979 RPC 303, the latter in relation to disclaimed matter in the opponents' trade marks. In the *European* case Millett L J said:

"Similarity is a matter of degree; and except in the case where there is absolutely no similarity between sign and mark (which is not this case) the question is whether similarity is such as to be likely to cause confusion in the mind of the public. A degree of similarity is tolerable; the question is whether there is confusing similarity."

Although that dealt with a matter of infringement the same considerations apply here. In this case too the respective trade marks are similar and there will be occasions when on seeing one the other will be recalled and vice versa. But in the final analysis there are sufficient differences in the trade marks, principally the lion device in the opponents trade mark which in practice is always used together with the words PREMIER LEAGUE on the endorsed goods, to ensure that actual confusion or misrepresentation is unlikely.

Insofar as damage to the opponents is concerned I have had no evidence placed before me on that point. I am unable to infer therefore what if any damage might be caused to the opponents by the applicants use of the trade mark in suit.

Taking into account all of the factors set out above I have to hold that the opponents have not established that they would succeed in an action for passing off or that the necessary elements for such an action are present in this case. The opposition founded on Section 5(4)(a) is therefore dismissed.

Finally, the opponents have included in their grounds of opposition bad faith under Section 3(6) which reads:

"(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith."

There is no evidence, in my view to support this and the opposition on this ground is dismissed.

As the applicants have been successful they are entitled to a contribution towards their costs.
I order the opponents to pay to the applicants the sum of £500 in respect of each application a
total of £1,000.

Dated this 27th day of August 1999

M KNIGHT
For the Registrar
the Comptroller General