

O-755-18

TRADE MARKS ACT 1994

**IN THE MATTER OF THE APPLICATION UNDER NO. 3234847
BY LEEDS CITY FOOTBALL CLUB LIMITED
TO REGISTER AS SERIES OF TWO TRADE MARKS:**



IN CLASSES 16, 25, 26 AND 41

AND

**IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 410325
BY LEICESTER CITY FOOTBALL CLUB LIMITED**

BACKGROUND AND PLEADINGS

1. On 1 June 2017, Leeds City Football Club Limited (“the Applicant”) applied to register, as a series of two, the figurative trade marks shown on the front page of this decision, which bear the text “LCFC – Leeds City Football Club”. The application is in respect of the following goods and services:

Class	Applicant’s goods and services
16	Printed matter; photographs; stationery; instructional and teaching material
25	Clothing, footwear, headgear
26	Badges for wear, not of precious metal
41	Education; providing of training; entertainment; sporting and cultural activities

2. The application was published for opposition purposes in the Trade Marks Journal on 23 June 2017 and is opposed by Leicester City Football Club Limited (“the Opponent”). The opposition is based on four grounds under the Trade Marks Act 1994 (“the Act”), namely: sections 5(2)(b), 5(3), 5(4)(a) and 3(6), each ground directed against the application in its entirety.
3. For its claims based on sections 5(2)(b) and 5(3), Opponent relies on its ownership of a UK trade mark registration (No. 2251624) for the word mark “LCFC”. The Opponent’s mark is registered in a total of twenty classes, but it relies only on its registration for the following goods and services:

Class	Opponent’s goods and services
16	Printed matter; printed publications; books, magazines, programmes, albums, diaries and calendars; book markers, greeting cards, wrapping paper, playing cards, place mats and beer mats; photographs, posters and pictures; paper, writing implements, drawing implements and pencil cases; gift vouchers; instructional and teaching materials
25	Clothing, footwear and headgear
26	Non-precious badges; rosettes
41	Organization of sporting events, competitions, games, shows, parties and conferences; presentation of live performances; physical education; sports tuition and training; provision of sporting and recreation facilities; management

	of sports facilities; rental of sports equipment and stadium facilities; information relating to sports entertainment or education provided on-line from a computer database or the Internet
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4. The Opponent applied for its mark on 4 November 2000. The Opponent's is therefore an earlier mark as defined in section 6 of the Trade Marks Act 1994 ("the Act"). The earlier mark completed its registration process on 20 April 2001 when it was entered in the register. The notice of opposition included a statement of use confirming to the effect that the earlier mark has been used (for all its goods and services) in the five-year period ending on the date of publication of the opposed trade mark.

Section 5(2)(b) claim

5. The Opponent puts its case under section 5(2)(b) of the Act as follows: The Application is *"for what would be recognised by most average consumers to be a typical football club crest. This is because the trade mark comprises animals on each side of a shield device with a football located directly above the shield. The average consumer would pay little attention to the specific animals other than recognising they are indicative of a typical football club crest. The shield contains the prominent letters LCFC and a white star. A banner at the bottom of the device contains the words "Leeds City Football Club". These words are in a much smaller font than the letters LCFC contained within the shield and, on that basis, are unlikely to be read. The dominant verbal part of the trade mark are the letters LCFC. For all relevant goods and services, the average consumer would likely pay no more attention than recognising that this trade mark is a typical football club crest for a team "LCFC". That is, the dominant element of this trade mark are the letters LCFC, the remaining elements doing little more than providing a generic indication that the letters LCFC relate to a football club."*

Section 5(3) claim (reputation)

6. The Opponent's claim under section 5(3) of the Act is that its earlier mark has a reputation such that use of the Applicant's mark for any or all of the goods or services in the application would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark. The grounds are particularised to include, among other things, a claim that the application is calculated to *"ride on the coat-tails of the Opponent's reputation in the*

trade mark LCFC in order to benefit from the power of attraction, the reputation, prestige, and the success associated with the trade mark LCFC without having to expend any effort building their own reputation in a trade mark". The particulars also allege that the Applicant is seeking to *"dilute the reputation of the trade mark, such that members of the general public may no longer immediately automatically recognise that the trade mark LCFC relates to the Opponent, but that it may relate to a football club from any city beginning with "L" e.g. Liverpool City, Lancaster City, Lichfield City, London City, Lisburn City, or Lichfield City"*.

Section 5(4)(a) claim (passing off)

7. The Opponent's claim under section 5(4)(a) of the Act is that the use of the Applicant's trade mark would be contrary to the law of passing off, relying on its claimed unregistered rights in the sign "LCFC", which it claims to have used throughout the UK since 2003 in relation to *"goods and services including, but not limited to: Printed matter, photographs, stationery, instructional and teaching material; clothing, footwear, headgear; badges for wear, not precious metal; and education; provision of training; entertainment; sporting and cultural activities."* The Opponent claims to have *"a massive reputation in the name LCFC and substantial goodwill, that reputation and goodwill being extensive and extending throughout the UK for all relevant goods and services."*

Section 3(6) (bad faith)

8. The Opponent's claim under section 3(6) refers to pre-application correspondence from the Applicant in which the Applicant's admission that its applied-for mark is a redesign of the original Leeds City Football Club badge, once used by the now defunct club of that name (1914-18). The historic badge had been the Coat of Arms of the city of Leeds, changed only to replace the city's Latin motto with the letter LCFC. The Opponent notes that the Applicant's redesign removes some original elements, introducing a single star in place of three, and increasing the size and prominence of the letters LCFC. The Opponent claims that *in the absence of any explanation to the contrary, it can only be assumed that the Applicant has redesigned the badge solely in order to produce the results set out above [as to riding coat-tails etc under section 5(3)]. In particular, they wish to obtain a registration of a football crest that prominently includes the letters LCFC. There is no reason why they could not have retained the original Leeds City football badge. Further, there is no good reason why the letters LCFC need to be so centrally and prominently displayed.*

9. The Opponent also claims that the date of the application indicates bad faith, since it was filed relatively shortly after the Opponent's Premier League triumph and significant exposure in the Champions League and the modification to include the letters LCFC "cannot be a coincidence".
10. The Opponent states that it can find no details of any football club associated with the Applicant and whilst there is a currently existing Leeds City Football Club it operates with a different crest from that applied for by the Applicant, which does not include the letter LCFC and does not conflict with the Opponent's trade mark registration. The Opponent doubts that the application is for the crest of a genuine football club. It describes the fact that the Applicant's is purportedly based on a genuine historic football crest of a team with the initials LCFC as "*a veneer of respectability*", which falls away in light of the changes made to the historic crest.

The Applicant's defence TM8

11. The Applicant submitted a Form TM8 notice of defence, including a counterstatement denying all the grounds. The Applicant marked its Form TM8 to indicate that it does not put the Opponent to proof of use of in respect of the earlier mark relied on by the Opponent under the section 5(2)(b) and 5(3) claims.
12. In respect of the section 5(2)(b) ground, the Applicant stated: "*The Crest (Badge) is clearly unique to Leeds City Football Club and bears no resemblance to [that of] any other football club, other than the historic continuance of similar Crests (Badges) depicted or used by other Football Clubs from Leeds since early 1900 (as far as we are aware)*".
13. In respect of the section 5(3)(b) ground, the Applicant stated: "*The Crest (Badge) ... has been in use since 1988 for goods and services used in classes 16, 25, 26 and 41*". In respect of the section 5(4)(a) ground, the Applicant stated: "*The Crest (Badge) ... has evolved from the previous use of very similar Crests (Badges) from the year we affiliated in 1988 (resembling the Leeds Coat of Arms Crest) that was also used by predecessors including Leeds City FC between the years 1904 to 1919) and Leeds United since 1920. It is our understanding that the opponents are known to be called the Foxes as depicted in their Football Crest (Badge) that has no resemblance whatsoever to the Owls as displayed on*

the Leeds City Football Crest (Badge) or any other football clubs from Leeds West Yorkshire”.

14. In respect of the section 3(6) ground, the Applicant stated that the Opponent’s claim was misleading and the Applicant enclosed with its Form TM8 various documents intended to show the previous existence of crests similar to the applied-for mark, and historical references to the Leeds City Football Club, including its topping a lower division in 1993-4.

Papers filed and representation

15. The Opponent is represented by Serjeants LLP. In addition to the statement of grounds in its notice of opposition (Form TM7), the Opponent filed evidence during the evidence rounds. Neither party requested a hearing, and Opponent filed written submissions in lieu of an oral hearing.
16. The Applicant has no professional representatives in this matter. When the Applicant filed its notice of defence and counterstatement it included materials of an evidential nature, which were inadmissible for lack of the required legal format. The Applicant subsequently filed evidence that was admitted into the proceedings.
17. To the extent I consider necessary or helpful, I include below a summary of the evidence filed by the parties. I also note that the Applicant filed submissions in lieu of an oral hearing, but those materials were filed a week or so after the deadline set by the Registry. The Opponent has requested that the Applicant’s submissions not be admitted. I will deal that request as a preliminary matter below.

PRELIMINARY MATTER – the Applicant’s late filed submissions

18. The Applicant was late in filing its submissions in lieu of a hearing, thereby having the advantage of having had sight of the submissions filed (on time) by the Opponent. In its letter to the Registry requesting that the Applicant’s submissions not be admitted to proceedings, the Opponent referred to guidance by the Supreme Court¹ in relation to the Civil Procedure Rules and the limited indulgence to be afforded to a litigant in person. While

¹ At paragraph 18 of *Barton (Appellant) v Wright Hassal LLP* [2018] UKSC 12 (21 February 2018).

I note the Opponent's objection, a different set of rules governs proceedings before the Tribunal², and, moreover, having read the late submissions, I find no significant disadvantage in fact arises. However, I also note that late filed materials include much that is of a factual nature. Such material is not only not presented in the proper format for evidence, but no leave to file late evidence was sought. I therefore admit into the proceedings the Applicant's late filed submissions to the extent that they are such i.e. are submissions of argument, but I exclude the material therein that may be construed as evidence.

EVIDENCE SUMMARY

The Opponent's evidence

19. During the evidence rounds the Opponent filed evidence in support of its objections under sections 5(3) and 3(6). Since the Applicant did not request proof of use of the Opponent's earlier registration, the Opponent filed no evidence or further submissions in support of its objection under section 5(4)(a) (passing off).
20. The Opponent's evidence objection consisted of two **Witness Statements by Timothy Paul Cadman**, the first dated 5 March 2018, the second 6 March 2018. Mr Cadman is a Trade Mark Attorney at the Opponent's legal representatives.
21. The **first Witness Statement** is filed in support of its **section 5(3) objection**, along with **Exhibits TC1 to TC7**, to illustrate the Opponent's reputation, which, the Opponent contends, resides equally in the names Leicester City and LCFC. The evidence emphasises the Opponent's unanticipated victory in the Premier League. Exhibits TC1 – TC4 show the earlier mark as underpinning the handles / usernames of the Opponent's Twitter, Instagram and Facebook accounts - and that its social media subscribers number in the millions. Exhibit TC5 shows the earlier mark fronting the open-top buses carrying the team on a victory parade in May 2016, which the BBC coverage states was attended by "more than 240,000" people. The mark is also displayed on large screens either side of the stage during the same celebrations. The Opponent claims that its success as a football club demonstrates reputation in the earlier mark for (at least most of) the services in class 41

² Trade Marks Rules 2008

and that the relevant goods are all goods typically sold by a football club. Exhibit TC7 shows various of the relevant goods offered for sale under the earlier mark via the Opponent's shop at LCFC.com.

22. The **second Witness Statement** is filed in support of its **section 3(6) objection**, along with along with **Exhibits TC8 to TC10**, to claim that the Applicant made its application in bad faith. Mr Cadman's evidence includes submissions commenting on the materials of an evidentiary nature that the Applicant filed early in the process. Mr Cadman comments that there is no evidence that the club to which the Applicant's mark relates has played a match since 1994, when it played in Division 3 of the West Yorkshire Association Football League. Mr Cadman comments that it is not normal for a club at such a low tier to have a trade mark registration or to sell merchandise. He claims that no badge of the club has ever previously included "LCFC" – only LCAFC or Leeds City Football Club, LC etc. He notes that the website³ of Leeds City Football Club is currently little more than a holding page, showing no players, results or merchandise. He also notes that Mr Roy Dixon (of the Applicant) is the director of several separate companies⁴ that have a name based on Leeds City (A)FC or similar, each incorporated on or after 2003. The witness submits that this is "unusual behaviour" for a person purporting to operate a low-level team "in a good faith manner".

The Applicant's evidence

23. The Applicant filed evidence admitted into the proceedings comprising a **Witness Statement by Roy Dixon** dated **22 January 2018**, along with **Exhibits RD1 to RD12**. A second **Witness statement** by **Roy Dixon** dated **6 May 2018**.
24. The evidence shows: various incarnations⁵ of a Leeds City football club, through Press clippings from the late 1980s; their topping Division 3 of the West Yorkshire Association Football League in 1993-94 season; that R Dixon, of Dixon Properties appeared to sponsor Leeds City AFC (under a similar mark to that applied for, including the letters "LC"), although the date is not clear; correspondence dated December 3 1998 (**Exhibit RD4**) on headed paper from West Riding County Football Association showing that Mr Roy Dixon was registered as a referee for season 1998/99 and that Leeds City FC was affiliated for the

³ Exhibit RD9 of the Applicant's evidence below.

⁴ Exhibit TC10 is a print-out from Companies House to this end.

⁵ Including as White Star Football Club

same season. (Mr Dixon's second Witness Statement explains affiliation as a necessary step to take part in football matches.) **Exhibit RD11** shows an image of a badge, and although its source is not entirely clearly, it is marked as dating from 1917, and includes the three owls of the Leeds City Crest, together with the letters LCFC. **Exhibit RD12** shows the registration at Companies House in 2003 of the Applicant company of which Mr Dixon is a director. Paragraph 8 of Mr Dixon's second Witness Statement states that the Applicant "would consider contesting the opponent's use of the initials LCFC should they use them [...] to refer directly to Leeds City Football Club" to cause harm to the Applicant. The Opponent takes issue with this in its submissions as to bad faith.

DECISION

The section 5(2)(b) ground

25. Section 5(2)(b) of the Act, reads as follows:

"5. – [...]

(2) A trade mark shall not be registered if because – [...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

26. I note that the Applicant, without legal representation in these proceedings, tends to emphasise that its applied-for mark is unlikely to be confused with the football crest or name of the Opponent. It is vital to understand that the assessment of a likelihood of confusion under section 5(2)(b) focuses on the degree of similarity between the parties' respective goods and services (as set out in their specifications) and on the similarity of the parties' respective marks, all viewed from the perspective of a notional average consumer.

27. Determination of a section 5(2)(b) claim must be made in light of the following principles, which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-

120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P. The principles are:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

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

Comparison of the goods and services

28. Since the Applicant chose⁶ not to put the Opponent to proof of use, the Opponent is consequently able to rely on all the goods and services on which it relies under its earlier mark, with no obligation to show that the mark has been used. The goods to be compared are:

Applicant's goods	Opponent's goods
Class 16: Printed matter; photographs; stationery; instructional and teaching material.	Class 16: Printed matter; printed publications; books, magazines, programmes, albums, diaries and calendars; book markers, greeting cards , wrapping paper, playing cards, place mats and beer mats; photographs , posters and pictures; paper, writing implements, drawing implements and pencil cases; gift vouchers; instructional and teaching materials
Class 25: Clothing, footwear, headgear	Class 25: Clothing, footwear and headgear
Class 26: Badges for wear, not of precious metal	Class 26: Non-precious badges; rosettes
The parties' specifications in Classes 16, 25 and 26 are essentially identical. They include identical terms and although the Opponent's specification in Class 16 does not use the term "stationery", it does include "greeting cards" and "paper", which are examples of stationery. It is clear from case law such as <i>Meric</i> ⁷ that goods can be considered as	

⁶ (as indicated by its response to question 7 in its Form TM8)

⁷ See paragraph 29 of the judgment of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, Case T- 133/05

identical when the goods designated by the earlier mark are included in a more general category designated by the trade mark application or vice versa.

29. The services to be compared are:

Applicant's services	Opponent's services
<p>Class 41: Education; providing of training; entertainment; sporting and cultural activities</p>	<p>Class 41: Organization of sporting events, competitions, games, shows, parties and conferences; presentation of live performances; physical education; sports tuition and training; provision of sporting and recreation facilities; management of sports facilities; rental of sports equipment and stadium facilities; information relating to sports entertainment or education provided on-line from a computer database or the Internet</p>

30. The Opponent submits that “*the services in class 41 are at least highly similar, generally relating to the provision of services relating to sporting and cultural activities*”. I note too that the Applicant makes no points to contest the similarity between the parties’ goods or services. In considering the extent to which there may be similarity between goods, I take account of factors such as⁸ those identified by the Court of Justice of the European Union (“the CJEU”) in *Canon*⁹ where it states that:

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

31. I find that the services may, on the basis of the principle in *Meric*, be considered identical, or else are highly similar on the basis of relevant factors such as the nature and purpose of the services and the respective users of the services.

⁸ I also note the description of “complementary” in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, and note too the relevant factors for assessing similarity (such the respective users of the services) identified by Jacob J (as he then was) in *British Sugar PLC v James Robertson & Sons Ltd* [1996] R.P.C. 281

⁹ Case C-39/97, at paragraph 23.

The average consumer and the purchasing process

32. It is necessary to determine who is the average consumer for the respective goods and how the consumer is likely to select the goods. It must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question¹⁰. In *Hearst Holdings Inc*,¹¹ Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect ... the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical... [it] does not denote some form of numerical mean, mode or median.”

33. In respect of the goods at issue, the average consumer in this case will be a member of the general public, who will purchase the goods through shops (or stalls) or via the internet. They will see the marks used on the goods as labelling or branding or in advertising, where a consumer will peruse shelves and browse the internet to select the goods. Therefore, I consider the purchase to be a primarily visual one¹², but aural considerations may also play a part, such as on the basis of word of mouth recommendations, so I also take into account the aural impact of the marks in the assessment. The level of attention of the average consumer in selecting and buying the goods specified in this case will not be above normal – the average consumer will pay a medium or ordinary level of attention.
34. In respect of the services at issue, the average consumer of the services will include members of the general public, who will want to access information on and attend or take part in sporting and cultural activities and training. Some of the services may also be of interest to businesses, such as *management of sports facilities* and *rental of sports equipment and stadium facilities*. The services will also be selected by primarily visual

¹⁰ *Lloyd Schuhfabrik Meyer*, Case C-342/97

¹¹ *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch),

¹² See paragraphs 49 and 50 of the judgment of the General Court in *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03.

means, the average consumer searching online or seeing the mark in directories or other advertising materials, although again aural considerations may also play a part. The services are not everyday purchases and entail considerable cost, so the level of attention of the average consumer in selecting and buying the services specified is likely to be above normal.

Distinctiveness of the earlier mark

35. The distinctive character of the earlier mark must be assessed, as the more distinctive the earlier mark, either inherently or through use, the greater the likelihood of confusion (*Sabel* at [24]). In *Lloyd Schuhfabrik*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

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

36. The Applicant’s arguments include the point that there are various football clubs whose initials are the same as the Opponent’s earlier mark. That point could be understood as a claim that the earlier mark is non-distinctive. However, if that is the Applicant claim, it is not

open to me to make that finding as a registered trade mark must be assumed to have at least some distinctive character¹³.

37. On the one hand, the Opponent's earlier mark is nothing more than the four letters "LCFC", which may be seen to carry no descriptive connotation for the goods at issue or services at issue (since there is no obvious connection between those letters and, for example, clothing or greetings cards). Viewed that way, the earlier mark is inherently distinctive to a normal degree.
38. However, on the other hand, a significant proportion of those who constitute the notional average consumer in this case will understand that the letters "FC", which form the second half of the Opponent's, commonly stand for "football club". That perception of the mark will be all the more likely in relation to the goods and services at issue insofar as they relate to football (including, for example, the Class 41 rental of stadium facilities). In that regard, the effect may be to reduce the level of inherent distinctiveness of the earlier mark.
39. The level of inherent distinctiveness of a trade mark may be enhanced through use in the UK. The Opponent made no express claim to enhanced distinctiveness of its earlier mark under its section 5(2)(b) ground and the Opponent was not put to proof of use of its mark, so it filed no evidence to those ends. The Opponent did file evidence to support its claim to a reputation under section 5(3), including screenshots of the mark displayed prominently at the celebrations of the Opponent's recent football Premiership victory and as the basis for social media communications. While I note the evidence filed, I make no finding as to whether the Opponent's earlier mark has gained enhanced distinctiveness for its goods and services for the purposes of its section 5(2)(b) claim. That said, it seems to me that if the mark has been enhanced through use, such enhancement would operate essentially in the context of football (as opposed to, say, clothing at large), in which case the enhancement may serve to do little more than offset the effect of the reduction in the mark's inherent distinctiveness arising from the prevalent use of "FC" by other football clubs. At any rate, I consider that in this instance that there is no benefit to the Opponent were I to find that its earlier mark has an enhanced distinctiveness through its use.

¹³ See the CJEU *Formula One Licensing BV v OHIM*, Case C-196/11P, at paragraphs 41-44.

Comparison of the marks

40. It is clear from *Sabel* that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo* that: “....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”
41. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are shown below:

Applicant’s contested series of trade marks	
	
Opponent’s earlier trade mark:	LCFC

42. The Applicant’s marks are alike, except that one is in colour, the other black and white. In considering the overall impression of the mark, one is struck by a number of elaborate

elements, especially the presence of birds, a football, a shield bearing a white star and the letters LCFC (in upper case). One can also see, although the font size is small, the words “Leeds City Football Club”. I find that the device elements are important in the overall impression of the mark, but the average consumer is likely to perceive and refer to the mark by a pronounceable component. Given the central position within the mark of the letters LCFC and their relative font size, I find that the average consumer will more readily perceive those letters than the smaller words that sit at the bottom of the mark. I find it likely that the average consumer – or certainly a substantial proportion of that notional consumer base – will perceive and refer to the mark as an LCFC badge/crest or mark. Given the presence of the football, the mark will likely be perceived as an LCFC badge.

43. As to the Opponent’s mark, its overall impression rests solely in the four letters, presented in upper case, with no stylistic embellishment or device. The letters have no single clear significance, but many of those who make up the average consumer will understand the letters “FC” to refer to a football club.

Visual similarity

44. The marks differ notably in that the Applicant’s mark has large and striking device elements, entirely absent from the Opponent’s earlier mark. However, the Opponent’s earlier mark features in its entirety in the Applicant’s mark, occupying a central and striking position. Taking account of the overall impressions of the marks I find them visually similar to a medium degree.

Aural similarity

45. Since the device elements present in the Applicant’s mark (the birds, shield, star etc) are not spoken, they play no part in an assessment of aural similarity. The marks may both be referred to as LCFC marks, and are therefore aurally identical. If the smaller words in the Applicant’s mark were read and voiced along with their four initials, I find the parties’ marks to be aurally similar to a degree between medium and high.

Conceptual similarity

46. The Opponent's submissions in lieu include the following: *"due to the heraldic elements, the provision of a football, and the prominent provision of an acronym ending in "FC", the average consumer would immediately recognise the mark of the present application as being the crest of a football club [...] having the initials "LC".* It submits that its own earlier mark *"would be recognised by the average consumer as an acronym. Further, it is likely that the average consumer would recognise that the letters "FC" at the end of the acronym would stand for "Football Club". Therefore, the average consumer would understand the earlier mark to be the acronym for a football club having the initials "LC"."* The Opponent concludes that the marks are therefore *"extremely conceptually similar, both being understood by the average consumer to be trade marks relating to a football club having the initials "LC"."* I largely agree with of those submissions and I find that despite the various elaborations present in the Applicant's mark (including the words), the parties' marks are conceptually similar to a degree between medium and high.

Conclusion as to likelihood of confusion

47. I make a global assessment of likelihood of confusion that takes account of my findings set out in the foregoing sections of this decision and of the various principles from case law outlined in paragraph 27 above. Earlier in this decision I concluded that:
- the parties' goods are identical and that their services are identical or highly similar;
 - the average consumer of the goods at issue will be the general public and for the services may also include businesses;
 - in selecting the goods and services at issue, visual considerations tend to predominate but aural considerations are also relevant;
 - in selecting the goods at issue the average consumer will pay no more than a normal degree of attention (a medium or ordinary degree), and in selecting the services an above average level of attention;
 - the overall impression and distinctiveness of the Opponent's trade mark lies in the four letters that make up that earlier mark; the overall impression conveyed by the Applicant's trade mark involves various device and word aspects but the same four letters play a central role;

- the Opponent's earlier trade mark may be considered inherently distinctive to a normal degree. I have borne in mind the possibility that the level of inherent distinctiveness may fall lower than that insofar as the mark may be seen to relate to a football club. I have also found that in this instance there is no benefit to the Opponent were I to find that its earlier mark has an enhanced distinctiveness through its use. I make this last point on the basis that if the distinctiveness of the mark has been enhanced through use, it will be in the context of an association with Leicester City Football Club; enhanced distinctiveness on that basis would then need to be considered (as part of the assessment of a likelihood of confusion) in light of the wording included in the Applicant's mark that show its mark to relate to Leeds City Football Club. In the circumstances, I will make my assessment of a likelihood of confusion proceeding on the basis that the earlier trade mark has no more than a normal degree of inherent distinctiveness (and possibly even lower than normal).
- the marks are visually similar to a medium degree, are aurally identical or else similar to medium to high degree, and share a medium to high degree of conceptual similarity.

48. In my assessment of a likelihood of confusion I particularly bear in mind the principle that there is an interdependence of factors, such that a lesser degree of similarity between the marks may be offset by a great degree of similarity between the goods or services. The goods or services are in this case identical or highly similar, and the marks are in no aspect less than similar to a medium degree. The Opponent's registered trade mark gives it exclusive rights in law to the letters LCFC in relation to the goods and services at issue. Those same letters form the dominant verbal part of the Applicant's mark and retain an independent distinctive character.

49. I also note that, sitting as a Deputy High Court Judge in the Glee¹⁴ case, Mr Roger Wyand QC stated that "*It is not necessary for infringement of a registered trade mark to show that there is 'right way round confusion'. All that is required is a likelihood of confusion.*" And when that case reached the Court of Appeal, Lord Justice Kitchin noted that the distinction between 'wrong' and 'right' way round evidence may be nothing more meaningful than the order in which a particular consumer happens to come across the mark and the sign.

¹⁴ *Comic Enterprises Limited v Twentieth Century Fox Film Corporation* [2014] EWHC 185 (Ch) – a case involving infringement, but from which I find the principle extends to opposition proceedings.

Nothing in the Act dictates that the average consumer must consider the signs/mark and respective goods or services in a particular chronological order. Therefore, for example, if the average consumer were familiar with the Applicant's mark, and then were to encounter the Opponent's mark on identical goods, it seems to me that a likelihood of confusion inevitably arises.

50. When I weigh in the balance all of the above factors, I conclude that there is a likelihood that the average consumer, even though deemed well informed and reasonably circumspect and observant, encountering the respective marks, may assume that the goods and services at issue are provided by the same or related undertaking. **Consequently, the opposition on the basis of section 5(2)(b) succeeds in full** and the application can proceed for none of the goods or services applied for.

The section 5(3) and 5(4)(a) grounds

51. In view of my findings as to a likelihood of confusion under the section 5(2)(b) ground and the success of the opposition in respect of the entirety of the application, it is unnecessary to consider the claims under sections 5(3) and 5(4)(a) grounds and I decline to do so.

Section 3(6) (bad faith)

52. Since an allegation of bad faith is a serious matter, I consider it warranted to deal with it, albeit relatively briefly, notwithstanding that the opposition has succeeded in full on the basis of the section 5(2)(b) ground.

Legal principles on bad faith

53. There is no definition of bad faith under section 3(6) of the Act or in the case law, but there are some key considerations that need to be taken into account when deciding a bad faith case. These were helpfully summarised by Arnold J in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). The main considerations are as follows:

- Bad faith should be assessed at the date of filing the contested application.¹⁵

¹⁵ Case C- 529/07 *Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35]

- Later evidence may however potentially be relevant if it helps to elucidate the position as it was at the application date ¹⁶
- A person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith.¹⁷
- Bad faith includes dishonesty and “some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined.” ¹⁸
- Section 3(6) of the 1994 Act, and comparable provisions under EU legislation, are intended to prevent abuse of the trade mark system.¹⁹ As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties.²⁰
- Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case.²¹
- Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's

¹⁶ See *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41]

¹⁷ See *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

¹⁸ See *Gromax Plastics Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

¹⁹ See *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21].

²⁰ See *Cipriani* at [185].

²¹ See *Lindt v Hauswirth* at [37]

own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry.²²

- Eighthly, consideration must be given to the applicant's intention. Arnold J refers²³ to the statements of the CJEU in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P Henkel v OHIM [2004] ECR I-5089, paragraph 48)."

²² See *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

²³ See paragraph 138 Red Bull.

Decision on the bad faith claim

54. A claim of bad faith is a serious allegation and may only succeed where there is cogent evidence to that effect. Bad faith cannot be found in circumstances where the facts are also consistent with good faith. I note the various points of suspicion put forward by the Opponent, but it seems to me that the fact that the Applicant's mark includes the full name "Leeds City Football Club", along with the ordinary acronym of that name – "LCFC" – is quite sufficient to defeat an allegation of bad faith. While some of the Applicant's evidence and submissions might perhaps have been presented in a more orderly fashion, and there is a tendency perhaps towards simple denial without great clarification, I do not consider it warranted to find bad faith in relation to the Opponent. The Applicant's mark does not purport to be that of the Opponent – it contains not only the name "Leeds", but also much of that city's coat of arms.
55. Moreover, the evidence shows that Mr Dixon has had involvement with the Leeds City football club dating back to the late 1990s and that the Applicant company was registered in 2003, long before the Opponent's Premier League triumph in 2016. The evidence also shows that the applied-for mark is a variation on an actual historic mark of the Leeds City football club; there seems to me nothing innately objectionable or irregular in the modifications made in the Applicant's mark. While I doubt that it is incumbent on the Applicant to explain its business rationale in these circumstances, I note that in its submissions in lieu the Applicant does offer (albeit late in the proceedings) an account of its business intentions for the mark. The Applicant indicates that it wishes to keep those plans confidential and there is no evidence to support the account, but that account is anyway one illustration of any number of ways in which the application may have been consistent with good faith at the date of its filing.
56. I also note the Opponent's concern expressed in its submissions in lieu to the effect that should the present application proceed to registration the Applicant could potentially use the resulting trade mark registration to contest at least some of the use of the earlier mark. I do not accept that to be intended implication of paragraph 8 of Mr Dixon's second Witness Statement.
57. **The opposition fails insofar as it is based on grounds under section 3(6) of the Act.**

COSTS

58. The Opponent has successfully opposed the Applicant's application to register its trade mark and is entitled to a contribution towards its costs, based on the scale published in Tribunal Practice Notice 2/2016. The award breakdown is as follows:

Official fee for Form TM7	£200
Preparing a statement and considering the other side's counterstatement	£300
Preparation of evidence and considering and commenting on the other side's evidence	£750
Preparation of submissions in lieu of oral hearing	£350
Total	£1600

59. I order Leeds City Football Club Limited to pay Leicester City Football Club Limited the sum of £1600 (one thousand six hundred pounds) which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

Dated this 26th day of November 2018

Matthew Williams
For the Registrar
