

EUTrade Mark Registration No. 010625812
 WEMBLEY FC and Lion's Head Device in Classes 3, 6, 9, 12, 14, 16,
 18, 20, 21, 25, 28, 32, 33, 35, 41 and 43



In the name of Wembley Football Club Limited
 - and -

Application for Declaration of Invalidity thereto
 by Wembley National Stadium Ltd



Statement of Grounds for Invalidity

1. The Applicant, Wembley National Stadium Ltd ('the Applicant') of Wembley Stadium, Wembley, London HA9 0WS hereby files an application for invalidity in respect of Community Trade Mark Registration No. 010625812 for the mark WEMBLEY FC and Lion's Head Device in Classes 3, 6, 9, 12, 14, 16, 18, 20, 21, 25, 28, 32, 33, 35, 41 and 43 (hereinafter referred to as "*the Subject mark*") in the name of Wembley Football Club Limited ('the Registrant') whose full address on record is 14 Woodfield Avenue North, Wembley, Middlesex, HA0 3NR. The language of the proceedings shall be English.
2. The Applicant is the owner of a number of United Kingdom and European Community Trade Mark registrations, as set out below:

Country	Mark	Classes	Application Date	Registration Date	Registration No.
EUTM	WEMBLEY	3, 6, 9, 14, 16, 18, 20, 21, 24, 25, 26, 28, 35, 42	02/07/1997	11/02/2000	000578930
EUTM	WEMBLEY STADIUM	2, 3, 5, 6, 8, 9, 11, 12, 13, 14, 15, 16, 18, 20, 21, 22, 24, 25, 26, 27, 28, 29, 30, 31, 32, 34, 35, 36, 38, 39, 41, 42, 43, 44	05/09/2007	10/06/2009	006284376
EUTM	 WEMBLEY	2, 3, 6, 9, 13, 14, 15, 16, 18, 20, 21, 22, 24, 25, 26, 27, 28, 29, 30, 31, 32, 35, 36, 38, 39, 41, 42, 43, 44, 45	22/04/2010	08/12/2010	009047176
EUTM	 CLUB WEMBLEY	2, 3, 6, 9, 13, 14, 15, 16, 18, 20, 21, 22, 24, 25, 26, 27, 28, 29, 30, 31, 32, 35, 36, 38, 39, 41, 42, 43, 44, 45	22/04/2010	08/12/2010	009048455
United Kingdom	WEMBLEY	6, 9, 14, 16, 18, 20, 21, 24, 25, 26, 28, 30, 31, 35, 41, 43, 45	31/10/1994	10/09/1999	2000877
United Kingdom	CLUB WEMBLEY	2, 3, 5, 6, 8, 9, 11, 14, 15, 16, 18, 20, 21, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 35, 36, 38, 39, 41, 42, 43	08/05/2003	25/06/2004	2331757

Country	Mark	Classes	Application Date	Registration Date	Registration No
United Kingdom	WEMBLEY STADIUM	2, 3, 5, 6, 8, 11, 12, 13, 14, 15, 18, 20, 21, 22, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 38, 39, 41, 42, 43, 44	05/09/2007	05/11/2010	2466088

- Collectively, the above marks shall be hereinafter referred to as "*the Applicant's marks*". We attach as **Exhibit A** extracts taken from the UK and Community trade mark databases, showing the relevant pages of the EU registration certificates and including renewal certificates for the relevant UK registrations to prove validity.
- On 8 February 2012, Wembley Football Club Limited filed the Subject Mark WEMBLEY FC and Lion's Head Device in Classes 3, 6, 9, 12, 14, 16, 18, 20, 21, 25, 28, 32, 33, 35, 41 and 43, now under EU Trade Mark Registration No. 010625812, depicted below:



- In accordance with Article 53(1)(a), an EU Trade Mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings where there is an earlier trade mark as referred to in Article 8(2) and the conditions set out in Article 8(1) or 8(5) are fulfilled.
- An "Earlier trade mark" under Article 8(2) means, *inter alia*, a EU Trade Mark, national Member State mark, or an International Trade Mark Registration with effect in the European Community or one of its Member States, with a date of application for registration which is earlier than the date of application for registration of the Subject mark.
- The Subject mark was filed on 8 February 2012. Therefore, the Applicant's marks [annexed hereto and referred to as Exhibit A above] are "Earlier trade marks" under Article 8(2) of the Council Registration 207/2009.
- In addition, Article 53(1)(c) provides that an EU trade mark shall be declared invalid where an earlier right referred to under Article 8(4) and the conditions therein exists.
- The Applicant has a reputation in the WEMBLEY name in the UK and EU dating back to the early 1920s, used in the course of trade, of more than mere local significance, sufficient to

establish common law rights and recognition. Indeed, the name has become famous and synonymous with the Applicant over many decades of use, particularly with respect to sports related goods/services as will be demonstrated.

Background

10. The Applicant is the owner of Wembley Stadium, the national football stadium of the United Kingdom. It is the second largest football stadium in the European Community, behind only Camp Nou in Barcelona.
11. Wembley Stadium was built in 1923. The original stadium was demolished in 2003, and replaced by the new Wembley Stadium, which opened in 2007. The new stadium was designed by Foster & Partners, including the now iconic arch which rises 133 metres above the external concourse of the stadium and is the longest single span roof structure in the world.
12. It has a capacity of between 60,000 and 105,000 people depending upon the event being housed, and is arguably the most iconic sports and entertainment venue in the United Kingdom and one of the most recognisable and iconic in Europe.
13. Wembley Stadium was the primary venue of the (1948 Olympics with king) 1966 Football World Cup, which was hosted by England, and was the venue to the England National Team's only ever World Cup win.
14. In May 2011, Wembley Stadium hosted the UEFA Champions League Final match between FC Barcelona and Manchester United. It also later hosted the 2013 Champions League Final.
15. Wembley Stadium, as the home of the English Football Association, is the host of all major football events in the English football calendar. It is also the venue for dozens of sporting and entertainment events every year, including:
 - The Football Association Cup (FA Cup) final;
 - The League Cup final;
 - The FA Community Shield;
 - All England Football Club home matches
 - The FA Trophy final;
 - The annual Football League promotion play-offs;
 - The Rugby League Challenge Cup final;
 - The annual 95.8 Capital FM Summertime Ball (concert);
 - Various large-scale music events throughout the summer.

16. The Rugby League Challenge Cup final was played annually at the 'old' Wembley Stadium from 1929 through to its closure, and returned to the new stadium in 2007, where it is again played annually.
17. In 1984, a United States Football League game was staged at Wembley Stadium, and between 1986 and 1993 eight National Football League (NFL) games were staged at the stadium featuring 13 different NFL teams. Since the new stadium opened in 2007, it has hosted one game per year during the regular NFL season, increasing to two in 2013, and the Jacksonville Tigers NFL team has committed to staging games at the Stadium during the 2013 to 2016 NFL seasons.
18. The first music event to take place at the new Wembley Stadium was a concert by George Michael in June 2007. This was followed by two sell-out shows by Muse a week later. Prior to these dates, Wembley was used as a venue for numerous concerts and events including the globally viewed LIVE AID concert from 1985 amongst many other famous artists.
19. In 2008, Madonna performed at the stadium to a sell-out crowd of 74,000 people. This concert alone grossed more than 12 million US Dollars, surpassing all other single concerts at Wembley Stadium.
20. In summer 2009, Take That played four nights at the stadium breaking the record for the fastest-selling tour in UK history. This record was broken by the same group two years later for their eight-date show at the stadium in 2011. More than 600,000 people attended the latter shows.
21. The stadium has hosted two large-scale charity concerts, including the Concert for Diana, commemorating the tenth anniversary of the death of Diana Princess of Wales, in July 2007.
22. This concert was attended by 63,000 people, and was broadcast in 140 countries worldwide, with an estimated audience of 5 million people.
23. In the United Kingdom the concert was broadcast by the BBC on television and radio. It received an average of 8.9 million viewers in the UK alone, peaking at 14.8 million. The concert lasted eight hours, and commanded a 44% share of the UK viewing audience for that time.
24. In June 2010, Green Day performed at the stadium as part of their world tour. This date was attended by the band's largest audience to date.
25. Since 2007, Wembley Stadium has hosted frequent large-scale music events including concerts by world famous acts including those listed above, and Metallica, the Foo Fighters; AC/DC, Oasis, U2, Coldplay, Bruce Springsteen, the Killers and Robbie Williams (as a solo artist).

Grounds for Invalidity

26. The Applicant bases their Application for Invalidity on a number of grounds, namely:

- a) **Article 53(1)(a) – Likelihood of Confusion with an Earlier Trade Mark**

- b) Article 8(5) – Earlier Trade Mark with a Reputation
- c) Article 53(1) c – Earlier non-registered mark of more than mere local significance with a reputation

27. This Application for Declaration of Invalidity is directed against all goods and services covered under the Subject registration on this basis.

28. Dealing with each of these grounds in turn:

Article 53(1)(a) – Likelihood of Confusion with an earlier Trade Mark

29. *An EU Trade Mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings where there is an earlier trade mark as referred to in Article 8(2) and the conditions set out in Article 8(1) or Article 8(5) are fulfilled.*

30. As already indicated above, the Applicant’s marks are ‘Earlier trade marks’ within the meaning of Article 8(2) of the Council Regulation 207/2009.

31. In accordance with Article 8(1)(b), upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered if, because of its identity with or similarity to the earlier trade mark and the identity or similarity between the goods or services covered by the trade mark, there exists a likelihood of confusion on the part of the public in the in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier mark.

32. By analogy therefore, and according to the wording of Article 53(1)(a), an EU Trade Mark shall be declared invalid if, at the date of application there existed an earlier mark which fulfilled the criteria set out above.

Similarity between the marks

33. The marks to be compared are as follows:

<u>Applicant’s Marks</u>	<u>Registrants’ Mark</u>
<p style="text-align: center;">WEMBLEY WEMBLEY STADIUM CLUB WEMBLEY</p>  <p style="text-align: center;">WEMBLEY</p>	

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34. The tests for assessing whether two marks are similar are now well established. In order to assess the degree of similarity between the marks concerned, it is necessary to determine the degree of visual, aural or conceptual similarity between them and, where appropriate, to determine the importance to be attached to those different elements, taking into account the category of goods or services in question and the circumstances in which they are marketed (*ECJ, 27 April 2006, L'Oreal/OHIM – Revlon, C-235/05 P, paragraph 40*).
35. The global appreciation of the likelihood of confusion must, as regards the visual, aural or conceptual similarity of the marks in question, be based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components (*ECJ, 20 September 2007, Quick Restaurants/OHIM – Societe des Produits Nestle, C-193/06 P, paragraph 34*).
36. It is also well established that when assessing the dominant character of one or several given elements of a complex trade mark, account should be taken, in particular, of the inherent characteristics of each of the elements when comparing them to those of the other elements (*CFI, 13 December 2007, Miguel Cabrera Sanchez/OHIM – Industrias Carnicas Valle, T-242/06, paragraph 47*).
37. The more distinctive the earlier mark, the greater the risk of confusion. Marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (*ECJ, 27 April 2006, L'Oreal/OHIM – Revlon, C-235/05 P, Paragraph 36*).
38. As the earlier marks are registered in the United Kingdom and the European Community, and feature only English-language words, the relevant consumer in this case must be found to be those consumers in the European Community who speak or understand the English language, and in particular residents of the United Kingdom.
39. The marks in question are clearly all similar visually and phonetically.
40. The WEMBLEY element of the Registrant's mark is wholly contained within the Earlier marks, and forms the dominant and distinctive element of both the Earlier marks and the Subject Mark.
41. Where the earlier marks feature additional word elements, these are purely descriptive terms STADIUM and CLUB in respect of sports-related goods/services, serving to render the distinctive term WEMBLEY the dominant component of each. As stated in the Guidelines of the Office referring to the BURGER case (T460/11), the word element in upper case letters stands out, simply because of its position and the very large size of its lettering, from all the other elements that make up the label. Further in the VITAFIT case (R552/10), the marks were considered visually similar because there was no high variation in the stylisation of the word elements in the figurative marks and the word element was easily recognisable and legible. The same applies in this case. Similarity may also be found despite the fact that the letters are graphically portrayed in different typefaces, in italics or bold, in upper or lower case or in colour (judgments of 18/06/2009, T-418/07, LIBRO, EU:T:2009:208; 15/11/2011, T-434/10, Alpine Pro Sportswear & Equipment, EU:T:2011:663, appeal C-42/12 P, Alpine Pro Sportswear & Equipment, EU:C:2012:765 dismissed)

42. In addition, the Subject mark includes the Latin motto '*a posse ad esse*'. The Latin language is not commonly understood or spoken by the average English-speaking consumer, and as such this element cannot be memorable or distinctive in the minds of the public. It is also de minimis in the Subject mark. It is therefore clearly the term WEMBLEY which must be held to take dominance in this mark and is the manner to which consumers will refer to and remember the Subject mark.
43. Further, the Subject mark features the abbreviation 'F.C.' located within a simple football device. In Opposition No. B1040684, the decision issued states that "*the letters 'FC' in the CTM application would be recognised by part of the concerned consumer as 'Futbol Club' or 'Football Club'*", and we contend that the use of the abbreviation alongside a clear representation of a football therefore serves to create this meaning immediately and obviously in the minds of consumers.
44. Phonetically, the Subject Mark will be pronounced as WEMBLEY as the other elements would not be spoken or considered as important to speaking the content of the mark. Likewise, the Applicant's earlier marks will be pronounced as WEMBLEY, WEMBLEY STADIUM or CLUB WEMBLEY as appropriate. The respective marks are therefore aurally either identical or highly similar as containing the whole word WEMBLEY.
45. In addition, the mark must be considered conceptually similar to the Applicant's earlier CLUB WEMBLEY marks, which clearly hold a similar meaning to the Subject mark which would be interpreted as meaning WEMBLEY FOOTBALL CLUB. The conceptual similarity to the WEMBLEY per se mark of the Applicant is also clear as both marks conjure the image of the Applicant and its famous stadium and services, in operation for many decades, particularly in respect of sports and entertainment related goods and services.
46. The shield and lion element in the Subject mark, whilst forming part of the mark, would merely be seen to be a decorative element to denote a football club and given the fame and reputation of the Applicant discussed below, the Subject mark will still be immediately associated and confused with the Earlier marks of the Applicant, giving rise to a likelihood of confusion having regard to all surrounding circumstances and a global appreciation of the marks and goods/services. This is particularly so given the enhanced distinctiveness enjoyed by the Applicant as a result of its significant and longstanding use and reputation prior to that of the Registrant as demonstrated in the evidence submitted herein. As such, the respective marks are clearly phonetically and conceptually similar. This is also enhanced by the fact that England Football Team plays its home matches at Wembey Stadium and its crest badge depicts heraldic lions as seen at **Exhibit B**, also being an EU mark registered in its own right under No. 7405285. These images will therefore be in the mind of the relevant English speaking consumer on seeing the Subject Mark and will increase the conceptual similarities that already exist.
47. On balance, therefore, as the dominant and distinctive element of all of the marks is shared in terms of the identical WEMBLEY element, and the clear, understood meaning of 'FC' to denote football club, such that the similarities vastly outweigh any differences. The two must be considered similar.
48. It is also well established that two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects (*CFI, 27 November 2007, Gateway/OHIM – Fujitsu Siemens Computers, T-434/05, paragraph 35*).

Similarity between the goods/services

49. The Applicant's Earlier marks, cover a wide range of goods and services in multiple classes. For the sake of brevity, we do not set out details of these as part of this Statement of Grounds, but merely refer to the attached register extracts.

50. The Subject mark covers the following goods and services:

Class 3

Soaps; perfumery, essential oils, cosmetics, hair lotions; deodorants for personal use; perfumes; toiletries; creams; gels; lotions; foams; soaps; shampoos; conditioners; body paint; preparations for the bath and shower; pre-shave and aftershave preparations; shaving preparations

Class 6

Common metals and their alloys; small items of metal hardware; key rings; statues, statuettes and figurines; bronzes; trophies made of metal

Class 9

Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; fire-extinguishing apparatus; compact discs; digital music (downloadable from the Internet); telecommunications apparatus; mouse mats; mobile phone accessories; cassettes; compact discs; DVDs; MP3s; cameras; disposable cameras; bags for camera equipment; exposed films; games adapted for use with television receivers; computer mice; memory cards and sticks; computer games; screensavers; publications in electronic format; electric and electronic scoreboards; video discs; parts and fittings for all the aforesaid goods; magnets, none of the aforementioned goods being related to or for use in riding and/or equestrian activities

Class 12

Vehicles

Class 14

Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments; clocks and watches; costume jewellery; trophies; parts and fittings for all the aforesaid goods; ornaments, figurines of precious metal; models of precious metal; badges of precious metal and brooches; tie clips, tie pins, pins, cuff links; medals and medallions; coins; key rings; bracelets of precious metal; silver locket, rings, earrings; pendants; body jewellery; key fobs made of precious metal; key fobs

Class 16

Paper, cardboard and goods made from these materials, not included in other classes; printed matter; photographs; stationery; notepaper; writing paper; envelopes; decalcomanias; labels; trading cards; post cards; notepads; stickers; posters; pictures; prints; albums; periodical publications; newspapers; annuals; poster magazines; printed programmes; book markers; photograph albums; philatelic stamps; stationery; rulers; pencil sharpeners; blackboards; height charts; table mats made of paper; calendars; desk top calendars; beer mats; pencil cases; writing and drawing instruments; personal organisers; address books; diaries; autograph books; picture frames of greeting cards; wrapping and packaging materials; carrier bags; bags of paper and/or plastic material; appliqués of paper; laminated cards; tissues and towels made of paper; paper napkins and tablecloths; gift bags and gift wrap made of paper or plastic; pin cases; writing instruments of precious metals; gift vouchers; stamps

Class 18

Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and traveling bags; souvenir bags; umbrellas, parasols and walking sticks; handbags, rucksacks, purses; bags; travel bags; backpacks; duffel bags; boot bags; wallets; purses; credit card holders; belts for luggage; shoulder belts; luggage tags, none of the aforementioned goods being related to or for use in riding and/or equestrian activities

Class 20

Furniture, mirrors, picture frames

Class 21

Household and kitchen utensils and containers; glasses, beer mugs, bottles, crockery

Class 25

Clothing, footwear, headgear; articles of outer clothing; articles of sports clothing; track suits; shirts, sweatshirts/sweaters, t-shirts, shorts, tops, skirts, trousers, dungarees, socks; gloves, ties (for wear), scarves, bibs, romper suits; baby sleep suits; knitted articles of clothing and articles of clothing made from knitted materials, anoraks, jackets, rainwear; dressing gowns; pyjamas; articles of underclothing; boxer shorts; baby boots; belts for wear; braces; wrist bands; swimwear; football clothing, footwear and headgear, none of the aforementioned goods being related to or for use in riding and/or equestrian activities

Class 28

Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; toys, board games; jigsaws; amusement apparatus not included in other classes; kites; shin guards; gloves (games); tapes for wrapping racquet handle grips; bags adapted for carrying sporting apparatus; novelties; party novelty hats; miniature replica football kits; replica football kits made of plastic; action figure toys; toy vehicles; teddy bears; dolls; footballs; balls; goal posts; sponge hands in the nature of novelties; outdoor rebound walls in the nature of playthings and sporting articles; coin and/or counter-operated games; playing cards; rattles; balloons, toy figurines, toy musical boxes; wooden toys; toy torches; toy jewellery; replica football kits made of paper or cardboard

Class 32

Beers; lagers; non alcoholic beverages; fruit juices and syrups; soft drinks; water

Class 33

Alcoholic beverages (except beer); ciders, wines, spirits, liqueurs, gins, rums, whiskeys

Class 35

Advertising; business management; business administration; office functions; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; provision of business information; arranging and organising of trade exhibitions; advertising and promotional services; trade conferences, trade seminars and trade exhibitions; marketing services; public relations and publicity services

Class 41

Education; providing of training; entertainment services; sporting and cultural activities; provision of information, escorting and directing spectators, visitors and vehicles, all being performed by stewards in relation of sports events, conferences, seminars, concerts and exhibitions; provision of sport, entertainment, cultural and musical events; provision of stadium facilities; hosting of exhibitions and seminars; educational services relating to sport, culture and music; coaching; arranging and organisation of competitions and sporting events; provision of courses of instruction in coaching and player development; physical fitness instruction; practical training demonstrations relating to football; provision of club recreation facilities; officiating at sports contests; sports camp services; sports club services; provision of facilities for sports events, seminars and concerts; sports refereeing and officiating

Class 43

Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; providing facilities for conventions, conferences, exhibitions and seminars; provision of exhibition facilities

51. Ignoring obvious errors in the above list (such as 'tos' [toys] in class 28 and 'ibracelets' [identity bracelets] in class 14), all of the above goods and services are covered, either specifically or through the use of the Nice Class Headings, in the specifications of the earlier marks. By way of example, all of the above-listed goods with the exception of those listed in classes 12 and 33 are covered by EUTM registration no. 009047176. The remaining goods in class 12 are covered by EUTM Registration no. 00624376 and UK registration no. 2466088, whilst those in class 33 are covered by UK Registration nos. 2331757 and 2466088.
52. The Applicant also contends that the goods and services covered by their other earlier marks not specifically mentioned in the previous paragraph cover goods and services which are identical or highly similar to those of the Subject mark.

Likelihood of Confusion

53. Article 8(1)(b) states that a trade mark shall not be registered if because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier mark.
54. As set out above, the Registrant's mark is highly similar to the Applicant's Earlier marks visually, phonetically and conceptually, covering identical or similar goods/services.
55. In determining the existence of a likelihood of confusion on the part of the average consumer, both the degree of similarity of the marks and the goods must be considered. Furthermore, as stated in *Canon*, "A lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks and vice versa". As seen above, the Subject Mark contains the word WEMBLEY, dominant in the mark and wholly contained within it, also being the dominant element of the Applicant's Earlier marks. Only a high degree of dissimilarity between the goods/services could offset the close similarity of the marks but this is not the case here, as the goods/services of the Registrant are either identical or similar to those in the Applicant's earlier marks.
56. As such it must be concluded that, in light of these factors consumers will be confused as to the origin of goods and services bearing the parties' marks, and will at least associate the goods/services of the Registrant with the Applicant's Earlier marks. This is particularly the case given the enhanced distinctiveness of the Applicant's Earlier marks through use and as

a result of its longstanding, historical reputation over many decades as demonstrating in the evidence attached herein. Where a mark possesses an enhanced distinctiveness through use, case law recognises this can be a contributing factor to finding a likelihood of confusion which we say is clearly present in this case.

Article 53(1)(a) - Conclusion

57. In light of the aforementioned submissions, it is clear that the Applicant's marks and the Subject mark are similar. Moreover, the marks cover identical and highly similar goods and services. As such, pursuant to Article 8(1)(b) and Article 53(1)(a) of Council Regulation 207/2009 the Subject mark should be declared invalid.

Article 8(5) – Earlier Trade Mark with a Reputation

58. In accordance with Article 8(5), *'upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered where it is identical with or similar to the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier mark is registered, where in the case of an earlier Community Trade mark, the trade mark has a reputation in the Community and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark'*.

59. The case law in relation to reputation is now well established.

60. A mark with a reputation is a mark which is known by a significant part of the public concerned by the products or services covered by that trade mark (*ECJ, 14 September 1999, General Motors/Yplon, C-375/97, Paragraph 26*). The public concerned is, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector (*ibis.*, paragraph 24).

61. When assessing the reputation of a mark, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it (*ibid.*, paragraph 27).

62. These criteria are not cumulative; the fact that the proprietor of the trade mark with a reputation does not produce any documentation regarding the market share held by the trade mark does not prevent the court from recognising the reputation of the trade mark on the basis of other elements (*CFI, 10 May 2007, Antartica/OHIM – The Nasdaq Stock Market, T-47/06, paragraph 51*).

63. Turning now to the marks at issue, the Applicant's marks are clearly similar to the Subject mark for the reasons already set out under the sections concerning Article 53(1)(a).

64. Where the earlier marks are EU trade marks, according to Article 8(5), it must be shown that these marks have a reputation within the European Community. With regard to the United Kingdom national registrations, such reputation must be shown for the United Kingdom.

65. In this regard, we attach at **Exhibit C**, an independent report as to the historical use and references to WEMBLEY of the Applicant, dating back to the early 1920s and continuing and increasing in regularity. This Exhibit C contains evidence and exhibits within as follows:

- i. **Exhibit 1 - First FA Cup Final Programme April 1923 & April 1924**
- ii. **Exhibit 2 - FA Cup Final Programme April 1925**
- iii. **Exhibit 3 - FA Cup Final Programmes 1926-1929**
- iv. **Exhibit 4 - FA Cup Final Programmes 1930-1946**
- v. **Exhibit 5 - FA Cup Final Programme April 1931**
- vi. **Exhibit 6 - Article from FA Cup Final Programme 1932**
- vii. **Exhibit 7 - Cardiff City Memorial Card 1927**
- viii. **Exhibit 8 - Unofficial Programmes**
- ix. **Exhibit 9 - Daily Mail & Daily Express Souvenirs 1931**
- x. **Exhibit 10 - British Pathe Reels of Challenge Cup Finals 1929-1935**
- xi. **Exhibit 11 - Greyhound Racing & Speedway**
- xii. **Exhibit 12 - Boxing & Ice Hockey**
- xiii. **Exhibit 13 - UK Media Articles 1921-1926**
- xiv. **Exhibit 14 - German Media**
- xv. **Exhibit 15 - French Media**
- xvi. **Exhibit 16 - Spanish Media**
- xvii. **Exhibit 17 - Advertising Posters**

66. We also attach at **Exhibit D**, copies of the relevant pages of the annual reports of the Applicant, detailing the turnover and profit from 2008, 2009, 2010 and 2011 by way of example and all prior to the filing date of the Subject Mark. The annual turnover and operating profit for these years is shown below:

YEAR	TURNOVER	OPERATING PROFIT
2008	£89.7M	£5.9M
2009	£102M	£9.6M
2010	£92M	£10.5M
2011	£99M	£21.5M

67. It is clear from the reports that the Applicant has experienced year on year growth and even greater recognition in the sphere of sport and entertainment services, events and the like over recent years. The 2008 report refers to Wembley Stadium hosting the world's biggest events and also discussed CLUB WEMBLEY generated some 45m GBP in annual revenue. The 2009 and 2010 reports refer to the increased operations of the Wembley Shop within the introductory comments, thus demonstrating the shop, selling the merchandise goods was clearly operational prior to the date of the Subject Mark.
68. This evidence clearly demonstrates the use and recognition of WEMBLEY by consumers in respect of the core services of the Applicant for sports and entertainment related services for over 90 years and significantly prior to the Subject mark and any use claimed by the Registrant of the Subject mark. These references include numerous examples of WEMBLEY per se without the word STADIUM.
69. The report also highlights the fame of the Applicant and WEMBLEY for hosting the F.A Cup Final, a football showpiece with Europe-wide fame and recognition. This fact is important given the clear football interest of the Registrant and the 'FC' element in the Subject mark, all serving to increase the close nature of the respective marks and the free-riding, blurring and tarnishment to the distinctive character and repute of the Applicant's WEMBLEY marks. The Applicant also submits that the presence of a lion in a crest in the Subject Mark will further be associated with the Applicant given that the England Football team has played all of its home matches at WEMBLEY and it has a crest device consisting of lions as below, in Exhibit B, further increasing the association and clear link to the Applicant in the Subject mark:



70. Whilst the above mark does not form the basis of the invalidity action, it is important from the perspective of a global appreciation of all surrounding circumstances and to support the link that would be made to the Applicant by consumers on seeing the Subject mark and that is required under Article 8(5).
71. The report also details references to other sports and events held at WEMBLEY by the Applicant and media references and posters referring to such events.
72. We also attach a further independent report with relevant exhibits at **Exhibit E** which details the continued use and references to WEMBLEY and WEMBLEY STADIUM in relation to sporting and entertainment events and services from the period 1990 to 2012, again, prior to the filing of the Subject Mark. The report in Exhibit D consists of the following:

i. Exhibit 1 - FA Cup Final Programme 1990-1991 and 1999-2000

- ii. Exhibit 2 - FA Cup Final Programme 2006-2011
- iii. Exhibit 3 – League Cup Final Programmes
- iv. Exhibit 4 – England match Programmes 1990-2010 samples
- v. Exhibit 5 – Rugby challenge cup finals 1991 to 2010
- vi. Exhibit 6 – Motor Race of champions 2007
- vii. Exhibit 7 - wrestling
- viii. Exhibit 8 – American Football 2007-2009
- ix. Exhibit 9 – Rugby Union at Wembley
- x. Exhibit 10 – Rugby Union at Wembley
- xi. Exhibit 11 – Music events
- xii. Exhibit 12 – UK press articles 1990 to 2011
- xiii. Exhibit 13, 14, 15 – Foreign language media
- xiv. Exhibit 16, 17, 18 – Social media and website

73. In respect of Exhibits 13,14 and 15, as the word Wembley is clear and evident in these publications, being the mark in issue to which the Applicant is claiming a reputation, the Applicant submits that there is no need for translations to be provided of the full content of the articles. The articles refer to WEMBLEY and the references to this are clear.

74. We also attach **Exhibit F** to refer to the merchandising activities of the Applicant under its WEMBLEY and WEMBLEY STADIUM marks. This includes a press release from the official website of the Applicant from 2011 referring to the official Wembley Store, stating the store offers 'a wide range of merchandise:

- England Home And Away replica kits
- England training wear
- England accessories and souvenirs e.g. footballs, key rings, pin badges
- Wembley leisure wear
- Wembley souvenirs e.g. mugs, magnets, stationery
- A selection of Premier League Club related merchandise
- FA Cup branded merchandise
- Posters
- Event specific merchandise e.g. t-shirts, scarves, pin badges, flags
- Shirt printing is also available in store"

75. It also shows an archived webpage from the Club Wembley site referring to the Wembley Store, stating '*The Stadium Store has a large variety of merchandise including England kit*

and training wear, Wembley Stadium merchandise and football kits. Shirt printing is also available.'

76. There are also printouts from a visitlondon website referring to the Wembley store and with photos of the store interior and exterior showing some of the goods for sale. An archive page of the same site and details from 2012 is also provided.

77. The Exhibit F shows examples of official Wembley merchandise for sale now on the official website or through Amazon or eBay showing for example, the following:

- Posters
- post cards
- programmes
- key rings
- footballs
- teddy bears
- clothing
- hats
- mugs
- puzzles
- spoons
- confectionery
- magnets
- models
- pens
- holdalls
- Bags
- glassware.

78. All of these contain reference to WEMBLEY or WEMBLEY STADIUM either as a word or combined with the logos of the Applicant. Many of these examples are taken from archived web pages with the date shown on the pages. The merchandise store has been an inherent part of Wembley Stadium for many years and certainly prior to the filing date of the Subject Mark.

79. The evidence submitted in these reports and referenced above clearly supports the fact that the Applicant has a huge and long reputation in the WEMBLEY and WEMBLEY STADIUM marks in particular in respect of sporting and entertainment related services, advertising, marketing and publicity services through its huge exposure and press and in merchandise goods. This reputation exists long prior to the filing date of the Subject Mark and prior to any date of use the Registrant may claim.

80. Therefore, the use of the Subject Mark in its form with the sporting and football references, is without due cause and would evidently take unfair advantage of or be detrimental to the distinctive character of the Applicant's earlier marks.

81. A further requirement to Article 8(5) is detriment to the distinctive character, also referred to as 'dilution', 'whittling away' or 'blurring', is caused when that mark's ability to identify the goods or services for which it is registered and used as coming from the proprietor of that mark is weakened, since use of the later mark leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is noticeably the case when the earlier

mark, which used to arouse immediate association with the goods and services for which it is registered, is no longer capable of doing so.

82. The concept of unfair advantage being taken of the distinctive character or the repute of the earlier mark by the use without due cause of the mark applied for encompasses instances where there is clear exploitation and 'free-riding on the coat tails' of a famous mark or an attempt to trade upon its reputation. In other words, this concerns the risk that the image of a mark with a reputation or the characteristics which it projects are transferred to the goods covered by the mark applied for, with the result that the marketing of those goods is made easier by that association with the earlier mark with a reputation (*CFI, 22 March 2007, Sigla/OHIM – Elleni Holding, T-215/03, paragraph 40*).
83. In this case, the consumer, without necessarily confusing the commercial origin of the product or service in question, is attracted by the mark applied for itself and will buy the product or service covered by it on the ground that it bears that mark, which is identical or similar to an earlier mark with a reputation. This situation is different from that where there is a likelihood of confusion, i.e. where the consumer may be attracted by the product or service covered by the mark applied for by considering it to be a product or service with the same commercial origin as that covered by an earlier mark which is identical or similar to the mark applied for (*ibid., paragraph 42*).
84. The Registrant's decision to adopt the WEMBLEY name, and the subject mark featuring a sporting reference, a football, the letters FC and a heraldic lion in a crest is a blatant attempt to exploit the fame of the Applicant's marks, and their brand in general and to associate themselves with that reputation, creating the requisite link with the Applicant and gaining a commercial advantage by doing so.
85. In view of this, and taking into account the significant reputation the Applicant has established in the WEMBLEY brand through its various activities, we submit that the Registrants' use and/or potential use of the WEMBLEY FC and Lion's Head Device takes unfair advantage of the distinctive character or repute of the Applicant's brand in the sense that it clearly rides off the coat tails of that reputation.
86. Moreover, there is a real risk that use of an earlier mark with a reputation by a third party will lead to the owner of the earlier mark's brand being diluted and/or tarnished. For example, if substandard services were being offered under the Subject Mark or poor quality merchandise goods, then this would significantly harm the reputation and goodwill of the earlier marks of the Applicant.
87. We submit that this risk of tarnishment also exists with the Subject mark in respect of a football club given the clear overlap in goods/services and the Applicant's clear reputation, rich history and immediate association with football.

Article 8(5) – Conclusion

88. In light of the aforementioned submissions, it is clear that the Applicant's marks and the Subject mark are similar. Moreover, there is a clear reputation attached to the WEMBLEY brand in the European Community, and in particular, in the United Kingdom through its rich, enviable history.

89. Therefore, pursuant to Article 8(5) and Article 53(1)(a) of the Council Regulation 207/2009, the Subject mark should be declared invalid in its entirety as it is without due cause and its use would take unfair advantage of or be detrimental to the distinctive character of the Applicant's marks.

Article 8(4) and Article 53(1)(c) – Earlier non-registered mark

90. The Applicant also has a reputation in the United Kingdom through use of its extensive, longstanding and historic use of WEMBLEY in respect of many goods/services. This earlier non-registered trade mark has been used by the Applicant in the course of trade and is of more than mere local significance.

91. Therefore, the use of WEMBLEY in the United Kingdom confers on the Applicant the right to prohibit the use of the Registrant's confusingly similar Subject mark for identical goods and services under the laws of the United Kingdom and by virtue of the law of passing-off.

92. The requirements to succeed in an action for passing-off are set out in the Opposition Guidelines document of OHIM which states:

"The particularities of the action of passing off Passing off is an economic tort in the common-law jurisdictions, the essential elements of which are (i) a misrepresentation (ii) causing damage to (iii) the goodwill of a trader or traders.

It is a form of intellectual property enforcement against unauthorised use of an intellectual property right. The purpose of this section is not to analyse the substantive requirements of passing-off actions as developed by the jurisprudence of the common-law courts but rather to set out which rights that can be protected by passing-off actions fall within the scope of Article 8(4) CTMR, and to show how the European judicature has applied the key requirements of Article 8(4) CTMR as regards passing off.

Historically, and in their most common form, passing-off actions offer protection similar to that for registered trade marks to non-registered trade marks in that they prevent use of a name, word, device or get-up that leads to the goods or services of one trader being misrepresented as those of another. In doing so, passing-off actions protect the goodwill that traders accrue by using signs rather than protecting signs per se.

The tort of passing off covers a broad set of situations ranging from its usual form above to an extended form which may prevent the use of generic terms where such use misrepresents goods or services as possessing a characteristic or quality that they do not have (e.g. Vodkat used on a type of drink that is not Vodka). In passing-off actions, the opponent (claimant) must prove three elements, the so-called classical trinity:

- (a) goodwill attached to the goods or services that it supplies;*
- (b) misrepresentation by the defendant to the public (intentional or not) leading or likely to lead the public to believe that the goods or services offered are those of the opponent (claimant);*
- (c) damage (actual or potential) by reason of the erroneous belief engendered by the defendant's misrepresentation.*

93. By way of supporting documentation, in addition to the evidence set out in Exhibit C, D, E and F which the Applicant also relies on in respect of establishing earlier use and reputation of more than mere local significance under Article 53(1)(c), attached at **Exhibit G** is a printout from the Applicant's own website of a press release from April 2013 discussing the history and the recent 90th Anniversary of WEMBLEY.
94. The evidence submitted clearly and unequivocally shows that the Applicant has a goodwill in the WEMBLEY and WEMBLEY STADIUM names and in CLUB WEMBLEY in a wide variety of sport and entertainment related services and hospitality/events in addition to related merchandise items and goods. Such a goodwill is not only present throughout the UK but is arguably global given the fame and repute of the Applicant's mark and its services.
95. The goodwill, particularly for the sport and entertainment services, dates back decades in the UK prior to both the Registrant's Subject Mark and any use it may purport to have of its mark. The use of the Subject Mark would therefore lead to a misrepresentation to the public, even if this is not deliberate, as intent is not part of the assessment for passing-off under the UK law, that would lead consumers to believe the goods and services of the Registrant derive from or are licensed or approved by the Applicant when they are not.
96. UK passing-off law confirms that actual damage need not have resulted but simply the likelihood of such damage arising to the Applicant's significant and historical goodwill exists as a result of the misrepresentation by the Registrant.
97. For these reasons, it is submitted that the requirements under Article 8(4) and 53(1) (c) are made out in respect of the laws of passing-off in the UK.

Conclusion

98. In accordance with the above, we submit that:
- a) The Applicant's marks and the Subject mark are highly similar. Moreover, all of the marks cover identical goods and services; and
 - b) The Subject mark is highly similar to the Earlier trade marks, which have a reputation in the European Community, and specifically in the United Kingdom for English speaking consumers as is relevant, and that the use of the Subject mark would take unfair advantage or be detrimental to the distinctive character or repute of the Earlier marks.
 - c) The Applicant is the owner of a non-registered mark of more than mere local significance with a huge, historic reputation, particularly in the United Kingdom, which confers on the Applicant the right to prevent the use of the Subject mark
99. We therefore request that the Subject mark be declared invalid in its entirety pursuant to Articles 53(1)(a), 8(1)(b) and 8(5) and Article 53(1)(c) and 8(4), and an award of costs be made in favour of the Applicant.

LANE IP LIMITED

Authorised Representatives for the Applicant