O/0848/24

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS. UK00003901540 AND UK00003901640
BY THE FOOTBALL ASSOCIATION PREMIER LEAGUE LIMITED
TO REGISTER THE TRADE MARKS:

IN CLASSES 9, 14, 16, 18, 25, 28, 35, 38 AND 41

AND

IN CLASSES 9, 14, 16, 18, 25, 28, 35, 38 AND 41

AND

IN THE MATTER OF THE OPPOSITIONS THERETO
UNDER NOS. 442303 AND 442304
BY A BRANDS LIMITED

BACKGROUND AND PLEADINGS

1. On 17 April 2023, The Football Association Premier League Limited ("the applicant") applied to register the marks shown below under no. UK00003901540 ("the applicant's first mark") and UK00003901640 ("the applicant's second mark") in the UK:

UK00003901540 
UK00003901640 

2. Both applications were published for opposition purposes on 12 May 2023 in relation to a long list of goods and services in classes 9, 14, 16, 18, 25, 28, 35, 38 and 41.

3. On 02 August 2023, both applications were partially opposed by A BRANDS LIMITED ("the opponent"). The oppositions were initially based upon one single ground, namely Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). However, following a very late request by the opponent to amend its pleadings[1] (which was allowed), an additional ground under Section 5(4)(a) was added. Consequently, the oppositions now stand on two grounds, a Section 5(2)(b) ground based on one single earlier mark, and a Section 5(4)(a) ground based on an unregistered right.

[1] The request was made on 23 February 2024 immediately before the deadline for written submissions which were due on 26 February 2024.

4. The opposition under Section 5(2)(b) is directed against some of the goods and services for which registration is sought namely those listed below:

> **Class 25:** *Clothing; footwear; headgear; football boots; sportswear; football shirts; replica football kits*.
>
> **Class 41:** *Entertainment; Party planning [entertainment]; Entertainer services.*

5. Rather oddly, the term *football bibs* in class 25 is not opposed, and the applied-for specification in class 41 contains a long list of entertainment services which are not opposed, only the terms shown above having been identified as the objected ones. In this connection, the opponent explains its choice of partially opposing the class 25 and class 41 specifications as follows:

> *"We have used this trademark since its registration, for organisation of events, entertainment services, party planning, catering services of food and drink, and associated merchandise, namely clothing. Therefore, we oppose to this similar mark being used for the exact same purposes, under Class 25, as well as objecting to its use under Class 41".*

6. Under Section 5(2)(b), the opponent relies in both oppositions on the trade mark shown below and all goods and services covered by it:

UK00003174150 Summer Series Filing date: 12 July 2016 Registration date: 24 March 2017 **Class 25:** *T-shirts; Athletic clothing; Athletics footwear; Athletics vests; Athletics wear; Baseball caps; Baseball caps and hats; Baseball shoes; Beanies; Bras; Caps [headwear]; Casual footwear; Casual jackets; Casual trousers; Casualwear;*

Clothing; Footwear; Trousers; Tops [clothing]; Gloves; Ties; Wristbands; Hoods; Ties.

Class 43: *Services for providing food and drink; temporary accommodation; bar services; coffee shop services; restaurant services.*

7. The trade mark relied upon by the opponent is an earlier mark in accordance with Section 6 of the Act. As the mark had been registered for more than five years at the application date of the contested marks, it is subject to the proof of use provisions laid out in Section 6A of the Act.

8. The opponent did not make any specific comment as regards to the likelihood of confusion, aside from those that I have reproduced above which were stated in response to question Q9, i.e. *"Use this space to supply any further information about why you consider there is a likelihood of confusion and for example why you consider the respective marks or goods and/or services to be similar*". Nonetheless, the pleadings were considered to be sufficient to put in issue the similarity of the marks, the similarity of the goods and services, and the likelihood of confusion.[2]

9. Under Section 5(4)(a), the applicant objects to the same goods and services in classes 25 and 41 objected under Section 5(2)(b). The opponent relies upon the sign 'Summer Series', which it claims to have used throughout the UK since 2014 in relation to *"Organisation of events, entertainment services, party planning, catering services of food and drink, and associated merchandise, namely clothing".* The opponent claims that use of the contested marks would be contrary to the law of passing off.

10. The applicant filed a counterstatement (as well as an amended counterstatement) in both proceedings denying the claims made and putting the opponent to proof of use for the goods and services relied upon.

[2] In *SKYCLUB*, BL-O/044/21 Mr Phillip Johnson, sitting as the Appointed Person, stated that: "*it is possible to make the objection entirely by completing the boxes on TM7. There is no need to file a separate Statement of Grounds. Of course, where certain things are alleged a Statement of Grounds will be needed, for instance where enhanced distinctiveness is claimed. Nevertheless, an Opponent has a fully pleaded claim based on the completion of the boxes on Form TM7 alone."*

11. The proceedings were consolidated on 20 October 2023 under Rule 62(1)(g) of the Trade Marks Rules 2008.

12. The opponent is represented by Dynham LTD. The applicant is represented by Abion UK Limited. Both parties filed evidence. Neither party requested a hearing, but they both filed written submissions in lieu. This decision is taken following a careful consideration of the papers.

EVIDENCE

13. The opponent's evidence takes the form of two witness statements from Ali Mahdavi, the first dated 09 January 2024 (with accompanying exhibits 1-18), and the second dated 10 June 2024 (with accompanying exhibits 1-12). Mr Mahdavi is the opponent's director, and his evidence goes to the use of the earlier mark/sign "Summer Series".

14. The applicant's evidence takes the form of a witness statement from Matthew McAleer dated 12 August 2024 (with accompanying exhibits MM1-7). Mr McAleer is Trade Mark Attorney at Abion UK Limited, and his evidence is aimed at supporting the argument that the mark 'Summer Series' is descriptive and non-distinctive.

15. I do not intend to summarise the evidence filed by the parties (or their submissions, for that matter) in full. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

RELEVANCE OF EU LAW

16. 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.

DECISION

17. Section 6A of the Act states:

"(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the

mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

18. Section 100 is also relevant, which reads:

"If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

19. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer*

BV [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale

of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

20. Further, in *Awareness Limited v Plymouth City Council,* Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

> "22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

> and further at paragraph 28:

> "28. ..... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as "tuition services", is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to "tuition services" even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted."

21. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd,* Case BL O/404/13*,* Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

> "21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:
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> > [24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.
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> 22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not *'show'* (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

22. The relevant period in which genuine use must be established is the five-year period ending with the filing date of the application for registration: in both cases here it is 18 April 2018 to 17 April 2023.

The evidence of use

23. In its submissions in lieu, the applicant says that the opponent's evidence falls far below the standard required to support genuine use in the UK, during the relevant period. In particular, the applicant criticises the opponent's evidence for the following reasons:

(a) Exhibits 1-12 to Mr Mahdavi's first witness statement are screenshots from Facebook events and Eventbrite which show the expression 'Summer Series' being used descriptively, along with other phrases e.g. *"The Secret Experience Summer Series",* in order to promote a series of summer parties. The opponent has not demonstrated how any of this evidence relates to the class 25 goods and class 43 services covered by the earlier mark in particular given that the hosting venues will be providing the accommodation, bar and restaurant services.

(b) The invoices provided in Exhibits 13 – 15 to Mr Mahdavi's first witness statement are irrelevant given that they relate to venues and sound equipment rental. Furthermore, the invoices in Exhibit 13 do not make any reference to the opponent's mark and the invoices in Exhibit 15 are outside the relevant timeframe and should therefore be dismissed.

(c) Exhibit 16 to Mr Mahdavi's first witness statement relates solely to ticket sales for events which, again, has no relevance in respect of the opponent's goods and services, whereas Exhibits 17 - 18 do not make any reference to the sign 'Summer Series' and in any case, the evidence does not relate to the goods and services relied upon by the opponent.

(d) Exhibit 1-6 to Mr Mahdavi's second witness statement provide copies of Terms and Conditions with the host venues. The terms and conditions with one hotel

illustrate that the hotel provide the Class 43 services including (i) exclusive use of the Long Bar, The Restaurant, Courtyard Gardens and the Terrace Room; (ii) waitresses for the event; (iii) at least 4 bartenders for the duration of the event.

(e) Likewise, the terms and conditions with another hotel illustrate that the hotel will also provide the Class 43 services including: (i) exclusive access to LSQ Rooftop for A Brands Limited guests; (ii) service and management of all food and beverages; (iii) waiting staff for premium tables and bar staff.

(f) Exhibit 7 to Mr Mahdavi's second witness statement provides a quote from a company to provide boat hire with security and DJ equipment hire which does not show any use in relation to the Class 25 good or the Class 43 services.

(g) Exhibit 8 to Mr Mahdavi's second witness statement is a Private Charter Confirmation from the company mentioned at point (f) showing their provision of venue and staff hire (with the Crew, Bar Supervisor and Bar Staff being provided by the company listed in the confirmation).

(h) Exhibit 9 to Mr Mahdavi's second witness statement is an email chain which falls outside the relevant period and confirms that another company will provide the venue and staff.

(i) Exhibit 10 to Mr Mahdavi's second witness statement is an image of a menu linked to events taking place on 10 June 2023, 1 July 2023 and 29 July 2023 which are all outside the relevant period, and Exhibit 11 is a copy of the contract with the venue, however, as the events fall outside the relevant period, this is also irrelevant for evidencing use in these proceedings. Nonetheless, Exhibit 11 confirms that another company will provide the venue as well as the food and beverages.

(j) Exhibit 12 to Mr Mahdavi's second witness statement purports to evidence the use of the opponent's mark on clothing and is comprised of undated images as those shown below:

However, only two of the images show the words “THE SUMMER SERIES”, but no accompanying statements or evidence have been provided by the opponent to indicate that the paper wristbands or hats were sold to consumers. As such, this evidence clearly falls well short of establishing genuine use of the opponent’s mark in relation to the relevant class 25 goods during the relevant period. I should also add that in any event, the opponent does not provide any evidence of revenue generated by this purported use, and does not indicate how many wristbands or hats were manufactured or sold. Lastly, as the

applicant notes, whilst the opponent has failed to provide any context in relation to the alleged use on paper wristbands, the presumption would be that these are issued to attendees of events to allow them access to the event, or to certain areas within the event so the paper wristbands are not designed to be treated as items of clothing but merely as indications of someone's level of access.

(k) Likewise, there is no evidence of the opponent providing *"temporary accommodation"* or *"coffee shop service*s". Turning to *"Services for providing food and drink; bar services; restaurant services"*, these services are provided by the host venues rather than the opponent. No evidence has been provided showing the use of the earlier mark at the actual event venues, there are no 'SUMMER SERIES' banners, or signage in the evidence, the extent of the use of 'SUMMER SERIES' appears to be limited to adding the mark to photographs posted on social media. The situation could be considered akin to bands or musicians playing at event venues. Whilst the act is there providing the entertainment, it is still the host venue providing the food and drink/bar services.

23. The applicant also argues that the mark 'SUMMER SERIES' has been used descriptively (rather than in a trade mark sense) as demonstrated by some of the exhibits which state "*we are back for another series of summer parties*"; in this connection, the applicant also points out that the series of events referenced in the evidence are alleged to have happened in June, July, and August, all of which are summer months.

24. In his first witness statement, Mr Mahdavi states that the earlier mark has been used in relation to the registered goods in class 25 (i.e. *T-shirts; Athletic clothing; Athletics footwear; Athletics vests; Athletics wear; Baseball caps; Baseball caps and hats; Baseball shoes; Beanies; Bras; Caps [headwear]; Casual footwear; Casual jackets; Casual trousers; Casualwear; Clothing; Footwear; Trousers; Tops [clothing]; Gloves; Ties; Wristbands; Hoods; Ties*) and services in class 43 (*Services for providing food and drink; temporary accommodation; bar services; coffee shop services; restaurant services*). However, rather oddly, Mr Mahdavi also states that the opponent has been using the earlier mark "Summer Series" in relation to services for

which that mark is not actually registered, namely *organisation of entertainment and social events* in class 41 and focuses on that use.

25. Although use in relation to entertainment services in class 41 is claimed under the Section 5(4)(a) ground (which was introduced by way of an amendment of pleadings that was allowed after Mr Mahdavi's first witness statement had been filed), and is therefore relevant under the passing off ground, it is completely irrelevant for the purpose of establishing use of the earlier mark, because the latter is only registered for goods and services in classes 25 and 43.

26. Nonetheless, the opponent seems to think that evidence of use in relation to the organisation of events is relevant insofar as it argues that *"throughout the events, the food and drink and entertainment were provided to consumers holistically as part of the 'Summer Series' experience".* However, in his first witness statement, Mr Mahdavi stated that the food and drinks provided at the opponent's events were the responsibility of the venue. It stated:

> *"In 2011, The Opponent initiated its event services under the names "Secret Brunch" and "Secret Experience," providing a range of events, parties, and entertainment services. Renowned as a prominent event organiser in London, The Opponent operates exclusive social events, gaining recognition for its exclusive brunch and summer parties. In 2014, A Brands Limited established "The Summer Series" as an event label dedicated to parties with catering, bar services, and event management during the summer annually."*

27. Similarly, in its submissions in lieu, the opponent states:

> *"The evidence of the Opponent (detailed above) demonstrate that the Opponent has offered events since 2014 and not only offers entertainment but also food and drink under the mark (with the venues paying a percentage of the takings on food and drink provided under the mark in addition to the Opponent retaining the entire entertainment income received through ticket sales)."*

28. Further, as the applicant entirely correctly noted, Mr Mahdavi also clarified that under the agreement with the venues it would be the venue which provides the food and drinks at the events. He stated:

> *"The financial arrangement that the Opponent has with the venues where its Summer Series events are held is that of a revenue share model. That is, the Opponent would have an agreement where it would:*
> *a. Organise the event;*
> *b. Bring guests in;*
> *c. Provide the entertainment;*
> *whilst the hotel/restaurant would provide food and drinks to its guests under the provision of the Summer Series event. The Opponent would retain 100% of the ticket revenues but would be paid a 20/30% commission from revenues generated from the food and beverages. The Opponent would be paid this commission by invoicing the venue after the event. Below are Exhibits for the invoices to the venues for the commission generated from revenues of the food and beverage…"*

29. The evidence of marketing also shows that food and drinks are presented as being the responsibility of the event venue. For example, one of the events advertised online on www.eventbrite.co.uk mentions food, saying as follows:[3]

> *"FOOD*
> *A delicious brunch menu is put together by the hotel's award-winning restaurant and will be available for you to purchase throughout the day. Table ticket holders can order from the comfort of their own tables. Others can be seated in the dining area on a first come first served basis."*

30. Another event says that no food will be served and advised guests to eat plenty before arrival,[4] whereas a further event indicates that the venue is responsible for managing the serving of alcohol and reserves the right to refuse the service of alcohol at their sole discretion.

[3] Exhibit 4
[4] Exhibit 8

31. In addition, the turnover figures which are provided by Mr Mahdavi in his first witness statement are said to relate to events held under the brand "*Secret Brunch", "Secret Experiences*" and the sub-brand "*Summer Series*". Once again, this would be revenue generated by the sale of tickets for the events, as well as a 30% commission on the sales of food and beverages sold at the event. In this connection, the additional evidence filed with Mr Mahdavi's second witness statement does not take the opponent's case further. For example, the various contracts which have been produced at Exhibit 1-4 are agreements between the opponent and the hotels by which the parties agree that the hotel will provide the venue, as well as the food and drinks; further, one of the clauses mentions that the hotel will create a drink and food menu for the event but does not say that the menu will be offered by the opponent under the mark "SUMMER SERIES" (as opposed to the name of the hotel or restaurant providing the menu). In such circumstances reference to "summer series" on the menu offered by the venue would be perceived as a theme for the menu rather than as an indication of the origin of the food served. Admittedly, some of the terms and conditions included in the contracts refer to the opponent providing, purchasing and delivering a specific brand of vodka and/or champagne for the bar or the tables, however, this consists in supplying the venue/bar with alcoholic products labelled with third-party brands and does not amount to the opponent providing services consisting of the provision of food and drinks under the trade mark 'SUMMER SERIES'.

32. Bearing in mind all of the above, it is obvious that any food and beverages offered at the events organised by the opponent was the responsibility of the venue where the event was held. Consequently, a guest to the event would understand the provision of food and drink as being provided by the hotel/venue/restaurant, not by the opponent who would be seen as responsible solely for organising the entertainment and selling the tickets. Therefore, there is no use for the registered *Services for providing food and drink; bar services; coffee shop services; restaurant services*. Likewise, there is no evidence of use for the registered *temporary accommodation*. Accordingly, there is no use in relation to any of the class 43 services.

33. The same goes for the goods in class 25. Leaving aside the fact that the trade mark 'SUMMER SERIES' is not really visible on the goods, there is no indication of the volume of wristbands and caps distributed/sold at the events. As noted above, I

have found that the opponent's paper wristbands are not designed to be treated as items of clothing but merely as indications of someone's level of access. Nonetheless, and more significantly, the evidence in relation to both the paper wristbands and the opponent's caps is evidence of promotional items aimed at promoting the event services rather than goods offered/sold to the general public; as such, it cannot count towards genuine use. This is because, use on promotional goods would not be viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods in question. In *Silberquelle GmbH v Maselli-Strickmode GmbH,* Case C-495/07, the CJEU held that:

> "17. It is settled case-law that 'genuine use' within the meaning of the Directive must be understood to denote actual use, consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (Case C-40/01 *Ansul* [2003] ECR I-2439, paragraphs 35 and 36, and Case C-442/07 *Verein Radetzky-Orden* [2008] ECR I-0000, paragraph 13).
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> 18. It follows from that concept of 'genuine use' that the protection that the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial raison d'être, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings (*Ansul*, paragraph 37, and *Verein Radetzky-Orden*, paragraph 14).
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> 19. As the Commission submitted in its observations to the Court and as the Advocate General stated in points 45 and 55 of his Opinion, it is essential, in the light of the number of marks that are registered and the conflicts that are likely to arise between them, to maintain the rights conferred by a mark for a given class of goods or services only where that mark has been used on the market for goods or services belonging to that class.

20. For the reasons set out in points 48 and 56 of that Opinion, that condition is not fulfilled where promotional items are handed out as a reward for the purchase of other goods and to encourage the sale of the latter.

21. In such a situation, those items are not distributed in any way with the aim of penetrating the market for goods in the same class. In those circumstances, affixing the mark to those items does not contribute to creating an outlet for those items or to distinguishing, in the interest of the customer, those items from the goods of other undertakings.

22. In the light of the foregoing considerations, the answer to the question referred is that Articles 10(1) and 12(1) of the directive must be interpreted as meaning that, where the proprietor of a mark affixes that mark to items that it gives, free of charge, to purchasers of its goods, it does not make genuine use of that mark in respect of the class covering those items."

34. In *Claridge's Hotel Ltd v Claridge Candles* Ltd [2019] EWHC 2003 (IPEC), Mr Recorder Campbell QC applied the case law of the CJEU, including *Ansul* and *Silberquelle,* as requiring that the effect of use relied on was to create or maintain a market for the goods/services covered by the registration. Consequently, he held that even though the claimant in *Claridge's* had applied that mark to toiletries and magazines, it had not sought to create a market for those goods; it had provided them [free of separate charge] to create or maintain the market for its hotel services. By contrast, the judge held that the claimant's mark had been put to genuine use in relation to restaurant, café, and bar services, as well as conference, business and health club services, notwithstanding the fact that these services were marketed only in connection with its hotel.

35. Accordingly, on the basis of the evidence before me, I am not satisfied that genuine use has been made on or in relation to any of the earlier goods and services in classes 25 and 43.

36. The opponent has failed to establish genuine use of its earlier mark within the relevant period. Accordingly, the opposition under Section 5(2)(b) fails at the first hurdle and is dismissed accordingly**.**

Section 5(4)(a)

37. Section 5(4)(a) states:

> "(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
>
> > (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
> >
> > (aa) […]
> > (b) […]
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

38. Subsection (4A) of Section 5 states:

> "(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

39. In *Discount Outlet v Feel Good UK,* [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

> "55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt &*

Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether *"a substantial number"* of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

40. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

(a) the nature and extent of the reputation relied upon,

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

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

The relevant date for Section 5(4)(a)

41. In *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of Section 5(4)(a) of the Act, as follows:

"43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether

the position would have been any different at the later date when the application was made.' "

42. The *prima facie* relevant date is the date the contested marks were filed. Although the applicant has filed evidence, it is not about the use of the applied-for marks. Hence, the relevant date in both proceedings is 17 April 2023.

Goodwill

43. Under this ground, the opponent claims that it has used the unregistered sign 'SUMMER SERIES' throughout the UK since 2014 in relation to *"Organisation of events, entertainment services, party planning, catering services of food and drink, and associated merchandise, namely clothing".*

44. I have already concluded that the opponent's evidence (including Mr Mahdavi's second witness statement which was filed after the Section 5(4)(a) ground had been added) does not establish use in relation to the registered goods and services, namely *T-shirts; Athletic clothing; Athletics footwear; Athletics vests; Athletics wear; Baseball caps; Baseball caps and hats; Baseball shoes; Beanies; Bras; Caps [headwear]; Casual footwear; Casual jackets; Casual trousers; Casualwear; Clothing; Footwear; Trousers; Tops [clothing]; Gloves; Ties; Wristbands; Hoods; Ties* (in class 25) and *Services for providing food and drink; temporary accommodation; bar services; coffee shop services; restaurant services* (in class 43). For the same reasons as those I have outlined above, I find that the opponent's evidence does not establish goodwill in relation to the more restricted (but still identical) goods and services claimed under Section 5(4)(a), namely *catering services of food and drink, and associated merchandise, namely clothing.*

45. As regards the opponent's claim that it is the owner of an actionable goodwill under the sign in relation to services consisting of *organisation of events, entertainment services, party planning*, admittedly the evidence establishes that there has been some use in the UK, although it is very limited.

46. First, while Mr Mahdavi says that use started in 2014, turnover figures are given only from 2019 with a total of £1.2 million in the four-year period of 2019-2022. In this connection, I have disregarded the figures for 2023, because they must relate to summer events which took place after the relevant date of 17 April 2023.

47. Second, the events in relation to which the opponent has used its sign took place only over the summer in June and July, and in one instance in August, which means that the sign has not been used for most part of the year.

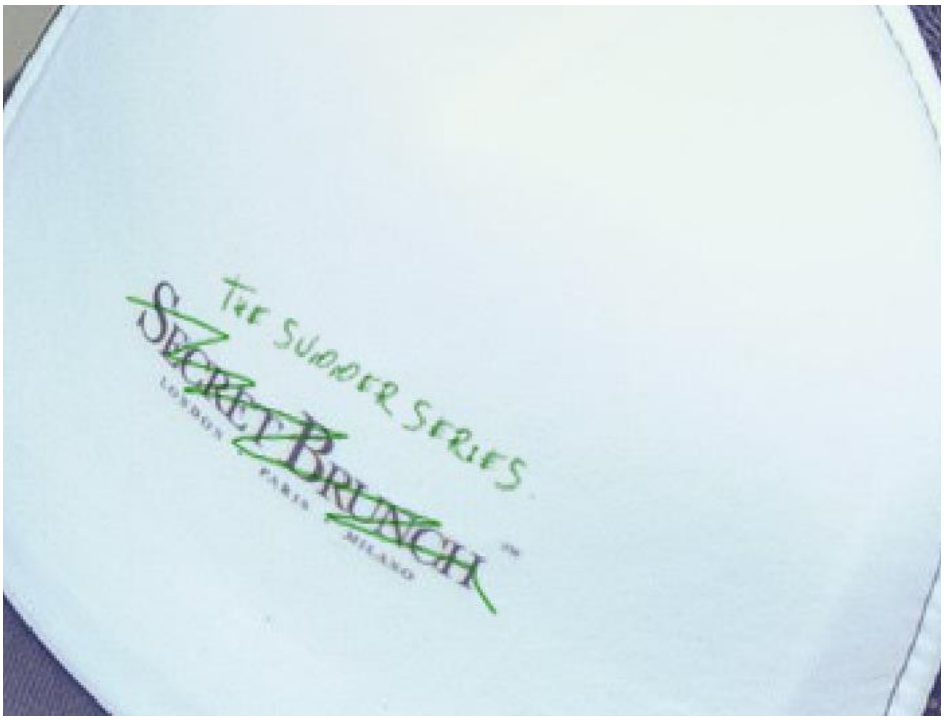
48. Third, the geographical extent of the use made in relation to those summer parties is restricted to one geographical area, namely London, with only one event taking place in 2017 and 2018, two in 2019 and 2022, and four in 2021; there were no events in 2020, probably due to the Covid pandemic.

49. Fourth, I agree with the applicant that the expression “SUMMER SERIES” is inherently weakly distinctive when used for a summer series of parties/events, and that the use the opponent has made of the sign is descriptive. Such descriptiveness is made even more apparent by the fact that the expression “SUMMER SERIES” has been used as a title based on a theme, along with the opponent’s main brands "Secret Brunch" and "Secret Experience" or the name of the event as shown by the examples below:

Saturday, 23 July

Final Summer Series Boat Party

50. This is important because descriptive or inherently non-distinctive marks require more use in order to acquire distinctiveness. Whilst it is not impossible to obtain sufficient goodwill in a descriptive name to support a claim for passing off, such use would have to be significant. Furthermore, as the applicant correctly pointed out, the evidence of the marks being used at events is very scant. For example, the phrase 'SUMMER SERIES' appears to be handwritten on a wristband and a cap and it is hardly legible as shown by the undated images below:



51. Lastly, I bear in mind the following factors:

(a) the self-evident descriptiveness (or otherwise very low inherent distinctiveness) of the words ‘SUMMER SERIES’ when used as the name of a series of parties/events held annually during the summer – that would not be a catchy name that would help guests remembering the party long after it is over.

(b) the fact that the events in relation to which the words ‘SUMMER SERIES’ have been used were not always held in the same venue - this would have made it less likely that the public would tie the events together in their recollection of previous events given also that the parties/events were an annual production.

(c) the fact that the opponent’s used the word ‘SUMMER SERIES’ as the name of the event/party, along with its main brands "Secret Brunch" and "Secret Experience" – in those circumstances the brand “Secret Brunch" and "Secret Experience" would be identified as the main sign denoting the origin of the services, whilst the word ‘SUMMER SERIES’ would be identified as denoting the theme of the party/event.

(d) the fact that the evidence does not establish that there was a community of partygoers which attended the opponent’s parties every summer.

52. In my view, bearing in mind all of the above, it is unlikely that the actual use made by the opponent had generated goodwill in the title or name ‘SUMMER SERIES’ and/or that the purchasers of the tickets would identify the name ‘SUMMER SERIES’ with the opponent. In this connection, whilst it is accepted that titles of newspapers, magazines and other periodical publications might have trade mark significance,[5] I am not persuaded that a name given to an annual recurring party which describes the seasonal theme of the party itself can generate goodwill. In contrast to the field of periodical publications where the publications are bought regularly and frequently, perhaps every day, week or month, the parties/events in relation to which the title/name ‘SUMMER SERIES’ has been used are annual summer events and there is no evidence that those who attended them were repeat customers who attend those parties/events again and again.

53. Accordingly, my primary finding is that the opponent did not have an actionable goodwill associated with the sign ‘SUMMER SERIES’ at the relevant date either because any goodwill which might have existed was trivial (and insufficient to sustain

[5] Wadlow on the Law of Passing-Off 6th Ed., 8-243 to 8-276.

an action for passing off),[6] or because it accrued to the "Secret Brunch" and "The Secret Experience" brands as the signs identifying the origin of the services.

54. If I am wrong and (1) the sign "SUMMER SERIES" was perceived by the relevant public as identifying the trade source of the opponent's parties/events and (2) the opponent had sufficient goodwill in the name 'SUMMER SERIES', such goodwill would be only in relation to *Organisation of summer events* and *summer party planning,* as the claimed goodwill in relation to entertainment services at large is too broad. In this connection, I have restricted the services relied upon by reference to their seasonal nature/theme because first, it reflects the use shown and the inherently weakly use made and second, if such restriction was omitted, it would conflate the strength of opponent's goodwill beyond what it really is. I will now go on to consider the question of misrepresentation and damage.

Misrepresentation

55. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

> "There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341* at page 407 the question on the issue of deception or confusion is
>
> > "is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]"
>
> The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd*. (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

[6] *Hart v Relentless Records* [2002] EWHC 1984 (Ch)

And later in the same judgment:

> ".... for my part, I think that references, in this context, to "more than *de minimis* " and "above a trivial level" are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion."

56. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, Lord Justice Lloyd commented on the paragraph above as follows:

> "64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the "substantial number" of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small."

57. Accordingly, once it has been established that the party relying on the existence of an earlier right under Section 5(4)(a) had sufficient goodwill at the relevant date to found a passing-off claim, the likelihood that only a relatively small number of persons would be likely to be deceived does not mean that the case must fail. There will be a misrepresentation if a substantial number of customers, or potential customers, of the claimant's actual business would be likely to be deceived.

Goods in class 25

58. As regards the opposed goods in class 25, I bear in mind that the competing fields of activity are different, the conflict being between items of clothing and the opponent's *Organisation of summer events* and *summer party planning.*

59. The requirements for passing off where there is no common field of activity is more stringent**.** In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

> "There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression "common field of activity" was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd*. (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although "the plaintiff and the defendant were not competing traders in the same line of business". In the *Lego* case *Falconer J*. acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.
>
> The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

> ‘…whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency) [1972] R.P.C. 838 at page 844 per Russell L.J.

In the *Lego case Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

> ‘even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.’

In the same case Stephenson L.J. said at page 547:

> '…in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged "passer off" seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.' "

60. The provision of clothing and the provision of *organisation of summer events and summer party planning* belong to different fields. The uses, users, methods of use of the goods and services are different, the goods and services do not share trade channels and are neither complementary nor in competition. In this connection, I have not overlooked the opponent's argument about event merchandise, however, the offering of merchandising goods (including goods in class 25) does not fall within notional and fair use of the applied-for goods in class 25 because it is not use that denotes the origin of the goods in order to create or preserve an outlet for those goods (conversely, it is used to promote the opponent's main business of party planning).

61. Turning to the services in class 41, i.e. *Entertainment; Party planning [entertainment]; Entertainer services,* they are sufficiently broad to encompass the opponent's earlier services *Organisation of summer events and summer party planning.* On that basis the services must be considered identical.[7]

62. In terms of similarity between the marks, the competing marks are as follows:

[7] *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05

The applicant's marks	The opponent's sign
	Summer series
	

63. The earlier sign consists of the word 'SUMMER SERIES' with no additional elements. In relation to the services for which the sign has been used, i.e. organisation of summer events and summer party planning, the sign is descriptive or, at best, very weakly distinctive.

64. The applicant's first mark consists of the image of a lion face wearing a crown. This figurative element is placed within a circle against a background of stars and stripes presented in a purple colour. The word 'SUMMER SERIES', are also present and positioned around the top right curve of the circle but are significantly smaller in size. Given the relative larger size and central position of the figurative element, and the descriptive or very weakly distinctiveness of the words 'SUMMER SERIES' which, in the context of the contested entertainment services will be perceived as referring to a characteristic of the services, namely that of the entertainment being in a form of a summer series (for example, a series of shows, events hosted in the summer or themed around summer), it is the figurative element that dominates the overall impression with the words 'SUMMER SERIES' playing a lesser role.

65. The second mark consists of the words 'SUMMER SERIES' presented on two levels in a slightly stylised and bold typeface and placed below the words 'PREMIER LEAGUE'. Between the words 'PREMIER' and 'LEAGUE' there is the image of a lion

head wearing a crown. Once again, in the context of the contested entertainment services, the words 'SUMMER SERIES' will be perceived as referring to a characteristic of the services, namely that of the entertainment being delivered in the form of summer series. The phrase 'PREMIER LEAGUE' (including the device) although smaller in size, is more distinctive than the words 'SUMMER SERIES' because a significant proportion of consumer will understand it as the name of a professional association football league in England (i.e. the highest level of the English football league system) and perceive it as the element of the sign which has trade mark significance.

The earlier sign and the applicant's first mark

66. Visually, the marks only overlap in the weakly distinctive elements, and the parts of the applicant's marks that create a striking impression are the elements that play a greater role in its overall impression. Accordingly, I consider that the earlier sign and the applicant's first mark are similar to a low degree due to the impact of the figurative elements which create a striking impression that is absent in the opponent' sign. Aurally, the device element will not be articulated in the applicant's first mark and thus the signs are identical. Conceptually, whilst the concept conveyed by the words 'SUMMER SERIES' is present in both signs, the concepts of the crowned lion and the stripe and star circle device introduce distinctive conceptual differences.

The earlier sign and the applicant's second mark

67. Visually and aurally, I consider that the earlier sign and the applicant's second mark are similar to a low to medium degree due to the larger size of the shared element 'SUMMER SERIES' but also bearing in mind the higher inherent distinctiveness of the phrase 'PREMIER LEAGUE' (including the device) which will be seen and articulated. Conceptually, whilst the concept conveyed by the words 'SUMMER SERIES' is present in both signs, the concepts of the English football league system and that of a crowned lion introduce distinctive conceptual differences.

68. I now draw together all of the matters set out above to constitute the cumulative basis for my conclusion under the Section 5(4)(a) ground.

Conclusions on misrepresentation

69. I shall start with the goods in class 25. In relation to these goods, I have found that there is no common field of activity, *clothing* and *organisation of summer events and summer party planning* belonging to different fields. Significantly, there are also other factors which militate against the opponent: first, the earlier sign 'SUMMER SERIES' is descriptive (and has been used in a descriptive manner) and second I have rejected the argument that notional and fair use of the applied-for marks in relation to clothing covers merchandise – on this point, in my view, there is no other plausible association between the respective fields of activity. Lastly, although the opponent's earlier sign and the applicant's first mark are aurally identical, the visual and conceptual similarity between them is low and this is very important because the goods will be selected mainly visually. In those circumstances, I think that it is unlikely that the public will be deceived into thinking that the opponent, who organises summer events/parties had diversified into the manufacture of clothing (the business of merchandise being different from that of selling clothes and goods in class 25) under a trade mark which differs in the typeface of the words, their colours, and the additional figurative elements of the crowned lion (in both marks) , stripe and star device (in the applicant's first mark) and the words 'PREMIER LEAGUE' (in the applicant's second mark). There is no misrepresentation (or damage) in relation to the goods in class 25.

70. Turning to the services in class 41, admittedly, they are identical to the services in relation to which the earlier sign has been used. However, as it will be recalled, the shared sign 'SUMMER SERIES' is descriptive, and it has been used in a descriptive manner by the opponent and will also be perceived as descriptive in the applications. Lastly, although the signs are visually similar to the extent that they coincide in the term 'SUMMER SERIES', they differ in the typeface of the words, their colours, and the additional figurative elements of the crowned lion (in both marks) , stripe and star device (in the applicant's first mark) and the words 'PREMIER LEAGUE' (in the applicant's second mark). Balancing all of these factors, I also conclude that there is no misrepresentation (or damage) in relation to the services in class 41.

71. The opposition also fails under the Section 5(4)(a) ground.

OUTCOME

72. The oppositions have failed, and the applications may proceed to registration.

COSTS

73. The applicant has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant the sum of £,1,700 calculated as follows:

Preparing a statement and considering the other side's statement (x2): £600
Filing evidence and considering the other party's evidence: £500
Written submissions: £600
Total: £1,700

74. I therefore order A BRANDS LIMITED to pay The Football Association Premier League Limited the sum of £1,700. 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 17th day of September 2025

TERESA PINTO
For the Registrar