O/0434/25

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF UK APPLICATION NOS. 3828657, 3829141 AND 3829134
IN THE NAME OF MARADONA GLOBAL LIMITED
TO REGISTER THE FOLLOWING TRADE MARKS:

DIEGO ARMANDO MARADONA

DIEGO MARADONA

IN CLASSES
3, 9, 14, 16, 18, 21, 25, 28, 29, 30, 31, 32, 33, 35, 36, 38, 41, 42 AND 45
AND
IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO
UNDER NOS. 439518, 440908, 440909
BY
DIEGO ARMANDO MARADONA SINAGRA
DALMA NEREA MARADONA VILLAFAÑE
DINORAH GIANINNA MARADONA VILLAFAÑE
DIEGO FERNANDO MARADONA OJEDA
JANA MARADONA

Background and pleadings

1. This decision concerns three consolidated oppositions against three trade marks that Maradona Global Limited ("the applicant")[1] seeks to register in the UK. The details of those three trade marks are set out below:

UK application no. 3828657 (Opposition no. 439518)    Filing date: 12 September 2022 Publication date: 02 December 2022 ("the applicant's first mark")
UK application no. 3829141 (Opposition no. 440908) DIEGO ARMANDO MARADONA Filing date: 13 September 2022 Publication date: 17 February 2023 ("the applicant's second mark")
UK application no. 3829134 (Opposition no. 440909) DIEGO MARADONA Filing date: 13 September 2022 Publication date: 17 February 2023 ("the applicant's third mark")

2. The above applications are all in respect of goods and services in Classes 3, 9, 14, 16, 18, 21, 25, 28, 29, 30, 31, 32, 33, 35, 36, 38, 41, 42 and 45.[2] The specifications of

[1] The company has changed its name to Podium Icons Ltd on 21 March 2023.
[2] Given the length of the specification I will not reproduce it in the decision or as an annex. However, the specification for the applicant's first mark can be found at https://trademarks.ipo.gov.uk/ipo-tmcase/page/Results/1/UK00003828657 and, as I will explain later, the specifications for the three marks are nearly identical.

the second and third marks are identical and differ from the specification of the first mark only to the limited extent that they do not contain a limited number of goods and services in Classes 16[3] and 41[4] for which the first mark seeks registration.

3. The applicant's marks are subject to oppositions brought by Diego Armando Maradona Sinagra, Dalma Nerea Maradona Villafañe, Dinorah Gianinna Maradona Villafañe, Diego Fernando Maradona Ojeda, and Jana Maradona ("the opponents").

4. The oppositions against the second and the third mark were both filed on 17 May 2023. The opposition against the first mark was filed on 2 March 2023. The oppositions are based on the following grounds:

The first opposition

5. The opposition against the applicant's first mark is directed towards all the goods and services for which the applicant seeks registration and is based on Sections 5(1), 5(2)(a), 5(3) and 3(6) of the Act with the opponents relying on one single earlier mark for the purpose of Sections 5(1), 5(2)(a), 5(3), the details of which are shown below:

UK00003709150 ("the first earlier mark")

Filing date: 12 October 2021

Registration date: 11 March 2022

Priority date: 21 April 2021

The mark is registered for goods and services in classes 9, 14, 25, 28, 32 and 41.

[3] The only material difference in the specifications in Class 16 is that the second and third earlier marks do not contain the terms "Art; works of art; photographs; prints; art prints; printed matter; cards; trading cards; collectible cards; books; printed publications; picture books; cards; posters; calendars".
[4] The only material difference in the specifications in Class 41 is that the second and third earlier marks do not contain the term "online books".

6. Under Sections 5(1) and 5(2)(a), the opponents state that the marks are identical and that the goods and services are either identical or similar, leading to a likelihood of confusion. Further, the opponents state that the earlier mark "*protects the signature and first forename of the famous football player, Diego Armando Maradona"* and *"it is comprised of the name DIEGO MARADONA in written script form, together with the number (10) positioned beneath, this being the number which the well-known footballer predominantly used throughout his career as a football player".*

7. Under Section 5(3), the opponents claim that the earlier mark has a reputation for the goods and services for which it is registered. In addition, they state that the opponents *"are the only rightful heirs and successors to the late Diego Maradona entitled by virtue of being beneficiaries of his estate to use and register the trade mark, the subject of trade mark registration no. 3709150 [i.e. the first earlier mark]"* and that *"that trade mark signifies an association with Diego Maradona by virtue of it consisting of his signature, forename and pitch playing position".* Further, the opponents claim that *"Diego Maradona is a household name in the UK*" and that *"the enhanced distinctiveness residing in the football player's signature registered as a trade mark affords it a wider penumbra of protection"* and that *"it is therefore most likely that the relevant public will believe the applicant's business to be connected to the opponents' business, because an economic link between the parties on account of the identical mark associated with the football player, Diego Maradona, will be made."* This, the opponents claim, will take unfair advantage of, or be detrimental to, the distinctive character and reputation of the earlier mark.

8. Under Section 3(6) the opponent states as follows:

> *"In choosing to misappropriate for use and registration a mark the property of the Opponents, and by extension, property of the Maradona estate, the Applicant is seeking to create an association with Diego Maradona and his legacy, to which the Applicant has no entitlement. Consequently, it can be inferred that the Applicant did dishonestly intend at the time of the application, in a manner inconsistent with honest practices, to undermine the rights of the Opponents with a mala fide intent to cause a deliberate association with the famous footballer's name, and thereby deceive consumers into thinking,*

wrongly, that the products and services sold by the Applicant are commercially linked or authenticated by Diego Maradona's heirs, successors and estate. As will be shown in evidence, the Opponents are the rightful owners of the mark. The Applicant did have prior knowledge of the Opponents' ownership of the mark and, therefore, the contested application is intended to prevent the Opponents' rightful exploitation of their property in the UK. In short, the Applicant is disentitled to exploit the Opponents' property, including by applying to register a trade mark as its own and it knows of that disentitlement".

The second opposition

9. The opposition against the applicant's second mark is based on Sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Act. In addition to the earlier mark set out above, in this opposition the opponents rely on an additional earlier mark for the purpose of Sections 5(2)(b) and 5(3), the details of which are shown below:

UK00902243947 ("the second earlier mark")
DIEGO MARADONA
Filing date: 09 July 2001
Registration date: 08 January 2003
The mark is registered for a range of goods and services in classes 3, 25 and 42.

10. Under Section 5(2)(b), the opponents claim that the marks are similar and that the goods and services are identical or similar resulting in a likelihood of confusion. For the sake of completeness, it is worth noting that when relying on the second earlier mark under Section 5(2)(b), the opponents direct the opposition towards some of the goods and services only and do not object to the goods and services in classes 9, 14, 16, 28, 32 and 33. In relation to the second earlier mark, the opponents claim that the earlier registration protects the first forename and surname of the famous football player, Diego Armando Maradona, that the applicant's second mark appropriates the entirety of the opponents' earlier registration, that the inclusion of 'ARMANDO' reinforces the overall common conceptual message of the well-known footballer by virtue of appropriating his full name, and that the relevant public is unlikely to distinguish between the marks.

11. The Section 5(2)(b) claim based on the first earlier mark is pleaded similarly to that based on the second earlier mark but is directed towards all of the goods and services for which the applicant's mark seeks registration. In particular, the opponent states that the first earlier mark protects the signature and first forename of the famous football player, Diego Armando Maradona, that the inclusion of 'ARMANDO' in the applicant's mark reinforces the overall common conceptual message of the well-known footballer by virtue of appropriating the footballer's full name, and that the average consumer will perceive the applicant's sign as being similar to the opponents' earlier registration.

12. The claims based on Section 5(3) and 3(6) are the same as those pleaded in the first opposition, and I do not need to repeat them here. The only point I would add is that when relying on the second earlier mark for the purpose of Section 5(3), the opponents claim reputation for all the goods and services for which that mark is registered.

13. Lastly, under Section 5(4)(a), the opponents rely on the unregistered sign DIEGO MARADONA which it claims to have used throughout the UK since a date "*to be confirmed".* Under this ground, the opponent claims that it has used its earlier sign for *"various merchandising goods and services*". As a result of the opponent's use of its sign, it claims that it has acquired significant goodwill. The opponents further claim that unauthorised use by the applicant of the contested marks would amount to a misrepresentation liable to deceive the public, who will be deceived into thinking, wrongly, that the applicant's goods and services are authentic and originate from the Maradona estate, resulting in likely or actual damage to the opponents' business, both in terms of loss of revenue as well as potential damage to the opponents' business reputation.

The third opposition

14. The opposition against the applicant's third mark is based upon the same grounds as those relied upon in the opposition against the second mark with the relevant grounds being pleaded identically. The only difference is that the opposition based upon the second earlier mark is founded on the marks being identical rather than similar so Sections 5(1) and 5(2)(a) are relied upon in place of Section 5(2)(b).

15. By virtue of their earlier filing (or priority) dates, which are earlier than the filing dates of the applicant's marks, the trade marks relied upon by the opponents are considered to be earlier marks in accordance with Section 6 of the Act. The first earlier mark had not been registered for five years or more at the filing dates of the applicant's marks and, as such, it is not subject to the use conditions under Section 6A of the Act; this means that the opponents may rely on all of the goods and services it has identified without demonstrating that it has used the mark. However, the second earlier mark, having been registered for more than five years at the filing dates of the applicant's marks, is subject to the use conditions under Section 6A of the Act.

16. The applicant filed a defence and counterstatement in each proceeding denying the claims made and putting the opponents to proof of use of the second earlier mark in the second and third oppositions. Each denial consists of a brief sentence which merely denies the opponents' claims but does not give any detail of the applicant's defences. In particular, in response to the allegation of bad faith, in each case the applicant states as follows:

> *"8. We deny that the Application was filed in bad faith. This is a serious allegation that the Opponents will have to make out.*
> *9. The Applicant is the legitimate owner of the trade mark rights in the Applicant's mark.*
> *10. The Application does not offend against Section 3(6) of the Trade Marks Act 1994 and the opposition on this ground should be dismissed in its entirety."*

17. Notably, the applicant's defences:

(a) Do not engage in any substantive argument as to why the applicant *is "the legitimate owner"* of the trade mark rights in the contested marks.

(b) Whilst denying the claim that there is a likelihood of confusion and that the opponents enjoy a reputation and goodwill in the earlier signs, the applicant's defence do not deny the claims that DIEGO ARMANDO MARADONA is the name of a famous football player well-known worldwide, including in the UK,

and that the UK public is likely to associate the contested marks directly with him.

(c) Do not deny that the applicant had prior knowledge of the opponents' ownership of the earlier marks.

(d) Contain denials of claims which are self-evidently true. For example, the applicant denies that the goods and services covered by the specifications of the respective 3829134 and 902243947 marks (the DIEGO MARADONA marks) are similar, notwithstanding both specifications cover identical terms such as *cosmetics; soaps; perfumery* (in class 3) and *Clothing; headgear; footwear* (in class 25).

18. All three sets of proceedings were consolidated under the lead case, opposition no. 439518, on 20 February 2024.

19. Only the opponents filed evidence during these proceedings. No hearing was requested and neither side filed written submissions in lieu.

20. The opponents are represented by Stevens Hewlett & Perkins. The applicant was initially represented by Birds & Birds LLP, however, following a request dated 30 May 2024 by Birds & Birds LLP, the latter was removed as the applicant's representative for these proceedings, and the applicant ultimately ceased to be represented by anybody. I make this decision having taken full account of all the papers, referring to them as necessary.

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

Evidence

22. The opponent's evidence came in the form of the witness statement of Peter William Cornford dated 22 April 2024. Mr Cornford is a Charted Trade Mark Attorney employed by the opponents' legal representatives and states that he is authorised to give evidence on the opponents' behalf. Mr Cornford's evidence is accompanied by 13 exhibits, being those labelled PWC1-PWC13.

23. Although the opponents rely on multiple grounds, I find it convenient to start with the claim of bad faith which is identically pleaded in all three oppositions.

Section 3(6)

24. Section 3(6) of the Act states:

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

25. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1) ("SkyKick")* [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240] as follows:

> "(i) […]
>
> (ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).
>
> (iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation […], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenaevnet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 ("*Malaysia Dairy*")], para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 ("*Sky CJEU*")], para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the […] law of trade marks, namely the establishment and functioning of […] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; [*Koton Mağazacilik Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*")], para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).
(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case (*[Hasbro Inc* v *EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 ("*Hasbro*")], paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a *bona fide* intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87)."

26. The essence of bad faith objection is that applicant's intended conduct is a departure from accepted principles of ethical behaviour or honest commercial practices. Earlier in *SkyKick*, Lord Kitchin considered the question of what amounts to bad faith. He underlined that the categories of bad faith and the circumstances which may constitute bad faith are not closed, and continued:

"152. In seeking to identify the relevant principles, it is necessary to have in mind two fundamental aspects of trade mark law to which I have already referred: first, it is concerned with the use of marks in trade to denote the origin of goods and services. Secondly, the aim of the trade mark regime is to contribute to a system of undistorted competition in which businesses are able to attract and retain customers by the quality of their goods and services, and for that purpose are able to have registered signs which enable consumers to distinguish the goods and services of one undertaking from those of another. Such a system must also provide an incentive and protection for the investment by a brand owner in the quality and other beneficial aspects of its goods and services, and so allow it to develop a goodwill in its business relating to their sale and supply.

153. Against this background, the essence of the objection that an application to register a mark was made in bad faith may be understood: it is that the motive or intention of the applicant was to engage in conduct that departed from accepted principles of ethical behaviour or honest commercial practices having regard to the purposes of the trade mark system which I have described. Whether the conduct was undertaken with that motive or intention and did indeed depart from such ethical behaviour or honest commercial practices must be assessed having regard to all the objective circumstances of the case: see, for example, *Koton Mağazacilik Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*"), paras 46 and 47 […]."

27. The correct approach to assessing bad faith was set out in *Alexander Trade Mark*, BL O/036/18, where Mr Geoffrey Hobbs sitting as the Appointed Person stated that the key questions for determination in a claim of bad faith are:

(a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?

(b) Was that an objective for the purposes of which the contested application could not be properly filed? and

(c) Was it established that the contested application was filed in pursuit of that objective?

28. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited* and others, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

29. An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies

(i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch).

30. The caselaw shows that the initial evidential burden falls upon the opponents: the opponents must present evidence from which a rebuttable presumption of lack of good faith can be drawn. If they do that, then the burden shifts to the applicant to rebut the allegation.

31. In the present proceedings, the applicant has provided nothing beyond the counterstatements. Further, the denials contained in the counterstatements amount, in substance, to a claim that the applicant is, in fact, *"the legitimate owner"* of trade mark rights in the name of the famous football player DIEGO ARMANDO MARADONA (and in his signature).

32. Admittedly, what I have said above about the applicant's defense not denying the claim that the contested marks will be associated with the name of the (deceased) famous football player DIEGO ARMANDO MARADONA, means that, in the absence of such denials, I must treat those aspects of the bad faith claim (i.e. that DIEGO ARMANDO MARADONA is the name of a famous football player who is well-known in the UK, and that the contested marks will be associated with that name) as having been admitted, or as being no longer at issue. In this connection, it is worth noting that whilst the applicant has briefly denied that the opponents enjoy *"reputation in the marks*" and *"goodwill in the marks for the goods and services claimed in the opposition"*, those denials relate to the claims that the opponents enjoy reputation and goodwill in the relevant markets for the goods and services concerned; they do not, however, amount to denying that DIEGO MARADONA (or DIEGO ARMANDO MARADONA) is a famous name which is well-known in the UK (or was well-known at the filing dates of the applicant's marks). In addition, as it will be recalled, the counterstatements do not address the allegation that the applicant had prior knowledge of the opponents' ownership of the earlier marks; this too must be taken to

be admitted based on the principle that where a defendant fails to deal with an allegation, it is taken to be admitted (CPR 16.5(5)).[5]

33. Thus, bearing in mind the generality of the applicant's defence, and the fact that the counterstatements fail to put each element of the Section 3(6) ground in issue, the only relevant point that the opponents must prove is that, at the filing dates of the applicant's marks, the opponents were authorized to use DIEGO ARMANDO MARADONA's name and signature in the UK as trade marks. Whether this is sufficient for the bad faith claim to succeed is something to which I will need to revert, but I will do so when I have explained what the evidence establishes. Whilst, I suppose, in the absence of any express challenge on the point, it could be inferred from the ownership of valid earlier trade mark registrations that the opponents were entitled to use DIEGO ARMANDO MARADONA's name and signature in the UK as trade marks, the opponents did not make such argument, and have specifically addressed the point in their evidence including in the context of previous litigation between the opponents and a company associated with the applicant. With this in mind, I now turn to the evidence.

The evidence of bad faith

34. The first part of Mr Cornford's evidence is aimed at establishing that DIEGO MARADONA (or DIEGO ARMANDO MARADONA) is the name a famous football player and that the footballer's name and signature were well-known in the UK by the relevant public for the goods and services concerned at the filing dates of the applicant's marks. As I have said, these claims must be treated as being admitted.

35. The second part of Mr Cornford's evidence touches upon the relationship between the applicant and other companies who were involved in litigation with the opponents regarding the use of Maradona's name and is as follows:

- Exhibit PWC3: this exhibit includes:

[5] See SkyClub (O/044/21) paragrphs 23-26

i. An extract from Companies House showing that the applicant, Maradona Global Limited (company no. 14315020), changed its name to Podium Icons Ltd on 21 March 2023. The registered address for the newly named company also appears to be different from the one on records which the applicant provided when it filed its Form TM8s and counterstatements. The new address is Labs, Hawley Wharf, 1 Water Lane, London, NW1 8NZ.

ii. An extract from Companies House for a company called Podium Venture Catalyst LLP (previously called Podium Venture Studio LLP), which trades from the same address as the applicant's newly named company.

i. An extract from the applicant's website at www.maradonaglobal.com (undated). It states that Maradona Global (the applicant's previous name) was established by Maradona's sisters, closest friends and colleagues, to promote the social causes Maradona supported. In his witness statement, Mr Cornford notes that on the final page of the extract, the details of the overarching company are listed as the applicant's newly named company (i.e. Podium Icons Limited) with an address of Labs, Hawley Wharf, 1 Water Lane, London, NW1 8NZ:

CONTINUING THE LEGACY...

Diego Maradona, known the world over as one of the greatest footballers of all time, was much more than a sportsperson. Maradona Global has been established by his sisters and closest friends and colleagues to celebrate the great work he did, to share the joy he gave to millions, and to promote the social causes he supported, to honour and protect Maradona's legacy for generations to come.

iii. An extract taken from Just Entrepreneurs. The article is titled "*Continuing Maradona's legacy: Launch of Maradona Global Ltd gives brands opportunity to work with the football icon".* The article states: *"UK venture builder Podium Ventures has successfully completed a deal with Sattvica S.A. owner of the worldwide rights to Maradona's brand name, image and likeness - and the Maradona sisters, led by Lili and Rita, to officially launch Maradona Global Limited"* and "*The new company, headquartered in London, will build upon the Maradona brand and create new ventures with partners and licensee across the globe who share the principles of social equity, diversity and inclusion. It will lead on commercial development of the Maradona brand globally and commence a broader vision to enact Diego's last wish of establishing a charitable foundation in his name"*. Mr Cornford comments on this evidence as follows:

"The article discloses that "Podium Ventures has successfully completed a deal with Sattvica S.A.", who falsely purports to the be the owner of the worldwide rights to the Maradona trade marks. It includes a quote from Matias Morla, the CEO of Sattvica S.A. which declares a partnership with Podium Ventures and an intention to produce "media and entertainment, gaming, apparel and footwear, to food and beverages" using the opponent's trade marks which it knows it has no entitlement to use. It names Lili and Rita Maradona as sisters of Diego Maradona. These individuals are not the named heirs of the Diego Maradona estate, as evidenced in Exhibit PWC5."

iv. An online article dated November 2022 from Business Age, which Mr Cornford states, is an online publisher of articles in the nature of business. Mr Cornford comments that the article has been written by Sanjay Wadhwani, CEO of Maradona Global Ltd (i.e. the applicant's previous company name) who asserts that the company is *"in partnership with the Maradona sisters and Sattvica S.A."* The article states as follows:

“They say you should never meet your heroes. Diego Maradona's passing in 2020 means that I will never get that chance. However, the recent launch of Maradona Global Limited (MGL) and our relationship with his sisters and heirs, led by his middle sister Rita Maradona (Kitty), presents a different kind of peril. 'That of respecting and enhancing the legacy of a global icon beloved by millions and, most especially, his family. There have been no shortage of suitors, hoping to take on the responsibility - and opportunities associated with the Maradona name since his untimely death, in addition to multiple attempts to capitalise on his image and likeness. The launch of Maradona Global Limited in partnership with the Maradona sisters and Sattvica S.A. - which controls worldwide rights to the Maradona brand and likeness - represents the first and only official partnership.”

Mr Cornford repeats that this ***evidence*** *“dishonestly misrepresents that [the applicant] is the owner of the worldwide rights to the Maradona trade mark, and even goes as far as to indirectly discredit[ing] the opponent's rightful entitlement to the trade marks when it asserts that it is "the first and only official partnership"*. Mr Cornford also points out that the article “*again names Lili and Rita Maradona as effective co-conspirators in the unauthorised enterprise; these individuals are not the named heirs of the Diego Maradona estate, as shown in Exhibit PWC5”.*

- Exhibit PWC4 includes:

    i. Copy of the decision no. R755/2021-1 of the EUIPO Board of Appeal dated 1 March 2022 (translated) between SATTVICA, S.A. (“Sattvica”), a company based in Argentina, and the heirs of Diego Armando Maradona. The decision concerns the dismissal of Sattvica's application to transfer the registration of Maradona’s trade marks to Sattvica and discloses the following information:

        a) On 9 July 2001, Diego Armando Maradona applied to register his name DIEGO MARADONA as a EUTM for goods and services in

classes 3, 25 and 42. The mark was registered under no. 2243947 on 8 January 2003.

b) On 27 January 2021, Sattvica made a first application to transfer the EUTM no. 2243947 in its favour. The request was accompanied by some documents to substantiate the transfer, including an authorization for commercial exploitation of trade marks dated 26 December 2015 and a trade mark use authorization agreement, undated, both granted by Maradona. The EUIPO actioned the transfer, however, on 2 February 2021, the recorded representative for the EUTM no. 2243947, asked the EUIPO to revoke the transfer alleging that no valid documentation or power of attorney had been provided in favour of Sattvica.

c) On 2 February 2021, the EUIPO notified the parties involved that the transfer had to be considered null and void.

d) On 3 February 2021, Sattvica's representative made a second application to transfer the EUTM no 2243947 to Sattvica supported by licensing agreements for the use of the trade mark, issued by Maradona in favour of Sattvica. The EUIPO actioned the transfer and notified it. On 8 February 2021, the recorded representative for the EUTM no. 2243947 asked the EUIPO to cancel the transfer (on account of the fact that Sattvica had not submitted any documentation or valid authorisation for the mark) in addition to taking measures to avoid future transfers of the EUTM in question, without the consent of the EUTM proprietor's legitimate heirs.

e) On 26 February 2021 the EUIPO notified the parties involved that the transfer had to be considered null and void. Sattvica appealed requesting the decision to be annulled and the second transfer of EUTM no 2243947 in the name of Sattvica to be allowed.

f) On 28 April 2021, the recorded representative for the EUTM no. 2243947 sought to register the transfer of EUTM no. 2243947 in favour of the heirs of Diego Armando Maradona. The request was supported by a copy of a court order dated 5 May 2021 from the Argentinian Criminal Court prohibiting Sattvica to engage in respect of all the trade marks relating to the name, pseudonyms and the representation of Diego Armando Maradona in Argentina and in any country in the world.

g) In dismissing the appeal, the BoA reiterated that the reason for declaring the registration of the transfer invalid was the failure to provide documents duly establishing the transfer. Observing that the proprietor of the EUTM No 2243947 and the grantor, Diego Armando Maradona, had died on 25 November 2020, that is, months before the application for registration of the transfer, the BoA stated that "*the death of the EUTM proprietor has an immediate effect, which is to trigger the universal succession. By virtue of that decision, it is the heirs who acquire ownership of the EUTM and from that moment alone they are entitled to transfer the EUTM in question"* and concluded that, since Sattvica did not provide an authorisation from the heirs of Diego Armando Maradona in its favour, the appeal was dismissed.

ii. Copy of the General Court's final decision in case T-299/22 *Sattvica v EUIPO*,[6] dated 7 November 2023, concerning an appeal brought by Sattvica against the BoA's decision R755/2021-1. The appeal was dismissed with the Court noting that the documents relied upon by Sattvica did not prove the transfer of the mark as they were simply authorizations for the exploitation of the mark, signed by the late Diego Armando Maradona, and did not formally justify a transfer of said mark in favour of Sattvica under a contract signed between the two parties

[6] At PWC12 Mr Cornford also provided a copy of decision of the CJEU dated 8 April 2024 which did not allow the appeal filed by Sattvica on 9 January 2024 in connection with the GC's decision.

(Sattvica and Maradona). Furthermore, the Court explained that as Maradona had died before the request for registration of the transfer was submitted, Sattvica could not correct the irregularities found. Nor was it able to produce any other documents. The decision also confirms that the names of Diego Armando Maradona's heirs are the same as those of the opponents in these proceedings.

iii. Copies of articles reporting on the General Court's decision T-299/22. They provide further information about Sattvica stating that it is a company established in Buenos Aires (Argentina) belonging to the former lawyer of Maradona.

- Exhibit PWC5: it consists of a declaration issued by the Civil and Commercial Court Nr 20 of La Plata of Argentina (i.e. the home country of Maradona). The document, which is translated in English, is dated 4 March 2021 and is titled "MARADONA DIEGO ARMANDO S / AB-INTESTATO SUCESSION (RESERVED)." It states that "*due to the death of Diego Armando Maradona, the successors to him as universal heirs are his sons Diego Armando Maradona Sinagra, Dalma Nerea Maradona Villafaie, Dinorah Gianinna Maradona Villafafie, Jana Maradona Sabalain and Diego Fernando Maradona Ojeda",* these being the opponents in these proceedings. Mr Cornford comments that notably "*Rita Maradona and Lili Maradona […] are not by virtue of this document the recorded heirs of the Diego Maradona Estate".*

- Exhibit PWC6: it consists of copy of a decision issued by the Civil Board Chamber F of Buenos Aires in Argentina (case 79035/2021). The decision, which is translated in English and is dated May 2022, confirms an interim measure ordering that the defendants, including an individual called Mr S.C. (see below) and Sattvica, *"... must cease using by themselves or through third parties the image, portrayal, voice, name and Pseudonym and the trademark of Diego Armando Maradona and any other mark related to his person".* This

decision was subsequently confirmed by the High Court of Argentina in February 2023.[7]

- Exhibit PWC7: it consists of search reports produced using WIPO's Global Brand Database which reveal a non-exhaustive list of applications for Diego Maradona trade marks filed by either Maradona Global Limited (in the UK) or Sattvica (in other countries). The reports are dated 27 March 2024 and list 27 trade marks.

- Exhibit PWC8: it consists of a copy of a notarial certificate issued by a Notary Public of Argentina. The certificate, which is translated in English, is dated 3 May 2021 and concerns a license agreement titled "LICENSE AGREEMENT FOR THE ECONOMIC EXPLOITATION OF IMAGE RIGHTS" signed by Maradona which purports to confer by way of license the right to use his name and trade marks to Sattvica, Mr S.C. and another individual called Mr M.E.M who, it is stated, was the owner of Sattvica and was responsible for advising Maradona. As Mr Cornford points out, the certificate states that *"on the date of the alleged signing of the Agreement, on 17 August 2020, Maradona was not in a position to understand the scope of the act that was formalized, which constitutes an injury and defect that invalidates the hypothetical agreement"* and orders Sattvica, Mr S.C and Mr M.E.M to refrain from exploiting and using the image, name or pseudonyms of the late Diego Armando Maradona, as well as from authorising the use, licensing or carrying out any legal act related to them. The exhibit also includes the report of a medical board dated 30 April 2021, together with an English translation, which states that *"since his admission to IPENSA, [Maradona] was NOT in full possession of his mental faculties, nor was he able to make decisions regarding his health"* which, Mr Cornford states, supports the notion that Maradona was not in a position to sign any license agreement, causing the license to be deemed null and void.

- Exhibit PWC9: it consists of a copy an email from the administrator of Maradona's estate notifying to Sattvica the termination of the "AGREEMENT

[7] PWC13

FOR THE ECONOMIC EXPLOITATION OF IMAGE". The document, which is translated in English, is dated 30 September 2021 and states as follows:

> *"Please find attached a copy of the formal termination notice, effective as of today, of the contract titled "LICENSE AGREEMENT FOR THE ECONOMIC EXPLOITATION OF IMAGE RIGHTS" dated August 17, 2020. Although the termination was notified by public deed today, it is also being communicated through this medium in accordance with Article 7 of the aforementioned document. As of today, you must refrain from any actions involving the image of the late Diego A. Maradona. In the event of non-compliance, I reserve the right to claim damages and losses resulting from your actions, which would be deemed illegitimate and in bad faith."*

- Exhibit PWC11: it consists of a copy of a decision issued by the Court of Appeal in Argentina revoking a precautionary measure obtained on 23 November 2021 by Mr S.C. (i.e. one of the individuals named along with Sattvica in the commercial exploitation contract of 17 August 2020) against Maradona's heirs and Sattvica (i.e. the defendants). The revoked measure ordered Maradona's heirs and Sattvica to refrain from any act or omission that hinders or obstructs the full exercise of the contractual rights of Mr S.C. pending a decision on the validity and enforceability of the contract in question. In revoking the measure, the judge observed that in the parallel proceeding mentioned at PWC6,[8] a precautionary measure contrary to the one requested by Mr S.C. was issued which was confirmed by the Court of Appeals; this, the judge said, supported a resolution of the issue of the validity of the 17 August 2020 contract contrary to the right invoked by Mr S.C.

- Exhibit PWC14: it consists of a copy of a licence agreement dated November 2021 (translated) between the Opponents and Coolulu Ltd, a company located in London, permitting the licensee to create NFTs using the name and trade

[8] Judgment of the CIVIL CHAMBER- F, of May 2022; in case 79035/2021 "MARADONA, DALMA NE REAY OTROS c/ YAKUZZA SRL Y OTROS s/MEDIDAS PRECAUTORIAS

marks of Maradona. Mr Cornford states that it is noteworthy that the licence agreement forecasts a sales projection of approximately £3,6 million. Mr Cornford also mentioned the existence of a cease-and-desist letter from Mr S.C. to Coolulu Ltd asserting that Mr S.C. is the legitimate licensee of the Diego Maradona trade marks by virtue of the licence agreement which was subsequently deemed null and void, however, there is no evidence of this.

Assessment of the bad faith claim

36. As it will be recalled, the only defence raised by the applicant is that it is the legitimate owner of trade mark rights in the applicant's marks. Since the applicant's marks seek to register the name and signature of the recently deceased famous football player Diego Armando Maradona (who is regarded by many as one of the greatest of all time) as trade marks, in order to establish that it is the *"legitimate owner of trade mark rights"* in the contested marks, the applicant must demonstrate that it is the holder of legal rights to market (or license the marketing of) Maradona's image and character.

37. First, at the risk of stating the obvious, it is important to note that the applicant is not the rightful owner of the name Diego Armando Maradona (the famous footballer having deceased in 2020) and does not claim to be (and it is obviously not) a successor of Maradona, Maradona's heirs (who are the opponents in those proceedings) making the very (serious) allegation that the applicant misappropriated for use and registration trade marks which are the property of the opponents (and, by extension, of the Maradona estate) and in respect of which the applicant has no entitlement. Further, the applicant did not indicate any connection between Maradona and the applicant and did not claim that Maradona has given consent for his name and signature to be used by the applicant.

38. Second, it goes without saying that the fact that the applicant applied to register the contested marks does not, in itself, make the applicant *"the legitimate owner"* of trade mark rights in the contested marks which, as wholes, reference, as far as the relevant consumer is concerned, the famous football player Maradona.

39. Third, it is not for me to guess the underlying reason for the applicant's defence. Without any explanation and evidence from the applicant as to why it believes to be *"the legitimate owner"* of trade mark rights in the contested marks, its defence is no more than an empty claim.

40. Nevertheless, the fact that the applicant's defence is wholly unsupported, does not mean that the opponents' case based on Section 3(6) must necessarily succeed. This is because there is a presumption that the applications were made in good faith, and a *prima facie* case of bad faith must be established by the opponents in order to rebut such presumption of good faith.

41. First of all, the evidence establishes that the opponents are the successors of the deceased famous football player Diego Armando Maradona. As regards the applicant, the evidence indicates that the applicant's company was set up by a UK venture company called Podium Ventures which, at around the same time as the applications were filed, publicly claimed to have successfully completed a deal with Sattvica - a company which claimed to be the *"owner of the worldwide rights to Maradona's brand name, image and likeness"* - and with Maradona's sisters with a view of licensing the Maradona brand globally through the applicant. An article written by the CEO of Maradona Global Ltd (i.e. the applicant's former name) and published in November 2022 (i.e. around one/two months after the filing dates of the contested marks), also states that the launch of the applicant's company was done with the approval of Maradona's heirs;[9] this is a wholly unsupported claim which does not tally up with the opponent's evidence that there have been legal proceedings at the EUIPO and in Argentina between the opponents (in their collective capacity as Maradona's heirs) and Sattvica in relation to the registration and use of trade marks referencing Maradona. It seems, therefore, unlikely that the opponents would have cooperated with Sattvica to license rights to Maradona's brand name to a third-party company (i.e. the applicant) when there was, in fact, a dispute between the two about trade mark rights in relation to Maradona's name. In particular, the EUIPO proceedings concerned Sattvica's attempt to obtain the transfer of the registration of Maradona's EUTM no. 2243947 for the mark Diego Maradona; these proceedings were concluded in favour

[9] The article states: "However, the recent launch of Maradona Global Limited (MGL) and our relationship with his sisters and heirs, led by his middle sister Rita Maradona (Kitty), presents a different kind of peril."

of the opponents with the General Court upholding the BoA's decision that the registration of the transfer was invalid because the documents relied upon by Sattvica were simply authorizations for the exploitation of the mark, signed by Maradona, and did not prove the transfer of the mark in favor of Sattvica. Likewise, the legal proceedings in Argentina involved multiple disputes which culminated in a number of interventions ordering Sattvica and two other individual named Mr S.C and Mr M.E.M (i.e. the owner of Sattvica) to refrain from exploiting and using the image, name or pseudonyms of the late Diego Armando Maradona, as well as from authorising the use, licensing or carrying out any legal act related to them; those interventions included an interim measure issued on May 2022 by the Civil Board Chamber F of Buenos Aires in Argentina (confirmed by the Court of Appeal) and a notarial certificate issued on 3 May 2021, both of which are dated before the filing dates of the contested marks. It also appears that at the centre of the disputes between the opponent and Sattvica were three licence agreements signed by Maradona, namely an authorization for commercial exploitation of trade marks dated 26 December 2015, a trade mark use authorization agreement, undated (both relied upon in the EUIPO proceedings by Sattvica) and a "LICENSE AGREEMENT FOR THE ECONOMIC EXPLOITATION OF IMAGE RIGHTS" signed by Maradona on 17 August 2020 (a few months before his death) and purportedly granting licence rights to Sattvica, Mr S.C and Mr M.E.M. Whilst the evidence is not 100% clear on this point, as it is not said when Maradona was admitted to IPENSA (at which point the medical report says that Maradona was not in full possession of his mental faculties), given that the licence agreement was signed only a few months before his death, I agree with Mr Cornford that this strongly suggests that when Maradona signed the agreement he was not in a position to do so which, in turn, raises an inference of bad faith for Sattvica and the other individuals who were the part of the licence agreement.

42. Here I need to take a step back and look at how the opponents' case is pleaded. It is true that had Sattvica applied for the contested marks, it would have been obvious to Sattvica that neither the authorization for commercial exploitation of trade marks dated 26 December 2015 (relied upon in the EUIPO proceedings) nor the licence of 17 August 2020 (both signed by Maradona himself), conferred on Sattvica any legal entitlement to apply for trade marks referencing Maradona in the UK (or anywhere else in the world). Further, had Sattvica applied for the contested marks in its own

name, the applications would have been in breach of the notarial certificate of May 2021 and the interim measure granted by the Argentinian Court in May 2022, both of which ordered Sattvica to cease using by itself or through third parties the image, portrayal, voice, name, pseudonym and trade marks of Maradona and any other mark related to his person; as the BoA observed in its decision no. R755/2021-1, those measures applied to the territory of Argentina and anywhere else in the world. In addition, prior to the filing dates of the contested applications, the administrator of Maradona's estate had notified Sattvica that the "AGREEMENT FOR THE ECONOMIC EXPLOITATION OF IMAGE" was terminated and had warned Sattvica that in the event of non-compliance, he reserved the right to claim damages and losses resulting from its actions, which would be deemed illegitimate and in bad faith. In those circumstances, had Sattvica applied for the contested marks in its own name, I would have concluded that the applications would breach the ban on applying for Maradona's trade marks and were made in bad faith to exploit the Maradona's renown in order to benefit from it and invoke the contested marks (once registered) against the opponents who, in their collective capacity as successors of Maradona, had legitimately acquired ownership of all trade mark rights related to his person, undermining, in a manner inconsistent with honest practices, their interests.

43. Admittedly, the contested marks were not filed by Sattvica but by the applicant who is a third-party company which purportedly completed a deal with Sattvica with a view to commercially developing the Maradona brand globally and licensing it. In the circumstances, it is not impossible that when Podium Ventures (i.e. the company which set up and launched the applicant's company) completed a deal with Sattvica, it actually believed that Sattvica was the legitimate owner of worldwide rights in Maradona's brand and name. However, this conclusion raises two issues. First, even if Podium Ventures (and, in turn, the applicant) was unaware of the fact that the authorization for commercial exploitation of trade marks of 26 December 2015 and the license of 17 August 2020 did not entitle Sattvica to use or licence Maradona's name, that would not explain why the applicant applied for the marks in its own name – the obvious course of action would have been, in those circumstances, for Sattvica (as the licensor) to apply for the marks and for the applicant (as the licensee) to use the marks under a licence from Sattvica. Second, had the applicant acted in good faith (based, for example, on the misunderstanding that it was entitled to apply for the

contested marks on the basis of a valid licence granted by Sattvica and with Sattvica's authorisation), it would have most likely backtracked on its applications when it was put to it that the applications were opposed by the legitimate heirs of Maradona. In my view, the fact that the applicant has continued to pursue the procedure for registration despite the opponents' opposition, indicates a dishonest intention at the relevant dates.

44. Moreover, the conclusion that the applicant's intent was dishonest follows from the fact that that applications for registration were filed deliberately with the purpose of creating an association with Maradona's name in order to benefit from its attractive force. According to Case T-795/17 *Moreira v EUIPO (NEYMAR)),* the very act of applying for the registration of a trade mark using the name of a famous person, but without any commercial connection, amounts to 'free riding' on that person's fame, which, in turn, amounts to a *prima facie* case of bad faith. Those circumstances, in particular, coupled with the fact that the applicant did not provide any proper explanation as to why it applied for the contested marks, and did not prove the circumstances which might substantiate its claim that it is the *"legitimate owner of trade mark rights in the contested marks*", means that the applicant's defence is not sufficient to rebut the *prima facie* case of bad faith established by the opponents. Accordingly, the oppositions based upon Section 3(6) of the Act succeed in their entirety.

Proof of use, reputation and goodwill

45. The opponents' evidence is all about Maradona's renown and the bad faith claim. There is no evidence of any use of the earlier marks in the UK or anywhere else by the opponents in relation to the registered goods and services - whilst the evidence includes examples of third-party websites selling Maradona's memorabilia, this is not use by the opponents of the marks for the goods and services concerned prior to the filing date of the contested marks. As such, the opponents cannot prove genuine use of the second earlier mark, reputation for the purpose of Section 5(3) or goodwill for the purpose of Section 5(4)(a). Accordingly, these claims fail. The only grounds which are left to be considered are the Section 5(1) and 5(2) grounds based on the first earlier mark, which is not subject to proof of use.

Section 5(1), 5(2)(a) and (b)

46. Section 5 of the Act reads as follows:

> "(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.
>
> (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, [...] there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.
>
> (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."

47. Section 5A of the Act is as follows:

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

48. The following principles 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:

(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 greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

49. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

> "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 intended purpose and their method of use and whether they are in competition with each other or are complementary."

50. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

51. In *Gérard Meric v OHIM* Case T- 133/05, the General Court ("GC") stated that:

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

52. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM***,** Case T-325/06, the GC stated that "complementary" means:

> "[…] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."

53. In *Sanco SA v OHIM,* Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13*:*

> "It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes."

54. Whilst on the other hand:

> "[…] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

55. Neither party has made any submissions as to the similarity of the goods and services. As such, when the goods and services are not self-evidently identical or similar, I find that there is not similarity. Given the length of the applicant's specification, I will only list the goods and services which I consider to be similar:

Class 9

56. The opponent's earlier mark is registered for the following goods in class 9:

> **Class 9:** *Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; apparatus and instruments for recording, transmitting, reproducing*

or processing sound, images or data; recorded and downloadable media, computer software, blank digital or analogue recording and storage media; mechanisms for coin-operated apparatus; cash registers, calculating devices; computers and computer peripheral devices; diving suits, divers' masks, ear plugs for divers, nose clips for divers and swimmers, gloves for divers, breathing apparatus for underwater swimming; fire-extinguishing apparatus.

57. Many goods in the contested specifications are related to computers, software, non-fungible token and recorded and downloadable media. The opponent's specifications cover computer software at large, computers and computer peripheral devices and recorded and downloadable media. Further the description of some of the objected goods, i.e. *downloadable software for viewing […] non-fungible tokens; downloadable digital media, namely, digital collectibles, digital tokens, non-fungible tokens (NFTs), cryptocurrencies, and digital art; downloadable software namely, virtual goods in the field of […];* indicate that (a) there is software used to view NFTs (which would make the goods highly complementary to the opponent's computer software) and (b) NFTs are a form of *downloadable digital media* (and, as such, would be covered by the opponents' term *recorded and downloadable media*) and virtual goods are a form of downloadable software (and, as such, would be covered by the opponents' term *computer software*). In addition, the opponent's specification cover, inter alia, divers' masks which would be similar to the contested *sport googles*, the latter including googles for swimming. On that basis, I find that the following goods are identical or similar to the opponent's goods:

Mobile phone applications; downloadable software; computer software and programs; non-fungible tokens (NFTs); downloadable software for use in electronically trading, storing, sending, receiving, accepting, buying, selling, accessing, and transmitting crypto-collectibles, digital collectibles, non-fungible tokens and other application tokens; downloadable software for use in electronically trading, storing, sending, receiving, accepting, and transmitting digital currency, virtual currency and cryptocurrency; downloadable software for use in electronically managing digital currency, virtual currency, and cryptocurrency payment and exchange transactions; downloadable software for viewing crypto-collectibles, non-fungible tokens and other application

tokens; downloadable audio and video recordings featuring content authenticated by non-fungible tokens; Video recordings; downloadable virtual goods, namely, non-fungible tokens (NFTs); downloadable digital media, namely, digital collectibles, digital tokens, non-fungible tokens (NFTs), cryptocurrencies, and digital art; downloadable software for processing digital files, digital art, media, videos, photography, music, data, statistics, graphics, or visual effects; pre-recorded audio and video compact discs; DVDs; motion picture films; digital recording media; animated films; recorded media; recorded films; musical sound recordings; podcasts; computer games; interactive game programs and software; downloadable computer and electronic game programs; computer and electronic game software for use on mobile phones and wireless devices; downloadable software and computer programs in the nature of a mobile application for playing games; downloadable game related software applications; computer software for the administration of online games and mobile gaming; augmented reality software; artificial intelligence and machine learning software; virtual reality software for playing computer and video games; computer hardware for games and gaming; virtual reality headsets and glasses; audio-visual headsets for playing video games; downloadable information relating to games and gaming; downloadable publications; electronic publications; interactive electronic publications; headsets, microphones and speakers for phones, tablet computers, MP3 players, portable media players and PDAs; downloadable virtual goods in the field of beverages, food, supplements, sports, gaming, music, and apparel; downloadable software namely, virtual goods in the field of beverages, food, supplements, sports, gaming, music, and apparel for use in virtual environments and worlds; downloadable software namely, virtual goods in the nature of beverages, food, supplements, bags, beverageware, coolers, clothing, headwear, footwear, gloves, scarves, tool kits, helmets, umbrellas, blankets, tents, towels, sporting equipment, musical instruments and accessories, sound and audio equipment and accessories, timepieces, jewellery, earrings, toys, toy cars, video game equipment and accessories, games, notebooks, coasters, posters, accessories, and other retail items; downloadable virtual goods, namely, computer programs featuring beverages, food, supplements, bags, beverageware, coolers, clothing, headwear, footwear,

gloves, scarves, tool kits, helmets, umbrellas, blankets, tents, towels, sporting equipment, musical instruments and accessories, sound and audio equipment and accessories, timepieces, jewellery, earrings, toys, toy cars, video game equipment and accessories, games, notebooks, coasters, posters, accessories, and other retail items; downloadable multimedia file containing artwork, text, audio, and video; downloadable multimedia file containing artwork, text, audio, and video relating to beverages, food, supplements, sports, gaming, music, and apparel authenticated by non-fungible tokens; non-fungible tokens; blockchain tokens; downloadable computer software for managing, displaying, monetizing, buying, selling, trading, transferring, clearing, confirming, and authenticating virtual goods, blockchain tokens, digital tokens, non-fungible tokens, digital media, digital files, and digital assets; downloadable computer software for use as a digital token wallet; cryptocurrency hardware wallets; downloadable software for enabling users to electronically create, store, send, receive, accept, exchange, and transmit digital assets; sports goggles; eBook.

58. However, I do not find any obvious overlap with the following goods which I find to be **dissimilar:**

Spectacles; reading spectacles; sunglasses; 3D spectacles; eyeglass and sunglass cases; decorative magnets; sports helmets; bicycle helmets; protective covers and cases for electronic devices namely, computers, tablet computers, mobile phones, digital cameras, digital media players, electronic book readers, smartwatches, and personal digital assistants; walkie-talkies; notebook holders; covers for mobile phones, smartphones, MP3 players, portable media players, tablet computers.

Class 14

59. The opponent's earlier mark is registered for the following goods in class 14:

Class 14: *Precious metals and their alloys; jewellery, precious and semi-precious stones; horological and chronometric instruments, clocks and watches.*

60. The contested goods in class 14 are as follows:

Precious metals and their alloys; jewellery; costume jewellery; precious stones; natural or synthetic precious stones; gemstones; imitation jewellery; earrings; bracelets; necklaces; brooches; cuff-links; ornamental pins; tie pins; horological and chronometric instruments; watches; watch straps; clocks; key rings; jewellery cases.

61. With the exception of *key rings; watch straps* and *jewellery cases,* the contested goods are either self-identical to the opponent's goods or fall within the opponent's broad terms and so are identical on the principle outlined in *Meric*. In addition, *watch straps* and *jewellery cases* are similar to at least a low degree the opponent's goods because they share trade channels, target the same uses and are complementary. The same goes for *key rings* which are frequently sold in jewellery shops and manufactured by the same producers of jewellery out of the same material. These goods are either identical or similar to a low degree.

Class 25

62. The opponent's earlier mark is registered for the following goods in class 25:

Class 25: *Clothing, footwear, headwear.*

63. The contested goods in class 25 are as follows:

Clothing; headgear; footwear; articles of clothing made of cashmere; articles of clothing made of leather or of imitation leather clothing; knitwear [clothing]; outer clothing; suits; coats; topcoats; jackets; parkas; waistcoats; raincoats; wraps; blouses; shirts; t-shirts; bodies; combinations (clothing); jerseys (clothing); pullovers; sweaters; sweat shirts; skirts; dresses; petticoats; aprons

(clothing); trousers; shorts; pants; sportswear; gymnastic clothing; gymnastic and sports outfits; yoga clothing; running wear; running gloves; winter sports wear; fleece jackets; sports blousons; playsuits; tennis wear; track suits; swim wear; pyjamas; nightwear; night gowns; dressing gowns; underwear; corsets (underclothing); brassieres; bodices; lingerie; slips (undergarments); briefs; boxer shorts; stockings; socks; tights; leggings; hosieries; baby pants; baby bodies; baby sleepwear; bathrobes; swimming costumes; bikinis; bathing trunks; bathing and shower caps; beach clothes; neckerchiefs; bow ties; collars; belts (clothing); money belts (clothing); ties; trouser straps; hats; hoods (clothing); headbands (clothing); caps; ear muffs (clothing); visors (hats); shawls; scarves; shoulder wraps (clothing), mittens; mufflers; gloves (clothing); boots; ankle boots; lace boots; sandals; slippers; shoes; sports shoes; boots for sports and beach shoes; bath slippers; sandals; gymnastic shoes; dress handkerchiefs; paper clothing; masquerade costumes; aprons; foot warmers; football boots; football shoes; football jerseys; football shirts; replica football kits.

64. The contested goods are either self-identical to the opponent's goods or fall within the opponent's broad terms and so are identical on the principle outlined in *Meric.* These goods are identical.

65. In addition, I find that the contested terms *bags; handbags; wallets; purses* in class 18 are aesthetically complementary to the opponent's clothing and are likely to share users and trade channels. These goods are similar to a low degree.

Class 28

66. The opponent's earlier mark is registered for the following goods in class 28:

Class 28: *Games, toys and playthings; video game apparatus; gymnastic and sporting articles; decorations for Christmas trees.*

67. The contested goods in class 28 are as follows:

Games, toys and playthings; video game apparatus; console gaming devices; portable gaming devices; action figures and accessories; board games, card games, playing cards; miniature toy vehicles, airplanes and helicopters; battery operated remote controlled toy vehicles; flying discs; jigsaw puzzles; kites; marbles; water squirting toys; toy pistols; target sets comprising toy guns, suction darts and target; pinball and arcade game machines and hand held units for playing electronic games; electronic games; arcade games; toy masks; toy houses for dolls; toy cars; teddy bears; plush toys; game cards, namely collectible trading cards; electronic games and consoles; sporting equipment; physical exercise equipment; footballs; tennis balls; cricket balls; rugby balls; baseballs; volleyballs; golf balls; lacrosse balls; football gloves; football equipment.

68. The contested goods are either self-identical to the opponent's goods or fall within the opponent's broad terms and so are identical on the principle outlined in *Meric.* These goods are identical.

Class 32

69. The opponent's earlier mark is registered for the following goods in class 32:

Class 32: *Beers; non-alcoholic beverages; mineral and aerated waters; fruit beverages and fruit juices; syrups and other non-alcoholic preparations for making beverages.*

70. The contested goods in class 32 are as follows:

Non-alcoholic beverages; non-alcoholic beverages including carbonated drinks and energy drinks; syrups, concentrates, powders and preparations for making beverages, including carbonated drinks and energy drinks; beer; mineral and sparkling water; de-alcoholised beverages; fruit drinks; fruit juices; fruit syrups; energy drinks containing caffeine; beverages containing vitamins.

71. The contested goods are either self-identical to the opponent's goods or fall within the opponent's broad terms and so are identical on the principle outlined in *Meric.* These goods are identical.

Class 41

72. The opponent's earlier mark is registered for the following services in class 41:

> **Class 41:** *Education; providing of training; entertainment; sporting and cultural activities.*

73. The contested services in class 41 are as follows:

> *Entertainment services; education services; teaching services; arranging and conducting events; publishing services; entertainment services featuring the provision of electronic media, multimedia content, videos, movies, pictures, images, text, photos, user-generated content, audio content and related information via the Internet and other communications networks; digital video, audio and multimedia entertainment publishing services; Entertainment services namely, providing non-downloadable digital collectibles, represented by non-fungible tokens via a blockchain network featuring footage, videos, data, statistics, records, images, art, visual effects, photography, graphics, and virtual experiences; Production, distribution, display and storage of digital collectibles in the nature of interactive media, video, photography, music, statistics, data, graphics, or visual effects, represented by non-fungible tokens via a blockchain network; entertainment services, namely, providing an online virtual environment for trading virtual cards and tokens; use of digital collectibles in contests, games and challenges; providing online electronic game software and video game software; providing entertainment news and information relating to electronic games, video gaming, and e-sports; lottery services; prize draws; gaming and gambling services; betting services; online gambling services; arranging, operating, organising and conducting lotteries and prize draws, including scratch cards; online gaming services in the nature of lotteries and prize draws; football academy services; arranging and conducting of live*

entertainment events; production, presentation, distribution, syndication, networking and rental of motion pictures, films, radio and television programmes and sound and video recordings; providing entertainment in the nature of audio-visual content via a website; providing online information in the fields of entertainment, motion pictures, films, radio and television programmes and sound and video recordings; provision of electronic publications, including online books, magazines, periodicals and newsletters, accessible via databases and the Internet; provision of non-downloadable entertainment content, videos and publications all via a website; providing online electronic publications, not downloadable, in the nature of electronic newsletters; publication of texts, illustrations, calendars of events, schedules, books, magazines, newspapers, periodicals and more generally all types of publication, including electronic and digital publishing; sports activities; sports services; sports entertainment services; sports education services; sports training; sports coaching services; sports events; entertainment services, namely, providing virtual goods, blockchain tokens, digital tokens, non-fungible tokens, digital media, digital files, and digital assets for use in online virtual environments; entertainment services, namely, providing on-line, non-downloadable virtual beverages, food, supplements, bags, beverageware, coolers, clothing, headwear, footwear, gloves, scarves, tool kits, helmets, umbrellas, blankets, tents, towels, sporting equipment, musical instruments and accessories, sound and audio equipment and accessories, timepieces, jewellery, earrings, necklaces, toys, toy cars, video game equipment and accessories, games, notebooks, coasters, posters, accessories, and other retail items for use in online virtual environments; entertainment services, namely, production, distribution, display, and storage of digital collectibles; entertainment services, namely, providing an on-line virtual environment for using, trading, and purchasing virtual goods, blockchain tokens, digital tokens, non-fungible tokens, digital media, digital files, and digital assets; providing online non-downloadable software for entertainment purposes; providing online non-downloadable software for entertainment purposes, namely, for shopping; Providing recorded media, videos, photography, music, data, statistics, graphics, and visual effects; information, advisory and consultancy services in relation to the aforesaid services.

74. Many services in the contested specifications are related to entertainment, education and sport. The description of some of the objected goods, i.e. *entertainment services featuring the provision of electronic media, multimedia content, videos, movies, pictures, images, text, photos, user-generated content, audio content and related information via the Internet and other communications networks; multimedia entertainment publishing services; providing entertainment in the nature of audio-visual content via a website;* indicate that the provision and publication of multimedia content is an entertainment service. As such I find that the earlier specification covering entertainment and education at large, encompass all but one of the contested services, the only exception being *operating betting and non-betting gaming equipment,* which is neither an entertainment not an educational service.

Overall conclusion on the similarity of the goods and services.

75. The goods and services which I found to be identical or similar to the opponents' goods and services are as follows:

> **Class 9:** *Mobile phone applications; downloadable software; computer software and programs; non-fungible tokens (NFTs); downloadable software for use in electronically trading, storing, sending, receiving, accepting, buying, selling, accessing, and transmitting crypto-collectibles, digital collectibles, non-fungible tokens and other application tokens; downloadable software for use in electronically trading, storing, sending, receiving, accepting, and transmitting digital currency, virtual currency and cryptocurrency; downloadable software for use in electronically managing digital currency, virtual currency, and cryptocurrency payment and exchange transactions; downloadable software for viewing crypto-collectibles, non-fungible tokens and other application tokens; downloadable audio and video recordings featuring content authenticated by non-fungible tokens; Video recordings; downloadable virtual goods, namely, non-fungible tokens (NFTs); downloadable digital media, namely, digital collectibles, digital tokens, non-fungible tokens (NFTs), cryptocurrencies, and digital art; downloadable software for processing digital files, digital art, media, videos, photography, music, data, statistics, graphics, or visual effects; pre-recorded audio and video compact discs; DVDs; motion*

picture films; digital recording media; animated films; recorded media; recorded films; musical sound recordings; podcasts; computer games; interactive game programs and software; downloadable computer and electronic game programs; computer and electronic game software for use on mobile phones and wireless devices; downloadable software and computer programs in the nature of a mobile application for playing games; downloadable game related software applications; computer software for the administration of online games and mobile gaming; augmented reality software; artificial intelligence and machine learning software; virtual reality software for playing computer and video games; computer hardware for games and gaming; virtual reality headsets and glasses; audio-visual headsets for playing video games; downloadable information relating to games and gaming; downloadable publications; electronic publications; interactive electronic publications; headsets, microphones and speakers for phones, tablet computers, MP3 players, portable media players and PDAs; downloadable virtual goods in the field of beverages, food, supplements, sports, gaming, music, and apparel; downloadable software namely, virtual goods in the field of beverages, food, supplements, sports, gaming, music, and apparel for use in virtual environments and worlds; downloadable software namely, virtual goods in the nature of beverages, food, supplements, bags, beverageware, coolers, clothing, headwear, footwear, gloves, scarves, tool kits, helmets, umbrellas, blankets, tents, towels, sporting equipment, musical instruments and accessories, sound and audio equipment and accessories, timepieces, jewellery, earrings, toys, toy cars, video game equipment and accessories, games, notebooks, coasters, posters, accessories, and other retail items; downloadable virtual goods, namely, computer programs featuring beverages, food, supplements, bags, beverageware, coolers, clothing, headwear, footwear, gloves, scarves, tool kits, helmets, umbrellas, blankets, tents, towels, sporting equipment, musical instruments and accessories, sound and audio equipment and accessories, timepieces, jewellery, earrings, toys, toy cars, video game equipment and accessories, games, notebooks, coasters, posters, accessories, and other retail items; downloadable multimedia file containing artwork, text, audio, and video; downloadable multimedia file containing artwork, text, audio, and video relating to beverages, food, supplements, sports,

gaming, music, and apparel authenticated by non-fungible tokens; non-fungible tokens; blockchain tokens; downloadable computer software for managing, displaying, monetizing, buying, selling, trading, transferring, clearing, confirming, and authenticating virtual goods, blockchain tokens, digital tokens, non-fungible tokens, digital media, digital files, and digital assets; downloadable computer software for use as a digital token wallet; cryptocurrency hardware wallets; downloadable software for enabling users to electronically create, store, send, receive, accept, exchange, and transmit digital assets; sports goggles.

Class 14, 25, 28, 32: all the contested goods

Class 18: *bags; handbags; wallets; purses*

Class 41: all services with the exception of *operating betting and non-betting gaming equipment* (which are dissimilar)

76. In *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA, Lady Justice Arden stated that:

> "49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

77. Under the present ground, some similarity of goods and services is therefore essential for a likelihood of confusion to be established. Since I have concluded that there is no meaningful similarity between some of the competing goods and services, the oppositions based on Sections 5(1), 5(2)(a) and (b) fail in relation to the goods and services which are not listed at paragraph 75.

Average consumer

78. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. In *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), Birss J. (as he then was) 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 parties were agreed that 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 words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

79. The average consumer will include both members of the general public and professional users. The parties' specifications cover a wide range of goods and services, but for most of them I consider that a medium degree of attention will be paid during the purchasing process.

80. The purchasing process is likely to be predominantly visual, with the goods and services predominantly being purchased through websites, apps or bricks-and-mortar premises. However, as word-of-mouth recommendations may also play a part, I do not discount that there may also be an aural component to the purchase.

Comparison of marks

81. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) 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 at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, 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."

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

83. The respective marks are shown below:

The contested marks	**The earlier mark**
The applicant's first mark 	
The applicant's second mark DIEGO ARMANDO MARADONA	
The applicant's third mark DIEGO MARADONA	

84. It is self-evident that the applicant's first mark is identical to the earlier mark.

85. Turning to the second and third marks, although the applicant denies that they are similar to the earlier mark, it does not deny the opponents' claims that:

a. the opponents' earlier mark protects the signature and first forename of the famous football player, Diego Armando Maradona. It comprises of the name DIEGO MARADONA in a written script form together with the number 10 positioned beneath it, this being the number the well-known footballer predominantly used throughout his career as a football player.

b. both the earlier mark and the applicant's marks will be perceived as conveying an association with the well-known footballer DIEGO ARMANDO MARADONA by virtue of appropriating the footballer's full name (the applicant's marks) and his signature (the opponent's earlier mark).

86. As these claims are not denied, I will proceed on the basis that they are admitted. It follows that whilst the visual and aural differences between the opponent's earlier marks and the applicant's second and third mark mean that they are not visually and aurally identical, they are nonetheless similar insofar as they share the identical forename DIEGO and the surname MARADONA (which, in the applicant's second and third mark, appears in standard letters, whereas in the opponent's earlier mark appears as a handwritten signature that will be perceived and read as the surname MARADONA). Consequently, both the applicant's marks and the earlier mark will all be associated with the name and signature of the famous football player DIEGO ARMANDO MARADONA and are conceptually identical (or highly similar).

Distinctive character of the earlier mark

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

> “22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

88. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

89. As it will be recalled, the earlier mark consists of the signature of the famous football player DIEGO ARMANDO MARADONA. The applicant has not denied that the mark will be perceived/understood as Maradona’s signature and Maradona’s renown is not in dispute. The renown of the football player means that the mark is also distinctive to a very high degree.

Likelihood of confusion

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

91. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark,* BL O/375/10, where Iain Purvis Q.C. (as he then was) as the Appointed Person explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This

may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

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

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

92. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis's formulation but added:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

93. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

Earlier in this decision I found that:

a) Some of the goods and services at issue are identical or similar.

b) The average consumer for the goods and services is a member of the general public or a business user, who will pay a medium degree of attention during the purchasing process.

c) The purchasing process is predominantly visual, although I do not discount an aural component to the purchase.

d) The applicant's first mark is identical to the opponents' earlier mark. Both marks convey the identical signature of the famous football player Diego Armando Maradona.

e) The applicant's second and third marks both convey the name of the famous football player Diego Armando Maradona. They are conceptually identical or highly similar to the earlier mark which conveys the signature of the same famous football player.

f) The earlier mark is distinctive to a very high degree.

94. I keep all these findings in mind when considering whether a likelihood of confusion exists.

95. Taking into account the identity of the earlier mark and the applicant's first mark, the opposition against this mark succeeds in relation to the goods and services which I found to be identical (under Section 5(1)) and similar (under Section 5(2)(a)).

96. Turning to the second and third earlier marks, the fact that those marks will be associated with the name of the famous football player DIEGO ARMANDO MARADONA and the earlier mark will be associated with his signature, will result in the relevant public being confused into thinking that both marks come from the same stable, namely the entity responsible for exploiting the rights to the name and image of the deceased football player, being the successors of the late football player or a licensee.

CONCLUSION

97. The oppositions have been successful in their entirety under Section 3(6) and partially under Sections 5(1) and 5(2). Accordingly, the applicant's trade mark application nos. 3828657, 3829141 and 3829134 will be refused in their entirety.

COSTS

98. The opponents have been successful and are, therefore, entitled to a contribution towards their costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the opponent the sum of £2,800, calculated as follows:

Preparing three notices of opposition:	£1,200
Filing evidence:	£1,000
Official fees:	£600
Total:	£2,800

99. I therefore order Maradona Global Limited to pay Diego Armando Maradona Sinagra, Dalma Nerea Maradona Villafañe, Dinorah Gianinna Maradona Villafañe, Diego Fernando Maradona Ojeda, and Jana Maradona the sum of £2,800. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 15th day of May 2025

TERESA PERKS
For the Registrar