

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2159232
TO REGISTER A TRADE MARK:
IN CLASSES 24, 25 and 26**

**AND IN THE MATTER OF
OPPOSITION THERETO UNDER No 50199
BY THE LIVERPOOL FOOTBALL CLUB
AND ATHLETIC GROUNDS PLC
TRADING AS
LIVERPOOL FOOTBALL CLUB**

Background

1. On 24 February 1998 Dig Souvenirs Limited of 76 Hamilton Road, Motherwell, ML1 3BY applied to register the trade mark:

**YOU'LL NEVER WALK ALONE BY DIG
SOUVENIRS**

in respect of the following goods:

- | | |
|----------|--|
| Class 24 | Pennants; banners and flags |
| Class 25 | Scarves, hats, anoraks, tracksuits, vests, singlets, shorts, briefs, shirts, jerseys, football boots, sports footwear, caps, gloves, ties, stockings and socks; all included in Class 25 |
| Class 26 | Club badges; festival badges; all included in Class 26 |

2. On 23 September 1999 The Liverpool Football Club and Athletic Grounds Plc trading as Liverpool Football Club filed notice of opposition to this application.

3. The opponents stated that they are the registered proprietor of United Kingdom trade mark registration no 1462263. Details of this registration, which is for a series of two marks, is attached at Annex A.

4. Registration No 1462263 is registered for the following goods:

- | | |
|----------|---|
| Class 03 | Soaps, perfumes, cosmetics, hair lotions, shampoos, dentifrices; all included in Class 3. |
| Class 14 | Medallions and brooches, all made of precious metals; watches and clocks; all included in Class 14. |

- Class 16 Stationery, photographs, posters, ordinary playing cards, autographs, sheets, binders (stationery), car stickers, writing implements, printed matter, printed publications, albums, diaries, calendars and books; all included in Class 16.
- Class 18 Articles made of leather or of imitation leather; wallets, articles of luggage; holdalls, duffel bags; all included in Class 18.
- Class 20 Mirrors; picture frames, furniture, pennants, key fobs, all being made of plastics material; all included in Class 20.
- Class 21 Brushes, glassware, porcelain and earthenware; all included in Class 21.
- Class 24 Textile articles; table linen; bed linen; blankets; all included in Class 24.
- Class 25 Scarves, hats, anoraks, tracksuits, vests, singlets, shorts, briefs, shirts, jerseys, football boots, sports footwear, caps, gloves, ties, stockings and socks; all included in Class 25.
- Class 26 Club badges; festival badges; all included in Class 26.
- Class 27 Carpets, rugs, mats and matting; wall hangings; all included in Class 27.
- Class 28 Toys, games, playthings, jigsaw puzzles; sporting and gymnastic articles; all included in Class 28
- Class 33 Alcoholic beverages; all included in Class 33.

5. The opponents claim that the respective trade marks are similar and encompass identical or similar goods; consequently registration of the application in suit would be contrary to Section 5(2)(b) of the Act. The opponents also state that they have made significant use of their earlier registrations and that these trade marks have acquired goodwill in the United Kingdom. Consequent upon this they believe that registration of the application in suit is liable to be prevented by the law of passing off and so would be contrary to Section 5(4)(a) of the Act.

6. The applicants filed a counterstatement denying the above grounds and seeking an award of costs.

7. Only the opponents filed evidence. Both sides agreed that a decision could be made on the basis of the papers filed. Consequently a decision will be taken from a careful study of the papers.

8. Acting on behalf of the Registrar I duly give the following decision.

Opponents' evidence

9. The opponents' evidence consists of a Witness Statement dated 5 February 2001 by Mr Richard Parry. Mr Parry is the Chief Executive of The Liverpool Club and Athletic Grounds Plc, the

opponents in this matter. He further states that he is authorised to make this statement on their behalf and that the information contained within this statement has been obtained from company records or his personal knowledge.

10. At Exhibit RP1 Mr Harris provides details of registered trade marks, in the name of the opponents, which incorporate the words YOU'LL NEVER WALK ALONE.

11. At Exhibit RP2 Mr Harris provides details from various web sites which, he submits, demonstrates that the words YOU'LL NEVER WALK ALONE immediately identifies Liverpool Football Club.

12. At Exhibit RP3 Mr Harris exhibits extracts from the Liverpool Football Club's official web site which provide information on the relevance of The Shankly Gates and information relating to the Hillsborough disaster on 15 April 1989. Also exhibited are a video cassette entitled Inside Liverpool and a compact disc entitled The Liverpool Way.

13. Exhibit RP4 features a recording of a radio programme broadcast on 14 January 2001 concerning the appropriation, by the opponents, of the song titled YOU'LL NEVER WALK ALONE.

14. Exhibits RP5 and RP6 demonstrate use of the opponents' trade marks.

15. At Exhibit RP7 is a copy of the Times newspaper dated 25 January 2001.

16. Further evidence is provided by way of Witness Statements from representatives of other football clubs based in the United Kingdom. These are from Andrea Murphy of Manchester United Merchandising Limited, John Hazell of Arsenal FC, Claire Lait of Chelsea Football Club, Louise Carter of Leeds United Football Club and Kate Bouchard of West Ham United who all state that if they saw the words YOU'LL NEVER WALK ALONE BY DIG SOUVENIRS on goods such pennants, clothing or badges they would assume that the goods would either come from or were authorised by Liverpool Football Club. These statements were provided in response to a direct inquiry from W P Thompson & Co, the opponents' trade mark attorneys. Details of this exchange of correspondence are provided with the statements.

Applicants' evidence

17. The applicants did not file any evidence in support of this application.

Written submissions

18. Written submissions were received from the opponents, I will refer to these as and when it is necessary during the course of this decision.

Decision

19. The grounds of opposition pursued by the opponents are those under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994. The relevant provisions read as follows:

Section 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.

(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....

20. The term 'earlier trade mark' is defined in section 6 of the Act as follows:

"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."

Section 5(2)(b) objection

21. In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] 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* page 224;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224; 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 Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, 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* page 224;

(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* page 224;

(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* page 7, 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* page 8, 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* page 224;

(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* page 732, paragraph 41;

(i) but if the association between the marks causes 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* page 9 paragraph 29.

22. It is clear that the opponents and the applicants have specifications in Classes 25 and 26 which are identical. It is also clear that the applicants' specification in Class 24 is completely covered by the term "Textile articles" in the opponents' specification in Class 24. I consider that the specifications encompass identical goods.

23. However, it is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of the goods is but one aspect to be considered. Due regard must be given to the closeness of the respective marks, the reputation the earlier mark enjoys in respect of the goods for which it is registered, and any other relevant factors.

24. The words YOU'LL NEVER WALK ALONE are common to both the applicants' mark and the opponents' marks. However, in both cases they are always with other matter.

25. The opponents' marks consist of the devices of crests together with several additional features. Both of the opponents' marks contain the words LIVERPOOL FOOTBALL CLUB together with the words YOU'LL NEVER WALK ALONE. One of the marks contains the additional elements 100 YEARS and 1892 - 1992.

26. The applicants' mark consists of the words YOU'LL NEVER WALK ALONE together with the additional words BY DIG PRODUCTIONS.

27. Visually the marks differ considerably. In my view the dominant feature of the opponents' marks are the words LIVERPOOL FOOTBALL CLUB. Although the words YOU'LL NEVER

WALK ALONE appear towards the top of the marks it is smaller in size and far less prominent. Also, whilst I accept the dictum that “words speak louder than devices”, it is clear that there is a considerable amount of additional matter in these marks which make up the device element.

28. When considering the aural features of the marks it is obvious that both marks contain the words YOU’LL NEVER WALK ALONE. However both marks contain additional matter.

Conceptually I find the marks to be quite different. The opponents’ marks consist of crest devices which appears as emblems of Liverpool Football Club whilst, at the same time, containing the words YOU’LL NEVER WALK ALONE. On the other hand the applicants’ mark consists of the words YOU’LL NEVER WALK ALONE together with the additional words BY DIG PRODUCTIONS.

29. Ordinarily I would also consider whether the opponents’ marks have a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of them. However, no such evidence has been filed. In such circumstances the opponents’ marks cannot be regarded as enjoying an above average reputation at the relevant date. I must also take into account the dictum of imperfect recollection.

30. In my view the words YOU’LL NEVER WALK ALONE cannot be said to be a dominant feature of these marks in suit. Whilst I accept that it is clearly common to all marks I must consider the marks in their totality. Taking account of all of these factors I conclude that whilst the goods in question are identical this is more than offset by the differences between the marks. With all of these factors in mind I conclude that, when all factors are considered, there was no realistic likelihood of confusion at 25 February 1998. Consequently the opposition under Section 5(2)(b) of the Act fails.

31. I next consider the objection under Section 5(4)(a) of the Act.

32. In deciding whether the trade mark in question offends against this Section of the Act I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC in the *Wild Child case (1998) 14 RPC 455*. In that decision Mr Hobbs stated that:

"The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art. 4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off".

"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."

33. The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. It is clear from Article 4(4)(b) that the earlier right had to have been "acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed". The relevant date is therefore the date of the filing of the application in suit.

34. It is claimed that the public would be confused as to the source of the applicants' goods believing them to originate from the opponents.

35. The opponents possess thirty three registered marks which incorporate the words YOU'LL NEVER WALK ALONE. All are in the form of a crest device together with other words and numerals. It is my view that in none of these registered marks are the words YOU'LL NEVER WALK ALONE more prominent than in the mark of registration No 1462263 shown at Annex A. All of the exhibits filed in support of this opposition demonstrate use of the words YOU'LL NEVER WALK ALONE as a component in a composite badge which is the crest of Liverpool Football Club. The evidence refers me to the adoption by the supporters of Liverpool Football Club of the song entitled YOU'LL NEVER WALK ALONE . Apart from its presence in the "Shankly Gates", there is no evidence at all that the opponents' use the words YOU'LL NEVER WALK ALONE solus. In the circumstances I am not satisfied that their case for goodwill or reputation has been made out. As I have already held that the respective trade marks are not confusingly similar it follows that there is unlikely to be any misrepresentation by the applicants's use of their trade mark such to lead the public to believe that the goods offered under it are the goods of the opponents. Thus there is unlikely to be any damage to the opponents. In the circumstances, the ground of opposition based upon Section 5(4)(a) is also dismissed.

36. As the opponents have failed, the applicants for registration are entitled to a contribution towards his costs and I therefore order them to pay him the sum of £ 335. This sum is 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 20th day of December 2001

A J PIKE
For the Registrar
the Comptroller-General

ANNEX A

