

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25

THE PATENT OFFICE

Room 1,
Harmsworth House,
13-15 Bouverie Street,
London, EC4Y 8DP.

Friday, 10th November 2006

Before:

THE APPOINTED PERSON
(MR. GEOFFREY HOBBS QC)

In the Matter of THE TRADE MARKS ACT 1994

-and-

In the Matter of UK Trade Mark Application No. 2307413
THE FA & Device in the name of
THE FOOTBALL ASSOCIATION LIMITED

-and-

In the Matter of Opposition No. 91618 thereto by Henkel KgaA

Appeal of the Opponent from the decision of
Mr. G.W. Salthouse dated 28th April 2006 on behalf of the
Registrar

(Computer-Aided Transcript of the Stenograph Notes of
Marten Walsh Cherer Ltd., Midway House,
27-29 Cursitor Street, London EC4A 1LT.
Telephone No: 020-74055010. Fax No: 020-74055026)

MR. SIMON MALYNICZ (instructed by Messrs. Forrester Ketley & Co.)
appeared on behalf of the Applicant/Respondent.

MS. RIGEL MOSS McGRATH (of Messrs. W.P. Thompson & Co.) appeared
on behalf of the Opponent/Appellant.

D E C I S I O N
(As approved)

1 THE APPOINTED PERSON: On 6th August 2002, the Football
2 Association Limited applied under number 2307413 to register
3 the following sign as a trade mark for use in relation to
4 a very wide range of goods and services:
5



12 The goods and services specified in the application for
13 registration are set out in Annex A to this decision.

14 The application for registration was subsequently
15 opposed by Henkel KGaA. It contended that use of the
16 applicant's mark in relation to goods and services of the kind
17 specified in the application would conflict with the rights to
18 which the opponent was entitled as proprietor of a cited
19 earlier Community trade mark registration under section
20 5(2)(b) of the Trade Marks Act 1994.

21 The cited registration was Community trade mark

1 number 69047 for the word mark **Fa** registered in respect of
2 the following goods in classes 3, 5 and 21:

3 Class 3. Soaps, perfumery, essential oils, preparations for
4 body and beautycare, deodorants for personal use, chemical
5 preparations for care and treatment of hair, non-medicated
6 toothpastes and mouthwashes, cosmetical foam baths and shower
7 baths.

8 Class 5. Medicated toothpastes and mouthwashes, chemical
9 preparations for sanitary purposes, disinfectants.

10 Class 21. Electric toothbrushes, dental water jets, shaving
11 brushes, powder puffs, eyebrow brushes, eyelash formers.

12 The trade mark was registered on 13th November 1998
13 pursuant to an application filed on 1st April 1996.

14 The evidence in support of the opposition consisted of a
15 witness statement of Gerhard Vasen with seven exhibits dated 3rd
16 March 2005. Mr. Vasen is the opponent's trade mark manager.
17 He maintained that the application for registration should be
18 refused in its entirety. His evidence showed that the earlier
19 trade mark had been used in Germany since the 1950s and that
20 it had subsequently come to acquire a reputation through use
21 in relation to goods of the kind for which it was registered
22 in many territories of the EU. However, he provided no
23 evidence of use or reputation in the United Kingdom.

24 With regard to the objection the opponent had raised
25 under section 5(2)(b), he said this:

26 "The contested mark is confusingly similar to my
27 Company's **Fa** trade mark, by virtue of the fact that the text
28 element of the applied for mark, '**THE FA**' is visually and
29 phonetically almost identical to the registered mark, **Fa**.
30 Furthermore, it is an established principle that if a mark

1 consists of text and a device, the text element is generally
2 the dominant element, as the consumer will refer to the mark
3 by the text element, or search for references to the mark on
4 the Internet using the text element. This submission is
5 highlighted by the following example. There is now produced
6 and shown to me EXHIBIT GV5 results of an Internet search,
7 using the term '**Fa**' and the Google search engine. The first
8 two results are links to the www.thefa.com website (the
9 Applicant's official website) clearly demonstrating the
10 possibility for confusion between the two marks." I note that
11 he offered no evidence with regard to pronunciation of his
12 company's trade mark and that he made no reference to there
13 being any conceptual similarity between the marks in issue.

14 The evidence in defence of the application was contained
15 in a witness statement of Nicholas Langhorne with seven
16 exhibits dated 12th September 2005. Mr. Langhorne is employed
17 as an in-house solicitor for the applicant. He referred to
18 the long history of the applicant as an association going back
19 to its foundation in 1871/1872. He also confirmed that the name
20 of the Association had for a considerable number of years been
21 abbreviated to "**The FA**" with the result that the designation
22 "**The FA**" had, according to his understanding of the position,
23 been distinctive of the Association and its activities since
24 at least 1949.

25 He noted that the device element of the opposed
26 application for registration, which he identified as "The FA
27 Crest", was derived from the Coat of Arms granted to the
28 Association by the College of Arms in 1948/1949. He confirmed
29 that The FA Crest had been licensed for use in respect of
30 a wide range of merchandise over a number of years.

1 At Exhibit 5 he produced details of the applicant's
2 United Kingdom registrations for, firstly, **The FA** in respect
3 of goods and services in various classes with effect from
4 6th August 2002; and, secondly, **FA** in respect of goods and
5 services in various classes with effect from 14th October
6 1993.

7 In paragraph 16 of his witness statement, he noted with
8 reference to the opponent's trade mark that he would expect it
9 to be pronounced so as to rhyme with the English word "far"
10 rather than as two separate letters.

11 Mr. Vasen provided a witness statement in reply.
12 He made comments and observations in relation to successive
13 paragraphs of Mr. Langhorne's witness statement.
14 Significantly, in my view, he made no comment or observation
15 in response to what Mr. Langhorne had said in paragraph 16 of
16 his witness statement on the subject of pronunciation.

17 The opposition was determined by Mr. George Salthouse
18 acting on behalf of the Registrar. Both sides filed written
19 submissions. Neither side wished to be heard. In his written
20 decision issued on 28th April 2006 under reference BL O-118-06
21 Mr. Salthouse rejected the opposition in its entirety and
22 ordered the opponent to pay £1,200 as a contribution towards
23 the applicant's costs of the Registry proceedings.

24 Having noted the well-established requirement for his
25 decision to be based on a global appreciation of all relevant

1 factors and made with due regard for the so-called principle of
2 interdependence (see paragraphs 19, 20 and 25 of his decision)
3 he concluded his assessment in the following terms:

4 "27. I now turn to the marks of the two parties. For
5 ease of reference I reproduce them below, with the applicant's
6 mark significantly reduced in size to take into account the
7 view expressed by the opponent regarding the dominant aspects
8 of the applicant's mark when used on goods in the marketplace:
9

Applicant's Mark	Opponent's Mark
	Fa

14 28. The opponent contends that the applicant's mark is
15 made up of three elements; the word 'THE' the letters 'FA' and
16 the shield device. It claims that the word 'The' is a
17 non-distinctive element whilst the other two elements are
18 distinctive. Of these two elements the opponent contends that
19 the letters 'FA' are very bold and so, in a reduced form the
20 shield element loses its visual impact, making the 'FA'
21 element even more dominant. They also comment that it is
22 accepted that words speak louder than devices. Thus, the
23 opponent contends that the two marks are visually and
24 phonetically similar.

25 29. I do not agree with the opponent that the average

1 consumer would carry out such a detailed dissection of the
2 mark. Consumers tend to view marks as wholes. However, even
3 following the contentions of the opponent and dismissing the
4 word 'The' as non-distinctive, I do not agree that the shield
5 device loses its visual impact when the mark is reduced in
6 size. In paragraph 27 above I have reduced the mark
7 considerably, and it is shown in a size that could readily be
8 applied to all goods covered by the opposition. To my mind
9 the shield device does not lose its visual impact. It is
10 still very clear and is still a very prominent part of the
11 overall mark. The letters at the top of the mark are
12 approaching the size where those with less than perfect vision
13 begin to struggle to read them. To my mind the marks are
14 visually and phonetically quite different.

15 30. No conceptual meaning has been provided for the
16 opponent's mark and I can only conclude that the average
17 consumer would not attach any meaning to the mark. The
18 applicant's mark would be seen by a large number of consumers
19 as referring to the first or original football association,
20 the device element being an obvious reference to England.

21 31. Taking account of the above it is my opinion that
22 the differences between the marks outweigh the similarities.

23 32. Taking account of all of the above when considering
24 the marks globally, I believe that there is not a likelihood
25 of consumers being confused into believing that the goods

1 provided by the applicant are those of the opponent or provided
2 by some undertaking linked to them. The opposition under
3 Section 5(2)(b) therefore fails."

4 The opponent gave notice of appeal to an Appointed
5 Person under section 76 of the Act contending in substance
6 that the hearing officer had erred by giving insufficient
7 weight to the degree of visual and phonetic similarity between
8 **The FA** on the one hand and **Fa** on the other when assessing the
9 likelihood of confusion under 5(2)(b). This contention was
10 developed in argument at the hearing before me.

11 At this point I think it is appropriate to refer to the
12 basic proposition confirmed by the ECJ in paragraph 29 of its
13 Judgment in Case C-120/04 Medion AG v Thomson Multimedia Sales
14 Germany & Austria GmbH (6th October 2005) that:

15 "29. In the context of consideration of the likelihood
16 of confusion, assessment of the similarity between two marks
17 means more than taking just one component of a composite trade
18 mark and comparing it with another mark. On the contrary, the
19 comparison must be made by examining each of the marks in
20 question as a whole, which does not mean that the overall
21 impression conveyed to the relevant public by a composite
22 trade mark may not, in certain circumstances, be dominated by
23 one or more of its components (see Matratzen Concord, paragraph
24 32)"

25 In a case such as the present, the marks in issue must

1 therefore be evaluated and compared without dismemberment or
2 excision. When that is done, they might be found to have
3 elements in common that the relevant average consumer may take
4 to be performing "an independent distinctive role". They
5 might then be regarded as distinctively similar marks, the
6 concurrent use of which would be liable to give rise to the
7 existence of a likelihood of confusion. This was recognised in
8 paragraphs 30 and 31 of the Judgment of the Court:

9 "30. However, beyond the usual case where the average
10 consumer perceives a mark as a whole, and notwithstanding that
11 the overall impression may be dominated by one or more
12 components of a composite mark, it is quite possible that in a
13 particular case an earlier mark used by a third party in a
14 composite sign including the name of the company of the third
15 party still has an independent distinctive role in the composite
16 sign, without necessarily constituting the dominant element.

17 31. In such a case the overall impression produced by
18 the composite sign may lead the public to believe that the goods
19 or services at issue derive, at the very least, from companies
20 which are linked economically, in which case the likelihood of
21 confusion must be held to be established."

22 For the purposes of the required assessment, the
23 decision taker must consider the net effect of the differences
24 and similarities between the marks in issue from the
25 perspective of the average consumer of the goods and services
26 concerned. The differences and similarities must be given as
27 much or as little significance as the average consumer would
28 have attached to them at the date of the opposed application

1 for registration.

2 In the present case, I think it is clear that the
3 applicant's mark would have been perceived and remembered as
4 the emblem of an organisation known as "**The FA**" and I have
5 little doubt that in the United Kingdom most people exposed to
6 the use of that emblem in relation to the goods and services
7 of the applicant would at the relevant date have appreciated
8 that the letters **F** and **A** were being used as an abbreviation of
9 the name of the relevant organisation, i.e. The Football
10 Association. Visually the mark would have been perceived as a
11 synthesis of verbal and non-verbal elements, each contributing
12 fully to the overall message that the mark denoted goods or
13 services directly or indirectly linked to the organisation
14 known as **The FA**.

15 On audible enunciation of the verbal elements of the
16 mark they would likewise be perceived as referring to the
17 organisation known as **The FA**. Conceptually, the mark as
18 a whole would fix itself in the recollection of the relevant
19 average consumer primarily as an emblem of identity.

20 I think that the relevant average consumer in the United
21 Kingdom would on exposure to the opponent's mark at the relevant
22 date have perceived and remembered it as a two-letter word. I
23 think that is how it appears visually to the eye of the
24 observer. On audible enunciation I would expect it to have been
25 pronounced so as to rhyme with the word "far". Conceptually,
26 it would fix itself in the recollection of the relevant
27 average consumer as an invented word with no readily
28 discernible hint or suggestion of meaning.

29 The case for similarity conducive to the existence of
30 a likelihood of confusion must, on this assessment of the

1 marks in issue, depend upon an entirely letter-based approach.
2 However, that approach appears to me to be unreal in
3 circumstances where the letters **F** and **A** function in
4 combination in the applicant's mark as an abbreviation of the
5 words which go to make up the name of a particular
6 organisation, but function in combination in the opponent's
7 mark as a single word with no readily discernible hint or
8 suggestion of meaning.

9 Indeed, the opponent's reliance on the results of a
10 Google search based on the term **Fa** appears to prove the
11 point exactly. It can be seen on visiting the Google Help
12 Center section of the Google website that Google searches are
13 not case sensitive:

14 "**Capitalization.** Google searches are NOT case
15 sensitive. All letters, regardless of how you type them, will
16 be understood as lower case. For example, searches for **george**
17 **washington**, **George Washington**, and **gEoRge wASHINGToN** will all
18 return the same results."

19 Thus, it is only by ignoring the visual, aural and
20 conceptual differences between the presentation of the letters
21 **F** and **A** in the marks at issue and adopting the essentially
22 robotic approach of a search engine that it is possible to
23 bring the marks into conflict at all. At the level of human
24 perception, I think that such similarities as there are between
25 the marks in issue are so slight and the differences between

1 them so great that, even where there is direct overlap between
2 the goods of the rival specifications, the marks could be used
3 concurrently in the course of trade in the United Kingdom
4 without giving rise to the existence of a likelihood of
5 confusion.

6 I agree with the hearing officer in thinking the
7 opposition should be dismissed. The appeal is therefore
8 dismissed.

9 MR. MALYNICZ: I am grateful for that. The only point remains to
10 ask for my costs of the appeal as well as the costs below
11 being confirmed.

12 THE APPOINTED PERSON: The figure below was £1,200.

13 MR. MALYNICZ: Yes.

14 THE APPOINTED PERSON: It was done entirely on paper but then
15 there was the evidence to prepare. All right. What do you
16 say, Ms. McGrath, do you oppose an award of costs?

17 MS. McGRATH: Naturally!

18 THE APPOINTED PERSON: Any reasons for opposing it?

19 MS. McGRATH: No, sir.

20 THE APPOINTED PERSON: All right. I think this is a case where
21 costs of the appeal should follow the event. I think
22 a reasonable award in favour of the successful applicant on
23 this appeal would be the same again, that is to say £1,200.
24 That sum to be paid within 14 days of the date of this
25 decision. Of course, that is in addition to £1,200 which have

ANNEX A

1 Class 03:

2 Non-medicated toilet preparations; soaps; shampoos;
3 deodorants; preparations for the care, treatment and
4 cleansing of the skin, hair and the body; preparations
5 for the bath and shower; aftershave preparations;
6 shaving preparations; cosmetic preparations;
7 dentifrices; laundry detergent and fabric conditioners;
8 vegetable dye skin transfers.

9

10 Class 05:

11 Air fresheners; air purifying preparations; deodorants
12 and deodorisers (other than for personal use).

13

14 Class 06:

15 Badges of metal for vehicles; metal badges; key rings;
16 metal toy boxes; metallic bins.

17

18 Class 08:

19 Hand-operated tools and implements; electric and
20 non-electric razors, including razor blades and
21 accessories therefor; cutlery; canteens of cutlery,
22 cutlery for children, disposable cutlery; manicure and
23 pedicure implements; scissors; depilatory apparatus;
24 eyebrow tweezers.

25

26 Class 09:

27 Sound and/or video recordings; tapes; cassettes; compact
28 discs; films; slides; lenticulars; video recorders;

1 video cassettes; games adapted for use with television
2 receivers; computer software; computer games; screen
3 savers; publications in electronic format; data
4 processing apparatus; electric and electronic
5 scoreboards; photographic and cinematographic apparatus
6 and instruments; apparatus for recording, transmission
7 or reproduction of sound or images; calculators; video
8 discs; time recording apparatus and instruments; encoded
9 credit cards, debit cards and charge cards; telephone
10 apparatus and instruments; sunglasses; protective
11 helmets; parts and fittings for all the aforesaid goods.

12

13 Class 11:

14 Lampshades; torches; lighting apparatus and
15 installations.

16

17 Class 14:

18 Urological and chronometric instruments; clocks and
19 watches; trophies; ornaments, figurines, models; badges
20 and brooches; tea plates, tea services, tea caddies, tea
21 pots, goblets, egg cups; trays, vases and urns; salt and
22 pepper pots; napkin holders and napkin rings; all made
23 wholly or principally of precious metals and their
24 alloys or coated therewith; jewellery and precious
25 stones; tie clips, tie pins, cuff links; medals and
26 medallions; coins; timekeeping systems for sport; shoe
27 ornaments of precious metal; belt buckles of precious
28 metal; key rings; identity tags and bracelets of
29 precious metal; silver lockets; rings, earrings; silver

1 perfume atomisers; silver perfume flasks and funnels;
2 silver pill boxes; silver compacts containing mirrors.

3

4 Class 16:

5 Paper; cardboard; notepaper; writing paper; transfers;
6 decalcomanias; labels; printed matter; trading cards;
7 stickers; posters; albums; periodical publications;
8 books; photographs; packs of photographs; stationery;
9 rulers; adhesive materials (stationery); instructional
10 and teaching materials (other than apparatus); coaching
11 aids in the nature of magnetic and dry-wipeable surfaces
12 with magnetic pieces; flags of paper, pennants of paper;
13 replica football kits made of paper or cardboard;
14 calendars; desk top calendars; milk cartons of
15 cardboard; beer mats; paper figurines; pencil cases;
16 writing and drawing instruments; writing instruments of
17 precious metals; files; folders and folios; personal
18 organisers; diaries; picture frames of cardboard;
19 greeting cards; wrapping and packaging materials;
20 appliques of paper; laminated cards; tissues and towels
21 made of paper; lithoserigraphs; rosettes of paper; paper
22 napkins and tablecloths; non-encoded credit, debit and
23 charge cards.

24

25 Class 18:

26 Bags and containers; leather and imitations of leather
27 and goods made from these materials; umbrellas; walking
28 sticks.

29

30 Class 20:

1 Tags; tags for use on soccer bags, made wholly or
2 principally of plastic; identity tags; identity tags for
3 use on soccer bags, made wholly or principally of
4 plastic; identification bracelets (not of metal) for
5 hospital purposes; plastic clips; plastic closures for
6 containers; picture frames; mirrors; replica football
7 kits made of plastic; cake decorations made of plastic;
8 non-metallic bins; bean bags; plastic figurines.

9

10 Class 21:

11 Lunch boxes; flasks; table mats; tankards; pewterware;
12 mugs; glassware; nonics; lager glasses; plastic cups,
13 soap holders and dispensers; toothbrushes; toothbrush
14 holders; sponges for toilet use; ceramic ornaments and
15 holloware; cleaning cloths; water bottles; perfume
16 atomisers; perfume flasks and funnels; pill boxes;
17 mirrors; compacts (not of precious metals or coated
18 therewith) containing mirrors.

19

20 Class 24:

21 Textile piece goods; bath linen; bed covers; curtains of
22 textile or plastic; sleeping bag sheet liners; bean bag
23 covers; fabric for use in the manufacture of bags; fibre
24 fabrics for use in the manufacture of linings of bags;
25 quilt bags; handkerchiefs; tea towels; textile wall
1 hangings; bar towels; flags (not of paper); pennants;
2 napkins and tablecloths.

1 Class 25:
2 Articles of outerclothing; articles of underclothing;
3 footwear; headgear.
4
5 Class 26:
6 Badges; pins; emblems; buttons; buckles; tie pins, (none
7 of precious metals or coated therewith); brooches (none
8 of precious metals or coated therewith); embroidery
9 being textile smallwares; shoe ornaments; appliques of
10 textile; rosettes of textile.
11
12 Class 27:
13 Wallpapers; wall paper borders; rugs; mats; wall
14 hangings.
15
16 Class 28:
17 Games and playthings; kites; gymnastic and sporting
18 articles; bags adapted for carrying sporting apparatus;
19 novelties; miniature replica football kits; action
20 figure toys; footballs; balls; goal posts; hand-held
21 electronic games; sponge hands in the nature of
22 novelties; outdoor rebound walls in the nature of
23 playthings and sporting articles; playing cards; coin
24 and/or counter-operated games.
25
26 Class 29:
27 Meat, fish, poultry and game; meat extracts; preserved,
28 dried and cooked fruits and vegetables; jellies, jams,
29 fruit sauces; milk and milk products; marmalade; meals
30 prepared from fish and poultry; snack foods; pickles;

1 processed peanuts; potato crisps; peanut butter; soups.

2

3 Class 30:

4 Coffee, tea, cocoa, artificial coffee; preparations made
5 from cereals; bread, pastry and confectionery; ices;
6 sauces (condiments); chocolate spread; cakes; cake
7 decorations made of candy; biscuits; frozen
8 confectionery; pizza; snack foods; snack foods and
9 crisps made from potato flour.

10

11 Class 32:

12 Non-alcoholic beverages; beers; mineral and aerated
13 waters; fruit drinks and fruit juices; isotonic drinks;
14 syrups and other preparations for making beverages.

15

16 Class 33:

17 Alcoholic beverages; wine, cider, champagne, perry.

18

19 Class 36:

20 Insurance services; general insurances; credit card,
21 charge card and debit card services; investment and
22 pension services; life insurance (protection investment
23 and pension products); banking and money transmission
24 services; secured lending; unsecured lending; interest
25 bearing and equity linked savings accounts and bonds;
26 unit trusts/PEPs/ISAs.

27

28 Class 38:

29 Broadcasting services; broadcasting and transmission of

1 television programmes; data transmission and data
2 broadcasting; broadcasting and transmission of text,
3 messages, information, sound and images; transmission of
4 television programmes, text, messages, information,
5 sound and images via communication and computer
6 networks; computer aided transmission of information,
7 messages, text, sound, images, data and television
8 programmes; broadcasting and transmission of digital
9 information by means of cable, wire or fibre; receiving
10 and exchanging of information text, messages, sound,
11 images and data; electronic mail services; interactive
12 video text services; news information and news agency
13 services; message sending; communications by and/or
14 between computers and computer terminals; communications
15 for access to information, text, sound, images and data
16 via communication and computer networks;
17 telecommunications access services for access to a
18 communications or computer network; retrieval, provision
19 and display of information from a computer stored
20 databank; electronic display of information, messages,
21 text images and data; on-line services; on-line
22 information services; information and advisory services
23 relating to any of the aforesaid services.

24

25 Class 41:

26 Training services; football academy services; assessment
27 and qualifications services; coaching; organisation of
28 competitions and sporting events; provision of courses
29 of instruction in coaching, sports medicine, player

1 development and child protection and welfare; physical
2 fitness instruction; practical training demonstrations
3 relating to football; providing courses of instruction
4 in self-awareness; arranging and conducting seminars,
5 conferences, exhibitions and symposia relating to
6 football; provision of club recreation facilities;
7 officiating at sports contests; sports camp services;
8 sports club services; provision of sports facilities;
9 sports refereeing; timing of sports events; staging of
10 sports tournaments; provision of information relating to
11 all of the aforesaid services; publication of printed
12 matter; award ceremonies; entertainment services;
13 production, presentation, distribution, syndication,
14 networking and rental of television programmes, films
15 and video recordings; production and presentation.