

Alicante, 10/07/2017

NOVAGRAAF NEDERLAND B.V.
P.O. Box 22722
NL-1100 DE Amsterdam
PAÍSES BAJOS

Notification of a decision to the EUTM proprietor/IR holder

Invalidity number: **000013867 C**
Contested trade mark: **010625812**
WEMBLEY

Please find attached the decision terminating the proceedings referred to above. The decision was delivered on **10/07/2017**.

Please note that decisions of the Cancellation Division are not signed by the responsible officials but only indicate their full name and bear a printed seal of the Office in accordance with Rule 55(1) EUTMIR.

Elisa ZAERA CUADRADO



Enclosures (excluding the cover letter): 13 pages

CANCELLATION No 13867 C (INVALIDITY)

Wembley National Stadium Limited, Wembley Stadium HA9 0WS Wembley, London, United Kingdom (applicant), represented by **Lane IP Limited**, 2 Throgmorton Avenue, EC2N 2DG London, United Kingdom (professional representative)

a g a i n s t

Wembley Football Club Limited, 14 Woodfield Avenue North Wembley, HA0 3NR Middlesex, United Kingdom (EUTM proprietor), represented by **Novagraaf Nederland B.V.**, Hoogoorddreef 5, 1101 BA, Amsterdam, The Netherlands (professional representative).

On 10/07/2017, the Cancellation Division takes the following

DECISION

1. The application for a declaration of invalidity is upheld.
2. European Union trade mark No 10 625 812 is declared invalid in its entirety.
3. The EUTM proprietor bears the costs, fixed at EUR 1 080.

REASONS

The applicant filed an application for a declaration of invalidity against all the goods and services of European Union trade mark No 10 625 812. The application is based on various European Union and UK trade mark registrations, inter alia, European Union trade mark registration No 6 284 376 'WEMBLEY STADIUM'. The applicant invoked Article 53(1)(a) EUTMR in connection with Article 8(1)(b) and Article 8(5) EUTMR. The applicant also based its application on the non-registered sign 'WEMBLEY'. In this regard, it also invoked Article 53(1)(c) in connection with Article 8(4) EUTMR.

SUMMARY OF THE PARTIES' ARGUMENTS

The applicant provides a description of its activities as owner of Wembley Stadium, the national football stadium of the United Kingdom which hosts major sports and music events. The applicant considers that the English-speaking part of the public in the European Union will consider the signs in conflict similar as they share the dominant and distinctive element 'WEMBLEY'. Moreover, it considers that the contested goods and services are either identical or highly similar to the earlier trade marks. As a result, the relevant public will confuse or at least associate the contested EUTM with the earlier marks. The applicant further argues that this is particularly the case given the enhanced distinctiveness through use of its earlier marks.

In addition, the applicant submits evidence in support of its claim of the use and recognition of WEMBLEY marks by consumers in respect of its core services for sports and entertainment related services over 90 years. It further argues why the use of the

contested EUTM would take unfair advantage of or be detrimental to the distinctive character of the earlier marks.

Finally, the applicant contends that WEMBLEY is a non-registered trade mark which has been used in the course of trade and is of more than mere local significance. Therefore, it argues that the use of WEMBLEY in the UK confers the right to prohibit the use of the EUTM for identical goods and services under the laws of the UK and by virtue of the law of passing off.

The EUTM proprietor did not submit observations in reply.

LIKELIHOOD OF CONFUSION — ARTICLE 53(1)(a) EUTMR IN CONNECTION WITH ARTICLE 8(1)(b) EUTMR

A likelihood of confusion exists if there is a risk that the public might believe that the goods or services in question, under the assumption that they bear the marks in question, come from the same undertaking or, as the case may be, from economically linked undertakings. Whether a likelihood of confusion exists depends on the appreciation in a global assessment of several factors, which are interdependent. These factors include the similarity of the signs, the similarity of the goods and services, the distinctiveness of the earlier mark, the distinctive and dominant elements of the conflicting signs and the relevant public.

The application is based on more than one earlier trade mark. The Cancellation Division finds it appropriate to first examine the application in relation to the applicant's European Union trade mark registration No 6 284 376 'WEMBLEY STADIUM'.

a) The goods and services

The relevant factors relating to the comparison of the goods or services include, inter alia, the nature and purpose of the goods or services, the distribution channels, the sales outlets, the producers, the method of use and whether they are in competition with each other or complementary to each other.

The goods and services on which the application is based are, inter alia, the following:

Class 3: *Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; deodorants for personal use; perfumes; toiletries; creams; gels; lotions; foams; soaps; talcum powder; shampoos; conditioners; sprays; body paint; deodorants; antiperspirants; body and facial scrubs; breath freshners; preparations for the care, treatment and cleansing of the skin, hair and the body; non-medicated toilet preparations; preparations for the bath and shower; bath crystals; pre-shave and aftershave preparations; shaving preparations; cosmetic preparations; non-medicated baby care preparations; laundry detergent and fabric conditioners; vegetable dye skin transfers; boot cream and polish; car cleaning preparations; cushions filled with fragrant or perfumed substances; pot pourri; room fragrancing products; tissues impregnated with non-medicated preparations for personal use.*

- Class 6: *Common metals and their alloys; metal building materials; transportable buildings of metal; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores; unwrought and partly wrought common metals including simple products made of them; badges of metal for vehicles; metal badges; keyrings and key chains; locks and ornaments; metallic bins; keys, key blanks; signs; statues, statuettes and figurines; bronzes; trophies made of metal; money boxes; boxes; clothes hangers and clothes hooks; all made wholly or principally of common metals; parts and fittings for all the aforesaid goods.*
- Class 9: *Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers; calculating machines, data processing equipment and computers; fire-extinguishing apparatus; computer hardware and firmware; computer software (including software downloadable from the Internet); compact discs; digital music (downloadable from the Internet); telecommunications apparatus; computer games equipment adapted for use with an external display screen or monitor; mouse mats; mobile phone accessories; contact lenses, spectacles and sunglasses; clothing for protection against accident, irradiation or fire; PDAs (Personal Digital Assistants), pocket PC's, laptop computers; tapes; cassettes; compact discs; DVDs; MP3s; cameras; disposable cameras; bags for camera equipment; films; photographic transparencies and photographic films prepared for exhibition purposes; slides; lenticulars; video recorders; video cassettes; games adapted for use with television receivers; computers and computer hardware; computer mice; memory cards and sticks; computer games; computer and electronic games consoles; screensavers; publications in electronic format; data processing apparatus; electric and electronic scoreboards; video discs; time recording apparatus and instruments; parts and fittings for all the aforesaid goods; encoded and encrypted credit cards, debit cards, charge cards, smart cards and telephone cards; telephone apparatus and instruments; mobile telephones; telephone answering apparatus; telephone recorders; telephones incorporating facsimile machines; magnets; visual display units; protective helmets and sports bags for protective helmets; parts and fittings for all the aforesaid goods.*
- Class 12: *Vehicles; apparatus for locomotion by land, air or water; coaches; motor vehicles; bicycles.*
- 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; timekeeping systems for sport; shoe ornaments of precious metal; key rings; identity tags and bracelets of precious metal;*

silver lockets, rings, earrings; pendants; jewellery charms; body jewellery; fobs incorporating key rings.

Class 16: *Paper, cardboard and goods made from these materials, not included in other classes; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; notepaper; writing paper; envelopes; transfers; decalcomanias; labels; trading cards; post cards; notepads; stickers; posters; pictures; prints; albums; periodical publications; newspapers; annuals; poster magazines; programmes; programme binders; book markers; packs of photographs; photograph albums; philatelic stamps; stationery; rulers; pencil sharpeners; blackboards; height charts; coaching aids in the nature of magnetic and dry-wipeable surfaces with magnetic pieces; flags of paper, pennants of paper; replica football kits made of paper or cardboard; calendars; desk top calendars; milk cartons of cardboard; beer mats; paper, cardboard and paper mache figurines; pencil cases; writing and drawing instruments; files; folders and folios; personal organisers; address books; diaries; jotters; autograph books; picture frames of cardboard; greeting cards; wrapping and packaging materials; souvenir bags of paper or plastic; carrier bags; bags of paper and/or plastic material; paper weights; appliques of paper; laminated cards; tissues and towels made of paper; lithoserigraphs; rosettes of paper; paper napkins and tablecloths; non-encoded credit, debit and charge cards; gift bags and gift wrap; pin cases; writing instruments of precious metals; gift vouchers; stamps; table mats made of paper; holders for checkbooks.*

Class 18: *Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; handbags, rucksacks, purses; clothing for animals; bags and containers; travel bags; backpacks; duffel bags; boot bags; holdalls; wallets; purses; credit card holders; belts for luggage; shoulder belts; luggage tags.*

Class 20: *Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics; metallic and non-metallic furniture including garden furniture; pillows and cushions; tags, not of metal or paper; tags for use on soccer bags, made wholly or principally of plastic; identity tags; identity tags for use on soccer bags, made wholly or principally of plastic; identification bracelets (not of metal) for hospital purposes; plastic clips; plastic closures for containers; cake decorations made of plastic; non-metallic bins; plastic figurines; plastic key rings; locks, not of metal; decorative plaques, not of metal; headboards being furniture, figurines, statuettes, of wood, wax, plaster and plastic; sleeping bags; bean bags. ç*

Class 21: *Household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steel wool; un-worked or semiworked glass (except glass used in building); glassware, porcelain and earthenware not included*

in other classes; electric and non-electric toothbrushes; domestic utensils and containers; wooden kitchen articles; lunch boxes; flasks; tankards; pewterware; mugs; pint glasses; lager glasses; wine glasses; champagne flutes; tumblers; whisky tumblers; chinaware; porcelain and earthenware; plastic cups, soap holders and dispensers; toothbrush holders; ceramic ornaments, plaques and hollowware; cleaning cloths; water bottles; perfume atomisers; perfume flasks and funnels; pill boxes; compacts (not of precious metals or coated therewith) containing mirrors; money boxes, figurines, statuettes of porcelain, terra-cotta or glass; tankards; tea plates, tea services, tea caddies, tea pots, goblets, egg cups; trays, vases and urns; salt and pepper pots; napkin holders and napkin rings, all made wholly or principally of precious metals and their alloys or coated therewith; silver perfume atomisers; silver perfume flasks and funnels; silver pill boxes; silver compacts containing mirrors.

Class 25: *Clothing, footwear, headgear; articles of outerclothing; 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.*

Class 28: *Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; hand-held computer games equipment which is self contained (not adapted for an external display screen or monitor); toys, board games; jigsaws; amusement apparatus; kites; shin guards; gloves (games); tapes for wrapping raquet 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.*

Class 32: *Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; shandy, de-alcoholised drinks, non-alcoholic beers and wines; cola drinks; lemonade; lagers; isotonic and sports drinks; soft drinks.*

Class 35: *[among others] 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; accountancy; auctioneering; trade fairs; opinion polling; data processing; provision of business information; arranging and organising of trade exhibitions; advertising and promotional services; trade conferences, trade seminars and trade exhibitions; business advice, assistance and business management consultancy services; 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; recreational information services; recreational information services provided on computer networks and by telephone; 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; production of television programmes; training services; football academy services; assessment and qualifications services; coaching; arranging and organisation of competitions and sporting events; provision of courses of instruction in coaching, sports medicine, player development and child protection and welfare; physical fitness instruction; practical training demonstrations relating to football; providing courses of instruction in selfawareness; arranging and conducting seminars, conferences, exhibitions, symposia and concerts; 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; timing of sports events; staging of sports tournaments, publication of printed matter; award ceremonies; betting services; provision of information relating to all of the aforesaid services.*

Class 43: *Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking/reservation services for restaurants and holiday accommodation; hotel accommodation and reservation services; tourist office accommodation and reservation services; providing facilities for conventions, conferences, exhibitions and seminars; provision of exhibition facilities; vetting of tourist accommodation.*

The contested goods and services are the following:

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.*

Contested goods in Classes 3, 6, 9, 12, 14, 16, 18, 20, 21, 25, 28 and 32

All of the contested goods in Classes 3, 6, 9, 12, 14, 16, 18, 20, 21, 25, 28 and 32 are identically contained in both lists of goods or are included in the broad categories of or overlap with the applicant's goods. In this regard, the Cancellation Division notes that the contested *exposed films* in Class 9 are included in the broad category *films* in Class 9 of the earlier trade mark. Similarly, the contested *printed programmes* in Class 16 are included in the broad category *programmes* in Class 16 of the earlier trade mark; the contested *souvenir bags* in Class 18 are included in the broad category *bags* in Class 18 of the earlier mark; and the contested *beer mugs, bottles, crockery* in Class 21 are included in the broad categories *glassware, porcelain and earthenware* in Class 21 of the earlier mark.

For the sake of completeness it is noted that the contested goods in Class 28 *replica football kits made of paper or cardboard* are included in the list of goods protected by the earlier mark in Class 16. These goods have the same nature, purpose and method of use. Moreover, they are in competition with each other and can coincide in their producers. Therefore, they are highly similar.

Contested goods in Class 33

The contested goods *alcoholic beverages (except beer)* and *wines* are considered similar to *beers* protected by the earlier mark in Class 32 as they have the same nature (beverages) and can coincide in producer, end user and distribution channels.

Similarly, the contested goods *ciders, spirits, liqueurs, gins, rums, whiskeys* are considered similar to *beers* protected by the earlier mark in Class 32 as they have the same nature (beverages) and can coincide in end user and distribution channels.

Contested services in Classes 35, 41 and 43

All of the contested services in Classes 35, 41 and 43 are identically contained in both lists of services.

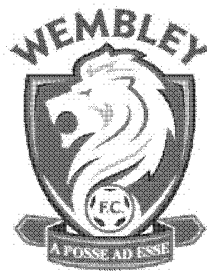
b) Relevant public — degree of attention

The average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect. It should also be borne in mind that the average consumer's degree of attention is likely to vary according to the category of goods or services in question.

In the present case, the goods and services found to be identical and similar to various degrees are partially directed at the public at large and partially directed at business customers with specific professional knowledge or expertise, in particular, certain goods such as *common and precious metals and their alloys* and certain services in Classes 35, 41 and 43. The degree of attention will vary from average to high.

c) The signs

WEMBLEY STADIUM



Earlier trade mark

Contested trade mark

The relevant territory is the European Union.

The global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression, bearing in mind their distinctive and dominant components (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23).

The unitary character of the European Union trade mark means that an earlier European Union trade mark can be relied on in proceedings for a declaration of invalidity against any European Union trade mark that would adversely affect the protection of the first mark, even if only in relation to the perception of consumers in part of the European Union (18/09/2008, C-514/06 P, Armafoam, EU:C:2008:511, § 57, by analogy). Therefore, a likelihood of confusion for only part of the relevant public of the European Union is sufficient to declare the contested trade mark invalid. In the present case, the Cancellation Division finds it appropriate to focus the comparison of the signs on the English-speaking part of the relevant public.

The earlier mark is a word mark. It will be understood by the relevant public as referring to a large multi-purpose ground ('stadium') in the Wembley area in London where the English national football team plays (www.collinsdictionary.com).

Bearing in mind that the relevant services in Class 41 refer to a number of services related to the provision of events (conferences, sports, musical and cultural events), the element 'STADIUM' will be weak for these services as it will be associated with the type of venue where these events are hosted. Therefore, the element 'WEMBLEY' is the most distinctive element in relation to those services. For the rest of the goods and services, both elements are equally distinctive.

The contested mark is a figurative mark consisting of a red coat of arms, depicting the stylised head of a lion which occupies nearly the entire shield and which is predominantly in white. A smaller and stylised representation of a football ball appears underneath the lion's head, in white and blue with the letters 'F.C.' in red. Above and below the coat of arms appear various verbal elements: above, the word 'WEMBLEY' represented in red block letters; below, a red ribbon with the following expression written in small white block letters: 'A POSE AD ESSE'. The combined presence of the element 'WEMBLEY' with the representation of a football ball and the letters 'F.C.' make that the contested mark as a whole will be associated, at least by a substantial part of the relevant public in the United Kingdom, with a Football Club ('F.C.') from the Wembley area in London. It is unlikely however that a substantial part of the public will grasp the meaning of the Latin expression 'A POSE AD ESSE' ('from possibility to actuality').

All the elements of the contested sign are equally distinctive except the football ball with the letters 'F.C.' on it. The public will associate this element as allusive to a particular type of sport. It is therefore weak in relation to the sport articles and football-related goods in Classes 25 and 28 and the services connected to sport in Class 41.

The white lion in the coat of arms and the element 'WEMBLEY' are the dominant elements of the contested mark as they are the most eye-catching.

Visually, the signs coincide in the verbal element 'WEMBLEY', which is a distinctive element in both signs and it is the co-dominant element in the contested sign. Moreover, it is the first verbal element of the earlier sign and the one placed

predominantly on top of the contested sign. Consumers generally tend to focus on the first element of a sign when being confronted with a trade mark. This is justified by the fact that the public reads from left to right, which makes the part placed at the left of the sign (the initial part) the one that first catches the attention of the reader. Likewise, consumers generally tend to read from top to bottom.

They differ in all other elements of the signs described above. However, the differing element 'STADIUM' in the earlier sign is placed in second position. As regards the differing verbal elements of the contested sign ('F.C.' and the Latin motto), they are less visually eye-catching than 'WEMBLEY', whereas the figurative elements (the coat of arms with the lion and the ball and the ribbon) may have a less strong impact. In this regard, it should be noted that when signs consist of both verbal and figurative components, in principle, the verbal component of the sign usually has a stronger impact on the consumer than the figurative component. This is because the public does not tend to analyse signs and will more easily refer to the signs in question by their verbal element than by describing their figurative elements (14/07/2005, T-312/03, Selenium-Ace, EU:T:2005:289, § 37; decisions of 19/12/2011, R 233/2011-4 Best Tone (fig.) / BETSTONE (fig.), § 24; 13/12/2011, R 53/2011-5, Jumbo(fig.) / DEVICE OF AN ELEPHANT (fig.), § 59).

Taking into account the above considerations, the signs are visually similar to a low degree.

Aurally, the pronunciation of the signs coincides in the sound of the letters 'WEMBLEY', present identically at the beginning in both signs. The pronunciation differs in the sound of the letters 'STADIUM' of the earlier sign which has no counterpart in the contested mark. The contested sign has additional verbal elements ('F.C.' and 'A POSE AD ESSE'), however, it is highly unlikely that they will be pronounced by the relevant public when referring to the signs.

In view of the above, the signs are aurally highly similar.

Conceptually, reference is made to the above considerations regarding the meaning of the signs. Both signs will be associated with the area of 'WEMBLEY' in London. More particularly, the relevant public will associate the earlier sign with a large sports ground in that area and the contested sign will be connected with a football team also in that area. As the signs will be associated with a similar meaning and both relate to a certain extent with football, the signs are similar to a high degree.

As the signs have been found similar in at least one aspect of the comparison, the examination of likelihood of confusion will proceed.

d) Distinctiveness of the earlier mark

The distinctiveness of the earlier mark is one of the factors to be taken into account in the global assessment of likelihood of confusion.

According to the applicant, the earlier mark has been extensively used and enjoys an enhanced scope of protection. However, for reasons of procedural economy, the evidence filed by the applicant to prove this claim does not have to be assessed in the present case (see below in 'Global assessment').

Consequently, the assessment of the distinctiveness of the earlier mark will rest on its distinctiveness per se. In the present case, the earlier trade mark as a whole has no

meaning for any of the goods and services from the perspective of the public in the relevant territory. Therefore, the distinctiveness of the earlier mark must be seen as normal, despite the presence of a weak element in the mark for certain services as stated above in section c) of this decision.

e) Global assessment, other arguments and conclusion

Evaluating likelihood of confusion implies some interdependence between the relevant factors and, in particular, a similarity between the marks and between the goods or services. Therefore, a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the marks and vice versa (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 17).

Moreover, likelihood of confusion covers situations where the consumer directly confuses the trade marks themselves, or where the consumer makes a connection between the conflicting signs and assumes that the goods/services covered are from the same or economically linked undertakings.

In the present case, the goods and services have been found to be partially identical and partially similar to various degrees. In addition, the signs are identical in their initial and distinctive verbal element 'WEMBLEY'. This element is also co-dominant in the contested sign. The differing element 'STADIUM' of the earlier sign plays a secondary role because of its position and, in relation to some of the services, also because of its weakness. As regards the other elements of the contested sign, in particular the predominant figurative element of a coat of arms with the head of a lion, although they certainly create a number of visual differences, they cannot outweigh the aural and conceptual similarities of the conflicting signs due to the presence of the common element 'WEMBLEY'. This conclusion applies a fortiori with regard to the secondary elements of the football ball and the ribbon with the Latin motto.

In view of the above, even if the public may display a higher degree of attention in relation to some of the relevant goods and services, the Cancellation Division finds that there is a likelihood of confusion on the part of the English-speaking part of the public. As stated above in section c) of this decision, a likelihood of confusion for only part of the relevant public of the European Union is sufficient to declare the contested trade mark invalid.

Therefore, the application is well founded on the basis of the applicant's European Union trade mark registration No 6 284 376. It follows that the contested trade mark must be declared invalid for all the contested goods and services.

Since the cancellation application is successful on the basis of the inherent distinctiveness of the earlier mark, there is no need to assess the enhanced degree of distinctiveness of the earlier mark due to its reputation as claimed by the applicant. The result would be the same even if the earlier mark enjoyed an enhanced degree of distinctiveness.

As the earlier right European Union trade mark registration No 6 284 376 leads to the success of the application and the cancellation of the contested trade mark for all the goods and services against which the application was directed, there is no need to examine the other earlier rights invoked by the applicant (16/09/2004, T-342/02, Moser Grupo Media, S.L., EU:T:2004:268).

Since the application is fully successful on the grounds of Article 8(1)(b) EUTMR, there is no need to further examine the other grounds of the application, namely Article 8(5) EUTMR in conjunction with Article 53(1)(a) and Article 8(4) in conjunction with Article 53(1)(c) EUTMR.

COSTS

According to Article 85(1) EUTMR, the losing party in cancellation proceedings must bear the fees and costs incurred by the other party.

Since the EUTM proprietor is the losing party, it must bear the cancellation fee as well as the costs incurred by the applicant in the course of these proceedings.

According to Rule 94(3) and (6) and Rule 94(7)(d)(iii) EUTMR, the costs to be paid to the applicant are the cancellation fee and the representation costs, which are to be fixed on the basis of the maximum rate set therein.



The Cancellation Division

Michaela SIMANDLOVA Elisa ZAERA CUADRADO Ana MUÑIZ RODRÍGUEZ

According to Article 59 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 60 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 720 has been paid.

The amount determined in the fixation of the costs may only be reviewed by a decision of the Cancellation Division on request. According to Rule 94(4) EUTMR, such a request must be filed within one month from the date of notification of this fixation of costs and shall be deemed to be filed only when the review fee of EUR 100 (Annex I A(33) EUTMR) has been paid.