

**O/314/18**

**TRADE MARKS ACT 1994**

**TRADE MARK APPLICATION No. 3193656**

**BY INTERNATIONAL GROUP MANAGEMENT LIMITED**

**AND**

**OPPOSITION No. 408581**

**BY THE FOOTBALL ASSOCIATION PREMIER LEAGUE LIMITED**

## Background and pleadings

1. This is an opposition by The Football Association Premier League Limited (“the opponent”) to an application filed on 27<sup>th</sup> October 2016 (“the relevant date”) by International Group Management Limited (“the applicant”) to register the marks shown below as a series of two trade marks.





The application is in class 41 and covers “*Organisation and regulation of video gaming competitions.*”

2. As nothing turns on the difference between the two marks, for the sake of convenience I will refer to them collectively as “the applicant’s mark”. My findings will apply equally to both marks.

3. The application was published for opposition purposes on 18<sup>th</sup> November 2016. Following a subsequent amendment of the application the list of services is now:

“*Organisation and regulation of video gaming competitions, none relating to association football.*”

4. The opponent opposes the application on grounds under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The s.5(2) and s.5(3) grounds are based on five of the opponent’s earlier marks, as shown below.

No./Territory	Mark	Classes	Filing date	Registration date
UK2147888	PREMIER LEAGUE	9, 14,16, 25, 26, 28, 41, 42	14/10/97	06/04/99
EU3784089	premierleague.com	41	20/04/04	04/09/07
EU5153077		6, 9,14,16,18, 24, 25, 26,28, 29, 30, 32, 33, 35, 38, 41, 43	05/06/06	01/10/08
EU12039251	FANTASY PREMIER LEAGUE	9, 16, 38, 41	02/08/13	18/09/14
UK3148844		3, 6, 9,14, 16, 18, 24, 25, 26, 28, 30, 32, 33, 35, 36, 38, 41, 43, 45	09/02/16	24/06/16

5. UK2147888 is subject to a disclaimer as follows:

“Registration of this mark shall give no right to the exclusive use, separately, of the words "Premier" and "League".

6. The opponent’s pleaded case was:

- The contested mark is similar to the earlier marks;
- All the goods/services covered by the earlier marks are the same or similar to the services covered by the contested mark;
- The earlier marks that are subject to proof of use (UK2147888, EU3784089 & EU5153077) had been put to genuine use during the previous 5 years in relation to all the goods and services for which they are registered;

- The earlier trade marks have acquired an enhanced distinctive character and reputation as a result of extensive use;
- The words PREMIER LEAGUE, in particular, are synonymous with the opponent;
- Use of the contested mark would create a likelihood of confusion with the earlier marks;
- Additionally, or alternatively, use of the contested mark would, without due cause, take unfair advantage and/or be detrimental to the reputation and distinctive character of the earlier marks;
- In particular, such use would “ride off the coat tails” of the reputation of the earlier marks.

7. The opponent’s ground of opposition under s.5(4)(a) of the Act is based on its claimed common law rights acquired in the words PREMIER LEAGUE as a result of the use of that sign in the UK since 1992. However, in contrast with the position the opponent took on its registered marks,<sup>1</sup> it claimed to have acquired goodwill and reputation under the marks in relation to a relatively narrower range of goods/services, namely:

“Computer games; computer software; downloadable electronic publications; games and playthings, apparatus for games; video game apparatus; sporting articles; education; providing of training; entertainment; sporting and cultural activities; entertainment information; provision of sporting facilities; online computer games; electronic game services provided by means of the internet; organisation of competitions; organisation of sporting events; entertainment services related to sport; providing online electronic publications, not downloadable; organisation and regulation of competitions; organisation and regulation of video gaming competitions.”

8. The applicant filed a counterstatement denying the grounds of opposition. I note, in particular, that the applicant:

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<sup>1</sup> The lists of goods/services of the five earlier marks occupied 28 pages of the notice of opposition.

- Admitted that 'ESPORTS' is descriptive of competitive video gaming;
- Denied that esports is a sport, or is in competition with traditional sports;
- Asserted that 'Premier League' is non-distinctive and in common use to denote top level competition;
- Denied that PREMIER LEAGUE is the dominant and distinctive element of the contested mark;
- Denied that the parties' marks are similar overall;
- Required proof of use of earlier marks UK2147888, EU3784089 & EU5153077;
- Denied that the goods/services covered by EU3784089 and EU12039251 are similar to the services covered by the contested mark;
- Admitted that "organisation of competitions [entertainment]" in UK3148844 is an identical service to the services covered by the contested mark;
- Claimed that it was unable to admit or deny whether the wide range of goods/services covered by UK2147888 and EU5153077 are similar to the services covered by the contested mark because the opponent had not particularised its claim sufficiently for it to understand which goods/services were claimed to be similar (or why);
- Similarly claimed to be unable to admit or deny whether the earlier marks had a reputation and enhanced distinctive character until the opponent realistically identified the scope of the claim;
- Denied that use of the contested mark would be "without due cause";
- Denied that the contested mark is designed to free-ride on the reputation of the opponent's earlier marks, or that it would take unfair advantage of any reputation attaching to those marks;
- Put the opponent to proof of the scope of the goodwill associated with Premier League given that the opponent's activities relate solely to association football.

9. Both sides seek an award of costs.

## Case management

10. The counterstatement was served on the opponent on 26<sup>th</sup> May 2017. The opponent was given until 26<sup>th</sup> July 2017 to file evidence in support of the opposition. On that day the opponent applied for an extension of 3 weeks to the period allowed for filing evidence. The opponent explained that it had gathered a large volume of evidence, but needed more time to complete this evidence and obtain further witness statements from third parties. In support of this application the opponent cited:

- (i) The advantage of completing the evidence after 31<sup>st</sup> July 2017, which is the end of the opponent's financial year and would allow up to date trading figures to be included;
- (ii) The need to file evidence of use and reputation of a number of marks;
- (iii) Late Spring/early summer is the off-season for football when those involved are often on holiday;
- (iv) The fact that two related parties to the applicant had filed further applications for marks including Premier League, which it had recently opposed and now intended to apply for consolidation of the proceedings;
- (v) The need to take account of the overriding objective set out in the Civil Procedure Rules, particularly showing that the parties were on an equal footing, dealing with the case in a way that is proportionate to its complexity, and ensuring it is dealt with fairly and expeditiously.

11. In anticipation that its evidence would exceed the 300 page 'trigger point' set out in Tribunal Practice Notice 1/2015 the opponent sought leave to file a larger volume of evidence. A case management conference ("CMC") was appointed for 17<sup>th</sup> August 2017 to cover:

- "1) Better identification of the goods/services the opponent relies on in this opposition;
- 2) The opponent's request to file over 300 pages of evidence;
- 3) The timetable, including the opponent's request for an extension of time to file evidence and any objection to it by the applicant;

4) Any consequential matters.”

12. On 16<sup>th</sup> August 2017 the opponent filed three witness statements, all from people who work for the opponent, with exhibits covering a total of 545 pages of evidence. Some of the reasons put forward to justify an extension of time appeared irrelevant. For example, the fact that parties related to the applicant had filed further applications for other marks was no reason to allow more time to file evidence in the current proceedings. And whilst the number of earlier marks relied on, and particularly the width of the claims made in relation to those marks, undoubtedly increased the evidential burden on the opponent beyond the norm, this was a consequence of the rather blunderbuss manner in which the opponent had chosen to present its case. I do not think that the overriding objective requires that proportionally more time should be given to a party to collect the volume of evidence required to support a poorly focussed case. The other arguments based on the timing of the holiday season in the football business and the imminent availability of annual trading date up to the end of July 2017 (when the relevant date is October 2016) also appeared weak. Nevertheless, I considered that, on balance, they were sufficient to justify the three week extension required in order to admit the evidence which had by then been filed.

13. I did not have time to review the evidence filed on 16<sup>th</sup> August before the CMC on the morning of 17<sup>th</sup> August 2017. However, following the CMC I reviewed the evidence. Later, on the same day, I issued the following directions:

“(1) The opponent’s request for a 3 week extension of time to file evidence should be granted.

(2) The opponent should state in writing, by 24<sup>th</sup> August, which goods/services the opponent still relies upon for the purposes of the use and reputation of the earlier marks in support of the s.5(2)(b) and s.5(3) grounds of opposition.

(3) The applicant should have 2 months to file evidence in support of the application, starting from 24<sup>th</sup> August.

(4) The costs for the CMC should be assessed and included in the costs awarded at the conclusion of the proceedings.”



Additionally, I directed that some of the opponent’s evidence should be excluded on the basis that it appeared to be irrelevant.

14. The opponent complied with the letter of the direction set out in paragraph 13(2) above, reducing the list of goods/services relied on in the earlier registrations from around 28 pages to just over 4 pages. However, given the identity of the opponent this still included a number of very surprising claims. For example, a claim that UK trade mark 3148844 had been used and acquired a reputation for “karaoke services.”

15. The opponent removed some of the evidence I had identified as irrelevant, but contested the direction to remove other parts of its evidence. Following a second CMC on 5<sup>th</sup> September 2017 the revised evidence was admitted without further alteration and directions were issued for the filing of the applicant’s evidence. The applicant filed its evidence on 2<sup>nd</sup> November 2017. The opponent filed its evidence-in-reply on 5<sup>th</sup> January 2018. At the same time, the opponent indicated that “*as the evidence rounds were now closed*” it had “*given some thought to how to narrow the issues in dispute and bring focus to the hearing.*” In keeping with this objective the opponent put forward a further revised list of the goods/services that it intended to rely on for each of the earlier marks, representing the opponent’s “*best case*”. This list is shown below.

Mark	Goods/services
UK2147888 PREMIER LEAGUE	Class 9: Games adapted for use with television receivers; computer software; all relating to Association football or the Football Association Premier League; all included in Class 9. Class 41: Services relating to sports' events and matches; all relating to the promotion of Association football; all included in Class 41.
EU3784089 premierleague.com	Class 41: Services relating to sports' events and matches; all relating to the Football Association Premier League.
EU5153077	Class 9: Games adapted for use with television receivers; computer games; computer software. Class 38: Broadcasting via television or over the Internet; pay-per-view television, video-on-demand. Class 41: Entertainment; sporting and cultural activities; information relating to sporting events provided on-line from a computer database or the Internet; electronic games



	<p>services provided by means of the Internet; organisation of competitions and sporting events; officiating at sports contests; entertainment services relating to sport; production of radio and television programmes.</p>
<p>EU12039251 FANTASY PREMIER LEAGUE</p>	<p>Class 9: Video game cartridges. Class 38: Telecommunications; Cable television broadcasting; Cellular telephone communication; providing an online gaming network; Providing access to databases; Radio broadcasting; Satellite transmission; Television broadcasting; Transmission of digital files; Wireless broadcasting. Class 41: Sporting and cultural activities; Organization of competitions [education]; Presentation of live performances; Production of radio and television programmes; Television entertainment.</p>
<p>UK3148844</p> 	<p>Class 9: Computer games; video games; computer software; Computer game software for use on mobile and cellular phones. Class 28: Computer game apparatus Class 38: Telecommunications; Cable television broadcasting; Providing access to databases; Satellite transmission; Television broadcasting; Transmission of digital files; Wireless broadcasting; Telecommunication of information; multimedia telecommunications; Internet portal services- broadcasting via television or over the Internet; pay-per-view television, video-on-demands broadcasting via cable television, radio; broadcasting of programmes by satellite; satellite broadcasting services relating to entertainment; satellite broadcasting services relating to sporting events; subscription television broadcasting; television broadcasting; streaming audio and video material on the internet; streaming of live football matches on the internet. Class 41: Entertainment; Sporting and cultural activities; Entertainment information; Game services provided on-line from a computer network; Live performances (Presentation of-); Organization of sports competitions; Television entertainment; Information relating to sporting events provided on-line from a computer database or the Internet; electronic games services provided by means of the Internet; organisation of competitions and sporting events; officiating at sports contests; entertainment services relating to sport; preparation of entertainment programmes for broadcasting; presentation of live entertainment; presentation of live football matches.</p>

I note that the re-revised list no longer includes karaoke services.

## The hearing

16. A hearing took place on 28<sup>th</sup> April 2018 at which Mr Simon Malynicz QC appeared as counsel for the opponent, instructed by Lane IP Limited. Mr Andrew Norris appeared as counsel for the applicant, instructed by Carpmaels & Ransford LLP.

17. By the time of the hearing the opponent's position was that its evidence was sufficient to show genuine use of earlier marks UK2147888, EU3784089 & EU5153077 in relation to the goods/services set out in the table above. The opponent submitted that, given that the PREMIER LEAGUE is a household name, it was "*astonishing*" that the applicant had put the opponent to proof of use of that mark.

18. The applicant's position was that it accepted that the opponent had shown use of PREMIER LEAGUE and premierleague.com in relation to *services relating to sports' events and matches; all relating to association football or the Football Association Premier League*. I also understood the applicant to accept that, within the limited scope of the list of services, PREMIER LEAGUE had a reputation. When I asked Mr Norris to clarify what the applicant understood by "*services relating to sports' events*" etc., he explained that the applicant thought it meant *the organisation and regulation* of such events and matches.

19. The applicant also accepted that the opponent had used EU5153077 in relation to *sporting and cultural activities, organisation of competitions and sporting events*, again subject to the restriction "*all relating to association football or the Football Association Premier League*."

20. The applicant specifically disputed that the opponent had shown genuine use of the PREMIER LEAGUE or premierleague.com marks in relation to *games adapted for use with television receivers; computer software, computer games or electronic games services provided by means of the Internet*. According to the applicant, the evidence showed only that Premier League had been used to designate the subject matter of a computer game marketed by a third party with the opponent's consent.

Similarly, the applicant disputed that the marks had been used in relation to any kind of broadcasting services, the use of Premier League being merely to indicate the subject matter of various broadcasts.

21. Mr Malynicz submitted that the opponent's closest mark was UK2147888 (PREMIER LEAGUE) and the closest earlier marks in terms of the respective services, were EU12039251 (FANTASY PREMIER LEAGUE) and UK3148844 (Premier League & lion's head), both of which covered *organisation of competitions per se*. The applicant accepts that these are identical to the services covered by the contested mark. Further, neither of these marks had been registered for long enough at the date of publication of the contested mark to be subject to the proof of use requirement set out in s.6A of the Act.

22. In my view, the opponent's best case is based on the registration and reputation of UK2147888 (PREMIER LEAGUE) and the registration of UK3148844 (Premier League & lion's head device) for *organisation of competitions*. None of the other three earlier marks relied on provide the opponent with any stronger case. In particular, the inclusion of FANTASY as the first word of EU12039251 means that it is less visually and (especially) aurally similar to the contested mark than UK3148844 (Premier League & lion's head device). Additionally, the description *organisation of competitions* in that registration is qualified by the word [*Educational*]. Video gaming competitions are unlikely to fall within the description *educational*. Therefore, although the respective services may be similar, they are not identical as they are with UK3148844.

23. This means that if the opponent's case under s.5(2) and s.5(3) fails on the basis of earlier marks UK2147888 and UK3148844, it will not succeed on the basis of any of the other earlier marks. Mr Malynicz accepted that the opponent's s.5(4)(a) ground added nothing to the case based on the earlier registered marks. This means that it is only necessary for me to examine the evidence and the arguments in so far as it is necessary to determine the conflict between the contested mark and earlier marks UK2147888 and UK3148844.

## The evidence

### The opponent's evidence-in-chief

24. The opponent's evidence consists of witness statements by Evan Ray (with 26 exhibits), Tom Greenwood (with 5 exhibits) and Matthew McAleer (with 8 exhibits).

25. Mr Ray is the applicant's Senior Commercial Solicitor. His evidence is that his company organises and operates the PREMIER LEAGUE football competition, which has run since 1992. According to Mr Ray, it is the most watched football league in the world. Over 13 million people attend Premier League matches in the UK each year. Examples of the mark in use at stadiums are in evidence.<sup>2</sup> An example is shown below.



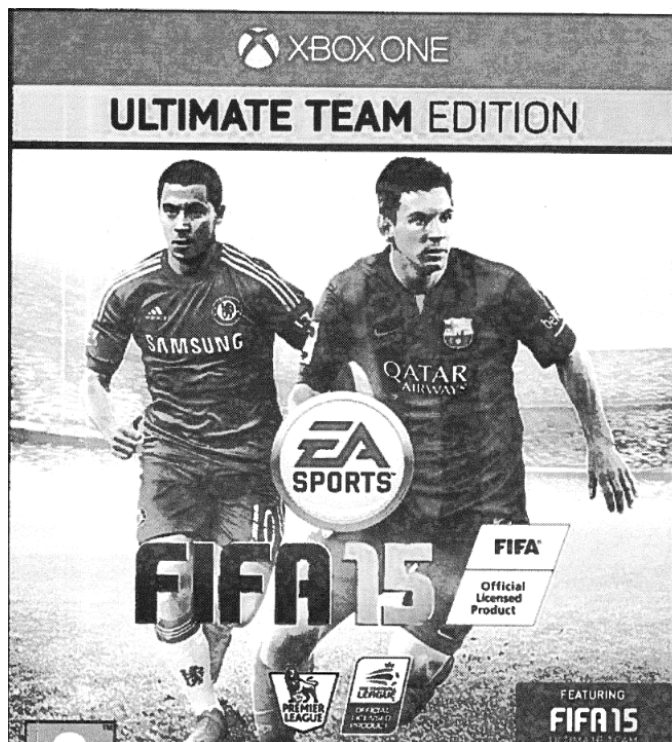
26. Mr Ray says that the applicant's biggest source of income is broadcasting revenue with the UK being the biggest revenue stream. The UK broadcasting rights for the 2013/14, 2014/15 & 2015/16 seasons sold for over £3 billion (out of total income of around £6 billion). However, whilst based in England and Wales, the Premier League is watched in 188 countries. In the season August 2015 to May

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<sup>2</sup> See exhibit ER3

2016, there were over 470 million European viewers of broadcast matches (excluding the UK). The comparative figure for the UK was 414 million.<sup>3</sup>

27. In addition to broadcasting revenue, Mr Ray says that the Premier League word and device marks are licensed on a variety of goods/services. Apart from broadcaster 'partners', Mr Ray provides limited information about licensing activities. Further, he mixes up information about licensing with sponsorship making it difficult to tell how much licensing activity takes place. However, Mr Ray does provide information about the applicant's relationship with EA Sports, which produces a video game series called FIFA. He says that a new version of the game has produced each year since 2011. It is adapted for playing on PlayStation and Xbox systems. Almost three million units of the game are sold each year in the UK alone, with many more in Europe. A picture of the game is shown below (from the 2015 season).



As can be seen, it is a game based on football. The EU5153077 mark appears towards the bottom of the front cover for the game.

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<sup>3</sup> Both figures obviously include multiple views of matches by the same people.

28. In addition to organising the Premier League football competition, the applicant also runs and regulates the Fantasy Premier League game. This is an online game. It allows users to assemble an imaginary team of real life footballers who score points based on the players' real life performances. In the year ending 1<sup>st</sup> June 2016, the game had over 3.5 million registered users.

29. Mr McAleer is a Trade Mark Attorney at Lane IP. His evidence includes an article from the website sermelo.com. It is from late 2017 and therefore about a year after the relevant date. However, the applicant relies on it for reasons explained below, so it is worth setting out the relevant points from it, which are:

*"...the professional Fifa community is small and draws a paltry amount of viewers compared to other eSports such as Dota 2, League of Legends or the recent Blizzard release." (i.e. non-football games)"*

*"In fact the prospect of gaining potential fans or indeed consumers from sponsorship must undoubtedly be a major reason for why both professional sports teams and big MNCs are getting involved with eSports. In particular, the demographics of the eSports community makes sponsoring eSports teams and players desirable for advertisers: according to the BBC around 75% of the fanbase are aged between 18-24 and 82% are male."*

30. Mr Greenwood is the applicant's Head of Partnership Activation. He leads the applicant's work on eSports along with Premier League clubs. Ms Greenwood says that he first met Mr Chester King (the moving force behind the applicant) in February 2016. They discussed eSports generally and Mr King mentioned the idea of an 'ePremier League'. He said he would come back when he had worked up the idea.

31. In January 2017 (i.e. after the relevant date), Mr Greenwood met Mr King again. Mr King explained that:

- eSports Premier League would be an eSports competition where fans of Premier League clubs competed against each other;

- eSports Premier League had nothing to do with football or sports games;
- The involvement of the Premier League clubs would be purely about fan engagement and data (i.e. getting supporters of rival clubs to play against each other, but not through football-based games).

32. Mr Greenwood says that he was sceptical about Mr King's assurances about the competition not involving football-based games.

### The applicant's evidence

33. Mr King is the Global Board Director of International Group Limited, which owns the applicant. Mr King says that he has been involved in esports since 2015 when he established the 'eGames', an international esports competition where gamers compete for medals not prize money. According to Mr King, in January 2016 the Business Secretary at the time, the Rt. Hon Sajid Javid MP, gave him authority to establish the 'British Esports Association'. Mr King explains that "*Esports means 'electronic sports' which is when the gaming community chooses a video game to be played in a competitive manner. Esports are video games of skill and always played human to human.*"

34. eSports can be played live in front of an audience or online. They can be played person to person or team to team. There are only around 35 esports video games. The majority of esports do not use sports video games. According to Twitch, the world's largest esports platform, the top 10 video games in August 2016 did not include any sports video games<sup>4</sup> (fighting and battle games being the most popular). According to Mr King, "*esports refers to the competitive element rather than the content of the games, and to elements like teams, fans, coaches and big attendance at the live finals.*" Mr King says that whilst there has been some debate in other countries, in the UK esports are classified as a game. In the UK, there are 3.6 million people who play or watch esports.

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<sup>4</sup> See exhibit CK8

35. Mr King says that:

- (i) He wanted to get away from the typical model of professional esports leagues so he created the concept of an esports league where fans of top sporting clubs would get to play each other;
- (ii) His idea was to involve fans from different sports, teams and leagues from around the world;
- (iii) One option was to start three 'ladders' with fans in China, UK and USA so the applicant could show esports matches online almost 24 hours per day;
- (iv) The esports tournament operator called Gfinity would help delivering the online and live matches;
- (iii) He wanted to use 'Premier League' in the name of this fans' league because it is a term in common use to describe top-level leagues.

36. To illustrate the last point, Mr King provides details of various other uses of 'Premier League' in esports and traditional sports, which he says are used or known about in the UK. The most apparently relevant are:

- (i) Premier League Basketball (unknown start date);
- (ii) The Indian Premier League (cricket, since 2008);
- (iii) Darts Premier League (since 2015);
- (iv) Premier League Gaming (unknown start date);
- (v) Mizuno Premier League (netball, since 2006);
- (vi) Polo Premier League (polo, unknown start date);
- (vii) Premier League (rugby, unknown start date);
- (viii) Premier League Snooker (1987 to 2012);
- (ix) Premier League (squash, since 2005);
- (x) Scottish Premier League (football, 1998 to 2013);
- (xi) Welsh Premier League (football, unknown start date).

37. Mr King says that he considered several names during 2016 including ePremier League. This was "*because 'esports' was not at the time a commonly known term.*" The name Esports Premier League was chosen because it fitted the concept of involving fans of 'premier' sports clubs from 'premier' sports in each country. On 12<sup>th</sup>



August 2016 the applicant applied to register this name as a trade mark. However, it was rejected by the trade mark examiner on the grounds that the name was descriptive of the services specified in the application. The applicant then decided to register the name in logo form. A branding agency was commissioned to create a logo. The brief was that (i) it should be easy to read and neutral enough to go on any esports team jersey as an armband, and (ii) it should be “*strong digitally*” with some sense of movement. The contested mark was the result.

38. Mr King says that his strategy was to get some iconic clubs on board so as to build momentum. So he spoke to Ron Greenwood at the Football Association Premier League, but also to a range of other clubs and organisations in various sports. These included Miami Dolphins (American football), Philadelphia 76s (basketball), Rajasthan Royals (cricket), Saracens (rugby), England Cricket Board, La Liga (football, Spain).

39. Mr King’s accounts of his meetings with the opponent differ in a number of respects from the account given by Mr Greenwood, but not in any respects which matter for present purposes. In particular, Mr King says that the applicant “*would not include a pure football computer game in the schedule of esports*”. Whilst expressing scepticism about the truth of it, Mr Greenwood’s evidence does not contradict this statement.

#### The opponent’s evidence in reply

40. The opponent’s evidence in reply consists of a second witness statement by Mr McAleer (with 12 exhibits). The relevant parts are as follows. Mr McAleer takes issue with Mr King’s claim that sports video games are not common in esports. He points out that the list of top 10 most popular games provided by Mr King is a global list. Therefore, it does not show that sports video games are not popular esports in the UK. He provides an extract from YouGov research into the esports market conducted in the UK in August 2017<sup>5</sup>, which states:

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<sup>5</sup> See exhibit MM13

“Sports games are popular amongst viewers and, in particular, future viewers – they are the third most popular type of game and the most popular type people are interested in watching.”

Mr McAleer points out that the YouGov research cites FIFA (a football video game) as an example of an esports game.

41. Mr McAleer also provides extracts from the British Esports Association website<sup>6</sup> which he notes states that “*FIFA is a hugely popular football game and the best selling sports video game series of all time*” and an ‘Esports Age Guide’ produced by the same organisation. The first games mentioned in this guide are FIFA and another football game called PES. Mr McAleer also provides extracts from the website of worldgaming.com.<sup>7</sup> He points out that of the 14 games listed on the site, 9 relate to sports and three of those to football. Mr McAleer notes Mr King’s evidence about a collaboration with esports tournament operator Gfinity. He provides an extract from the website of Gfinity, which lists 13 video games. He points out that 6 of these relate to the FIFA football game.<sup>8</sup>

42. As regards the use of Premier League by third parties, Mr McAleer’s evidence<sup>9</sup> is that:

- (i) The UK website for Premier League Basketball has barely any content and suggests that it is not an active competition;
- (ii) The Indian Premier League is an Indian domestic league and therefore irrelevant to the position in the UK;
- (iii) The PDC Darts Premier League appears international in nature and no evidence has been provided to show that it is well known in the UK;
- (iv) The UK website for Premier League Gaming has very little content, for example it has a blank home page;
- (v) There is no evidence that the England Netball Mizuno Premier League is likely to be widely known;

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<sup>6</sup> See exhibit MM13

<sup>7</sup> See exhibit MM14

<sup>8</sup> See exhibit MM19

<sup>9</sup> See exhibit MM16

- (vi) The website for the Polo Premier League is just a holding page;
- (vii) The use of Premier League by the North West Intermediate Rugby Union Traders Premier League is small scale use restricted to the North West of England and unlikely to be widely known in the UK;
- (viii) The Premier League Snooker has not been active since 2012 and there is no evidence that it was widely known to the public;
- (ix) Premier League Squash also appears to be used on only a small scale and is unlikely to be widely known.

### **Proof of use of UK2147888**

43. The relevant period is 19<sup>th</sup> November 2011 to 18<sup>th</sup> November 2016.

44. It is common ground that the mark was put to genuine use in relation to *services relating to sports' events and matches; all relating to the promotion of Association football; all included in Class 41*. Therefore, it is only necessary to determine if the mark was also put to genuine use in relation to *games adapted for use with television receivers; computer software; all relating to Association football or the Football Association Premier League; all included in Class 9*.

45. Section 6A of the Act states:

“6A. - (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), (b) 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 period of five years ending with the date of publication.

(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 period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(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.”

46. The opponent claims to have used the mark in relation to video games, specifically the FIFA video game produced by EA Sports. The applicant says that there is no use shown in relation to *games adapted for use with television receivers*. I agree. The FIFA game shown in the evidence appears to be adapted for use on xBox and PlayStation. There is no evidence that either of these devices require the use of TVs whether as “receivers” [of a broadcast signal] or simply as monitors.

47. However, the list of goods also includes *computer software; all relating to Association football or the Football Association Premier League*. This includes computer games software, which is essentially what the FIFA game is. There is no dispute that the EU5153077 (PREMIER LEAGUE & Lion device) shown at paragraphs 15 and 27 above appeared on the cover of that game. The opponent says that amounts to genuine use of PREMIER LEAGUE, relying on the judgment of the Court of Justice of the EU (“CJEU”) in *Colloseum Holdings AG v Levi Strauss & Co.*<sup>10</sup>

48. The applicant says that the use shown is descriptive use, merely designating the subject matter of the football game (or part of it). In this connection, the applicant points out that EA Sports is identified as the producer of the game and, therefore, who the public would regard as responsible for the quality of the goods. Consequently, the use shown is not in accordance with the essential function of a trade mark, which is necessary in order to demonstrate genuine use.<sup>11</sup> In this connection, the applicant points out that the marks of other leagues are also shown on the game. Therefore the badges of the leagues identify only the content of the game, not its trade source.

49. The opponent says that the mark designates the FIFA game is an authorised product of the opponent. Therefore, it is trade mark use and, by extension, genuine use of the mark in relation to the game.

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<sup>10</sup> Case C-12/12

<sup>11</sup> See *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52 at paragraph 219(3)

50. I accept that the EU5153077 mark appearing on the cover of the FIFA game would have been understood by average consumers to indicate that the game was marketed with the consent of the opponent. It follows that the opponent would have been held responsible (or at least partly responsible) for the quality of the product. It is not necessary for the opponent to be regarded as solely responsible for the product. Therefore the appearance of third party marks does not mean that the opponent's mark was not being used as a trade mark. I find that it was. Consequently, EU5153077 was put to genuine use in relation to computer games software. Does this apply, by extension, to UK2147888? In *Colloseum* the CJEU stated that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

51. In my view, the words Premier League alone would have been understood as indicating that the computer game software was marketed with the consent of the opponent. Therefore, I am satisfied that the words PREMIER LEAGUE indicated that the opponent was at least partly responsible for the computer games software bearing that mark. I therefore find that the opponent has shown genuine use of UK 2147888 in relation to computer [games] software. Consequently, the opponent can also rely on the registration of UK2147888 for those goods in this opposition.

#### **The section 5(2) ground based on UK2147888**

52. Section 5(2)(b) of the Act is as follows:

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

(a) -

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

The relevant average consumer and the selection process

53. The respective services are shown below.

UK2147888	Contested mark
Services relating to sports' events and matches; all relating to the promotion of Association football; all included in Class 41.	Organisation and regulation of video gaming competitions, none relating to association football.

54. Mr Malynicz submitted that the average consumer of the applicant's services are players in video gaming competitions and the public that watches such games. Mr Norris appeared to take a similar position, referring me to the evidence that most players are young and male. I will proceed on this basis. Similarly, the average consumer of the services covered by the earlier mark includes those members of the public who play or watch association football.

55. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*.<sup>12</sup> I see no reason to believe that the relevant average consumer of the services at issue will pay an exceptionally high or low degree of attention when selecting a service provider. Therefore, I find that the relevant average consumer will pay a normal or average degree of attention when selecting the services at issue.

56. When I asked him about it, Mr Malynicz suggested that the applicant's services are likely to be selected from advertisements, including online advertisements. I agree that this will be the primary means through which such services are selected. However, I consider it likely that video gaming competitions are also likely to be the subject of word of mouth recommendations from players and watchers of such events. Therefore, the way that the marks look will have most bearing on the

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<sup>12</sup> Case C-342/97



likelihood of confusion, but the way that they sound will also have some (albeit less) impact.

### Comparison of services

57. In the judgment of the CJEU in *Canon*<sup>13</sup> the court stated 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”.

58. It is common ground that ‘association football’ means soccer. Therefore, the exclusion applied to the applicant’s list of services excludes the organisation and regulation of video gaming competitions relating to any form of association football (i.e. soccer). By contrast, the opponent’s list of services all relate to association football. Consequently, the services are not identical.

59. Although it is clear that the services covered by UK2147888 all relate to the promotion of association football, the description of the actual services, i.e. *services relating to sports' events and matches* is vague and poorly defined. It could cover a range of possible services. As I mentioned earlier, Mr Norris said that the applicant understood the term to mean the organisation and regulation of sports' events and matches, specifically association football. Mr Malynicz did not appear to suggest that the opponent’s specification should be interpreted much differently. In any event, it is well established that specifications of services should not be interpreted broadly. Rather, where a specification contains a general term, it should be given a meaning consistent with the core of the possible meanings attributable to it.<sup>14</sup> Therefore, I will interpret the specification of UK2147888 as meaning *the organisation and regulation of sports' events and matches for the promotion of association football*.

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<sup>13</sup> Case C-39/97, at paragraph 23 of the judgment

<sup>14</sup> See *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16

60. The respective services are similar to some degree in nature, both involving the organisation and regulation of competitive events and matches. The parties disagree as to whether 'esports' is a game or a sport. I do not think it matters. Video gaming competitions are clearly different to soccer competitions, even if the former includes soccer games. The purpose of the respective services is similar in that both are intended to encourage and promote (albeit different kinds of) live competitive matches and events. The method of use of the services is not the same. The applicant's services are more of an online activity than playing or watching soccer. However, there is some similarity of use because soccer is also watched online (or via TV screens) and the evidence shows that the applicant's services are capable of being played in front of live audiences. The services are not really in competition. Nor are they complementary in the sense described in the case law. However, the evidence shows that there is a likely to be a significant overlap in the end users of the respective services. Overall, I consider that there is a medium degree of similarity between the respective services.

61. Trade mark UK2147888 is registered in relation to computer games software in class 9 subject to the limitation "*all relating to Association football or the Football Association Premier League.*" Again, the applicant's specification of services has a contrasting exclusion. Further, the comparison in this case is between the opponent's goods and the applicant's services. In my view, the services covered by the contested mark are no more similar to the goods covered by UK2147888 than they are to the services considered above. Consequently, the registration of the earlier mark in relation to computer (games) software in class 9 does not improve the opponent's case.

#### Distinctive character of earlier mark UK2147888

62. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*<sup>1</sup> the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an

overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-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).”

63. The applicant says that PREMIER LEAGUE means ‘top league’ and is therefore descriptive of the services of any sporting competition. The opponent does not appear to strongly dispute that the words are prima facie descriptive, but argues that the mark has become highly distinctive through use. In this connection, the opponent disputes that the applicant has shown widespread use of the same name by third parties in the UK prior to the relevant date.

64. I accept that the evidence shows that the opponent’s PREMIER LEAGUE is very well known in the UK. I also accept that the evidence does not show widespread generic use of the name by third parties in the UK. However, certain apparently descriptive uses, such as SCOTTISH PREMIER LEAGUE (football) and INDIAN PREMIER LEAGUE (cricket) were likely to be widely known to sports fans in the UK at the relevant date. It is true that the latter is known as an overseas competition, but even this sort of use will have helped to prevent the ordinary meaning of ‘premier league’ from being entirely displaced by its acquired meaning as one of the opponent’s trade marks. I therefore find that, at the relevant date, absent any clear

indication to the contrary, UK consumers would have regarded the words PREMIER LEAGUE as designating the opponent's football competition in England and Wales. However, I do not accept that the mark was so strongly distinctive of trade origin that it would have triggered a connection with the opponent irrespective of other indications, such as the geographical coverage of the football league (i.e. SCOTTISH) and/or the type of competition (i.e. cricket). I therefore find that although the earlier mark had a strong reputation at the relevant date it was only distinctive of the opponent to a medium degree.

### Comparison of marks

65. In *Bimbo SA v OHIM*<sup>15</sup> the CJEU stated 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.”

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.

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<sup>15</sup> Case C-591/12P

66. The respective trade marks are shown below:

PREMIER LEAGUE	
Earlier trade mark	Contested mark

67. The earlier mark is composed of the words PREMIER LEAGUE. This forms a unit having a clear composite meaning, i.e. top level league.

68. The contested mark is made up of a roundel device on which the words ESPORTS PREMIER LEAGUE appear in clear and ordinary letters. The opponent relies on *Oberhauser v OHIM*<sup>16</sup>, *Wassen v OHIM*<sup>17</sup> and others as support for the proposition that ‘words speak louder than devices’. However, as Mr Norris pointed out, this is no more than a rule of thumb which does not always apply.<sup>18</sup> Ultimately, it all depends on the marks. The applicant argues that what it calls the spinning tyre device is memorable and distinctive. I disagree. I find that the device element in the contested mark makes only a small contribution to the visual impact of the mark as a whole (and none to the aural or conceptual impacts). This is because the device appears to serve as little more than a frame for the words ESPORTS PREMIER LEAGUE, which dominate the mark. The more important part of the comparison is therefore between the words PREMIER LEAGUE and ESPORTS PREMIER LEAGUE.

69. The applicant accepts that the word ‘esports’ is purely descriptive. It must therefore be less distinctive than Premier League, which is at least capable of acquiring distinctive character as a trade mark. However, as ESPORTS is the first word in the contested mark it will not be overlooked or missed when the contested mark is seen or verbalised. The inclusion of the word ESPORTS in the contested

<sup>16</sup> Case T-104/01

<sup>17</sup> Case T-312/03

<sup>18</sup> See *L&D SA v OHIM* [2008] E.T.M.R. 62

mark therefore distinguishes the look and sound of the marks to some extent, despite its purely descriptive significance. The marks are more similar to the ear than to the eye because the device element of the contested mark makes no contribution to the sound of that mark. Overall, I find that the marks are visually similar to a medium degree and aurally similar to a medium to high degree.

70. The letter 'e' is commonly used to mean 'electronic', e.g. email, e-forms. The meanings of 'sports', 'premier' and 'league' are obvious. Therefore, the words 'esports' and 'premier league' are, according to their ordinary meanings, descriptive of 'electronic sports' and 'top level league', respectively. In my view, the words in the contested mark convey the idea of a top level league composed of players or teams competing through electronic sports. The concept of a 'top level league' in the earlier mark is the same concept that is present in the contested mark. Further, the association between sports and 'league' are reflected in the ordinary meaning of the word 'esports'. I therefore find that the marks are conceptually similar to a medium to high degree.

#### Global assessment – likelihood of confusion

71. 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.

#### *The principles*

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well

informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

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

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

72. In my view, even allowing for imperfect recollection, the differences between the marks as wholes, when combined with the difference between the respective services, are sufficient to avoid a likelihood of direct confusion.

73. I have more difficulty in ruling out the likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*,<sup>19</sup> Mr Iain Purvis Q.C. as the Appointed Person noted 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.”

74. Given my findings that:

- (i) The device element of the contested mark makes only a small contribution to the visual impact it makes on consumers (and none to the aural or conceptual impacts);

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<sup>19</sup> Case BL-O/375/10



- (ii) The word 'esports' is purely descriptive of the services covered by the contested mark;
- (iii) The words Premier League are distinctive (through use) to a medium degree of the opponent's services relating to the organisation and regulation of association football;

- there appears to be cause for concern that the services covered by the contested mark will be understood as being connected with the opponent.

75. The applicant has three answers to this. Firstly, that it has excluded services relating to association football. Secondly, that 'esports' is a game not a sport. Thirdly, that video games based on football are not a popular amongst players of esports.

76. I find that the technical categorisation of esports as a game makes no difference to the level of expectation amongst UK consumers as to whether the services provided under the contested mark are likely to include football-based games.

77. I note Mr King's evidence that 'esports' was not a widely understood term in the UK in 2016. I take this to mean that the specific meaning he attributes to the word was not widely understood. That does not mean that esports would have been a meaningless word. On the contrary, to those unfamiliar with the emerging use of the word to denote competitive video game playing, it would have been understood to mean 'electronic sports' at large. It follows that many UK users of the services covered by the contested mark may not have been aware that existing esports competitions tended to be based on battle and combat games. Further, the evidence shows that although football-based video games are not the most popular type of games for current players of esports, they are a category of video games of interest to UK video gamers, including existing players of esports.

78. Against this background, the applicant's exclusion of services relating to association football is not sufficient to avoid confusion. This is because, at the relevant date, the presence of the words PREMIER LEAGUE in the contested mark would have lead a significant proportion of average UK consumers to expect the services provided under that mark to include video gaming competitions based on

the type of association football organised and regulated by the opponent.<sup>20</sup> In these circumstances, average consumers would regard the words PREMIER LEAGUE as indicating that there is an economic connection between the users of the marks. The inclusion of the words ESPORTS (and/or the device element) in the contested mark would not have been sufficient to counter this impression.

79. This constitutes a likelihood of indirect confusion. The opposition under s.5(2)(b) based on UK2147888 therefore succeeds.

### **The section 5(2)(b) ground of opposition based on UK3148844**

#### Comparison of services

80. Earlier trade mark UK3148844 is registered for, *inter alia*, *organisation of competitions*. The earlier mark is not subject to proof of use. This means that the opponent can rely on this mark for the purposes of this opposition in relation to any services that fall within the above description. This includes *Organisation of video gaming competitions*. The respective services are therefore identical or, if *regulation* is different to *organisation*, then highly similar.

#### Distinctive character of the earlier mark


81. Considered in relation to *organisation of video gaming competitions*, the earlier mark as a whole has a normal degree of distinctive character. However, the words Premier League meaning ‘top level league’ are *prima facie* descriptive of the quality and/or kind of such services. They are therefore lacking in inherent distinctive character. Neither the earlier mark as a whole, nor the words Premier League as such, had acquired an enhanced degree of distinctive character through use by the relevant date in relation to the services under consideration. In coming to this conclusion, I have not overlooked the evidence that the opponent operates an online game based on fantasy football. However, this is under a different mark. Further, this is different to a video gaming competition.

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<sup>20</sup> See *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch)

## Comparison of marks

82. The respective marks are shown below.

	
Earlier trade mark	Contested mark

83. The earlier mark consists of a device composed of a partial silhouette of the head and mane of a lion wearing a crown and the words Premier League. Although the words are very low in distinctiveness and appear second (to someone reading from left to right) they make up a significant proportion of the mark. In my view, they make a more-than-negligible contribution to the visual impression created by the earlier mark as a whole.

84. As I noted earlier, the words ESPORTS PREMIER LEAGUE dominate the visual impression created by the contested mark. The presence of the words PREMIER LEAGUE in both marks creates a certain degree of visual similarity between them. Again the words are low in distinctiveness, ESPORTS in particular being 100% descriptive of the kind or subject matter of the services. That word must therefore be even less distinctive than Premier League, which is at least capable of acquiring distinctive character as a trade mark. However, as ESPORTS is the first word in the contested mark it will not be overlooked. Taking account also of the different device elements, I find that there is a low degree of visual similarity between the marks.

85. Consumers are unlikely to verbalise the device element of the earlier mark. Consequently, in aural use it is likely to be referred to as *Premier League*. The word ESPORTS will not be missed when the contested mark is verbalised. The inclusion of the word ESPORTS in the contested mark therefore distinguishes the

sound of the marks to some extent, despite its purely descriptive significance. Overall, I find that the marks are aurally similar to a medium to high degree.

86. Mr Norris submitted at the hearing that the device of a lion was a recurring and important part of the opponent's branding. I accept that it gives the earlier mark the concept of a lion, which has no counterpart in the contested mark. Additionally, the earlier mark conveys the specific idea of a top level league, and through that a more general association with sport. The contested mark conveys the single and specific concept of a top level league composed of players or teams competing through electronic sports. This is similar to one of the concepts conveyed by the earlier mark, i.e. the 'top level league' concept. Therefore, compared as wholes, I find that the marks are conceptually similar to a medium degree.

#### Likelihood of confusion

87. The identity or high similarity of the services under consideration means that there may still be a likelihood of confusion despite a lesser degree of similarity between the marks. The opponent says that the similarity is sufficient to create a likelihood of confusion. The applicant, of course, says not. Mr Norris submitted that I should attach particular significance to the fact that the only element which is common to both marks - Premier League - is descriptive/non-distinctive in relation to the services at issue. Mr Malynicz submitted that even if this is so, the low level of distinctiveness of the common element between the marks does not exclude a likelihood of confusion. In this connection, he relied on the judgment of the CJEU in *BSH Bosch und Siemens Hausgeräte GmbH v EUIPO and LG Electronics Inc.*<sup>21</sup> The first-named party had filed an application to register the mark shown below as an EU trade mark in relation to goods in classes 7, 9 and 11.



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<sup>21</sup> Case C-43/15P

88. The application was opposed by LG Electronics Inc. on the basis of an earlier mark comprised of the word KOMPRESSOR. Insofar as the respective goods were the same or similar, the EUIPO upheld the opposition. Appeals to the Board of Appeal and the General Court were rejected. A further appeal was made to the CJEU. One of the grounds for appeal was that insufficient weight had been given to the fact that the word COMPRESSOR was descriptive for certain categories of relevant goods; namely, those that included a compressor. The appeal was heard by the Grand Chamber of the CJEU. It summed up the appellant's submission like this:

“48. In BSH's submission, where the earlier mark is a readily recognisable variant of a descriptive indication and the later mark contains the descriptive indication itself, even the existence of major similarities between the signs and identity of the goods which the opposing marks cover are not capable of permitting the conclusion that there is a likelihood of confusion if the similarities of the signs are limited to the descriptive indications and concern only goods which are described by the indication. The public does not perceive any indication of origin in a descriptive indication, but is guided by the other elements of the mark.”

89. Turning to the judgment under appeal the CJEU stated that:

“56. After recalling the relevant case-law in paragraphs 26 and 27 of the judgment under appeal, the General Court stated in paragraph 28 that, as regards the goods in respect of which the First Board of Appeal of EUIPO upheld the opposition, the latter found, without this being contested by BSH, first, that the goods at issue are in part identical and in part similar and, secondly, that the opposing signs are similar. The General Court observed that the cumulative effect of those findings is sufficient, in any event, to be able to conclude that there is a likelihood of confusion, even if the earlier national marks were to be regarded as having a weak distinctive character.

57. The General Court added, in paragraph 29 of the judgment under appeal, that, when assessing the likelihood of confusion, the First Board of Appeal of EUIPO did take account of the fact that, as regards the goods at issue, neither

the earlier national marks nor the mark applied for are particularly distinctive. However, the Board of Appeal recalled that, according to the case-law, even for marks with a weak distinctive character, there can be a likelihood of confusion, particularly in view of the similarity of the signs and of the goods or services covered, and stated that that is true where, as in the present case, the goods are identical and the opposing marks are highly similar.

58. In paragraph 31 of the judgment under appeal, the General Court observed that to accept BSH's argument would have the effect of disregarding the similarity of the marks as a factor in favour of the factor constituted by the distinctive character of the earlier mark, which would thus be given undue importance. The result would be that, where the earlier mark is only of weak distinctive character, a likelihood of confusion would exist only where that mark was reproduced in its entirety by the mark applied for, depriving the degree of similarity between the signs in question of any significance. Such a result would not be consistent with the very nature of the global assessment which the competent authorities are required to undertake by virtue of Article 8(1)(b) of Regulation No 40/94.

59. Therefore, the General Court held, in paragraph 32 of the judgment under appeal, that BSH's arguments relating to the weak distinctive character of the earlier national marks could not affect the conclusion of the First Board of Appeal of EUIPO as to the existence of a likelihood of confusion.

60. That assessment by the General Court of the likelihood of confusion is not vitiated by any error of law.

61. Indeed, the Court of Justice, rejecting a line of argument similar to that advanced by BSH in the second plea, has already held on a number of occasions that, although the distinctive character of an earlier mark must be taken into account when assessing the likelihood of confusion globally, it is, however, only one factor among others involved in that assessment (see, in particular, orders of 29 November 2012, *Hrbek v OHIM*, C-42/12 P, not published, EU:C:2012:765, paragraph 61, and of 2 October 2014,

*Przedsiębiorstwo Handlowe Medox Lepiarz v OHIM*, C-91/14 P, not published, EU:C:2014:2261, paragraph 22).

62. Furthermore, although it is true that the more distinctive the earlier mark the greater the likelihood of confusion will be, such a likelihood of confusion cannot, however, be precluded where the distinctive character of the earlier mark is weak (see, in particular, order of 19 November 2015, *Fetim v OHIM*, C-190/15 P, not published, EU:C:2015:778, paragraph 40 and the case-law cited).

63. Consequently, even in a case involving an earlier mark of weak distinctive character, the General Court may hold that there is a likelihood of confusion on account, in particular, of a similarity between the signs and between the goods or services covered (see, in particular, orders of 2 October 2014, *Przedsiębiorstwo Handlowe Medox Lepiarz v OHIM*, C-91/14 P, not published, EU:C:2014:2261, paragraph 24 and the case-law cited, and of 7 May 2015, *Adler Modemärkte v OHIM*, C-343/14 P, not published, EU:C:2015:310, paragraph 59).

64. Thus, the findings made by the General Court in paragraph 31 of the judgment under appeal, which reject the proposition put forward by BSH and against which the second plea is directed, in fact do no more than recall the Court of Justice's settled case-law according to which that proposition is not consistent with the very nature of the global assessment which the competent authorities are required to undertake by virtue of Article 8(1)(b) of Regulation No 40/94 since, contrary to the appellant's contentions, it would have the effect of disregarding the similarity of the marks as a factor in favour of the factor constituted by the distinctive character of the earlier mark (see, in this regard, judgment of 15 March 2007, *T.I.M.E. ART v OHIM*, C-171/06 P, not published, EU:C:2007:171, paragraph 41, and order of 19 November 2015, *Fetim v OHIM*, C-190/15 P, not published, EU:C:2015:778, paragraph 46 and the case-law cited).

65. As regards the argument advanced in this regard by BSH that that case-law is wrong given that it leads to the monopolisation of a purely descriptive indication, it must be stated that it is not Article 8(1)(b) of Regulation No 40/94 but Articles 7(1)(b) and (c) and 51 of that regulation and Article 3(1)(b) and (c) of Directive 2008/95 which are intended to avoid such monopolisation.”

90. The CJEU’s judgment confirms pre-existing CJEU case law to the effect that the level of distinctive character of an element which is common to both marks (or similar as between them) is but one element in the global assessment of the likelihood of confusion. Consequently, even where the level of distinctive character of the element in question is very low, other factors in the required global assessment, such as the identity of the goods/services and a high level of overall similarity between the marks, may still justify a finding that there is a likelihood of confusion.

91. Shortly after the CJEU’s judgment in the *Kompressor* case, judgment was given in a UK trade mark appeal to the High Court in England and Wales: *Nicoventures Holdings Limited v The London Vape Company Ltd.*<sup>22</sup> An application had been made to register the mark shown below in relation to electronic cigarettes.



92. It was opposed on the basis of the following earlier mark, which was already registered for the same goods.



93. The registrar upheld the opposition, finding that the marks were highly similar and the goods identical. In these circumstances, the low distinctiveness of the elements VAPE and CO was found to be insufficient to avoid a likelihood of

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<sup>22</sup> [2017] EWHC 3393 (Ch)



confusion. However, the appeal to the High Court was upheld.<sup>23</sup> The judge stated that:

“31. The nature of the common elements needs to be considered and in a case like this, in which the common elements are elements which themselves are descriptive and non-distinctive (as the Hearing Officer found in paragraph 34), it is necessary somewhere to focus on the impact of this aspect on the likelihood of confusion. As has been said already it does not preclude a likelihood of confusion but it does weigh against it. There may still be a likelihood of confusion having regard to the distinctiveness and visual impact of the other components and the overall impression but the matter needs to be addressed.

32. The Hearing Officer found that the element in the opponent's mark which is the common element (i.e. VAPE and CO) is itself more distinctive than other features of that mark (i.e. the stylised features). That is a decision he was entitled to reach but it does not mean that once that decision has been reached, the low distinctiveness of what is the common element ceases to be relevant to a likelihood of confusion. Far from it. That is not what the CJEU in *L'Oreal v OHIM* was saying at all.

33. Given that the Hearing Officer has erred in this way, the matter needs to be considered again bearing in mind the *White and Mackay's* principle. Given the clarity of the Hearing Officer's decision there is no need to go over this at length.

34. Each mark includes as important elements the terms VAPE and CO. There is more to each mark than that because they each include stylised features which are unremarkable but are different from one another (decision paragraphs 27 and 28). The point is that the marks do have a high degree of visual, aural and conceptual similarity (paragraphs 29-31) but that similarity arises from the common elements of the terms VAPE and CO and the

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<sup>23</sup> EWHC 3393 (Ch)

combination of those two words. Bearing in mind the goods and services for which these marks are registered or applied for respectively, those words individually are both descriptive and non-distinctive. Put together the combination is also descriptive and non-distinctive.

35. As the Hearing Officer held in paragraph 31 they connote an undertaking in the vaping market. The average consumer, who is a member of the general public over 18 years old, will pay a relatively high degree of attention to the selection of goods and a reasonable level of attention to the selection of services.

36. Bearing all this in mind but in particular having regard to the low degree of distinctiveness about the features these two marks have in common, even taking into account imperfect recollection the differences in the two marks will take on a greater significance for the average consumer than they might otherwise. Although the stylised aspects of each mark are not very remarkable, the fact remains that these aspects are entirely different. From the point of view of visual similarity, the likelihood of confusion is low. Considering conceptual similarity, the concept the two marks share is entirely down to their non-distinctive elements. It is the common concept which is non-distinctive. That does not lead to a likelihood of confusion. In some ways the respondent's best case could be thought to come from considering the aural similarity. From that point of view of course the visual stylised elements will not be present, and hearing "Vape dot co" or "THE Vape dot co" is not so far away from hearing "Vape and co" but the fact is again that they are not the same and what they share is entirely non-distinctive when one bears in mind this is all in the context of electronic cigarettes.

37. Accordingly I do not consider that there is a likelihood of confusion in this case."

94. The *Whyte and MacKay* principle referred to in the judgment is a reference to an earlier judgment of the High Court in England and Wales<sup>24</sup> in which another judge concluded that:

“...what can be said with confidence is that, if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.”

95. Neither of the judgments of the High Court go quite so far as to exclude the likelihood of confusion where the only element in common between two marks is one that lacks distinctive character. They are therefore consistent with *Kompressor* and the case law of the CJEU which precedes it. That will remain the case unless or until the so-called *Whyte and MacKay* principle is elevated to a rule that a likelihood of confusion cannot be based on non-distinctive similarities between marks.

96. Proceeding on this basis, I find that Mr Malynicz is correct to submit that the low level of distinctiveness of PREMIER LEAGUE (in both marks when considered in relation to organising video gaming competitions) does not preclude a finding that there is a likelihood of confusion between the contested mark and UK3148844. However, Mr Norris is correct to submit that the low level of distinctiveness of this element of the marks is a factor which weighs against a likelihood of confusion.

97. Taking into account also that the level of overall similarity between the marks covered by this comparison is not high (and in the case of the most operative one, visual similarity, it is low), I find that there is no likelihood of direct or indirect confusion, even if both marks were used in relation to services for the organisation [and regulation] of video gaming competitions (none relating to association football in the case of the applicant's mark).

98. Consequently, the s.5(2)(b) opposition based on UK3148844 fails insofar as it is based on the notional use of both marks in relation to the organisation of video gaming competitions. The opponent's mark has, of course, been used and acquired

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<sup>24</sup> [2015] EWHC 1271 (Ch)

a distinctive character in relation to the organisation and regulation of association football. However, there is no point in considering that case again. This is because it cannot improve the opponent's case over the one based on earlier UK mark 2147888 (the words PREMIER LEAGUE alone).

### **The section 5(3) ground of opposition**

99. It is only necessary to consider this in relation to earlier trade mark UK 2147888 – PREMIER LEAGUE. Mr Malynicz focused the opponent's case on the allegation that the contested mark will take unfair advantage of the reputation of the earlier mark. I will do the same.

100. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

101. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark

have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

### Reputation

102. There is no longer any dispute that PREMIER LEAGUE has a reputation in the UK in relation to *services relating to sports' events and matches; all relating to the promotion of Association football; all included in Class 41*.

### Link

103. Earlier I found that the presence of the words PREMIER LEAGUE in the contested mark would have led a significant proportion of average UK consumers to expect the services provided under that mark to include video gaming competitions based on the type of association football organised and regulated by the opponent. Even if, contrary to my finding under s.5(2)(b), that does not lead average consumers to believe that there is an economic connection between the users of the marks, it will, in my view, cause them to make a link between the marks, i.e. the contested mark will call the earlier mark to mind.

### Unfair advantage

104. Mr Norris submitted that the evidence shows that the applicant did not intend to take advantage of the earlier mark. Rather, the applicant chose to use the words Premier League because of their ordinary meaning in relation to a series of competitive events between pre-agreed teams and/or individuals. Mr Malynicz pointed out that it was not necessary for the mark to have been selected with the intention of taking advantage of the earlier mark. It was sufficient if the objective effect of the use of the contested mark was to take unfair advantage of the reputation of the earlier mark.<sup>25</sup> I accept that submission. Intention is a relevant factor, but not an essential one.

105. In the field of association football, PREMIER LEAGUE means the competition organised and regulated by the opponent. The evidence shows that the earlier mark has a strong reputation in that context. It is undoubtedly the sort of reputation capable of attracting numerous soccer fans to goods and services that are perceived as being related to PREMIER LEAGUE soccer. In my view, the inclusion of those words as a prominent feature of the contested mark in relation to a video gaming competition that could be based wholly or partly on soccer games, is sufficient to take advantage of the reputation of the earlier mark. The absence from the contested mark of any effective indication that the services provided under it are related to something other than association football makes the advantage gained unfair.<sup>26</sup>

### Due cause

106. Mr Norris submitted that the applicant had due cause to use the contested mark. In this connection he referred me to the judgment of the CJEU in *Interflora*.<sup>27</sup> The relevant part is shown below.

“91. By contrast, where the advertisement displayed on the internet on the basis of a keyword corresponding to a trade mark with a reputation puts

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<sup>25</sup> See *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) at paragraph 80 of the judgment.

<sup>26</sup> ESPORTS is not an effective indication for the reasons given at paragraph 77 above.

<sup>27</sup> Case C-323/09, particularly paragraph 91.

forward – without offering a mere imitation of the goods or services of the proprietor of that trade mark, without causing dilution or tarnishment and without, moreover, adversely affecting the functions of the trade mark concerned – an alternative to the goods or services of the proprietor of the trade mark with a reputation, it must be concluded that such use falls, as a rule, within the ambit of fair competition in the sector for the goods or services concerned and is thus not without ‘due cause’ for the purposes of Article 5(2) of Directive 89/104 and Article 9(1)(c) of Regulation No 40/94.”

107. The *Interflora* case was about the use of trade marks by third parties as AdWords. That is different to the factual situation before me where the applicant wishes to use the words PREMIER LEAGUE as part of its own trade mark. In any event, I have found that the use of the contested mark will affect the functions of that mark by causing confusion.

108. Leaving *Interflora* to one side, the applicant’s real point is that PREMIER LEAGUE is descriptive of a top level league. Therefore, it has due cause to use it in relation to the organisation of a league for a video gaming competition. There is some force in that point. In *Leidseplein Beheer BV v Red Bull*<sup>28</sup> the CJEU held that:

“43. In a system for the protection of marks such as that adopted, on the basis of Directive 89/104, by the Benelux Convention, however, the interests of a third party in using, in the course of trade, a sign similar to a mark with a reputation must be considered, in the context of Article 5(2) of that directive, in the light of the possibility for the user of that sign to claim ‘due cause’.

44. Where the proprietor of the mark with a reputation has demonstrated the existence of one of the forms of injury referred to in Article 5(2) of Directive 89/104 and, in particular, has shown that unfair advantage has been taken of the distinctive character or the repute of that mark, the onus is on the third party using a sign similar to the mark with a reputation to establish that he has

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<sup>28</sup> Case C-65/12



due cause for using such a sign (see, by analogy, Case C-252/07 *Intel Corporation* [2008] ECR I-8823, paragraph 39).

45. It follows that the concept of ‘due cause’ may not only include objectively overriding reasons but may also relate to the subjective interests of a third party using a sign which is identical or similar to the mark with a reputation.”

109. It is not therefore necessary for the applicant to show that it must use the words Premier League. It is sufficient that it has legitimate commercial reasons for doing so. In principle, the fact that the words at issue are descriptive of the services may constitute a legitimate commercial reason for using them. On the other hand, the onus is on the applicant to establish that it has due cause to use the contested mark. This must include consideration as to whether it has taken reasonable steps to avoid or minimise any damage to, or the taking unfair advantage of, the earlier mark.<sup>29</sup>

110. In my view, the applicant’s case on due cause falls down at this point. This is because (a) the capacity of the words PREMIER LEAGUE to take unfair advantage of the reputation of the earlier mark comes from the inclusion of those words as a prominent feature of the contested mark, and (b) neither the addition of the word ESPORTS, nor the placing of the words within the round “spinning wheel” device are sufficient to avoid or minimise the risk of consumers making the sort of link with the earlier mark which draws on its reputation in the field of association football.

111. The opposition under s.5(3) based on earlier mark UK2147888 therefore succeeds.

### **The section 5(4)(a) ground of opposition**

112. Given that the opposition under s.5(2)(b) and s.5(3) based on UK2147888 has succeeded, I see no need to deal with this ground. I therefore decline to do so.

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<sup>29</sup> See *The London Taxi Corporation Ltd v Frazer-Nash Research Ltd & Another* [2017] EWCA Civ 1729 at paragraphs 90/91 and, by analogy, paragraphs 92-96.

## Overall outcome

113. The opposition has succeeded. The application will be refused.

## Costs

114. The opponent has succeeded and would normally be entitled to a contribution towards its costs. The applicant asks me to take into account that the opponent presented a poorly focused case which only became clear after the evidence rounds had closed. Further, the opponent filed a large volume of evidence, much of which went nowhere, or to issues that were not necessary for the disposal of the opposition. However, all of this evidence had to be read and processed by the applicant. This increased the applicant's costs beyond what was necessary or proportionate to the real issues in the case.

115. The opponent denies that it acted unreasonably and says that it should not be penalised for narrowing and focusing its case.

116. In my view, the applicant's complaint is justified. The opposition as filed was very poorly focused. The applicant identified this in its counterstatement. However, even after the directions issued at the first CMC, the opponent persisted with its claim that some of the earlier marks had been used and acquired a reputation for a wide range of goods/services, including some unlikely ones, e.g. karaoke services. The opponent's position (or that of its legal advisors) is revealed in its letter of 5<sup>th</sup> January 2018 which stated that "*now that the evidence rounds are closed*" it had "*given some thought to how to narrow the issues in dispute and bring focus to the hearing.*" The correct time to have done that was when the opposition was filed or, failing that, when the applicant's counterstatement drew attention to the poor particularisation of the opposition or, failing that, when the registrar directed the opponent to better particularise its case.

117. The opponent's explanation for the timing of its decision to properly focus its case turns the relationship between pleadings and evidence on its head. The evidence is supposed to be directed to the pleaded case. If the pleaded case takes a

blunderbuss approach and is poorly focused, the evidence is likely to suffer similar defects. Additionally, bringing focus to the opposition after the evidence rounds are closed may be unfair to an applicant. That applicant may have presented different evidence focusing on the opponent's real case, if it had better understood what this was before filing its own evidence.

118. These are not new criticisms. They have been made many times before, but it appears to be difficult to resist the temptation to plead widely and focus (i.e. work out and reveal the best case) only when it suits the opponent to do so. This practice ought to be discouraged.

119. Rule 67 of the Trade Mark Rules 2008 gives the registrar a wide discretion when it comes to awards of costs. In my view, the opponent's behaviour has caused the applicant extra and unnecessary costs to the point where it would be unjust to require the applicant to now contribute to the opponent's costs. I therefore order each side to bear its own costs.

**Dated this 22nd day of May 2018**

**Allan James  
For the Registrar**