

O-528-21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3468651

BY LEEDS CITY FOOTBALL CLUB LIMITED AND LCFC LIMITED

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 420524

BY LEICESTER CITY FOOTBALL CLUB LIMITED

Background and pleadings

1. On 20 February 2020, Leeds City Football Club Limited and LCFC Limited (“the applicants”) applied to register the trade marks shown below (“the contested marks”) as a series of two, under number 3468651:



2. As the only difference between the marks is the use of greyscale in one and colour in the other, I will refer to them in the singular unless it is necessary to distinguish between them. Registration is sought for the following goods and services:

Class 16: Printed Matter; Photographs; Stationary [presumably ‘stationery’]; Instructional and Teaching Material.

Class 25: Clothing; Footwear; Headgear.

Class 26: Badges for wear, not of precious metal.

Class 41: Education; Providing of Training; Entertainment; Sporting and Cultural Activities; Photography; Audio and video production, and photography; Photography services.

3. The application is opposed by Leicester City Football Club Limited (“the opponent”). The opposition is based upon ss. 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994

("the Act"). Under each of these grounds, the opposition is directed against all of the goods and services in the application.

4. Under ss. 5(2)(b) and 5(3), the opponent relies upon UK trade mark number 3259636 "LCFC". The trade mark has a filing date of 27 September 2017 and was registered on 2 February 2018, making it a valid earlier mark under s. 6 of the Act. The trade mark is registered for a wide range of goods and services in nineteen classes. For the opposition under s. 5(2)(b), the opponent relies upon all of the goods and services in classes 16, 25, 28 and 41 for which the mark is registered. The goods and services relied upon are shown in full in the annexe to this decision.

5. The claim under s. 5(2)(b), is that the contested mark is similar to the opponent's marks and that the goods and services at issue are identical. The opponent asserts that there is a likelihood of confusion, including the likelihood of association. The opponent also claims that its earlier trade mark benefits from enhanced distinctive character.

6. Under s. 5(3), the opponent claims that its trade mark has a reputation in respect of "clothing" in class 25 and for "entertainment; sporting activities; sporting services; football entertainment services; entertainment in the nature of football games" in class 41. The opponent claims that the reputation of the earlier mark in the UK is such that use of the contested mark would cause the relevant public to believe that there is an economic connection between the parties, where no such connection exists. The opponent further claims that the applicants would obtain an unfair advantage through the use of the contested mark and that there would be a dilution or blurring of the reputation and distinctive character of the earlier trade mark.

7. Under s. 5(4)(a), the opponent claims that it has goodwill connected with the sign "LCFC" as a result of the use it has made of the sign throughout the UK since 2000. Use is asserted in relation to the following goods and services:

Clothing; printed matter; stationery; badges for wear; key rings.

Entertainment; sporting activities; sporting services; football entertainment services; entertainment in the nature of football games.

8. The opponent claims that consumers would be deceived into thinking that the goods and services offered under the contested mark were the goods and services of the opponent or that they were endorsed by or related to the opponent. This would, it says, damage the opponent's business.

9. The applicants filed a counterstatement denying the grounds of opposition. I will return to their specific comments as necessary later in this decision.

10. Only the opponent filed evidence. Neither party requested a hearing. Only the opponent filed written submissions in lieu. The applicants are not professionally represented. The opponent is represented by Wilson Gunn. This decision is taken following a careful reading of all of the papers.

Relevant date and proof of use

11. The relevant date for the assessment under ss. 5(2)(b) and 5(3) is the filing date of the contested application, i.e. 20 February 2020. As there is no claim to, and no evidence of, earlier use of the contested trade mark, its filing date is also the relevant date for the assessment under s. 5(4)(a).¹

12. The opponent's trade mark had not been registered for five years by the filing date of the contested application. It is not, therefore, subject to the use provisions at s. 6A of the Act and the opponent may rely upon the mark without showing that it has put it to genuine use.

Witnesses

13. The opponent's first witness is Terry Rundle, the opponent's professional representative. Mr Rundle's statement is a vehicle for the introduction of the evidence of Timothy Cadman (see below) and of a decision of this tribunal (O/755/18) concerning previous proceedings between the parties. I have read the decision but it is neither binding upon me nor of persuasive value.

¹ See *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11 at [43].

14. The main witness for the opponent is Timothy Cadman. Mr Cadman's witness statement is dated 5 March 2018. It appears that Mr Cadman, who is also a trade mark attorney, was the opponent's professional representative during the previous proceedings. Mr Cadman's evidence focuses on showing the opponent's reputation in respect of the class 41 services relied upon in the earlier proceedings.²

15. I have read all of the evidence. I will return to it as I consider appropriate later in this decision.

Section 5(2)(b)

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

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

[...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

17. Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

18. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen*

² Cadman, §9.

Handel B.V., Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

19. In class 16, registration is sought for “printed matter; photographs; stationary [presumably ‘stationery’]; instructional and teaching material”. These goods have direct counterparts in the earlier specification and are identical.

20. The contested mark’s “clothing; footwear; headgear” in class 25 is also matched by identical terms in the earlier specification.

21. In class 26, the contested specification is for “badges for wear, not of precious metal”. The earlier specification is for “badges for wear” at large. However, as badges of precious metal are not proper to class 26, even though expressed differently, these goods are also identical.

22. The contested specification in class 41 includes “education; providing of training; entertainment; sporting and cultural activities”. These terms are self-evidently identical to the same terms in the earlier specification.

23. The opponent argues that “audio and video production” in the contested specification is identical to “production of video recordings and/or sound recordings” in the earlier mark’s specification. I agree: they are the same services phrased differently.

24. That leaves “photography; [...] and photography; photography services”. Where goods or services in the specification of the contested mark are included within a more general category designated by the goods/services of the earlier mark, or vice versa, such goods and services can be considered identical: *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, EU:T:2006:247. I note the opponent’s submission that the services are similar to at least a medium degree. However, the notice of opposition specifies that the opponent considers the goods to be identical. There has been no application to amend the pleadings. Without such an application, I do not consider it open to the opponent to widen its claim in final submissions. That said, there is no explicit abandonment of the claim that the services are identical. I will, therefore, consider whether the services are identical.

25. Photography may involve the provision of a service such as portrait photography, be the creation of works of art or involve, for example, photo journalism. It therefore seems to me that photography services at least fall within one or the other, or both, of the very wide terms “entertainment; cultural activities” in the earlier specification. These services are, on that footing, identical under the principle expounded in *Meric*.

The average consumer and the nature of the purchasing act

26. The average consumer is a legal construct deemed to be reasonably well informed and reasonably circumspect: *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch) at [60]. For the purposes 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 and services in question: *Lloyd Schuhfabrik*.

27. The average consumer of the goods at issue is likely to be mainly a member of the general public. The purchasing process will be primarily visual, with the goods viewed in advertisements, in print or online, and chosen from shelves in shops or their online equivalents. The majority of the goods are not very costly and are likely to be bought with some frequency but some attention will be paid to factors such as the style or content. The purchasing process will, for most of the goods, involve a medium degree of attention.

However, stationery is likely to attract a lower than average degree of attention, being purchased with greater frequency and being, on the whole, very inexpensive. I acknowledge that goods such as instructional and teaching material may also be purchased by professionals who will pay a higher than average level of attention to ensure the selection of appropriate material. The purchasing process would still be predominantly visual for this group, though selection may be more via means of, for example, catalogues and advertising than browsing shelves. I do not discount an aural element for either group.

28. Turning to the services, the average consumer of audio and video production services is likely to be a professional purchasing the services in a business context. For the remaining services, the average consumer will be either a member of the public or a professional, such as a teacher, coach or professional in the entertainment industry. The member of the public selecting entertainment, sporting and cultural services and photography services is likely to pay a medium degree of attention, with some care taken over factors such as the precise range of activities or services on offer and their suitability for the consumer's needs. A reasonably high level of attention will be paid to education services, given the long-term implications and their greater cost. The professional will pay a reasonably high level of attention to the selection of the services across the board, as, for example, higher costs and outlay and service level agreements will be factors.

Distinctive character of the earlier trade mark

29. In *Lloyd Schuhfabrik*, the CJEU stated that:

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

30. I accept that the consumer is likely to know that "FC" is frequently used to indicate "football club", and that s/he may even surmise that the first "C" stands for "City". However, the letters "LCFC" do not themselves indicate an obvious characteristic of the goods and services, other than their potential connection with a specific entity, and I see no reason why that would have a deleterious effect on the ability of the mark as a whole to indicate trade origin. My view is that the earlier mark has an average degree of inherent distinctive character. The opponent lays claim to enhanced distinctive character due to the use that has been made of the earlier mark.

31. Mr Cadman's evidence is that the opponent is a football club and a member of the Premier League.³ The opponent is said to have come to particular national prominence in the 2015/2016 football season when it won the Premier League against tremendous odds. An article from May 2016 details the digital growth which resulted for the opponent's social media sites, moving its social media audience up eleven places to seventh largest among the Premier League teams.⁴ The article says that on-pitch performance has increased the opponent's visibility on television and in "general Premier League conversation", though it attributes much of the opponent's digital success to international growth (for example, 18% came from Algeria). It includes some references to "LCFC".

³ Cadman, §10.

⁴ TC4.

32. There is evidence from 2017 and 2018 of the opponent's Twitter, Instagram and Facebook accounts.⁵ All show the handle "@lfc", though "Leicester City" or "Leicester City Football Club" are the profile names which precede "lfc" on individual posts. The Twitter and Instagram accounts have over a million followers each; Facebook has in excess of six million. However, these appear to be global figures. Links on the Twitter and Facebook pages appear to show that the opponent's website is lfc.com.

33. A BBC news article dated 16 May 2016 details the victory parade following the opponent's Premier League win, which attracted over 240,000 onlookers.⁶ The article does not refer to the opponent as "LCFC" but the initials are visible on the team's bus.

34. Prints dated March 2018 from the opponent's website show the letters "LCFC" used in connection with various items such as pens, pencils, notepads, books, magazines, t-shirts, hoodies, sweatshirts, hats, scarves, slippers, badges and key rings.⁷

35. The opponent's evidence shows that its Premier League win against the odds in 2016/2016 increased its visibility. My understanding is that the opponent remains in the Premier League. However, the question is not whether the opponent has a reputation but whether the trade mark "LCFC" does. "LCFC" is present on all of the opponent's social media (or at least it was in 2018 and the applicants have not suggested that the position at the relevant date was any different). However, "LCFC" appears to be the secondary brand identifier to "Leicester City"/"Leicester City Football Club" and there is no evidence of the extent to which the opponent's social media followers are in the UK, or the amount of UK traffic to those sites. "LCFC" does appear on the opponent's retail website to describe official merchandise, not always in conjunction with the words "Leicester City". There is, though, no evidence of other retail outlets and it seems to me that one football club's website is unlikely to attract a broad spectrum of consumers for the categories of goods and services at issue. I also have no evidence of the number of UK visitors to the site, or of the number of UK supporters. The third-party references to the opponent in the evidence, such as it is, tend to be to "Leicester City" or simply "Leicester"; only one article

⁵ TC1-TC3.

⁶ TC5.

⁷ TC7.

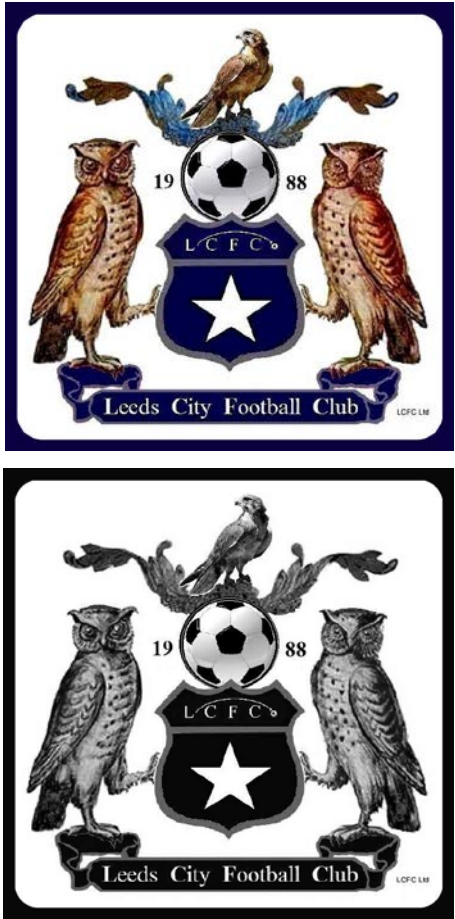
refers to the opponent as “LCFC”. There is no evidence at all of any revenue figures, nor is there any clear evidence of how the opponent’s reputation may have changed in the four years since it won the Premier League. In the absence of any evidence as to the extent of sales of goods or services in connection with the trade mark, I am not prepared to conclude that the earlier mark’s distinctiveness has been materially increased. If that is not right, the distinctiveness of the mark has only been enhanced to a reasonably high degree in relation to services connected with its activities as a football club.

Comparison of trade marks

36. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel* (particularly paragraph 23). *Sabel* also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, that:

“[...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion”.

37. It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account the distinctive and dominant components of the marks. Due weight must be given to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

Earlier mark	Contested marks (series of two)
LCFC	 <p>The image shows two versions of the Leeds City Football Club crest. The top version is in color, featuring a blue shield with a white star, flanked by two brown owls. Above the shield is a soccer ball with the numbers 19 and 88, and a falcon perched on a branch. The bottom version is a black and white version of the same crest. Both versions include the text 'Leeds City Football Club' at the bottom and 'LCFC' on the shield.</p>

38. The opponent contends that the findings in the tribunal’s previous decision O/775/18 apply, i.e. that there is a medium degree of visual similarity, and a medium to high degree of both aural and conceptual similarity. The applicants deny that the marks are “effectively” similar or identical.

39. The earlier mark consists of the letters “LCFC”. The overall impression is contained in the combination of those four letters.

40. Although one of the contested marks is in greyscale and the other in full colour, I do not consider that the difference between the colour and greyscale versions is such that there is a material alteration in the level of similarity between the earlier mark and the two contested marks. My findings can be taken to apply equally to both.

41. The contested marks are complex figurative marks containing a number of elements. Two owls support a shield device between them. At the top of the mark is a stylised leaf device placed horizontally, upon which a bird of prey sits. The shield bears a star, along with the letters "LCFC" and an arc device ending with a very small football. Above the shield is a football with "19" to the left and "88" to the right. At the bottom of the mark is a banner which bears the words "Leeds City Football Club" in an unremarkable typeface. "LCFC Ltd" is in plain, very small letters at the bottom right of the mark.

42. Given their size and position, the bird devices and shield will all play an important role in the overall impression. The football will also play a role, though to a lesser degree where the goods and services concern football and it is non-distinctive. Although they are quite small in comparison to the bird, football and shield devices, the consumer's tendency to latch on to verbal elements of a trade mark results in the words "Leeds City Football Club" and the letters "LCFC" playing a roughly equal role to the figurative elements described above; despite its central position, the "LCFC" element is smaller and it is somewhat subordinate to the full words. I am doubtful that "LCFC Ltd" at the bottom right of the mark will be noticed. That, along with the numbers "1988", which simply indicate a date, usually the date of establishment, and the commonplace banner device upon which the words sit will play only weak roles.

43. There are clearly significant visual differences between the marks. The only element which is shared are the identical letters "LCFC". In my assessment, there is a fairly low degree of visual similarity between the marks. I acknowledge that my view is different from that of the hearing officer in previous proceedings but I have taken into account my assessment of the overall impression, including the position and size of the various elements, and the fact that the shared component is identical.

44. Neither the figurative components of the contested mark, nor “1988” or “LCFC Ltd” (the latter two elements being of low distinctiveness or unlikely to be noticed) will be articulated. It will be verbalised as either “LCFC”, “Leeds City Football Club” or “LCFC Leeds United Football Club”. The levels of aural similarity with the earlier “LCFC”, which will be pronounced entirely predictably as the individual letters, will be identical, dissimilar or similar to a fairly low degree, respectively.

45. I agree with the opponent that the contested marks will be perceived as the crest of a football club: the words “Leeds City Football Club” point the consumer decidedly in that direction. In the contested marks, the letters “LCFC” will be taken to refer to the word which appear below. The earlier mark contains no such clear indication of how it should be construed. However, it is commonplace for football clubs to use “FC” in their designation and I agree with the opponent that at least a significant proportion of consumers will perceive “FC” in the earlier mark as meaning “football club”. The marks have a medium degree of conceptual similarity in such circumstances.

Likelihood of confusion

46. In determining whether there is a likelihood of confusion, all of the above factors need to be borne in mind. They must be considered globally (*Sabel* at [22]), from the perspective of the average consumer. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]). The factors considered above have a degree of interdependency (*Canon* at [17]): for example, a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

47. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *LA Sugar Limited v Back Beat Inc.*, BL O/375/10, where Iain Purvis Q.C., sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

48. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C. (as he then was), sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls another mark to mind. That is mere association, not indirect confusion.

49. I also consider it appropriate to bear in mind the guidance concerning independent distinctive elements in trade marks. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. He said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors”.

50. It is worth underscoring that the assessment of confusion under s. 5(2)(b), especially where there is no enhanced distinctiveness through use, is a somewhat artificial exercise. What I am not entitled to do is assume that the average consumer will know that “LCFC” in the earlier mark stands for “Leicester City Football Club”. The assessment must rather be made on the straightforward comparison between the trade marks and their specifications, as they appear on the register, bearing in mind the various factors in relation to which I have made findings, above.

51. There are significant visual differences between the marks. Those differences are sufficient to rule out direct confusion, i.e. that the consumer will simply think one trade mark is the other.

52. That leaves indirect confusion. In the contested mark, the element “LCFC” is an independent distinctive element, albeit one for which a meaning is easily inferred from the accompanying words. I will consider first the position where there is a fairly low degree of visual similarity, aural dissimilarity and a medium degree of conceptual similarity, which I consider will be the case for a significant proportion of consumers. The earlier mark is inherently distinctive to a medium degree. The goods and services are identical. I acknowledge that there is a relatively modest amount of visual similarity between the marks—the visual aspect being of particular importance, given the way in which the goods and services will be selected— and no aural similarity. However, the shared element is identical. Approaching the assessment on the footing I have outlined, above, my view is that there is a likelihood of indirect confusion for the average consumer, in either group, paying even a reasonably high degree of attention. The string “LCFC” is present in both marks. The average consumer is likely to associate both trade marks with a football club and, in the absence of any other indication as to origin in the earlier mark (i.e. any way to know what the letters “LC” stand for in the earlier mark), the average consumer is liable to be confused that the later mark is another mark used by the owner of the earlier mark, or vice versa. Although it does not play a dominant role in the contested mark, the common element is enough to lead the consumer to believe that the marks are used by the same or economically connected undertakings. I do not consider that the potential aural dissimilarity is sufficient to disturb that conclusion, given that the purchasing process will be mainly visual. In any event, I have found that some consumers will articulate the “LCFC” element in the contested mark. Consumers who articulate both parts are likely to constitute a smaller but still significant proportion of consumers, for whom, all of the other factors being equal, will be more, not less, susceptible to confusion. There is a likelihood of indirect confusion.

53. The ground under s. 5(2)(b) succeeds.

Other grounds

54. As the opposition under s. 5(2)(b) has succeeded in full, the claims based upon ss. 5(3) and 5(4)(a) cannot improve the opponent's position. I decline to consider the remaining grounds.

Conclusion

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

Costs

56. The opponent has been successful and is entitled to an award of costs. There is no request that I depart from the normal Registry scale (Tribunal Practice Notice 2/2016 refers). I bear in mind that there were no costs associated with considering evidence filed by the applicant. I award costs to the opponent as follows:

Official fee:	£200
Preparing the notice of opposition and considering the counterstatement:	£300
Filing evidence:	£500
Written submissions:	£300
Total:	£1,300

57. I order Leeds City Football Club Limited and LCFC Limited to pay Leicester City Football Club Limited the sum of **£1,300**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of July 2021

Heather Harrison
For the Registrar

ANNEXE

UK 3259636

Class 16: Printed matter; photographs; stationery; artists' materials; instructional and teaching materials; newspapers, magazines and periodical publications; printed publicity and promotional material; printed programmes; books; booklets; brochures; leaflets; newsletters; diaries; personal organisers; address books; albums; photograph albums; autograph books; autographed photographs and autographed paper items; scrap books; catalogues; files and folders; binders; programme binders; calendars; paper; cardboard; note pads and note books; envelopes; labels; bookmarks; bookends; paperweights; posters; trading cards; collectors' cards; stickers; transfers; decalcomanias; stencils; maps; charts; tickets; printed forms; certificates; menus; gift vouchers; philatelic stamps; paper flags and pennants; paper banners; signs and advertisement boards of paper and cardboard; cards; greeting cards; postcards; gift wrap and packaging paper; gift tags; gift bags; carrier bags; packaging bags of paper; writing instruments; drawing instruments; pens; pencils; pencil sharpeners; erasers; rulers; cases and boxes for pens and pencils; pen and pencil holders; rubber stamps; prints and pictures; money clips; beer mats; paper and cardboard coasters; paper and cardboard place mats; paper table cloths and napkins.

Class 25: Clothing, footwear, headgear; articles of outer clothing; sportswear; leisurewear; sports kits; sports shirts; sports shorts; sports socks; football kits; football shirts; football shorts; football socks; training clothing; tracksuits; training pants; sweatshirts; sweatpants; jackets; coats; waterproof clothing; anoraks; shirts; tops; t-shirts; polo shirts; vests; knitwear; jerseys; pullovers; sweaters; hooded tops; cardigans; waistcoats; suits; trousers; pants; shorts; ties; underwear; nightwear; swimwear; socks; gloves; mittens; scarves; wristbands; headbands; ready-made clothes linings; shoes; boots; sandals; slippers; sports shoes; training shoes; football boots and shoes; studs for football boots; hats; caps; sun visors; belts; aprons; uniforms; articles of clothing, footwear and headgear for babies and children; bibs; baby boots.

Class 26: Badges for wear; ornamental novelty badges; embroidered badges; belt clasps; buckles; embroidery; haberdashery; sewing thimbles; hat ornaments; patches; ribbons and braid; hair ornaments; hair fasteners; hair bands; hair pins; hair grips; hair clips; hair slides; hair nets; buttons; rosettes; shoe ornaments; clothing and shoe fasteners; shoe laces; cords; numerals or letters for marking textile articles; competitors' numbers; expanding bands for holding sleeves; artificial flowers; lanyards for wear.

Class 41: Entertainment; sporting and cultural activities; education; providing of training; sporting services; organisation of sporting events; provision of entertainment, training, recreational, sporting and cultural activities and facilities; instruction and educational services; education and training in relation to sports; football academy services; football coaching; arranging and conducting of education and training in relation to football; arranging, conducting and provision of football instructional courses; football entertainment services; entertainment in the nature of football games; physical education; fitness training services; physiotherapy training; sport and holiday camp services (in the nature of entertainment); rental of sporting equipment; practical training and demonstrations; arranging, organising and conducting of conferences, conventions, seminars, events and exhibitions; arranging, organising and conducting of games, contests, competitions, shows and parties; organising community sporting and cultural events; hospitality services (entertainment); lotteries; gaming services; arranging, organising and conducting of award ceremonies; provision of museum facilities; provision and management of stadium facilities and services; rental of stadium facilities; management of sports facilities; presentation of live performances; provision of club sporting services; sports club services; provision of health club, fitness club and gymnasium facilities; provision of sports information services; provision of information relating to football; sporting information services, namely scouting of players; fan club services; fan club membership scheme services; box office services; booking and ticketing services for sports, entertainment, cultural and educational events; entertainment, training, recreational, and sporting information services provided via the Internet and other computer and communications networks; education and entertainment services provided by means of radio, television, telephony, the Internet and online databases; provision of cinematographic and video entertainment; entertainment and

educational services featuring electronic media, multimedia content, audio and video content, movies, pictures, photographs, graphics, images, text and related information provided via the Internet and other computer and communications networks; streamable audio and/or video recordings; streamable music, sounds, images, graphics, videos, games, text or data; film production; production of video recordings and/or sound recordings; production and distribution of television and radio programmes; production of sporting events for television and radio; publication of magazines, books, texts and printed matter; publishing by electronic means; providing online non-downloadable electronic publications; provision of television programmes, radio programmes, films, audio and/or visual material and games online (not downloadable); publication of news online; information relating to sport and entertainment provided online from a computer database or the Internet; information, advisory and consultancy services in relation to all of the aforesaid.